

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS

Twenty-First Session
Geneva, June 22 to 26, 2009

SUBMISSION BY THE RUSSIAN FEDERATION

Document prepared by the Secretariat

1. In a communication dated March 2, 2009, the Secretariat received a submission from the Russian Federation relating to the extension of the effect of Article 6ter of the Paris Convention for the Protection of Industrial Property for consideration by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), at its twenty-first session to be held in Geneva from June 22 to 26, 2009.
2. The said submission is contained in Annex I to the present document.

[Annex I follows]

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ANNEX I

**Submission by the Russian Federation
to the Standing Committee on the Law of Trademarks,
Industrial Designs and Geographical Indications**

1. The proposal of the Delegation of Jamaica, put forward at the twentieth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (hereinafter, “the SCT”), on the extension of Article *6ter* of the Paris Convention for the Protection of Industrial Property (hereinafter, “the Paris Convention”) to the names of States, is not for the first time being put before WIPO. This issue had already been examined while preparing for and during the Diplomatic Conference for the review of the Paris Convention in 1980.
2. The proposal in question is motivated by the possible benefits which may accrue as a result of providing legal protection for the names of States on the basis of Article *6ter* of the Paris Convention.
3. As is well known, a basic provision of the Paris Convention contained in paragraph (1)(a) of Article *6ter*, is that the countries of the Paris Union have come to an agreement to refuse or to invalidate the registration of armorial bearings, flags, and other State emblems and to prohibit by appropriate measures their use, without authorization by the competent authorities, either as trademarks or elements of trademarks.
4. Regardless of the absence in Article *6ter* 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.
5. Thus, in accordance with paragraph 1 of Article 1483 of the Civil Code of the Russian Federation (hereinafter, “the Code”), 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.
6. The possibility of rejection of the designations referred to during registration is based on Article *6quinquies* B(2) of the Paris Convention.
7. In accordance with current Russian legislation, the designation for which registration as a trademark containing the name of a State is claimed, is regarded as an indication as to the place of production or sale of the good. It may be included in the trademark as a non-protectable element, provided two conditions are satisfied.
8. The first condition is that the name of the State must be accurate in relation to the place of manufacture of the good and the place of business of its manufacturer. In the opposite case, the inclusion of this name in the trade mark must be considered false and, consequently, registration of the claimed designation impossible, as contravening paragraph 3(1) of Article 1483 of the Code.

9. The second condition of the inclusion of the name of a State as a non-protectable element in a claimed designation is that such a name must not occupy a dominant position in the claimed designation. When determining whether a non-protectable element occupies a dominant position in the designation, its semantic and/or spatial significance is borne in mind.

10. As evidenced by law-enforcement practice, the significance of a verbal designation which is the name of a State (or of a designation based thereon), even if such a designation does not constitute a major part of the designation, enables a conclusion to be drawn as to its dominant semantic importance.

11. Based on the above, Russian legislation envisages the possibility of providing legal protection for the names of States.

12. With regard to other aspects relating to the proposal of the Delegation of Jamaica on Article *6ter* of the Paris Convention, these may be discussed as an agenda item on Article *6ter* of the Paris Convention at the twenty-first session of the SCT.

13. Examples of designations including names of States, in relation to which the provisions of Article 1483 of the Code were applied, are given in Annex II.

[Annex II follows]

ANNEX II

	<p>Application №2005719567</p>	<p>Inclusion as a non-protectable element in a trademark of an official name of a State (Switzerland), in which the applicant has its place of business.</p>
	<p>Application №2007708407</p>	<p>Inclusion as a non-protectable element in a trademark of an official name of a State (Finland), in which the applicant has its place of business.</p>
	<p>Application №2006716585</p>	<p>Inclusion as a non-protectable element in a trademark of an official name of a State (Sweden), in which the applicant has its place of business.</p>
	<p>Application №2005706934</p>	<p>An applicant from Panama requests legal protection of a designation which includes the official name of a State (Italy). Registration of the designation as a trademark is not possible, since it is capable of misleading the consumer regarding the producer and country of origin of the goods.</p>

	<p>Application №2006706972</p>	<p>An applicant from Russia requests legal protection of a designation which includes the official name of a State (France).</p> <p>Registration of the designation as a trademark is not possible, since it is capable of misleading the consumer regarding the producer and country of origin of the goods.</p>
	<p>Application №2008702532</p>	<p>An applicant from Germany requests legal protection of a designation which includes the official name of a State (Austria).</p> <p>Registration of the designation as a trademark is not possible, since it is capable of misleading the consumer regarding the producer and country of origin of the goods.</p>

[End of Annex II and of document]