

Superintendency of Commerce and Industry

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Ms. Wang Binying

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Dear Ms. Binying,

In response to your kind invitation to comment on the proposal presented by the Delegation of Jamaica at the thirty-first session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) in Geneva from March 17 to March 21, 2014, entitled: "Draft Joint Recommendation for the Protection of Country Names", we are pleased to transmit to the Secretariat the comments of the Superintendency of Industry and Commerce on the subject.

We consider that the Paris Convention is clear as to the difference between three different situations, viz.:

- i. It is impossible to register marks which lack distinctiveness, may be misleading, or infringe the rights of third parties. This reasoning is based on the protection of individuals, as well as trademark owners and consumers in their right to acquire transparent goods.
- ii. It is impossible to register trademarks that reproduce official seals and names of countries. As it can be understood, this rule is not intended to protect special or private rights; its sole justification springs from the intention to make clear that the names of countries or official seals cannot be trademarks and therefore cannot be included by anyone in a registered mark, and there are no exceptions regarding the accuracy or imaginativeness of the sign.
- iii. There is an obligation to be truthful when indications of source are used.

The Paris Convention does not confer on indications of source the same scope as on other Industrial Property Rights, except that in light of the *raison d'être* of the Convention (which was

the discrepancy between the business and geographical origin of some products) and its goal of preventing unfair competition, the only restriction on indications of source is that they should not be false, which means that they can be used by anyone. In accordance with the definition adopted by WIPO, indications of source were not created to register the name of a country, or to grant exclusive rights over the name to individuals. For this reason, we cannot view the two situations as equivalent.

However, they cannot be understood as a general exception to the inclusion of the name of a country in a trademark registration, unless, as noted in TRIPS, in the exceptional situation in which a geographical indication, be it a collective mark, certification mark, geographical indication or appellation of origin, is the country name.

In conclusion:

- We support the initiative of Jamaica, given the concerns and the reality in terms of the lack of protection of country names in the trademark registration stages that include them.
- We take the view that the proposed joint recommendation might include the following considerations:
 - o Country names should not be included in a trademark registration, regardless of whether the goods or services identified by the mark have their origin in the country depicted. The reason for this exclusion is not given for accuracy of information; among other things, the brand can be sold or transferred subsequently to a person who is not a national of the country depicted, or the products may not originate from that country.
 - o Perhaps the only exception could be the case of collective marks, certification or appellations of origin, to avoid conflation with all the marks discussed above.
 - o Consistent with the foregoing, we believe that a country brand, which is not legal concept, but rather a trend, should be viewed as a State strategy or campaign to support its businesses and products, which falls within the concept of collective or certification mark, and even an appellation of origin. Therefore, we believe that its inclusion in the proposal as drafted is anti-technical.
 - o We call for increased protection of country names and for their exclusion from trademark registrations. It is not proper to grant permission in case of a disclaimer by the applicant since, as a first step, no individual should ever be able legitimately to claim such a right, given that even if a waiver allows the use of a country name in products to be marketed (by way of a geographical indication), the intention is certainly not that this will become necessary in the registry.

Kind regards,

Maria José Lamus Becerra
Director of Distinctive Signs