



**World Intellectual Property Organization
34 chemin des Colombettes,
1211 Geneva 20
Switzerland**

**For the attention of the Standing Committee on the Law of Trademarks, Industrial Designs
and Geographical Indications**

January 13, 2017

**MARQUES COMMENTS ON PROTECTION OF COUNTRY NAMES AGAINST REGISTRATION AND
USE AS TRADEMARKS: PRACTICES, APPROACHES AND POSSIBLE AREAS OF CONVERGENCE**

Dear Sir/Madam,

MARQUES is an official non-governmental organisation that was granted observer status at the World Intellectual Property Organization - WIPO in 1989 by the Governing Bodies at their Twentieth Series of Meetings (cf. paragraph 213 of General Report, document AB/XX/20).

MARQUES is the European association representing brand owners' interests. **MARQUES'** mission is to be the trusted voice for brand owners. More information about **MARQUES** and its initiatives is available at www.marques.org.

This letter is in response to the Document dated 25 February 2016 prepared by the Secretariat of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications from the Thirty-Fifth Session, Geneva, April 25-27, 2016, regarding the Protection of Country Names against Registration and Use as Trademarks: Practices, Approaches and Possible Areas of Convergence.

MARQUES has now had an opportunity to review this Document and has the following comments regarding the Possible Areas of Convergence.

Possible Area of Convergence No. 1 – Notion of Country Name

MARQUES agrees with the statements therein, namely that for the purposes of examination of marks, 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.

MARQUES Ltd - Unit Q, Troon Way Business Centre, Humberstone Lane,
Thurmaston, Leicester LE4 9HA United Kingdom
Phone +44 116 274 7355 Fax +44 116 274 7365 Email: info@marques.org / aromeo@marques.org

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

MARQUES agrees with the statements therein, namely, 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.

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

MARQUES agrees with the statements therein, namely, at least for the purposes of examination, trademarks consisting of or containing a country name should be refused where the use of that name renders the mark as a whole misleading, deceptive or false in relation to the origin of the goods or services.

Possible Area of Convergence No. 4 - Consideration of Other Elements of the Mark

MARQUES agrees with the statements therein, namely, at least for the purposes of examination and unless the applicable law specifies otherwise, trademarks consisting of a country name, among other elements, should be refused where the use of that name renders the mark as a whole non-distinctive, misleading, deceptive or false in relation to the origin of the goods or services.

Possible Area of Convergence No. 5 - Invalidation and Opposition Procedures

MARQUES agrees with the statements therein, namely, 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.

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.

With respect to the first 5 Possible Areas of Convergence, these questions appeared to be grounded in trademark law. However, Possible Area of Convergence No. 6 does not appear to be so grounded and appears to be more broadly framed as preventing the use of country names if there is deception of the public and calls for seizure of goods. This appears to potentially capture non-trademark use as well as trademark use. In addition, the current remedies for this type of action appears to be different in different countries with different legislative frameworks in place. It appears also that depending on the jurisdiction, a cause of action relating to this issue may be brought by an individual entity, an independent association

and/or by a governmental authority. It appears that this issue and Possible Area of Convergence is complex and not sufficiently related to trademarks to be addressed in this framework.

We would be pleased to address any questions or concerns regarding the above.

Yours Sincerely,

On behalf of **MARQUES** the European Association of Trade Mark Owners

MARQUES International Trademark Law and Practice Team



Michael J. Leonard, Vice-Chair of the Team