

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

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INFORMATION ON CASES AND CASE STUDIES RELEVANT TO THE PROTECTION OF NAMES OF STATES AND ON NATION BRANDING SCHEMES

Document prepared by the Secretariat

INTRODUCTION

1. At its twenty-sixth session, held in Geneva from October 24 to 28, 2011, and February 1 to 3, 2012, the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) invited interested members to communicate to the Secretariat cases and case studies relevant to the protection of names of States as well as any information on nation branding schemes in which they have engaged including problems encountered in their implementation. The SCT requested the Secretariat to compile those communications into a working document to be presented to the twenty-seventh session of the SCT and to include information on nation branding available at WIPO (paragraph 14 of document SCT/26/8). Submissions of interested SCT members were to reach the Secretariat by March 15, 2012. Following the rescheduling of the twenty-seventh session of the SCT and upon request by the Delegations of Barbados and Jamaica, this deadline was extended to May 15, 2012.
2. By May 15, 2012, the Secretariat had received submissions from the Delegations of Jamaica, Lithuania, Mexico, Poland, Republic of Moldova, Turkey, Uganda and the United States of America. All submissions were posted on the SCT Electronic Forum web page.
3. The present document describes the work concerning the protection of names of States that the SCT has undertaken so far. It then summarizes the submitted information first in relation to the protection of names of States and then in relation to nation branding schemes. Finally, it provides an overview of the information on nation branding available at WIPO.

PREVIOUS WORK ON THE PROTECTION OF NAMES OF STATES

4. At its twenty-first session, held in Geneva from June 22 to 26, 2009, the SCT requested the Secretariat to prepare a draft questionnaire concerning the protection of official names of States against registration or use as trademarks (paragraph 15 of document SCT/21/7).

5. A first draft questionnaire (document SCT/22/4) was discussed by the SCT at its twenty-second session, held in Geneva from November 23 to 26, 2009. The Secretariat was requested to revise the draft questionnaire, taking into account all comments made by delegations at that session (paragraph 14 of document SCT/22/8).

6. At its twenty-third session, held in Geneva from June 30 to July 2, 2010, the SCT adopted the text of the revised draft questionnaire (document SCT/23/4), and the questionnaire was circulated to members afterwards. The Secretariat presented a summary of the replies to the questionnaire (document SCT/24/6 Prov.) to the SCT at its twenty-fourth session, held in Geneva from November 1 to 4, 2010. The document was subsequently revised following comments received by the Secretariat during and after that session. A final version of the summary is contained in document SCT/24/6. The SCT also requested the Secretariat to prepare a draft reference document for consideration at its next session, based on the Committee's work in that area so far and offering a comprehensive overview of the law and practice of members with regard to the protection of country names against registration and use as trademarks.

7. At its twenty-fifth session, held in Geneva from March 28 to April 1, 2011, the SCT held discussions based on a draft Reference Document on the Protection of Country Names Against Registration and Use as Trademarks (document SCT/25/4). The Draft Reference Document was based on the replies provided by members to the questionnaire. This document deals with the exclusion of names of States from registration as trademarks, procedural issues relating to registration as trademarks, protection against use as trademarks, and Article 10 of the Paris Convention for the Protection of Industrial Property (Paris Convention). The Chair of the twenty-fifth session concluded that the document would remain open for further comments to be provided by SCT members through the SCT Electronic Forum. The SCT also requested the Secretariat to revise the Draft Reference Document based on the comments received and to present it to the twenty-sixth session of the SCT.

CASES AND CASE STUDIES RELEVANT TO THE PROTECTION OF NAMES OF STATES

8. The submission by the Delegation of Jamaica consists of two documents: a report and a collection of case studies. The report stresses that States should have the exclusive moral and economic right to control their country name and nation brand and to prevent any unauthorized exploitation thereof¹. In addition, the ability to prevent unauthorized use should not depend on whether such use occurs in the course of trade, whether it creates a likelihood of confusion, or whether it causes or is likely to cause damage². Moreover, the right of States to control their country names should also extend to translations, homonyms, homographs and homophones of country names³.

9. The Delegation of Jamaica views such protection of country names as a fundamental part of the sovereignty of States that is consistent with the right to self-determination of peoples⁴. Furthermore, the extensive effort and investment that the Government of Jamaica employs to develop its nation brand and to stop the unauthorized use of its country name or nation brand would be undermined if it could not manage the use of its country name and nation brand⁵. Finally, it maintains that there is no logical justification for the fact that the names of international intergovernmental organizations enjoy a high degree of protection under Article 6*ter* of the Paris Convention but that the same level of protection is unavailable to names of States⁶.

10. The report also analyzes the extent to which country names are protected under the existing regimes for trademarks (in particular collective and certification marks), trade names, passing off/unfair competition, and geographical indications⁷. Finding that these regimes only offer limited protection, the report concludes that they are unable to accommodate the desired level of protection for country names.

11. At the domestic level, it is current practice of the Intellectual Property Office of Jamaica (hereinafter referred to as “The IP Office of Jamaica”) not to allow the registration of trademarks that incorporate country names. Companies established in Jamaica, however, are not blocked from using the name “Jamaica”. The IP Office of Jamaica is also seeking an amendment of the Trade Marks Act to incorporate the protection of country names in order to formalize its current practice⁸.

12. In order to create the suggested level of recognition and protection for country names, the Delegation of Jamaica advocates a structured holistic international approach. It takes the view that the most appropriate solution would be to enlarge the scope of protection of Article 6*ter* of the Paris Convention to include country names. The IP Office of Jamaica would then grant the same level of protection as it offers to its own country name to the names of all States party to the amended Convention⁹. Alternatively, a trademark-related or *sui generis* mechanism could achieve the same result. Moreover, the Delegation of Jamaica affirms that it is open to other viable suggestions affording adequate and sufficient legal protection and means of prevention and redress for unauthorized use of country names.

13. In summary, the Delegation of Jamaica submits that any State should have the right to make any use of its country name dependent on prior informed consent, mutually agreed terms, and full and effective economic benefit-sharing¹⁰.

14. The second document submitted by the Delegation of Jamaica in addition to the report highlights a number of products that are marketed using the terms “Jamaica”, “Jamaican” or “Jamaican style”. It includes newspaper clippings, product images, and information provided on the websites of the producers of some of these products. The document also contains the lists of results returned upon a search for the term “Jamaica” in selected trademark databases.

15. The Delegation of Lithuania reports that applicants for trademarks and designs incorporating State symbols are required to obtain permission for the use of these symbols under pre-established eligibility criteria. In relation to business names, applicants must equally comply with pre-established criteria. As far as domain names are concerned, in order to register a domain name that contains the name of the State as a second-level domain (the part before .lt), permission must be sought under pre-established criteria.

16. The Delegation of Mexico submits that under its domestic IP law trademarks incorporating the names of States are not excluded from registration and that an authorization by the competent authorities is not required. This notwithstanding, a trademark cannot be registered if the use of the name of a State is descriptive of the goods and services for which registration is sought, is misleading as to the origin of the latter or lacks distinctiveness in any other form. These grounds are either considered *ex officio* or upon third-party submission by way of observations or during cancellation proceedings.

17. In its submission, the Delegation of the Republic of Moldova indicates that the national registration of trademarks incorporating names of States requires the permission of the competent authority. As far as the name “Moldova” is concerned, the criteria for approving such use are stipulated in special regulations.

18. The Delegation of Poland reports on two particular instances in which protection for trademarks incorporating names of States was rejected. In the first example, registration was sought for a figurative trademark with the word element “ID”. The rejection was based on Article 8(6) of the national Trade Marks Act, according to which trademarks containing the name or abbreviation of a State member of the Paris Union can only be registered if the applicant shows entitlement to such use. Based on standard 3166 of the International Organization for Standardization (hereinafter ISO 3166), the word element ID was understood as the letter code of Indonesia and registration was denied.

19. In the second example, the IP Office of Poland held that the sign “MI CUBA”, in relation to which registration as a trademark was applied for by a Polish entrepreneur, was likely to mislead consumers as to the origin and the quality of the goods bearing the mark and thus rejected registration.

20. The submission of the Delegation of Turkey reports on a change in the practice of the IP Office of Turkey with regard to the protection of names of States. Prior to a revision of the Office Guidelines in November 2011, country names could be registered as trademarks if the applicant had obtained authorization by the competent authorities. Under the newly changed policy, it is no longer possible to register country names as trademarks.

21. The Delegation of Turkey provides three cases where registration as trademarks was sought for signs incorporating names of States. In two instances, registration was denied as the signs were seen as mere indications of the geographic origin of the relevant goods and services. In the third case, however, the trademark BAHAMA was registered for milk chocolate coated coconut bars.

22. The submission by the Delegation of Uganda points out that there is no specific law on the protection of names of States as such but that the national flag and armorial bearings of Uganda are protected by statute and that the protection conferred upon State emblems, official hallmarks and emblems of international intergovernmental organizations by Article 6*ter* of the Paris Convention also applies in Uganda.

23. The submission by the Delegation of the United States of America provides a review of 10 cases in which the registration of a sign containing the name of a State was refused. In all of these instances, the refusal was either based on the finding that the marks were merely descriptive of the geographic origin of the goods concerned or, where the public connected the geographical meaning of the mark with the relevant goods but the latter originated elsewhere, that they were primarily geographically deceptively misdescriptive.

24. Beyond the realm of trademark law, country names have seen some form of protection in the context of domain names. Notably, the Internet Corporation for Assigned Names and Number (ICANN) will not register country names as new generic top-level domain names (gTLDs) in the current application round¹¹. The main criterion for deciding whether a name is regarded as a country name for the purposes of gTLDs is ISO 3166. In addition, permutations and transpositions of these names as well as names by which a country is commonly known are equally excluded from registration as gTLD.

NATION BRANDING

CASES AND CASE STUDIES RELEVANT TO NATION BRANDING

25. Three of the eight submissions address the issue of nation branding, notably those of the Delegations of Jamaica, Republic of Moldova and Uganda.

26. The Delegation of Jamaica submits a detailed description of its nation branding activities until present. While Jamaica has always enjoyed a distinctive and strong reputation, the efforts to influence its image in the world began in the 1950s when the country name “Jamaica” as well as an associated logo were registered as trademarks in order to promote tourism. In more recent times, a number of different State and private-sector entities have developed and registered various trademarks, collective and certification marks in order to highlight the authenticity and the origin of products and services from Jamaica or to utilize Jamaica’s positive reputation to promote trade and investment¹². These include: a certification mark and two trademarks for Blue Mountain coffee; five certification marks for Jamaican jerk seasoning and sauces, scotch bonnet pepper, honey, bammies and generic food stuff; four collective marks for wearable art, visual art, fresh produce and boutique agribusiness; five different trademarks to attract trade and investment; two certification marks for authentic Jamaican products as well as three trademarks for unique products from Jamaica.

27. At the beginning of the twenty-first century Jamaica started to broaden its approach to nation branding. Commissioned by WIPO’s former Intellectual Property and Economic Development Division (IPEDD), a feasibility study on the development and implementation of a nation branding strategy in Jamaica was completed by external consultant Simon Anholt in 2006¹³.

28. Beyond country-specific considerations the study provided a comprehensive overview of the creation and implementation of nation branding strategies. A nation brand was understood as the particular image or reputation that a country has in the eyes of both people inside and outside of that country. Nation branding thus transcends the realm of IP and can be understood as the process of training countries and people to channel their behavior in a common direction that is positive and productive for the country’s reputation. Such active management of a nation’s brand was seen as an advantage in the competition for that nation’s share of the world’s consumers, capital, aid, tourists, students, investors and for the attention and respect of the media and of the global community.

29. The study highlighted the necessity to align all aspects of a Jamaica’s engagement with other countries in order to channel a nation’s behavior in the direction of an agreed brand vision. Notably, the areas of tourism, export, governance, investment and immigration, culture and heritage and people must all reinforce the same vision.

30. By way of more practical advice, the study proposed an eight-step action plan to create and implement a nation branding strategy:

- defining the branding task;
- building the brand team;
- auditing brand assets;
- defining the brand vision;
- testing potential brand visions;
- developing the brand vision domestically;
- implementing the brand; and
- monitoring progress.

31. Particularly with regard to the implementation phase, the study called for branding based on IP. Underlying this proposal was the assumption that innovation has a strong potential of positively influencing the reputation of the country. This pre-supposes, however, that the created innovations are in line with the relevant branding strategy.

32. As trademarks, and more particularly collective and certification marks, convey certain values or qualities of the products for which they are registered and used, they also have the potential to advance nation branding strategies if the latter are built on the same values and ideas.

33. Subsequent to the completion of the feasibility study, a follow-up workshop was organized by WIPO in 2007. In 2008, the Government of Jamaica formally expressed its intent to develop and implement a nation branding strategy before seeking advice on nation branding from an external consultant in 2010¹⁴.

34. Today, nation branding activities are an integral part of the work towards national development. Within the framework of Jamaica's "National Export Strategy" (NES) the development and implementation of a nation branding initiative is now part of the efforts on the part of the Government of Jamaica to increase exports and international market share for its products and services. A three-phase action plan for nation branding has been adopted to develop, implement and monitor a nation branding strategy.

35. The Delegation of the Republic of Moldova reports the launch of a branding strategy in 2006 that focuses on the notion "quality driven". This notion was derived from the country's key characteristics, notably its open-minded and international-oriented society and its fertile geography. The submission also contains the visual sign adopted to represent this branding strategy: a three-dimensional cube used with the country name "Moldova". The sign has been registered as a national trademark for all 45 classes by the Minister of Economy.

36. The Delegation of Uganda reports on concrete activities in the area of nation branding. There has been the "Proudly Ugandan" campaign to support products that originate in Uganda, the "Gifted by Nature" campaign to brand the country more generally, and trade and investment initiatives aimed to promote tourism, exports, and encourage foreign direct investment. The submission also mentions the current WIPO project on the branding of products with unique Ugandan qualities (see below paragraphs 46 to 48).

INFORMATION ON NATION BRANDING AVAILABLE AT WIPO

37. Information on nation branding available at WIPO has been gathered through mainly two projects: a tool on the role of trademarks and geographic indications in nation branding, and a project on IP and product branding for business development in developing countries and least developed countries (LDCs).

Tool on the Role of IP, in Particular Trademarks and Geographical Indications, in Creating, Developing and Strengthening a Nation Brand (2009-2012)

38. A project on nation branding is being developed by WIPO's Division for Certain Countries in Europe and Asia (DCEA). One of the DCEA's priorities is to support Member States in creating a national IP strategy that blends in comfortably with the relevant State's economic and cultural strategy. As a practical means to support the development of national IP strategies, the DCEA has been developing a new series of tools for experts and practitioners, as well as policy makers in countries in transition¹⁵.

39. One of these tools addresses the role of IP for nation branding (hereinafter nation branding tool). The final version of the nation branding tool was under preparation at the time of conclusion of the present document and its publication is expected for the third quarter of 2012. It is based on the premise that a country with a strong nation brand image has a competitive advantage in domestic, regional and world markets. The tool explores ways to use trademarks

and geographical indications as part of a comprehensive and concerted nation branding strategy and identifies win-win synergies between individual product brands and a bigger nation brand which distinguish the country and its products and services from others, transmit messages about quality and thereby develop consumer preference and loyalty for both the country and its products and services¹⁶.

40. The nation branding tool is based on experiences gathered from the 33 States that fall within the mandate of the DCEA¹⁷, notably the results of a survey sent to the national IP offices in February 2010, of several exploratory missions during the year 2010, and of three inter-regional events on nation branding between 2009 and 2011. The findings of the report, however, lend themselves to generalization and may thus also be of importance to countries beyond the particular geographic region.

41. The tool first stresses that successful nation branding initiatives require an intellectual property culture and, more specifically, a clear and accessible legal framework, effective IP protection, and awareness of the commercial and economic value of IP.

42. While nation branding initiatives may be shaped by both the public and the private sector, the report observes that national IP offices appear to be a largely underutilized resource of experience. In relation to initiatives led by commercial entities, the tool specifically mentions examples where collective and certification marks have been used to develop a quality reputation for national food products, which is not only conducive to foreign investment and tourism but also strengthens the domestic market for the products concerned. Finally, a coordinated strategic approach is advocated where different government departments work together with private sector producers.

43. The tool suggests that nation branding initiatives may be built around objective characteristics of a country such as its geographical features, its social and cultural history, or an existing reputation for a particular technology. Beyond this, it is of equal importance that nation branding meets the expectations of users and leaves a positive impression.

44. With regard to the branding of products and services, the tool notes that trademarks and geographical indications, although representing distinct forms of IP, may both help establish a product brand and reinforce each other. Attempts to link such product or service brands to the nation brand will be most successful where the product or service concerned is in some way special to the country.

45. The tool finishes with recommendations for the development and implementation of national branding initiatives and the role that trademarks and geographical indications may play therein.

IP and Product Branding for Business Development in Developing Countries and LDCs (since 2010)

46. At its fifth session, held in Geneva from April 26 to 30, 2010, the Committee on Development and Intellectual Property (CDIP) approved the currently ongoing project on IP and Product Branding for Business Development in Developing Countries and LDCs¹⁸. This project aims at supporting local associations of producers and farmers in the design and implementation of strategies for the appropriate use of IP in product branding. It focuses on three particular products in each of the three beneficiary countries (Panama, Thailand and Uganda)¹⁹.

47. The first results of the project have been produced for Panama, where branding strategies have been developed for Palmira coffee, molas (a traditional garment of the Guna²⁰, Panama's second-largest indigenous community), and La Chorrera pineapples. In all three instances these strategies centered on the development and use of collective and certification marks with the aim of guaranteeing the products' authenticity and quality. Likewise, promising results have been obtained in Thailand, where branding strategies have been developed for three handicraft products carrying the name of their district or community of origin, i.e. Bang Chao Cha wicker products, Mae Cham woven cotton textiles and Lamphoon Brocade Silk, using marks and other distinctive signs.

48. Although the project is only concerned with product and not nation branding, it should be highlighted that the relevant products have been selected because they represented characteristics linked to their geographical origin. Where the branding strategy emphasizes the link between the products and the country, it could be used as a first step towards a further reaching nation branding initiative. Yet, this would pre-suppose that a further-reaching nation branding vision was already developed and that the images conveyed by the product brand would correspond and reinforce that vision.

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¹ Submission by the Delegation of Jamaica (Report), pp. 2 and 38. As to Jamaica's nation branding initiatives, see below at paragraphs 25 to 33.

² Submission by the Delegation of Jamaica (Report), pp. 30 to 32.

³ Submission by the Delegation of Jamaica (Report), p. 33. As the Delegation of Jamaica explains in its submission, homonyms are words that share the same spelling and the same pronunciation but have different meanings, homographs are words that share the same spelling irrespective of their pronunciation, and homophones are words that share the same pronunciation irrespective of their spelling.

⁴ Submission by the Delegation of Jamaica (Report), p. 35.

⁵ Submission by the Delegation of Jamaica (Report), pp. 2, 37 and 38. Also see the cost figures provided on pp. 10,11 and 12.

⁶ Submission by the Delegation of Jamaica (Report), p. 34.

⁷ Submission by the Delegation of Jamaica (Report), pp. 29 to 34.

⁸ Submission by the Delegation of Jamaica (Report), pp. 35 and 36.

⁹ Submission by the Delegation of Jamaica (Report), p. 36.

¹⁰ Submission by the Delegation of Jamaica (Report), p. 38.

¹¹ ICANN, gTLD Applicant Guidebook, section 2.2.1.4, available at: <http://newgtlds.icann.org/en/applicants/agb>.

¹² Submission by the Delegation of Jamaica (Report), pp. 8 to 22.

¹³ Submission by the Delegation of Jamaica (Report), pp. 22 to 24.

¹⁴ Submission by the Delegation of Jamaica (Report), pp. 23 and 24.

¹⁵ See <http://www.wipo.int/dcea/en/tools/> as well as WIPO Program and Budget for 2010/11, document A/47/3, Annex, p. 85.

¹⁶ Tool on the Role of IP, in Particular Trademarks and Geographical Indications, in Creating, Developing and Strengthening a Nation Brand, pp. 7, 8 and 9.

¹⁷ The 33 States within the mandate of the DCEA are comprised of 17 Central European and Baltic States (notably Albania, Bosnia and Herzegovina, Bulgaria, Croatia, Czech Republic, Estonia, Hungary, Latvia, Lithuania, Montenegro, Poland, Republic of Moldova, Romania, Serbia, Slovakia, Slovenia, and the former Yugoslav Republic of Macedonia); Central Asian, Eastern European and Caucasian States (Armenia, Azerbaijan, Belarus, Georgia, Kazakhstan, Kyrgyzstan, Russian Federation, Tajikistan, Turkmenistan, Ukraine, and Uzbekistan); and five Mediterranean States (Cyprus, Greece, Israel, Malta and Turkey).

¹⁸ Document CDIP/5/5, available at: http://www.wipo.int/edocs/mdocs/mdocs/en/cdip_5/cdip_5_5.pdf.

¹⁹ Document CDIP/9/2, Annex II, p. 18, available at: http://www.wipo.int/edocs/mdocs/mdocs/en/cdip_9/cdip_9_2.pdf; see also WIPO Magazine, April 2012, pp. 14 to 19, available at: http://www.wipo.int/wipomagazine/en/pdf/2012/wipo_pub_121_2012_02.pdf.

²⁰ Frequently used are also the spellings Kuna or Cuna.