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World Intellectual Property Organization
Standing Committee on the Law of Trademarks, Industrial Designs and
Geographical Indications
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COMMENTS AND OBSERVATIONS ON AREAS OF CONVERGENCE CONCERNING COUNTRY NAMES

In the letter dated in 3rd of November 2016, the Secretariat invited members of SCT to submit comments and observations including practical examples of how the certain principles, identified in document SCT/35/4, are applied in national jurisdictions.

For clarification, the Finnish Patent and Registration Office (“the Office”) notes on its behalf that the information, that the Office provided for the Questionnaire summarized in the document SCT/24/6 prepared by the Secretariat, is still accurate.

In this paper the Office briefly represents office practice in the matter as to how the trademarks consisting of country names with or without other elements are treated in office praxis (1.). Also general notes related to the opposition proceedings (2.) will be discussed as well as the matter of using the trademark which contains a name of a state (3.).

1. Notion of Country Name/ Non-registrable if Considered Descriptive

The Finnish practise in protection of country name covers as a rule the official and formal name of the state, the name which is in common use, translation of the name, transliteration of the name, the short name of the state as well as use of the name in abbreviated form and as an adjective. As a principle, the state names are protected, however, not automatically and in all situations. As described later in this paper, it is necessary to take into account the awareness and language skills of the relevant class of persons and in some cases whether the name designates a place which is associated with the claimed goods or services.

The names of the States aren’t automatically excluded from the registration under the Finnish legislation. However, they’re excluded from registration as trademarks for goods/services if the mark could therefore be considered descriptive of the origin of the goods/services or misleading as to the origin of the goods/services.

Under the Finnish Trademarks Act¹ a trade mark that denotes either alone or with only few alterations or additions (inter alia) the quality or place of manufacture of the goods shall not, as such, be regarded as distinctive and therefore such mark isn’t eligible for registration. When assessing the distinctiveness of the trade mark, the

¹ The current Trademarks Act can be found in Finnish at the address
<http://finlex.fi/fi/laki/ajantasa/1964/19640007?search%5Btype%5D=pika&search%5Bpika%5D=tavaramerkkilaki#L3P26>

12/01/2017

trade mark is assessed as a whole. If the mark also contains other distinctive elements apart from the country name, a trademark can be considered distinctive as a whole.

When assessing the distinctiveness of the trademark, the office must take into account the awareness and language skills of the relevant class of persons. When a notion of a country name is included in the mark, it should be assessed whether an average consumer is able to get an impression of an indication of the source of origin. For example, if a trademark applied for consists of a name of country written in Arabic or Chinese symbols, it would be unlikely that a Finnish average consumer, being aware in a normal degree and having the basic language skills, would be able to identify a notion of a country name in the mark.

Notion of a country name can be interpreted many ways. First of all, it should be taken to account that the official languages of Finland are both Finnish and Swedish. Secondly, other language which is considered well known in Finland would be English. German, French and Spanish have to be taken into consideration as well, when a trademark consists of one or more word elements, which can be considered commonly known.² Also it must be taken to account what has already been described in the document SCT/35/4, page 4, i.e. "For example, it may be necessary to take into account whether the average consumer of the goods or services concerned understands the country name (without being a specialist in geography) and whether the name designates a place which is currently associated with the claimed goods or services or whether it is reasonably expected that it will be associated with them in the future."

Examples of the office practice

1.1. A trademark consisting of a name of a state

Application no T200701682 Madagascar (appl. date 23/05/2007)

Class 3 Perfumes

The trademark consists solely of a word Madagascar which is an island country in the Indian Ocean. Bearing in mind the awareness and the language skills of the average consumer the office found that the trademark was purely descriptive because it indicated the origin of the goods. In the office action, the office stated that if the applicant would be able to provide evidence supporting that the mark had been used for a long period and to such extent, that the mark had reached the required level of distinctiveness through genuine use, the office may consider the mark to be distinctive for those reasons.

Since the applicant was Finnish, the trademark was also considered to be misleading as to the origin of the products. In the office action, the office stated that the applicant had two options to overcome the notion of misleading trademark: 1. Limiting the list of goods and services to cover only products which originate from Madagascar. 2. Providing evidence and proof of use supporting that the relevant public is no longer

² For example "El Tinto" for alcoholic beverages (application no T201000996, appl. date 06/04/2010). The descriptiveness is very obvious because the Spanish word "el tinto" means red wine.

12/01/2017

misled because the mark has been used for such long period of time and to such extend.

The applicant didn't reply to the office action within the given time and the application was therefore left unprocessed any further.

Application no T201102366 VATICAN (appl. date 08/08/2011)

Class 30 Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; Flour and preparations made from cereals, bread, pastry and confectionery, ices; Honey, treacle; Yeast, baking-powder; Salt, mustard; Vinegar, sauces [condiments]; Spices; Ice.

Class 35 Advertising; Business management; Business administration; Office functions.

Class 43 Restaurant.

The trademark consists solely of a word VATICAN. "Vatikaani", the Finnish translation of the mark, is phonetically very similar to the applied trademark. Vatikaani means both the official residence of the Pope and the state of Vatican City in Finnish language. Bearing in mind the awareness and the language skills of the average consumer, the office found that the trademark was purely descriptive. The official English name of the state of Vatican would be Vatican City, however, this was irrelevant because the trademark consisted only of the word VATICAN which gave a direct indication for the Finnish consumer of the origin of the products. In the office action, the office stated that if the applicant would be able to provide evidence supporting that the mark had been used for a long period and to such extend, that the mark had reached the required level of distinctiveness through genuine use, the office may consider the mark to be distinctive for those reasons.

Since the applicant was Finnish, the trademark was also considered to be misleading as to the origin of the products in classes 30 and 35. The office takes the view that restaurant services form an exception to this main rule. It is very commonly known, that restaurants can offer food originating from any state or continent regardless of where the service is offered. Therefore, the office found the trademark non-misleading as to the restaurant services in the class 43.

In the office action, the office stated that the applicant had two options to overcome the notion of misleading trademark: 1. Limiting the list of goods and services to cover only products which originate from Vatican. 2. Providing evidence and proof of use supporting that the relevant public is no longer misled because the mark has been used for such long period of time and to such extend.

The applicant didn't reply to the office action within the given time and the application was therefore left unprocessed any further.

Application no T200602952 TOGO (appl. date 01/04/1999)

Class 31 cereal, bread, biscuits, cakes, pastries and confectionery, ice creams

The trademark consists solely of a word TOGO which is a state in West Africa. The office rejected the application stating that the trademark was descriptive consisting solely of a country name indicating the origin of the goods. Since the applicant was

12/01/2017

Italian the Office also found the trademark to be misleading as to the origin of the goods.

The applicant appealed to the Board of appeal and the Board found the trademark eligible for registration. In its decision the Board stated that although the applied trademark is a country name, the state is not particularly known for the applied goods and the average Finnish consumer probably would not think that the goods are manufactured in that state. Thus, the trademark did not indicate the geographical origin of the goods and the mark was found distinctive for the applied goods. Since the average consumer was found not to regard the mark descriptive as to the origin of the goods, the mark was not therefore likely to mislead the public as to the origin of the goods. The trademark was registered for the applied goods.

Application no T201452470 NORWEGIAN (appl. date 08/12/2014)

Class 39 e.g. air travel services; travel services; air transport services; travel agent services; vehicle rental services; courier services

Class 43 e.g. services for providing food and drink; temporary accommodation; accommodation booking services; booking of temporary accommodation, hotel rooms and restaurants; restaurant services

The trademark consists solely of a word NORWEGIAN which means a native or national of Norway, the language of Norway or something relating to Norway. The Office found the trademark descriptive for all the applied services in classes 39 and 43 since the mark indicated the geographical origin of the services and the quality of the services (the quality meaning e.g. air travel services or restaurant services provided in the Norwegian language). The mark was also found misleading as to the origin of the services since the applicant was Irish. The applicant limited the list of services to cover only certain services in class 39 relating to air travel and provided proof of use of the mark. The trademark was considered to be used a long enough period of time and to such extent, that the mark had reached the required level of distinctiveness through genuine use. The office considered the mark to have the acquired distinctiveness through use and therefore registered the applied mark.

1.2. Trademarks containing country names and other elements

International registration no 859547 Espiritu de Chile (appl. date 05/07/2005)

Class 33 Alcoholic beverages (except beers), all goods of Chilean origin

The trademark consists of Spanish words "Espiritu de" and of word Chile that means the state of Chile in several languages, including Spanish, English and Finnish. The Office rejected the international registration stating that the mark lacked the distinctive character. The Spanish word Espiritu means among other things alcohol and spirit. The office found that the trademark as a whole meant alcohol from Chile and thus the trademark indicated the kind, quality and geographical origin of the applied goods.

The holder of the international registration appealed to the Board of appeal and then to the Supreme Administrative Court. The court found that the word Espiritu meant first and foremost spirit, soul and character, although it had also the meaning of alcohol and spirit. The court stated that the word Espiritu was not normally used in

12/01/2017

Spanish in the meaning of alcohol. The court also stated that Spanish is not a commonly known and mastered language in Finland and that the target group does not regard the trademark in the meaning "alcohol from Chile". The trademark was therefore found distinctive and later registered.

Application no T201451843 Suomi 100 (appl. date 19/09/2014)

Class 41 Sporting and cultural activities; Entertainment services; Organisation of training; Education.

The trademark consists of a Finnish word Suomi (= Finland) and a number 100. The office found that the trademark lacked the distinctive character because it only provided the information of the source of the origin of the services (Suomi) and also a number, which also lacked the distinctiveness in itself. The number 100 was assessed as an indicator for example the quantity or price of the services which the application covered. Therefore, the mark as a whole wasn't eligible for registration because it was seen purely descriptive as its nature and not able to distinguish the applicant's services from those of other undertakings.

Application no T201450648 SuomiLOVE (appl. date 21/03/2014)

Class 9 Compact discs, DVDs and other digital recording media
Class 15 Musical instruments.
Class 16 Stationery
Class 25 Clothing, footwear, headgear
Class 28 Games and playthings
Class 35 Advertising
Class 38 Telecommunication services; TV program broadcasting services
Class 41 Entertainment services; Sporting and cultural activities

The trademark consists of a Finnish word Suomi (= Finland) and of an English word LOVE written together. The Office examines both absolute grounds and relative grounds ex officio. The trademark was considered distinctive in relation to the nature of the goods and services. However, the office found the mark similarly confusing with four earlier trademarks covering same or similar goods/services. These earlier registered marks consisted solely of the word LOVE. The office action can be summarized as follows: The distinctive element of the applied trademark is identical to the earlier marks, and the indication of the geographical origin of the goods/services, the word Suomi, is a descriptive element of the mark. Therefore, the applied mark is liable to be confused with the earlier trademarks and cannot be registered without a sufficient consent given by the proprietors of the earlier rights.

1.3. Trademarks containing abbreviations of country name or country names as adjectives

Application no T201551237 Finnhealth (appl. date 15/06/2015)

Class 38 Telecommunication services
Class 39 Travel arrangement

12/01/2017

Class 44 Health care

The trademark consists of a word Finn, written together with the word health. According to dictionary, Finn is a native or national of Finland or a person of Finnish descent. The office found that the trademark was descriptive for the services in class 44 because it described that the services were related to health care and offered in Finland or to the Finnish people.

Application no T201650002 FinTestit (appl. date 04/01/2016)

Class 9 Electrical test apparatus; Circuit testing instruments; Transistor testers; Testing apparatus for checking electronic devices; Testing apparatus for electronic equipment
Class 42 Testing of computer hardware

The trademark consists of a word Fin, which is an abbreviation of Finland, written together with the word Testit. Testit is a plural form of the word testi, which means “a test” in English. The office found that the trademark was descriptive for the goods and services applied because it described that the goods and services related to testing and originated from Finland. The mark wasn’t able to distinguish the goods and services from those of other undertakings, even as a whole.

Application no T201003701 Usatec (appl. date 21/12/2010)

Class 12 Vehicles; Vehicles for locomotion by land, air, water or rail

Application no T200501707 USATEC (appl. date 22/06/2005)

Class 7 Machines

In both cases the applicant was a Finnish company registered in the Finnish trade register. It was considered that the word Usa or USA didn’t have such a clear and independent role in the mark that an average consumer could be misled as to the origin of the goods applied for. The marks were also considered to be distinctive in relation to the goods applied for and therefore they were eligible for registration.

2. Invalidation and Opposition Procedures

Invalidation and opposition procedures provide an additional way for third parties to object a registration. The opposition period is after the registration. The opposition procedures take place before the Office whereas the invalidation procedure is processed at the Market Court.³

The Finnish Trademarks act does not include specific provisions on filing an opposition or invalidation claim on the basis of trademark containing a country name. The ground for invalidation or opposition of a trademark including a country name could be that the trademark lacks distinctiveness or misleads the public. The Office examines ex officio these absolute grounds in the trademark application procedure. The arguments for the opposition or invalidation could be, for example, that the office

³ <http://www.markkinaoikeus.fi/en/index.html>

12/01/2017

has incorrectly found the mark to be distinctive and eligible for registration in the first place, or that the office has incorrectly interpreted the proof of use on acquired distinctiveness or the proof of use itself hasn't been sufficient and accurate enough.

If the trademark includes a country name, the ground for opposition or invalidation could be that the mark misleads the public as to the origin of the goods or services. The trademark can be misleading before registration, i.e. it should have not been registered in the first place since the mark refers to a country which isn't the proprietor's domicile, or the trademark has become misleading after the registration. The latter situation is regulated in the Finnish Trademarks Act section 26.

Unfortunately, the Office isn't aware of any case law (office practice or court decisions) on opposition or invalidation proceedings where the claim would have concerned a trademark including a country name and thus being descriptive or misleading.

3. Use as a mark

The Finnish Trademarks Act doesn't provide specific provisions for the use of the trademark containing a name of a state nor specific limitations to use of such mark. The Trademarks Act regulates situations where a trademark has become misleading and is used in a misleading way.

Trademarks Act section 26.1:

The exclusive rights in a trademark shall be invalidated:

- (1) if it is obvious that the mark has lost the power to distinguish its proprietor's goods from those of others that it had when it was registered or became established;
- (2) if the mark has become misleading or contrary to law and order or morality since it was registered or became established.

Trademarks Act section 36:

"If a trade symbol that has been transferred or licensed becomes misleading in the form in which it is used by the new proprietor or licensee, a court of law may, at its discretion, prohibit the new proprietor or licensee from using it. "

Trademarks Act section 37:

"If the use of a trade symbol is prohibited under section 36, the court may, where practicable, order that a trade symbol placed on goods, their packaging, brochures, leaflets, commercial documents or the like contrary to a prohibition under section 36 be erased or altered so as to be no longer misleading. If this cannot be done in any other way, the court shall order that the material so marked be destroyed or changed in a specified manner.

Material referred to in the above paragraph may be confiscated pending the implementation of the said order in which case the general regulations on confiscation in criminal cases shall apply."

The Consumer Protection Act 38/1978⁴ sets the provisions for fair marketing. The trader is prohibited from giving false or misleading information within marketing concerning, inter alia, the quality and origin of the consumer good. Also Unfair

⁴ The current Consumer Protection Act can be found in Finnish at the address <http://www.finlex.fi/fi/laki/ajantasa/1978/19780038#L2P1>

12/01/2017

Business Practices Act 1061/1978⁵ sets the provisions for good business practice. The trader is prohibited from, inter alia, giving a false or misleading expression concerning one's own business if the said expression is likely to affect the demand for or supply of a product or harm the business of another. Therefore, instruments for third parties to intervene to such use is governed in other legislation than within the Trademarks Act.

These processes and application of the above mentioned regulations are beyond the Office's administrative branch and therefore the Office leaves comments and other observations related to these matters aside from this paper.

Unfortunately, the Office isn't aware of any case law concerning use of a trademark containing a country name.

4. Comments and observations

Generally, it can be said that the state names are protected from registration as trademarks. In order to have a trademark containing a country name registered, one could in some cases either limit the list of goods and services or provide proof of use of the mark.

Yours sincerely

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⁵ The current Unfair Business Practices Act can be found in Finnish at the address <http://www.finlex.fi/fi/laki/ajantasa/1978/19781061#P1>