



European Communities Trade Mark Association

13 January 2017

## **ECTA COMMENTS ON SCT/35/4:**

# **‘PROTECTION OF COUNTRY NAMES AGAINST REGISTRATION AND USE AS TRADE MARKS PRACTICES, APPROACHES AND POSSIBLE AREAS OF CONVERGENCE’**

### **INTRODUCTION**

This document contains examples and/or general remarks about the consistency of the case-law and practice in various countries with the principles expressed in the ‘Possible Areas of Convergence’ concerned, i.e. No. 1 (Notion of Country Name), No. 2 (Non-registrable if Considered Descriptive), No. 5 (Invalidation and Opposition Procedures) and No. 6 (Use as a Mark).

Comments refer to all EU trademark jurisdictions with the exception of Latvia and Slovakia, and they additionally cover the EUIPO’s practice. Also, we have gathered feedback regarding Paraguay, Switzerland and Turkey.

The first instance examination decisions of numerous Intellectual Property Offices (IPTO) are not published and it is thus difficult to retrieve exact practical examples of how the principles covered by the four “Possible Areas of Convergence” are applied. In such cases, the doctrine or professional experience of trademark practitioners can shed some light on the national offices’ approach to registrability issues.

The approach of the respective offices and the judiciary can also be inferred, e.g. from decisions involving trademarks consisting of a country name among other elements (covered by ‘Possible Area of Convergence No. 4’) which, in some countries, appear to be the only available examples. If in a given country signs that consist of a “COUNTRY NAME + device / descriptive element” are, as a matter of recurrent practice, refused registration, no different outcome can, of course, be expected for signs consisting solely of a country name. For this reason, we have also included such case-law in this document.

In addition, in some cases the names of countries can be protected as GIs. This is so, for example, for ‘CAFÉ DE COLOMBIA’ or ‘ESTONIA’ (liquors). If the names of countries are protected as PDO/PGIS/GIS, then the only peculiarity is that the corresponding GI rules will have to be applied. This represents an additional potential ground for refusal against trade marks incorporating or evocating such country names.

## COMMENTS REGARDING THE APPLICABLE LEGAL PROVISIONS, CASE-LAW AND PRACTICE IN THE VARIOUS JURISDICTIONS.

### 1) Austria

Under Austrian Law trade marks consisting solely of 1) official or formal name of the State (e.g. 'ITALIA'), 2) their translations (e.g. 'ITALY'), as well as 3) the form as an adjective (e.g. 'ITALIANO') will be refused or may be invalidated if they may serve in trade to designate the geographical origin of the goods or service. Any interested party may file an administrative action for invalidation of such a trade mark.

The respective provisions of the Austrian Trade Marks Act are:

*Section 4(1)4: "Excluded from registration are signs which (...) (4) consist exclusively of signs or indications which may serve, in trade, to designate the kind, the quality, the quantity, the intended purpose, the value, the geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service."*

*Section 33(1): "The cancellation of a mark for ex-officio reasons may be demanded by anyone."*

### 2) Benelux

Under Benelux law (the Benelux Treaty on Intellectual Property – BTIP) trade marks consisting solely of 1) the official or formal name of a State (e.g. 'ITALIA'), 2) their translations (e.g. 'ITALY'), as well as 3) the form as an adjective (e.g. 'ITALIANO') may be refused by the Benelux Office for Intellectual Property or may be invalidated by the Belgian, Dutch or Luxembourg Courts (depending on which Court has jurisdiction) if they may serve in trade to designate the geographical origin of the goods or service. Any interested party may file a Court action for invalidation of such a trademark.

The respective provisions of the BTIP are:

*Article 2.11.1.c: "the Office shall refuse to register a trade mark if, in its opinion (...) the trade mark consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or performance of the service, or other characteristics of the goods or services."*

*Article 2.28.1.c: "Any interested party, including the Public Prosecutor, may invoke the invalidity of (...) the registration of a trade mark which consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or performance of the service, or other characteristics of the goods or services."*

In the Benelux it is not possible to file an opposition against a trade mark on the account of its descriptive character of the place of origin of the goods or services.

### 3) Bulgaria

Under Bulgarian law there is no special provision explicitly establishing a ground of refusal / invalidity of country names, as opposed to specially protected emblems and the national flag.

Article 11 of the Law on Marks and GIs, reads as follows:

*“Absolute grounds for refusal of registration: (iv) marks which consist exclusively of signs designating the kind, quality, quantity, intended purpose, value, geographical origin, time or process of production of the goods or the manner of rendering of the services, or other characteristics of the goods or services; (vii) marks which may deceive the consumers as to the nature, quality or geographical origin of the goods or services.”*

A trade mark may be cancelled ex-officio and third parties may file objections upon publication of the mark, on the grounds of Article 11 cited above.

There are no registrations on the database of the BPO for trade marks consisting solely of country names “Bulgaria”, “Bulgarian” or “БЪЛГАРИЯ”. There are “protected trade marks” which cover the names “Bulgaria / Bulgarian”, “България”, which are solely held and used by governmental institutions of the Republic of Bulgaria. Any trade mark application applied for by a Bulgarian entity / an applicant with a clear connection to Bulgaria, like local production / manufacturing / provision of services, and comprising the term “Bulgaria” may be allowed to proceed to registration with a disclaimer on the word “Bulgaria”.

Country names are commonly registered as trade marks in combination with other distinctive term(s). The following examples are trade marks considered as non-descriptive that have been registered by the BPO:

- ‘GAZPROM BULGARIA’, registered in classes 1 and 42;
- ‘AMAZING BULGARIA’, registered in classes 39, 41 and 43;
- ‘BULGARIAN ONLINE’, registered in class 16.

### 4) Croatia

Under Croatian law there are no specific provisions prohibiting the registration of country names as trade marks, except for the name “Croatia“ / “Hrvatska“.

Absolute grounds for refusal in accordance with the Art. 5 of the Croatian Trade Mark Law regarding the name of the country and geographical origins, are as follows:

*“The following shall not be registered (...) 3. signs which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of providing of the service, or to designate other characteristics of the goods or services; (...) 7. signs which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services; (...) 9. signs for wines which contain or consist of geographical indications identifying wines and signs for spirits which contain or consist of geographical indications identifying spirits with respect to such wines or spirits not having that geographical origin; 10. signs, which contain the name or abbreviation of the name, national coat of arms, emblem, flag or other official sign of the Republic of Croatia, or a part thereof, and the imitation thereof, except with the authorization of the competent authority of the Republic of Croatia; 11. signs which contain or consist of designations of origin or geographical indications, in effect in the territory of the Republic of Croatia, if a request for the registration of a trade mark has been filed after the filing date of a request for the registration of a designation of origin or a geographical indication within the scope provided by legislation, by virtue of which such designations are registered, and which refer to the same type of products and services.”*

The official title of the Republic of Croatia, its emblem and its flag, as well as the national anthem (in case of sound trade marks) are excluded from registration as trade marks, except with special authorizations.

## 5) Cyprus

Under Cyprus law there are no specific grounds of refusal / cancellation with respect to trade marks consisting of country names. However, pursuant to the Cyprus Trade Marks Law (Cap 268) Article 11(1)(C), a trade mark will not be registered or if registered it may be cancelled if:

*“it consists exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods or of the provision of the services or of other characteristics of the goods or services.”*

Furthermore, pursuant to the Cyprus Trade Mark Regulations:

*“For trade marks consisting of, amongst others, distinguishing signs or flags of any state, city, municipality or village location, the Registrar of Trade Marks may request, prior to proceeding with the registration of such a trade mark, to be provided with a consent to its registration by any official or other person who the Registrar of Trade Marks considers as being competent to provide such a consent. In the case where the above consent is not provided then the Registrar of Trade Marks may refuse to register the trade mark.”*

## 6) Czech Republic

Under Czech law word marks consisting solely of the name of a country are, according to the present practice, considered non-distinctive. Such trade marks have been refused ex-officio while trade marks that contain other distinctive elements in addition to country name(s) are usually registrable.

The following legal means are 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: a) filing a request for invalidation of the trademark with the IPO; b) filing a legal action prohibiting use of a trade mark that is deceiving an average consumer regarding the origin of goods or services. Such use is considered as an unfair competition act.

## 7) Denmark

Under Danish practice (PTO's guidelines) country names will, as an overall rule, be refused registration on absolute grounds by the PTO considering such country names as being descriptive according to the Danish Trade Marks Act §13 (2)(i). As an exception, trade marks consisting of a country name covering some limited services which may not normally be offered across country borders, such as a hairdressing salon, might be accepted for registration.

The Boards of Appeal has considered the above practice of the PTO in the matter of the trademark application for the following country name:

- 'TOGO' for goods in class 30 (decision No. AN200800005 – application No. VA 2006 05209).

In this case the PTO refused registration of the mark and the decision was upheld by the Boards of Appeal.

In 2000, the Danish PTO refused registration of:

- 'DANMARK' (Denmark in Danish) for goods in class 16 (application No. VA 1999 00840),

referring to the mark as being descriptive.

In 2010, the Danish PTO refused registration of:

- 'NZ' for goods in class 33 (application No. VA 2009 01459),

referring to the mark being descriptive since "NZ" will be perceived as the country code for New Zealand. Hence, the consumer will understand that the goods originate from New Zealand.

In 2014, the Danish PTO refused registration of:

- 'DANNEVANG' for goods in class 31 (application No. VA 2013 02970),

considering the mark being descriptive, since "Dannevang" is a synonym for Denmark.

## 8) Estonia

Under Estonian law there are no separate rules which would prohibit the protection of country names as trade mark and such signs are examined based on the general absolute and relative grounds of refusal.

Under the old Trade Mark Act (effective until 30 April 2004), the disclaiming part(s) of a trade mark were established at any event as a result of ex-officio examination and such details can be viewed in the trade mark records (e.g. if country name being just part of a trademark, e.g. "COUNTRY NAME & Design"). Under the new Trade Mark Act (effective as of 1 May 2004), the disclaiming parts are established only in case of doubt of scope of protection of a trade mark.

A search on the official database did not reveal any refused trade marks consisting solely of a country name "ESTONIA" or "EESTI" (in Estonian). Only one word mark solely containing the element "ESTONIA" has being registered (Reg. No. 38636) for "*pianos*" in class 15. However, the fact that pianos under the trade mark "ESTONIA" are very well-known in this country might have impacted the registrability of this expression as a trade mark.

Trade marks consisting solely of country names would therefore likely be refused by the Estonian Patent Office based on the absolute grounds (e.g. non-distinctive, descriptive), unless the acquired distinctness or well-known status of these trade marks by the filing date could be shown and proved. Such position could be supported by the fact that the Board of Appeals has passed, for instance, the decision No. 1622-o of 30 June 2016 where the applicant appealed the Estonian Patent Office's decision to refuse the registration of the trademark "RALLY ESTONIA" in classes 25 and 41 (Appl. No. M201000839), since the Office had found the trade mark being descriptive and non-distinctive in relation to goods and services in question.

## 9) EUIPO

Under EUIPO's practice and the EU trade mark law no general ground for refusal exists in relation to the names of states or countries. They fall into the category of geographical names whose capacity to serve as trade marks must be examined in relation to the list of goods and services claimed (decision of the First Board of Appeal of September 30, 2002, Case No. R691/2000-1, "*Greenland*").

The notion of country names, along with other geographical terms, is interpreted broadly and encompasses, e.g. forms as an adjective (see: judgment of the Court of First Instance of 15

October 2003, Case No. T-295/01, “Oldenburger”) and even outdated terms such as “Ceylon” or “Bombay”. What is relevant is whether such terms are commonly used or generally understood by consumers as a designation of origin. If this is the case, the extended notion of a country name under the ‘Possible Area of Convergence No. 1’ is in line with the EUIPO’s practice.

Trade marks consisting solely of a country name should be refused by the EUIPO where the use of that name is descriptive of the place of origin of the goods or services (‘Possible Area of Convergence No. 2’). According to Article 7(1)(c) of Council Regulation (EC) No. 207/2009 on the European Union trademark which provides for absolute grounds for refusal:

*“The following shall not be registered: (...) (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate (...) geographical origin (...) of the goods or of rendering of the service (...).”*

The descriptive character of a country name may relate to the place of production of the goods; the subject matter of a good (e.g. the country a travel guide is about); the place where the services are rendered; the kind of cuisine (e.g. for restaurants); or the place that influences consumer preferences (e.g. lifestyle) by eliciting a favorable response. The assessment must be made with reference to the claimed goods and services and with reference to the perception by the relevant public.

The registration of country names as trade marks is not possible where such countries are either already famous or known for the category of goods / services concerned, and the following factors should be taken into account: the degree of familiarity of the relevant public with the geographical term (such as a country name), the characteristics of the place designated by the term, and the category of goods or services (judgment of the Court of 4 May 1999, Case No. C-108/97 and C-109/97, “Chiemsee”)

It is not necessary to establish that the name actually designates the true geographical origin of the goods or services. It is enough to demonstrate that the connection between the name of the place and the goods / services may enable the relevant public to perceive the contested sign as an indication of the origin of those goods (judgment of the Court of First Instance of 15 October 2003, Case No. T-295/01, “Oldenburger”). For example, “SWITZERLAND” should be refused for financial services (EUIPO’s “Guidelines”, part B, Section 4, p. 60).

Also, the registration of geographical names as trade marks is not possible where such a geographical name is liable to be used by undertakings and must remain available to such undertakings as indications of the geographical origin of the goods and services concerned. With regard to a reasonable future association, a refusal cannot be based solely on the argument that the goods or services can theoretically be produced or rendered in the place designated by the geographical term (judgment of the Court of First Instance of 8 July 2009, Case No. T-226/08, “Alaska”).

Finally, country names may be refused merely because of their widespread recognition and fame for the high quality of their goods or services. In such cases no detailed assessment of the association between the place and the goods and services is necessary (judgment of the General Court of 15 December 2011, “*Passionately Swiss*”).

Article 7(1)(c) does not, on the other hand, preclude the registration of geographical terms, such as country names, which are unknown to the relevant public – or at least unknown as the designation of a geographical location – or of names in respect of which, because of the type of place they designate, the public is unlikely to believe that the category of goods or services concerned originates there or was conceived there (see: judgement of the General Court of 15 January 2015, Case No. T-197/13, “*Monaco*”).

Country names that are merely allusive or fanciful should thus not be objected to on this basis. The same applies to the fashionable use of country names for goods and services unrelated to what the country is known for. Whether or not this is the case will be determined by taking as a basis a reasonably well-informed consumer who has sufficient common knowledge but is not a specialist in geography. For an objection to be raised, the Office must prove that the geographical term is known by the relevant public as designating a place.

The following marks consisting solely of country names have been considered distinctive and thus registered as European Union trade marks:

- ‘MONACO’ in relation to, *inter alia*, “*jewelry and watches*” in cl. 14, “*bags*” in cl. 18, “*clothing*” in cl. 25, “*toys*” in cl. 28, “*services for providing food and drink*” in cl. 43 (International registration No. 1069254 designating, *inter alia*, the EU, dating back to 2010);
- ‘FINLANDIA’ in relation to, *inter alia*, “*mirrors*” in cl. 20 and “*advertising*” in cl. 35 (registration No. 007555519 dating back to 2009);
- ‘COLUMBIA’ in relation to, *inter alia*, “*meat*” in cl. 29 and “*spices*” in cl. 30 (decision of the Fourth Board of Appeal of March 26, 2008, Case No. R529/2006-4 – registration No. 004084364 dating back to 2004);
- ‘GREENLAND’ in relation to, *inter alia*, “*meat*” in cl. 29, “*chocolate*” and “*milk*” in cl. 30 and “*fresh vegetables and fruits*” in cl. 31 (decision of the First Board of Appeal of September 30, 2002, Case No. R691/2000-1 – registration No. 001022474 dating back to 1998);
- ‘SUDAN’ in relation to “*dyes and colorants for coloring and marking mineral oil*” in cl. 2 (decision of the Second Board of Appeal of February 6, 2002, Case No. R0594/1999-2 – registration No. 000156067 dating back to 1996).

The following signs, consisting solely of country names, have been considered descriptive and thus refused registration as European Union trade marks:

- 'BRASIL' in relation to, *inter alia*, "beers" in class 32 and "whisky" in class 33 decision of the First Board of Appeal of 6 February 2014, Case No. R0434/2013-1, application No. 011246238 dating back to 2012);
- 'MONACO' in relation to "magnetic data carriers" in cl. 9, "books made from these materials [paper and cardboard], not included in other classes; printed matter; photographs" in class 16, "transport; travel arrangement" in cl. 39, "entertainment, sporting activities" in cl. 41 and "temporary accommodation" in cl. 43 (Judgment of the General Court of 15 January 2015, Case No. T-197/13 – International registration No. 1069254 designating, *inter alia*, the EU, dating back to 2010);
- 'FINLANDIA' in relation to, *inter alia*, "furniture" in cl. 20 (OHIM's decision of June 18, 2009 – application No. 007555519 dating back to 2009);
- 'POLONAISE' in relation to, *inter alia*, "alcoholic beverages" in cl. 33 (OHIM's decision of 27 June, 2007 – application No. 005129861 dating back to 2006);
- 'DANIA' in relation to, *inter alia*, "beers" in cl. 32 and "coffee" in cl. 30 (OHIM's decision of 29 July 2005 – application No. 004085577 dating back to 2004);
- 'GERMANIA' in relation to, *inter alia*, "transport services" in cl. 39 (decision of the First Board of Appeal of 21 June 2006, Case No. R1253/2005-1 – application No. 003296282 dating back to 2003);
- 'GREENLAND' in relation to, *inter alia*, "fish" and "seafood" in cl. 29 (decision of the First Board of Appeal of 30 September, 2002, Case No. R 691/2000-1 – application No. 001022474 dating back to 1998);
- 'ICELAND' in relation to, "knitwear" in cl. 25 (OHIM's decision of 11 November, 1998 – application No. 000360032 dating back to 1996);

As far as 'Possible Area of Convergence No. 5' the following considerations apply.

The grounds for refusal described in 'Possible Areas of Convergence' No. 2 ("non-registrable if considered descriptive") and No. 3 ("non-registrable if considered misleading, deceptive or false"), also in the light of the Area No. 4 ("consideration of other elements of the mark") constitute grounds for invalidity of registered marks, according to Article 52 of Council Regulation (EC) No. 207/2009. These grounds cannot be relied upon in opposition proceedings but they may constitute grounds for third party observations as prescribed by Article 40 of the Regulation:

*"Any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or consumers may submit to the Office written observations, explaining on which grounds, under Articles 5 and 7, the trade mark should not be registered ex officio."*

As far as 'Possible Area of Convergence No. 6', legal means 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 are dealt with by the authorities of the Member States.

## 10) Finland

Under Finnish law any interested party may oppose or initiate cancellation procedure both based on absolute and relative grounds.

A search on the Finnish Trade Mark Register did not reveal trade marks that only consist of the country name "Finland" or the Finnish corresponding expression "Suomi". There appear to be approximately 550 various trade marks that include the word "FINLAND" and approximately 180 various trade marks incorporating the word "SUOMI" (all the marks – both valid applications and registrations and non-valid marks e.g. removed from the register based on rejection, owner's request etc.). These marks are either composed of several word elements including the country name or of a composition of figurative elements.

However, it used to be a practice at the Finnish Trade Mark Office to refuse registration of any trade mark that merely indicated a geographical location as an absolute bar to registration (e.g. indication of a place where the product is manufactured or coming from, risk of misleading the consumers about the geographic origin of the products or services). Nowadays the Office would assess each case separately whether the products and services in the particular trade mark are e.g. actually misleading or not.

## 11) France

Under French law, a geographical name (including a country name) can constitute a valid trade mark (see Article L.711-1 of the French Intellectual Property Code).

However, to be registered, such sign (composed of a country name only) must not be descriptive or deceptive or liable to mislead the public in particular as regards the geographical origin of the goods or services. These conditions are absolute grounds of invalidity.

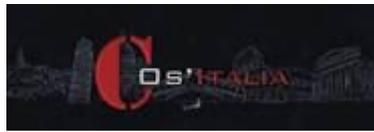
Generally, the registration of a mark consisting solely of a country will be rejected by the French Trade Mark Office (FTO). For example, recently, the FTO refused the registration of the French trade mark application for

- 'MOROCCO' filed by the French company Yves Saint Laurent to designate goods in classes 9, 14, 18 and 25.

The FTO considered that this trade mark application is devoid of any distinctive character and is likely to mislead the public regarding the origin of the goods covered (FTO, decision of 28 April 2009). Yves Saint Laurent filed an appeal against this decision before the Paris Court of Appeals. The Court of Appeals upheld the FTO's decision considering that the

French consumers will be able to translate the English word “MOROCO” into the French word “MAROC”, and will legitimately think that the goods designated under the “MOROCO” denomination come from Maroc (Paris Court of Appeals, decision dated 7 April 2010). If the filing of the trade mark application is considered admissible by the FTO, the registration of this application can also be contested by a prior owner (via an opposition action) or any interested person (by filing observations before the FTO) within two months of the publication of the application.

In practice, to be registered, a country name must be included in a more complex sign, i.e., with other elements (such as figurative or word elements). For instance, the FTO did not refuse the registration of the following French trade marks:



- 'COS ITALIA' - application No. 16.4.311.327 (cl. 16, 29, 30, 35 and 43);
- *Saveurs d'Allemagne* - application No. 16.4.257.152 (cl. 29, 30, 32 and 33);
- *Objectif USA* - application No. 15.4.148.152 (cl. 35, 36, 41 and 45).

Regarding the legal means available in France, it is possible to file an infringement action, an unfair competition action or a civil action for misleading trade practices before the French Courts in order to contest the use of a country name if such use is likely to deceive the public. These actions can be initiated by anyone having a legitimate interest.

## 12) Germany

Under German Law, refusal and invalidation apply to trade marks consisting solely of 1) official or formal name of the State, 2) their translations, as well as 3) the form as an adjective, which may serve, in the course of trade, to designate the geographical origin of the goods or service.

Anyone can request a cancellation proceeding against such trade marks before the German Patent and Trade Mark Office (administrative proceeding). However, if a German trade mark was registered for ten years or more, the cancellation request is no longer possible.

Furthermore, indications of geographical origin (including country names) are considered as “other rights” under German Trade Mark Law. A proprietor of an earlier indication of geographical origin or third parties listed in Sec. 8 (3) of the German Act Against Unfair Competition (i.e. competitors, chambers of Industry and Commerce or Craft Chambers, associations with legal personality which exist for the promotion of commercial or of independent professional interests, other specific qualified entities) can file a cancellation claim against the (younger) trade mark registration before court (court proceeding), provided

the “other right” entitles to prohibit the use of the registered trade mark in the entire territory of the Federal Republic of Germany.

The following provisions of the German Trade Mark Law are relevant:

*Section 8 (2) (Absolute obstacles to protection): “The following trade marks shall be excluded from registration (...) 2. which consist exclusively of signs or indications which may serve, in the course of trade, to designate the nature, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the services or to designate other characteristics of the goods or services (...).”*

The above, however, does not apply,

*“if, prior to the point in time of the decision on registration, the trade mark has become established in the trade circles involved as a result of its use for the goods or services for which the application was filed.” (Section 7 (3) ) of the German Trademark Act.”*

Also, Section 37 (1) (Examination for absolute obstacles to protection) expressly provides that a trademark, which is excluded from registration in accordance with section 8 of the German Trademark Act (see above) “*the application shall be refused.*”

Section 13 (Other earlier rights) provides that:

*“(1) The registration of a trade mark may be cancelled if another person has acquired another right ... prior to the date material to the seniority of the registered trade mark, and this entitles him/her to prohibit the use of the registered trade mark in the entire territory of the Federal Republic of Germany. (2) The other rights within the meaning of subs. 1 shall include in particular: (...) 5. indications of geographical origin.”*

Section 50 of the German Trade Mark Act (Invalidity because of absolute obstacles to protection) [administrative proceeding] provides the right to cancel a trade mark, solely consisting of a country name, by any third party, as it provides that:

*“(1) The registration of a trade mark shall be cancelled on request because of invalidity if it has been registered in contravention of sections ... 8.”*

However, there are exceptions according to Section 50 (2) of the German Trade Mark Act:

*“(2) If the trade mark has been registered in contravention of sections .... 8 subs. 2 Nos. 1 to 9, the registration may only be cancelled if the obstacle to protection still exists at the time of the decision on the application for cancellation. If the trade mark has been registered in contravention of section 8 subs. 2 No. 1, 2 or 3, the registration may furthermore only be cancelled if the application for cancellation is lodged within ten years since the date of registration.”*

The last sentence provides a special protection for proprietors of German trade marks, which are registered for ten years and more: they cannot be cancelled any longer, when referring to some specific absolute grounds (in Sec. 8 (2) 1. to 3.), including trade marks consisting exclusively of a country name.

Section 51 (Invalidity because of the existence of earlier rights) [court proceeding] says that:

*“(1) The registration of a trade mark shall be cancelled in response to an action because of invalidity if it is opposed by a right within the meaning of sections... 13 with older seniority.”*

As far as the case-law, please consider the following decisions of the German Federal Patent Court (two of them have the opposite result, however):

- ‘DEUTSCH’ - (27W(pat)544/12 of 26.03.2013) where the court refused registration of the trademark “deutsch” (however, plus device element of cow) for several of the claimed goods/services, arguing – among others – that the word element “deutsch” serves to designate the geographical origin of these goods/services;
- ‘ST. LUCIA’ - (25W(pat)132/09 of 04.02.2010) where the court regarded the word mark “St. Lucia” to be registrable for “tea” in class 30. The court found that the sign “St. Lucia” may not serve to designate the geographical origin of tea, as the Caribbean island state “St. Lucia” appears not to produce tea and “St. Lucia” is also the name of around 600 designations, churches and other objects;
- ‘KUBA’ - (32W(pat)228/03 of 26.10.2005) where the court allowed registration of the word mark “KUBA” (German writing of Cuba) for the specific services of class 41 “operating of museums (performance, exhibitions) in the area of sound furniture”. The court argued in 2005 that - due to the economic embargo against Cuba and Cuba’s extremely low economic situation - it is rather unlikely that the German public believes that the origin of these services is in Cuba.

There are cases regarding trade marks consisting solely of an island or city name or of a geographical area name (as being part of a country/State), e.g.:

- ‘KOPENHAGEN’ – the German Federal Patent Court (court ref. 26W(pat)552/11) ruled on 26.03.2014 that the German word mark “KOPENHAGEN” is not allowed for registration, among others, for goods in class 20. The court argued that the mark is a designation which may indicate the geographical origin of the claimed goods;
- ‘OXFORD’ – the German Federal Patent Court (26W(pat)556/11) decided on 26.03.2014 that the German word mark “OXFORD” is not registrable, among others, for goods in class 20, saying that the sign is a designation which may indicate the geographical origin of the claimed goods;

- 'SPEICHERSTADT' – the German Federal Patent Court (24W(pat)076/08 on 04.05.2010) did not allow registration of the word mark "Speicherstadt" in classes 3-5, 9, 14, 16, 18, 20, 21, 25, 26, 28, 30, 32-36, 41, 43. The court considered the sign to indicate the geographical origin, as "Speicherstadt" is the name of an (at least in Germany) famous old part at the harbor area of the city Hamburg).
- 'LEMBERGERLAND' – in cancellation proceeding filed by a third party, the German Federal Patent Court (court ref. 26W(pat)068/13) found on 30.04.2014 that the German word mark application "Lembergerland" (which was not yet registered) is not registrable for "alcoholic beverages (except beer)" in class 33, as the word "Lemberger" is the name of a vine variety and therefore descriptive for wine. Furthermore, the word "Lembergerland" is considered to be a geographical indication, referring to a geographical area in a specific part of Germany. Furthermore, the trademark is non-distinctive, merely indicating that the wine is made from wine grown in Lembergerland. Therefore, the trade mark application was not allowed for registration.

### 13) Greece

Under Greek law, according to Article 123 par. 3a of Trade Mark Law 4155/2013 "*country names, (...) are not registrable as trade marks*". Consequently, with regard to trade mark applications consisting solely of a country name (either in the local language or in translation, e.g. "GREECE" or "HELLAS" or "ΕΛΛΑΔΑ" or "ΕΛΛΑΣ" etc.) the law explicitly provides for an absolute ground for refusal.

This provision is not necessarily connected with other absolute grounds for refusal such as descriptiveness or deceptiveness with regard to specific goods and/or services. It is noteworthy that this provision is applied by the Examiner even in cases where a country name is combined with another word-part lacking the minimum degree of distinctive power (see below).

In case a country name is filed in conjunction with another word-part or a pictorial part prevailing case-law tends to reject the majority of such applications on absolute grounds, in particular as an indication of origin of G/S or as a misleading indication with regard to the origin of G/S which are not connected with the involved country. However, there is a minority of Examiners' decisions by virtue of which composite trademark applications are accepted for registration despite the explicit inclusion of a country name in the word-part of the mark.

The following case-law is worth considering:

#### Rejected trade mark applications:

- 'SPIRIT OF GREECE' – application No. 220.113 / 28.2.2013 (cl. 29);
- 'GREECE FORWARD' – application No. 220.673 / 9.4.2013 (cl. 16, 35, 39, 41, 43);

- 'NEW GREECE and device' – application No. 222.282 / 24.7.2013 (cl. 16);
- 'KEEP CALM AND GO TO GREECE' – application No. 224.221 / 18.12.2013 (cl. 40);
- 'GR WORLD' – application No. 224.927 / 11.2.2014 (cl. 38, 42).

#### Accepted trade mark applications:

- 'NATURA GRECA GREEK ART HOUSE and device' – application No. 221.560 / 10.6.2013 (cl. 3, 30, 33);
- 'ENTERPRISE GREECE INVEST & TRADE' – application No. 225.810 / 4.4.2014 (cl. 35, 36, 41, 42, 45);
- 'ACT4GREECE and device' – application No. 236.022 / 5.2.2016 (cl. 35, 36);
- 'GRECO GREEK MUSIC BAR' – application No. 224.931 / 11.2.2014 (cl. 41, 43).

With regard to accepted trade mark applications despite the inclusion of a formal country name, any third party showing a legitimate interest may file a petition for invalidity at the Administrative Trade Marks Committee. Furthermore, by means of a civil action before the National Community Trademark Courts (Athens, Thessaloniki), any third party showing legitimate interest may request, among others, the prohibition of use of such a trademark invoking e.g. the deceptive character of the challenged mark or circumstances of unfair competition.

## **14) Hungary**

Under Hungarian law, the registration of trade marks consisting solely of country names may be refused for two reasons: a) being descriptive for the geographical origin of the goods or services; b) being deceiving for the consumers.

According to the Article 2(2)(a) of the Hungarian Trade Marks Act:

*“A sign shall be refused trade mark protection if it is not capable for making a distinction, in particular, if it consists exclusively of signs or information which may serve, in commercial circulation, to designate the type, quality, quantity, intended purpose, value, geographical origin, time of production or fulfilment, or any other characteristic of the goods or services, or which are permanently and customary used in colloquial language, or in trade practices”*

Furthermore, Article 3(1)(b) provides that:

*“A sign may not enjoy trade mark protection, if (...) it is suitable for deceiving consumers with regard to the type, quality, geographical origin or other characteristic of the goods or services”.*

These are absolute grounds of refusal which are examined by the Hungarian Intellectual Property Office (HIPO) ex-officio before the publishing of the application.

Only one case of a trade mark consisting solely of a name of country (in a translated form) can be found on the database of the Hungarian Intellectual Property Office ('HUNGARIA' – application No. M0902277); it was applied for goods in class 25 and services in class 35 and the application proceedings have terminated due to the withdrawal of the application.

If any third party wishes to prevent the use of the country name as trade mark / trade name which is likely to deceive the public or descriptive as to the geographical origin of the goods or services, he may initiate invalidation proceeding before the Office based on the above absolute grounds. It is available for any interested party:

*Art. 33(1)(a) – “A trade mark shall be invalidated if the subject of trade mark protection did not meet the conditions of the registration specified [in the Act].”*

*Art. 35(1) “Trade mark protection shall terminate, if as a result of its use, the trade mark has become liable to mislead, in particular in respect to the nature, quality or geographical origin of the goods or services.”*

As regards the legal means to prevent the use of country names if such use is likely to deceive the public, for instance as to the geographical origin of the goods or services, the field of competition law applies. The consumer protection authority shall have jurisdiction in these cases (i.e. with any infringement of the provisions relating to the prohibition of unfair commercial practices).

## 15) Ireland

Under Irish law (section 8(1)(c) of the Irish Trade Marks Act, 1996:

*“The following shall not be registered as trade marks: (...) (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services;”*

If a trade mark is filed in Ireland comprising of a country name, a refusal is likely to be raised by the Office on the grounds of descriptiveness but it may be possible to overcome such a refusal by filing arguments at the Irish Office highlighting the principles laid down in the “*Windsurfing*” case, arguing that there is no plausible connection between the goods/services and the geographical location and that the fact that a word is a geographical name does not automatically mean that it serves as an indication of geographical origin when used in trade. Use of the proposed mark in trade would assist with any such arguments.

## 16) Italy

### Possible Area of Convergence No. 1 (Notion of Country Name)

The notion of “Country name” extends to any name/adjective/image that is able to specifically identify a State and its territory. In particular, for the purposes of trade mark law, the notion of “Country name” comprises 1) official or formal name of the State (e.g. ‘ITALIA’), 2) their translations (e.g. ‘ITALY’), as well as 3) the form as an adjective (e.g. ‘ITALIANO’).

### Possible Area of Convergence No. 2 (Non-registrable if Considered Descriptive)

In Italy the registration of a trade mark containing a Country name must comply with the general requirements for registration and, therefore, a mark consisting exclusively of a country name cannot be registered or can be declared invalid if registered when it may serve in trade to designate the geographical origin of the goods or service, since it lacks distinctive character.

In particular, according to Article 13 of the Italian Code of Industrial Property (Legislative Decree, February 10, 2005, No. 30):

*“Art. 13 - Distinctive character*

- 1. Signs lacking a distinctive character shall not be registered as trade marks. These include:
  - a) those consisting only of signs that have become commonly used in current language or in the common practices of the trade;*
  - b) **those consisting exclusively** of general designations of goods or services or descriptive indications that refer to them, such as signs that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, **geographical origin** or the time of production of the good or of the rendering of the service or other characteristics of the good or service.**
- 2. Notwithstanding paragraph 1, signs that have acquired a distinctive character prior to the application for registration, due to the use that has been made of them, may be registered as trade marks.*
- 3. A trade mark shall not be declared or considered invalid if prior to the filing of the application or claim of nullity, the sign referred to, due to the use that has been made of the same, has acquired a distinctive character.*
- 4. A trade mark is revoked if, due to the activity or lack thereof of its owner, it has become a generic designation of the product or service in trade or has however lost its distinctive character.”*

Nevertheless, according to Italian case law, a geographical name may be registered as a trade mark if it does not indicate the geographical origin of the goods, if it has acquired a distinctive character (i.e. secondary meaning), if it indicates a restricted area or a place

owned by an only one proprietor and/or it is contained in a complex trade mark that does not identify a real geographical area.

For example, a geographical name may be registered as a trade mark when it does not indicate the geographical origin but is used in evocative function and not with reference to the origin of the product: “AUSTRALIAN” for clothing produced in Italy, SEAT “IBIZA”, “ROMA” for perfume, “BROOKLYN” for a chewing gum produced in Italy (Court of Milano 27.05.1996), “BAVARIA” for a beer which is not produced in the region of Bavaria (Court of Appeal of Torino 02.02.2011, Court of Torino 30.11.2006).

As an example of secondary meaning acquired by an Italian trade mark, the trade mark “FABRIANO” for paper can be mentioned, “FABRIANO” is the name of a geographical location, but thanks to its reputation consumers connect the trade mark to the protected products rather than the geographical origin of the same.

Moreover, the trade mark “VERRAZZANO” for wines has been considered valid since it refers to a circumscribed and unknown geographical place (Court of Florence, 18.09.2006).

Another interesting case regards the trade mark “FONTANA CANDIDA”, which was registered since it was the ancient name of a geographical area. However, such name fell into disuse and disappeared from the land registry maps before the trade mark registration, which was hence considered to have a sufficient distinctive character (Court of Appeals of Rome, 07.02.1994).

Moreover, the trade mark “COSTA SMERALDA” (Court of Rome, 14.10.1997) was considered valid since it does not refer to a real geographical area, originally known by this name, but to a fantasy name which, through use and promotion, gave name to a geographical area; the same can be said with reference to the trade mark “GARDALAND”.

### Possible Area of Convergence No. 3 (Non-registrable if Considered Misleading, Deceptive or False)

In Italy, the deceptive nature of geographical names (alongside absence of distinctive character) constitutes a ground of absolute refusal of a trade mark registration.

In particular, as regards the deceptive nature, we highlight the Art. 14:

#### *“Art. 14 - Lawfulness*

- 1. The following shall not be registered as trade marks: [...]*
  - b) signs that can mislead the public, in particular as to **the geographical origin**, nature or quality of the goods or services; [...]*
- 2. A trade mark is revoked:*
  - a) if it has become suitable to mislead the public, in particular as to the nature, quality or origin of the goods or services, due to the manner and context in which it is used by the owner or with his consent, for the goods or services for which it is registered.”*

## Possible Area of Convergence No. 5 (Invalidation and Opposition Procedures)

Moreover, the lack of distinctiveness and the deceptive character of a mark are considered grounds for invalidity and the supervening deceptive nature or the loss of distinctiveness are considered grounds for revocation of a trade mark.

In particular, the action for invalidity or revocation may be brought by anyone who is interested.

Italian IP Code:

“Art. 25 – Invalidation

1. A trade mark shall be considered invalid: [...]
- b) if it conflicts with the provisions set forth in Articles 9, 10, 13, 14(1), and 19(2);[...]

“Art. 27 – Revocation

1. A trade mark shall be revoked:
  - a) due to vulgarization according to Article 13(4);
  - b) due to its becoming unlawful according to Article 14(2); [...]

Nevertheless, in Italy the lack of novelty (in accordance with Art. 12 of the IP Code) and the contrast with earlier rights of third parties (portraits, personal names, well-known signs used in the field of art, literature, sport etc. in accordance with Art. 8 of the IP Code) are the only grounds for opposition.

Therefore, the lack of distinctiveness and the deceptive nature are not considered grounds for opposition. To make an opposition against the registration of a mark it is necessary to have a qualified interest (i.e. trade mark or other earlier rights).

## Possible Area of Convergence No. 6 (Use as a Mark)

There are different measures to prevent the use of country names as trade mark if it can mislead consumers about the origin of the product. For example, civil actions in Court are available for any interested party as well as the public prosecutors (although no decisions on such actions were located).

Further, in Italy, for example, according to Art. 4, paragraph 49, of Law n. 350/2003, placing on the market goods bearing “*false or misleading indication*” of Italian origin and “*the use of signs, figures, or anything else that could lead consumers to believe that the product or good is of Italian origin*” is a crime punished in accordance with Art. 517 of Criminal Code (up to two years of imprisonment and fine).

Moreover, in Italy, administrative sanctions are provided for those who use any information which might confuse consumers about the origin of products (i.e. for wines, in case of use of

false and misleading information on the packaging or in advertising about the origin, nature and the essential quality of the products, or any practice capable of mislead consumers about the true origin of the products).

## 17) Lithuania

Under Lithuanian law there are no specific provisions regarding country names to be excluded from registration as trade marks, except the name of Lithuania.

The Lithuanian Trade Mark law has a provision (Article 6, part 1 (8)) according to which signs shall be declared invalid if they consist, *inter alia*, of the official (e.g. the Republic of Lithuania) or traditional (abbreviated) (e.g. Lithuania) state name of the Republic of Lithuania [...] unless the permission for their use in a mark has been issued according to established procedure by the institution authorised by the Government of the Republic of Lithuania. The Minister of Justice grants the permissions under the Law on Trade Marks.

For instance, permission for the use of Lithuanian State symbols in a mark or design shall be granted if these symbols are used respectfully, do not diminish the name of the Lithuanian State, are not contrary to public order and morality, and the applicant demonstrates that he meets at least one the following requirements: 1) represents or will represent the Lithuanian State and public interests in other countries or international organizations whose activities are compatible with legal acts of the Republic of Lithuania; 2) performs or will perform activities, or will elaborate products in the interest of Lithuanian public policy, economics, science and culture; 3) the goods or services are common in Lithuania; they represent or will represent its culture or traditions of manufacture; 4) uses or will use a trade mark or design to represent Lithuanian culture, science, historical or cultural heritage, traditions of manufacture, as well as to promote the image of Lithuania.

Upon examination the following marks, consisting of the traditional state name of the Republic of Lithuania have been refused:

-  applied for the goods in class 37;

-  applied for the goods in class 41;

-  applied for the goods in class 32.

As regards the names of other countries, they may be treated as geographical origin. According to Article 6 part 1 (4) of the Republic of Lithuania Law on Trade Marks, a sign shall not be recognised as a mark and shall be refused or the registration of a registered mark shall be declared invalid if it consists exclusively of *inter alia* [...] geographical origin or the

time of production of the goods or of rendering of the service, the mode of production or other characteristics of the goods and/or services.

## 18) Malta

Under Malta's practice, and as a matter of policy, any trade mark application applied for by a Maltese entity / an applicant with a clear connection to Malta and comprising the term "Malta" would only be allowed to proceed to registration with a disclaimer on the word "Malta", to the following effect: *Registration gives no right to the exclusive use of the word "Malta".*

A provision of law explicitly establishing such a ground of refusal / invalidity does not exist under Maltese law, as opposed to specially protected emblems and the national flag of Malta. Having said this, Article 4(1)(c) and Article 4(3)(b) of the Trade Marks Act (Cap. 416 of the Revised Edition of the Laws of Malta), read as follows:

*"Grounds for refusal of registration - 4. (1) The following shall not be registered as trade marks (...) (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; (...) 4. (3) A trade mark shall not be registered if it is (...) (b) of such a nature as to deceive the public or likely to deceive the public as to the nature, quality or geographical origin of the goods or service or in any other manner."*

## 19) The Netherlands

Based on Article 2.4 of the Benelux Convention on Intellectual Property (BCIP), no right in a trade mark shall be acquired by the following:

*(a) the registration of a trade mark which, regardless of the use made thereof, is contrary to morality or public policy in one of the Benelux countries or in respect of which rejection or invalidation is provided for by Article 6ter of the Paris Convention.*

*(b) the registration of a trade mark which is likely to mislead the public, for example concerning the nature, quality or geographical origin of goods or services;*

*(g) the registration of a trade mark for wines which includes a geographical indication identifying wines or which comprises such indication, or the registration of a trade mark for spirits which includes a geographical indication identifying the spirits of which comprises such indication, in respect of wines or spirits which do not have that origin, unless the filing leading to such registration was made in good faith prior to 1 January 2000 or before onset of the protection of the said geographical indication in the country of origin or in the Community.*

### Refusal by Office (no trade mark registered)

Based on Article 2.11 paragraph 1 under (e) BCIP, the Benelux Trademark Office shall refuse to register a trade mark if it considers that the mark is a trade mark referred to under

Article 2.4 (a), (b) or (g). Nullity invoked by any interested party (trade mark registered, but registration can be nullified by interested party)

Based on 2.28 BCIP, any interested party, including the Public Prosecutor, may invoke the nullity of: (e) registration of a trade mark under which no trade mark right is acquired in accordance with Article 2.4 (a), (b) or (g).

### Other observations on practice and recent case law

Taking a quick look into the Benelux trade mark register shows that on this date, there are (approximately) 788 registered Benelux trade marks containing the element “Nederland” and 693 registered Benelux trade marks containing the element “Holland”. For instance, the figurative mark 100 % Holland is registered as a Benelux trade mark for inter alia clothing (registration number 0819222). Furthermore, the word mark “ABC Nederland” is registered as a Benelux trade mark for, *inter alia*, insurances (registration No. 0943073). The Benelux register also contains entries for trade marks containing the name of other countries, such as Germany. Therefore, it appears that trade marks that include the element “Nederland” or “Holland” (or another country name) are easily accepted, provided that they are not misleading with regard to the place of origin.

However, there are examples of Dutch case law where it was held that a trade mark containing the name of a country was not valid because the mark constituted merely of a geographical name. For example, the trade mark ‘L’Argentina’ was held to be invalid by the Dutch Courts (Supreme Court of the Netherlands, 11 November 2016, ECLI:NL:HR:2016:2573). The public is familiar with the country Argentina and could think that the goods offered under this trade mark (clothing and shoes in this case) originated from Argentina. Such cases are assessed with reference to the criteria in the Chiemsee-case of the CJEU (4 May 1999, ECLI:EU:C:1999:230).

It seems therefore that although the BCIP may easily accept trade marks including geographical names, these marks may still be successfully contested in a court of law.

## **20) Paraguay**

Under Paraguay's law (Article 2 par.b of Trade Mark Law No. 1294/1998):

*“shields, emblems, badges and names, whose use belong to the State, any other Public Law Juridical Person or International Entities, except when they are applied for by them”*

are not registrable as trade marks.

In case a country name is filed in conjunction with another word the general criterion is to allow registration provided that exclusivity of the name of the State is not claimed.

## Rejected trade mark applications:

- 'GTS DO BRASIL' – application No. 1524198 in class 7;
- 'FABBRI 1905 ARGENTINA' – application No. 1115675 in class 30.

## Accepted trade mark applications:

- 'HOTEL DEL YACHT Y GOLF CLUB PARAGUAYO' – registration No. 297774 in class 35;
- 'MONTE VERDE PARAGUAY' – registration No. 306025 in class 36;
- 'MISS UNIVERSO PARAGUAY' – registration No. 331423 in class 38.

## **21) Poland**

Under Polish law refusal or invalidation apply to trade marks consisting solely of 1) official or formal name of the State, 2) their translations (e.g. 'POLAND'), as well as 3) the form as an adjective (e.g. 'LA ESPAÑOLA').

It seems that the trade marks consisting solely of a country name are often refused on the grounds of a misleading character of the geographical indications, e.g.:

- 'NORWEGIA' – application No. Z.301409 for alcoholic beverages in class 33;
- 'ENGLAND.PL' – application No. Z.400690 for services in class 35, 36 and 38.

Upon examination the following marks, consisting solely of a country name, have been refused registration on the account of their descriptive character of the place of origin of the goods or services:

- 'NORVEGIA' - International registration No. 885965 applied for "*meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; cheese; dairy products*" in class 29;
- 'LA ESPAÑOLA' – application No. Z.260063 applied for "*edible oils and fats*" in class 29;
- 'POLAND' – application No. Z.259540 applied for "*alcoholic beverages*" in class 33.

## 22) Portugal

Under Portuguese practice the Trade Mark Office refused the following trade mark due to descriptiveness:



'PORTUGAL and device' (national colors and shield design) – Application No. 443841, covering goods in class 25 i.e. “sweaters; caps; pants; sweaters; coats; Jerseys [clothing]; socks; T-shirts; pullovers”).

## 23) Romania

Under Romanian law oppositions cannot be filed on absolute grounds. Invalidations on absolute grounds are possible and may be filed in Court (Art. 47 par. (1) (a) of Law 84/98 (r)). In principle, when it comes to country names, ex-officio examinations/observations are covering the same absolute grounds as an invalidation action, namely Art. 5 of Law 84/98 (r):

*(a) Signs that cannot constitute a trade mark, within the meaning of Art. 2 (not capable of distinguishing the goods or services of one enterprise from those of other enterprises);*

*(b) Trade marks which are devoid of any distinctive character;*

*(d) Trade marks which consist exclusively of signs or indications which may serve, in trade, to designate [...] the geographical origin (when the applicant originates from the same country)*

*(f) Trade marks which are liable to mislead the public as to the geographical origin [...] (when the applicant does not originate from the same country).*

The following cases exemplify the official practice:

	Trade mark	Appln. No.	Appln. date	Goods/services	Status	Applicant
▪	<b>CUBA</b>	M 2012 05376	24.08.2012	29; 30; 31; 32; 33	Rejected	RO
▪	 <b>Columbia</b>	M 2007 09771	22.10.2007	25	Rejected	RO
▪	<b>RIO BRAZILIA</b>	034690	19.04.1995	30 <sup>2</sup> , 35, 39	Lapsed <sup>1</sup>	RO
▪	<b>MONACO</b>	038557	28.02.1996	33; 35; 39	Registered	RO

▪	<b>ECUADOR</b>	M 2014 03666	23.05.2014	30	Registered	RO
▪	<b>PANAMA</b>	M 2008 00331	17.01.2008	24	Registered	RO
▪	<b>PANAMA</b>	M 2004 09895	18.11.2004	33	Rejected	RO
▪	<b>Ko\$oVo</b>	M 2002 00161	15.01.2002	35; 41	Rejected <sup>3</sup>	RO
▪	<b>KO\$OVO</b>	M 2000 04319	16.10.2000	41	Lapsed <sup>1</sup>	RO

1 not renewed in 2005 / 2010

2 class 30: green and roasted Brazilian coffee

3 rejection grounds is unclear; it might have been refused based on prior identical registration M 2000 04319

However, Art. 23 par. (1) of Law 84/98 (r) provides that:

*“Where a non-essential element of the trade mark is devoid of distinctive character and if said element could give rise to doubts as to the scope of trademark protection, OSIM shall request that the applicant states, [...] that he disclaims any exclusive right on said element. The statement shall be published together with the registered trade mark.”*

Therefore, even in the eventuality of an application consisting of a combined trade mark, the registration of such verbal elements should have been avoided (but this would not impede the use as such, including the country name).

Having in view this particularity of the Romanian law in respect with disclaimers, the following examples appear pertinent to underline the same lack of unitary approach of the national office in respect with similar registrations:

Trade mark	Appl. No.	Appl. date	Goods/services	Status	Disclaimer	Applicant
• 	039063	16.04.1996	16; 35; 42	Rejected	/	RO
• 	M 2003 04096	28.07.2003	1-45	Registered	Yes	RO <sup>1</sup>
• 	M 2004 07928	15.09.2004	25; 41	Registered	Yes	RO

•		M 2007 07049	17.07.2007	6	Registered	Yes	PL
•		M 2015 01751	16.03.2015	1-45	Registered	No	RO <sup>1</sup>
•		M 2016 01824	16.03.2016	9; 14; 16; 18; 24; 25; 28; 32; 41; 43	Decision of admittance of protection	No	RO

<sup>1</sup> both registrations belong to the National Olympic Committee

## 24) Slovenia

Under Slovenian law (IP Act):

*“A sign which is ineligible for registration because it contains the name or abbreviation of the name, State armorial bearing, emblem, flag or other official sign of the Republic of Slovenia, or a part thereof, which is in breach of the provisions of paragraph (1)(j) and (k), shall not be used in the course of trade without the consent of the Government of the Republic of Slovenia.”*

However, in practice at present SIPO (during ex-officio examination due to the absolute grounds for refusal) does not request proper consent from the applicant when the name Slovenia/Slovenija is just one part of the entire mark. In the past SIPO refused some mark (for example "ETIS ELEKTRONSKI TELEFONSKI IMENIK SLOVENIJE") which included the name Slovenija or Slovenia without the required consent, but this practice has been changed. Thus, the marks which include besides the word Slovenia/Slovenija also other words or figurative elements can be registered (for instance there are registered fig. marks: "SLOVENIA VINUM", "SLOVENIA EXPERIENCE", "FIREBALL SLOVENIA", "I FEEL SLOVENIA"). However, solely word "Slovenia" or "Slovenija" in standard characters cannot obtain registration, but there has not been any such case as of yet.

As far as name of other countries are concerned the SIPO does not refuse the same, especially not when besides this name the mark includes also other elements (for instance: figurative marks "CHARLES VÖGELE SWITZERLAND", "SANTANA BRASIL", "CROATIA RECORDS"). In the past SIPO requested that the goods had to be restricted to the goods which originate from certain county if the mark includes the country name. Nowadays, this practice is not in force any longer and SIPO registers the trade marks which besides other words or parts include the country name. No consent of the country authorities is required.

In any case when SIPO refuses the mark on the basis of absolute grounds, the applicant has a possibility to appeal this decision by filing a complaint with the Administrative Court in Ljubljana.

The registration of any mark can be attacked due to the absolute grounds with filing a nullity action before the civil Court. A complaint can be filed by any interested party.

## 25) Spain

### Legal basis: Law 17/2001 of December 7 on Trade Marks

The question of registration of country names as trade marks is part of the general law governing the registration of geographical names.

The country names can be considered to be included under the term "indication of a geographical origin" in the Spanish legislation as follows:

### Possible Area of Convergence No. 2 (Non-registrable if Considered Descriptive):

*Absolute Grounds: Article 5(1)(c) of the Spanish Trade Marks Law:*

*The following signs may not be registered as a trademark:*

*(c) those which consist exclusively of signs or indications which may be used in trade to designate the species, quality, quantity, purpose, value, geographical origin or period of production of the good or provision of the service, or other characteristics of the good or service.*

### Possible Area of Convergence No. 3 and 4 (Non-registrable if Considered Misleading, Deceptive or False) / (Consideration of Other Elements of the Mark):

*Absolute Grounds: Article 5(1)(g) of the Spanish Trade Marks Law:*

*(g) those which may mislead the public, for example as to the nature, quality or geographical origin of the good or service.*

### Possible Area of Convergence No. 5 (Invalidation and Opposition Procedures)

Under Spanish Trade Mark Law any interested party may oppose or apply to invalidate with the Spanish Courts - on absolute grounds- a trade mark that merely consists in an indication of geographical origin, according to Article 5(1)(c) and/or (g) of Spanish Trade Mark Law.

## Case Law

The judgment of the Court of Justice of the European Communities (currently, Court of Justice) of 04/05/1999 in the "Windsurfing Chiemsee" case established an important doctrine in Spain (as it was in the whole EU) concerning the registrability of geographical names.

This case has its origin in the lawsuit against the owner of the German mark "Windsurfing Chiemsee" (registered to cover "clothing and sports shoes") with two businessmen who used the name "Chiemsee" (which designates the largest lake Bavaria) in connection with identical goods. Before its judgment, the Court of First Instance of Munich referred to the Court of Justice the question whether, when interpreting Article 3 (c) of Directive 89/104/ EEC, the possibility of using a designation to indicate the geographical origin of the relevant products should be sufficient.

The doctrine of the Court of Justice in its judgment of 04/05/1999 has been developed and supplemented by the Court of First Instance of the European Communities (currently General Court) in its judgment of 25/10/2005 which ruled in the "Peek & Clopenburg" case. In that judgment, the Court of First Instance of the European Communities (currently General Court) stated (point 49) that in assessing whether a sign constitutes an indication of geographical origin, account must be taken of all the relevant circumstances, such as the nature of the goods or services designated, the greater or lesser reputation, especially within the economic sector involved, of the geographical location in question and the relevant public's greater or lesser familiarity with it, the customs obtaining in the area of activity concerned and the question to what extent the geographical origin of the goods or services at issue may be relevant, in the view of the persons concerned, to the assessment of the quality or other characteristics of the goods or services concerned.

The Spanish Trade Marks Office rejects almost automatically any geographical term as deceptive of the origin of the goods or services unless the products claimed or the services rendered have their origin in that area and that it is expressly indicated in the specification.

For example the mark "MARRAKECH ICE TEA" was rejected because it was found to be misleading about the origin of the products, "JAMAICA" (figurative) for products in class 32 and 33 was considered to be deceptive of the origin of the products.

Likewise, the mark "TENORIO.PORTUGAL" (figurative) was refused as it was considered to be misleading about the origin of the products and the applicant invited to indicate that the products had their origin in Portugal.

The mark "WHITE RUSSIAN" for clothing in class 25 was also rejected as misleading of the origin of the products as according to the Spanish Office, the applicant should have indicated in the specification that the products claimed have their origin in Russia.

## **26) Sweden**

Under Swedish law an interested party may oppose or apply to cancel also on absolute grounds, not only relative grounds.

The Swedish PTO up to a few years back refused registration of any trade mark that merely indicated a geographical location as an absolute bar to registration (risk of misleading the consumers about the geographic origin of the products or services). This practice was however overturned by the Appeal court in a series of decisions a few years back referencing

“*Chiemsee*” case and requiring the PTO to assess whether the products and services in the particular trade mark is actually misleading as above or not.

## 27) Switzerland

Under Switzerland’s law (Art. 10 Sect. 1 Al. 1 and Art. 11 of the Swiss Federal Act on Protection of Coat of Arms and Other Official Signs) it is prohibited to use “*national images and word signs of other states and signs which can be confused with these signs*”. The scope of these provisions is significantly more comprehensive than the relevant section of the Paris Convention. Besides of that, the legislation provides specific protection for the Red Cross and names and signs of the UN. The provisions of these legislation applies irrespective of whether the sign is misleading or if there is a danger of confusion.

Consequently, the official names of states, the names that are in common use and any translation of these names into a language that will be understood in Switzerland (at least German, French, Italian, English) are not registerable. These names do not only violate the above mentioned provisions, but are also considered to be descriptive. If such names are used as unregistered trade marks, civil actions can be filed in a civil court. In addition, the Federal Act on Protection of Coat of Arms also provides for criminal sanctions. Trade marks consisting just of verbal elements referring to the name of states or adjectives thereof (e.g. “ITALIA”, “ITALIANO”, “ITALIEN” etc.) are refused in any case. Consequently, there is no case law for such clear cut cases.

## 28) Turkey

Under Turkish law there are no specific rules which prohibit the registration of country names as trade marks. These trade marks are examined based on general absolute grounds for refusal.

In Turkey trade marks consisting solely of 1) the official or formal name of the State: “TURKIYE CUMHURİYETİ”, 2) their translations: “REPUBLIC OF TURKEY” or “TURKISH REPUBLIC”, 3) the form as an adjective: “TURKISH” will be refused or may be invalidated if they may serve in trade to designate the geographical origin of the goods or service. Any person who has suffered, State Prosecutor or related official authorities may appeal for invalidity at the court.

The applicable provisions under the Turkish Trade Mark Law are the following:

*“Article 7 - Absolute Grounds for Refusal for Registry of a Trade Mark (...) c) trade marks which consist exclusively of signs or indications which serve in trade to indicate the kind, characteristics, quality, intended purpose, value, geographical origin, or designate the time of production of the goods or of rendering of the service or other characteristics of goods or services...”.*

*“Article 42 - Invalidity of a Trade Mark. A registered trade mark shall be declared invalid by the court in following cases: a) where in breach of Article 7 (However, the action regarding well-known trade marks as specified subparagraph (i) of Article 7 has to be*

*instituted within five years from the date of registration. If there is bad faith time limit shall not apply.)”*

*“Article 43 - Application for a Declaration of Invalidity . Any person who has suffered, State Prosecutor or related official authorities may appeal for invalidity at the court”.*

There is no registration on the official database of solely the country names “Turkey”, “Türkiye” or “Turkish” as trade marks.

In Turkey there are “protected trade marks” which cover the names “TÜRKIYE CUMHURİYETİ”, “TÜRKIYE” and their translations “REPUBLIC OF TURKEY”, “TURKISH REPUBLIC”, “TURKEY” and are solely hold and used by governmental institutions of the Turkish Republic. For instance; “REPUBLIC OF TURKEY PRIME MINISTER'S OFFICE”, “REPUBLIC OF TURKEY MINISTRY FOR EU AFFAIRS”, “TURKEY DISCOVER THE POTENTIAL”, “GOTURKEY”, “TURKEY HOME”, “TURKEY”.

The country name that is in common use is “TURKEY” and the translation there of is “TÜRKIYE”. In Turkey it is possible to register the name “TURKEY” or “TÜRKIYE” as a trade mark used in combination with a distinctive term. The following registered trade marks are examples of marks that are not considered descriptive by the TPI:

- ‘WINES OF TURKEY’ for alcoholic beverages including wines;
- ‘OWN IN TURKEY’ and ‘YOUR HOME IN TURKEY’ for real estate services;
- ‘DOCTOR TURKEY’ for medical services;
- ‘NEW LIFE TURKEY’ for real estate services;
- ‘TEACHERSINTURKEY’ for education services;
- ‘COIN TURKEY’ for cashboxes;
- ‘BETTER HOMES TURKEY’ temporary accommodation services;
- ‘BOOKINTURKEY’ for travel services.

The short name of the state “TR” by itself and with an additional term can be used and registered as a trade mark in Turkey. For example, “TR” is registered as a trade mark and the following trade marks with the abbreviated form of Turkey “TR” are accepted and registered by the TPI: TR-MAX, TR 2016, TR 100, TR PLUS, MENU TR, TR PLAKA, TR-POWER, MORE TR, LOGIC TR.

The following examples are trade marks considered as non-descriptive and that have been registered by the TPI:

- 'BIKE TR', registered for bicycles and bicycles accessories;
- 'TR-PAY', registered for ATM machines and financial and monetary services;
- 'TR-PHARM', for example registered for pharmaceuticals, chemicals use in agriculture, horticulture and forestry, medical services; veterinary services;
- 'TR-BUY', registered for coin cases and ATM machines;
- 'TR-NET', registered for computer services.

Trade marks which include the term "TURKISH", such as:

- 'TURKISH EXPRESS', registered for transport; packaging and storage of goods; travel arrangement;
- 'TURKISH DAILY NEWS', registered for daily, weekly, monthly newspapers and magazines;
- 'DISCOVER TURKISH FURNITURE', registered for furniture.

The overall conclusion can be made that despite the fact that according to the Turkish law a country name can only be used in combination with a distinctive term, in practise there are many trade marks registered that should be refused because of their lack of distinctiveness.

## 29) United Kingdom

'UK' includes all countries, namely England, Scotland, Wales and Northern Ireland. Throughout the UK the same Trade Mark Law – the Trade Marks Act 1994 (as amended) which is essentially based on EU Directives – applies. The Common Law remedy, relating to 'passing off', applies in all parts of the UK. Under that law, which requires proof of a 'reputation' acquired by the use of a mark or name in business, remedies are available against deceptive use of names of all kinds, including country names and other geographical names. The rights that are protectable under the law of passing off can also be relied upon in opposition to applications for registration (under the 1994 Act), and in proceedings for invalidity.

### Case law and practice in the UK

Under the UK 1994 Act, the question of registration of country names as trade marks is part of the general law governing the registration of geographical names. In the absence of any specific decisions, whether of the UKIPO or the Courts, the best source of general information is the Manual of Trade Mark Practice, which is published on their website at: <https://www.gov.uk/government/organisations/intellectual-property-office>. The notion of a 'country name' as such is not separately treated. The UKIPO applies the decision of the CJEU in *Windsurfing Chiemsee v Boots and Attenberger* (Cases C-108/97 and 109/97). The main applicable provision is section 3(1) of the 1994 Act. Section 3(1)(c), which provides for

refusal of registration of “trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the *kind*, quality, quantity, intended purpose, value, *geographical origin*, the time of production of goods or of rendering of services, or *other characteristics of goods or services*”. Italicised words are, in particular, considered applicable by the UKIPO. Section 3(4) of the 1994 Act will also be considered by the UKIPO. This prohibits registration of trade marks the use of which is prohibited in the UK by any enactment or rule of law *or by any provision of Community law*. These laws include EU Regulations covering GIs.

In respect of geographical names, the UKIPO will raise objection if the name designates a place which, in the minds of the relevant public, is already associated with goods/services listed in the application, or if (where there is no current association) the name is liable to be used in the future by undertakings as an indication of the geographical origin of the goods or services concerned.

Names of countries or of places outside the UK are treated on the same principles as names of places in the UK. So far as use of country names is concerned, this is covered by the law of passing off, as mentioned above, or (where applicable) under the EU laws protecting GIs.

Factors which are considered are whether the location has an existing reputation for the goods or services concerned and whether the characteristics of the location indicate that the place is, or in the future is liable to become, a geographical source for the goods or services.

Thus, a country name like “ICELAND” can be registered for some goods, for example dishwashers and freezers, if either there is distinctive character acquired through use, or if the relevant public would not perceive the name as indicating the goods’ place of origin. But “ICELAND” cannot be registered for other goods, such as meat.

The UKIPO refused the following marks containing a country name on absolute grounds:



- ‘100% BRITISH & device’ – application No. 2645364 covering goods and services in classes 16, 29, 30, 31, 32, 33 and 35;
- ‘JERSEY’ – application No. 2574917 covering goods in class 3;
- ‘ICELAND’ – application No. 2341223 covering “*meat, poultry and game*”.

The latter mark was, on the other hand accepted for other goods.

Please also note that in the UK, it is possible for anyone to oppose a mark on absolute grounds. In the “ICELAND” decision, the opponent was the Icelandic Government.

There have been several important cases of relevance under the law of passing off. In an important decision some years ago, a claim for passing off in respect of deceptive use of a

country name was upheld by an English judge in the case of *Chocosuisse Union des Fabricants Suisses de Chocolat v Cadbury Ltd* [1998] Reports of Patent Cases 117. The decision followed a line of leading decisions, protecting such designations as 'Champagne', 'Scotch Whisky' and 'Advokaat'. Essentially, what the law of passing off provides is a remedy against use of a country name which is deceptive as to the origin of a product.

Finally, there are trading standards laws, such as the Trade Descriptions Act, independent of trade mark law, which are enforced by local government, to prevent misleading labelling on goods regarding their place of origin.

## **CONCLUSIVE REMARKS**

In view of the aforesaid, ECTA has come to a conclusion that there are still very different approaches to the registration of geographical names including country names as trade marks in Europe, despite the Directive and the existence of the Windsurfing Chiemsee criteria. It goes without saying that there are very different approaches to the registrability of geographical names, incl. country names, also in the rest of the world.

Therefore, ECTA finds very useful the SCT discussions on the possible areas of convergence and hopes that they will help to harmonise the criteria in benefit of the trade mark owners.

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ECTA, which was formed in 1980, is an organisation concerned primarily with trade marks and designs. ECTA has approximately 1,500 members, coming from all the Member States of the EU, with associate Members from more than 50 other countries throughout the world. ECTA brings together those practicing in the field of IP, in particular, trade marks, designs, geographical indications, copyright and related matters. These professionals are lawyers, trade mark and patent attorneys, in-house lawyers concerned with IP matters, and other specialists in these fields. ECTA does not have any direct or indirect links to, and is not funded by, any section of the tobacco industry.

The extensive work carried out by the Association, following the above guidelines, combined with the high degree of professionalism and recognised technical capabilities of its members, has established ECTA at the highest level and has allowed the Association to achieve the status of a recognised expert spokesman on all questions related to the protection and use of trade marks, designs and domain names in and throughout the European Union, and for example, in the following areas:

- Harmonization of the national laws of the EU member countries;
- Community Trade Mark Regulation and Directive;
- Community Design Regulation and Directive;
- Organisation and practice of the EUIPO.

In addition to having close links with the European Commission and the European Union Intellectual Property Office (EUIPO), ECTA is recognised by WIPO as a non-Government Organisation (NGO).

ECTA does also take into consideration all questions arising from the new framework affecting trade marks, including the globalization of markets, the explosion of the Internet and the changes in the world economy.