

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

**Thirty-Ninth Session
Geneva, April 23 to 26, 2018**

PROPOSAL BY THE DELEGATION OF PERU

Document prepared by the Secretariat

In a communication dated April 5, 2018, the Delegation of Peru transmitted to the International Bureau of the World Intellectual Property Organization (WIPO) the proposal contained in the Annex to the present document.

[Annex follows]

PROPOSAL BY THE REPUBLIC OF PERU FOR THE RECOGNITION AND PROTECTION OF NATION BRANDS

EXPLANATORY STATEMENT

I. BACKGROUND

In a world of increasingly globalized markets, countries are constantly competing to be recognized and to position themselves commercially in order to attract tourism, foreign investment, human capital and demand for their products and services. The strategies used to achieve these objectives must be credible to their citizens, relevant to their audiences and different from those of their competitors.

In recent years, governments have become increasingly interested in implementing policies and designing nation branding strategies to associate a set of country values with a particular sign, logo or emblem, building a reputation that can be associated with that sign.

Countries are seeking to promote a strong brand that can be fixed in the public mind, having a direct impact both nationally and internationally, while building a global competitive advantage. The nation brand is a tool to promote the positive image of the country in the country and abroad.

II. NATURE OF THE NATION BRAND

A nation brand has particular characteristics that differentiate it from an ordinary trademark. These features include the following:

- It is a sign adopted by a State as part of policies and strategies seeking to disseminate and promote the identity and image of the country and its strategic sectors, including tourism, exports and investments.
- By its nature and application, its use is not limited or circumscribed to certain goods or services, since the nation brand identifies and represents a nation as a whole.
- This instrument is projected nationally and internationally. At the national level, it serves to implement policies to strengthen and promote the country's image among its own citizens. In the international sphere, it serves to introduce the country to a foreign public, to attract this public to the country and to raise its awareness and increased acceptance of the products and services originating from the country in question, and thus promote commercial, economic, tourist and cultural links.

The nation brand constitutes a *sui generis* distinctive sign because, notwithstanding its name, it is not intended to be a trademark (ordinary, collective or certification) since it does not apply to a specific product or service of a particular company. Nation brands do not operate under private law, as do trademarks, and should not be reduced to that level in their recognition and protection.

Nation brands play an emblematic role in the country's identity and image. They may be used as an umbrella sign to accompany other signs (geographical indications and appellations of origin) in relation to the goods and services of the country concerned.

III. BASIS OF PROTECTION

At the international level, there is still no agreed definition of what a nation brand is, nor a regulatory regime that regulates it internationally in a binding way. The procedure for the communication and notification of State emblems and official signs of control and warranty established by Article 6^{ter} of the Paris Convention for the Protection of Industrial Property exists at the multilateral level. Some countries, including Peru, have used this procedure to

communicate and protect their State emblems and official signs of control and warranty.

However, in the international arena, in the absence of an agreed definition of a nation brand, some States have resorted to treating such signs as if they were trademarks and have registered them as such. Nevertheless, such registration provides limited protection and entails considerable expense. Furthermore, it degrades the status of the sign by treating it as a trademark and reduces the State concerned to the level of a person subject to private law, equal in status to commercial enterprises which register their trademarks. This has costly consequences and effects, especially as concerns the defense and subsequent enforcement of exclusive rights over the nation brand.

Hence, nation brands clearly need a special procedure that allows them, in accordance with their particular nature, to be protected simply, effectively, cost-effectively and internationally, to prevent the unauthorized registration and use of identical or similar signs by third parties and thereby to complement the method offered by the aforementioned Article 6*ter* of the Paris Convention.

DRAFT

Nation Brand Regime

CONSIDERING THE FOLLOWING:

That nation brands are essential signs for the communication process in the implementation of national policies to promote the identity and image of countries operating in the modern world, characterized as it is by globalized communications and trade;

That the use of nation brands forms part of national policies for the promotion of various commercial sectors, including tourism, exports and investments, as well as the country's positive image;

That there is currently no international regime for the recognition and protection of nation brands;

That Article 6*ter* of the Paris Convention for the Protection of Industrial Property sets forth a system of communication and reciprocal notification of State emblems and official signs of control and warranty;

That, accordingly, certain Member States have been applying the protection provided for in Article 6*ter* in respect of their official emblems and signs of control and warranty;

That it is nonetheless appropriate to establish a system for the recognition of nation brands among Member States in order to improve their protection against the possible unauthorized registration or use of identical or similar signs; and

That such a system must be simple, efficient and cost-effective and be based on the reciprocal communication of nation brands and on their *ex officio* protection.

NATION BRAND REGIME

CHAPTER I

The nation brand recognition and protection system

Article 1. – Purpose and scope

These rules establish a common system for the recognition and protection of the nation brands of Member States’.

Article 2. – Definition of nation brand

A nation brand is any sign adopted and used by a Member State to promote its image within and outside the country and to promote, *inter alia*, tourism, culture, gastronomy, exports or investment by the Member State. The nation brand shall be not be time-barred and may not be seized.

Article 3. – Number and variants of nation brands

Each Member State shall determine the number and variants of nation brands it wishes to protect and communicate in accordance with the procedure laid down herein.

Article 4. – Ownership of the nation brand

Each Member State shall determine the proprietor of the nation brands to which it is entitled and shall designate the authority or authorities which shall exercise that right and other rights deriving therefrom.

Article 5. – Protection of nation brands

1. A nation brand of a Member State shall be recognized and protected in the other Member States as soon as it is communicated, provided that no reasoned objections are raised, in accordance with the procedure laid down in Article 6 hereof.

2. The rights of each Member State in respect of its nation brands which have been acquired through use, dissemination or registration in any capacity whatsoever before the said communication is made shall not be affected.

CHAPTER II

Procedure for the communication and protection of nation brands

Article 6. – Communication and protection of a nation brand

1. The competent national authority of a Member State which receives a communication of a nation brand shall immediately inform the competent national intellectual property office of that Member State, if they are different entities, by transmitting to it a copy of the communication received.

2. Member States shall have a period of ninety (90) calendar days as from receipt of the communication referred to in paragraph 1 above to notify their reasoned objections to the recognition and protection of the nation brand.

3. The communication and any objections referred to in this Article shall be submitted simultaneously to the International Bureau.

Article 7. – Publication of nation brands

Each Member State shall publish in an official medium the nation brands which are recognized and protected under this regime.

Article 8. – Incorporation into databases and other registries

Recognized and protected nation brands shall be incorporated into databases and registers of distinctive signs or other registers.

CHAPTER III

Protection of nation brands

Article 9. – Validity of the nation brand

1. A nation brand which has been communicated to a Member State shall be protected for an indefinite time.
2. The obligation to protect a nation brand shall cease at the express request of the Member State which communicated it. Such a request shall be made following the procedure provided for the initial communication of the nation brands.
3. Nation brands shall not be subject to any use requirements as a condition for maintaining their recognition and protection.

Article 10. – Use of the nation brand and permission for use

1. Each Member State shall determine the policies and rules relating to the use of its nation brands.
2. Each Member State shall lay down the procedure and conditions for seeking and obtaining authorization to use its nation brands domestically or abroad and shall designate the national authority empowered to issue such authorization.

Article 11. – Measures to ensure the protection of the nation brand

Each Member State shall take the necessary administrative or judicial measures to ensure that the nation brands communicated to it actually enjoy the protection provided for herein. To this end, each Member State shall provide that its national authorities shall consult the recognized and protected nation brands and take them into account when taking decisions on the registration and protection of distinctive signs, in accordance with its internal procedure.

Article 12. – Protection of the nation brand

1. Each Member State shall, either *proprio motu* or at the request of a party, refuse to register or to protect any trademark, trade name, sign, banner, slogan, geographical indication, appellations of origin or any other distinctive sign which is identical or similar to a protected nation brand.

2. Each member State shall, either *proprio motu* or at the request of a party, cancel any registration it has granted in contravention of sub-article 1, or as a result of bad faith. Such cancellation shall not be time-barred.

3. Each Member State shall, either *proprio motu* or at the request of a party, take the necessary measures to prevent or to end any use or imminence of use of a sign which is identical or similar to a protected nation brand, where such use or imminence of use occurs without the express written consent of the competent national authority of the Member State to which the nation brand relates. Such action shall not be time-barred.

4. For the purposes of this Article, use of a sign shall include the following acts, among others, whether or not they are for profit:

- (a) use in trade;
- (b) use in any medium of communication or dissemination;
- (c) use in advertising or in documents;
- (d) the manufacture of documents, labels, packages, wrappings, packaging or other elements or materials which reproduce or contain a nation brand or similar sign and the marketing or possession of such elements or materials; and
- (e) any use which might indicate a link or association with the protected nation brand.

Article 13. – Precautionary and final measures for the protection of the nation brand

The competent national authority of the Member State in which the infringing uses referred to in Article 12 above are or may be made shall, *proprio motu* or at the request of a party, take the precautionary and final measures provided for in its legislation in the event of action for infringement of distinctive signs.

Finals provisions

Article 14. – Payments and fees

The procedures for the communication and publication of nation brands, and the procedures relating to their enforcement, shall not be subject to any payment of fees or other charges.

Article 15. – Protection resulting from other international instruments

The protection conferred under these arrangements shall not affect the protection which Member States grant to nation brands of other Member States, either as State emblems or as official signs of control and warranty in accordance with Article 6^{ter} of the Paris Convention for the Protection of Industrial Property, or in compliance with international treaties or international agreements which individually bind Member States.

[End of Annex and of document]