

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

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PROTECTION OF COUNTRY NAMES AGAINST REGISTRATION AND USE AS TRADEMARKS: PRACTICES, APPROACHES AND POSSIBLE AREAS OF CONVERGENCE – COMMENTS BY MEMBERS

Document prepared by the Secretariat

I. INTRODUCTION

1. From its twenty-first session (June 22 to 26, 2009) to its thirty-fourth session (November 16 to 18, 2015), the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) considered a number of working documents regarding the Protection of Country Names Against their Registration and Use as Trademarks.
2. The documents were based on information provided by SCT members in their replies to the Questionnaire Concerning the Protection of Names of States Against Registration and Use as Trademarks, presented in document SCT/24/6 (hereinafter referred to as the “Questionnaire”), as well as on additional written submissions by SCT members on national law and practice concerning the protection of country names.
3. The Revised Draft Reference Document on the Protection of Country Names Against Registration and Use as Trademarks (SCT/34/2 Prov.2) was adopted by the SCT and published as document WIPO/Strad/INF/7 in accordance with the Summary by the Chair of the thirty-fourth session of the SCT (reference is made to paragraph 9 of document SCT/34/7).

4. At the thirty-fourth session of the SCT (November 16 to 18, 2015), the Chair requested the Secretariat to prepare a new document, based on document SCT/34/2 for discussion at its thirty-fifth session, identifying different practices and approaches, and existing areas of convergence in regard of the protection of country names. Accordingly, the Secretariat prepared document SCT/35/4, which drew on the information contained in document SCT/34/2 and suggested areas of convergence¹ that may arise in this field.

5. At the thirty-sixth session of the SCT (October 17 to 19, 2016), the Chair requested the Secretariat to invite SCT members to submit, in priority comments and observations to Areas of Convergence No. 1 (Notion of Country Name), No. 2 (Non-registrable if Considered Descriptive), No. 5 (Invalidation and Opposition Procedures) and No. 6 (Use as a Mark) including practical examples of how these principles are applied in their jurisdictions.

6. The present document summarizes the comments provided by SCT members on the areas of convergence, as well as examples of their national law and practice. By February 10, 2017, twenty five members sent submissions to the International Bureau: Argentina, Belarus, Canada, Colombia, Costa Rica, Finland, France, Georgia, Germany, Greece, Iceland, Ireland, Peru, Philippines, Poland, Portugal, Singapore, South Africa, Spain, Sweden, Switzerland, Tajikistan, Ukraine, United States of America and Uzbekistan. One intergovernmental organization, namely the African Intellectual Property Organization (OAPI) and the following observers also submitted contributions: European Communities Trade Mark Association (ECTA), the Japan Patent Attorneys Association (JPAA) and MARQUES – the Association of European Trade Mark Owners. The full text of all submissions is posted on the SCT Electronic Forum Webpage at: <http://www.wipo.int/sct/en/comments/>.

7. In order to facilitate the SCT discussions, comments provided by members have been summarized under each possible area of convergence. Comments provided on all possible areas of convergence have been reflected in Annex I to the present document and the examples contained in Annex II constitute a selection of those provided by SCT members in their submissions.

8. The SCT is invited to consider the present document and indicate how it wishes to pursue its work on this agenda item.

[Annexes follow]

¹ The term “area of convergence” has been used by the SCT in the past in order to name documents that describe the outcome of the work of the SCT in specific areas of trademark law. See in particular documents WIPO/Strad/INF/3 on Representation of Non-Traditional Marks and WIPO/Strad/INF/4 on Trademark Opposition Procedures at <http://www.wipo.int/sct/en/wipo-strad/>.

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.

COMMENTS RECEIVED

Argentina

Article 3(g) of Law No. 22.362 on Trademarks and Trade Names prohibits the registration as a mark of "... names or other distinctive signs used by foreign nations that have been recognized by the Government of Argentina".

Colombia

National law does not contain specific references to whether the protection covers only official names or also encompasses the name of the State that is in common use or an abbreviated version. We therefore agree that for the purpose of the examination of marks, it should be understood that a country name may cover the forms proposed in possible Area of Convergence No. 1.

Costa Rica

It is suggested that the wording "use of the name as an adjective" be further clarified.

Finland

National practice generally covers all the variations mentioned in possible Area of Convergence No. 1. Names of States are however not protected automatically and in every situation. It is necessary to take into account the awareness and language skills of the target public and, in some cases, whether the name designates a place which is associated with the goods or services claimed in the application.

France:

There is no general exclusion from registering country names as marks for goods or services.

Germany

Under national trademark law, "country names" do not form a category of their own. They are a particular type of indication of geographical origin. As a rule, such indications are refused registration as a descriptive reference to the origin of the goods and services as well as the lack of distinctive character. However, Germany supports the definition of what is deemed a country name in possible Area of Convergence No. 1.

Greece

Under article 123, section 3(a) of Law No. 4072/2012, part III on Trademarks, the names of States cannot be registered as marks. This prohibition includes in practice, not only the official or formal name, but also the common name, the translation, transliteration of that name, as well as the abbreviated name of the State. This national rule is clear and the practice of national examiners is coherent with it. Greece does not have a margin to apply a different practice.

Iceland

A country name is considered to cover, at least for the purposes of examination, the same versions or abbreviations as outlined in possible Area of Convergence No. 1.

Peru

In accordance with Decision No. 486, establishing the Common Industrial Property Regime of the Andean Community (hereinafter referred to as “Decision 486 of the Andean Community”), country names are not included in the grounds for refusal of registration as a mark.

Philippines

The Intellectual Property Office of Philippines (IPOP HL) generally follows the approach described in possible Area of Convergence No. 1. However, IPOP HL has reservations on the use of country names in abbreviated form because some abbreviations may not be commonly known to examiners, such as country names in domain name forms.

Poland

The Patent Office of Poland agrees that for the purpose of trademark examination, a country name may include the variations described in possible Area of Convergence No. 1. During the assessment of registrability, the Office often relies on the ISO 3166 standard published by the International Organization for Standardization (ISO), which defines the codes of country names, dependent territories and special areas of geographical interest. An example of national practice is provided on page 1 of Annex II.

Portugal

The Industrial Property Code (IPC) of Portugal does not contain any rules regarding the protection of country names against registration as trademarks. However, such use cannot be regarded as unlimited. Rather than direct protection, there is a limitation on use for the benefit of competing users as well as consumers. Article 223(1)(c) of the IPC provides that signs which consist exclusively of the geographical origin of the goods and services (which includes country names) cannot be registered.

Singapore

Trade marks legislation in Singapore does not define the term “country”. Instead, there are references to the term “geographical origin” in the Trade Marks Act. While absolute grounds of refusal include references to the term “geographical origin”, this term is also not defined further. Given that the term “country” is not defined in the trade marks legislation of Singapore, it is unclear whether country names would include “the official or formal name of the country, the name that is in common use, translation and transliteration of that name, the short name of the country, as well as use of the name in abbreviated form and as an adjective”. Singapore has practical concerns relating to the inclusion of these terms as part of the definition of “country name”, as it is difficult to ascertain what these could be.

Presently, in determining whether a country name is objectionable in the course of examination of an application for trade mark registration, a trade mark examiner would rely on general Internet searches. However, Singapore is of the view that these may not yield comprehensive results on the translation and transliteration of the country name, as there are many languages and hence possible transliterations of the country name. Also it is noted that countries generally have multiple variations of these names. For instance, some short names and common names of the Republic of Singapore include “Singapore”, “Singapura” and “Lion City”, and common abbreviations used to refer to Singapore include “SG”, “SGP” or “SIN”. Therefore, searches may not yield all the possible short names, common names or abbreviations of a country name.

Singapore proposes that if the SCT intends to proceed with the mandatory protection of country names against registration and use as trademarks, it could be considered creating (at WIPO) a centralized database to house “the official or formal name of a country, the name that is in common use, translation and transliteration of that name, the short name of the country, as well as the name in abbreviated form and as an adjective” of the countries to which the protection applies, so that IP offices may refer to it in the course of examination of applications for trademark registrations.

South Africa

In the Trade Marks Act 194 of 1993, there is no express definition of “country” or “country name”. There is, however, a remote reference in the form of the definition of “convention country” in section 2(1) of the Act. Therefore, in accordance with rules of statutory interpretation, the notion of a country (and by implication a country name) is presupposed and should be given its literal meaning. The trade mark examination practice of the Trade Marks Division of the Companies and Intellectual Property Commission (CIPC) reflects the conceptions of a country name considered in possible Area of Convergence No. 1. Several composite marks from the Register of Trade Marks are provided on page 1 of Annex II.

Spain

The notion of country names in Spain coincides with the indication contained in possible Area of Convergence No. 1.

Sweden

The Law of Sweden does not contain a statutory provision to refuse the registration of a trademark on the ground that it is or contains the name of a State, for which there is no definition. Hence, reference to a territory may be perceived as the name of a State, regardless of whether it is the formal name, a translation and transliteration of the name as well as use of the name in abbreviated form or as an adjective.

Switzerland

The notion of country name as detailed in possible Area of Convergence No. 1 is the same as in Switzerland. Specifically, country names are considered direct indications of origin, i.e. specific designations as to the geographical origin of goods or services. Linguistically correct derivatives – e.g. adjectives – are treated on the same footing as the country names themselves. Reference is made to the Trademarks Directives of the Federal Intellectual Property Institute.

Tajikistan

The name of a State covers the short name of that State or the name that is in common use, which may or may not be the official name. In accordance with Article 8(4) of the Law on Trademarks and Service Marks “... registration as trademark shall not be allowed for designations that consist only of elements representing the official names of States ...” Such names may be incorporated in a trademark as non-protected elements, subject to the consent of a competent authority.

Ukraine

The national Office supports the notion of country names as set out in possible Area of Convergence No. 1.

United States of America

While one would like to think that all country names are known to all of the consumers of the world, it is not a certainty. Moreover, the farther away one moves from the name of the country to the variations of the country name listed in possible Area of Convergence No. 1, the less likely the terms will be known to the local consumer, particularly translation or transliteration. As such, the list of identifiers in possible Area of Convergence No. 1, which could be used to presume equivalency with a country name, is much too broad. If there is any suggestion that use of these identifiers in a trademark application should be considered *per se* deceptive or otherwise shift the burden of proof that use is not deceptive, we observe that such a presumption would be completely false in those instances where the name is unknown to the local consumer. The United States of America proposes to narrow this possible area of convergence to a formulation that is more likely to be true, that is where it could be said that a country name is known to the local consumer and perceived as actually referencing the country.

Uzbekistan

In accordance with Article 10(2) of the Law on Trademarks, Service Marks and Appellations of Origin, designations representing the official names of States cannot be registered as trademarks.

OAPI

The notion of country name is not specifically defined in the Bangui Agreement², in particular Annex III thereto on trademarks and service marks, which is the national intellectual property law of the seventeen OAPI States³, or the relevant implementing regulations. The proposal in possible Area of Convergence No. 1 meets with the approval of OAPI. That is to say, a country name can be “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 inclusion of translation and transliteration is, in our view, necessary. At our office, any part of a sign registered as a mark which is in a language other than French or English (the working languages of OAPI) must be translated or transliterated by the applicant so that the examiner can ensure its compliance with public policy and morality.

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.

COMMENTS RECEIVED

Argentina

Article 2(a) of Law No. 22.362 on Trademarks and Trade Names stipulates that “names, words and signs” that describe the “nature, function, qualities or other characteristics” of a mark may not be registered. This exclusion applies to country names indicative of a place of manufacture where that place is recognized as the origin of such goods by different manufacturers. Otherwise, country names, unless misleading or appellations of origin, may be registered.

Canada

On February 23, 2016, the Federal Court of Appeal amended the test for geographically descriptive trademarks in the case of *MC Imports Inc. v. AFOD Ltd., 2016 FCA 60*. In this recent decision, the Court established a test for determining whether a geographical name is non-registrable as a trademark due to it clearly describing the place of origin of the associated goods or services. A trademark will now be considered to be a geographic name in Canada if research shows that it has no other meaning than as a geographic name. The test entails first determining whether the trademark is a geographic name, and second, determining whether the goods or services originate from the geographic location used as the trademark.

While the first step of the test may be straight-forward in many instances, there may be cases where the name of a geographic place also has other meanings. To the extent there is ambiguity on whether the trademark actually refers to a place, the analysis would focus on consumer perceptions, where the relevant ordinary consumer from whose perspective the

² Agreement establishing the African Intellectual Property Organization concluded in Bangui, Central African Republic, on March 2, 1977.

³ Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Comoros, Congo, Côte d’Ivoire, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Mali, Mauritania, Niger, Senegal and Togo.

question ought to be considered is the ordinary consumer of the products or services with which the mark is associated.

Once it is concluded that the trademark refers to a geographic location, the focus of the analysis becomes the origin of the goods or services. Goods or services may be found to originate from a geographic location if they are manufactured, produced, grown, assembled, designed, provided or sold there or if the main component or ingredient is made in that geographic location. If the associated goods or services originate in the place referred to by the trademark, then the trademark is clearly descriptive of place of origin. On the other hand, if the trademark refers to a geographic place that is not the actual place of origin of the goods or services, then it cannot be clearly descriptive of place of origin, and further analysis is required to determine whether the trademark is deceptively misdescriptive.

This objective test will increase the difficulty of applicants to overcome objections as a result of geographic descriptiveness. This clarification provides further certainty that there is a sufficient level of protection in Canada to prevent bad faith use of country names. The Canadian Intellectual Property Office has updated its examination manual to reflect this decision.

Colombia

Decision 486 of the Andean Community contains a set of assumptions that fulfill the mandate established in Article 6*quinquies* of the Paris Convention for the Protection of Industrial Property (hereinafter referred to as “the Paris Convention”), in that they prohibit the registration of signs that do not meet the requirement of distinctiveness, which can be found in descriptiveness, genericity and common use. However, the descriptiveness of a sign, a cause of irregularity cited in Article 135(e) of Decision 486, can occur when the sign to be registered consists exclusively of a geographical name that is known to the public as the one from which the product quality originates. But in fact, it is not sufficient for the sign to be of a geographical origin or place to conclude that it is descriptive, since the consumer does not necessarily associate that origin with the quality of the product and, moreover, where there is no link between the origin and the quality of the product, the mark may be granted.

The national Office considers that any sign that lacks distinctiveness may or may not be descriptive and this is independently assessed. However, if the sign is not distinctive, it cannot be regarded as a valid mark. Where the trade mark consists solely of a country name which relates to products, this would be an issue more appropriately addressed under geographical indications. It is therefore necessary to draw a distinction in possible Area of Convergence No. 2 between, on the one hand, the descriptive character of the mark and the confusion that can arise if the product does not come from the named country and, on the other, a case in which there is a total lack of distinctiveness.

Costa Rica

The national Office considers that it is appropriate to clarify in possible Area of Convergence No. 2 that a country name is not necessarily descriptive of the origin of all the products coming from that nation, but only where that country is recognized as the place of production of the goods and services claimed in the application.

Finland

Names of States are excluded from registration as marks for goods or services if the mark could be considered descriptive or misleading as to the origin of the goods or services. Under the Trademarks Act of Finland, a trademark that denotes either alone or with a few alterations or additions (*inter alia*) the quality or place of manufacturing of the goods shall not, as such, be regarded as distinctive and shall not be eligible for registration. When assessing distinctiveness, the mark is considered as a whole. If the mark contains other distinctive elements apart from the country name, it can be considered distinctive as a whole. When assessing the distinctiveness of a mark, the Office must take into account the awareness and language skills

of the relevant class of persons. When a country name is included in a mark, the assessment should be whether an average consumer is able to get the impression of an indication of the source of origin. Examples of national practice are provided on page 2 of Annex II.

France

Article L 711-2(b) of the Intellectual Property Code (CPI) stipulates in particular that “The following are not distinctive: [...] signs or names which may serve to designate a feature of the product or service, particularly the type, quality, quantity, destination, value, geographical origin, time of production of the goods or provision of the service [...]”. Country names must be distinctive, as with all appellations used as marks. However, by their very nature, geographical names and hence names of States designate particular places and as such cannot be monopolized by means of registration. This concerns two types of geographical name: those not considered suggestive by the general public and, conversely, those which are not neutral in the mind of the consumer. The examination thus depends primarily on the assessment of the distinctive and non-descriptive character of the term in question. An example of national practice is provided on page 2 of Annex II.

Germany

It is correct that trademarks consisting solely of a country name should be refused where the country name describes the place of origin of the goods or services. Rulings of the Federal Patent Court follow this principle. An example of national practice is provided on page 2 of Annex II.

Iceland

Marks consisting solely of a country name in any of the versions described under possible Area of Convergence No. 1 are refused if considered descriptive for the goods and/or services in question. This is the same as outlined in possible Area of Convergence No. 2.

Peru

Decision No. 486 of the Andean Community establishes that signs may not be registered as trademarks if they lack distinctiveness or consist exclusively of a sign or indication that may serve in trade to describe the quality, quantity, intended purpose, value, place of origin of the goods or services or that may mislead the commercial circles or the public about the geographical origin of the goods or services.

Philippines

In accordance with Section 123(1)(j) of the Intellectual Property Code of the Philippines, a mark cannot be registered if it consists exclusively of signs or indications that may serve in trade to designate the geographical origin of goods and services. This provision covers country names.

Poland

In accordance with Article 129 of the Industrial Property Act of Poland “signs which consist exclusively or mainly of elements which may serve, in trade, to designate the kind, origin, quality, quantity, value, intended purpose, manufacturing process, composition, function or usefulness of the goods, cannot be registered”. Therefore, if a trademark consists solely of a country name, it would be considered descriptive of the place of origin of the goods or services and therefore not registrable (for example: Poland, France, PL, FR, etc.). If a word mark contains a country name and some other elements which may also serve to also designate the previously indicated elements, it will be considered descriptive and therefore not registrable (for example: Polish coffee, artificial coffee, flavored coffee, etc. in class 30; Japanese cars for vehicles in class 12).

Portugal

Article 223(1)(c) of the Industrial Property Code (IPC) of Portugal provides that signs which consist exclusively of the geographical origin of the goods and services (which includes country names) cannot be registered. It could be argued that if there is no connection between the name and the product or service mentioned in the application, the registration may be granted. However, the fact that the sign is not solely composed of the country name does not mean that it will be immediately registered. A limitation may arise from the fact that the sign in question could also mislead the consumer about the origin of the product or service in accordance with Article 238(4)(d) of the IPC.

Singapore

Under section 7(1)(b) of the Trade Marks Act, a trade mark which is devoid of any distinctive character shall not be registered. Under section 7(1)(c) of the Trade Marks Act, a trade mark comprising a country name would be refused registration if it is found to consist exclusively of signs or indications which may serve, in trade, to designate the geographical origin of goods or of rendering of services. The objections in section 7(1)(b) and (c) can be overcome if the trade mark, before the date of application for registration, has in fact acquired a distinctive character as a result of the use of it, under section 7(2) of the Trade Marks Act.

The examination practice of Singapore for marks comprising names denoting geographical locations indicate, in summary, that where the geographical location has a reputation for the goods or services listed in the application or closely related goods or services, such application will be refused. Particularly, the Office would have a stricter stand for applications concerning goods which are natural produce. The names of places, which because of their characteristics are likely to be the source of natural products, are unlikely to be registrable. An example of a mark filed with the national office of Singapore is provided on page 3 of Annex II.

The registrability of geographical places with no reputation and where the application does not include natural products will be assessed against the following criteria: (i) how well-known the name of the geographical location is and (ii) the goods and services with which the place is currently associated. Applying these criteria, the names of geographical locations outside Singapore are generally acceptable for services, unless the services are of the sort that are likely to be provided in Singapore from overseas, such as financial services, entertainment or travel accommodation. Examples of marks filed with the national office of Singapore, which illustrate the above principles are provided on page 3 of Annex II.

A mark consisting exclusively of a sign designating geographical origin can be registered if in fact, it has acquired a distinctive character as a result of use before the date of application for registration. However, it may be nearly impossible to overcome the objection on the basis of use if the mark comprises exclusively the name of a country.

South Africa

The Trade Marks Act does not contain a general exclusion to the registration of signs which consist of country names independently of any other consideration. However, section 10(2)(b) of the Act finds application in prohibiting the use of names designating the origin of goods or services. It states: "Unregistrable trade marks: The following marks shall not be registered as trade marks, or, if registered, shall, subject to the provisions of sections 3 and 70, be liable to be removed from the register: ... (2) a mark which – ... (b) consists exclusively of a sign or an indication which may serve, in trade, to designate ... geographical origin ..." The Courts in South Africa have held that Section 10(2)(b) is not concerned with distinctiveness, but serves a public interest and seeks to preserve the rights of other traders."

The Supreme Court of Appeal provided definitive guidance in respect of section 10(2)(b) and set out the historical rationale for provisions prohibiting the use of names designating the geographical origin of goods or services: “The reasons for these provisions [are] that the vocabulary of the English language is common property which belongs to all and that no one should be permitted to prevent other members of the community from using ‘for purposes of description’ a word that has reference to character or quality of goods and one assumes, geographical names ...”⁴.

A refusal on absolute grounds based on section 10(2)(b) of the Act in relation to a simpliciter geographical name does not find application in relation to a composite mark. In this regard, cognizance must be taken of section 15 of the Act which provides the Registrar with a discretionary power to require, as a condition for granting or maintaining a registration, that if a trade mark contains matter which is not capable of distinguishing, it should be disclaimed. Therefore, in terms of section 15(a), a mark which contains a country name with additional matter would only be registered subject to the applicant disclaiming the right to the exclusive use of the country name.

In terms of section 15(b), the Registrar, at the stage of examination, may require as a condition of registration an endorsement to be entered by the applicant which is necessary for the purpose of defining his rights under the registration. The courts in South Africa have recognized this discretionary power (albeit in exceptional circumstances) in relation to special forms of disclaimers where geographical names are in question.

Spain

According to national law, country names are not descriptive *per se*; they only indicate the geographical origin of defined products or services. For example, the mark “Spain Apples” accompanied by a very characteristic figurative element would be admissible and the indication of goods should read: “apples originating from Spain”.

Sweden

During the prosecution of the trademark application, the Swedish Patent and Registration Office (PVR) will assess what can be considered as the name of a state according to the established practice and jurisprudence. The benchmark *Chiemsee* ruling of the Court of Justice of the European Union (EUCJ) (joined cases C–108/97 and C–109/97) is a leading part of the practice.

Where a country name is considered to be well-known to the local consuming public, the analysis would be whether any plausible connection can be established between that name and the goods covered by the application. If the answer is negative, the mark would be deemed not to mislead the consumer. In other cases, it may be considered whether the geographical name can be linked to the actual quality or other characteristic of the goods and whether this is likely to mislead the consumer about the commercial origin of the products. The same applies in relation to service marks. An example of relevant national practice is provided on page 3 of Annex II.

Switzerland

In Switzerland, marks consisting exclusively of country names are also denied registration owing to their descriptive character. Indications of a descriptive nature are objective indications on goods or services (in this connection, see in particular Article 6*quinquies* B.2 of the Paris Convention. Interested parties do not perceive them as references to any particular company (devoid of distinctive character) and they should in principle remain freely available to all market players (availability requirement).

⁴ Harms DP in *Century City Apartment Property Services CC and Another v Century City Property Owner’s Association* 2010 (3) SA 1, Supreme Court of Appeals of South Africa.

Tajikistan

Article 8(1)(3) of the Law on Trademarks and Service Marks provides for the refusal of an application where the sign indicates the place of origin of the goods. Therefore, a country name that is considered descriptive would be refused registration.

Ukraine

In accordance with national law, trademarks which consist exclusively of designations or data that are descriptive when used in relation to the goods and services claimed in the application should be refused, in particular when they indicate the place, time of manufacture, sale of the goods or provision of the services. The Office will nevertheless assess the position of such a designation has in the mark. Along with this rule, national law provides for a separate ground for refusal of a trademark containing the official name of a country. Such a name may however be included in a trademark as a non-protectable element provided that consent has been given by the competent authority. Yet, this ground does not exclude examination of the trademark as to distinctiveness. National law does not extend the ground for refusal to the name of the State in adjectival form. Instead, the examiner will check if the trademark is misleading with regard to the geographical place of origin of the goods or services.

United States of America

In the typical case of a trademark consisting solely of the country name, we can see how possible Area of Convergence No. 2 superficially appears to reflect convergence in national systems: most trademark laws provide that a mark should be refused when it is descriptive of the origin of the goods or services. However, there are exceptions to the rule that geographically descriptive matter is non-registrable, and the exceptions are significant.

Under US law, a geographically descriptive mark may acquire distinctiveness and therefore, would be eligible for registration. Of course, in the case of a country name, acquiring such distinctiveness would be difficult because a showing of acquired distinctiveness requires continuous and exclusive use of the matter for the goods or services. Country names are considered to be in the public domain so it would be a rare circumstance that a trademark applicant could legitimately claim that it has acquired distinctiveness for a mark consisting solely of a country name for the particular goods or services in a jurisdiction, although not impossible. That said, considering the variations of the country name as included in possible Area of Convergence No. 1, a successful showing of acquired distinctiveness becomes increasingly possible.

There is yet another exception to the principle that geographically descriptive marks should be refused: under trademark systems used for the protection of geographical indications, geographically descriptive matter is registrable under certain circumstances. Possible Area of Convergence No. 2 suggests that delegations agree that there should be a prohibition of registration of country names or any variations as certification marks of regional origin, or collective marks or trademarks that function as geographical indications owned by the country itself or a certifying authority for the country. That could be an unintended consequence, but nonetheless, it is one that undermines trademark systems for the protection of geographical indications. The United States of America proposes to narrow possible Area of Convergence No. 2 to ensure that when a geographic term including a country name is distinctive, it is registrable.

Uzbekistan

According to Article 10(8) of the Law on Trademarks, Service Marks and Appellations of Origin, designations used to indicate the characteristics of the goods, including the type, quality, quantity, properties, purpose, value, as well as the place and time of manufacturing or sale of goods cannot be registered as trademarks.

OAPI

Any mark devoid of distinctive character cannot be validly registered with OAPI. The same is true for any sign which is solely descriptive, in particular of the nature, characteristics or geographical origin of the goods or services in question. Therefore, a country name would not be considered a valid mark if it were used to describe the place of origin of the goods or services or if it were perceived by the public only as an indication of the place of origin of those goods or services.

POSSIBLE AREA OF CONVERGENCE No. 3 NON-REGISTRABLE IF CONSIDERED MISLEADING, DECEPTIVE OR FALSE

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.

COMMENTS RECEIVED

Colombia

Article 135(i) of Decision No. 486 of the Andean Community prohibits the registration as a mark of signs that “may mislead the business community or the public, in particular as to geographical origin[...].” In order for a sign to be considered misleading, the above rule does not require that it be so in its entirety; it is sufficient that a part of the sign may mislead the business community or the public as to the origin of the product or its characteristics, among other factors. Refusal of registration of a sign for this reason does not require the misleading to have occurred; the requirement is that it may occur. In this light, a mark should not indicate a false provenance that attributes characteristics or positive connotations to the product if this is not consistent with reality. Thus, if the national Office were to examine “D’RICARDOS THE SWISS WATCH”, which is manufactured in Bogota with Colombian technology, it would find this type of product misleading because the quality of Swiss watches is recognized.

Costa Rica

The name of a country becomes misleading when that country is recognized as the place of production of the goods or services claimed in the application.

Finland

A country name can be excluded from registration as a trademark if it is misleading as to the origin of the goods or services claimed in the application.

France

Article L 711-3(c) of the Intellectual Property Code (CPI) stipulates in particular that “The following may not be adopted as a mark or an element of a mark: [...] (c) Signs liable to mislead the public, particularly as regards the nature, quality or geographical origin of the goods or services.” Cases of deception are more common where the country already has a particular reputation such that its appropriation does not appear to be legitimate. Such cases can take many different forms, e.g., deception as to the appearance of official guarantees of the goods or as to the source or origin of goods.

The approach of the National Industrial Property Institute (INPI) to deception, for signs partially consisting of a country name, differs according to whether the sign in question designates goods or services. Signs filed to distinguish only services are never, or hardly ever, challenged on the grounds that they are misleading. For signs filed exclusively for goods, the INPI makes a distinction according to the following, non-exhaustive, list of assumptions, on a case-by-case basis.

Combining the name of a State or its adjectival form with the name of goods does not serve to define what, in the design, manufacture or sales process, was done in France. On the basis of this ambiguity, the INPI issues an objection to the registration in which the examiner requests the applicant to explicitly indicate the restrictive reference “all goods of French origin or made in France” on the list of goods for which the sign was filed. If the applicant refuses to include this restrictive reference, the goods that are the subject of the challenge are refused mark registration. An example of relevant national practice is provided on page 4 of Annex II.

These decisions in these types of cases seek to determine whether the State in question has a particular reputation for the goods and services claimed or whether those goods and services are actually produced or provided in that State and fall within one of its economic sectors. If so, an objection is registered on the grounds of lack of distinctiveness, the descriptiveness of the sign and deception.

Singapore

Under section 7(4)(b) of the Trade Marks Act, a trade mark comprising a country name would be refused registration if it is found to be of a nature as to deceive the public, for instance, as to the geographic origin of the goods or services. The examination practice of the Singapore Office in relation to geographical names is as follows. In relation to goods, the use of a geographical name in a trade mark would lead consumers to view the mark as an indication of the source of the goods and would be objectionable if the goods do not originate from the location. However, if the geographical name in the trade mark appears merely to be a fanciful association, this would be acceptable. In relation to services, the use of a geographical name in a trade mark is usually more acceptable as it is less likely to be regarded as an indication of the origin of the services. Examples of relevant national practice are provided on page 4 of Annex II.

Sweden

The Swedish Patent and Registration Office (PVR) determines that there is misleading commercial origin when the geographical name is likely to establish a connection between the applied-for sign and the quality or other characteristics of the goods or services. Misleading character must be certain. 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 a consumer expectation that could lead to deception if the expectation is not fulfilled.

POSSIBLE AREA OF CONVERGENCE No. 4 CONSIDERATION OF OTHER ELEMENTS OF THE MARK

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.

COMMENTS RECEIVED

Colombia

Decision No. 486 of the Andean Community provides that other elements must be taken into account to find that a sign containing a country name may be considered descriptive or misleading. Examples include the link that the consumer finds to exist between the characteristics of the product and its origin or provenance, or the potential of the sign to deceive the business community or the public as to the provenance of the product or its characteristics.

Finland

When assessing distinctiveness, the mark is assessed as a whole. If the mark contains other distinctive elements apart from the country name, it may be considered distinctive as a whole.

France

Signs consisting of the name of an entity combined with the term “France” are challenged where the message conveyed is ambiguous. However, signs combining the term French with an entity name are not objected to since there is no notion of manufacture. Where the name of an entity infers the notion of manufacture, the INPI will assess the elements as a whole. In practice, references to the notion of manufacture must be sufficiently accurate. For instance, the INPI will accept the term “factory” but will object to the term “processing plant”. The entity name must include the name of a specific product. References to other goods in the filing will be challenged.

Some expressions containing references to a country name eliminate any risk of deception and are not challenged. Examples: Designed in France/Made in France/French manufacture/Manufactured in France/French store. However, for ambiguous expressions such as “created in France”, “French creation” or “à la française”, the INPI will object where those terms do not serve to determine whether the product is designed or made in France. Including the reference “all goods of French origin or made in France” after the list of goods objected serves to remedy the defect of deception. Examples of relevant national practice are provided on page 5 of Annex II.

Poland

If a trademark contains a country name and some other descriptive elements but it also contains graphic elements, it may be registered provided the graphic elements are sufficiently distinctive to indicate the origin of the goods and services. Examples of registered marks of the latter type are provided on page 5 of Annex II.

Singapore

For marks containing a country name together with other elements, the mark would be examined as a whole to determine whether it is distinctive. Hence, a trademark containing a country name may not be refused if it is considered distinctive as a whole. The presence of other elements in the mark is not a relevant factor in determining whether the mark would be deceptive.

Sweden

If other elements of the mark are to be considered, it is important to assess whether any of those elements would mislead the consumer as to the place of production of the goods. If the additional elements of the trademark are individually distinctive, it often follows that the mark is distinctive and not descriptive as a whole. Marks consisting of figurative elements or a word will be assessed as a whole. Where a figurative element is recognized by the consumer, for example, if the mark is composed of the Town Hall Building of Stockholm and the verbal element “Sweden”, lack of distinctiveness cannot be ruled out. Examples of registered marks of the latter type are provided on page 5 of Annex II.

Tajikistan

In accordance with Article 8(2) of the Law on Trademarks and Service Marks where the name of a country is (a) the country of origin of the applicant (his location) and (b) is not a dominant element of the mark, the trademark may be registered if consent is provided by the competent authority and the name of the country will be included as a non-protected element.

*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.

COMMENTS RECEIVED

Argentina

Article 4 of Law No. 22.362 on Trademarks and Trade Names stipulates that in order to “exercise the right to oppose” the registration or use of a trademark, the applicant or opponent “must have a legitimate interest”. Thus, “any person” with a legitimate interest can oppose a trademark application provided, of course, they can prove the existence of a de facto situation worthy of legal protection. Oppositions can be based on any legal cause establishing grounds for the non-granting of the mark in question. Under Article 24(a) of the aforementioned Argentine Law, registrations made “in breach of the provisions” of said Law shall be null and void. This refers to marks that, for one reason or another, should not have been registered but were nonetheless granted by the respective office. Requests to annul registrations are not handled by the trademark office: they must be referred to the Federal Civil and Commercial Court.

Canada

Section 18 of the Trade-marks Act of Canada provides for the invalidation of a trademark registration in Canada. Specifically, section 18(1) states that the registration of a trademark is invalid if the trademark was not registrable at the date of registration. As such, judicial decisions ruling on the registrability of a trademark, as in the case *MC Imports Inc. v. AFOD Ltd.*, regarding geographically descriptive trademarks, apply in invalidation proceedings. Additionally, under section 38(2)(b) of the Trade-marks Act, an opposition to the registration of a trademark may be based on the ground that a trademark is not registrable as set out above. As in the case with invalidation, case law assessing the registrability of a trademark applies in an opposition proceeding. Therefore, the grounds for refusal of the registration of a trademark will also apply to opposition and invalidation proceedings in Canada.

Colombia

During the process of registration of a trademark, the national Office orders the publication of the application if it fully meets the legal requirements as to form. For a period of 30 days after publication, interested third parties may oppose the registration, alleging that the sign is descriptive or misleading as to the geographical provenance of the products or services for which it is to be used. Likewise, the national Office may *ex officio* so declare in the administrative decision on the application for trademark registration and thus refuse registration. Subsequent to the registration of the trademark, if it is considered that it has been granted in violation of the provisions of Decision No. 486 of the Andean Community, the absolute nullity of the corresponding administrative decision may be argued before the Council of State, the highest court for administrative disputes in Colombia.

Finland

Finland applies a system of post-registration opposition. The Trademark Office hears opposition cases whereas invalidation procedures are processed by the Market Court. The Trademarks Act of Finland does not contain specific provisions on the filing of an opposition or invalidation claim based on the point that the trademark contains a country name. The ground for invalidation or opposition in such a case would be that the trademark lacks distinctiveness or misleads the public. The Office examines these grounds *ex officio* during the trademark application procedure. Arguments for opposition or invalidation could be, for example, that the Office has incorrectly found the mark to be distinctive and thus eligible for

registration in the first place, or that the Office has incorrectly interpreted the proof of use on acquired distinctiveness or that the proof of use itself has not been sufficient and accurate enough.

If the trademark includes a country name, the ground for opposition or invalidation could be that the mark misleads the public as to the origin of the goods or services. The trademark can be misleading before registration, i.e. it should not have been registered since the mark refers to a country where the proprietor does not have its domicile, or the trademark has become misleading after registration. The latter situation is regulated in section 26 of the Trademarks Act of Finland.

The Office is not aware of any case law (office practice or court decisions) on opposition or invalidation proceedings where the claim would have concerned a trademark including a country name and thus being descriptive or misleading.

France

Article L712-3 of the Intellectual Property Code (CPI): "Publication shall contain a notice that any interested party may submit observations within a period of two months to the Director of the National Institute of Industrial Property (INPI)." Article R712-9 of the Intellectual Property Code: "Observations filed in light of Article L. 712-3 shall be communicated without delay to the applicant by the INPI or shall be dismissed without effect if it is ascertained that they were submitted after the expiry of the prescribed time limit or that their subject matter is obviously extraneous to the legislative provisions in force. The author of the observations shall be so informed." Applications for invalidation are currently a judicial procedure governed by Article L714-3 of the IPC. Whereas action for invalidation is action for absolute invalidation open to any interested party, in accordance with French procedural law, applicants must prove that they have *locus standi*.

Article 45 of EU Directive 2015/2436 of December 16, 2015 to approximate the laws of the Member States relating to trade marks (recast), currently being transposed into national legislation, provides for the establishment of an administrative procedure for revocation or declaration of invalidity. The administrative procedure for invalidity is based in particular on Article 4 of said Directive regarding absolute grounds for refusal or invalidity. Absolute grounds for invalidity concern, inter alia, marks devoid of any distinctive character, marks which consist exclusively of signs or indications designating geographical origin and misleading marks.

Germany

National law provides for a cancellation procedure to be applied with the German Patent and Trade Mark Office in the case of a trademark with a country name if the country name is descriptive or liable to deceive the public.

Iceland

Trademark Legislation of Iceland provides for both opposition and invalidation procedures (administrative or courts). The grounds for either of the two are the same as grounds for refusal and cover the grounds described in possible Areas of Convergence No. 2, 3 and 4.

Philippines

Although the Intellectual Property (IP) Code of the Philippines and its regulations do not specifically enumerate the grounds for invalidation and opposition, these are taken into account because section 151 provides that a petition for cancellation may be filed if the registration of a mark was obtained contrary to the provisions of the IP Code. This means that if a country name was registered even if it is descriptive of, or misleading as to the geographical origin of the goods, then it can be cancelled for having been registered contrary to the provisions of the IP Code. Section 134 on opposition, on the other hand, provides that any person who may be

damaged by the registration of the mark may file an opposition. It does not provide for specific grounds. For example, if the mark “Italy” or “Italia” was registered for pasta or wine and the goods do not come from Italy, it can be cancelled or opposed for being misleading.

Poland

If a registered trademark that contains or consists of a country name is considered descriptive, it is possible to invalidate such a mark based on grounds for refusal under Article 129 of the Industrial Property Act. Currently, the Act does not foresee a possibility to file an opposition against a trademark application based on absolute grounds. However, at any point before the trademark registration, third parties may submit to the office written observations explaining on which grounds the trademark should not be registered.

Singapore

Under section 13 of the Trade Marks Act, any person may, within the prescribed time from the date of publication of the application, give notice to the Registrar of opposition to the registration, by including a statement of the grounds of opposition and other related matter. The grounds of opposition include absolute grounds for refusal of registration relating to marks that describe the place of origin of the goods or services and marks which deceive the public as to the origin of the goods or services. Under section 23 of the Trade Marks Act, the registration of a trade mark may be declared invalid on the grounds that the trade mark was registered in breach of absolute grounds for refusal.

South Africa

Trademark examination encompasses both absolute and relative grounds for refusal. Likewise, an opposition (pre-registration) can be based on the same grounds. An opposition to a mark which consists exclusively of a country name can be based on the absolute ground of being exclusively descriptive, *inter alia* of geographical origin. A further ground for refusal could be section 10(12) of the Trade Marks Act, which states that a trademark cannot be registered if it “... is inherently deceptive or the use of which would be likely to deceive or cause confusion...” Generally speaking, this ground for opposition is designed largely for the protection of the public against all forms of deception. It is recognized in South African Law that deception of origin can be as to the geographical origin of the goods where a trade mark is such that it suggests origin from a particular country and its use on goods not produced in that country is calculated to deceive.

It is worth noting, however, that a mark deemed to be inherently deceptive as to the geographical origin of the goods at the stage of examination can be resolved by requiring the applicant to enter a country or place of origin endorsement. This endorsement must be requested where the mark could possibly indicate a source of origin that might mislead or confuse the consumer.

Section 10(13) of the Trade Marks Act provides another ground for opposition in that it precludes the registration of a mark which, as a result of the manner in which it has been used, would be likely to deceive or create confusion. How this ground intersects with country names is that it will prevent the registration of trade marks that in use are confusing or deceptive as to origin. It is therefore possible to have, in relation to the same application consisting of a composite mark: (a) a disclaimer of the geographical origin appearing in the mark and (b) an undertaking that the country of origin will be clearly indicated on the goods, as these two endorsements fulfill two different functions, yet both contribute towards the registrability of the mark as applied for.

Spain

An opposition may be based on the absolute ground for refusal provided in Article 5(1)(g) of the Trademark Law according to which signs may not be registered as trademarks when they are likely to mislead the public as to for example, the nature, quality or geographical origin of the

product or service. The name of the State (Spain) may be registered when it forms part of a verbal or graphical grouping that is sufficiently characteristic or distinctive, as long as it does not mislead the public or suggests that the sign is a guarantee mark or has official sponsorship if such is not the case. However, the fact that the word "Spain" is present in a sign as the main or predominant element constitutes indicia that this may be a sign which falls within the scope of Article 5(1)(g) of the Trademark Law, although this cannot be established as a general rule and the analysis must be on a case-by-case basis.

Sweden

Within a period of three months from the publication of the registration of the mark, any interested person may file opposition on the grounds of lack of distinctiveness. However, according to a recent proposal to transpose European Union Directive No. 2015/2436 of December 16, 2015 into national law, it will no longer be possible to file an opposition based on absolute grounds, such as lack of distinctiveness. The Swedish Patent and Registration Office (PVR) allows for observations to be filed. However, the author of the observation does not become a party to the procedures. It is possible to have a mark revoked if, as a consequence of the use made of it by the holder, the mark has become non-distinctive.

Switzerland

During the registration procedure, the Swiss Federal Institute of Intellectual Property (IPI) checks as a matter of course whether there are any absolute grounds to deny trademark protection. If so, applications for registration are refused. Descriptive marks (grounds for refusal set out in possible Area of Convergence No. 2) are denied registration in accordance with Article 2(a) of the Law on the Protection of Marks (LPM) on the basis that they are devoid of any concrete distinctive character.

Marks liable to mislead as to geographical origin are denied registration in accordance with Article 2(c) LPM (grounds for refusal set out in possible Areas of Convergence Nos. 3 and 4). Thus, marks containing country names are denied registration if the list of goods and services is not limited to the indicated country of origin. Under the Institute's restriction practices, any sign containing a reference to a particular geographical origin may be registered as a mark only if it concerns the goods or services corresponding to that reference. The list of goods or services is consequently restricted in line with the expectations of consumers to avoid their potentially being misled. For simple indications of Swiss or foreign origin, the Institute imposes a restriction to the country of origin. For example, the mark "SWISSPOR" (mark No. P-470286) is registered in Switzerland for class 17 goods originating from Switzerland.

Individuals establishing that they have a legal interest may file an action with the competent judicial authorities for the annulment of any mark considered to have been registered despite the existence of absolute grounds for exclusion.

Tajikistan

In accordance with Article 33 of the Law on Trademarks and Service Marks, if a trademark was granted contrary to the requirements set out in Article 8 (devoid of distinctive character or consisting exclusively of elements representing the official names of States), any person may request the invalidation in full or in part of the mark, at any point during its term of validity.

Ukraine

In accordance with national law the ground for refusal of registration of a mark, namely non-registrable if considered descriptive constitutes a ground for invalidation and also a ground for opposition.

United States of America

In principle, the United States of America agrees that the grounds of refusal in examination should be the same as those grounds for opposition or invalidation.

Uzbekistan

According to Article 24 of the Law on Trademarks, Service Marks and Appellations of Origin, a trademark registration certificate may be declared invalid in total or in part during the entire term of its validity if it was issued in breach of the requirements specified in Article 2(2) and Article 10(1) to (12). These provisions concern absolute grounds for refusal, in particular Article 10(2) refers to the official names of States. The trademark registration certificate may also be declared invalid in total or in part during a period of three years from the date of publication of the registration if acts performed by the owner of the mark have resulted in unfair competition in the prescribed manner. Cases of invalidation are submitted to the Board of Appeals or the Court. Opposition procedures are not stipulated in national law.

OAPI

Under the OAPI system, procedures for opposition (before the office) and annulment (before the courts) have the same objective, i.e. to strike from the special register any mark that fails to meet the conditions for validity laid down in Annex III, Articles 2 and 3 of the Bangui Agreement. The grounds for refusal set out in possible Areas of Convergence No. 2, 3 and 4 should constitute grounds for opposition and annulment of registered trademarks.

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.

COMMENTS RECEIVED

Argentina

Under Article 4 of the Law No. 22.362 on Trademarks and Trade Names, any person may oppose the use of a mark. This is the basis for any civil injunction to prohibit the use of a mark. Thus, any applicant with a "legitimate interest" has the necessary means to prevent the use of a country name where such use is misleading as to the nature, quality or geographical origin of goods or services. This principle is well founded: it is enshrined in legislation to protect the interests of both trademark holders and consumers and to foster good business practice, thereby enabling the free, harmonious and honest development of trade. Lastly, Article 10*bis* of the Paris Convention, ratified in our country by Law No. 17.011, constitutes a directly applicable standard.

Colombia

Article 11 of Law No. 256 regulating Acts of Unfair Competition (Law No. 256) which regulates acts of unfair competition in Colombia, in accordance with Article 10*bis* (3)(iii) of the Paris Convention, states: "The use or dissemination of incorrect or false statements or assertions, the omission of true ones and any other type of practice which, by virtue of the circumstances in which it occurs, is liable to mislead the persons to whom it is directed or reaches as regards the activity, the commercial services or establishments of others and as regards the nature, the method of manufacture, the characteristics, suitability in use or the quantity of the products shall be prohibited." Moreover, Article 31 of the same law provides for the measures that may be taken by a court to prevent or stop act of unfair competition, such as acts of deception, thus: "[...] on proof the commission of an act of unfair competition or the imminence thereof, the court, on application by a person with locus standi and under the responsibility of such person, may order the temporary cessation of such act and institute other appropriate precautionary measures." "The measures provided for by the court shall be processed preferentially. In case of serious and imminent danger, they may be adopted without hearing the opposing party and may be issued within twenty-four hours following the filing of the

application. If the measures are requested before the application is filed, the judge at the place in which the act of unfair competition produces or is liable to produce its effects shall also have jurisdiction.” A reading of articles 11 and 31, supports the conclusion that Colombian legislation has the appropriate legal means to prevent or cause the cessation of the use of country names, where such use is intended to mislead the persons to whom it is directed, regarding the characteristics or qualities of the product.

Finland

The Trademarks Act of Finland does not contain specific provisions concerning the use of a trademark containing a country name, nor specific limitations to the use of such marks. Section 26(1)(2) of the Trademarks Act provides that “the exclusive rights in a trademark shall be invalidated if the mark has become misleading or contrary to law and order or morality since it was registered or became established.”

Section 36 provides that “if a trade symbol that has been transferred or licensed becomes misleading in the form in which it is used by the new proprietor or licensee, a court of law may, at its discretion, prohibit the new proprietor or licensee from using it.” And section 37 provides that “if the use of a trade symbol is prohibited under section 36, the court may, where practicable, order that a trade symbol placed on goods, their packaging, brochures, leaflets, commercial documents or the like contrary to a prohibition under section 36 be erased or amended so as to no longer be misleading. If this cannot be done in any other way, the Court shall order that the material so marked be destroyed or changed in a specified manner. Material referred to above may be confiscated pending the implementation of the said order in which case the general regulations on confiscation in criminal cases shall apply.”

The Consumer Protection Act 38/1978 sets out the provisions on fair marketing. A trader is prohibited from giving false or misleading information during its commercial activity concerning, *inter alia*, the quality and the origin of the good. Also, the Unfair Business Practices Act 1061/1978 sets out the provisions for good business practices. The trader is prohibited *inter alia*, from giving a false or misleading expression concerning its own business if the said expression is likely to affect the demand for or supply of a product or harm the business of another trader. Therefore, instruments for third parties to prevent such uses are governed by legislation other than the Trademarks Act. Unfortunately, the Office is not aware of any case law concerning use of a trademark containing a country name.

France

Articles L 121-1 to L 121-7 of the Consumer Code stipulates that a commercial practice is misleading where it occurs in one of the following circumstances: (1) where it engenders confusion with other goods or services, marks, trade names or other distinctive signs of a competitor, and (2) where it relies on allegations, indications or presentations which are false or likely to mislead and covers one or more elements and in particular “the essential characteristics of the goods or services, namely: their substantial qualities, content, accessories, origin, quantity, method and date of production, conditions of use, suitability for use, properties, expected outcomes of use and outcomes and main features of tests and inspections performed on the goods or services”;

Officials of the General Directorate of Competition, Consumer Affairs and the Repression of Fraud are authorized to investigate and record infringements. Punishable individuals are professionals who engage in practices contrary to the professional diligence requirements set out in the Directive, such as “the standard of special skill and care which a trader may reasonably be expected to exercise commensurate with honest market practice and/or the general principle of good faith”. The cessation of misleading commercial practice may be ordered by an authorized official, either by an investigating judge or by the court seized of the proceedings.

Germany

The misuse of indications of geographical origin falls within the jurisdiction of the ordinary courts. The customs authorities are in charge of seizures. Section 127 of the Trade Marks Act prohibits the misleading use of indications of geographical origin for goods or services not originating from the place, area, territory or country designated by the indication. Indications of geographical origin with a particular reputation enjoy additional protection against being used for goods and services of a different origin if such use would constitute an opportunity to take unfair advantage of, or be detrimental to, the reputation of the indication of geographical origin or its distinctive character. Both principles also apply in cases of deviations from or additions to the original indication of geographical origin if those deviations or additions do not eliminate the ability of the signs in question to mislead or to unfairly exploit or harm the reputation or distinctive character of the original indication of geographical origin. Section 128 of the Trade Marks Act provides for remedies in such cases and in particular a request for injunctions or a claim for compensation of damages.

Iceland

Iceland agrees that appropriate legal means should be provided for interested parties to prevent the use of country names if such use is likely to deceive the public in the manner outlined in possible Area of Convergence No. 6. In Iceland it is possible to file a complaint, i.e. based on these grounds with the Icelandic Consumer Agency based on Act No. 57/2005 on the surveillance of unfair business practices and market transparency.

Philippines

The Intellectual Property (IP) Code of the Philippines provides for remedies against misleading use. Section 166 provides that no article of imported merchandise calculated to induce the public to believe that the article is manufactured in any foreign country or locality other than the country or locality where it is in fact manufactured shall be admitted to entry at any customs house of the Philippines. Section 168 provides for acts constituting unfair competition and section 169 provides for acts constituting false designations of origin, false description or false representation. The remedies of search and seizure are available to the complainant under the prescribed rules.

Poland

Interested parties may rely on the Unfair Competition Act in order to prevent the use of country names if such use is likely to deceive the public. According to Article 8 of the Act, labelling products with a false or misleading geographical indication, directly or indirectly indicating a country, a region or locality, or the use of such indications in commercial activity, advertising, business letters, invoices or other documents, shall be an act of unfair competition. Article 9 of the Act states that where the product or service is protected in its place of origin and its specific features or properties are linked with that origin, the false or misleading use of those geographical indications shall be an act of unfair competition, even if the words "kind", "type" or "method" were added.

Further, where an act of unfair competition is committed, the entrepreneur whose interest is threatened or infringed may request: (1) the surrender of the prohibited practice, (2) the removal of effects linked with the prohibited practice, (3) making one or more statements of appropriate content and form, (4) compensation for damages pursuant to the general rules, (5) handing over of unjustified benefits and (6) where the act of unfair competition has been deliberate, awarding an adequate amount of money to a determined social goal (for example in support of Polish culture or the protection of national heritage).

The burden of proof as to the veracity of the marking or information placed on products or their packaging, or statements contained in advertising, shall fall upon the person that has been accused of an act of unfair competition connected with misleading character.

Singapore

The Trade Marks Act does not have provisions allowing 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, or to request the seizure of goods bearing false indications as to their source.

South Africa

There are various legislative frameworks that deal with the use of a mark which is misleading or deceptive as to geographical origin. Each legislative framework provides for its own procedures and mechanisms for sanctioning such use. Section 10(13) of the Trade Marks Act precludes the registration of a mark which, as a result of the manner in which it has been used, would be likely to deceive or cause confusion. It is accepted that this subsection applies equally to the use after registration leading to deception or confusion. Under section 26 of the Act, if a trade mark fails to comply with any condition entered in the register in relation to the registration (such as failure to comply with a country/place of origin endorsement), any interested person may apply to court or to the registrar for any order varying or removing the registration.

Sections 6 to 11 of the Merchandise Marks Act 17 of 1941 (as amended) contain provisions, statutory powers and criminal sanctions in respect of: applying a false trade description and alteration of a trademark, sale and hiring out of goods bearing false trade descriptions, sale of imported goods bearing the name or make of a South African manufacturer or trader, unaccompanied by an indication of origin, sale of imported goods bearing marks in an official language, unaccompanied by an indication of origin, power to require an indication of origin and compliance with specified standards in the case of certain classes of goods, and to prescribe the type of indication of origin of goods to be made.

Sections 24, 29 and 41 of the Consumer Protection Act of 2008 contain provisions which may prohibit the use of a mark which is misleading or deceptive as to geographical origin. The provisions concern product labelling and trade descriptions, right to fair and responsible marketing (general standards for marketing of goods or services) and false, misleading or deceptive representations.

The Liquor Act 59 of 2003 is an example of a legislative framework which is aimed at regulating a specific industry. As such, Section 9 of the Act imposes certain advertising restrictions: "(1) A person must not advertise – (a) any liquor or methylated spirits – (i) in a false or misleading manner ..."

Sweden

Under the Marketing Act of 2008, incorrect statements that are misleading with respect to business of a person or the business activity of another person are prohibited. This applies, *inter alia*, to representations which concern the origin of a product, provided that it affects or is likely to affect the ability of the recipient of the statement to make a well-founded business decision. Moreover, in the context of comparative advertising, the comparison may not give rise to confusion, take unfair advantage of the reputation associated with the trademark of a competitor, its business name, or other distinctive signs, or the designation of origin of the goods concerned. In respect of goods bearing a designation of origin, the comparison must pertain to goods of the same designation.

Switzerland

In light of the requirements of Article 10 in relation to Article 9 of the Paris Convention (PC), the Member States should provide the appropriate legal means to interested parties to prevent the use of false indications as to the source of products or services. As specified by the Guide to the Application of the Paris Convention, this provision applies "to all direct or indirect uses of a

false indication of the source of goods, irrespective of whether such indication is the name of a specified locality or country or is joined to a trade name of a fictitious character or used with fraudulent intention”⁵.

In Switzerland, geographical indications are afforded general protection *sui generis*, independent of any registration. Accordingly, any goods, agricultural or otherwise, are protected provided they meet the conditions set out in the Law on the Protection of Marks (LPM), an Act which protects any direct or indirect reference to the geographical origin of goods or services against unlawful use (false or misleading indications of origin, LPM Article 47) with a view to perpetually protecting the value of Swiss indications of origin and establishing a basis on which to effectively combat abusive usages. For example, the indication “St Gallen” is protected for embroidery despite not being listed in any federal or cantonal register. Where inaccurate indications of origin are used, the LPM provides for legal action through civil claims. Under Article 52 of the LPM, any individual who establishes a legal interest has the capacity to bring an action for recognition of a right or legal relationship. Any individual whose right to an indication of origin has been infringed may also file an injunction to prohibit or eliminate said infringement under LPM Article 55. An aggrieved party may also file actions for damages, compensation of non-pecuniary losses and forfeiture of profits under LPM Article 55(2).

The use of inaccurate indications of origin is also a criminal offence prosecutable *ex officio* under LPM Article 64(1). Intentional use of an inaccurate indication of origin is punishable by fine or custodial sentence of up to one year. If the offender acts commercially, the act is punishable by fine or custodial sentence of up to five years. In the event of a custodial sentence, a fine is also issued.

Ukraine

The Trademark Law of Ukraine does not contain any specific prohibition of the use of trademarks that are likely to deceive the general public, in particular concerning the geographical origin of the goods and services. Such trademarks are non-registrable and if they have been registered, they may be invalidated. However, if the producer, while making use of indications in the course of trade, provides misleading information to the consumer, in particular deceptive data about the origin of the goods, such activity is deemed to be unfair competition and will be prohibited. Ukraine supports possible Area of Convergence No. 6 and considers that interested parties should have access to appropriate legal means of preventing the use of country names if such use is likely to deceive the public as to the geographical place of origin of the goods and services.

United States of America

The scope of the text of “Possible Area of Convergence No. 6: Use as a Mark” is significantly broader than its title suggests. The text clearly imputes obligations from Paris Convention Articles 9 and 10 (seizure upon importation of goods bearing false indications of source), and Article 10*bis* (unfair competition) to the handling by WIPO Members of country names in trademarks with some serious implications.

First, the inclusion of concepts of unfair competition –making actionable the use of a country name that deceives as to the “nature or quality” of the goods or services– starts with the assumption that country names are capable of source identification beyond geographical origin. Paris Convention Article 10*bis* requires WIPO Members to make actionable acts of unfair

⁵ Guide to the Application of the Paris Convention for the Protection of Industrial Property, 1969, by Professor Georg Bodenhausen, p. 145.

competition between competitors where allegations in the course of trade are used that create confusion or mislead consumers; this is not limited to false allegations of geographical origin but includes concepts like misappropriation or passing off.

As noted above, it would be a rare circumstance that a trademark consisting solely of a country name would be capable of identifying source other than geographical origin. Yet the text gives the impression that country names are *per se* source identifiers, beyond geography, to the government of the country of origin. In other words, possible Area of Convergence No. 6 suggests that misuse of a country name, beyond deception as to geographic origin of the goods or services, is an act of unfair competition perpetuated against the government of a country. This area of convergence could be read to mean that governments are interested parties under Article 10*bis* in claims of unfair competition related to use or misuse of country names in trademarks. Moreover the language referenced in the area of convergence is drawn from Article 10*bis*(3)(iii) which refers only to goods while the area of convergence text also covers services. This interpretative expansion could call into question the implementation of some WIPO Members of their obligations under Article 10*bis*.

Second, because this possible area of convergence is called “use as a mark” and focused entirely on geographic matter in trademarks, not on labels *per se*, we have concerns with the suggestion that Paris Convention Article 10 must be applied to the mark, instead of an analysis of the label or packaging on which the trademark appears. For the United States of America, Article 10 is implemented through a variety of laws and regulations, not just the Trademark Act, but also the US Tariff Act along with regulations issued by the US Customs and Border Protection Service (CBP). The interplay between the Customs regulations and the trademark provisions with regard to country of origin labeling is complex.

OAPI

Any use of a country name liable to mislead the public, particularly as to the nature, quality or geographical origin of the goods or services in question, should be prevented using the appropriate legal instruments, the aim of which should be to stop the use of the mark by means of injunctions and to award damages and any other compensation provided for by civil law, without prejudice to the legal avenues provided by trademark legislation.

[Annex II follows]

The examples contained in this Annex constitute a selection of those provided by SCT members in their submissions.

Possible Area of Convergence No.1
Notion of Country Name

Poland

Case 6 II SA433/03 of 28 May 2004

The Court held that it is impossible to register a trademark that consists of the two-letter country code defined in ISO standard, in the present case, the code of South Africa.

South Africa

Several composite marks from the Register of Trade Marks:

Official or formal name of the State: Trade Mark Registration N° 2011/23006

LE TOUR DE FRANCE in class 12, subject to the following limitation: *“Registration of this trade mark shall give no right to the exclusive use of the word “FRANCE” separately and apart from the mark.”*

Name that is in common use: Trade Mark Registration N° 2006/23002

MZANSI FO SHO in class 41 subject to the following limitation in respect of the common colloquial term used for South Africa: *“Registration of this trade mark shall give no right to the exclusive use of the word “MZANSI” separately and apart from the mark.”*

Translation and transliteration of a country name: Trade Mark Registration N° 2012/00265

CHINA TELECOM in class 35 subject to the following endorsement: *“The transliteration of the Chinese characters in the mark is ZHONG GUO DIAN XIN which means CHINA TELECOM in English. Registration of this trade mark shall give no right to the exclusive use of “CHINA” in its geographical connotation, apart from the mark.”*

Use of the country name in abbreviated form: Trade Mark Registration N° 2009/19989

USA PRO in class 28 subject to the following limitation: *“Registration of this trade mark shall give no right to the exclusive use word USA separately and apart from the mark.”*

Use of the country name as an adjective: Trade Mark Registration N°. 2000/13700

FLAMBOS~MEXICAN~FLAME GRILLED CHICKEN in class 29 subject to the following limitations: *“Registration of this trade mark shall give no right to the exclusive use of the word MEXICAN or of the word GRILLED CHICKEN separately and apart from the mark.”*

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

Finland

Application No. T201452470 **NORWEGIAN** (08/12/2014) – Certain services in classes 39 and 43.

Granted: The trademark consists solely of the word NORWEGIAN which means a native or national of Norway, the language of Norway or something relating to Norway. The Office found the trademark descriptive for all the services in classes 39 and 43 since the mark indicated the geographical origin and the quality of the services. The mark was also found misleading as to the origin of the services since the applicant was Irish. The applicant limited the list of services to cover only certain services in class 39 relating to air travel and provided proof of use of the mark. The trademark was considered to be used for a long enough period of time and to such an extent, the mark had reached the required level of distinctiveness through genuine use.

France

Applications: **MOROCCO** (No. 073517019), **MOROCCO** (No. 073517015) and **MOROKO** (No. 03517017) in classes 9, 14, 18 and 25.

Refused by the Court of Appeal of Paris, confirming a decision from the National Intellectual Property Institute (INPI).

Germany

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

Germania – Class 21

Refused: the Federal Patent Court decided that the mark was not eligible for protection, because of a mere reference to Germany as the known country of production. The Court also considered the need to keep free the Italian translation of the country name "Germania" for use by competitors in import and export markets.

Singapore

Trade Mark No.40201505876V



Certain goods in class 29

Objectionable: The mark is descriptive of the geographical origin of the goods, indicating that they are from New Zealand ("NZ"). New Zealand is the world's largest exporter of dairy commodities, representing approximately one third of the international dairy trade each year.

Trade Mark No. 40201505398Q

THAI TOWN

Certain services in classes 35 and 43.

Acceptable

Trade mark No. N° T1205498I

MOZAMBIQUE GAS

Certain goods and services in classes 4, 40 and 42.

Objectionable.

Sweden

Patent Appeal Court (PBR) case No. 92-593.

(CHRYSLER) MONACO

The PBR concluded that the state name MONACO was well known to the Swedish consumer, although no plausible connection was found, that the goods (cars etcetera) would originate from Monaco and therefore the mark was deemed not to mislead the consumer.

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

France

EVI  **FRANCE**

Class 34

INPI formulated a substantive objection as to the misleading character of the term “France”. The applicant then filed the following limitation: “all these goods originate from France or are manufactured in France”.

Singapore

Trade Mark No. T1413659A

teuscher
Chocolates of Switzerland

Class 30: chocolate.

Objectionable: the mark will lead consumers to believe that the goods on which the mark is applied originate from Switzerland. Application was restricted to “Chocolate originating from Switzerland”.

Trade Mark No. 40201510518Q



Services in class 35.

Acceptable.

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

France



Registered in class 25.

Poland



Registered in classes 30 and 35.



Registered in classes 29, 30, 31, 35 and 43.

Sweden

SVENSK BYGGTJÄNST (SWEDISH BUILDING SERVICE)

Case number No.11-077

The Swedish Patent Appeal Court (PBR) found that the Swedish Patent and Registration Office (PRV) failed to examine if the word Swedish had a connection with the quality of the services applied for, overturned the decision of PRV and resent the application to be examined in detail.

[End of Annexes and of document]