

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

**Forty-Third Session**  
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REVISED PROPOSAL BY THE DELEGATION OF JAMAICA

*Document prepared by the Secretariat*

In a communication dated October 30, 2020, the Delegation of Jamaica transmitted to the International Bureau a revised version of the proposal contained in document SCT/32/2, entitled “Revised Draft Joint Recommendation Concerning Provisions on the Protection of Country Names”. Annex II to the present document contains the revised version of the proposal by the Delegation of Jamaica, while Annex I contains a cover page with an explanation thereof.

[Annexes follow]

## REVISED PROPOSAL FROM JAMAICA

The Delegation of Jamaica has taken the liberty of preparing a Revised Draft Joint Recommendation for the Protection of Country Names (attached), as has been done in relation to other trade mark areas of common importance and convergence, which could guide and be used by Member States in trademark examination manuals at the national and regional level, in order to promote consistent and comprehensive protection for country names.

Like the two previous versions, the Revised Draft Joint Recommendation incorporates language and definitions largely from the previous Joint Recommendations (including well-known marks and marks on the internet), as well as from Article 6 *ter* of the Paris Convention, the WIPO Study (Doc. SCT/29/5) and the Revised Draft Reference Document on the Protection of Country Names Against Registration and Use as Trademarks (Doc. SCT/30/4). It also incorporates the definition of “nation brand” taken from WIPO Document SCT/43/3 REV. 2, Compilation of Questions on Nation-Brand Protection in Member States and WIPO Document SCT/43/8, Returns to the Questionnaire on Nation-Brand Protection in Member States.

We have sought to revise the previous version of our proposal to positively respond to previous comments from Member States at the SCT. We have narrowed somewhat the definition of “country name”.

Articles 2 to 5 address marks that conflict with country names and essentially provide for the same protection as is provided for well-known marks. Article 2 includes bad faith applications for registration. It would only be optional for guidance purposes only. Article 3 details what should qualify as conflicting marks, that is, marks which conflict with a country name.

Articles 4 and 5 were drafted based on the WIPO Study and Report and seek to recommend acceptable grounds for refusal (in addition to Articles 2 and 3) and acceptable grounds for acceptance (subject to Articles 2 to 4). Information/documentary evidence is required for those sections so as to place the onus on applicants rather than on intellectual property offices to establish the legitimacy of the use of the country name.

Article 6 covers oppositions and invalidations and Article 7 covers unfair competition and passing off.

Finally, Article 8 outlines factors for determining false connection to a state, which provides the express flexibility desired by many delegations, as it provides additional grounds and factors which permit applicants to establish a genuine connection to a state and therefore a valid basis to use a country name in their trademark

We have streamlined the articles to refer to trademarks only and not business identifiers and domain names. We have also simplified the language, making the text shorter and easier to read and understand.

The Delegation of Jamaica continues to believe that convergence among member states on an agreed approach to the protection of country names in the trademark system is possible. We are very grateful to the delegations to the SCT for purposeful and constructive engagement on this very important global issue and hope that the Revised Draft Joint Recommendation can serve the purpose of facilitating continued discussion and constructive engagement, as we together seek to find common solutions to this problem.

[Annex II follows]

**REVISED DRAFT  
JOINT RECOMMENDATION  
CONCERNING PROVISIONS ON THE PROTECTION OF COUNTRY NAMES**

**PREFACE**

The Joint Recommendation Concerning Provisions on the Protection of Country Names aims at harmonizing the examination and determination of applications for the registration of trademarks which consist of or contain country names, in order to promote consistent and comprehensive treatment and protection of country names among Member States.

Further to the adoption by the WIPO Assemblies of the Joint Recommendation Concerning Provisions on the Protection of Well-known Marks, in September 1999, the Joint Recommendation Concerning Trademark Licenses in September 2000, and the Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet, in October 2001, this Joint Recommendation represents an achievement of the SCT in implementing WIPO's policy of finding new ways to accelerate the development of international harmonized common principles.

**Joint Recommendation**

The Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO),

*Taking into account* the provisions of the Paris Convention for the Protection of Industrial Property relative to the protection of armorial bearings, flags, and other State emblems of the countries of the Union, and official signs and hallmarks indicating control and warranty adopted by them;

*Considering* the deliberations within the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) since 1999 concerning the protection of country names, and the Study to determine possible best practices for the protection of country names from registration as trademarks, or as elements of trademarks (Doc. SCT/29/5) and the Revised Draft Reference Document on the Protection of Country Names Against Registration and Use as Trademarks (Doc. SCT/30/4), which revealed the diverse practice of states and therefore the lack of internationally consistent protection for country names in regard to the examination and treatment of applications for the registration of trademarks which consist of or contain country names;

*Recommend* that each Member State may consider the use of any of the provisions adopted by the SCT, as guidelines for the examination and treatment of applications for the registration of trademarks which consist of or contain country names;

*It is further recommended* to each Member State of the Paris Union or of WIPO which is also a member of a regional intergovernmental organization that has competence in the area of registration of trademarks, to bring to the attention of that organization the possibility of protecting country names in accordance, *mutatis mutandis*, with the provisions contained herein.

Provisions follow.

## Article 1 Definitions

For the purposes of these Provisions, unless expressly stated otherwise:

(i) “act of unfair competition” means any act of competition contrary to honest business practices in industrial or commercial matters as defined in Article 10 *bis* of the Paris Convention for the Protection of Industrial Property, signed in Paris on March 20, 1883, as revised and amended;<sup>1</sup>

(ii) “application” means an application for registration;<sup>2</sup>

(iii) “competent authority” means an administrative, judicial or quasi-judicial authority of a Member State which is competent for determining whether a mark conflicts with a country name, whether a right has been acquired, maintained or infringed, for determining remedies, or for determining whether an act of competition constitutes an act of unfair competition, as the case may be;<sup>3</sup>

(iv) “connection” means association with the country either by virtue of the origin or destination of the goods or services;<sup>4</sup>

(v) “country name” includes the official name, the short name, the formal name, the historical name, translation, transliteration, denomination, international code, standard abbreviation and adjectives of any of those names of a Member State;<sup>5</sup>

(vi) “internet” refers to an interactive medium for communication which contains information that is simultaneously and immediately accessible irrespective of territorial location to members of the public from a place and at a time individually chosen by them;<sup>6</sup>

(vii) “mark” means a mark relating to goods (trademark) or to services (service mark) or to both goods and services;<sup>7</sup>

(viii) “Member State” means a State member of the Paris Union for the Protection of Industrial Property and/or of the World Intellectual Property Organization;<sup>8</sup>

(ix) “nation brand” means a sign adopted by a State, including a logo, symbol or emblem, that serves as a visual element of any policy or strategy intended to promote national identity and/or the image of a country;<sup>9</sup>

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<sup>1</sup> Taken from Article 1 of the Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet.

<sup>2</sup> Taken from Article 1 of the Joint Recommendation Concerning Trademark Licenses.

<sup>3</sup> Taken from Article 1 of the Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet.

<sup>4</sup> Original definition/criteria. Alternatively, see Article 10.

<sup>5</sup> Original definition based on the Revised Draft Reference Document on the Protection of Country Names Against Registration and Use as Trademarks (Doc. SCT/30/4)

<sup>6</sup> Taken from Article 1 of the Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet.

<sup>7</sup> Taken from the Joint Recommendation Concerning Trademark Licenses.

<sup>8</sup> Taken from Article 1 of the Joint Recommendation Concerning Provisions on the Protection of Well-known Marks and from Article 1 of the Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet.

<sup>9</sup> Adapted from WIPO Document SCT/43/3 REV. 2, Compilation of Questions on Nation-Brand Protection in Member States and WIPO Document SCT/43/8, Returns to the Questionnaire on Nation-Brand Protection in Member States

- (x) “office” means the agency entrusted by a Member State with the registration of marks;<sup>10</sup>
- (xi) “person” shall be construed as references to both a natural person and a legal entity;<sup>11</sup>
- (xii) “registered” or “registration” means the registration of a mark by an Office;<sup>12</sup>
- (xiii) “remedies” means the remedies which a competent authority of a Member State can impose under the applicable law, as a result of an action for the infringement of a right or an act of unfair competition;<sup>13</sup>
- (xiv) “right” means a trademark right in a sign, whether registered or unregistered, under the applicable law.<sup>14</sup>

## Article 2

### Protection of Country Names; Bad Faith

- (1) [*Protection of Country Names*] A Member State shall protect country names against conflicting marks.<sup>15</sup>
- (2) [*Consideration of Bad Faith*] Bad faith may be considered as one factor among others in assessing competing interests in applying these Provisions.<sup>16</sup>
- (3) [*Factors*] For the purposes of applying these provisions, any relevant circumstance shall be considered in determining whether a mark that consists of or contains a country name, was or is being or is intended to be used in bad faith. In particular, the competent authority shall take into consideration, inter alia, whether the trademark applicant or proprietor intended, by their adoption or use of the mark, to represent a false connection between the goods or services with which the mark is used or intended to be used, and the country named in the mark.

## Article 3

### Conflicting Marks<sup>17</sup>

- (1) [*Conflicting Marks*] (a) A mark shall be deemed to be in conflict with a country name and therefore liable to be refused registration, where that mark, or a part thereof, consists of or contains a country name and use of that mark:
- (i) is liable to create confusion, or to deceive the public as to the nature, quality and/or geographical origin of the goods or services, if the mark is the subject of an application for registration, or is registered, in respect of goods and/or services;

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<sup>10</sup> Taken from Article 1 of the Joint Recommendation Concerning Provisions on the Protection of Well-known Marks.

<sup>11</sup> Original definition.

<sup>12</sup> Taken from the Joint Recommendation Concerning Trademark Licenses.

<sup>13</sup> Taken from Article 1 of the Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet.

<sup>14</sup> Adapted from Article 1 of the Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet.

<sup>15</sup> Adapted from Article 3 of the Joint Recommendation Concerning Provisions on the Protection of Well-known Marks.

<sup>16</sup> Adapted from Article 3 of the Joint Recommendation Concerning Provisions on the Protection of Well-known Marks.

<sup>17</sup> Adapted from Article 4 of the Joint Recommendation Concerning Provisions on the Protection of Well-known Marks.

(ii) would indicate a false connection between the goods and/or services for which the mark is used, is the subject of an application for registration, or is registered, and the relevant Member State identifiable by the country name;

(iii) is likely to impair or dilute the distinctive character, reputation, country name and/or nation brand of the relevant Member State identifiable by the country name;

(iv) would take unfair advantage of the distinctive character, reputation, country name and/or nation brand of the relevant Member State identifiable by the country name.

(b) It is open to Member States to find that a mark which consists of or contains a country name, in relation to goods or services which do not originate in the country indicated by the country name, satisfies any or all of the criteria outlined in paragraph (a) above.

(c) Irrespective of the goods and/or services for which a mark is used, is the subject of an application for registration, or is registered, it is open to Member States to find, without satisfying the criteria outlined in paragraph (a) above, that a mark is in conflict with a country name where the mark, or a part thereof, consists of or contains a country name and the mark is being used or intended to be used in relation to goods or services which do not originate in the country indicated by the country name.

(2) [*Opposition Procedures*] If the applicable law allows third parties to oppose the registration of a mark, a conflict with a country name under paragraph (1)(a) shall constitute a ground for opposition.

(3) [*Invalidation Procedures*] (a) If the applicable law allows third parties to invalidate the registration of a mark, a conflict with a country name under paragraph (1)(a) shall constitute a ground for invalidation.

(b) If the registration of a mark may be invalidated by a competent authority on its own initiative, a conflict with a country name shall be a ground for such invalidation.

(4) [*Prohibition of Use*] The relevant Member State which is identifiable by a country name, or a legal person authorized by the relevant Member State, shall be entitled to apply to a competent authority to oppose, invalidate or request the prohibition of, the use of a mark which is in conflict with the country name.

## Article 4

### Determination of Whether to Refuse a Mark with a country name<sup>18</sup>

(1) [*Factors for Refusal*] In addition to the circumstances outlined in Articles 2 to 3 above, the Office or competent authority shall refuse registration of a mark which consists of or contains a country name:

(i) where the mark is considered descriptive of the origin of the goods in respect of which registration is sought, even if the mark does not “consist exclusively” of the country name;

(ii) where the use of the name of a State could be considered to be misleading, deceptive or false as to the origin of the goods or services for the which registration is sought, even if the mark includes other elements which accurately represent the origin of the product;

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<sup>18</sup> Based on the Study to determine possible best practices for the protection of country names from registration as trademarks, or as elements of trademarks (Doc. SCT/29/5) and the Revised Draft Reference Document on the Protection of Country Names Against Registration and Use as Trademarks (Doc. SCT/30/4).

(iii) on the basis of public order or morality as defined by national law and/or policy in place to protect country names; or

(iv) on the basis of any national law that offers *sui generis* or *per se* protection for country names;

(2) The competent authority shall consider information submitted to it with respect to factors from which it may be inferred that the mark is, or is not, distinctive, descriptive, generic, misleading, deceptive or false.

## Article 5

### Determination of Whether to Accept a Mark with a country name<sup>19</sup>

(1) [*Factors for Acceptance*] Subject to Articles 2 to 4 above, the Office or competent authority may accept registration of a mark which consists of or contains a country name:

(i) If the application for registration of the mark is supported by documentary evidence to show that the goods or services for which the mark is proposed to be registered originate from the country named in the trademark;

(ii) If the application for registration of the mark is supported by documentary evidence of authorization by the competent authority or authorities, if any, of the relevant Member State;

(iii) If the application for registration of the mark is supported by documentary evidence of the applicant's compliance with established national law and/or policy of the relevant Member State named in the trademark regarding use of the country name or other related designation;

(iv) if evidence is presented by the Applicant to show that the country name as used in the mark has a secondary non-geographical meaning and that the mark is not liable to be perceived by the public as misleading, deceptive or false as to the origin of the goods and/or services for which registration is sought; or

(v) if evidence is presented by the Applicant to show that the mark is well-known and/or has a reputation and that the mark is not liable to be perceived by the public as misleading, deceptive or false as to the origin of the goods and/or services for which registration is sought.

(2) If the goods or services for which the mark is registered or intended to be registered originate from the country named in the trademark, the Office or competent authority, where it has the power to do so, may impose a condition or limitation on the registration of the mark, to the effect that the mark shall only be used in relation to goods and/or services which originate in the Member State identifiable by the country name in the mark.

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<sup>19</sup> Based on the Study to determine possible best practices for the protection of country names from registration as trademarks, or as elements of trademarks (Doc. SCT/29/5) and the Revised Draft Reference Document on the Protection of Country Names Against Registration and Use as Trademarks (Doc. SCT/30/4).

## **Article 6**

### **Oppositions and Invalidity**

The grounds provided in Articles 2, 3 and 4 for refusing the registration of a trademark as being descriptive, non-distinctive, generic, misleading, deceptive or false, shall apply to Opposition and Invalidity Proceedings as applicable under national law.<sup>20</sup>

## **Article 7**

### **Unfair Competition or Passing Off<sup>21</sup>**

There shall be liability in a Member State under the applicable law when an act of unfair competition or passing off is committed, through use of a mark consisting of or containing a country name, which is misleading, deceptive, false and amounts to an act of unfair competition or passing off in accordance with national law.

## **Article 8**

### **Factors for Determining False Connection to a State<sup>22</sup>**

[Factors] In determining whether use of a mark, which consists of or contains a country name, would indicate a false connection to a Member State that is identifiable by the country name, the following factors may be considered:

- (a) circumstances indicating whether the user of the mark is doing business in relation to goods or services which originate in the Member State;
- (b) circumstances indicating whether the user of the mark is doing business in the Member State, in relation to goods or services which are associated with the mark;
- (c) the level and character of commercial activity, if any, of the user in relation to the Member State, including:
  - (i) whether the user is actually serving customers located in the Member State;
  - (ii) whether the user offers post-sales activities in the Member State, such as warranty or service; or
  - (iii) whether the user undertakes further commercial activities in the Member State which are related to the use of the mark.

[End of Annex II and of document]

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<sup>20</sup> Based on the Study to determine possible best practices for the protection of country names from registration as trademarks, or as elements of trademarks (Doc. SCT/29/5) and the Revised Draft Reference Document on the Protection of Country Names Against Registration and Use as Trademarks (Doc. SCT/30/4).

<sup>21</sup> Adapted from Article 7 of the Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet.

<sup>22</sup> Adapted from Article 3 of the Joint Recommendation Concerning the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet.