

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

Forty-Third Session
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REVISED PROPOSAL BY THE DELEGATIONS OF GEORGIA, ICELAND, INDONESIA,
JAMAICA, LIECHTENSTEIN, MALAYSIA, MEXICO, MONACO, PERU, SENEGAL,
SWITZERLAND AND THE UNITED ARAB EMIRATES CONCERNING EXAMINATION
GUIDELINES FOR TRADEMARK WHICH CONSIST OF OR CONTAIN COUNTRY NAMES OR
GEOGRAPHICAL NAMES OF NATIONAL SIGNIFICANCE

Document prepared by the Secretariat

In a communication dated February 18, 2020, the Delegations of Georgia, Iceland, Indonesia, Jamaica, Liechtenstein, Malaysia, Mexico, Monaco, Peru, Senegal, Switzerland and the United Arab Emirates transmitted to the International Bureau of the World Intellectual Property Organization (WIPO) the proposal contained in document SCT/43/6.

In a communication dated October 24, 2022, the Delegations of Georgia, Iceland, Indonesia, Jamaica, Liechtenstein, Malaysia, Mexico, Monaco, Peru, Senegal, Switzerland and the United Arab Emirates transmitted to the International Bureau of the World Intellectual Property Organization (WIPO) the revised proposal contained in the Annex to the present document.

[Annex follows]

The delegations of GEORGIA, ICELAND, INDONESIA, JAMAICA, LIECHTENSTEIN, MALAYSIA, MEXICO, MONACO, PERU, SENEGAL, SWITZERLAND and the UNITED ARAB EMIRATES

REQUEST

the SCT to invite the WIPO General Assembly to adopt the following

EXAMINATION GUIDELINES

FOR TRADEMARKS WHICH CONSIST OF OR CONTAIN COUNTRY NAMES OR GEOGRAPHICAL NAMES OF NATIONAL SIGNIFICANCE

1. *Definition of country name*

A country name includes the official or formal name of the State, the name that is in common use, translation and transliteration of that name, the former name of the country, the short name of the State, as well as the name in abbreviated form and as an adjective.

2. *Definition of geographical names of national significance*

Geographical names of national significance include the names of capital cities of States, the names of geographical and administrative regions and the names of UNESCO World Heritage Sites.

3. *Free disposal and fair use exception*

The registration of a trademark consisting solely of a country name or a geographical name of national significance or containing such a name shall not prevent competitors or third parties from using that name to designate the true geographical source of their goods and services.

4. *Non-registrable non-distinctive signs*

- a) An application for a word trademark consisting solely of a country name or of a geographical name of national significance should be rejected.
- b) The office or competent authority may though accept the registration of such a trademark if the trademark, in relation with the claimed products or services, is not likely to be perceived by the public as a country name or a geographical name of national significance. This is for instance the case when the country name as used in the mark is translated or transliterated in a language which is unknown to a large majority of the relevant public.
- c) The office or competent authority may accept the registration of such a trademark if the applicant already owns an identical mark registered in the country of examination for identical or similar goods or services, provided that this trademark is not subject to an invalidity or nullity action.

5. *Non-registrable misleading signs*

- a) An application for a trademark containing a country name or a geographical name of national significance among other distinctive elements shall be rejected where the use of that name renders the trademark as a whole misleading, deceptive or false in relation to the true geographical origin of the goods or services.

- b) The office or competent authority may though accept the registration of such a trademark if that name does not render the trademark as a whole misleading, deceptive or false in relation to the true geographical origin of the goods or services, in particular if
- i. the name as used in the trademark has lost its geographical meaning and is exclusively perceived as a reference to a specific company, or
 - ii. the name as used in the trademark is perceived as a fanciful name and, because of the other elements of the sign and in connection with the goods and services claimed, this meaning prevails over its geographical meaning, or
 - iii. the country name as used in the trademark is translated or transliterated in a language which is unknown to a large majority of the relevant public, or
 - iv. a condition or limitation figures on the registration of the trademark, to the effect that the trademark shall only be used in relation to goods and/or services which originate in the country identified by the trademark;
 - v. the products or services do likely originate from the place designated in the trademark.

6. *Invalidation and opposition procedures*

The grounds for refusal outlined in guidelines 4 and 5 above should constitute grounds for invalidation of registered trademarks, and where the applicable law so provides, also grounds for opposition to the registration. The State which is identified by a country name or a geographical name of national significance, or a legal person authorized by the relevant State, shall be entitled as an interested party to oppose the registration of a mark or request its invalidation on the grounds outlined in guidelines 4 and 5 above.

7. *Use of existing official lists*

In the course of examination, examiners may refer to the following official lists:

- i. the list of Country Names established by the United Nations Group of Experts on Geographical Names (UNGEGN)¹;
- ii. the name of capital cities contained in the Geographical Names Database of the UNGEGN²;
- iii. the ISO 3166-2 list concerning regions³; and

¹ As approved by at the UN Conference on the Standardization of Geographical Names on Country Names. This conference takes place every 5 years. The most recent list of country names has been approved at the Eleventh Conference in August 2017. It is available as E/CONF.105/13 here:

https://unstats.un.org/unsd/geoinfo/ungegn/docs/11th-uncsgn-docs/E_Conf.105_13_CRP.13_15_UNGEGN%20WG%20Country%20Names%20Document.pdf

² <https://unstats.un.org/unsd/geoinfo/geonames/>

³ ISO 3166 is the International Standard for country codes and codes for their subdivisions established by the International Organization for Standardization (available at <https://www.iso.org/iso-3166-country-codes.html>).

- iv. the list of sites forming part of the cultural and natural heritage ("World Heritage List") under the Convention concerning the Protection of the World Cultural and Natural Heritage⁴.

[End of Annex and of document]

⁴ Convention concerning the Protection of the World Cultural and Natural Heritage adopted on 23 November, 1972, under the auspices of the United Nations Educational, Scientific and Cultural Organization (UNESCO).