

C 8607 – Information on the protection of country names in the area of mark registrations

Response of France

In Circular C 8607, the International Bureau requested information on the protection of country names under the applicable legislation of Member States and existing case law.

The National Institute of Industrial Property (INPI) would remind the International Bureau that it previously responded to Questionnaire C 7868 on the protection of country names by States, distributed on July 22, 2010.

In response to Circular C 8607, the INPI would like to add the following information.

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Rule: No general exclusion from registering country names as marks for goods or services

The national legislation applicable to the protection of country names is the same as that applicable to geographical indications in general, i.e., that such signs may be registered as marks in France provided they have **distinctive (non-descriptive) character** and are **not misleading**.

Article L 711.1 of the Intellectual Property Code (CPI) expressly stipulates that geographical names may be registered as marks:

“A trademark (...) is a sign capable of graphic representation which serves to distinguish goods or services (...)”, “The following, in particular, may constitute such a sign: (a) denominations of all forms, such as [...] geographical names [...]”.

This position has been adopted because of the many disadvantages posed by a general and absolute exclusion. There are so many geographical names that a name which might initially appear to be imaginary could in fact be the name of a far-off, unknown town, mountain or river. Cancelling such a mark would be rather drastic given that the risk of causing confusion would appear to be minimal or non-existent.

Accordingly, country names and, more generally, geographical terms may be validly registered as marks, as with any other appellation, provided they are capable of graphic representation, distinctive, non-descriptive and are neither misleading nor unlawfully used. There are therefore restrictions on this basic freedom: it is prohibited to adopt as a mark or as an element of a mark a geographical name which may serve to describe the geographical origin of goods or services or to mislead the public about that origin. Descriptiveness exists where the country name describes the origin of the goods or services and it is misleading only where the country name does not describe the origin when it should.

Therefore, a geographical term may be validly registered as a mark, as with any other appellation, provided it is distinctive. In respect of **country names**, the **French system** does **not deviate from this general rule**, which is combined with the **following provisos**:

- distinctiveness requirement
- non-descriptiveness requirement
- non-misleading requirement

Area of convergence No. 1: Notion of country name

Subject: In connection with this area of convergence, Document SCT 35/4 proposes that the notion of country name cover, barring any legal provisions to the contrary, the following aspects of country names:

- ***Official or formal names of States***
- ***Names in common use***
- ***Translations and transliterations of such names***
- ***Short names of States***
- ***Use of such names in abbreviated form and as an adjective***

Observations:

See examples provided below.

Area of convergence No. 2: Non-registrable if considered descriptive

Subject: *In connection with this area of convergence, Document SCT/34 discusses the refusal of applications for registrations exclusively consisting of a country name where the use of that name describes the place of origin of the goods or services.*

(a) Legislation

Article L 711-2(b) CPI stipulates in particular that “**The following are not distinctive:** [...] **signs or names which may serve to designate a feature** of the product or service, particularly the type, quality, quantity, **destination**, value, **geographical origin**, time of production of the goods or provision of the service [...]”

Country names must be distinctive, as with all appellations used as marks. However, by their very nature, geographical names and hence names of States designate particular places and as such cannot be monopolized by means of registration. This concerns two types of geographical name: those not considered suggestive by the general public and, conversely, those which are not neutral in the mind of the consumer. The examination thus depends primarily on the assessment of the distinctive and non-descriptive character of the term in question.

(b) INPI practice and case law: names of States used in isolation

The practice of the INPI with regard to the protection of country names is in accordance with the case law of the French courts. The INPI refuses the registration of country names as marks where those names are used in isolation; where they are used alongside other elements, the INPI will assess on a case-by-case basis to what extent the other elements constituting the mark in some way influence the distinctive or misleading character of the set of elements to be examined and give that mark a distinctive character.

A number of refusals have been issued:

- refusal of protection in France for the international mark **FRANCIA** (no. 1 013 231) in class 3, **INPI, January 6, 2011**;
- refusal of protection in France for the international mark **BULGARI** (No. 995 330) in classes 31, 32 and 33, **INPI, January 6, 2011**; and
- refusal of protection for French marks **MOROCCO** (No. 07 3 517 019), **MOROCCO** (No. 07 3 517 015) and **MOROKO** (No. 07 3 517 017) in classes 9, 14, 18 and 25, **Paris Court of Appeal, April 7, 2010** (INPI decision upheld).

In these decisions, the **signs** applied for enabled the consumer to immediately make a **direct and clear connection** with the **goods and services** by indicating that they were from France, Bulgaria or Morocco. The signs did not make it possible to distinguish the goods and services from those with the same geographical origin and, conversely, were misleading for goods and services with a different geographic origin. In the cited cases, linguistic or spelling differences were not sufficient to avoid immediately evoking those countries in the minds of French consumers.

Area of convergence No. 3: Non-registrable if considered misleading, deceptive or false

Article L 711-3(c) CPI stipulates in particular that “*The following may not be adopted as a mark or an element of a mark: [...] (c) Signs liable to mislead the public, particularly as regards the nature, quality or geographical origin of the goods or services.*”

Cases of deception are more common where the country already has a particular reputation such that its appropriation does not appear to be legitimate. Such cases can take many different forms, e.g., deception as to the appearance of official guarantees of the goods or as to the source or origin of goods.

In practice, deception takes two different forms:

(1) Deception as to the source of goods

(a) Practice of the INPI

The INPI's approach to deception, for signs partially consisting of a country name, differs according to whether the sign in question designates goods or services.

Signs filed to distinguish only services are never, or hardly ever, challenged on the grounds that they are misleading.

For signs filed exclusively for goods, the INPI makes a distinction according to the following, non-exhaustive, list of assumptions, on a case-by-case basis:

(i). Combining the name of goods with the terms France/French:

Combining the name of a State or its adjectival form with the name of goods does not serve to define what, in the design, manufacture or sales process, was done in France. On the basis of this ambiguity, the INPI issues an objection to the registration in which the examiner requests the applicant to explicitly indicate the restrictive reference “*all goods of French origin or made in France*” on the list of goods for which the sign was filed.

If the applicant refuses to include this restrictive reference, the goods that are the subject of the challenge are refused mark registration.

(ii). Combining the name of an entity with the term France/French

- Signs consisting of the name of an entity combined with the term FRANCE are challenged where the message conveyed is ambiguous.

Example:

EVI  **FRANCE**

Mark filed for class 34 goods. The INPI filed a substantive objection to the misleading character of the term “France”. The applicant amended its filing by adding the restrictive reference “*all goods of French origin or made in France*”.

- However, signs combining the term French with an entity name are not objected to since there is no notion of manufacture.

Example:

ASSOCIATION DES GRANDS CONCOURS
VINICOLES FRANÇAIS

Mark registered in class 33

- Where the name of an entity infers the notion of manufacture, the INPI will assess the elements as a whole:
 - In practice, references to the notion of manufacture must be sufficiently accurate. For instance, the INPI will accept the term “*factory*” but will object to the term “*processing plant*”.
 - The entity name must include the name of a specific product. References to other goods in the filing will be challenged.

Example:

A large, stylized logo consisting of the letters 'M', 'F', and 'C' in a bold, sans-serif font. The 'M' is formed by two diagonal lines meeting at the top, and the 'F' and 'C' are solid block letters.

For the sign “*Manufacture française de cycles*” (“French Bicycle Factory”), the INPI will issue the applicant with a substantive objection for goods which are not bicycles and demand the inclusion of the restrictive reference “*all goods of French origin or made in France*”.

(iii). **Independent reference within the mark model**

Some expressions containing references to a country name eliminate any risk of deception and are not challenged.

Examples: Designed in France/Made in France/French manufacture/Manufactured in France/French store



Mark registered without objection in class 25

However, for ambiguous expressions such as “*created in France*”, “*French creation*” or “*à la française*”, the INPI will object where those terms do not serve to determine whether the product is designed or made in France. Including the reference “*all goods of French origin or made in France*” after the list of goods objected to serves to remedy the defect of deception.

Examples:

- **created in FRANCE imagined in PROVENCE**
Mark filed in classes 3, 14, 21 and 24, registered after inclusion of the restrictive reference indicating that the goods in question were of French origin.
- **Le brushing à la française** Mark filed in classes 3 and 44, registered after inclusion of the restrictive reference indicating that the goods concerned in class 3 were of French origin.

(iv). **Reference to France with Switzerland or a geographical name referring to the Franco-Swiss agreement**

(b) Case law

- Validation of the French mark **THE FRENCH TOUCH** (no. 00 002 731) **in classes 30, 32, 33 and 34, Tribunal de grande instance de Nanterre, April 3, 2008.**
The Paris Court of Appeal considered, with regard to the validity of the mark THE FRENCH TOUCH, that “*this expression refers less to a geographic origin than to the qualities associated therewith*”, that “*the expression suggests a sense, a style and a way of being or acting French without those qualities or characteristics ever being precisely defined*”, that “*these terms are not customarily used in the wine and alcoholic beverages sector and serve neither to designate the geographic origin nor to describe the qualities of the beverages in question, which are commonly described using specific vocabulary*”, and that “*it is therefore admissible that the term The French Touch is distinctive in the alcoholic beverages sector*”.

- by creating an artificial link with the area or country whose name is associated with a particular cultural activity, **CA Paris, December 17, 2003** (Monaco Circuit) and **CA Paris, April 7, 2010** (Morocco)
- by incorporating an appellation of origin to which the product has no entitlement, **CA Paris, June 16, 1988** (Brazil) or liable to be confused with such an appellation

“Considering that while the indication of the provenance of a product is in principle legitimate, the filing as a mark of terms indicating a geographical name may not enjoy an exclusive right where it designates a town, city or country with a certain reputation in respect of the product in question”

“It appears from the documents filed into the record that Brazil, as a producer of high-quality coffee, has a reputation so well established that in France in particular, it is above all with this product that the collective consciousness associates the name of this South American State”

““Brasil” and “Brazil”, while being foreign names (Portuguese and English) are nonetheless extremely similar both phonetically and visually to the French name “Brésil”; the French public is all the more likely to make the connection between said foreign names and the country in South America as the term “Brésil” is not a common noun in the French language and, as a proper noun, designates nothing other than that country”

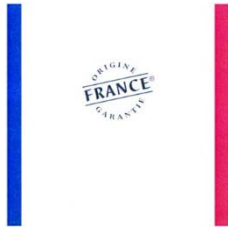
“The appellations “Brasil” and “Brazil” may therefore not be appropriated as marks in light of the principles expounded above, particularly in light of the noted risk of confusion ensuing when, under the mark Brasil, blends are sold in which the percentage of Brazilian coffee is very low or zero”

- **ECJ, May 4, 1999, Windsurfing Chiemsee C-108/97 and C-109/97**

“[The Directive] does not prohibit the registration of geographical names as trade marks solely where the names designate places which are, in the mind of the relevant class of persons, currently associated with the category of goods in question; it also applies to geographical names which are liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods”

“Where there is currently no association in the mind of the relevant class of persons between the geographical name and the category of goods in question, the competent authority must assess whether it is reasonable to assume that such a name is, in the mind of the relevant class of persons, capable of designating the geographical origin of that category of goods”

(2) Deception as to the appearance of official guarantees with goods



- **Invalidation of mark** **CA Paris, March 1, 2016, no. 15/15779**
“Upon examination of the impugned sign, as featured in the filed application for registration, the form of a very simple stamp featuring the words ORIGIN GUARANTEED FRANCE and the reproduction of the colours red, white and blue in the order of the French flag are indeed liable to mislead the public to believe that ORIGIN GUARANTEED FRANCE amounts to an endorsement by an official department or, at the very least, a business concern authorized by the public authorities; the INPI Director General has therefore rightly decided that this application should be refused on the grounds of Article L711-3(c) of the Intellectual Property Code”
- **Invalidation of mark “FRANCE”, CA Paris, March 15, 1988**
“While it is not possible to prohibit outright the use of the word “France”, this should occur where such a mark could lead the public to believe that it is issued by an official department or a department acting under the oversight and authorization of public or administrative authorities, given the verbal or graphic set of elements which incorporate the word “France” and the goods or services designated by the mark”
- *“The assessment must be conducted for each type”, CA Paris, February 25, 1988*
- *“The court being obliged to note which particular circumstances may lead the public to perceive the use of the word “France” as the endorsement of a public authority”*
Court of Cassation, Commercial Chamber, June 16, 1980
- *“Whereas the mark “Eurotrain” does not constitute an indication capable of misleading the public, [...] CA Paris, June 27, 1978 [...] the marks “Eurolivret”, “eurosouscripteur” and “Eurocotation” are deceptive, the European Community being tasked with intervening in financial transactions”*
CA Paris, April 8, 1993

These decisions seek to determine whether the State in question has a **particular reputation for the goods and services claimed** or whether those **goods and services are actually produced or provided in that State and fall within one of its economic sectors**. If so, an objection is registered on the grounds of lack of distinctiveness, the descriptiveness of the sign and deception.

Possible area of convergence No. 5: Invalidation and opposition procedures

Subject: *The grounds for refusal set out in areas of convergence 2, 3 and 4 should constitute grounds for invalidation of registered marks and, where the applicable legislation permits, grounds for opposition.*

Observations:

1. Possible recourse to third-party observations during the registration phase

Article L712-3 of the Intellectual Property Code: *“Publication shall contain a notice that any interested party may submit observations within a period of two months to the Director of the National Institute of Industrial Property.”*

Article R712-9 of the Intellectual Property Code: *“Observations filed in light of Article L. 712-3 (available in French [here](#)) shall be communicated without delay to the applicant by the INPI or shall be dismissed without effect if it is ascertained that they were submitted after the expiry of the prescribed time limit or that their subject matter is obviously outwith the legislative provisions in force. The author of the observations shall be so informed.”*

2. Applications for invalidation of registered marks

(a) Applicable legislation

Applications for invalidation are currently a judicial procedure governed by Article L714-3 of the Intellectual Property Code:

“The registration of a mark that does not comply with Articles L711-1 to L711-4 shall be declared null and void by court decision. The public prosecutor may institute invalidity proceedings ex officio pursuant to Articles L711-1, L711-2 and L711-3.¹ [...] An invalidity decision shall be absolute.”

Whereas action for invalidation is action for absolute invalidation open to any interested party, in accordance with French procedural law, applicants must prove that they have *locus standi*.

(b) Transposition of new Marks Directive

¹ **Article L711-2 of the Intellectual Property Code**

“The distinctiveness of a sign that is capable of constituting a mark shall be assessed in relation to the designated goods or services.

The following shall not be of a distinctive nature:

(a) signs or names which in everyday or technical language simply constitute the necessary, generic or usual designation of the goods or services;
(b) signs or names which may serve to designate a feature of the product or service, particularly the type, quality, quantity, purpose, value, geographical origin, time of production of the goods or furnishing of the service; and
(c) signs exclusively constituted by the shape imposed by the nature or function of the product or which vest the product with its substantial value. Distinctiveness may be acquired by use, except in the case referred to in item (c)”

Art L711-3 of the Intellectual Property Code

“The following may not be adopted as a mark or an element of a mark:

(a) signs excluded by Article 6ter of the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised or by Article 23(2) of Annex 1C to the Agreement Establishing the World Trade Organization;
(b) signs contrary to public policy or morality or whose use is prohibited by law;
(c) signs liable to mislead the public, particularly as regards the nature, quality or geographical origin of the goods or services.”

Article 45 of EU Directive 2015/2436 of December 16, 2015 to approximate the laws of the Member States relating to trade marks (recast), currently being transposed into national legislation, provides for the establishment of an administrative procedure for revocation or declaration of invalidity.

The administrative procedure for invalidity is based in particular on Article 4 of said Directive regarding absolute grounds for refusal or invalidity. Absolute grounds for invalidity concern, *inter alia*, marks devoid of any distinctive character, marks which consist exclusively of signs or indications designating geographical origin and misleading marks.

Finally, the administrative procedure for invalidity on absolute grounds of invalidity are open to ***“any natural or legal person and any group or body set up for the purpose of representing the interests of manufacturers, producers, suppliers of services, traders or consumers, and which, under the terms of the law governing it, has the capacity to sue in its own name and to be sued”***.

3. Remarks on mechanisms recognizing similar situations (not available for the protection of names of States):

The application of other provisions which may concern geographical names would seemingly need to be ruled out:

➤ **Assessing the “personality” of an authority**

L 711-4(h) permits local authorities to apply for invalidation of a mark containing their geographical indication if that mark harms their name, image or reputation. **This option is not open to names of States.**

➤ **Opposition measures available to regional authorities but not to States**

Regional authorities may oppose the registration of a mark harming their name, image or reputation.

The regional authority must invoke a sign:

- of any nature (image, department number, usual name, emblem, etc.); and
- which serves to identify it: the regional authority must provide all documents liable to justify its identification by means of the sign that it is invoking (INSEE documents, legal or regulatory papers, etc.).

In its statement of grounds, the regional authority must establish how the application for the contentious registration harms its name, image or reputation (Article L 711-4(h) of the Intellectual Property Code).

➤ **Protection under Article 6ter of the Paris Convention**

The protection attached to Article 6ter concerns only: armorial bearings, flags (without any obligation as to prior notification), emblems, signs and hallmarks. **This option is not open to names of States.**

Possible area of convergence No. 6: Use as a mark

Subject: *Appropriate legal instruments should be available to interested parties to prevent the use of country names where such use is liable to mislead the public, e.g. as to the nature, quality or geographical origin of goods or services, and to request the seizure of goods bearing false indications as to the source of those goods.*

Observations:

(a) Absolute nullity: (see area of convergence No. 5)

(b) Directorate-General for Competition, Consumer Affairs and Fraud Prevention (DGCCRF) and misleading commercial practices

Article L121-1 to L 121-7 of the Consumer Code

The Code stipulates that a commercial practice is misleading where it occurs in one of the following circumstances:

1 where it engenders confusion with other goods or services, marks, trade names or other distinctive signs of a competitor;

2 where it relies on allegations, indications or presentations which are false or likely to mislead and covers one or more elements and in particular “the essential characteristics of the goods or services, namely: their substantial qualities, content, accessories, origin, quantity, method and date of production, conditions of use, suitability for use, properties, expected outcomes of use and outcomes and main features of tests and inspections performed on the goods or services”;

Officials of the DGCCRF are authorized to investigate and record infringements.

Punishable individuals are professionals who engage in practices contrary to the **professional diligence** requirements set out in the Directive, such as “*the standard of special skill and care which a trader may reasonably be expected to exercise commensurate with honest market practice and/or the general principle of good faith*”.

The cessation of misleading commercial practice may be ordered by an authorized official, either by an investigating judge or by the court seized of the proceedings.

Misleading commercial practices may be subject to criminal sanction, including a maximum prison sentence of two years and a fine of 300,000 euros.

As additional sanctions, natural persons may also be banned from engaging in commercial or industrial activities, directing, administering, managing or controlling, in any capacity whatsoever, directly or indirectly, on their own account or on behalf of another person, a commercial or industrial enterprise or company for a period of up to five years.

Legal persons found criminally liable are punishable by a fine of 1,500,000 euros and the additional penalties provided for in Articles 131-39(2) to (9) of the Penal Code (available in French [here](#)).

In the event of conviction, the court may order that the decision be published or disclosed.

It may also order the disclosure, at the expense of the convicted person, of one or more amending announcements.

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