

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

**Fortieth Session**  
**Geneva, November 12 to November 16, 2018**

### **SUMMARY OF THE VARIOUS EXAMINATION PRACTICES REGARDING TRADEMARKS CONSISTING OF, OR CONTAINING, COUNTRY NAMES**

*Document prepared by the Secretariat*

1. Following a request from the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), an Information Session on Country Names (see document SCT/IS/CN/GE/18/1) took place on April 24, 2018, in the framework of the thirty-ninth session of the SCT, which was held in Geneva from April 23 to 26, 2018 (hereinafter “the Information Session”). The Information Session took the form of a moderated roundtable, addressing the examination by offices of trademarks consisting of, or containing, country names, and taking into account the perspectives of users.
2. At the end of the thirty-ninth session of the SCT, the Chair “noted the SCT’s satisfaction with the Information Session on Country Names. The Chair requested the Secretariat to prepare a document summarizing the various examination practices regarding trademarks consisting of, or containing, country names, as presented by the panelists at the above Information Session” (see paragraphs 12 and 13 of document SCT/39/10).
3. This document contains the requested summary, which is structured along the steps taken by offices in the examination of signs that consist of, or contain, a country name, as discussed at the Information Session. The summary is divided in three parts: (a) determining whether the sign in the application concerns a country name, (b) refusal of country names as such, and (c) assessing the distinctive, descriptive or deceptive character of the sign.
4. In addition, the panelists at the Information Session discussed the question of country names as elements of a State’s sovereignty or as elements of a country’s goodwill or reputation. This document also summarizes the discussions on this point.

## SUMMARY OF EXAMINATION PRACTICES

(a) Determining whether the sign in the application concerns a country name

5. At the outset of the examination process, offices need to determine whether the trademark application actually concerns a country name. The practices presented in the Information Session showed two approaches to reach that determination: (i) an approach that relies on a pre-defined list of country names, and (ii) an approach that leaves examiners free to use all types of evidence at their disposal.

### *Approach that relies on a pre-defined list of country names*

6. Under this approach, examiners rely on a source, pre-defined by the office, to determine that a name concerns a country name. The source can consist of, for example, a list established and updated by the office, the United Nations Member State list, the Article 6ter database, bilateral agreements between countries, or WIPO standards.

7. Offices which follow this approach consider that the use of an official source for determining that a name is a country name guarantees practice consistency, as well as an equal treatment of all countries.

### *Approach that does not rely on a pre-defined list of country names*

8. In other offices, examiners do not rely on a pre-defined source to determine that a term is a country name. In those offices, examiners may use all types of evidence at their disposal, including searches on the Internet and their own knowledge and culture. Usually, the key question in those offices is that of the primary significance of the term to the average consumer. Examiners in those offices need to evaluate whether or not, in the context of its use in the application, the term will be perceived by the average consumer as a country name. For instance, depending on the context, the same name can be perceived by consumers as a country name, or as a name without any geographic significance (e.g., France is both a country name and a woman's name). In addition, certain terms which are not official country names as such can be perceived by consumers as designating a country and thus having geographic significance (e.g., historical country names, nicknames, adjectives, translations or phrases customarily used to designate a country).

9. Offices following this approach generally consider that practice consistency may be facilitated through regular meetings, information sharing and training of examiners.

(b) Refusal of country names as such

10. In certain jurisdictions, there is a general prohibition to register country names where they are the only element of the sign. In those jurisdictions, once it has been determined that the sign in an application consists of a country name, the office refuses to register the country name, without carrying out any further test as to the distinctiveness of the sign\*.

11. Such general prohibition to register a country name is sometimes based on a specific provision in the law, warranted by the consideration that a country name cannot be owned by an individual undertaking.

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\* In some jurisdictions, such refusal can be overcome, subject to authorization by the competent authority in the country concerned.

12. In general, where the sign contains a country name, together with other elements, the aforementioned offices proceed to evaluate the distinctive, descriptive or deceptive character of the sign as a whole.

(c) Assessing the distinctive, descriptive or deceptive character of the sign

13. As indicated in paragraphs 10 and 12 above, some offices evaluate the distinctive, descriptive or deceptive character of a sign concerning a country name, only where the sign *contains* a country name, together with other elements, but not where it *consists* exclusively of a country name. Other offices carry out such evaluation with respect to all signs consisting of, or containing, a country name.

14. The Information Session highlighted various approaches among offices for evaluating the distinctive, descriptive or deceptive character of a sign that consists of, or contains, a country name; in particular, the Session displayed variations on the role and assessment of the consumer's perception. The approaches are summarized below.

*Distinctiveness*

15. In some offices, signs consisting exclusively of a country name are refused because they are considered insufficiently distinctive. Where the sign does not consist exclusively of, but contains, a country name, there is a higher likelihood that offices may consider it distinctive.

16. In other offices, both signs consisting of, and signs containing, a country name, could be considered distinctive, depending on the consumer's perception and taking into account the goods and services in respect of which protection for the mark is sought. Although it would be exceptional for a sign consisting of a country name alone to be considered distinctive, some offices do not discard that it could under certain limited circumstances, for instance in the case of acquired distinctiveness.

*Descriptive character*

17. Where the sign consists exclusively of a country name and the goods or services originate from that country, descriptiveness will typically constitute a ground for refusal. Where the sign contains a country name, together with other elements, an evaluation of the descriptive character of the sign as a whole is generally made.

18. Some offices evaluate the descriptive character of the sign, whether the sign consists exclusively of, or contains, a country name, taking into account the consumer's perception. Whether the country name is descriptive of the origin of the goods and services or not is therefore determined on a case-by-case basis. For instance, some offices ask themselves the question whether the geographical name could realistically serve as origin of the goods (for example, North Pole for bananas). Other offices, having determined that the sign concerns a country name and that the goods and services originate in it, additionally analyze whether purchasers would be likely to believe that the goods or services originate in the country concerned. Some offices reply to those questions taking into account the situation at the time of the application only, while others consider any possibility that the goods might be produced in the country in the future.

19. With respect to signs containing a country name, together with other distinctive elements, some offices accept to register the mark where the goods come from that country, provided, however, that the list of goods is limited to those which originate in the country. The main purpose of such approach is to avoid the consumer's deception as to the origin of the goods.

20. Other offices consider that a country name is a descriptive element, which needs to be disclaimed, even if combined with other elements in the sign.

21. Some offices have a specific provision on fair use in their laws, whereby the holder of a mark containing a descriptive geographical term cannot prevent others from using that term.

#### *Deceptive character*

22. Where the sign concerns a country name, and the goods or services do not originate from that country, the deceptive character of the sign will typically constitute a ground for refusal.

23. In some offices, the deceptive nature of the sign would be assessed, taking in account the perception of the average consumer as regards the origin of the goods, on a case-by-case basis. In those offices, the fact that the goods do not come from the place does not lead, by definition, to the sign being considered deceptive. This would only be the case if it is determined that (i) the goods do not come from the place, and (ii) purchasers would be likely to believe that the goods come from the place (for instance, where the country name has a reputation for the goods or services in the application). In addition, a third element may be required to conclude that a sign is deceptive, namely (iii) that the inaccurate origin indicated in the mark is a material factor in the consumer's decision to buy the goods or use the services.

#### **COUNTRY NAMES AS ELEMENTS OF SOVEREIGNTY OR AS ELEMENTS OF A COUNTRY'S GOODWILL OR REPUTATION**

24. In concluding the discussions, the question was posed whether countries have a right to their own name. For some panelists, the answer to this question is in the affirmative, which justifies the treatment given to country names by their offices in the examination of trademark applications consisting of, or containing such names. According to this view, the problem with the registration of country names lies not only in the deception which such registration may cause, but also in the monopoly obtained by a private entity, which deprives the country itself from its own name.

25. According to another view, the aforementioned approach does not sufficiently take into account the context of use and the consumer's perception. Under this view, considering that a country name belongs to the country gives rise to an additional question, to which there is no answer at present, namely that of the exact object that belongs to the country (only the official name of the country, or also the country name's variations, nicknames, short forms and translations?).

26. A related question was whether a country name is a core element of a country's goodwill or reputation. The ensuing question is whether countries should be in a position to control the reputation and goodwill linked to their names, by means of internationally recognized mechanisms. Some panelists respond in the affirmative to the latter question. For other panelists, the answer to this question needs to take into account the constitutional realities of countries. In some countries, there is no constitutional power for governments to control the country's reputation or goodwill, but only the ability to regulate consumer's confusion and deception.

## CONCLUSION

27. The Information Session displayed two broad approaches by offices in the examination of country names in trademark applications. In some jurisdictions, country names are treated as a special category of signs, which may be, *per se*, excluded from registration as trademarks. This can be explained, in particular, by the fact that country names are viewed, in those jurisdictions, as elements of the sovereignty of States, which deserve to be protected as such. In other jurisdictions, country names are treated as any other geographical term. They are excluded from registration, insofar only as they lack distinctive character or are considered to be descriptive or deceptive. Typically, the consumer's perception is the key consideration taken into account to determine whether a country name can be registered as a mark or not.

*28. The SCT is invited to consider the present document.*

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