

PROTECTION OF COUNTRY NAMES AND NATION BRANDING

Legal Aspects · A practitioner's perspective

Verena v. Bomhard, BomhardIP, Alicante, Spain

bomhardIP

- Can private parties register a word mark that consists of the name of a country?
- How about the countries themselves, their authorities, or authorised bodies such as associations?
- Exceptions to the rule?
- Country names as part of complex word or figurative marks

OVERVIEW



I am not considering flags or state emblems, whether protected under Art. 6ter or not. This is about the country names only.

- EU: no special rules for country names
- Ground for refusal / invalidity: descriptiveness
- [Deceptiveness less relevant: abstract consideration]
- OHIM Guidelines
- Case Law
- Exceptions to the rule

WORD MARKS THAT CONSIST OF A COUNTRY NAME



- Geographical term: every existing name of a place, for example a country... Including in its adjectival form
- Assessment
 - Name known to the relevant public?
 - “Link” between the goods or services and the name (production, subject matter, place of services, recognition of country name)?
 - On the other hand, merely theoretical possibility that goods or services can be produced or rendered in the place not sufficient
- New 02/15: “principles apply also to the names of countries”

OHIM GUIDELINES



Part B, Examination, Section 4, § 2.3.2.6 Geographical terms, amended 02/15

- Basis: **CHIEMSEE** (1999)
- • **ALASKA** (2008)
- • **PASSIONATELY SWISS** (2011) / **SWISS CONCEPT** (2014);
BRASIL (2013) / **THE SPIRIT OF CUBA** (2014);
NORWEGIAN GETAWAY (2014);
SUEDTIROL (2014)

CASE LAW

- Chiemsee: ECJ, 4 May 1999, C-108/97, C-109/97, Windsurfing Chiemsee
- ALASKA: General Court, 8 Jul 2009, T-225, 226/08 (only available in German and French), Mineralbrunnen Rhön-Sprudel Egon Schindel GmbH v. OHIM / Schwarzbräu GmbH. Appeal C-365, 366/09 removed. ALASKA, class 32, valid.
- PASSIONATELY SWISS: General Court, 15 Dec 2011, T-377/09, Mövenpick Holding v. OHIM (ex parte) (only DE, FR). CTM application for cl. 16, 35, 41, 43, 44 refused.
- SWISS CONCEPT (fig.) Board of Appeal, 28 Oct 2014, R1577/2014-4, refusal for cl 14, 18, 25 confirmed.
- BRASIL: OHIM, First Board of Appeal, 6 Feb 2013, Allied Domecq Spirits & Wine Limited (ex parte), classes 32 and 33 (whisky). Final refusal
- THE SPIRIT OF CUBA, General Court, 24 June 2014, T-207/13, 1872 Holdings vof v/ OHIM, Havana Club International SA. Registration for cl. 33 (rum and rum-based alcoholic beverages), 35, 42 invalid.
- NORWEGIAN GETAWAY: General Court, 23 Jan 2014, T-513/12 (ex parte) (only DE, FR). NCL Corporation Ltd. (Miami, Florida) v. OHIM. Cl. 39.
- SUEDTIROL: Grand Board of OHIM, 10 Oct 2014, R 574/2013-G, Autonome Provinz Bozen-Südtirol / Provincia Autonoma di Bolzano-Alto Adige v. INTERNET CONSULTING GmbH (only DE). Cl. 35, 39. Mark declared invalid.

- **MONACO** (2015): IR in the name of the Principality of Monaco designating (inter alia) EU
- Multi-class registration refused for some goods and services
- (but not for cars, jewelry, bags, clothing, games, telecommunication services)
- Partial refusal upheld: Art. 7(1)(c) CTMR follows objective criteria. No particular entitlement to the registration of descriptive terms.

DIFFERENT CRITERIA FOR GOVERNMENTAL BODIES?



MONACO: General Court, 15 Jan 2015, T-197/13, *Marques de l'Etat de Monaco (MEM) v OHIM (ex parte)* (available in most languages but not [yet?] English). IR 1069254 MONACO registered by the Principality of Monaco (transferred 2012 to plaintiff MEM). Classes 9, 12, 14, 16, 18, 25, 28, 35, 38, 39, 41, 43. Refused for 9 (magnetic data carriers), 16 (printed matter), 39, 41 (entertainment, sport activities), 43 (accommodation). Refusal upheld.

- Principality submitted itself to the jurisdiction of OHIM and EU Courts by designating the EU in its IR.
- NB 228 CTMs and IRs (applications and registrations) that consist of or contain MONACO including
 - CLUB MONACO (cl 25) (1996)
 - GRAND PRIX DE MONACO (wide variety of merchandise) (1996)
 - MONACO (cl. 9 – software for radiation treatment; 2003; opposed RX MONACO filed 2012, opp pending since 2013)
 - MONACO TELECOM (cl. 9, 16, 35, 37, 38, 42; 2004); also: MONACO HOME, VISION, MOBILE, CONNECT (2006, 7)
 - MONACO (cl 12: recreational vehicles, motorhomes); Monaco RV, Indiana, US: opposition to Principality of Monaco's IR MONACO led to restriction in class 12 by exclusion of recreational vehicles (2014)
 - BRASSERIE DE MONACO (2009)
 - BIERE DE MONACO (2009)

- Monaco (cl. 3, 32, all goods; 2011; Aqua Monaco GmbH, Munich)
- Monaco Star; Monaco Platinum (cl. 33, 2011; Brand New Ideas EOOD, BG)

- Registered CTMs (word marks or little stylized words)
 - FIJI (semiconductor technology, 2010; alcoholic beverages, 2002)
 -  (mineral waters; also: FIJI MINERAL WATER; 2001/2003) (also: FIJI BLEND – cl. 3, 2003; FIJI GAMES, cl. 41, 2005)
 - FIDJI (medical devices – 2009; paints, cars, fabrics, 2003)
 -  (application for foodstuffs including cocoa and coffee, allowed 2008, rejected due to opposition / prior rights)
 - SEYCHELLES (building materials, 2009; cosmetics, 2008; clothing, 2007)

ALL COUNTRIES ARE EQUAL BUT SOME ARE MORE EQUAL?



TOGO: opposition by Disney against Barilla's CTM application no. 6523724, earlier mark TOGGO. Opp granted; BoA 28 Mar 2011, R1095/2010-4). Extensive conceptual comparison with no mention of TOGO being a country but „to go“ and Italian colloquial meaning of „togo“ – something like „that rocks“. TOGO – main crops for export: cocoa and coffee.

- What happened to the criterion „need to keep a term available“?
- That would seem to allow equitable results
 - Consumer understanding should not be overestimated and may be random (South Tyrol known, Alaska, Togo, Seychelles, Fiji not?; Switzerland has luxury image, Monaco does not?)
 - Knowledge in trade should be taken into account (Alaska!)
 - Actual absence of need to keep free for others (due to sole authority for use lying with government / institution etc) to justify registration?

COMMENTS



- Distinctiveness depends on additional elements
- Deceptiveness depends on
 - Presumed importance of the country name to the relevant consumer
 - Presumed use of the mark with goods and services deriving from the country in question

COMBINATION MARKS THAT INCLUDE COUNTRY NAME



- Deceptiveness of a mark is judged independently of the applicant
- If there is any potentially legitimate use of the mark the mark is not considered deceptive
- Approach endorsed by General Court in



DECEPTIVENESS – OHIM'S POSITION



INTERTOPS: GC, T-140/02, 13 Sep 2005, Sportwetten Gera ./ Intertops Sportwetten. Intertops Sportwetten owned mark for sports bets without the administrative permit (in Germany) to perform such services. GC agreed with OHIM that as long as the mark could legitimately be used it was not to be considered deceptive or contrary to public policy.



DECEPTIVE?

Applicant: Paola Vergamini, an individual with no perceptible business or links with producers of Halal products, in Castelnuovo di Garfagnana, Italy, Province of Lucca

Trademark application currently before General Court on account of opposition by the Government of Malaysia based on earlier passing-off rights to certification mark HALAL MALAYSIA

Hallmark HALAL MALAYSIA meanwhile notified under Article 6ter PC (MY1) but not at the time the Board of Appeal decided on the opposition.

Descriptiveness / deceptiveness of the mark not an argument in opposition proceedings before OHIM



DECEPTIVE?

Classes 5, 34, 35 – tobacco products

Applicant: Italian individual in Valencia, Spain





For clothing (oder marks); We love Italy: Foodstuffs (2013)
MADE IN SCOTLAND: Made in Scotland B.V.

- Seychellness (cosmetics, games; Seybex Ltd., London; 2009)



Foodstuffs
Comimpex
Int'l srl
(2012, 2013)



However, 2013 rejection of 3 applications by Comimpex:



cl. 25, 28, 32, 35
Bernhard Berger,
Baumkirchen, AT
(2013)



cl. 10, 16, 18, 25
Harald Prantner,
Hamburg (2012)



RECENT EXAMPLES





France: CTMm 539179, 5 Oct 2006, reg. 14 Aug 2007, cl. 16, 25, 35, 41, 43: Office National Interprofessionnel des Fruits, des Légumes, des Vines et de l'Horticulture Française.
ITALY / ITALIA: 24 Jun 2009, 3 May 2010, all goods; Presidenza del Consiglio dei Ministri

- **Event marks** ITALY 2016 (BUT: GERMANY 2006 cancelled); LE TOUR DE FRANCE
- **Historical** / disused names: SCANDIA
- **Banks, Insurance** companies: BANK OF SCOTLAND,  , Swiss Re
- **Airlines** Air Seychelles, FIJI AIR,  allowed (“swiss“ word rejected)
- **Tobacco** COLOMBIAN GOLD
- **HiTech** FIJI (semiconductors), JAVA (software), MONACO (radiation technology)
- **Entertainment** RADIO FRANCE INTERNATIONALE; ITALIA RADIO; EUROPA RADIO; FRANCE TELEVISION
- **Telecom** France Telecom (Orange), Telecom Europa (Deutsche Telekom), TELECOM AMERICAS (América Móvil, S.A.B. de CV)
- **Institutions**, national associations etc. (museums, universities, libraries, “The...”)

SPECIAL CASES?



ITALY 2016: UEFA

GERMANY 2006 of FIFA declared invalid by BoA by decision of 30 June 2008 on application by Ferrero oHG; case went to General Court but then FIFA decided to surrender the mark. To date no decision from Luxembourg regarding these event marks.

AIR SEYCHELLES: Air Seychelles, Ltd.

COLOMBIAN GOLD: PROTABACO, S.A. (Promotora de Tabaco de Colombia, S.A.)

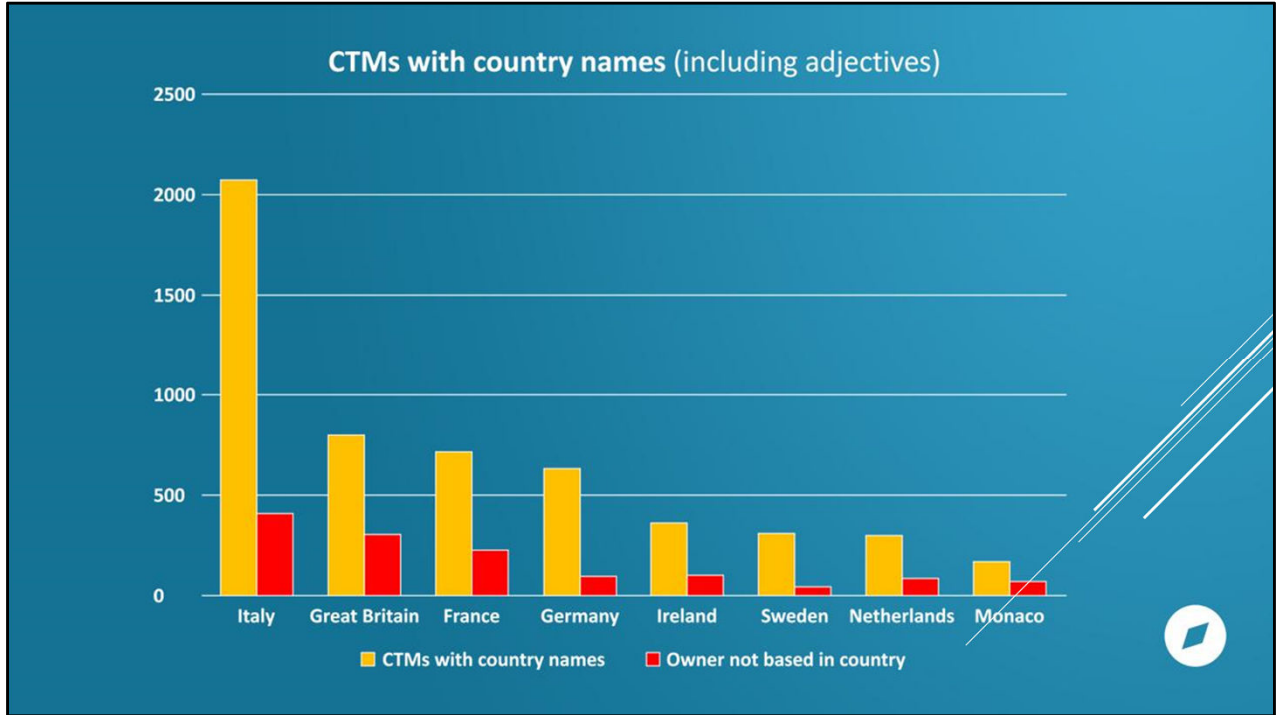
FIJI: Cambridge Nanotech Inc., Massachusetts

JAVA: now owned by Oracle

- **FRANCE:** 481 (122 not based in France), FRENCH: 181 (87), FRANCAIS: 48 (13); TOTAL: 710 (222 = 33%)
- **ITALY:** 394 (82 not based in Italy), ITALIA: 667 (114), ITALIAN, ITALIANO, ITALIANI etc.: 985 (183 not based in Italy); TOTAL: 2064 (397 = 18.4%)
- **GERMANY:** 335, GERMAN: 191 (together 70 not based in Germany); DEUTSCHLAND: 101 (19); TOTAL 627 (89 = 14.2%)
- **SWEDEN:** 215 (23); SWEDISH: 94 (18); Total 309 (41 = 13.3%)
- **HOLLAND:** 138 (53), DUTCH: 102 (21); NETHERLANDS 19 (5); NEDERLAND(SE) 35 (5); TOTAL 294 (84 = 28.6%).
- **BRITISH:** 220 (59), BRITAIN: 39 (6); ENGLAND: 130 (33), ENGLISH: 213 (136); SCOTLAND: 83 (16), SCOTTISH: 63 (13); WALES: 23 (3), WELSH: 12 (2); TOTAL: 783 (301 = 38.4%)
- **IRELAND:** 150 (42) [25: GB], IRISH: 208 (58) [20: GB]; TOTAL 358 (100 = 28%; 45 = 12.5% GB)
- **MONACO:** 166 (59), MONEGASQUE 7 (1); TOTAL 173 (60 = 34.6%)

SOME NUMBERS – RELEVANCE IN PRACTICE (CTMS, FILED OR REGISTERED)





- No absolute bar but trend towards stricter examination criteria
- Still too much focus on consumer expectations
- Deceptiveness is a dull sword due to abstract examination
- No special treatment for governments or government bodies in principle
- Legal uncertainty due to multitude of registered marks that do not comply with current criteria

CONCLUSION: COUNTRY NAMES IN THE EU



THANK YOU VERY MUCH

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