

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

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PROTECTION OF COUNTRY NAMES AGAINST REGISTRATION AND USE AS TRADEMARKS: PRACTICES, APPROACHES AND POSSIBLE AREAS OF CONVERGENCE – ANALYSIS OF THE COMMENTS BY MEMBERS

Document prepared by the Secretariat

I. INTRODUCTION

1. From its twenty-first session (June 22 to 26, 2009) to its thirty-fourth session (November 16 to 18, 2015), the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) considered a number of working documents regarding the Protection of Country Names Against their Registration and Use as Trademarks.
2. At the thirty-fourth session of the SCT (November 16 to 18, 2015), the Chair requested the Secretariat to prepare a new document, based on document SCT/34/2, for discussion at its thirty-fifth session, identifying different practices and approaches, and existing areas of convergence in regard of the protection of country names. Accordingly, the Secretariat prepared document, which drew on the information contained in document SCT/34/2 and suggested the following Areas of Convergence^{*}: No. 1 (Notion of Country Name),

^{*} The term “area of convergence” has been used by the SCT in the past to name documents that describe the outcome of the work of the SCT in specific areas of trademark law. See in particular documents WIPO/Strad/INF/3 on Representation of Non-Traditional Marks and WIPO/Strad/INF/4 on Trademark Opposition Procedures at <http://www.wipo.int/sct/en/wipo-strad/>.

No. 2 (Non-registrable if Considered Descriptive), No. 3 (Non-Registrable if Considered Misleading, Deceptive or False), No. 4 (Consideration of Other Elements of the Mark), No. 5 (Invalidation and Opposition Procedures) and No. 6 (Use as a Mark).

3. At the thirty-sixth session of the SCT (October 17 to 19, 2016), the Chair requested the Secretariat to invite SCT members to submit, in priority, comments and observations to Areas of Convergence Nos. 1, 2, 5 and 6 including practical examples of how these principles are applied in their jurisdictions. By February 10, 2017, 25 members sent submissions to the International Bureau. These comments were summarized in document SCT/37/3, which was discussed during the thirty-seventh session of the SCT.

4. At that session, the Chair called on members to provide additional submissions on the areas of convergence. By June 30, 2017, 14 members sent submissions that have been compiled by the Secretariat in a revised version of document SCT/37/3. At the same session, the Chair also requested the Secretariat to prepare an analytical document on the basis of all comments and observations received from members (reference is made to document SCT/37/8, paragraph 14).

5. The present document provides an analysis of the submissions on the priority areas of convergence, the text of which is reproduced at the beginning of each subsection for ease of reference. As part of this analysis, the document attempts to describe any trends, specific ideas or additional concepts emerging from the comments and observations, as well as to provide an overview of the extent of support for each area of convergence.

6. The analysis does not currently cover Possible Areas of Convergence No. 3 (Non-Registrable if Considered Misleading, Deceptive or False) and No. 4 (Consideration of Other Elements of the Mark), which were not considered as priority by the SCT. These may be included in the analysis should the SCT decide to do so in due course.

II. ANALYSIS OF MEMBER STATE COMMENTS

POSSIBLE AREA OF CONVERGENCE No. 1 NOTION OF COUNTRY NAME

At least for the purposes of examination of marks, and unless the applicable law specifies otherwise, a country name may cover: the official or formal name of the State, the name that is in common use, translation and transliteration of that name, the short name of the State, as well as use of the name in abbreviated form and as an adjective.

ANALYSIS OF COMMENTS

7. The majority of contributing SCT members agreed that at least for the purposes of examination of marks, and unless the applicable law specifies otherwise, a country name may cover the categories included in Possible Area of Convergence No. 1. The national laws of certain countries contain a specific provision dealing with the inadmissibility for registration as a mark of a sign that consists of the official name of a State, although the submissions did not provide a specific reference to a list of official country names.

8. Several SCT members indicated that, in the context of their normative systems, country names do not constitute a separate or specific category of sign. Such names are rather included in the broader category of geographical terms, which may either be considered distinctive and therefore registrable as a mark or non-distinctive and refused registration.

9. While some members supported the inclusion of translations and transliterations of country names, as well as abbreviations thereof, others expressed concern. In the view of the former, this inclusion was necessary where the Office handled applications in multiple languages, whereas in the view of the latter, these variations were unlikely to be known to examiners. In relation to abbreviations, a suggestion was made to refer to the International Standards Organization (ISO) Standard No. 3166, which defines codes for the names of countries, dependent territories, special areas of geographical interest, and their principal subdivisions.

10. A member submission suggested that if it became mandatory to refuse translations and transliterations of country names in applications for the registration of marks, a centralized database could be created at WIPO to serve as a reference tool for IP Offices in the course of examination. The case was made that even though examiners could rely on Internet searches to determine whether a country name was objectionable as a mark, such searches might yield incomplete results.

11. The number of variations of a country name covered in this proposed area of convergence was a matter of concern for another SCT member. In its view, consumers around the world were not likely to know all country names and all variations of those names. It was suggested to narrow down the text to a formulation where it could be said that a country name is known to the local consumer and perceived as actually referencing the country.

*POSSIBLE AREA OF CONVERGENCE No. 2
NON-REGISTRABLE IF CONSIDERED DESCRIPTIVE*

At least for the purposes of examination, trademarks consisting solely of a country name should be refused where the use of that name is descriptive of the place of origin of the goods or services.

ANALYSIS OF COMMENTS

12. The majority of submissions referred to the provision of their national law implementing Article 6*quinquies* B.2 of the Paris Convention and in accordance with which trademarks are not granted registration when they are devoid of any distinctive character or consist exclusively of signs or indications which may serve in trade to designate *inter alia*, the place of origin of the goods or of rendering the services.

13. It was explained that, in application of the above mentioned provision, trademarks consisting solely of a country name would be refused at examination, where the use of that name is descriptive of the place of origin of the goods or services. Under the laws of a number of SCT members, there was an express reference to country names as matter that should be excluded from registration as a mark. The laws of a few other members do not consider the descriptive character of a trademark as a ground to be assessed independently from lack of distinctive character.

14. Most SCT members submitted that the determination of the descriptive character of a geographical term, including country names, is not done in isolation but should take into account other elements. The first element is whether the name is known or even well-known to the local consuming public and if on this basis, there would be any plausible connection between the name and the goods or services claimed in the application. The second element described by some SCT members was whether or not the country name could be linked to the actual quality, reputation or other characteristics of the goods and whether or not this would be likely to mislead the consumer.

15. Along the lines of the previous submissions, one SCT member described the test for geographically descriptive marks, which has been developed by its highest court. Where a trademark contains a geographical name and research shows that it has no other meaning than as a geographical name, it is non-registrable, as it is clearly describing the place of origin of the associated goods or services. There may be cases where the name of a geographic place also has other meanings and here the analysis would focus on consumer perceptions, from the perspective of the ordinary consumer. Then, the focus would be on whether the goods or services are found to originate from the geographical place, that is, whether they are manufactured, produced, grown, assembled, designed, provided or sold there or if the main component or ingredient is made in that geographic location. If this is the case, then the trademark is deemed descriptive of the place of origin.

16. Some SCT members indicated that an objection on the basis of the geographically descriptive character of the sign can nonetheless be overcome if the trademark, before the date of application for registration, has acquired distinctive character as a result of the use made of it. In the case of a country name, acquiring such distinctiveness would be difficult because a showing of acquired distinctiveness requires continuous and exclusive use in relation to the goods or services. This would be a rare occurrence for a mark consisting solely of a country name, although it is not impossible. However, if one considers the variations of country names given in Area of Convergence No. 1, a successful showing of acquired distinctiveness becomes increasingly possible.

POSSIBLE AREA OF CONVERGENCE No. 5 INVALIDATION AND OPPOSITION PROCEDURES

The grounds for refusal described in possible Areas of Convergence No. 2, [3 and 4], above should constitute grounds for invalidation of registered marks, and where the applicable law so provides, also grounds for opposition.

ANALYSIS OF COMMENTS

17. Several contributing SCT members seem to agree that the grounds for refusal described in possible Area of Convergence No. 2 should constitute grounds for invalidation and/or for opposition. Some members pointed out that under their national systems it is not possible to file an opposition against trademark registration based on absolute grounds such as descriptiveness or deceptiveness.

18. The majority of SCT members declared that the grounds described in possible Area of Convergence No. 2 should constitute grounds for invalidation and/or for opposition. Nevertheless, most members acknowledged that their national laws do not consider country names as such, to be a ground for invalidation and/or opposition.

19. A few SCT members stated not to be aware of cases of opposition or invalidation where the claim concerned an allegedly descriptive or misleading trademark including a country name.

20. A few submissions indicated that inherent deceptiveness as to the geographical origin of goods at the stage of examination may be overcome by requiring the applicant to enter an endorsement of the country or place of origin of the goods. Such endorsement must be requested where the mark could possibly indicate a misleading or confusing source of origin.

POSSIBLE AREA OF CONVERGENCE No. 6
USE AS A MARK

Appropriate legal means should be made available for interested parties to prevent the use of country names if such use is likely to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services and to request the seizure of goods bearing false indications as to their source.

ANALYSIS OF COMMENTS

21. The majority of contributing SCT members seem to agree that appropriate legal means should be made available for interested parties to prevent the use of country names if such use is likely to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services and to request the seizure of goods bearing false indications as to their source.
22. Several SCT members declared that, although their systems do not specifically provide for protection against the use of country names if such use is misleading or implies a false indication as to the nature, quality or geographical origin of the goods or services, this may nevertheless be prohibited under unfair competition laws which implement Article 10*bis* of the Paris Convention. Others asserted that such uses would be covered in the context of consumer protection or advertising laws, or cumulatively under more than one of these normative frameworks.
23. Nonetheless, one SCT member stated that its trademark law does not contain provisions allowing interested parties to prevent the use of country names if such use is likely to deceive the public as to the nature, quality or geographical origin of the goods or services and to request the seizure of goods bearing false indications as to their source.
24. One SCT member declared that, under its national law, if the goods marked with an indication of geographical origin have special qualities, the indication of geographical origin may only be used in the course of trade for goods or services having the corresponding origin and qualities. The same submission noted that indications of geographical origin which enjoy a particular reputation benefit from additional protection against use for goods and services of a different origin if such use would constitute an opportunity to take unfair advantage of, or be detrimental to, the reputation of the indication or its distinctive character.
25. Another SCT member expressed concern as to the scope of Possible Area of Convergence No. 6 noting that the inclusion of the concept of unfair competition seems to imply that country names are capable of source identification beyond geographic origin. This would suggest that misuse of a country name in a trademark, beyond deception as to geographic origin of the goods or services, is an act of unfair competition and that governments are interested parties under Article 10*bis* of the Paris Convention in claims of unfair competition. The member noted that Article 10*bis* (3) 3 of the Paris Convention only refers to goods, while the text of the possible area of convergence also covers services, this having possible implications on the implementation of some WIPO members of their obligations under the Paris Convention.

26. The SCT is invited to consider the present document, and indicate which next steps it wishes to take in respect of the matter.

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