

Dear Sir or Madam,

With reference to your letter of 3 November 2016 (C.8607) on the national practice of protecting country names, I would like to answer the questions as follow:

Possible area of Convergence No. 1
Notion of Country Name

At least for the purposes of examination of marks, and unless the applicable law specifies otherwise, a country name may cover: the official or formal name of the State, the name that is in common use, translation and transliteration of that name, the short name of the State, as well as use of the name in abbreviated form and as an adjective.

Under German trade mark law, “country names” do not form a category of their own. Country names are a particular type of indication of geographical origin. Such indications, as a rule, are refused as a descriptive reference to the origin of the goods and services and due to lack of distinctive character. We support the definition of what is deemed a country name.

Possible area of Convergence No. 2
Non-registrable if Considered Descriptive

At least for the purposes of examination, trademarks consisting solely of a country name should be refused where the use of that name is descriptive of the place of origin of the goods or services.

It is correct that trade marks consisting solely of a country name should be refused where the country name describes the place of origin of the goods and services. German case law also follows this principle. The following rulings of the Federal Patent Court (*Bundespatentgericht* [BPatG]) deal with this matter:

Germania - BPatG, 26 W (pat) 052/99 of 25 April 2001

Class 21, household utensils and apparatus, cooking pots

Reasons: Not eligible for protection, because mere reference to Germany as the known country of production; the need of free availability of the Italian indication for use by competitors in import and export.

California- BPatG, 26 W (pat) 26/12 of 18 April 2012

Class 34, for tobacco among other things

Reasons: Not eligible for protection; significant interest by the general public to unrestricted use of the designation in the light of the outstanding economic importance of the U.S. state.

CCCP – BPatG, 26 W (pat) 2/08 of 21 January 2009

Class 25, textiles

Reasons: Not eligible for protection, because reference to the former Soviet Union; although an obsolete place name it is still understood by a part of the relevant public as a reference to a geographical place.

Schweizer Rechtsanwälte – BPatG, 24 W (pat) 032/ 08 of 28 April 2009

Class 35, 42, services rendered by a lawyer, among other things

Reasons: Not eligible for protection, because mere indication that the services are offered and rendered by lawyers from Switzerland.

Possible area of Convergence No. 5 Invalidation and Opposition Procedures

The grounds for refusal described in possible areas of convergence No. 2, 3 and 4 above should constitute grounds for invalidation of registered marks, and where the applicable law so provides, also grounds for opposition.

German law provides for a cancellation procedure before the German Patent and Trade Mark Office for a trade mark with a country name if the country name is descriptive or liable to deceive the public.

Possible area of Convergence No. 6 Use as a Mark

Appropriate legal means should be 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 and to request the seizure of goods bearing false indications as to their source.

The misuse of indications of geographical origin falls within the jurisdiction of the ordinary courts of law. The legal provisions in the Trade Mark Act (*Markengesetz*) read as follows:

Section 127 of the Trade Mark Act – Scope of protection

- (1) Indications of geographical origin may not be used in the course of trade for goods or services which do not originate from the place, area, territory or country which is designated by the indication of geographical origin if it is likely to mislead concerning the geographical origin should such names, indications or signs for goods or services of different origin be used.
- (2) If the goods or services marked by an indication of geographical origin have special properties or a special quality, the indication of geographical origin may only be used in the course of trade for the corresponding goods or services of this origin if the goods or services have these properties or this quality.
- (3) If an indication of geographical origin enjoys a particular reputation, it may not be used in the course of trade for goods or services of a different origin even if it is not likely to mislead concerning the geographical origin if use provides without good cause an opportunity for goods or services of a different origin to take unfair advantage of, or be detrimental to, the reputation of the indication of geographical origin or its distinctive character.
- (4) The above subsections shall also apply if names, indications or signs are used which are similar to the protected indication of geographical origin or if the indication of geographical origin is used with additions insofar as
- 1. in cases falling under subs. 1, despite the deviation or the additions, it is likely to mislead concerning the geographical origin, or
 - 2. in cases falling under subs. 3, despite the deviation or the additions, it is suitable to take unfair advantage of, or be detrimental to, the reputation or the distinctive character of the indication of geographical origin.

Section 128 of the Trade Mark Act – claim for injunction; claim for compensation of damages

(1) Anyone who in the course of trade uses names, indications or signs in contravention of [section 127](#) may be claimed against by persons with an entitlement in accordance with [section 8 subs. 3 of the Act Against Unfair Competition](#) to claim rights for an injunction if there is a danger of recurrence. The right shall also exist if a contravention is threatened. [Sections 18, 19, 19a and 19c](#) shall apply mutatis mutandis.

(2) Anyone intentionally or negligently acting in contravention of [section 127](#) shall be liable to pay compensation to the entitled party of the indication of geographical origin for the damage incurred by virtue of the contravention. The profit which the infringer made by virtue of the infringement of the right may also be taken into consideration when assessing the compensation. [Section 19b](#) shall apply mutatis mutandis.

(3) [Section 14 subs. 7](#) and [section 19d](#) shall apply mutatis mutandis

The customs authority is in charge of seizures.

If you have any questions, please do not hesitate to contact us.

Best regards,

Katrin Hübner

Section 4.3.3
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