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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-Second Session
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DRAFT QUESTIONNAIRE CONCERNING THE PROTECTION OF OFFICIAL NAMES
OF STATES AGAINST REGISTRATION OR 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 or 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. Following the twenty-second session of the SCT, the final version of the questionnaire will be circulated to SCT Members. Returns to the questionnaire will be compiled by the Secretariat and presented for consideration at the twenty-third session of the SCT (see document SCT/21/7, paragraph 15).

2. In accordance with this request, the Secretariat has prepared the draft questionnaire contained in Annex I to this document.

3. The SCT is invited to consider and comment the draft questionnaire contained in the Annex to this document with a view to finalizing and circulating that questionnaire prior to the twenty-third session of the SCT.

[Annex follows]

ANNEX

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

REPLY ON BEHALF OF

Question 1:

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

YES NO N/A

Question 2:

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

YES NO N/A

Question 3:

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

YES NO N/A

Question 4:

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

YES NO N/A

Question 5:

Where a possible conflict between a trademark for goods and an official name of a State constitutes a ground for refusing the registration of the trademark, 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 cancellation procedures

YES NO N/A

Question 6:

Where the possible conflict between a trademark for services and an official name of a State constitutes a ground for refusing the registration of the trademark, 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 cancellation procedures

YES NO N/A

Question 7:

In determining whether there is a conflict between a trademark for which registration is sought (for goods and services) and an official name of a State, consideration must be given to the 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 8:

Where the applicable legislation protects official names of States against use as trademarks (for goods 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 9:

In determining whether there is a conflict between a trademark that is being used for goods and services and an official 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 10:

Use of official names of States on goods and services is considered to constitute a potential case for the application of Article 10 of the Paris Convention for the Protection of Industrial Property^{*}, 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

*

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.

(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.

[Endnote continued from previous page]

Article 10ter

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 10bis.
- (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 10bis, in so far as the law of the country in which protection is claimed allows such action by federations and associations of that country.

[End of Annex and of document]