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WORLD INTELLECTUAL PROPERTY ORGANIZATION
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STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS

Twenty-Third Session
Geneva, June 30 to July 2, 2010

**DRAFT QUESTIONNAIRE CONCERNING THE PROTECTION OF NAMES OF STATES
AGAINST REGISTRATION AND USE AS TRADEMARKS**

Document prepared by the Secretariat

1. At its twenty-first session, held in Geneva from June 22 to 26, 2009, the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) requested the Secretariat to prepare a draft questionnaire concerning the protection of official names of States against registration and use as trademarks for consideration by the SCT at its twenty-second session. That questionnaire should also make reference to the concept of geographical deceptiveness (see document SCT/21/7, paragraph 15).

2. At its twenty-second session, the SCT requested the Secretariat to revise the draft questionnaire concerning the protection of official names of States against registration and use as trademarks, taking into account all comments made by delegations at the twenty-second session. It also requested the Secretariat to publish an intermediary version of the revised draft questionnaire on the SCT Electronic Forum for further comments. A revised version of the draft questionnaire, taking into account the comments from the twenty-second session as well as the comments on the intermediary version published on the SCT Electronic Forum would be presented to the twenty-third session of the SCT for adoption and subsequent circulation (see document SCT/22/8, paragraph 14).

3. The intermediary version of the draft questionnaire, which was revised in accordance with the comments made by the SCT at its twenty-second session was published on the SCT E-Forum on January 29, 2010, together with an invitation to SCT Members to provide comments, if any, by February 10, 2010.

4. In particular, the attention of the SCT is drawn to the following amendments:

(i) The term “official names of States” is replaced by “names of States” and intends to cover the short name of the State or the name that is in common use, which may or may not be the official name, the formal name used in an official diplomatic context, translation and transliteration of the name as well as use of the name in abbreviated form and as adjective.

(ii) The revised draft questionnaire does not address the issue of non-commercial use of names of States. Trademarks are signs that are used to distinguish goods and services from one undertaking of those of other undertakings and their validity is dependent on their use in commerce. Therefore, non-commercial use of names of States appears to be outside the ambit of trademark law.

5. Comments were received from the following SCT Members: Brazil, Japan, Mexico, Russian Federation and Sweden. All comments were published on the SCT E-Forum.

6. The SCT is invited to consider the revised draft questionnaire contained in the Annex to the present document and to approve it for subsequent circulation.

[Annex follows]

ANNEX

DRAFT QUESTIONNAIRE CONCERNING THE PROTECTION OF NAMES OF STATES
AGAINST REGISTRATION AND USE AS TRADEMARKS

REPLY ON BEHALF OF

I. PROTECTION OF NAMES OF STATES¹ AGAINST REGISTRATION AS
TRADEMARKS

Question 1:

Under the applicable legislation², names of States are:

Generally excluded from registration as trademark for goods:

YES NO N/A

Excluded from registration as trademark for goods if they could be considered descriptive of the origin of the goods in respect of which registration is sought:

YES NO N/A

Excluded from registration as trademark for goods if the use of the name of a State could be considered to be misleading as to the origin of the goods in respect of which registration is sought:

YES NO N/A

Excluded from registration as a trademark for goods if they otherwise lack any distinctive character:

YES NO N/A

Registrable as trademark for goods provided an authorization by the competent authority is granted:

YES NO N/A

Question 2:

Under the applicable legislation, names of States are:

Generally excluded from registration as trademark for services:

YES NO N/A

Excluded from registration as trademark for services if they could be considered descriptive of the origin of the services in respect of which registration is sought:

YES NO N/A

Excluded from registration as trademark for services if the use of the name of a State could be considered to be misleading as to the origin of the services in respect of which registration is sought:

YES NO N/A

Excluded from registration as a trademark for services if they otherwise lack any distinctive character:

YES NO N/A

Registrable as trademark for services provided an authorization by the competent authority is granted:

YES NO N/A

Question 3:

Where a possible conflict between a trademark for goods and a name of a State constitutes a ground for refusing the registration of the trademark in respect of goods, this ground

Is raised *ex officio* by the Office as part of the examination of an application:

YES NO N/A

Can be raised by third parties in opposition procedures:

YES NO N/A

Can be raised by third parties as observation:

YES NO N/A

Can be raised by third parties in post registration invalidation procedures:

YES NO N/A

Question 4:

Where the possible conflict between a trademark for services and a name of a State constitutes a ground for refusing the registration of the trademark in respect of services, this ground

Is raised *ex officio* by the Office as part of the examination of an application:

YES NO N/A

Can be raised by third parties in opposition procedures:

YES NO N/A

Can be raised by third parties as observation:

YES NO N/A

Can be raised by third parties in post registration invalidation procedures:

YES NO N/A

Question 5:

In determining whether the inclusion of a name of a State in a trademark would be a ground for refusing the registration of that trademark for goods and/or services, consideration must be given to the potential deception of consumers as to the origin of the goods and/or services on which the trademark is proposed to be used.

YES NO N/A

Question 6:

If under the applicable legislation, names of States are generally protected against registration as trademark, are there any exceptions to such protection?

YES NO N/A

II. PROTECTION OF NAMES OF STATES AGAINST USE AS TRADEMARKS

Question 7:

Under the applicable legislation, names of States are protected against use as trademarks for goods.

YES NO N/A

Question 8:

Under the applicable legislation, names of States are protected against use as trademarks for services.

YES NO N/A

Question 9:

Where the applicable legislation protects names of States against use as trademarks for goods and/or services, such protection is being provided

Under trademark law

YES NO N/A

Law against unfair competition

YES NO N/A

General tort law (passing off)

YES NO N/A

Other (please specify)

Question 10:

If under the applicable legislation, names of States are generally protected against use as trademark, are there any exceptions to such protection?

YES NO N/A

Question 11:

In determining whether there is a conflict between a trademark that is being used for goods and/or services and a name of a State, consideration must be given to a potential deception of consumers as to the origin of the goods or services on which the trademark is proposed to be used.

YES NO N/A

Question 12:

Use of names of States on goods and/or services is considered to constitute a potential case for the application of Article 10 of the Paris Convention for the Protection of Industrial Property³, which prescribes *inter alia* certain measures applicable in cases of the “direct or indirect use of a false indication of the source of goods”.

YES NO N/A

[End of Annex and of document]

¹ The expression “names of States” is meant to cover the short name of the State or the name that is in common use, which may or may not be the official name, the formal name used in an official diplomatic context, translation and transliteration of the name as well as use of the name in abbreviated form and as adjective.

² The expression “applicable legislation” is meant to cover the applicable law of a given jurisdiction as well as any relevant trademarks office procedure.

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Article 10

False Indications: Seizure, on Importation, etc., of Goods Bearing False Indications as to their Source or the Identity of the Producer

(1) The provisions of the preceding Article shall apply in cases of direct or indirect use of a false indication of the source of the goods or the identity of the producer, manufacturer, or merchant.

(2) Any producer, manufacturer, or merchant, whether a natural person or a legal entity, engaged in the production or manufacture of or trade in such goods and established either in the locality falsely indicated as the source, or in the region where such locality is situated, or in the country falsely indicated, or in the country where the false indication of source is used, shall in any case be deemed an interested party.

Article 9

Marks, Trade Names: Seizure, on Importation, etc., of Goods Unlawfully Bearing a Mark or Trade Name

(1) All goods unlawfully bearing a trademark or trade name shall be seized on importation into those countries of the Union where such mark or trade name is entitled to legal protection.

(2) Seizure shall likewise be effected in the country where the unlawful affixation occurred or in the country into which the goods were imported.

(3) Seizure shall take place at the request of the public prosecutor, or any other competent authority, or any interested party, whether a natural person or a legal entity, in conformity with the domestic legislation of each country.

(4) The authorities shall not be bound to effect seizure of goods in transit.

[Endnote continued on next page]

[Endnote continued from previous page]

(5) If the legislation of a country does not permit seizure on importation, seizure shall be replaced by prohibition of importation or by seizure inside the country.

(6) If the legislation of a country permits neither seizure on importation nor prohibition of importation nor seizure inside the country, then, until such time as the legislation is modified accordingly, these measures shall be replaced by the actions and remedies available in such cases to nationals under the law of such country.

Article 10^{ter}

Marks, Trade Names, False Indications, Unfair Competition: Remedies, Right to Sue

(1) The countries of the Union undertake to assure to nationals of the other countries of the Union appropriate legal remedies effectively to repress all the acts referred to in Articles 9, 10, and 10^{bis}.

(2) They undertake, further, to provide measures to permit federations and associations representing interested industrialists, producers, or merchants, provided that the existence of such federations and associations is not contrary to the laws of their countries, to take action in the courts or before the administrative authorities, with a view to the repression of the acts referred to in Articles 9, 10, and 10^{bis}, in so far as the law of the country in which protection is claimed allows such action by federations and associations of that country.