

Submission of Norway on Possible Areas of Convergence regarding the protection of country names against registration and use as trade marks (document SCT/37/3) to the Standing Committee on Trademarks, Industrial Designs and Geographical Indications (SCT)

Madam/Sir,

Norway offers the following comments to WIPO document SCT/37/3 Annex 1, Possible Areas of Convergence Nos. 1, 2, 5 and 6, to which the members of the SCT at the 37th Session. March 27-30, 2017, were invited to submit comments.

For detailed information about the application of Norwegian law relevant to country names, we refer to the submission of Norway to the SCT/29, May 27-31, 2013, published on the Electronic Forum of the SCT and accessible via this link: <http://www.wipo.int/export/sites/www/sct/en/comments/pdf/sct29/norway.pdf>. In the following, Norway will address the merit and content of document SCT/37/3.

General comment

As reflected in SCT reference document WIPO/Strad/INF/7 para 86 and 87¹, existing possibilities to refuse applications for registration of a trademark and/or invalidate registered trademarks that consist of or contain a country name, are many and to various degrees applicable in a majority of the member states of the SCT. Hence, the Norwegian position on further work within the SCT on the protection of country names against registration and use as trademarks remains unchanged in that we do not support norm-setting activities in this area.

In our opinion, the SCT should rather focus on raising awareness amongst states, users of the trademark system and consumers about the possible application of such existing grounds for refusal and/or invalidity, in order to prevent misuse and inappropriate monopolisation of country names. A document such as SCT/37/3 Annex 1, Possible Areas of Convergence, may raise such awareness and provide useful guidance, provided that the scope and wording of the text are sufficiently clear and concise.

Comments to Possible Areas of Convergence

Norway would like to comment on some of the proposed areas of convergence that we see problematic with regard to scope and clarity of the text.

Our first comment relates to both possible areas of convergence no 1 and 2:

“No. 1 POSSIBLE AREA OF CONVERGENCE - NOTION OF COUNTRY NAME

¹ http://www.wipo.int/export/sites/www/sct/en/meetings/pdf/wipo_strad_inf_7.pdf

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.

No. 2 POSSIBLE AREA OF CONVERGENCE - 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.”

Pursuant to Article 3 (1)(c) of DIRECTIVE 2008/95/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 22 October 2008 to approximate the laws of the Member States relating to trade marks (hereafter: TMD), trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services, shall be not be registered or, if registered, shall be liable to be declared invalid. This Article is implemented in Norwegian law by Norwegian Trademarks Act § 14 (2) (a).

The correct application of TMD Article 3(1)(c) follows from the case law of the Court of Justice of the European Union (CJEU) and the General Court (GC). The general principles set out in that case law are relevant for the application of the Norwegian Trade Marks Act § 14 (2) (a).

According to established case law from the General Court, a sign’s descriptiveness cannot be assessed otherwise than by reference to the goods or services concerned, on the one hand, and by reference to the understanding, which the relevant persons have of it, on the other. See inter alia, judgment of 27 April 2016, *NIAGARA*, T-89/15. Consequently, a trademark that consists of, or contains a country name will not constitute an inappropriate monopolisation of that country name in the context of the law (or in the marketplace for that matter), if *the relevant public* does not perceive the trademark as a descriptive indication for the goods and services in question. According to reference document WIPO/Strad/INF/7, the relevant public’s perception of the mark is relevant for the application of the law in several of the member states of the SCT.

The same “test” will apply to trade marks that consist of or contain variations of the country name as those specified in Possible Area of Convergence No. 1, Notion of a Country Name. The relevant public might be familiar with references to a country other than the official or formal name of that country. However, as to the “translation and transliteration”, “the short name” and “the [...] abbreviated form” of any country’s name, it may also well be that the relevant public will *not* perceive all such variations

as references to a country and the mark will consequently not constitute any misuse or inappropriate monopolisation.

In light of the above, for the texts to have adequate value as guidance to states, users of the trademark system and consumers, the scope of text Possible Area Of Convergence No. 1 – Notion of a Country Name should be narrowed in order to serve its purpose, and Possible Area Of Convergence No. 2 – Non-Registrable if Considered Descriptive, should reflect that a trademark that consists of or contains a country name may be refused if it is *perceived* as a descriptive indication by *the relevant public*. Such a clarification would also take into account the concept of acquired distinctiveness, which, although it rarely would be the case, also may apply to trademarks containing country names.

Moreover, TMD Art. 15 (2) allows for a country name to be registered as a collective mark. Pursuant to the Norwegian Trademarks Act § 14 (4), a mark that is used in an industrial or commercial undertaking to designate the geographical origin of a product or service may be registered as a collective mark. A collective mark may be used by the members of the organization subject to the conditions indicated in the regulations for its use. The system of collective marks is an important instrument for associations who want to indicate to the public and control that the products of its members e.g. have a certain quality. Consequently, “exceptions” to the general rule not to register a descriptive sign may exist, be well founded and should be reflected in the texts.

Norway would also like to comment on possible are of convergence no 6:

“No. 6 POSSIBLE AREA OF CONVERGENCE - 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.”

According to reference document WIPO/Strad/INF/7, the use of a country name may be prohibited under several laws, for instance trademark law, tort law, laws against unfair competition, consumer protection laws etc.²

The Paris Convention for the Protection of Industrial Property provides a framework for the regulation of goods bearing false indications as to their source and of goods unlawfully bearing a mark or trade name³. The proposed text touches upon several concepts covered by the convention text, and appears as an attempt to merge several concepts without fully reflecting the content of any of them. Moreover, at present, the scope of the text covers all types of use of a country name, and sets out obligations of a state to provide legal means in a much broader area of impact than the field of trademarks. Hence, not only is the scope of the text difficult to define, the text may also interfere with the law or duties of government bodies on other areas

² See http://www.wipo.int/export/sites/www/sct/en/meetings/pdf/wipo_strad_inf_7.pdf para.75-84.

³ See inter alia, Paris Convention for the Protection of Industrial Property (as amended on September 28, 1979) Article 9, 10, 10bis and 10ter.

than trademark law. In light of this, and in light of the clear parallels made to articles of the Paris Convention, Norway is of the opinion that the proposed text in its present form may create more confusion than clarity.