

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

THE PROTECTION OF COUNTRY NAMES AGAINST REGISTRATION AND USE AS TRADEMARKS

Document prepared by the Secretariat

I. INTRODUCTION

1. From its twenty-second session (November 23 to 26, 2009) to its thirty-fourth session (November 16 to 18, 2015), the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) considered a number of working documents concerning the Protection of Country Names Against Registration and Use as Trademarks (see documents SCT/22/4, SCT/23/4, SCT/24/2, SCT/24/6, SCT/25/4, SCT/27/5, SCT/29/5, SCT/30/4, SCT/31/4, SCT/31/5, SCT/32/2 and SCT/34/2 Prov.2).

2. At its thirty-fourth session (November 16 to 18, 2015), the SCT adopted the Revised Reference Document on the Protection of Country Names Against Registration and Use as Trademarks (SCT/34/2 Prov.2) as a reference document and agreed that the Secretariat would publish the document in the WIPO/STrad/INF Series.

II. PRELIMINARY CONSIDERATION

3. Document WIPO/STrad/INF/7 attempts to articulate in a single reference document the wealth of information provided in the above-mentioned sources. In this document, the expressions “country names” and “names of States” are used interchangeably, as it has been the practice in the relevant SCT document series. Moreover and unless otherwise indicated, the word “trademark” is intended to cover marks that apply to both goods and to services.

4. It is important to note that, when adopting the Questionnaire, the SCT understood that the expression “names of States” was intended to cover the short name of the State or the name that is in common use, which may or may not be the official name, the formal name used in an official diplomatic context, translation and transliteration of the name as well as use of the name in abbreviated form and as an adjective. The SCT also understood that the Questionnaire would not address the issue of non-commercial use of names of States, as such uses appeared to be outside the ambit of trademark law (paragraph 4 of document SCT/23/4).

III. EXCLUSION OF REGISTRATION OF NAMES OF STATES AS TRADEMARKS

5. Generally speaking, the registration of a trademark is based on a formal application filed directly or indirectly with a national or regional trademark registration authority. Like any other sign applied for registration as a trademark, a sign consisting of or containing the name of a State will be examined by the competent authority in light of formal and substantive requirements. The scope of examination by offices and, in particular, the nature of the possible grounds for refusing the application, which are examined by the office or that may be raised in opposition procedures, can vary depending on the applicable law.

(a) Generally Excluded from Registration

6. This approach creates an absolute bar for registration as trademarks of signs which consist of or contain country names, unless the applicant provides proof of consent by the competent authorities. The relevant provisions usually contemplate protection for country names, regardless of whether the sign applied for is descriptive or misleading. Some returns to the Questionnaire indicated that even where an authorization is given, the trademark would have to be assessed under the other grounds for refusal provided for in national law, such as, for example, lack of distinctive character of the mark or non-conformity of the mark with public policy and morality.

7. In some cases, where a country name constitutes a ground for refusal, it is construed as the name of the national State or the name of any State¹, depending on whether or not it is intended to apply that ground of refusal to the name of the State where the trademark is applied for or to the names of all States. Generally, national laws do not contain specific references to an official list of country names, and few of them include additional precisions as to whether protection is given to official names only, or also to common names or abbreviated versions of State names.

8. The Trademark Law of Serbia prohibits the registration of the “name or abbreviation of the name of a country”². The Trademark Law of Albania provides that “a sign is not registered as a trademark if it consists of the name of a State”³. In addition, the implementing regulation specifies that this absolute ground for refusal was established because of the lack of distinctive character of country names, and that when other distinctive elements accompany that name, the trademark could be registered, provided that the applicant includes a disclaimer concerning the name of the State.

9. Under the Trademark Law of Cambodia, marks which are identical or similar with, or contain as an element “a name or abbreviation or initials of the name of (...) any State” cannot be registered⁴. This provision is included in the enumeration that corresponds to signs protected under Article 6*ter* of the Paris Convention for the Protection of Industrial Property (hereinafter referred to as “the Paris Convention”) and could therefore be considered as a national extension of that provision. Similarly, the Trademark Act of Bangladesh includes country names as an absolute ground of refusal equivalent to that contemplated in the Law of Cambodia⁵. The Trademark Law of Iran (Islamic Republic of) stipulates that a mark cannot be

registered if “it is identical with, or is an imitation of, or contains as an element, (...) a name or abbreviation or initials of the name of (...) any State”⁶ and the legislation of Oman contains an identical ground⁷ for refusal.

10. Under the Trademark Law of the Republic of Moldova and the Regulation on conditions for granting a permission to use the official or historical denominations of the State in marks on products and/or services, as well as on industrial designs, a Government appointed Committee⁸, needs to consider and authorize the registration and use as a mark (without exclusive right) of the official or historical name of the State (Republic of Moldova), its short name (Moldova) and translations thereof, used separately or in combination with other verbal or figurative elements. However, the State Agency on Intellectual Property (AGEPI) may authorize physical or legal persons having their domicile or commercial establishment in the Republic of Moldova to use abbreviations or derivatives of the official or historical name of the State, as well the presentation of the official or historical name of the State in a form different than as mentioned.

11. The Delegations of Antigua and Barbuda, Argentina, Belarus, Chile, China, Costa Rica, Ecuador, Georgia and Ukraine⁹, quoted in their submissions the legal text containing a ground for refusal which extends the notion of State emblem to country names, and in some cases, short names or abbreviations of those names. Yet, in other member submissions, reference was made to national practice, according to which the provisions of Article 6^{ter} of the Paris Convention have been understood to cover country names¹⁰. One Member State submission indicated that a specific ground for refusal was contemplated in national law to exclude from registration the name of the national State only¹¹. The text remains silent in relation to the names and other denominations of foreign countries.

12. In its submission prior to the twenty-first session of the SCT, the Delegation of the Russian Federation mentioned that “[r]egardless of the absence in Article 6^{ter} of the Paris Convention of a reference to the names of States, the majority of the world’s countries have appropriate standards in their national trademark legislation, which allow the issue of protection of these names to be resolved. Thus, in accordance with paragraph 1 of Article 1483 of the Civil Code of the Russian Federation..., State registration as trademarks of designations which do not possess distinguishing capacity or which consist solely of elements which characterize goods, including those indicating their place of production or sale, is not permitted”¹².

(b) Excluded from Registration if Considered Lacking Distinctive Character

13. The basic function of a trademark is to distinguish the products or services of one undertaking from those of other undertakings. Hence, the lack of distinctiveness of a trademark prevents it from performing that basic function and the application for registration of a sign which is not distinctive, will regularly be refused. An overwhelming majority of returns to the Questionnaire (94.1 per cent) indicated that names of States were excluded from registration as a trademark if they lacked any distinctive character.

(c) Excluded from Registration if Considered Descriptive

14. In order to be protected, a trademark must be distinctive and among the criteria that make a trademark distinctive is the absence of any descriptive feature. This ground for refusal is invoked by offices in examination, by way of determining whether the signs applied for are indications used to designate the characteristics of the goods or services, or *inter alia*, their place of origin. This is the most commonly used ground for refusal against which the registrability of country names as trademarks is examined, since the interest of the public is that such indications remain available for use by any trader in order to provide information relating to the goods or services sold or offered.

15. For that purpose, various jurisdictions simply prohibit the registration and use of marks that consist of geographical names¹³, while others adopt the terminology of Article 6*quinquies* B.2 of the Paris Convention and exclude from registration as trademarks those signs or indications which may serve in trade to designate the geographical origin of goods or services¹⁴. Although this terminology does not expressly refer to country names, it is interpreted by a number of trademark offices as excluding names of States from registration, at least when the sign applied for is constituted exclusively of the name of the State.

16. According to the quantitative summary of replies to the Questionnaire (Question I(1)(b), Annex II of document SCT/24/6), 95.9 per cent of the responding countries indicated that under the applicable legislation, names of States were excluded from registration as a trademark for goods if they could be considered descriptive of the origin of the goods in respect of which registration was sought.

17. According to the Guidelines for Examination in the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), descriptive terms can consist of geographical terms, which are described as “every existing name of a place, for example a country, city, lake or river. This list is not exhaustive. Adjectival forms are not sufficiently different from the original geographical term to cause the relevant public to think of something other than that geographical term”¹⁵. In assessing the registrability of a geographical term as a mark, the assessment is whether the term describes objective characteristics of the goods or services.

18. In individual Member State submissions communicated to WIPO, the following practices were described. When examining applications containing a geographical place name, some trademark offices will consider that the sign applied for “consists exclusively” of such a name if it is accompanied by non-distinctive elements. On the contrary, if the sign is combined with elements which are found distinctive, the trademark would be accepted for registration¹⁶.

19. This understanding derives from the common ground according to which a sign would not be registrable if it consists of a descriptive indication. In this instance, the name of a country would be recognized by consumers as merely evocative of the place of origin of the goods or services and would therefore lack distinctiveness¹⁷. Since geographical terms may generally serve in trade to designate the origin of the goods or services, it is considered that such indications, including country names, should remain available for traders, either as part of a trademark or as a description of the products or services.

20. The Trademark Act of the United States of America provides that “a mark which, when used on or in connection with the goods of the applicant is primarily geographically descriptive of them¹⁸” could be refused registration. Although no specific protection is provided in the law for country names, it should be noted that marks composed of or consisting of geographical signs, including names of States, could be refused if the mark is considered geographically descriptive.

21. In its submission, the Delegation of Germany referred to the Court of Justice of the European Union decision in joint cases C-108/97 and C-109/97, according to which names designating a geographical origin – for example names of countries – as a rule must be kept available for use by other traders¹⁹. The Delegation noted that any registrations of country names in the trademark register of Germany usually date from a time prior to that judgment.

22. The Delegation of Germany also noted that a geographical name may be registered as a trademark only if there is special evidence that, exceptionally, it is not capable of serving in trade as a reference to the geographical origin of the goods and services concerned. In this context, it is not only the current need to leave the sign free for use by others that should be considered but, based on a realistic prediction, it should also be considered whether it is reasonable to assume that such a need may be expected in the future²⁰.

23. In some cases however, registration is only granted if the applicant files a disclaimer with the Office. Therefore, the trademark would be accepted as a whole but the name of the State would not be granted protection. In its submission, the Delegation of Jamaica indicated that where the trademark includes as an element the country name, the national Office requires the applicant to include a disclaimer concerning the latter. According to the submission by the Delegation of Belize, the same practice applies in that jurisdiction²¹. In essence, the country name is kept available for other traders, while it can potentially be included in several marks.

24. Another exception to the refusal of the registration of geographically descriptive terms can be found where the Office accepts special evidence that the geographical name in question does not serve in trade to indicate the geographical origin of the goods or services²². Similarly, the Examination Guide adopted by the Spanish Patent and Trademark Office (OEPM) specifies that the registration of a geographic designation is not prohibited *per se*, but only to the extent that it constitutes exclusively an indication of origin of the goods or services²³. Besides, the OEPM Examination Guide clarifies that the exclusion concerning official emblems of Spain does not extend to the denomination "Spain" or the names of other States, which could be protected against appropriation under the general exclusion concerning geographic indications.

25. In its submission, the Delegation of Italy declared that national law does not contain a specific provision concerning the exclusion of country names from registration as trademarks. In such cases, the general principles of trademark law apply. In particular, the law provides that "the rights in a registered trademark shall not entitle the proprietor to prohibit another person from using in the course of trade references to the geographical origin of the goods or services..."²⁴. However, in carrying out trademark examination of applications containing a country name, the Italian Patent and Trademark Office gives particular attention to the distinctive character of the sign applied for.

26. According to the submission by the Delegation of Norway²⁵, it is in principle, possible to register a descriptive mark consisting of a country name based on acquired distinctiveness. This may apply if the sign in question has become well-known as the applicant's indication of commercial origin in the relevant market. However, in reality this would be hard to prove for the applicant in respect of trademarks which exclusively consist of a country name, as the relevant public will often perceive the mark as the name of a country, not exclusively as the applicant's indication of commercial origin.

(d) Excluded from Registration if Considered Misleading

27. In addition to being descriptive, trademarks consisting of or containing country names may also be likely to mislead the public as to the origin of the goods or services. A false representation through a mark that goods or services originate from a particular place may expose that mark to refusal, if in fact the goods or services have no connection with the country name. The boundaries among the terms misleading, deceptive or false are not clearly defined, and there is a degree of overlap in the subject matter that can be characterized as the one or the other.

28. According to the quantitative summary of replies to the Questionnaire (Question I(1)(c), in Annex II of document SCT/24/6), 98.5 per cent of the responding countries indicated that country names were excluded from registration as trademarks if the use of the name of a State could be considered to be misleading as to the origin of the goods and 77.3 per cent said that names of States would be excluded if they could be considered incorrect as to the origin of the products for which registration is sought (Question I(1)(e), in Annex II of document SCT/24/6).

29. The law in certain jurisdictions provides for a universal bar to registrability of geographically misleading signs. For example, European Council Directive 2008/95 provides that trademarks shall not be registered if they are of "such a nature as to deceive the public, for

instance as to the nature, quality or geographical origin of the goods or service”²⁶. This provision is designed to protect the public, i.e., the consumers of the goods or services offered under the trademark for which registration is sought.

30. Under the Trademark Law of the United States of America, a mark may not be registered if it is “primarily geographically deceptively misdescriptive of the goods or services named in the application”²⁷. To support a refusal to register a mark on this ground, it must be shown that: (1) the primary significance of the mark is a generally known geographical location; (2) the goods or services do not originate in the place identified in the mark; (3) purchasers would be likely to believe that the goods or services originate in the geographical place identified in the mark. However, if the mark is remote or obscure, the public is unlikely to make a goods/place or services/place association; and (4) the misrepresentation is a material factor in a significant portion of the relevant consumer’s decision to buy the goods or use the services.

31. Under the national laws of several States, geographical terms, or names, as well as abbreviations thereof, cannot be registered as trademarks where such indications are likely to mislead the consumers or create confusion concerning the origin of the goods or services²⁸. The terminology used in national law to describe misleading character or likelihood of confusion is not always uniform²⁹. In addition, the submissions of two Member States, namely Poland and Ukraine referred to an international standard used by their national Offices to determine the official names of States³⁰.

32. In its submission, the Delegation of Australia noted that grounds for rejection of a trademark are only established where it is clear that the trademark as a whole is not capable of distinguishing, or that because of a connotation in the mark, use of the trademark would be likely to deceive or cause confusion. The trademark must be considered not only as a whole, but also taking into account the impact of the various elements of the trademark, including their relative size and prominence within the mark³¹.

33. In its submission, the Delegation of the United Kingdom noted that geographical place names, and figurative trademarks indicating geographical origin, as well as variations of these, where the geographical place has a reputation for the goods or services applied for, should be objected³². The reason for such an objection would be that the use of a geographical place name in circumstances where it has a reputation creates an “expectation” in the mind of the consumer which could lead to deception if that expectation is not fulfilled.

34. In some jurisdictions, the exclusion of geographical indicators from registration as trademarks, where those indicators include country names, receive a particular consideration when the application concerns goods such as wines and spirits. In those cases, the trademark registration of signs which include country names is prohibited if the goods (wines and spirits) do not originate in the relevant geographic location³³.

(e) Excluded from Registration if Considered Incorrect

35. Signs that are descriptive or indicative of geographical origin are false or incorrect for products that do not come from the region described or indicated. The returns to the Questionnaire showed that names of States are excluded from registration as a trademark if they can be considered incorrect as to the origin of the products and/or services for which registration is sought in more than three quarters of the cases (77.3 per cent in the case of products and 76.6 per cent in the case of services).

(f) Excluded from Registration for Other Reasons

36. The returns to the Questionnaire showed that in certain jurisdictions (37.3 per cent in the case of goods and 31.8 per cent in the case of services) names of States are excluded from registration as a trademark for reasons other than those mentioned above. The name of a State can be excluded from registration *inter alia* because: it is substantially identical or similar to an earlier trademark; there is a likelihood of confusion with existing signs; it is a common name used in the course of trade; there is an indication of bad faith; the name of the State is a generic term; the name of the State has become customary in the current language or in the honest and established practices of trade; or an earlier trademark, consisting also of the name of a State, acquires distinctive character through use.

37. Additional details were provided in the Member State submissions concerning another ground for refusal, namely when a mark consisting of or containing a country name is considered to be contrary to public order or morality. It is a universally accepted principle that signs which are contrary to public order or morality are excluded from registration as trademarks. The appreciation of whether a particular sign is contrary to public order or morality is regularly subject to cultural and historical representations about the meaning of particular signs. Although it might not be *prima facie* evident how this ground could operate in relation to country names, there seem to be relevant examples in national law and practice. For instance, the Trademark Law of the Republic of Korea refers to “trademarks that falsely indicate a connection with, or that criticize, insult or are liable to defame, any nation...”³⁴.

38. Some trademark laws stipulate that registration could be denied for trademarks that would disparage national symbols or bring them into contempt, or disrepute, although no specific mention is made of country names³⁵. In the United States of America, application for the mark “NOT MADE IN CHINA” was refused by the United States Patent and Trademark Office (USPTO) on the ground that the mark consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols of China, in accordance with Section 2(a) of the Trademark Act³⁶. In Italy, a sign which includes a country name may not be registered as a trademark if it is detrimental to the image of the country concerned³⁷.

39. In its submission, the Delegation of Colombia indicated that the name “Colombia” and national symbols of the country could be included in a trademark only in the following cases. If the mark is not deceptive, misleading with regard to the origin of the goods or services, not likely to create confusion or association with a protected appellation of origin, does not take unfair advantage of the notoriety of the country or is not contrary to the duty of respect and honor stipulated in national law³⁸.

IV. PROCEDURAL ISSUES RELATING TO APPLICATIONS CONSISTING OF OR CONTAINING NAMES OF STATES

40. The Questionnaire collected information as to how names of States were dealt with under national trademark law during the trademark registration procedure, namely whether they were excluded from registration *ex officio* by the office or whether the exclusion could be raised by third parties.

(a) Names of States Are Excluded from Registration *Ex Officio*

41. The exclusion of the name of a State from trademark registration constitutes a ground that is raised *ex officio* during examination by offices of almost all the Member States which have replied to the Questionnaire (more than 97 per cent). Furthermore, an important number of

those national Offices consider that ground independently from other grounds (around 90 per cent). One return indicated that such exclusion did not apply in cases where the signs concerned were sufficiently distinctive.

42. A few returns indicated that this ground is always raised together with other grounds. This was the case for three returns concerning goods and four returns with respect to services. The relevant answers relating to this item did not specify however which particular grounds were concerned.

(b) Registration of Names of States as Trademarks is Granted if Authorization is Provided

43. In almost half of the returns received (47.8 per cent in the case of goods and 46.4 per cent in the case of services), names of States were registrable as trademarks or elements of trademarks for goods and/or services, provided an express authorization by the competent authority was produced. This was the case in Costa Rica³⁹, Ecuador⁴⁰, Georgia⁴¹, Lithuania⁴², Slovenia⁴³ and Ukraine⁴⁴. Some returns indicated that even if the authorization was produced, the registration of the mark was still subject to the assessment of distinctive character of the sign, or to the filing of a disclaimer of protection of the country name.

44. In its submission, the Delegation of Norway indicated that an unsuccessful applicant would not be able to overcome a refusal based on descriptiveness by submitting a letter of consent from the relevant national authority, because the issue was whether or not the relevant public perceived the country name as an indication of commercial origin or simply as the name of a country. In that jurisdiction, the country name was not as such a proprietary right that the country in question controlled⁴⁵.

(c) Names of States Constitute a Ground That Can Be Raised by Third Parties in Opposition

45. Even in Member States that provide for one of the grounds described above for protecting country names from registration as a trademark or part of a trademark, there may be situations in which the examination by the national Office of an applied-for sign consisting of or containing a country name does not result in a refusal of registration. Notably, this may be the outcome in systems in which applications are not examined *ex officio* as to the potential ground for refusing country names. Moreover, there may be instances in which a national Office assumes that an applied-for sign consisting of or containing a country name can be registered.

46. National trademark laws may provide for procedures in addition to the *ex officio* examination that enable third parties to raise the claim that an applied-for sign should not be registered because it consists of or contains a country name. More specifically, opposition, observation, and invalidation procedures may offer additional avenues to prevent or cancel a registration.

47. The availability of opposition procedures is a common feature of trademark registration regimes that is desirable and useful not only for applicants, rights holders and other interested parties but also for trademark administrations and the public at large⁴⁶. Opposition procedures introduce an element of internal checks and balances and enable third parties to provide information and evidence which could prevent the registration of a particular sign as a trademark and which trademark offices otherwise may not have at their disposal⁴⁷. The SCT identified areas of convergence in trademark opposition procedures at its twentieth session, held in Geneva from December 1 to 5, 2008⁴⁸.

48. Opposition procedures can therefore present an additional opportunity for preventing the registration as a trademark of a sign incorporating a country name in cases where the *ex officio* examination of the trademark office alone would not result in a refusal. Providing an additional opportunity to raise a specific point is a characteristic of opposition procedures irrespective of whether a national system provides for pre-registration or post-registration opposition⁴⁹.

49. The returns to the Questionnaire indicated that more than two-thirds of the Member States (67 per cent) allow that possibility. When this is the case, this ground can be raised independently from other grounds. However, the different types of opposition systems applied in the Member States concerned (e.g. pre-grant or post-grant opposition) were not specified in the answers provided.

Grounds for Filing an Opposition

50. If opposition procedures are to offer an additional avenue for protecting country names, two conditions must be met under national trademark law: firstly, such law must contain a ground for refusing the registration as a trademark of signs that consist of or contain a country name⁵⁰ and secondly, claiming inconsistency with that provision must be recognized as a ground for filing an opposition.

51. As far as the latter point is concerned, the replies to the Questionnaire indicate that in the majority of Member States whose trademark laws contain a possible ground for refusing an applied-for sign consisting of or containing a country name this ground can also be claimed in opposition procedures. Notably, 67.2 per cent of the replies received stated that if the name of a State is excluded from registration as a trademark in respect of goods this ground can be raised by third parties in opposition procedures. 67.7 per cent of the replies received stated that if the name of a State is excluded from registration as a trademark in respect of services, this ground can be raised by third parties in opposition procedures⁵¹.

52. This impression is corroborated in the submissions by the Delegations of SCT members received after the twenty-seventh session of the SCT. In their submissions, a number of Delegations expressly confirmed that it would be possible under their national laws to raise the claim in opposition procedures that an applied-for sign consisting of or containing a country name should be refused registration because it is of merely descriptive character. These include the Delegations of Australia, Chile, Finland, Ireland, Japan, Norway, and the United Kingdom⁵².

53. Under the trademark law of Ireland, it may equally be invoked in opposition proceedings that a sign consisting of or containing a country name should be refused registration because it is devoid of any distinctive character. Moreover, the Delegations of Ireland, Finland, Japan, Norway, and the United Kingdom stated that their respective national laws allowed oppositions based on the claim that a sign consisting of or containing a country name should be refused registration because it is misleading, deceptive, or false. Finally, the national laws of Chile and Greece provide for *per se* protection of country names and also allow oppositions based on that ground⁵³.

54. In Argentina, the national trademark law provides for *per se* protection of the official name of a state. In addition, the Office also refuses the registration as a trademark of a sign containing a country's common name if the country concerned files an opposition showing that a registration would damage its interests⁵⁴.

Entitlement to File an Opposition

55. Whether a particular entitlement must be demonstrated in order to file an opposition is a question that is answered differently in national trademark laws. In some systems, any person may file an opposition. There are other systems, however, where opponents must have a legitimate interest in filing or must show that they would be damaged by the registration of the applied-for sign. Sometimes, still, the necessary entitlement depends on the grounds asserted and is determined by the Office⁵⁵.

56. In systems limiting the circle of potential opponents the question arises as to who would be entitled to oppose the registration of a sign consisting of or containing a country name. In general, most concerned would appear to be the government of the country whose name is the subject of an application for registration as a trademark or as part of a trademark. In this case, however, there may be doubts as to which body or authority within the government would have the necessary standing. Under the Trademark Law of Greece, for example, officially represented governments may file oppositions⁵⁶.

57. Apart from governments, other subjects of law may equally have an interest in preventing the registration of a sign as a trademark that consists of or contains a country name. One could, for example, think of nationals of the country or competitors of the applicant. Determining who has the necessary standing to file an opposition will ultimately depend on the applicable national trademark law.

Time Limit for Filing an Opposition

58. It is common practice that an opposition may only be raised within a certain time limit⁵⁷. Typically, national trademark laws provide for time limits of either two or three months and in some countries this period may be extended⁵⁸. The SCT considered that ideally an initial opposition period would be two months and in any case not more than six months⁵⁹.

(d) Names of States Constitute a Ground That Can Be Raised by Third Parties as an Observation

59. A further potential avenue for claiming that an applied-for sign should not be registered because it consists of or contains a country name may be the filing of observations. The laws of some Member States foresee that written observations may be submitted in relation to trademark applications⁶⁰. The person presenting the observation does not become a party to the proceedings and, usually, Offices do not reply to observations⁶¹. Observations are intended to provide an Office with any information that could lead to the refusal of the registration of an applied-for sign. This may be particularly helpful and effective where the issue raised is not known to the examiner, for example in situations in which the descriptiveness of an applied-for sign is known only to a specialized sector of the public⁶².

60. Where national laws allow for the submission of observations, the grounds upon which such observations can be based are usually not limited although some jurisdictions exclude claims based on prior third-party rights⁶³. As the question of whether or not a country name can be registered arises irrespective of any third-party rights, observations appear to be suitable means of protecting a country name from registration as a trademark or as part of a trademark in all national systems providing for a possible ground for refusing such signs and allowing observations.

61. In addition, where observations are allowed, these may usually be submitted by anybody and no particular entitlement needs to be shown. Likewise, there is no specific time limit to respect and observations may be presented at any point prior to the registration of the trademark⁶⁴. Some Member States have explicitly confirmed that the fact an applied-for sign

consists of or contains a country name may be raised by way of observations, notably Ireland, Norway, and Slovakia. In Argentina, the Office will reject an application to register a sign containing a country's common name if that country submits an observation to this effect showing that its interests would be damaged by the registration⁶⁵.

62. More than 50 per cent of the returns to the Questionnaire indicated that observations can be raised against the registration of a trademark consisting of or containing the name of a State, either in parallel to other grounds (5 per cent) or independently.

(e) Names of States Constitute a Ground That Can Be Raised by Third Parties in Invalidation Procedures

63. Where a sign consisting of or containing a country name was registered as a trademark although the relevant national trademark law provides for possible grounds for refusing such registration, invalidation proceedings offer a final avenue to protect the country name in question. Through invalidation proceedings, the claimant seeks to cancel an existing registration from the register. Amongst national trademark systems no uniform terminology exists and proceedings aimed at invalidating a granted registration may also be referred to as cancellation, nullification, or revocation.

64. More important than the respective terminology is the effect with which a trademark may be invalidated. As a general rule, if a trademark is invalidated on grounds that already existed at the time of registration, upon invalidation the sign is treated as if it had never been registered. If a trademark is cancelled on grounds, the conditions of which are only satisfied at a certain point in time after registration, the sign will only be cancelled with effect from the moment as of which the cancellation was requested. As far as country names are concerned, where the registration of a sign is invalidated on the basis that the sign consists of or contains a country name, this is a circumstance which in all likelihood would have already been present when the sign was registered. In such a case, the sign should have never been registered as a trademark, and as a consequence of the invalidation, it will be treated as if it had never been registered.

65. Invalidation proceedings against a trademark consisting of a country name can be initiated after its registration. An average of 92 per cent of the returns to the Questionnaire specified that exclusion of names of States from trademark registration could be raised by third parties in the course of invalidation procedures. Predominantly, this ground is raised independently from other grounds.

Grounds for Requesting Invalidation

66. In order to cancel a registered trademark consisting of or containing a country name, at least two conditions must be regularly present under the relevant national trademark law: firstly, there must be a ground for refusing the registration as a trademark of signs consisting of or containing a country name and secondly, a claim that the sign was registered in contravention of the former provision must be recognized as a valid ground for requesting the invalidation.

67. The replies to the Questionnaire⁶⁶ suggest that in the Member States the national trademark law of which contains a possible ground for refusing an applied-for sign consisting of or containing a country name, non-compliance with this provision would be a valid ground for requesting invalidation. Notably, 93.8 per cent of the replies received stated that if the name of a State is excluded from registration as a trademark in respect of goods, this ground can be raised by third parties in post-registration invalidation procedures. According to 92.6 per cent of the replies received, if the name of a State is excluded from registration as a trademark in respect of services, third parties may raise this ground in post-registration invalidation procedures.

68. This impression is corroborated by the submissions of the Delegations of SCT members received after the twenty-seventh session of the SCT. Several Delegations expressly confirmed that invalidation procedures may be based on the claim that a registered sign consisting of or containing a country name should not have been registered because of its descriptive character. More specifically, this is the case in Finland, Ireland, Japan, Norway, Slovakia and the United Kingdom⁶⁷.

69. In the Czech Republic, Ireland and Slovakia, it may be invoked in invalidation proceedings that a sign consisting of or containing a country name should not have been registered because it is devoid of any distinctive character. However, there is an important qualification to that rule: even if the sign was devoid of any distinctive character at the time of registration, it will not be invalidated if during the period between registration and invalidation request it has acquired distinctiveness through use⁶⁸.

70. Several delegations specifically confirmed that invalidation procedures may be based on the claim that the registered sign consisting of or containing a country name should not have been registered because it is misleading, deceptive or false. These include Belize, the Czech Republic, Finland, Ireland, Japan, Norway, Slovakia and the United Kingdom⁶⁹.

71. In the Czech Republic, invalidation procedures may also be based on the claim that a sign consisting of or containing a country name should have been refused registration because it is contrary to public policy. Finally, it has been confirmed by the delegations of Chile, China, Costa Rica and Greece that invalidation may be requested where a sign has been registered in contravention of the *per se* protection of country names that exists under the respective national trademark laws⁷⁰.

Entitlement to Request Invalidation

72. As is the case with opposition procedures, national trademark laws may require the claimant to demonstrate entitlement to request the invalidation of a mark. In the specific context of country names, the Delegations of Belize, China and Ireland have reported that invalidation may be requested by any person and under the Trademark Law of the Czech Republic, Norway, and Slovakia, invalidation proceedings may be instigated by third parties. Under the Trademark Law of Costa Rica and Greece, the Government of the country concerned may request the invalidation⁷¹.

Time Limit for Requesting Invalidation

73. It should also be noted that national trademark laws may provide for specific time limits for requesting the invalidation of a trademark. Examples of countries providing for such time limits are Chile (five years from registration) and Costa Rica (four years from registration). In Costa Rica no time limit needs to be observed if the sign was registered in bad faith⁷².

V. PROTECTION OF NAMES OF STATES AGAINST USE AS TRADEMARKS

74. In addition to the protection granted to names of States against registration as trademarks, SCT members decided to inquire, through the Questionnaire, the applicable law and the practice of Member States in relation to “use” of such signs in the market place as trademarks or parts thereof, i.e., to distinguish goods and services from one undertaking from those of other undertakings. Although this part of the Questionnaire may not be universally applicable, it was considered relevant for the inquiry.

(a) Generally Excluded from Use Under Trademark Law

75. In reply to the enquiry relating to the source of the exclusion of names of States from use as trademarks, 60.5 per cent of the returns indicated that such exclusion was provided for in statutory trademark law, while 39.5 per cent of the returns did not concern such a statute.

76. The returns to the Questionnaire show that names of States are excluded from use as trademarks in 42 per cent of the cases, while 58 per cent of the returns indicate that such signs are not excluded from use. There are no appreciable differences in the returns for use as trademark for goods and in the returns concerning use for services. In both cases, the number of responding countries was 69.

77. The above totals need to be considered in connection with the returns provided under question number 10, namely if, under the applicable legislation, names of States are generally excluded from use as trademarks, and whether there are any exceptions to such exclusion. Out of 41 returns, 31 per cent indicated that there could be exceptions to the exclusion, and 68.3 per cent indicated that the exclusion was absolute, i.e., that no exceptions were admissible.

78. However, at least two returns, which provided a negative reply, included comments to the effect that although they did not generally exclude names of States from use as trademarks for goods and/or for services, the act of misleading the public as to the source, origin or quality of the products was prohibited under specific laws, or that remedies were available for third parties.

79. One such remedy could consist in bringing a civil law action, which would prevent the use of signs or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which was likely to cause confusion, or to cause mistake, or to deceive as to affiliation, connection, or association of such person with another person, as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities of another person.

(b) Potential Consumer Deception in Use as a Trademark of the Name of a State

80. Generally speaking, use as a mark of the name of a State follows the same principle that applies to registration. A sign consisting of or containing a country name could not be used on products or in relation to services if it is of such a nature as to deceive the public, for instance concerning the nature, quality or geographical origin of the goods or services. If a trader made a false representation that his goods came from a particular country, such misrepresentation could deceive the consumers of his goods and influence their purchasing decisions.

81. Consideration of the potential deception of consumers regarding the origin of the goods and services seemed to be an important issue for respondents to the Questionnaire and it is covered by 69 returns. The breakdown of those returns shows 82.6 per cent positive answers and 17.4 per cent negative answers.

VI. ARTICLE 10 OF THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY

82. The use of a country name may also be prohibited under legal bases other than trademark law. One such basis may be found in tort laws or laws against unfair competition. Article 10*bis* of the Paris Convention binds the countries of the Paris Union to assure effective protection against unfair competition. The replies to the Questionnaire showed that in 51.7 per cent of the countries in which the use of country names as a trademark was excluded

this exclusion was based on the law against unfair competition. In 48.1 per cent of the countries it was based on general tort law or passing off⁷³. In its reply, the Benelux Office for Intellectual Property confirmed that the abuse of a country name may be prevented by tort law⁷⁴.

83. Rules to prevent false indications of products are another area of law through which the use of a country name may be restricted. Article 10 of the Paris Convention provides that it may be a ground for seizure if goods bear false indications of their source. The vast majority of countries that replied to the Questionnaire (82.6 per cent) considered the use of country names as trademarks on goods and/or services as a potential case of application of the provision⁷⁵. In Italy, the question of whether the applied-for signs directly or indirectly use false indications of the source of goods was taken into account when trademark applications were being examined⁷⁶. In Australia, protection against misuse on labeling and presentation of goods is governed by a range of consumer protection provisions including the Competition and Consumer Act 2010⁷⁷.

84. Article 10 of the Paris Convention states as follows:

[False Indications: Seizure, on Importation, etc., of Goods Bearing False Indications as to their Source or the Identity of the Producer]

“(1) The provisions of the preceding Article shall apply in cases of direct or indirect use of a false indication of the source of the goods or the identity of the producer, manufacturer, or merchant.

“(2) Any producer, manufacturer, or merchant, whether a natural person or a legal entity, engaged in the production or manufacture of or trade in such goods and established either in the locality falsely indicated as the source, or in the region where such locality is situated, or in the country falsely indicated, or in the country where the false indication of source is used, shall in any case be deemed an interested party.”

VII. CONCLUSION

85. The present review of trademark law and intellectual property office practices in the area of the protection of country names has attempted to capture all past SCT efforts to deal with the range of issues relating to the protection of these identifiers. It is expected that this overview of practices and underlying legal rules will be helpful in promoting a better understanding of the available tools to protect country names against undue registration or use as trademarks.

86. An important finding of the review indicates that there are several opportunities at various stages before and after the registration of a trademark where the protection of country names may be invoked. If national laws provide for grounds that, irrespective of their technical construction, may prevent signs consisting of or containing a country name from being registered, these grounds are not only relevant when the Office assesses an application *ex officio*. Rather, third parties also appear to avail themselves of at least one of the outlined avenues for claiming, based on the respective ground that a sign consisting of or containing a country name should not be or should not have been registered.

87. In order to raise awareness of the existing possibilities to refuse or invalidate the registration as a trademark of signs consisting of or containing a country name, the protection of country names could be addressed in trademark examination manuals. More specifically, it would appear useful to emphasize country names as a possible application of the general grounds for refusing signs that lack any distinctiveness, are descriptive, are contrary to public policy, or are misleading, deceptive, or false.

88. Regulations and measures to protect country names have been identified not only in relation to the registration of trademarks but more generally in the fields of trade and communications. Use of country names as a prominent part of nation branding identifiers highlights the need to preserve such names from misuse and promote their positive exploitation in country branding strategies to the benefit of the broader national collectivity.

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¹ In Section 3(2) the Trade Marks Act 2003 of Antigua and Barbuda, Article 10(2) of the Trademark Law of China, Article 4(4) of the Law N°2181-XII on Trademarks and Service Marks of February 5, 1993 of Belarus.

² Article 5(13) of the Law on Trademarks of Serbia, dated December 11, 2009.

³ Article 142(1)(g) of the Law N° 9947 on Industrial Property of Albania, dated July 7, 2008.

⁴ Article 4(d) of the Law Concerning Marks, Trade Names and Acts of Unfair Competition of the Kingdom of Cambodia, dated January 8, 2002.

⁵ Article 8(e) of the Trademark Act (Act N° XIX) of Bangladesh, dated March 24, 2009.

⁶ Article 32(d) of the Patents, Industrial Designs and Trademarks Registration Act of Iran (Islamic Republic of), dated October 29, 2007.

⁷ Section 36(2)(iv) of the Industrial Property Rights and their Enforcement for the Sultanate of Oman (Royal Decree No. 67/2008) of May 12, 2008.

⁸ Submission by the Delegation of the Republic of Moldova.

⁹ See the respective submissions at <http://www.wipo.int/sct/en/comments/>.

¹⁰ Submissions by the Delegations of Colombia and Slovenia.

¹¹ Submission by the Delegation of Lithuania.

¹² See paragraphs 4 and 5 of Annex I to document SCT/21/5 containing a Submission by the Russian Federation.

¹³ This is the case in Venezuela (Article 33(5) of the Industrial Property Law of September 2, 1955).

¹⁴ Submission by the Delegation of Jamaica: Article 11((1)(c) of the Trademark Act of July 26, 1999. The same Paris Convention wording is used in the Trademarks Act of Barbados (Section 9(1)(b) of the Trademarks Act, December 21, 1981). See also the submission by the Delegation of Spain (Article 5 of the Trademark Law N°17/2001 of December 7, 2001); by the Delegation of Norway: Trademark Act Section 14; by the Delegation of Germany: Trade Mark Act Section 8(2), n° 1, 2 and 4. Likewise, the legislation of Slovakia adopts the same bar (Act N° 506/2009 Coll. on Trade Marks). For Europe, see Article 7(1)(c) of the Regulation (EC) No 207/2009 of 26 February 2009 on the Community Trademark. In the United Kingdom, the applicable provision is Section 3(1)(c) of the Trademark Act of July 21, 1994. The Law of Bulgaria equally provides for an exclusion concerning signs that indicate the geographic origin of the goods or services: Article 11(4) of the Law on Marks and Geographical Indications of September 1, 1999, amended in 2010. Article 6(1)(3) of the Law of the Republic of Kazakhstan on trademarks, service marks and appellations of origin (July 26, 1999) also considers the place of origin as a descriptive feature excluded from registration.

¹⁵ See Guidelines for Examination in the Office for Harmonization in the Internal Market (Trade Marks and Designs) on Community Trademarks (amended 02/2015), Part B, Section 4: Absolute Grounds for Refusal, paragraph 2.3.2.6 Geographical Terms, page 45.

¹⁶ Submission by the Delegation of the United Kingdom and submission of the Delegation of Benelux. The Benelux Office considers in general that country names could be registered if combined with a distinctive element.

¹⁷ This is the case for instance in the legislation of Morocco: Article 134(b) of the Law N° 17-97 Relating to the Protection of Industrial Property of March 16, 2000.

¹⁸ Section 2 (15 U.S.C. § 1052) of the Trademark Act of the United States of America, dated July 5, 1946.

¹⁹ *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) And Boots- und Segelzubehör Walter Huber (C-108/97), Franz Attenberger (C-109/97)*, Judgement of May 4, 1999. See also submissions by the Delegations of the United Kingdom and the Benelux Office for Intellectual Property (BOIP).

²⁰ *BGH [Bundesgerichtshof – Federal Court of Justice of Germany] - I ZB 10/01, July 17, 2003 - Lichtenstein; I ZB 53/05, March, 13 2008 (Nos. 12, 18, 23) - SPA II; - I ZB 107/08, May 20, 2009 (No. 15) – Vierlinden.*

²¹ Submissions by the Delegations of Belize and Jamaica.

²² Submission by the Delegation of Norway.

²³ *Oficina Española de Patentes y Marcas (OEPM)*, Guide on Examination of Registration Prohibitions (Part I, Absolute Prohibitions), which is available at

http://www.oepm.es/es/signos_distintivos/marcas_nacionales/Guia_examen_prohibiciones_registro/

²⁴ Article 1bis(1)(b) of the Legislative Decree No. 499 of Italy, dated October 8, 1999.

²⁵ Submission by the Delegation of Norway.

²⁶ EC Council Directive 2008/95, Article (3)(1)(g).

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- ²⁷ Trademarks Act of the United States of America, Section 2(e)(3); 15 USC, Section 152(e)(3).
- ²⁸ Submission by the Delegation of Mexico. The same type of registration would be refused in Canada according to Article 9 of the Trademarks Act, R.S.C., 1985, c. T-13, last amended on December 31, 2008. In Brazil, the corresponding provision is Article 124(IX) and (X) of the Industrial Property Law N°9.279 of May 14, 1996, and in Bulgaria, Article 11(7) of the Law on Marks and Geographical Indications of September 1, 1999, amended in 2010.
- ²⁹ See Article 7(1)(g) of the European Regulation (EC) No 207/2009 of February 26, 2009. See also submission by the Delegation of the United Kingdom. In addition, see also Article L711-2(b) and L711-3(c) of Intellectual Property Code of France, July 1, 1992 and Article 135(c) of the Law N° 17-97 Relating to the Protection of Industrial Property of Morocco, March 16, 2000.
- ³⁰ In their submissions, the Delegations of Poland and Ukraine referred to International Standard ISO 3166 and WIPO Standard ST.3.
- ³¹ Submission by the Delegation of Australia.
- ³² Submission by the Delegation of the United Kingdom.
- ³³ Submissions by the Delegations of the Czech Republic and Slovakia. See also Section 7(7) of the Trademark Act of December 11, 1998 of Singapore and Section 1210.08 (a) of the Manual of Trademark Procedures of the United States of America.
- ³⁴ Article 7(1)(ii) of the Trademark Law of the Republic of Korea, dated November 28, 1949, as amended on May 21, 2009.
- ³⁵ Submission by the Delegation of Trinidad and Tobago: Section 13(a)(ii) of the Trademarks Act of 1955. See also submission by the Delegation of United States of America.
- ³⁶ Submission by the Delegation of the United States of America.
- ³⁷ Submission by the Delegation of Italy.
- ³⁸ Submission by the Delegation of Colombia at <http://www.wipo.int/sct/en/comments/>.
- ³⁹ See Article 7 of the Law 7978 of Costa Rica concerning Trademarks and Distinctive Signs.
- ⁴⁰ Article 195 of the Intellectual Property Law of Ecuador.
- ⁴¹ See submission by the Delegation of Georgia at <http://www.wipo.int/sct/en/comments/>.
- ⁴² Article 6, part 1 (8) of the Trademark law of Lithuania.
- ⁴³ Industrial Property Act (ZIL) of Slovenia: Article 43 (1) g, h and 43 (3).
- ⁴⁴ Article 6 of the Law of Ukraine on the Protection of Rights to Marks for Goods and Services.
- ⁴⁵ Trademarks Act of Norway.
- ⁴⁶ See Trademark Opposition Procedures – Areas of Convergence, document WIPO/STrad/INF/4, Area of Convergence No. 1.
- ⁴⁷ See Trademark Opposition Procedures – Key Learnings, document SCT/18/3, p. 2.
- ⁴⁸ See Trademark Opposition Procedures – Areas of Convergence, document WIPO/STrad/INF/4. According to Article 15.5 of the Agreement on Trade-related Aspects of Intellectual Property Rights members of the WTO may afford an opportunity for the registration of a trademark to be opposed.
- ⁴⁹ Whether a national system allows for oppositions before or after the registration for a trademark is a policy choice dictated by strategic factors. For an overview of the advantages and disadvantages of either variant see Trademark Opposition Procedures, document SCT/17/4, p. 14.
- ⁵⁰ For a more detailed overview of the various possibilities of protecting signs consisting of or containing a country name see Section II above.
- ⁵¹ Summary of the Replies to the Questionnaire Concerning the Protection of Names of States Against Registration and Use as Trademark, document SCT/24/6, Annex II, p. 3.
- ⁵² See the respective submissions at <http://www.wipo.int/sct/en/comments/>.
- ⁵³ *Idem*.
- ⁵⁴ Submission by the Delegation of Argentina.
- ⁵⁵ See Summary of Replies to the Questionnaire on Trademark Law and Practice (SCT/11/6), document WIPO/STrad/INF/1 Rev.1, replies to V.4.A (pp. 99-100), Trademark Opposition Procedures, document SCT/17/4, pp. 6-7, and Trademark Opposition Procedures – Key Learnings, document SCT/18/3, p. 3.
- ⁵⁶ Submission by the Delegation of Greece.
- ⁵⁷ See Trademark Opposition Procedures – Key Learnings, document SCT/18/3, pp. 7-8.
- ⁵⁸ See the comparative table in Trademark Opposition Procedures – Key Learnings, document SCT/18/3, Annex.
- ⁵⁹ See Trademark Opposition Procedures Areas of Convergence, document WIPO/STrad/INF/4, Area of Convergence No. 5.
- ⁶⁰ See Trademark Opposition Procedures, document SCT/17/4, p. 13.
- ⁶¹ See Trademark Opposition Procedures – Areas of Convergence, document WIPO/STrad/INF/4, Annex p. 5.
- ⁶² See Trademark Opposition Procedures – Areas of Convergence, document WIPO/STrad/INF/4, Annex p. 5.
- ⁶³ See Trademark Opposition Procedures – Areas of Convergence, document WIPO/STrad/INF/4, Annex p. 5.
- ⁶⁴ See Trademark Opposition Procedures – Key Learnings, document SCT/18/3, pp. 4-5.
- ⁶⁵ See the respective submissions at <http://www.wipo.int/sct/en/comments/>.
- ⁶⁶ See the Summary of Replies to the Questionnaire Concerning the Protection of Names of States Against Registration and Use as Trademarks, document SCT/24/6, Annex II, p. 3.
- ⁶⁷ See the respective submissions at <http://www.wipo.int/sct/en/comments/>.

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⁶⁸ Section 32(2) of Act No. 441/2003 on Trade Marks of the Czech Republic and section 52(1) of the Trade Marks Act 1996 of Ireland.

⁶⁹ See the respective submissions at <http://www.wipo.int/sct/en/comments/>.

⁷⁰ *Idem.*

⁷¹ *Idem.*

⁷² *Idem.*

⁷³ Summary of the Replies to the Questionnaire Concerning the Protection of Names of States Against Registration and Use as Trademarks, document SCT/24/6, Annex II, p. 5.

⁷⁴ Submission by the Benelux Office for Intellectual Property, p. 1.

⁷⁵ Summary of the Replies to the Questionnaire Concerning the Protection of Names of States Against Registration and Use as Trademark, document SCT/24/6, Annex II, pp. 40-41.

⁷⁶ Submission by the Delegation of Italy.

⁷⁷ Submission by the Delegation of Australia, p. 1.