

# WORLD TRADE ORGANIZATION

RESTRICTED

TN/IP/M/27  
5 January 2011

(11-0001)

**Council for Trade-Related Aspects of  
Intellectual Property Rights  
Special Session**

## MINUTES OF MEETING

Held in the Centre William Rappard  
on 28 October 2010

*Chairman: Ambassador D. Mwape (Zambia)*

<u>Subjects discussed</u>	<u>Page No.</u>
A. NEGOTIATION ON THE ESTABLISHMENT OF A MULTILATERAL SYSTEM OF NOTIFICATION AND REGISTRATION OF GEOGRAPHICAL INDICATIONS FOR WINES AND SPIRITS .....	1
B. OTHER BUSINESS .....	21

- 
1. The twenty-seventh Special Session agreed to adopt the agenda as set out in WTO/AIR/3633.
  - A. NEGOTIATION ON THE ESTABLISHMENT OF A MULTILATERAL SYSTEM OF NOTIFICATION AND REGISTRATION OF GEOGRAPHICAL INDICATIONS FOR WINES AND SPIRITS
    2. The Chairman recalled that in line with the work programme for negotiating groups for the period of September to December 2010 he had held informal consultations on how to organize the Special Session's work with delegations sponsoring TN/IP/W/10/Rev.2 and with those sponsoring the modalities proposal in TN/C/W/52, as well as with Hong Kong, China, on 14 October 2010. On the following day, he had informed the whole membership about his group consultations at an open-ended informal meeting for purposes of transparency and inclusiveness.
    3. He further recalled that the 26<sup>th</sup> meeting of the Special Session held on 10 June had structured its work and discussion around the two sub-questions he had posed under the *chapeau* of the two main questions raised by his predecessor, Ambassador Clarke, on legal effects or consequences of registrations. These two sub-questions had been motivated by the following considerations. There was a need for that negotiating group to depart from rhetorical debates. While several issues were important to that negotiation, including inter alia the other key issue of participation and the important area of special and differential treatment, his sense was that the issue of legal effects or consequences of registration was the stumbling block. In order to depart from rhetorical discussions he believed it would be helpful for delegations to first focus on grounds they felt sufficiently comfortable, i.e. current rules and practices in their own jurisdictions. He believed that this would help the negotiating group see more clearly differences and areas of commonality.

4. He said that the two sub-questions were intended to structure and focus the discussion on central elements of the discussion on legal effects or consequences of registration, and to better understand the concerns expressed by some Members. The sub-questions were not intended to lead in any particular direction or to prejudge any result of the discussions. It was they, the delegations, who had the say. The first sub-question concerned how domestic trademark and GI authorities currently operated and how their operating mode might be affected by different ways of taking into account the information in the envisaged Register of geographical indications for wines and spirits. The second sub-question concerned how domestic authorities were currently dealing with the substantiation of claims of genericness of a term in procedures of registration and protection.

5. In his view, the discussion at the meeting of 10 June had been extremely informative as delegations had explained the current procedures and practices applied at domestic level. There existed now a wealth of information which he believed would grow and merit close examination. Since some of the responses at the last meeting had been preliminary and not all delegations had been able to give responses due to the short notice of the sub-questions, he suggested to continue exploring the issues at this formal meeting. Delegations which had given preliminary comments would therefore have the opportunity to further supplement the information, to fine tune it or to respond to other delegations' observations. He also urged delegations which had not hitherto taken the floor to provide information about current practices in their own jurisdictions.

6. He also wished to make it clear that that any other means by which Members might have intended to share information about their systems at this meeting, such as case studies, scenarios or presentations, remained most welcome and that delegation wishing to address any other issues, including participation and special and differential treatment, should feel free to do so.

*First sub-question<sup>1</sup>*

7. Before addressing the first sub-question, the Chairman recalled that, at the June meeting, the delegation of the United States had made suggestions about "further elaboration of sub-question Number 1". The suggestions had been reflected in paragraph 68 of the minutes in TN/IP/M/26. At the request of the delegation of the United States, hard copies of these questions had been made available in the room. He suggested that, when addressing the various elements of his sub-questions, the delegation of the United States used their perspective to respond to them, which would help other delegations to better understand the current practices in the United States.

8. The representative of Hong Kong, China said that sharing and exchanging technical information would deepen Members' understanding of the operation of national trademark and GI authorities in practice, particularly on how information was taken into account. Her delegation had already shared with Members information on its domestic system which was recorded in paragraphs 21 to 24 and paragraphs 86 and 87 of the minutes of the meeting (TN/IP/M/26). She believed that such exchanges on domestic systems should, at some point, lead to a discussions on how the prevailing systems could take account of a multilateral register. In that context, her delegation believed Hong Kong, China's room document dated 28 October 2009 could help to focus the discussion.

9. That room document had illustrated the working of Hong Kong, China's proposal by way of four hypothetical case studies, which dealt with:

---

<sup>1</sup> "When making decisions regarding the protection of geographical indications and trademarks, what sources of information are the relevant national agencies currently legally obliged to take into account and what sanction is available if they fail to do so? Are additional sources of information that become newly available automatically covered by such a legal obligation?"

- A non-contentious notification and registration of a geographical indication from a participating WTO Member economy at both the domestic and international levels;
- A contentious geographical indication that is resolved at the domestic level before notification and registration at the international level from a participating WTO Member economy.
- A non-protectable geographical indication that is screened out by a participating WTO Member economy at the domestic level; and
- A contentious notification and registration at both international and domestic level, where the case is finally resolved at the domestic level in another participating WTO Member economy.

10. She believed this room document could play a useful role in the discussions and her delegation would continue to perform a bridging role in the negotiation of a registration system of geographical indications for wines and spirits.

11. The representative of Thailand said that, with respect to the Chairman's sub-question 1, when making decisions regarding the protection of geographical indications, the national agency in Thailand was required to take into account the information mentioned in the Act on Protection of Geographical Indications of 2003 and the Ministerial Regulations of 2004. However, the Thai GI Protection Act and its Ministerial Regulations did not specifically provide sources of information for the national agency to take into account when making such decisions. The competent official could therefore also call upon the applicant or other persons concerned to give a statement or produce additional evidence. In cases where an expert opinion is necessary in the field related to the matter requiring determination, the Registrar had to refer the matter to the experts for consideration. If the authority failed to do so, the applicant could file a complaint to the national agency for administrative measures. If the applicant was not satisfied with the administrative decision, the applicant could further pursue the case by filing a complaint to the administrative court. Under this legislation, the national agency was not required by law to take into account the newly available information. If an interested party or competent official made a request to the Registrar to consider information newly available, then the national agency would consider this information and forward it to the GI Board for a decision on whether or not to correct or revoke the GI legislation.

12. The representative of Turkey said with respect to the first sub-question that in addition to its specific regime for the protection of trademarks Turkey had established a *sui generis* system for the protection of geographical indications. Both trademarks and GIs were currently protected in the context of a decree, but two separate draft laws were pending in parliament in that regard.

13. With respect to the protection of the geographical indications, following examination and acceptance, Article 9 of Decree 555 provided that where necessary, or if there was an objection upon publication in accordance with Article 11, the Turkish Patent Institute might require an examination of the application by one or more public institutions, universities or independent private institutions. The names of these institutions were not specifically mentioned in the legislation itself. Depending on the nature of the application, views from local institutions or research institutions could be requested. These institutions only provided advice and did not express any views on whether or not the subject matter of the application constituted a geographical indication.

14. With respect to the procedure for trademark applications the legislation did not itself specify any sources of information. One absolute ground for refusal of a trademark application was that the sign was identical or confusingly similar with an earlier trademark in respect of an identical or same type of product or service. In that context examiners consulted a database that had been established

in 2005. Under Article 7 on the protection of trademarks, some basic criteria were applied in Turkey. She said there was also an on-going twinning project with the European Union in which the Turkish Patent Institute was working towards more extensive and detailed guidelines to be applied which would be published after conclusion of the project.

15. The representative of Australia said that her delegation had provided preliminary responses to the Chairman's question in June but she was now in a position to elaborate on these more fully. Her delegation considered that the Chair's sub-question allowed Members to further explore the information that domestic systems took into account when determining how common names and generic names were addressed in their domestic IP systems. However, her delegation had found the reference to "legally obliged" and "sanctions" to be quite narrow. Accordingly her delegation had constructed its responses based on Australia's system, which included reference to non-legally binding aspects as well as those based in law.

16. With respect to sub-question 1, she said that when determining a trademark in Australia, consistent with Article 15 of TRIPS, trademark examiners considered whether a sign was capable of distinguishing goods or services in the marketplace. On the basis of legislation and practice guidelines, examiners sought to determine how the term might ordinarily be used or understood in the marketplace. Determining whether a trademark was capable of distinguishing the specified goods or services required an assessment of whether the term had sufficient inherent adaptation to distinguish the good or service in the marketplace. A term could not be inherently adapted to distinguish products if it had a commonly understood meaning. Australia generally protected geographical indications through certification trademarks, which differed from ordinary trademarks in that they had to be capable of distinguishing certified goods and services from non-certified goods and services. Such a mark certified the goods as having a certain standard of quality or accuracy, a particular composition or geographical origin, for example.

17. In accordance with established practice, examiners were trained to assess consumer perception in relation to whether the sign or indication was one that other traders were likely to need in the ordinary course of business to indicate their similar products. An examination decision was an administrative decision in Australian law. Examiners used a range of standard sources and resources to determine whether trademarks, including certification trademarks, were capable of distinguishing goods or services. These resources included, but were not limited to, dictionary references, gazette references, industry information, use by multiple traders as a descriptive term, Internet searches, decisions in other jurisdictions, observations by applicants and observations by third parties.

18. With regard to available sanctions, if an examiner failed to take information into account, Australia did not apply sanctions to trademark examiners but provided possible recourses. If an interested person was not satisfied with the examiner in relation to a trademark, that person might pursue action through an administrative hearing process. Further review mechanisms were also available through the courts, including rejections of the trademark application. Hearing decisions could be appealed to the prescribed court. Under these proceedings an application might be found to be for a term accepted as a generic term.

19. Regarding the taking into account of additional sources of information, such newly available information might be taken into account in a number of ways. If additional new information was provided by way of third party observation, it might be taken into account. A third party observation could take place by way of a letter to the office attempting to prevent registration and providing reasons for that. The information contained might be taken into account but the office was not obliged to act upon it. In such a case the office did not engage with the third party on the issues but provided information that registration of the application might be opposed if it was accepted. New information could also be provided in support of registrations by way of evidence from third parties. If additional new information became available after acceptance but before registration of the

trademark, it might be taken into account by way of revocation proceedings or opposition to registration. Any person might oppose the registration of a trademark on a specific range of grounds. These grounds included almost all of the grounds for which an application could have been rejected during examination and also some additional grounds.

20. Finally, if additional new information became available after registration, action might be taken through the courts. In Australia, action through the courts in relation to new information included rectification action to achieve either amendment or cancellation of the trademark. Action might be taken in the courts on any of the prescribed grounds on which registration could have been opposed in the first place. If a registered trademark contained or consisted of a sign that became generally accepted within the relevant trade as a sign that described or was the name of an article, substance or service, rather than a product or service from one particular trade source, then the registered owner lost the exclusive right to use or authorize other persons to use the trademark in relation to the particular article, substance or service.

21. The representative of New Zealand said that his delegation continued to support the Chairman's method of work as set out in his introduction. New Zealand had already responded to the sub-questions at the last meeting and he noted that a good record of that intervention was contained in the minutes in TN/IP/M/26. In relation to the first sub-question he would refer Members to paragraphs 29 to 38 of the minutes. Rather than repeating those statements again, he said his delegation would be happy to elaborate or to explain further if Members should have any specific questions.

22. In that same spirit, his delegation would appreciate clarification on some statements made at the last meeting. First, in relation to the statement by the European Union on the issue of guidance for domestic systems as to the consequences of consulting various sources of information. The delegation of the European Union had emphasized, as was reflected in paragraph 20 of the minutes, that to simply provide for a consultation of that information would not be sufficient because for a source to be truly relevant the competent authorities would need to have clear legally binding guidelines on the consequences to be derived from such consultation.

23. The European Union had also referred to the sources of information which the Commission consulted when making decisions. It had stated in paragraph 11 of the minutes that the Commission services would examine the information contained in the GI application file and would also consult and take into account any other sources of information they deemed appropriate. In view of the European Union's suggestion that there be legally binding guidelines on the consequences that consultation of the sources of information should entail, he asked the following questions: firstly, what were the clear legally binding guidelines on the consequences to be derived from consulting the application file; secondly, what were the clear legally binding guidelines on the consequences to be derived from examining other sources of information deemed appropriate; and thirdly, where were those legally binding consequences set out, in the EU regulation or in another text.

24. His delegation's second question concerned the issue of how GI or trademark examiners weighed information from various sources when they were making the decision. As his delegation had stated last time, New Zealand considered it important that examiners retained discretion regarding how to weigh various pieces of information from different sources on a case-by-case basis and not to have any particular source of information deemed to be more important than any other source or any other evidence that might be presented to the examiner. In relation to this issue, in paragraph 11 of the last meeting's minutes the delegation of the European Union had referred to the *ex officio* examination of an application and an objection procedure where third parties could file duly substantiated objections. The EU delegation had stated that on the basis of all of the information available the Commission would then decide either to grant protection or to reject the application. His question was how the Commission weighed the various pieces of information referred to in that

statement, and whether the Commission was required to give greater weight to any of those various sources of information or whether the Commission had discretion to weigh that evidence on a case-by-case basis as it saw fit.

25. The representative of Chinese Taipei said with respect to sub-question 1 that her delegation would like to elaborate on the preliminary responses given at the last meeting. As noted before, Chinese Taipei protected geographical indications through several mechanisms, and the trademark system was one of the principal avenues. In applications for the registration of trademarks, certification marks or collective trademarks, intellectual property examiners followed the standards provided by the Trademark Act and the relevant regulations or examination guidelines to guide them in their processing and substantial determinations. Based on that legislation, when examining an application, an examiner had to consult the prior trademark database established by the Intellectual Property Office and any other available information including any objective evidence from dictionaries, governmental bulletins, newspapers, journals and magazines. As additional new sources of information became available, for example, if a new database were to be established on the basis of the joint proposal on the multilateral system of notification and registration of geographical indications for wines and spirits, such information would automatically be included as a source of information for examination. She said that, if an applicant was dissatisfied with a rejection by the Intellectual Property Office, the applicant could make an administrative appeal and resort to further litigation in order to have established that the decision was against the law and should be revoked. One reason for an appeal could be that an examiner had not taken into account some important information.

26. The representative of Japan said that his delegation welcomed the ongoing technical discussion based on the sub-questions elaborated by the Chairman which he believed could lead to a mutual satisfactory solution under the mandate. His delegation had made a preliminary comment to the Chair's question 1 at the previous session and, based on that, would like to provide further comments.

27. With regard to geographical indications for wines and spirits, he said that Japan had introduced administrative measures by a notice from the National Tax Agency entitled "A Standard for Indication in Relation to Geographical Indications," which was based on the Law Concerning Liquor Business Association and Measures for Securing Revenue from Liquor Tax. The notice provided that in addition to Japanese geographical indications designated by the Commissioner of the National Tax Agency, any geographical indication protected in a WTO Member was also protected in Japan. When deciding whether or not a claimed geographical indication would be protected in Japan, it was current practice that information on a related geographical indication registered and protected in other Members on the Internet and other devices would be consulted and taken into account. He said that under the TN/C/W/52 proposal, the fact that a geographical indication was listed in the GI Register would be treated as prima facie evidence that the said geographical indication met the definition in Article 22.1 of the TRIPS Agreement. His delegation wished to explain how such a proposal would impact on the current practice, although it was difficult to do so in the absence of a detailed legal text.

28. When deciding whether or not a specific geographical indication protected in other Members would be protected in Japan, Japanese authorities currently examined themselves whether such a geographical indication met the definition in Article 22.1 of the TRIPS Agreement based on relevant information. With respect to certain specific geographical indications Japan had agreed in several Economic Partnership Agreements (EPAs) that these were indeed geographical indications as defined in Article 22.1 of the TRIPS Agreement. With respect to other claimed geographical indications it was necessary for expert officials to scrutinize numerous documents that Japan requested the other party to submit in order to prove that the claimed geographical indication met the said definition. It usually required a lot of successive communications to collect the necessary information between

parties and a great deal of time to examine it. In an effort to maintain a balance between the time period for negotiating the EPA and the time needed for examination of the claimed geographical indications, Japan usually requested the other parties to limit the number of claimed geographical indications in the preparatory phase, also taking account of the fact that possible generic names were included in the claimed list. But even such a limited list imposed a considerable burden on them to complete the process.

29. If the TN/C/W/52 proposal were to be implemented, this considerable burden for collecting and examining such information would be imposed on third parties, including from the private sector. Although the TN/C/W/52 proponents had explained that the final decision for protection would not be determined by the GI Register, such a shift of the considerable burden to third parties from the private sector would nevertheless be problematic. Furthermore, the proposal of prima facie evidence was not reasonable in view of the chilling effect caused by the aforementioned considerable burden and considering the balance of cost and benefit between the party seeking to benefit from the exclusive right of a geographical indication and the relevant stakeholders, including the private sector.

30. He said that with respect to trademark protection his delegation had already provided a detailed explanation at the previous session, and he would therefore not repeat that here.

31. The delegation of Canada said that delegations' preliminary or complete responses to the Chair's sub-question 1 had been very helpful and informative, particularly for key export markets in that particular sector. He encouraged delegations who had not yet had a chance to provide responses to do so. His delegation had given a preliminary response to sub-question 1 at the last meeting which was recorded beginning at paragraph 25 of the minutes and he confirmed that there was no need to make any notable changes to that intervention.

32. The representative of the European Union said that, as he had recently taken over responsibility for intellectual property and procurement in DG Trade of the Commission, one of the advantages of being new to the negotiations on the establishment of a multilateral system for notification and registration of geographical indications for wines and spirits was being in a position to take a fresh look at the issues and the discussions that had taken place so far. His intervention would address three parts. First, he would like to place the negotiations in the overall negotiating context. Second, he would look at what he saw as emerging areas of convergence and, third, he would try to link some of the answers to the Chairs questions back to the proposal on the table, in particular as his delegation had responded to these questions in detail in June.

33. First, with respect to the overall negotiating process, the Director-General, in his report to the TNC on 19 October stated in view of the G-20 meeting in Seoul that they were looking "to Leaders to send a clear political signal that [we] are ready to enter into the end-game of the Doha negotiations". Mr Lamy further said that the aim of the Geneva cocktail approach was "to reach a level of ambition and balance that [we] can all subscribe to. This of course requires that all areas are included". The representative of the European Union believed all delegations could subscribe to that. If they wanted the so-called Geneva cocktail to be good, all ingredients had to be present. There was no way that an important area and an important ingredient for the cocktail, such as TRIPS, could be missing. The cocktail would simply not taste the same and would be unacceptable for most of them.

34. With regard to how other negotiating areas had been progressing, his delegation believed that the TRIPS Special Session would not be ready, should the signal come to enter the end-game scenario. It was therefore important to continue to make concrete progress towards reaching a common understanding, which required an effort from all Members. This had been the European Union's approach from the outset and still remained so. His delegation had come a long way from its original request to the positions that were now reflected in TN/C/W/52, tabled in 2008 by two-thirds of the Members. He recalled that an important feature of that document was an attempt to include

elements of interest to a wide group of Members, including developed and developing countries. The fact that the document attracted the support of 108 Members, both developing and developed, was clear evidence that this proposal was the most serious attempt to find a possible landing zone in these negotiations. As was well known, this required progress on all three TRIPS issues. He said he would also like to note that the countries supporting TN/C/W/52 had all moved from their initial positions to find common ground. If there were to be any progress at all, the time had come for others to show movement as well.

35. As regards the GI Register, he said that there were three papers on the table: TN/IP/W/8 from Hong Kong, China, TN/IP/W/10/Rev.2, sponsored by less than 20 Members, and TN/C/W/52, supported by 108 countries. The TN/C/W/52 proposal for draft modalities had been presented in July 2008 in great detail since it had been tabled both orally during TRIPS Council Special Sessions and in writing. A large number of detailed questions by Members had been answered, for example, in a communication dated 23 February 2009, providing a written version of the elements of the EC delegation's oral interventions at the TRIPS Special Session of 4 and 5 December 2008. Further explanations had been provided in subsequent meetings. In sum, a great deal of information had been exchanged and his delegation believed it had built a better understanding for all Members on the technical aspects of the TN/C/W/52 proposal.

36. His delegation fully supported the Chair's approach to pursue technical work. It had therefore complemented the information previously provided by detailed answers to the sub-questions on legal effects and consequences of the Register at the last meeting. His delegation found it difficult to imagine that there were still many questions remaining open as to what TN/C/W/52 contained. However, it stood ready to respond again to any questions. He recalled that some Members had also promised to provide further information in future meetings.

37. He would like to highlight the following elements in responses which he believed represented interesting points of convergence between Members. First, in practice if not also in law, trademark offices, when taking decisions regarding the protection of geographical indications and trademarks, did consult various sources of information and did take such information into account when forming their decisions. It was his understanding that, for example, in Korea existing databases and Internet articles of international literature would be fully taken into account. In Japan, the Lisbon Agreement database and relevant information related to GI Registers in foreign countries were consulted. In the United States, the US Patent and Trademark Office used relevant information found in the publicly available trademark database, online sources, other databases, newspapers, magazine articles, Internet websites, dictionaries, gazettes and similar sources were used.

38. Second, it was also part of the domestic legal orders to respect international treaties to which Members were parties. As stated by the delegation of Chile at the last meeting, even when there was no obligation to consult specific sources of information, all binding standards including international treaties signed by Chile which contained provisions on geographical indications were taken into consideration in the registration process.

39. Third, he believed Members could all agree that some specific weight was attached to such information. It was also reasonable that a certain common understanding, mutually agreed at the WTO level, would provide some guarantees to ensure a level international playing field and that was what international negotiations were all about.

40. Fourth, in light of the information provided by those Members who took the floor at the last meeting, it had not been contested that the burden of proving genericness during examination or challenge of a protected term was on the one claiming that the term was generic. Hence, his delegation was of the view that if the Special Session aimed to identify a common understanding about how information on the Register would be taken into account, this was the way Members



needed to structure the discussions. This was entirely consistent with the Chairman's approach and the questions which the Chair had circulated as to how proposals would be absorbed by the Members' systems.

41. To follow up on the objective of making progress, his delegation suggested looking at how Members would implement the proposals on the table, focusing for the time being on TN/IP/W/10/Rev.2 and TN/C/W/52. Members should be able to provide explanations not only regarding implementation of their own proposals, but also of other proposals on the table and he said his delegation would take this approach at this meeting. As it was important to identify divergences and possible convergences it was fundamental that the exercise went beyond mere explanations but was really aimed at reaching a common understanding of the implications of the Register. He would therefore, without prejudice to the actual implementation in the future, present the European Union's view on how proposals tabled by other Members as well as its own proposal would be implemented within the European Union. Both aspects were important and his delegation had endeavoured to do their homework in order to facilitate the work of others.

42. Starting with the joint proposal of TN/IP/W/10/Rev.2 and how it would be implemented in the European Union, he recalled that the joint proposal was rather succinct and had not been modified in substance since it was tabled in 2002. Subsequent revisions had been made to add co-sponsors but no substantive modifications had taken place. Under the joint proposal each participating Member committed to ensure that its procedures included provisions to consult the database in accordance with domestic law. As regarded non-participating Members, paragraph 6 provided that consultation was encouraged but not compulsory. Co-sponsors of the joint proposal had confirmed orally that participating Members would take the Register information into account and in accordance with their domestic laws. He said, it would be useful if the joint proposal could be updated to provide further details on how its proponents would take the Register into account and perhaps also what weight they would attach to the information.

43. He said that, as already explained at the previous meeting, geographical indications protected wines and spirits at EU level. GI applications for wines and spirits were scrutinized by Commission services. They underwent an objection procedure and were registered if the conditions were met. If the European Union were to participate in the database envisaged by the joint proposal, the European Union would certainly have to change the regulation governing the registration of geographical indications. In accordance with the new provisions, when receiving a GI application from a group of producers from, using a previous example, "Ruritania", the Commission would consult the database. If Ruritania was not a participant in the Register then no information would be found. That meant that for a number of groups of producers the Register would be of no help because the public authorities, for whatever reason, had not used the opportunity to participate in the Register.

44. If, on the other hand, Ruritania did participate in the Register, the Commission services would find information about the notifying Member, the name of the geographical indication, the territory in which the wine or spirit originated and whether the name was a wine or spirit. How would they take that information into account? All the information in the Register would correspond to the basic elements which already had to be submitted with a GI application in the European Union. His delegation came to the conclusion that in the European Union the joint proposal Register would, in practice, amount to a duplication of the information already provided by the applicants and therefore would not add any value for the European Union. In that context, his delegation failed to see how the joint proposal Register would meet the mandate of facilitating GI protection.

45. As also explained at the previous meeting, the European Union had established a Community trademark system in which trademarks could be registered directly at EU level as a single title covering the whole EU territory. Such trademark applications were examined by an EU office based in Spain. If the European Union were to participate in the joint proposal Register, there would be a

need to amend the EU trademark regulation, or at least the trademark examiners guidelines to provide for the consultation of the Register. When receiving an application for a trademark or a collective or a certification mark, the trademark office would consult the Register and find information that it would treat according to its respective legislation. That was why the European Union, together with the other co-sponsors of TN/C/W/52, encouraged the adoption of common guidelines as to how the Register information would be taken into account. TN/C/W/52 provided orientations on that matter.

46. Turning to the issue of how TN/C/W/52 would be implemented in the European Union, he recalled that his delegation had already explained the TN/C/W/52 proposal in detail, both orally and in writing. It was, however, ready to develop additional elements in order to bring the technical discussions forward. As already underlined, the merit of TN/C/W/52 was to clearly spell out what the consequences of the Register would be, namely that (i) a name on the Register would be considered *prima facie* evidence that, in that Member, the notified GI met the definition of "GI" laid down in TRIPS Article 22.1, and (ii) domestic authorities would consider assertions on the genericness exception laid down in TRIPS Article 24 only if these were substantiated.

47. As regards the registration of geographical indications in the European Union, the consultation and taking into account of the Register would be provided for in the EU GI Regulations. As a consequence, when examining a GI application, the Commission services would consult the Register. As the TN/C/W/52 Register applied to all WTO Members, all would have the opportunity to notify their geographical indications for wines and spirits to the Register.

48. When examining a GI application, the Commission services would consider that, *prima facie*, a geographical indication on the Register met the GI definition. They might, *ex officio* or at the request of a party, request additional information if doubt arose. Likewise, as was already the case in EU legislation, they might, *ex officio* or at the request of a party, consider that a third country GI applied for was identical with a generic term in the European Union and would substantiate its findings. On the basis of all those elements, considering also other requirements of the GI legislation, for instance in relation with prior trademarks, the Commission services would then decide whether or not to protect the geographical indication.

49. Finally, as regards the impact on trademarks, again, after the appropriate legislation or trademark examiners guidelines had been modified, the trademark office would consult the Register. The Register would provide the examiners with clear indications as to the nature of the name to be examined, and that would be treated according to EU or Member State domestic law, as appropriate.

50. He recalled that the European Union had wanted to engage in an analysis of the implications of each proposal's implementation – not only the proposal it was co-sponsoring, but also of the proposals supported by other Members. He was confident that the proponents of proposals other than TN/C/W/52 would also duly participate in that important work.

51. The representative of Argentina recalled that her delegation did not support the parallelism proposed in document TN/C/W/52. As a co-sponsor, her delegation reiterated its support for the joint proposal which complied with the mandate of Article 23.4 of the TRIPS Agreement and paragraph 18 of the Doha Declaration. The joint proposal had had a high level of acceptance by the Members of the WTO. It proposed the establishment of a multilateral system of certification and registration of geographical indications of wines and spirits that would facilitate the protection of geographical indications of wines and spirits. It preserved the territorial nature of intellectual property rights of geographical indications. In line with Article 23.4 of the TRIPS Agreement the participation in the Register was strictly voluntary. This also implied that the joint proposal took into consideration special and differential treatment given that each Member State could decide whether or not to participate.

52. She said that the delegation of the European Union had still not explained how special and differential treatment would be available under their proposal in document TN/C/W/52. Furthermore, the mandatory participation proposed in that proposal was not acceptable to her delegation. Under the procedures for full participating Members in paragraph 5 of the joint proposal, each Member would guarantee that their procedures provide for consultation of the database when making decisions relative to the protection of trademarks or geographical indications of wines and spirits in line with its domestic legislation. Regarding the proposal in TN/C/W/52, the legal effect of *prima facie* evidence, the extra-territorial nature of the proposal and the inherent reversal of the burden of proof were not acceptable to her delegation.

53. The representative of Switzerland said that her delegation believed the Chair's approach was a very good way of improving Members' understanding of the proposals on the table and of current national practices. Her delegation's response to the two sub-questions at the last meeting was recorded in paragraphs 39 and 43 of the minutes so that there was no need to repeat them. She would, however, like to emphasize the fact that the responses recorded there did not only apply to GIs for wines and spirits but were applicable to all products in Switzerland.

54. In clarifying a couple of additional points, she said that currently the different Swiss authorities that decided on the protection of geographical indications or trademarks were obliged to consult instruments that were sources of law, and to implement information and obligations in those sources of law. These included national laws, ordinances and regulations that were developed on the basis of those national laws as well as international treaties. All of those various sources of law contained substantive information regarding geographical indications and trademarks that were examined. The obligation to consult did not just refer to those instruments but also specified the legal consequences flowing from the consideration of the information in those instruments to determine whether or not a term deserved protection. The national authorities consulted other sources of information such as dictionaries, the Internet, atlases, and databases if necessary in an individual case to form a reasoned decision. In the proposed procedures there were also opportunities for certain bodies to make comments or provide information which the authorities would take into consideration in accordance with the rules of procedure applicable in each case.

55. This also meant that if there was a new source of information, that source would not be covered by any domestic legal obligation to consult and consider that information. According to information received at this stage this was the situation not only in Switzerland but also in many other countries. For those reasons, it was not sufficient for the proposal W/10 to create an obligation to consult information contained in the Register but Members needed to add complementary information. The proposal TN/C/W/52 did remedy this. It created the obligation to consult and consider the information on the Register without challenging the principal of territoriality, as the final decision on whether or not to protect a GI was left to national authorities. With regard to sanctions, she referred Members to her delegation's responses at the last meeting on the various ways of appealing decisions in Switzerland.

56. In concluding, she recalled that the TN/C/W/52 proposal also covered the other two TRIPS subjects, GI extension and disclosure of the country providing/source of genetic resources which were, as another delegation had pointed out, essential ingredients for a successful cocktail. She said that given the broad support it enjoyed, the flexibilities it contained and the concessions it represented, compared to the original positions on the Register, TN/C/W/52 was an important proposal which should be taken into account in the course of this negotiation.

57. The representative of Brazil reaffirmed her delegation's support for the Chairman's proposal on how to conduct the work of the Special Session and said that her delegation expected soon to be able to engage in substantive discussions. She recalled her delegation's position in favour of simultaneous, parallel and joint treatment of the three TRIPS issues, namely GI Register,

GI Extension and TRIPS/CBD. Her delegation was therefore strongly committed to document TN/C/W/52 as an inclusive and balanced position which represented a sincere attempt by 108 Members to deliver on the mandate of the Doha Development Round. Her delegation supported the procedure and substantive parameters contained in the modalities proposal. The proposal reflected a positive movement from some Members to review their previous positions so that they could bring an end to the deadlock that had continued for so many years.

58. The representative of the United States said his delegation appreciated that the establishment of the multilateral system of notification and registration was part of the single undertaking, and it was fully committed to fulfilling their mandate. His delegation was prepared to continue engaging with other Members, and to think creatively about how to best achieve that objective. The position of his delegation in the negotiation and its view of the ingredients in the "Geneva cocktail" were well known. It still believed that their ingredients would make the most satisfactory cocktail for all Members to consume.

59. The United States was one of the numerous co-sponsors of the joint proposal of TN/IP/W/10/Rev.2, and reaffirmed its continued support for the text as the optimal means by which the Special Session could fulfil the mandate for the negotiation. His delegation considered that the joint proposal represented the appropriate basis for continued work of the Special Session, and the best prospects for a rapid and expeditious conclusion of its work.

60. It remained the firm position of the United States that the registration system should convey no legal presumptions, but should instead be limited, as the mandate made clear, to the facilitation of protection for wine and spirit geographical indications through a transparent system of information-sharing.

61. He expressed his appreciation for the new EU delegate's efforts to focus on the positive aspects of convergence and sincerely looked forward to working with him and his delegation, as well as other delegations, in continuing their work. While he did not agree with some of the elements the EU delegate had described, such as the weight assigned to geographical indications placed on the Register due to a unilateral determination by one Member on facts that existed in their jurisdiction, he did agree that a focus on practical implementation of the TN/IP/W/10/Rev.2 and TN/C/W/52 proposals in the context of their respective jurisdictions would be helpful in making progress. In that connection, as had been mentioned before, the joint proposal was the least common denominator for the negotiation and therefore should form the basis of the Special Session's efforts to move forward.

62. At the last meeting of the Special Session, the United States had joined several other Members in providing responses to the sub-questions asked by the Chairman. Its answers were reproduced in the minutes in TN/IP/M/26 so he would not go into them again. At this meeting he had expressed the hope to hear the answers of other Members to the Chairman's sub-questions. He had also noted the constructive suggestion from the delegation of the European Union that Members correlate their answers to the two proposals. His delegation would like to comply with that helpful suggestion. However, in order to explain how the United States would implement TN/C/W/52, it still needed to understand the requirements of the proposal in practical terms. He was confident that, once the various TN/C/W/52 proponents had explained how they would answer the Chairman's questions with respect to their own implementation of the proposal, his delegation would be better able to answer those questions itself.

63. Meanwhile, as suggested by his delegation in June, to understand the proposals on the table, it would be helpful to answer several additional questions:

- (a) When considering whether a geographical indication qualifies for protection as a trademark or under another system of protection, what sources of information do the relevant national authorities take into account?
- (b) Is there any record of the information that was considered or taken into account in making a decision?
- (c) If so, is the information in the examination files available to the public?
- (d) When is it possible for a third party to provide information that was not taken into account and have the decision changed?
- (e) Can this information be the basis for having a decision?
- (f) Do Members have measures in place to ensure that responsible officials or examiners take into account relevant information? What are those measures?

64. In its previous answers his delegation had explained the sources of information that were used by relevant national authorities and that would be its answer to question (a).

65. As for its question (b), his delegation's answer was in the affirmative. A complete record of the decision that was made would be maintained.

66. As to question (c), the answer was that the examiner's electronic record of research sources would be found along with the records of the search for conflicting marks, official actions and the like in the electronic file. The electronic file records would be available to the public via the US Patent and Trademark Office's (USPTO) website (<http://www.uspto.gov/>) and the Trademark Documentation Retrieval ("TDR") application (<http://tportal.uspto.gov/external/portal/tow>.) His delegation would be interested in the extent to which other Members did the same or were prepared to do so in connection to the answer he had just given to whether the information in the examination files was available to the public.

67. As to question (d), he said a third party might provide information at any time, but a letter of protest filed before publication would only be granted where it was determined that the evidence was relevant and might support any reasonable ground for refusal appropriate in *ex parte* examination. After publication, for the letter of protest to be accepted, i.e. for the individual to obtain a right to reappraisal of the issue, the protestor must submit evidence supporting a refusal of registration, such that publication of the mark without consideration of the issue and evidence presented in the letter of protest was a clear error by the USPTO.

68. As to question (e), the answer would be in the affirmative. The information provided in a protest could be the basis for having a decision. For example, if the Deputy Commissioner granted a letter of protest filed prior to the mark's publication, the examiner would consider the information or evidence supplied with the letter of protest but would not be required to refuse registration based on that letter of protest - see TMEP §1715.02(b); in the case of a letter of protest filed and granted after publication of the mark, an examiner must issue the refusal or requirement except in unusual circumstances - see TMEP §1715.03(d). Thus, there was no doubt that there were opportunities for reconsideration of relevant facts at the initiative of a third party. His delegation would again be interested in understanding whether facts ignored could be a basis for decisions in other jurisdictions.

69. As to question (f) to supplement the Chair's two sub-questions, he said that in addition to the letter of protest procedure there were two procedures by which third parties might affect the initial registration or continued registration of a mark in the United States. These *inter partes* proceedings fell under the jurisdiction of the USPTO's administrative court, the Trademark Trial and Appeal Board, and are known as opposition and cancellation proceedings.

70. He concluded by saying that, in light of the above clarifications, the US procedures provide a robust set of procedures that permitted outcomes to be challenged, including the possibility for appeal as well as administrative proceedings, including opposition. Like Australia, the structures he had described at this meeting and at the June meeting provided a strong measure of accountability, recourse and public record. They were also consequences – as any judge or examining attorney would explain, no one wanted to be overturned. He hoped that the explanation of the US system had been helpful, and trusted that at the meeting and in future discussions they would gain a similar understanding of other Members' systems.

71. The representative of China said he would like to encourage the Chairman to further clarify the relevance of the sub-questions with the direction of the Special Session's discussion and provide guidance for future negotiations based on the answers already furnished by many Members.

72. As a co-sponsor of TN/C/W/52, China requested that the three TRIPS-related issues, namely TRIPS/CBD, GI Extension and the GI Register should be pushed forward in parallel. In this context he would like to encourage DG consultations on GI Extension and TRIPS/CBD to continue at least with the same frequency as the Special Sessions. Furthermore, the GI Register should cover all products to avoid further discrimination against geographical indications for products other than wines and spirits. His delegation's position on special and differential treatment remained unchanged.

#### *Second sub-question<sup>2</sup>*

73. The representative of New Zealand said that he would come to the second question by a round-about route, i.e. by responding to the EU statement made earlier and which he thought covered both Chairman's sub-questions.

74. In relation to the first part of the EU statement he said that it was unhelpful in the process of advancing negotiations to enter into discussions of broader, rhetorical and political issues. It was precisely to avoid that kind of discussion that the Special Session had been making efforts to focus on areas in which it could examine national systems, which in the end would enable more useful dialogue. He thought that was being achieved. He considered the last meeting in June to be good thanks to the Chairman's sub-questions. This process should continue. If issues were brought in that were not within the mandate as the European Union had done, then New Zealand would want to talk about for example agricultural market access subsidies, which clearly would not help the process.

75. The second part of the EU representative's statement was more positive and was a good faith effort to identify some emerging areas of convergence. Whilst he would agree with the first two areas identified, and like the representative of the United States, he was not yet convinced that there was commonality of views regarding the weight to be attached to the information on the Register. As the minutes of the June meeting (TN/IP/M/26) had quite clearly shown, the weight of evidence had to be

---

<sup>2</sup> "In national proceedings regarding the protection of geographical indications and trademarks, what level of substantiation is currently required to raise the issue of genericness of a term and who bears the burden of proving genericness or non-genericness

a. during an application process for protection of a term?

b. if a protected term is challenged?"

assessed on a case-by-case basis in New Zealand's system. His delegation would be cautious about predetermining the weight of evidence and hence bias such evidence, particularly if it came from a unilateral decision of another jurisdiction.

76. The fourth possible area of convergence related to genericness. He thought the representative of the European Union had stated that it was not contested that the burden of proving genericness was on the person claiming that the term was generic. This was true to an extent. As the minutes of the June meeting would show, his delegation had explained how the system in New Zealand would operate when a third party objected to an application or sought to have a trademark overturned on the grounds of genericness. In that situation, that third party bore the burden of proof. However, his delegation had also said, as reflected in paragraph 81 on TN/IP/M/26, that "basically" an applicant had to satisfy the examiner that there were no grounds, e.g. genericness, that would prevent registration of a trademark. In New Zealand's system, the applicant would have to prove, through evidence, that a term was non-generic. This also seemed to be the case in Switzerland: as indicated in paragraph 108 of TN/IP/M/26, the Swiss representative had said that the proof of genericness or non-genericness of a geographical indication had to be provided by the GI applicant. He actually took comfort from that statement, which was suggestive of a good balance in Switzerland at least between geographical indications and generics. Having said that, it was not clear to him that the current burden of proof was actually reflected in the proposal that Switzerland supported as its representative had said in paragraph 109 of the minutes that the obligation to substantiate the genericness of a term should be included in the future Register. He asked the delegation of Switzerland to further clarify its position.

77. Finally, he said that the suggestion made by the delegation of the European Union that Members examine how the two proposals on the table might be implemented was potentially constructive and doubtless resulting from the fact-based discussion arising from the Chairman's sub-questions. In that context, he acknowledged that Members had previously engaged in a reasonable process of questions and answers relating to the proposals supported by the European Union, Switzerland and some others. However, he did not consider that such a dialogue based on questions and answers was truly a replacement for a properly elaborated legal proposal. Should his delegation have to examine how that proposal might be implemented, then it would be helpful to have an elaborated version of the TN/C/W/52 proposal, or at least to hear from a wide variety of Members who supported that proposal on how they would implement it. Whilst there had been a few more delegations explaining how they would implement the so-called "majority proposal", he would wish to hear more from other co-sponsors.

78. The representative of Chile recalled that, at the June meeting his delegation had addressed the first question and would therefore simply refer to its statements made then, and focus on sub-question 2.

79. The Chilean Industrial Property Law 19.039 provided that generic terms could not be registered as trademarks or as geographical indications. With regard to trademarks, Article 20.e) of the Law stipulated that expressions or signs used to indicate the type ("género") of products or services, and those generally used in trade to describe certain goods or classes of goods, or certain services or types of services could not be registered as trademarks. As regards geographical indications, Article 95 of the same Law established that signs or expressions that were common or generic indications, i.e. considered as such by those familiar with such matters or by the public in general could not be recognized as geographical indications. The procedure of registering trademarks and geographical indications was administered by the Industrial Property Institute, and the issue of genericness of a term was determined by the Institute. The genericness of a term could also be challenged in opposition proceedings by any interested party. In that case, whoever presented an opposition must substantiate the cause of action or provide other background information concerning

the generic nature of the term, to enable the Industrial Property Institute to carry out a more thorough analysis.

80. With regard to the burden of proof of genericness under sub-question 2, he said that when it related to trademark applications, which were of the competence of the Industrial Property Institute, the issue of registrability of a term was to be determined by the Institute. The applicants must, in principle, comply with the requirements to ensure that the term was eligible for registration. One of the requirements was that the term for which protection was sought was not a generic term. The situation differed when the trademark or the geographical indication had already been registered, i.e. was protected. In that case, the burden of proof that the term registered was generic would be on the alleging party. Appeals could be made to the Institute against the registration or another action could be initiated.

81. The representative of Thailand stated that with regard to sub-question 2, Thailand defined a generic name as a name commonly known as referring to a particular kind of goods that was defined in the inventory of the Act on Protection of Geographical Indications of 2003. During the application process for GI protection, applicants would bear the burden of proving genericness or non-genericness. If a protected term was challenged, the person who challenged that term would bear the burden of proving genericness or non-genericness.

82. The representative of Japan recalling that his delegation had made a brief comment regarding the Chairman's sub-question 2 at the previous session, wished to complement the information given. In order to take the negotiation forward, Japan's comment to sub-question 2 should be provided with the proposals to the Special Session in mind. In particular, TN/C/W/52 modality proposal should be borne in mind because it included a relevant part: it proposed that "domestic authorities shall consider assertions on the genericness exception laid down in TRIPS Article 24.6 only if these are substantiated." That sentence demonstrated that the burden of proof of a person who sought protection of a geographical indication was a relevant issue. For that reason, he wished to explain the Japanese system from the perspective of a person seeking protection of a geographical indication as well as a person seeking to prevent that protection.

83. Geographical indications for wines and spirits were protected under "Standard for Indication in Relation to Geographical Indications," which was based on the Law Concerning Liquor Business Association and Measures for Securing Revenue from Liquor Tax. Under that system, a person who sought protection of a geographical indication was not first required to show that it was not identical with the term customary in common language as the common name for goods or service at issue in Japan. That did not signify that the legal system in Japan hindered a person who sought to prevent protection to provide information that the geographical indication sought for protection was likely to be identical with the term customary in common language as the common name for goods or service at issue in Japan.

84. Japanese Trademark Law did not first require a person who sought rejection, invalidation or cancellation of a trademark with a GI for the purpose of protection of the geographical indication to show that the GI sought for protection was not generic. At the stage of trademark examination, a third party might provide information about genericness of the trademark as such applied for registration. After registration, a third party might initiate an opposition or invalidation trial and might refer the issue of genericness of registered trademarks to a board of appeal.

85. The representative of Chinese Taipei said that, as a co-sponsor of the joint proposal it had been pursuing a multilateral system that was within the mandate of the Doha Declaration and the TRIPS Agreement. As stated in previous sessions, her delegation firmly believed that the joint proposal was the most appropriate solution within the mandate because of its voluntary participation and a lesser degree of burden placed on the participating Members.



86. In response to sub-question 2.a, she said that the examiner who rejected a trademark application was required to provide reasons and sufficient evidence, which meant that the examiner should bear the burden of proof. In terms of the level of substantiation currently required, the examiner must support his decision with clear and convincing evidence. In response to sub-question 2.b, a challenger of a registered trademark should bear the burden of proving his or her claims. A written document containing the grounds for the challenge and supporting evidence must be forwarded to the right holder of the trademark for consideration in defence and counter-evidence. Again, the grounds and evidence put forward in support of the challenge must be capable of proving the claims clearly and sufficiently.

87. The representative of Australia said that her delegation shared the views of the European Union that it was unfortunate that the Special Session was not yet in a position to enter an end-game scenario. For her delegation, the Special Session's ability to engage in the crucial technical work necessary to reach that end-game point had been unfortunately hamstrung by some Members' insistence on linking the issue of the register to other unrelated issues which were not mandated aspects of the Doha Development Agenda.

88. Moreover, progress in the Special Session was limited by the absence of negotiating texts on the table. It had long expressed frustration with the unwillingness of some Members to submit formal proposals to the Special Session which were both consistent with the mandate and at a comparable level to the joint proposal. Such a submission would provide clarity on the status of the various ideas and documents circulated and would allow a genuine technical dialogue on a text, enabling this negotiating group to fulfil their mandate most effectively.

89. Her delegation considered that active engagement in technical discussions by all Members would be the most useful way to identify areas of convergence that were fundamental to advance their work in this Session. It welcomed the efforts by the European Union in that context but did not necessarily share their views on the content of possible areas of convergence. She wondered whether a more fulsome technical discussion would allow them to find those areas of convergence in the future.

90. With that in mind, she would provide an elaboration on the response to the Chairman's second sub-question. On the question of substantiation of genericness, in Australia, rather than characterizing the genericness of a term as something that required substantiation, the fact that the term was a common name for a good or a service was viewed as a ground for that term's inability to be capable of distinguishing the good or service, i.e. its inability to be registered as a trademark. In Australia, genericness was generally determined by the court, for example with respect to a registered trademark which was being challenged by another party who had considered it as having lost its significance as a trademark or that it had become generally accepted within the relevant trade as a generic. There was no explicit provision in the trademark legislation relating to the particular level of substantiation required to raise the issue of genericness. During an application for a process for a protection of a term, if a trademark examiner found that grounds for rejection existed because the indication was common or generic, the applicant could attempt to overcome the ground for rejection by providing information sufficient to persuade the examiner that the sign was not generic, i.e. similarly to the process in New Zealand and, as she had understood, in Switzerland, the burden would be on the applicant. In a practical sense, once the ground had been identified, the burden was on the applicant to show that the sign was not generic. In circumstances where a trademark had been accepted, third parties might challenge the acceptance of the trademark. In Australia the burden was with the opponent to persuade the officer that the mark was common or generic.

91. In circumstances where a protected term was challenged under the trademark system in Australia, a challenge to a geographical indication registered under the trademark system must be taken to court and the burden of proof in that circumstance was for the challenging party to prove that

a term was generic, as initially there would be a presumption of validity in favour of the registered trademark. Only a court could make a definitive finding of genericism for trademarks and that would normally be as the result of what was known as a cancellation action. An agreed person or the registrar of trademarks might make an application to a prescribed court to amend or cancel a registered trademark if it became generally accepted within the relevant trade as a sign or term that described, or was the name of, an article, substance or service.

92. In concluding, she said that her delegation was looking forward to hearing from all its trading partners similar levels of detail on their practices with respect to the Chairman's sub-questions and with respect to the proposals that they supported.

93. The representative of the European Union said that the representative of New Zealand, who did not wish to respond on the first part of his initial statement, had actually well responded. The point he was trying to make, which was slightly mischaracterized, was not to draw other issues into that context but merely to usefully remind delegations that they were not negotiating in a vacuum, but in a broader context.

94. On sub-question 2, he would refrain from repeating what his delegation had said in June, but would simply refer Members to paragraphs 88–93 of the minutes of the June meeting with a few additional comments.

95. On the supplementary questions raised by the delegation of the United States, he said that his delegation had responded to most of them in June and would refer the delegation of the United States to sub-paragraphs 9–15 of the minutes of that meeting. His delegation would check again with colleagues and see if they had additional elements to share for the next meeting.

96. In response to Australia's statement, he said he understood that the initial burden was on the trademark examiner. It was only when the trademark examiner had made a determination that the burden shifted to whoever was contesting the determination. He would appreciate clarification from Australia. If his initial understanding was correct, then he believed that there was convergence as stated in his previous statement.

97. The representative of Canada expressed his delegation's support for the comments made by the delegations of New Zealand, the United States, Australia and others concerning the utility of having a substantive technical proposal from the TN/C/W/52 co-sponsors. His delegation had demonstrated in past TRIPS Council meetings how the joint proposal would be implemented domestically in Canada. His delegation had taken up the call to see if it could seek to do the same with the TN/C/W/52 proposal but it simply could not do so because its being a modality proposal and as such was technically incomplete. A proposal should include all relevant elements and not leave them for future discussions, for example, the notification elements. He reiterated the need for a substantive technical proposal from the TN/C/W/52 co-sponsors in conjunction with further technical information that could emerge from the types of questions that the Chairman had put before the Special Session.

98. Referring to paragraph 88 of the minutes of TN/IP/N/26, where the European Union had indicated that, under its proposal on genericness, a party making a claim must do so through a clear and sufficient demonstration of their case so that the other party could reply, he asked regarding sub-question 2 whether or not there were criteria or guidelines regarding what constituted a clear and sufficient demonstration.

99. Referring to paragraph 90 of the same minutes, where it was reflected that under the EU submission third parties might file "duly substantiated" objections, he asked the delegation of the European Union what would constitute a duly substantiated objection.

100. The representative of the United States said that with respect to the second sub-question that the Chairman had elaborated, he would refer other delegations to his delegation's intervention at the June meeting of the Special Session, reflected in paragraph 110 of the minutes of that meeting.

101. In response to the comment made by the representative of the European Union that his delegation had mostly answered the questions put by the United States, asked whether the EU delegation could provide the information in response to each sub-question in a more specified form. This would be helpful for other delegations, particularly regarding the issue of availability of a record and the availability of that record to the public and in what format that would be made available. He also thought that answers to the questions posed by the representative of New Zealand would be helpful in that regard.

102. The representative of Peru said that, under Peruvian law, generic terms were not eligible for registration, either as GIs or as trademarks. At the time of assessing the application for registration the examiner would take into consideration all the various sources of information. Determinations could be challenged on administrative and judiciary levels. Moreover, if the application was opposed, the opponent had to substantiate the genericness claims. As regards oppositions, decisions thereon could also be challenged on administrative and judiciary levels.

103. The representative of Switzerland said she would not repeat the responses that she had given in June on the second question, but would instead refer to paragraphs 108-109 of the minutes in TN/IP/M/26.

104. With regard to comments made by previous speakers, she recalled that under the TN/C/W/52 proposal the proponents had submitted a text with draft modalities and principles because in the course of detailed discussions based on previous proposals they had realized that they were unable to make progress because they could not agree on issues of principle. Should the Special Session come back to discussing details, she failed to see how they could make progress before agreeing to certain general principles for the multilateral system. That was why it would be necessary to continue working on the issues of principle in TN/C/W/52 in order to get more clarity for the Special Session.

105. Turning to the comments made by the representative of New Zealand regarding her intervention at the June meeting, she said that at national level, in carrying out an examination of geographical indications, the competent authorities duly took genericness into consideration before registering the indications. She expressed her satisfaction that the New Zealand delegation had recognized that the Swiss authorities carried out such examination, and that there was a balancing between geographical indications and generics at national level. This was also a recognition that the information that would be provided subsequently as well as the geographical indications that would be sent to the multilateral Register would be based on work carried out at national level, taking account of various elements, notably genericness.

106. With regard to the manner in which consideration would be given to the work done at national level and what Switzerland was seeking to obtain through the negotiation on the establishment of a multilateral Register, she said that it was necessary to make a distinction between the objectives of the two registers. On a national level, when a geographical indication was examined and then registered, the register created protection of the geographical indication at national level. Once granted, the registration was very strong. She noted that, in many jurisdictions, including the Swiss one, the trademark applicant would not be required to prove that the trademark was not descriptive or generic. It was for the examiner to determine during the examination process whether or not the term was generic or descriptive and then the right holder could object to the assessment made by the examiner. In that regard the trademark examiner clearly played an important role.

107. The TN/C/W/52 proposal sought to create a source of information that all of the WTO Members had to take into account whenever they examined a GI or trademark application. As pointed out, registering a geographical indication in the multilateral Register would not create protection in all WTO Members. However, it would create a source of information that each and every Member would have to take into account whenever its authorities considered a trademark application. Thereafter, they would decide at national level whether or not that information would be fully implemented to reject the trademark because it contained a GI application, or based on the evaluation of the situation at national level they would decide not to take that information into account because the term was generic.

108. Switzerland's concerns and the reasons for its support of the TN/C/W/52 proposal and its various elements was to provide a mandatory source of information for all WTO Members to facilitate protection of geographical indications in third countries and to provide information that only the country of origin was in a position to provide on geographical indications that it had already acknowledged at a national level within its territory.

109. The aim pursued and the mandate received were to facilitate protection of geographical indications in third countries. In this regard, she said that in many cases geographical indications were the property of local communities who did not often have the resources to monitor third markets and all the WTO Members as far as trademark registrations were concerned. Hence, a mechanism had to be found, obliging trademark examiners to give careful attention to geographical indications when examining trademarks to prevent trademark registrations of geographical indications for products that were not linked to those GIs. Once a trademark had been registered in good faith, it would prevent, at least in many domestic systems, the GI product of the country of origin from being marketed in a third country on grounds of prior trademarks. In that regard, this was one of the important elements of TN/C/W/5, which definitely needed to be considered in creating a multilateral system that facilitated the protection of geographical indications.

110. The Chairman recalled that the second sub-question did differentiate two elements: on the one hand, the level of substantiation required to raise the issue of genericness, and on the other, the burden of proof, i.e. who would bear the burden of proof.

111. The representative of the European Union first referred to his delegation's initial invitation to all Members, and to the Joint Proposal Group in particular, to describe how they would implement the TN/C/W/52 proposal. The representative of Switzerland had said that TN/C/W/52 was never aimed at being a legal text, but a draft modalities text. He did not think that that in itself should prevent delegations from describing how, for example, the concept of "prime facie" would work in their system. He said that even if the European Union did not like the joint proposal it had made the effort to examine how it could be implemented. He would ask the Joint Proposal Group to do the same with TN/C/W/52 even if it was not a full legal draft. He hoped in that spirit they could approach the question as well and endeavour to make a good faith effort to describe how it would be implemented.

112. As regards the questions raised by New Zealand and Canada, he said that his delegation had the beginning of a response, but would need some verification. He would come back to it at the next meeting.

113. On the US questions, he asked the delegation of the United States to clarify the context of their questions (d) and (e) as that of an administrative procedure or that of a legal challenge subsequent to the administrative procedure. Further clarifications would help his delegation look at a possible answer.

114. The representative of the United States responded to the preceding intervention by saying that with respect to sub-questions (d) and (e), his delegation would be interested in both aspects to the extent that they were relevant.

115. With regard to the second sub-question on the genericness, the representative of Turkey said that under the relevant Turkish legislation, genericness was specified as one of the reasons for absolute refusal. When an application was made, the examiner had to carry out the necessary research and, if there was a claim of non-genericness, the burden of proof was on the applicant. Genericness was defined under Turkish law as the name that had become the common or generic name for the product, even where it related to a region or an area associated with the production or marketing origin thereof. Use by the public in the area of origin and use by consumers in general had to be taken into consideration in order to determine whether or not a name was generic. After registration was completed, any dispute had to be resolved in a judicial procedure.

116. Her delegation was in agreement with the delegation of Switzerland that the TN/C/W/52 proposal contained some key elements that must be first agreed. The Special Session should continue discussing these key issues.

117. Furthermore, like China and Switzerland, her delegation believed that a register of geographical indications for all products would be an ideal solution in the context of a comprehensive approach. The three issues under discussion in relation to the TRIPS Agreement should be taken up in parallel for a successful conclusion of the negotiations.

118. The Chairman expressed his thanks to all delegations that had contributed to the discussion, in particular those delegations that had made new contributions. He would not attempt to make a summary of what he had found to be a rich, instructive and structured discussion. As he had indicated at the outset of the meeting, he intended his sub-questions to be a starting point, and help the group to structure and focus the work on certain elements to see where the differences laid and where there could be commonalities.

## B. OTHER BUSINESS

119. Regarding the Special Session's work in the coming weeks, he recalled the TNC Chairman's remarks at the 19 October meeting that "small group activities will continue until mid-November, at which point I think we will need to evaluate again and take stock of where the process has got to as well as next steps, benefiting also from the discussions at the G-20 and APEC Leaders' meeting". Keeping in mind that background, as well as what might be envisaged by the whole Membership, he said he would consult delegations, as appropriate, on how to proceed with their work to ensure staying in step with the overall process.

120. Regarding future meetings for 2011, he recalled that, at the regular session of the TRIPS Council of 26-27 October, the dates for meetings in 2011 had been set for 1-2 March, 7-8 June and 25-26 October 2011. He suggested that, as in the past, a formal meeting of the Special Session be held back to back with the regular session meetings at these dates, i.e. on 3 March, 9 June and 27 October.

121. With regard to the work of the small brainstorming group on TRIPS, he briefly recalled that, at the informal TNC meeting of 19 October, the TNC Chairman had reported on the work and consultations guided by the so-called "cocktail approach" – a combination of variable geometry, small groups, bilateral contacts, Negotiating Groups and the Director-General's own consultations. It had been agreed that all of those processes had to feed into the Negotiating Groups and the TNC, preserving the centrality and primacy of the multilateral process and its transparency and inclusiveness. In the so-called "small group" process at ambassadorial level, brainstorming sessions

had taken place in various sectors, including TRIPS. For more details on the TNC's Chairman's remarks on that process and on the various groups, he referred to document JOB/TNC/5. He recalled that the TNC Chairman had also urged delegations to continue to reach out to ensure inclusiveness and participation. He trusted that the active participants in the small brainstorming group would communicate any significant developments in their small group discussions to the wider Membership when appropriate, in order for such developments to feed into the multilateral process.

122. He then invited delegations that had participated in the small brainstorming group to make any reports on any developments therefrom.

123. The representatives of Chile and Switzerland thanked the Chairman for his remarks on the small group meetings and for the opportunity to provide information. They said that, following the discussions on TRIPS issues in the small group, their delegations had sent a request addressed to the Director-General seeking a factual paper to better understand the use of certain expressions in the WTO dispute settlement procedures. The emphasis was placed on three expressions: *prime facie evidence*, *burden of proof* and *due diligence*.

124. The representative of Ecuador asked whether or not the factual paper would be provided to all WTO Members for purposes of transparency and inclusiveness. Such a paper could be of interest to all Members.

125. The representative of Bolivia supported Ecuador's observations. His delegation was not against that type of work being done but was struck by the procedure. Whilst acknowledging that the small informal groups had been set up to facilitate negotiations, he wondered whether they had the authority to ask the Secretariat to provide documents, in particular on issues of interest to them only. He wanted clarity on the right of those groups to make that kind of request and whether all of the parties interested in the negotiations might be entitled to make similar requests in the interests of inclusiveness and transparency.

126. The representative of Switzerland said that her delegation had taken note of the statement made by the representative of Ecuador and would ensure that transparency was respected on that issue.

127. The representative of the United States said that he assumed that the paper requested would not be an official TRIPS document. As regards calls for transparency, he also assumed that the paper would be made available to all Members.

128. The Chairman thanked the delegations of Chile and Switzerland for the information which provided the Special Session with some transparency and fed into the multilateral process as agreed at the last TNC meeting. His understanding was that the request had come from the Members who were participating in the small group. It was a request made specifically by Chile and Switzerland to facilitate the discussion in the small group. The reporting had been done by the delegations of Chile and Switzerland in order to bring awareness as to what was being done in that small group. What he anticipated was that, once the document had been prepared at the request of two delegations, the document would go to the Members that had requested it and this negotiating group would rely on those Members to make the paper available to ensure transparency.

129. The Special Session took note of the statements made.

---