

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

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SUBMISSION 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 submission contained in the Annex to the present document.

[Annex follows]

INTRODUCTION

Pursuant to a request made at the twenty-seventh session of the SCT, the Secretariat prepared a study (document SCT/29/5) to determine possible best practices for the protection of country names from registration as trademarks, or as elements of trademarks. The Delegation of Jamaica has taken the time to conduct a detailed analysis of the study as reflected in document SCT/29/5, which we now share with this Committee to further discussion on this very important issue.

The results of the study confirm to us that the practice of States, as it relates to the protection of country names, is neither uniform nor comprehensive. While the study shows that protection is available for country names through several alternative means, it also clearly shows that such protection is often limited to particular circumstances, such as where the country name is the sole element of the mark, which circumstances can often be circumvented to render the mark acceptable. Therefore, despite the seemingly positive returns to the survey, the results when properly analysed reveal that there are many circumstances where trademarks with country names are accepted for registration by intellectual property offices.

Alternative means of protection such as oppositions, unfair competition and passing-off, although possible in theory, such actions nearly always require engaging foreign legal representation and may involve litigation which can be costly, especially for developing countries and Small Island Developing States.

The Delegation of Jamaica therefore submits its Analysis of the Study on the Protection of Country Names so that it may inform discussions within the SCT on this Agenda Item for the Protection of Country Names. We look forward to working with other delegations to find solutions to these issues and to inform the process of developing a Joint Recommendation for the Protection of Country Names.

ANALYSIS OF THE STUDY ON THE PROTECTION OF COUNTRY NAMES

INTRODUCTION

Pursuant to a request made at the twenty-seventh session of the SCT, the Secretariat prepared a study (document SCT/29/5) to determine possible best practices for the protection of country names from registration as trademarks, or as elements of trademarks. The following represents the analysis by Jamaica of the said study. The headings and sub-headings used in the study are used herein for easier analysis and reference.

EXAMINATION PHASE

While the study shows that protection is available for country names through several alternative means, it also clearly shows that such protection is often limited to particular circumstances, such as where the country name is the sole element of the mark, which circumstances can often be circumvented to render the mark acceptable. Therefore, where the mark has additional words or figurative elements, it will be accepted for registration by most IP offices around the world. Similarly, where the country name has a secondary non-geographical meaning attributed to it, the mark may nevertheless be accepted. Other countries will accept an application to register a mark with a country name if the mark has acquired distinctiveness or if the applicant files a disclaimer in respect of the country name.

The study revealed that during the examination phase in most countries, a mark containing a country name may be accepted for registration in some or all of the following circumstances:

- i. if the country name appears amongst other elements;
- ii. if the applicant is from the country named in the trade mark;
- iii. if the applicant files a disclaimer in respect of the country name;
- iv. if the country name as used in the mark has a secondary non-geographical meaning;
- v. if the mark has acquired distinctiveness;
- vi. if special evidence is presented to show that the geographical name in question does not serve in trade to indicate the geographical origin of the goods or services;
- vii. if the mark is well-known and/or has a reputation; or
- viii. in jurisdictions where applications are not examined *ex officio* as to the potential ground for refusing country names.

Descriptive Character

In relation to “Descriptive Character”, 95.9% of the responding countries indicated that under the applicable legislation, names of states are excluded from registration as trademark for goods ONLY IF they are considered descriptive of the origin of the goods in respect of which registration is sought. This is the most commonly used ground against which the registrability of country names as trademarks is checked. Differentiation is made between marks which “consist exclusively” of a country name and those which include additional words and/or figurative elements. The effect is that if the sign with country name is combined with elements which are found distinctive, the trademark would be accepted for registration. Examples of this are reflected in Annex II, Figure II of the study.

Misleading, Deceptive, False

In respect of the grounds for refusal based on marks being deemed “Misleading, Deceptive, False”, the study clearly shows that “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” (paragraph 31). While 98.5% of the responding countries indicated that country names are 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% said that names of States would be excluded IF they can be considered incorrect as to the origin of the products for which registration is sought, the fact remains that such marks will only be refused IF considered to be misleading, deceptive or incorrect as to origin. Therefore, if the mark with the country name is accompanied by other elements or labeling which accurately represents the origin of the product, the use of the country name in the trademark will likely be permitted nevertheless. Annex II, Figure 6 shows an example of that reality.

Public Order and Morality

In relation to ‘public order and morality’, those terms are defined, interpreted and applied differently from jurisdiction to jurisdiction. This therefore is inadequate to protect country names which will not always be caught by the application of these principles, and not in all countries.

Per se Protection

The study confirms that very few countries have specific *per se* protection for country names which provides an absolute bar for registration of marks with country names.

Refusal or Exclusion of Marks with Other Verbal Signs Related to Geographical Origin

In relation to the refusal or exclusion of marks with other verbal signs related to geographical origin, the study confirms that there are considerable differences in national practice concerning the official names, pronunciations, translations, denominations, international code, standard abbreviations and adjectives of country names which are or ought to be protected.

OPPOSITION PROCEDURES AND OTHER PROCEEDINGS

In relation to opposition procedures and other proceedings, it is clear that relying on opposition and observation proceedings for the protection of country names is insufficient and inadequate.

Oppositions

As the study shows, two conditions must be met under national trademark law: (1) the law must contain a ground for refusing signs from registration as a trademark that consist of or contain a country name and (2) claiming inconsistency with that provision must be recognized as a ground for filing an opposition. As mentioned above, although many countries interpret national laws to protect country names somewhat, such protection is not uniform and allows many exceptions.

Therefore, the opposition procedures do not offer any greater protection than the limited protection offered by the substantive trade mark law. In fact, oppositions present a further hurdle to country name protection for it would require substantial resources for states, especially developing countries and Small Island Developing States, to police the trade mark offices and registries of the world, and to commence opposition proceedings and perhaps even court litigation in foreign jurisdictions.

Further, as the study found, there may be doubts as to which body or authority within the Government would have the necessary standing to bring such oppositions. An additional hurdle would be the time limits to file such oppositions, as in most jurisdictions opposition may only be raised within two or three months.

Overall then the opposition procedure imposes more hurdles and is therefore inadequate to protect country names, which, in order to be protected adequately, ought to be protected within national laws, policies and procedures, through an international treaty or joint recommendation of the WIPO General Assembly, as has been done in relation to other trade mark areas of common importance and convergence.

Observations

Observations, even more so than oppositions, are inadequate and ineffective to protect country names. Observations are not required to be considered or acted upon by the IP office or by the applicant, as are oppositions. Most IP offices are not bound to even respond to observations and in fact, most do not. Even though there are generally no rules as to standing or any specific time limit to make observations, the fact is that, in practice in the vast majority of jurisdictions, trade mark applications are very rarely refused on the basis of observations. Observations are therefore inadequate to protect country names.

Invalidation

The study shows that at least two conditions must be regularly present under the relevant national trademark law to be able to use invalidity proceedings: (1) there must be a ground for refusing the registration as a trademark of signs consisting of or containing a country name, and (2) a claim that the sign was registered in contravention of the former provision must be recognized as a valid ground for requesting the invalidation. The same comments made above in relation to oppositions regarding increased costs, standing and time limits, are also applicable to invalidity proceedings, rendering them inadequate to protect country names.

TORT LAW AND UNFAIR COMPETITION

In relation to the relevance of Tort Law and Unfair Competition to protect country names, the study clearly shows that, of the countries in which the use of country names as a trademark is excluded, just over 51% exclude country names based on the law against unfair competition, while 48.1% exclude country names based on general tort law or passing-off. Again, this shows great divergence in practice in the protection afforded to country names. Further, enforcing unfair competition and passing-off laws across borders often requires engaging foreign legal representation and may involve litigation which can be costly, especially for developing countries and Small Island Developing States. Passing-off is further restricted by its legal limitations which may require goodwill in the locality among the consumers. The protection of country names ought not to be so limited.

NORMS AND PRACTICES RELATING TO THE IMPORT AND EXPORT OF GOODS

Regarding norms and practices relating to the import and export of goods, the study shows that the standards that are used vary nationally. Further, requirements to indicate place of origin on labeling of food products for import and export are complied with once the country of origin is named on the label or packaging. Therefore, once the labeling or packaging has the country of origin thereon, it matters not whether the trademark used on the label or packaging has a country name which is different from the stated country of origin.

NORMS AND PRACTICES RELATING TO COUNTRY NAME IDENTIFIERS

Similarly, the extent to which the "place of origin" includes the official name, the short name, the formal name, the historical name of a State or the translation, transliteration, abbreviation or adjective thereof, varies from country to country.

Regarding the new Generic Top Level Domain names, though ICANN will not approve applications for strings that are country or territory names, country names nevertheless are not protected from misuse or unauthorized use in domain names which are not top level domains. This does not therefore provide any protection for domain names like www.jamaica.com for example, as complained of in our previous submissions to this Committee.

NATION BRANDING SCHEMES

In relation to nation branding schemes, the study showed that many countries actually have embarked upon a nation branding strategy, which is very useful. Not only does the study confirm that the country name is an essential element of any nation branding campaign, the study also confirms that the country name is the strongest association with a country. However the study did not go far enough in assessing the real and/or potential impact of weak country name protection on nation branding schemes, which still needs to be done.

CONCLUSION

The results of the study confirm that the practice of States, as it relates to the protection of country names, is neither uniform nor comprehensive. Many loopholes exist in trademark law and practice, both pre-grant and post-grant, which permit the possibility of country names being registered as part of trademarks. Alternative procedures of protection such as oppositions and observations are financially and logistically burdensome on States, especially developing countries. The study confirms the need for stronger, more comprehensive and internationally consistent protection for country names, through consistent and agreed approaches to examination of trademarks with country names.

[End of Annex and of document]