

(As delivered)

IN THE WORLD TRADE ORGANIZATION

Before the Appellate Body

**Australia – Certain Measures Concerning Trademarks, Geographical
Indications and other Plain Packaging Requirements Applicable to Tobacco
Products and Packaging**

(WT/DS435/441)

Oral Statement

by

Norway as a Third Participant

**Hearing of the Appellate Body
Geneva**

11 June 2019

Presiding Member, Members of the Division,

1. Norway welcomes this opportunity to make a brief statement, and we will offer some remarks on what we consider to be the proper interpretation of the term “unjustifiably” as it appears in Article 20 of the TRIPS Agreement.
2. Neither the ordinary meaning, context, object and purpose nor the negotiating history support the claim by Honduras that the term “unjustifiably” refers to measures “that are not more trademark encumbering than necessary”, which require an analysis of potentially less trademark-restrictive alternatives”.¹
3. The ordinary meaning of “unjustifiably” is not synonymous with “unnecessary”, and should not be interpreted that way in Article 20. Hence, the Panel was correct in its finding that the test for “unjustifiably” will differ from a test whether a measure is “unnecessary”.
4. Article 20 must be read in light of the objectives and principles of the TRIPS Agreement as expressed in Articles 7 and 8.1 respectively. Whereas Article 7 establishes that the “protection and enforcement of intellectual property rights should contribute [...] to a balance of rights and obligations, Article 8.1 sets out the fundamental principles to be taken into account when interpreting the TRIPS Agreement. According to this provision, “Members may [...] adopt measures necessary to promote public health [...] provided that such measures are consistent with the provisions of the Agreement”. Moreover, the WTO membership has also acknowledged this inherent freedom to pursue legitimate public policy objectives² in the Doha Declaration on Public Health, in which it is not only underscored that the TRIPS Agreement “does not or should not prevent Members from taking measures to protect public health”,³ but also stated that “each provision of the TRIPS Agreement shall be read in the light of the object and purpose of the Agreement as expressed, in particular, in its objectives and principles”.⁴
5. Norway also finds support for this view in the context of other provisions of the TRIPS Agreement. Within the Agreement, the word “necessary” is used in several Articles. In the

¹ Honduras’ Appellant Submission paras 231-259.

² Panel Report, *EC – Trademarks and Geographical Indications (US)*, para. 7.210, and Panel Report, *EC – Trademarks and Geographical Indications (Australia)*, para. 7.246.

³ Doha Declaration on the TRIPS Agreement and Public Health (adopted on 14 November 2001 at the Fourth WTO Ministerial Conference), recital 4.

⁴ Doha Declaration on the TRIPS Agreement and Public Health (adopted on 14 November 2001 at the Fourth WTO Ministerial Conference), recital 5.

context of the GATT 1994 Article XX, the Appellate Body has explained that the use of different terms must be given interpretative effect. While it was included in other places of the TRIPS Agreement, the drafters chose not to use the term “necessary” in Article 20. This choice reinforces our view that Honduras cannot be heard with their arguments that the term “unjustifiably” should be interpreted as to encompass notions of “necessity”, “least restrictiveness” and “reasonable available alternatives”.

6. Before concluding, we will briefly comment on the contextual significance the Panel gave to the TRIPS Agreement Article 17 when interpreting Article 20 and the assessment of whether the use of a trademark in the course of trade is being "unjustifiably" encumbered by special requirements. The Panel considered the context of Article 17 to confirm that this assessment involves consideration of, i.a., the nature and extent of the encumbrance resulting from the special requirements, taking due account of the legitimate interest of the trademark owner in using its trademark in the course of trade.⁵ From Norway’s perspective, we agree with Australia that the Panel gave Article 17 more contextual weight than it is due. In this regard, we note the separate purposes of these two provisions: Article 17 provides exceptions to the rights conferred by a trademark in Article 16. In contrast, a special requirement that a Member imposes upon the use of trademarks under Article 20 does not detract from a right that the Member is otherwise required to confer upon trademark owners.
7. Finally, we would like to point out that, contrary to what Honduras appears to allege, the Panel in this dispute did *not* consider Article 20 to constitute an exception. As opposed to Article 17, Article 20 is not formulated as an exception to rights conferred under the Agreement. As pointed out by Australia, the Panel correctly found that “Article 20 clearly sets out a single obligation to refrain from imposing special requirements that ‘*unjustifiably* encumber’ the use of trademarks in the course of trade – *not* a ‘prohibition’ on encumbrances that is subject to a subsequent ‘exception’ or ‘qualification’”.⁶
8. Thank you.

⁵ Panel Report, para. 7.2428.

⁶ Australia’s Appellee Submission, para. 199 (emphasis original).