

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

**Thirty-First Session
Geneva, March 17 to 21, 2014**

PROPOSAL BY THE DELEGATION OF JAMAICA

Document prepared by the Secretariat

In a communication dated December 31, 2013, the Delegation of Jamaica transmitted to the International Bureau of the World Intellectual Property Organization (WIPO) the proposal contained in the Annex to the present document.

[Annex follows]

INTRODUCTION

The SCT will recall that for over thirty years, concerns have been expressed by states internationally regarding the lack of international protection for country names and that proposals have been repeatedly made over the years for a review of the Paris Convention, in order to broaden the scope of Article 6*ter* to protect country names by including names of states within a special category of protected signs which currently includes armorial bearings, flags, other State emblems, official signs and hallmarks that are to be refused or invalidated as trademarks. This would have effectively led to the expansion of Article 6*ter*(1)(a) to include the protection of country names. Unfortunately, attempts to review Article 6*ter* of the Paris Convention have been so far unsuccessful.

Following a proposal made by the Delegation of Jamaica at the twenty-first session of the SCT in June 2009 (see document SCT/21/6), the SCT decided to prepare a draft questionnaire concerning the protection of official names of States against registration or use as trademarks, for consideration by the SCT. Following the twenty-third session of the SCT, the revised and final version of the questionnaire (document SCT/24/2) was circulated to SCT members. Returns to the questionnaire were compiled by the Secretariat and presented for consideration at the twenty-fourth session of the SCT (document SCT/24/6).

At that session, the SCT 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 Member States with regard to the protection of country names against registration and use as trademarks.

At its twenty-seventh session, the SCT requested the Secretariat to prepare a study to determine possible best practices for the protection of country names from registration as trademarks, or as elements of trademarks and to submit the study to the twenty-ninth session of the SCT. The Study was prepared by the Secretariat and submitted to the twenty-ninth session of the SCT. The Secretariat also recently prepared a Revised Draft Reference Document on the Protection of Country Names Against Registration and Use as Trademarks (document SCT/30/4).

At its thirtieth session, the SCT decided that work relating to the protection of country names would continue in the Committee and invited delegations to submit their proposals in writing to the Secretariat by the end of 2013. The Proposal below is submitted to the SCT by the Delegation of Jamaica pursuant to that decision.

PROPOSAL

The Paris Convention for the Protection of Industrial Property does not prescribe specific rules for the protection of country names, allowing Member States to adopt varied approaches to the matter.

The results obtained from the questionnaire suggest that the importance of the need to protect country names is recognised by many countries, and is addressed in domestic law and trademark practice in most countries. Convergence among Member States on an agreed approach to the protection of country names in the trademark system is possible. The absence of a common approach to the treatment of country names by intellectual property offices has, therefore, contributed to inconsistency in the registration and use of trademarks containing country names. There is concern that registrations may be considered or given where the use of a country name is neither authorised nor relates to

subject matter that has a direct relationship with the relevant country. It is feared that this can potentially cause commercial loss, affect the image and reputation of the country and harm the interests of consumers.

The Study shows that, although there are areas of convergence in treatment of trademark applications which consist of or contain country names, the protection that currently exists internationally for country names is inconsistent internationally. Therefore there is need for internationally consistent protection for country names.

The Delegation of Jamaica has prepared a Draft Joint Recommendation for the Protection of Country Names (that is contained in this document), as has been done in relation to other trade mark areas of common importance and convergence, which could guide and be used by Member States in trademark examination manuals at the national and regional level, in order to promote consistent and comprehensive treatment of this issue.

The Draft Joint Recommendation incorporates language and definitions largely from the previous Joint Recommendations (including well-known marks and marks on the Internet), as well as from Article 6~~ter~~ of the Paris Convention, the WIPO Study (document SCT/29/5) and the Revised Draft Reference Document on the Protection of Country Names Against Registration and Use as Trademarks (document SCT/30/4).

In the Draft Joint Recommendation, "country name" is defined broadly, as the WIPO Study revealed it often is, to include translations, abbreviations, country code, etc. "Minimum standard of protection for a country name" is a concept we consider may be useful for the protection for country names. Otherwise the terminology "conflicts with a country name" could be used.

Articles 2 to 5 address marks that conflict with country names and essentially provides for the same protection as is provided for well-known marks. It would only be optional for guidance purposes only.

Articles 6 and 7 were drafted based on the WIPO Study and Report and seek to prescribe acceptable grounds for refusal (in addition to Articles 2 to 5) and acceptable grounds for acceptance (subject to Articles 2 to 6). Information/documentary evidence is required for those sections so as to place the onus on applicants rather than on intellectual property offices to establish the legitimacy of the use of the country name.

Article 7(2) permits an approach which is to impose a condition on the registration of some marks with country names, to the effect that the right is limited to goods or services that originate in the identified country.

Articles 8 and 9 are standard concepts taken from other Joint Recommendations.

The Delegation of Jamaica wishes to thank the delegations to the SCT for their purposeful and constructive engagement on this agenda item. It is our sincere hope that this Draft Joint Recommendation will serve to continue the dialogue on the Protection of Country Names as together we seek meaningful and lasting solutions to this fundamentally important issue.

[Draft Joint Recommendation follows]

DRAFT JOINT RECOMMENDATION CONCERNING PROVISIONS
ON THE PROTECTION OF COUNTRY NAMES

PREFACE

The Joint Recommendation Concerning Provisions on the Protection of Country Names aims at harmonizing the examination and determination of trade mark applications for the registration of trademarks which consist of or contain country names, in order to promote consistent and comprehensive treatment and protection of country names among Member States.

Further to the adoption by the WIPO Assemblies of the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks in September 1999, the Joint Recommendation Concerning Trademark Licenses in September 2000, and the Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet in October 2001, this Joint Recommendation is the fourth achievement of the SCT in implementing WIPO's policy of finding new ways to accelerate the development of international harmonized common principles.

The question of new approaches to the progressive development of international intellectual property law was implemented by WIPO pursuant to the WIPO Program and Budget for the biennium 1998-99. This is so that a more flexible approach may be taken towards the harmonization of industrial property principles and rules, and coordination of administration, so that results can be achieved and applied more rapidly, ensuring earlier practical benefits for administrators and users of the industrial property system (see document A/32/2-WO/BC/18/2, page 86).

Joint Recommendation

The Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO),

Taking into account the provisions of the Paris Convention for the Protection of Industrial Property relative to the protection of armorial bearings, flags, and other State emblems of the countries of the Union, and official signs and hallmarks indicating control and warranty adopted by them;

Considering the deliberations within the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) since 1999 concerning the protection of country names, the Study to determine possible best practices for the protection of country names from registration as trademarks, or as elements of trademarks (document SCT/29/5) and the Revised Draft Reference Document on the Protection of Country Names Against Registration and Use as Trademarks (document SCT/30/4), which revealed the diverse practice of States and therefore the lack of internationally consistent protection for country names in regard to the examination and treatment of applications for the registration of trademarks which consist of or contain country names;

Recommend that each Member State may consider the use of any of the provisions adopted by the SCT, as guidelines for the examination and treatment of applications for the registration of trademarks which consist of or contain country names;

It is further recommended to each Member State of the Paris Union or of WIPO which is also a member of a regional intergovernmental organization that has competence in the area of registration of trademarks, to bring to the attention of that organization the possibility of protecting country names in accordance, *mutatis mutandis*, with the provisions contained herein.

Article 1
Definitions

For the purposes of these Provisions, unless expressly stated otherwise:

(i) “act of unfair competition” means any act of competition contrary to honest business practices in industrial or commercial matters as defined in Article 10*bis* of the Paris Convention for the Protection of Industrial Property, signed in Paris on March 20, 1883, as revised and amended¹;

(ii) “application” means an application for registration²;

(iii) “business identifier” means any sign used to identify a business of a natural person, a legal person, an organization or an association³;

(iv) “competent authority” means an administrative, judicial or quasi-judicial authority of a Member State which is competent for determining whether a mark or business identifier conflicts with a country name, whether a right has been acquired, maintained or infringed, for determining remedies, or for determining whether an act of competition constitutes an act of unfair competition, as the case may be⁴;

(v) “connection” means association with the country either by virtue of the origin or destination of the goods or services⁵;

(vi) “country name” includes the official name, the short name, the formal name, the historical name, or pronunciation, translation, transliteration, denomination, international code, standard abbreviation and adjectives of any of those names of a Member State⁶;

(vii) “domain name” means an alphanumeric string that corresponds to a numerical address on the Internet⁷;

(viii) “internet” refers to an interactive medium for communication which contains information that is simultaneously and immediately accessible irrespective of territorial location to members of the public from a place and at a time individually chosen by them⁸;

¹ Taken from Article 1 of the Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet.

² Taken from Article 1 of the Joint Recommendation Concerning Trademark Licenses.

³ Taken from Article 1 of the Joint Recommendation Concerning Provisions on the Protection of Well-known Marks.

⁴ Taken from Article 1 of the Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet.

⁵ Original definition/criteria. Alternatively, see Article 10.

⁶ Original definition based on the Revised Draft Reference Document on the Protection of Country Names Against Registration and Use as Trademarks (document SCT/30/4)

⁷ Taken from Article 1 of the Joint Recommendation Concerning Provisions on the Protection of Well-known Marks.

(ix) “mark” means a mark relating to goods (trademark) or to services (service mark) or to both goods and services⁹;

(x) “Member State” means a State member of the Paris Union for the Protection of Industrial Property and/or of the World Intellectual Property Organization¹⁰;

(xi) “minimum standard of protection for a country name” means the standard of protection as provided for in this Joint Recommendation;

(xii) “office” means the agency entrusted by a Member State with the registration of marks¹¹;

(xiii) “person” shall be construed as references to both a natural person and a legal entity¹²;

(xiv) “registered” or “registration” means the registration of a mark by an office¹³;

(xv) “remedies” means the remedies which a competent authority of a Member State can impose under the applicable law, as a result of an action for the infringement of a right or an act of unfair competition¹⁴;

(xvi) “right” means a trademark right in a sign, whether registered or unregistered, or a right in a business identifier or domain name, under the applicable law¹⁵.

Article 2 *Protection of Country Names; Bad Faith*

(1) [*Protection of Country Names*] A Member State shall protect country names against conflicting marks, business identifiers and domain names¹⁶.

(2) [*Consideration of Bad Faith*] Bad faith may be considered as one factor among others in assessing competing interests in applying these Provisions¹⁷.

[Footnote continued from previous page]

⁸ Taken from Article 1 of the Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet.

⁹ Taken from the Joint Recommendation Concerning Trademark Licenses.

¹⁰ Taken from Article 1 of the Joint Recommendation Concerning Provisions on the Protection of Well-known Marks and from Article 1 of the Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet.

¹¹ Taken from Article 1 of the Joint Recommendation Concerning Provisions on the Protection of Well-known Marks.

¹² Original definition.

¹³ Taken from the Joint Recommendation Concerning Trademark Licenses.

¹⁴ Taken from Article 1 of the Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet.

¹⁵ Adapted from Article 1 of the Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet.

¹⁶ Adapted from Article 3 of the Joint Recommendation Concerning Provisions on the Protection of Well-known Marks.

¹⁷ Adapted from Article 3 of the Joint Recommendation Concerning Provisions on the Protection of Well-known Marks.

(3) [*Factors*] For the purposes of applying these provisions, any relevant circumstance shall be considered in determining whether a mark that consists of or contains a country name, was or is being used in bad faith, or whether a right was acquired in bad faith. In particular, the competent authority shall take into consideration, *inter alia*:

(i) whether the person who used the country name or acquired the right, had knowledge of that country name, or could not have reasonably been unaware of that country name, at the time when the person first used the country name, acquired the right or filed an application for acquisition or use of the right, whichever is earlier, and

(ii) whether the use of the mark would take unfair advantage of, or unjustifiably impair, the distinctive character or the reputation of the country name and/or nation brand contained in the mark¹⁸.

Article 3 *Conflicting Marks*¹⁹

(1) [*Conflicting Marks*] (a) A mark shall be deemed to be in conflict with the minimum standard of protection for a country name where that mark, or a part thereof, constitutes a reproduction, an imitation, a translation, a transliteration, or an abbreviation, of a country name, which is liable to create confusion, if the mark, or a part thereof, is the subject of an application for registration, or is registered, in respect of goods and/or services.

(b) Irrespective of the goods and/or services for which a mark is used, is the subject of an application for registration, or is registered, that mark shall be deemed to be in conflict with the minimum standard of protection for a country name where the mark, or a part thereof, constitutes a reproduction, an imitation, a translation, a transliteration, or an abbreviation of a country name, and where at least one of the following conditions is fulfilled:

(i) the use of that mark would indicate a false connection between the goods and/or services for which the mark is used, is the subject of an application for registration, or is registered, and the relevant Member State identifiable by the country name;

(ii) the use of that mark is likely to impair or dilute the distinctive character, reputation, country name and/or nation brand of the relevant Member State identifiable by the country name;

(iii) the use of that mark would take unfair advantage of the distinctive character, reputation, country name and/or nation brand of the relevant Member State identifiable by the country name.

(2) [*Opposition Procedures*] If the applicable law allows third parties to oppose the registration of a mark, a conflict with a country name under paragraph (1)(a) shall constitute a ground for opposition.

¹⁸ Adapted from Article 4 of the Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet.

¹⁹ Adapted from Article 4 of the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks.

(3) [*Invalidation Procedures*] (a) The relevant Member State which is identifiable by a country name, or a legal person authorized by the relevant Member State, shall be entitled to request the invalidation, by a decision of the competent authority, of the registration of a mark which is in conflict with the country name and/or which does not meet the minimum standard of protection for a country name.

(b) If the registration of a mark may be invalidated by a competent authority on its own initiative, a conflict with a country name shall be a ground for such invalidation.

(4) [*Prohibition of Use*] The relevant Member State which is identifiable by a country name, or a legal person authorized by the relevant Member State, shall be entitled to request the prohibition, by a decision of the competent authority, of the use of a mark which is in conflict with the country name and/or which does not meet the minimum standard of protection for a country name.

Article 4 *Conflicting Business Identifiers*²⁰

(1) [*Conflicting Business Identifiers*] A business identifier shall be deemed to be in conflict with a country name where that business identifier, or a part thereof, constitutes a reproduction, an imitation, a translation, a transliteration, or an abbreviation of the country name, and where at least one of the following conditions is fulfilled:

(i) the use of the business identifier would indicate a false connection between the business for which it is used and the relevant Member State identifiable by the country name;

(ii) the use of the business identifier is likely to impair or dilute the distinctive character, reputation, country name and/or nation brand of the relevant Member State identifiable by the country name;

(iii) the use of the business identifier would take unfair advantage of the distinctive character, reputation, country name and/or nation brand of the relevant Member State identifiable by the country name.

(2) [*Prohibition of Use*] The relevant Member State which is identifiable by a country name, or a legal person authorized by the relevant Member State, shall be entitled to request the prohibition, by a decision of the competent authority, of the use of a business identifier which is in conflict with its country name.

²⁰ Adapted from Article 5 of the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks.

Article 5
*Conflicting Domain Names*²¹

(1) [*Conflicting Domain Names*] A domain name shall be deemed to be in conflict with a country name at least where that domain name, or a part thereof, constitutes a reproduction, an imitation, a translation, a transliteration, or an abbreviation of the country name, and the domain name has been registered or used in bad faith, or where at least one of the following conditions is fulfilled:

(i) the use of the domain name would indicate a false connection between the business for which it is used and the relevant Member State identifiable by the country name;

(ii) the use of the domain name is likely to impair or dilute the distinctive character, reputation, country name and/or nation brand of the relevant Member State identifiable by the country name; or

(iii) the use of the domain name would take unfair advantage of the distinctive character, reputation, country name and/or nation brand of the relevant Member State identifiable by the country name.

(2) [*Cancellation; Transfer*] The relevant Member State which is identifiable by a country name, or a legal person authorized by the relevant Member State, shall be entitled to request, by a decision of the competent authority, that the registrant of the conflicting domain name cancel the registration, or transfer it to the relevant Member State, or legal entity duly nominated by the relevant Member State.

Article 6
*Determination of Whether to Refuse a Mark with a Country Name*²²

(1) [*Factors for Refusal*] In addition to the circumstances outlined in Articles 2 to 5 above, the office or competent authority shall refuse registration of a mark which consists of or contains a country name:

(i) where the mark is considered descriptive of the origin of the goods in respect of which registration is sought, even if the mark does not “consist exclusively” of the country name;

(ii) where the use of the name of a State could be considered to be misleading, deceptive or false as to the origin of the goods or services for which the registration is sought, even if the mark includes other elements which accurately represent the origin of the product;

(iii) on the basis of public order or morality as defined by national law and/or policy in place to protect country names; or

²¹ Adapted from Article 6 of the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks.

²² Based on the Study to determine possible best practices for the protection of country names from registration as trademarks or as elements of trademarks (document SCT/29/5) and the Revised Draft Reference Document on the Protection of Country Names Against Registration and Use as Trademarks (document SCT/30/4).

(iv) on the basis of any national law that offers *sui generis* or *per se* protection for country names;

(2) The competent authority shall consider information submitted to it with respect to factors from which it may be inferred that the mark is, or is not, distinctive, descriptive, generic, misleading, deceptive or false.

Article 7
*Determination of Whether to Accept a Mark with a Country Name*²³

(1) [*Factors for Acceptance*] Subject to Articles 2 to 6 above, the office or competent authority may accept registration of a mark which consists of or contains a country name:

(i) If the application for registration of the mark is supported by documentary evidence to show that the goods or services for which the mark is registered originate from the country named in the trademark;

(ii) If the application for registration of the mark is supported by documentary evidence of authorization by the competent authority or authorities, if any, of the relevant Member State;

(iii) If the application for registration of the mark is supported by documentary evidence of the applicant's compliance with established national law and/or policy of the relevant Member State named in the trademark regarding use of the country name or other related designation;

(iv) if evidence is presented by the Applicant to show that the country name as used in the mark has a secondary non-geographical meaning and that the mark is not liable to be perceived by the public as misleading, deceptive or false as to the origin of the goods and/or services for which registration is sought; or

(v) if evidence is presented by the Applicant to show that the mark is well-known and/or has a reputation and that the mark is not liable to be perceived by the public as misleading, deceptive or false as to the origin of the goods and/or services for which registration is sought.

(2) If the goods or services for which the mark is registered or intended to be registered originate from the country named in the trademark, the office or competent authority, where it has the power to do so, may impose a condition or limitation on the registration of the mark, to the effect that the mark shall only be used in relation to goods and/or services which originate in the Member State identifiable by the mark.

²³ Based on the Study to determine possible best practices for the protection of country names from registration as trademarks, or as elements of trademarks (document SCT/29/5) and the Revised Draft Reference Document on the Protection of Country Names Against Registration and Use as Trademarks (document SCT/30/4).

Article 8
Opposition and Invalidity

The grounds provided above for refusing the registration of a trademark as being descriptive, non-distinctive, generic, misleading, deceptive or false, shall apply to opposition and invalidity proceedings as applicable under national law²⁴.

Article 9
*Unfair Competition or Passing-off*²⁵

There shall be liability in a Member State under the applicable law when an act of unfair competition or passing-off is committed, through use of a mark, business identifier or domain name, consisting of or containing a country name, which is misleading, deceptive, false and amounts to an act of unfair competition or passing-off in accordance with national law.

Article 10
*Factors for Determining False Connection to a State*²⁶

(1) [*Factors*] In determining whether use of a mark, business identifier, or domain name, which consists of or contains a country name, would indicate a false connection to a Member State that is identifiable by the country name, the following factors may be considered:

(a) circumstances indicating that the user of the mark, business identifier, or domain name, is doing, or has undertaken significant plans to do, business in relation to goods or services which originate in the Member State;

(b) circumstances indicating that the user of the mark, business identifier, or domain name, is doing, or has undertaken significant plans to do, business in the Member State, in relation to goods or services which are associated with the mark, business identifier, or domain name;

(c) the level and character of commercial activity of the user in relation to the Member State, including:

(i) whether the user is actually serving customers located in the Member State;

(ii) whether the user offers post-sales activities in the Member State, such as warranty or service; or

(iii) whether the user undertakes further commercial activities in the Member State which are related to the use of the mark, business identifier, or domain name.

²⁴ Based on the Study to determine possible best practices for the protection of country names from registration as trademarks, or as elements of trademarks (document SCT/29/5) and the Revised Draft Reference Document on the Protection of Country Names Against Registration and Use as Trademarks (document SCT/30/4).

²⁵ Adapted from Article 7 of the Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet.

²⁶ Adapted from Article 3 of the Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet.

- (d) the connection of an offer of goods or services with the Member State;
- (e) the connection of the manner of use of the mark, business identifier, or domain name with the Member State, including:
 - (i) whether the user has indicated, in conjunction with the use of the sign, an address, telephone number or other means of contact in the Member State; or
 - (ii) whether the mark, business identifier, or domain name is used in connection with a domain name which is registered under the ISO Standard country code 3166 Top Level Domain referring to the Member State.

[End of Annex and of document]