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Submission from the Swedish Patent and Registration Office (PRV) in reply to questionnaire C.8607 dated 3rd November 2016 regarding the practice on “Names of States/Country Names”.

Madam/Sir,

With reference to the above mentioned questionnaire, this is the reply by the Swedish Delegation to the SCT.

Background

There is no official statutory provision in Swedish law to refuse registration of a trademark on the ground of that it is or contains a “state name”. Furthermore, no statute of permit is at hand for those circumstances.

In many cases of misleading, miss crediting, deceptive or false use of marks, those problems are solved under the Marketing Act.

(1) Notion of Country Name

With regard to commercial use, the Swedish Law does not contain any definition of a State name. Hence, a reference to a territory etc, may be perceived as a state name regardless of whether it is the formal name used in a diplomatic context, a translation and transliteration of the name as well as use of the name in abbreviated form or as an adjective.

Examples of where the notion of *country* names for example *cannot* be ruled out are:

-Popular wording of a state names; abbreviations of state names, also in context of country code top level domains (e.g.SE); former state or country names (regardless of de facto/de jure acceptance); minor

spelling differences; different country name depending on language (e.g. Netherlands/Holland).

Therefore we concur with the declaration terminology of “names of states”/”country names”, concluded in the SCT/35/4.

(2) (Non) -registrable if considered Descriptive

During the trademark application prosecution, The Swedish Patent- and Registration Office (PRV) assesses what will be embraced as a state name according to established routines and jurisprudence. The benchmarking Chiemsee - ruling of the EUCJ (C-108/97 and C-109/9) is a leading part of the routine, although this ruling actually concerning the name Windsurfing Chiemsee.

A mark consisting of a non-descriptive name and state name was tried in (CHRYSLER) MONACO, Patent Appeal Court (PBR) case 92-593. PBR concluded that the state name MONACO was well known to the Swedish consumer, although no plausible connection was found, that that the goods (cars etcetera) would origin from MONACO and therefore the mark was deemed not to mislead the consumer. The mark was held distinctive.

Another later ruling by the same instance was the case (ALASKA) 00-334, where ALASKA was considered well known to the Swedish consumers as an American state, but the geographical name could not be linked to the actual quality or otherwise of the goods (pipes, raw rubber etcetera). The mark was not deemed to mislead the consumer about the commercial origin of the goods.

(3) Consideration of Other Elements of the Mark

In case MÜNCHENER BAYERSKT LAGERÖL (MUNICH BAVARIAN LAGER BEER) 91-084, the applied mark was giving the impression that the product was manufactured in Munich and the state Bavaria, which could be perceived as misleading for a product which is in fact was produced in Sweden. There was an absence of distinctive features.

If the supplementing part of the trademark is individually distinctive, it often follows that the mark is distinctive and not descriptive as a whole, just as where the geographical place only is pointed out where the services origins. There must be a link between the geographical place and the services. KARLSTADS STADSNÄT (KARLSTAD TOWNNET), PBR case 10-282, was considered distinctive (for electronic Network providing services), but later on PBR found that LAPPLANDS ELNÄT (“north region of SE” LAPPLAND POWERNET), PBR case 15-019, was without distinctiveness (Power, power-net providing services).

PRV did find SVENSK BYGGTJÄNST (SWEDISH BUILDING SERVICE) descriptive for services as a contractor in the building and real estate sector. PBR found that PRV failed to examine if the word Swedish had a connection of establishing a quality for the services applied for and quashed the decision of PRV and sent the application back to PRV ordering PRV to examine that detail (case number 11-077).

Marks consisting of figurative parts only or figurative parts and a word are to be assessed as a whole. Where the figure in the mark is recognized by the consumer, for example, the Town Hall in Stockholm and the other lingual part of the mark is SWEDEN, lack of distinctiveness cannot be ruled out (Comparable to Södermalmsnytt “Södermalm is a part of Stockholm” NEWS, PMD case 05-404 and Östermalmsnytt “Östermalm is a part of Stockholm” NEWS, PMD case 05-406).

(4) (Non)-registrable if Considered Misleading

PRV recognizes “misleading commercial origin of the goods and services” when the geographical name is non-distinctive (e.g. MANITOBA CREAM case 10-189, citation “in light of that the mark MANITOBA does not convey something which is likely to establish a connection with the quality of the goods or others following the geographical origin is the mark not misleading”). There must be an actual misleading. If the mark contains of a misleading word and a distinctive word it will often be approved.

In addition, geographical place names as well as variations of these, where the place has a reputation, are also objected, since the use of a geographical place name in circumstances where it has a reputation creates consumer expectation could lead to deception if the expectation is not fulfilled. For example, a Danish fish producer selling “Alaska Pollock” under the mark NORWEIGAN SALMON would be considered misleading the public.

(4.1) Contrary to public morality or misleading the public

As far as the today's status on “contrary to public morality or misleading of the public”, PRV has no clear case which has been assessed under actual terms, and shows refusal to register a mark which contains a breach to public morality. PRV has revoked JAG ÄR TOKIG I SÄTER (“I am mad in Säter”) after opposition as contrary to public morality. Säter is a Swedish Community where a vast legal psychiatric ward is situated. The mark was sought for marketing services (application no. 2015/05791). As an absolute ground for refusal, a mark with a distinctive part and a statement which is contrary to public morality is deemed to be refused.

(5) Invalidation and Opposition Procedures and Use as a Mark
PRV allow observations. The observer upholds no position as part.

To oppose and make a claim against the distinctiveness of a trademark after it has been registered and published, is possible for anyone, within in three months. According to the latest law-making proposal in Sweden (following the new EU trademark directive), it would not be a possible to make an opposition claim based on absolute grounds such as distinctiveness.

In terms of invalidation, cancellation, nullification and revocation the mark can be deemed to be revoked on grounds of lacking distinctiveness (as a “state name”) if it is a consequence of the use of the mark by the holder.

(6) Competition Law/Marketing Law

There are provisions about misleading commercial origin and unfair competition of your own products or those of a competitor, as well as, by comparing products in marketing, any unfair advantage of another competitor trademark or geographical indication is prohibited. If goods are compared, those of the competitor can be pointed out, which are of the same geographical indication of origin. Under specific circumstances a breach will constitute a distortion of fair competition.