

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

Thirty-Seventh Session
Geneva, March 27 to 30, 2017

NOTE BY THE DELEGATION OF ICELAND

Document prepared by the Secretariat

The Annex to this document contains a Note by the Delegation of Iceland.

[Annex follows]

THE USE OF COUNTRY NAMES AS WORD MARKS: THE CASE OF ICELAND

Iceland is party to the Paris Convention and a member of WIPO and WTO/TRIPS. Furthermore, Iceland is party to several international conventions on IPR. Iceland is also a member of the European Economic Area (EEA) and the internal market. Iceland accordingly incorporates the EU/EEA legislation for trademarks into its national legal order.

As is the case in many countries, Icelandic law provides only indirect protection for country names. It should be noted that we understand the term “country names” as has been defined by the SCT in its previous work related to the protection of country names. Icelandic legislation does not specifically exclude country names from trade mark registration, but word marks consisting of country names are indirectly protected as they are often considered to be either descriptive or deceptive. This is especially true for word marks consisting exclusively of a country name.

However, as the case of Iceland presented here, demonstrates, in practice, country names seem not to be offered sufficient protection. In recent years, Iceland has had to allocate considerable time and resources to protect the name of the country from trade mark registrations in almost all corners of the world. The most known of these cases has often been headlined Iceland v. Iceland in the media and i.a. revolves around the registration of the word mark “Iceland” owned by a British supermarket chain, Iceland Foods Ltd. in the United Kingdom and the European Union.

The British supermarket Iceland Foods opened their first store in the UK in 1970 and started using their now registered trademark. In 1994 Iceland Foods Ltd. filed their first trademark application and in 1997 the trademark Iceland was registered with minor stylizing elements for food and drinks. Iceland Foods Ltd. continued to file for various trademarks containing the word Iceland between 1996 and 1999. In 2002 the Iceland trademark is registered in the UK with minor stylizing elements for services.

Iceland Foods Ltd. also holds a UK registration of the word mark Iceland. The company filed for UK registration of the word mark in the UK in 2003. As a result of opposition in the UK various goods and services (fish, meat, water and cosmetics) were deleted but the word mark was registered to Iceland Foods Ltd. for 21 classes in 2014.

Iceland Foods Ltd. filed an EUIPO application for the word mark Iceland in 2002 which was accepted for registration in 2004 for all classes applied for except fish and living animals. In 2005 five oppositions are filed against the word mark at EUIPO, mainly based on prior registrations in the name of Icelandic companies which contained the word Iceland, none of which were successful. In 2014 the word mark is registered at the EUIPO as an EU trademark in eight (8) classes of goods and services, including classes 29-32 and class 35. These classes cover almost all agricultural products, including meat, poultry and game, milk and milk products, agricultural, horticultural and forestry and grain products, fresh fruits and vegetables, seeds, animal feeds, beer and water.

Iceland Foods Ltd. has actively enforced its exclusive rights to the word mark Iceland and opposed the registration of a number of trademarks containing the word Iceland by Icelandic businesses. It inter alia opposed the registration of “Inspired by Iceland” which is a national branding scheme partly sponsored and endorsed by the government of Iceland.

It is unacceptable that a single private party can exclude Icelandic companies and producers, and even a national branding program sponsored by the Icelandic government, from referring to Iceland when identifying their products.

On November 14, 2016, the Ministry for Foreign Affairs of Iceland, SA-Business Iceland and Promote Iceland filed an invalidity claim against the EUTM word mark registration Iceland with the EUIPO on the grounds that the word mark is descriptive and lacks distinctiveness as it is merely an indication of geographical origin. The process at the EUIPO is ongoing.

Due to long usage and wide market presence in the UK it is possible that the Iceland Foods Ltd. Iceland trademarks could be considered well known in the UK-market, which would further limit the legal action available to Iceland.

It is an issue of public interest that country names remain available and that no one natural person or legal entity can acquire exclusive rights to country names. It is a matter of principle that the public at large, i.e. including businesses, is able to enjoy access to and use their country's name as a source of identity and branding.

Country names furthermore communicate powerful messages and are a prominent part of nation branding identifiers. Country names serve to indicate provenance or origin, quality and other characteristics of goods and services and can also influence consumer preferences by association in various ways.

Allowing for the registration of country names can easily lead to customer confusion on the geographical origin of the goods in question and also, to the quality of goods actually derived from the actual geographical origin.

Iceland Foods Limited sells its products in the UK mostly in Iceland Stores, but according to the Iceland Foods web site, there are currently 34 Iceland franchise stores operating in markets including Spain and Portugal. Products marked by the word mark Iceland are also sold in BR Foods in Greece, Overseas in Spain and Portugal and Polar Express in France.

The following pictures of products sold by Iceland Foods Ltd. demonstrate how confusing the use of country names as trademarks can be in relation to geographic origin. Whereas fish and lamb are two of the most known exported products of Iceland (the country), the following goods are not in any way from or produced in or packed in Iceland (the country).



Under further information on the product, provided on the Iceland Foods web site, it can be seen that the goods are produced and packed in China for Iceland Foods Limited (Annex F).

Product Information

Iceland 5 Wild Pink Salmon Fillets 600g

SKIN ON BONELESS PINK SALMON FILLET PORTIONS WITH A PROTECTIVE ICE GLAZE

Storage

Keep frozen. Do NOT refreeze after defrosting.

Manufacturers Address

Produced and Packed in China for Iceland Foods Ltd., U.K., CH5 2NW.



Under further information on the product, provided on the Iceland Foods web site, it can be seen that the goods are farmed in Vietnam and India, and produced and packed in the United Kingdom):

Manufacturers Address

King prawns (*penaeus vannamei*) farmed in Vietnam and India. Produced and Packed in the U.K. for Iceland Foods Ltd., U.K., CH5 2NW.



Iceland 4 Lamb Doner Quarter Pounders 454g

★★★★☆ 3.9 (7 reviews) [Read a Review](#)

£1.00

£2.20 per 1 kg



Ingredients

Product Information

Nutrition

Cooking Instructions

Reviews

Product Information

Iceland 4 Lamb Doner Quarter Pounders 454g

Lamb burger with chilli and spices.

Storage

Keep Frozen. Do NOT refreeze after defrosting.

Manufacturers Address

roduced and Packed in the U.K. for Iceland Foods Ltd., U.K., CH5 2NW.

As the case of Iceland demonstrates, in practice, country names seem not to be offered sufficient protection. Although the current trademark system does provide some safeguards against the registration of country names as word marks, it does not provide such protection in a consistent and predictable manner. Furthermore, the costs associated to protecting country names against registration as word marks either by opposing registrations or filing invalidity claims all over the world are relatively high, posing a heavy burden on the tax payers of small states. Going forward it is important to strengthen the protection of country names against registration as word marks. Awareness-raising and clear cut directions in trademark examination manuals is not enough; proper predictable and consistent protection for country names against registration as word marks will only be achieved through a norm-setting instrument.

[End of Annex and of document]