

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.

The Benelux Office for Intellectual Property (hereinafter referred to as: BOIP) considers that a country name is a geographical indication that may serve in trade to designate characteristics (such as their geographical origin) of the goods or services indicated in a trademark application. The ECJ's decision in the Chiemsee case (C-108/97) makes it clear that these descriptive indications should not be monopolized by registering them as trademarks and so BOIP has to refuse their registration. All competitors in a specific market should be able to communicate about the characteristics of the products they offer.

The notion of descriptiveness is to be based upon the expected perception of the specific sign by the relevant public, as defined by the ECJ in the Gut Springenheide case (C-210/96). Whether or not 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 is considered as descriptive will always depend on the expected interpretation of the specific sign by this public.

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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.

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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.

As far as area of convergence No. 2 is concerned, BOIP would like to point out that the absolute ground that obliges BOIP to refuse descriptive trademarks, can also be invoked in invalidation procedures before the courts. This ground will also become available as a basis for an invalidation action before BOIP from the moment the applicable legislation is adapted to give BOIP this competency. This ground may be invoked by any interested party. Oppositions can in the Benelux only be based on older trademarks.

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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.

If an interested party wants to object to the use of a trademark, the means mentioned under Area of Convergence 5 (invalidation) are available. The description of Area of Convergence 6 however seems to imply, other than the title refers to, that it concerns the use of country names in a broader sense. In case of misleading advertising, where false claims are made, an interested party can refer to the rules on misleading advertising which are laid down in the Dutch Civil Code.

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