

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

Forty-Third Session Geneva

QUESTIONNAIRE ON NATION-BRAND PROTECTION IN MEMBER STATES

prepared by the Secretariat

1. At the conclusion of the forty-second session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), the Chair of the SCT invited the Delegation of Peru to send to the Secretariat a proposal for a Draft Questionnaire on Nation-Brand Protection in Member States. The Chair also invited members to send questions they would like to include in the draft questionnaire, before December 31, 2019 (document SCT/42/8, paragraph 23). By that deadline, the Secretariat had received contributions from the following Member States: Australia, Brazil, Ecuador, Peru and Switzerland.
2. The Secretariat compiled all questions received in document SCT/43/3 Rev. and, based on the compilation, prepared a Draft Questionnaire on Nation-Brand Protection in Member States, presented in the Annex to document SCT/43/7 Prov.. In preparing the draft questionnaire, the Secretariat edited the questions to render them suitable for use in an online electronic survey tool with the purpose of achieving efficiency in data collection and analysis. In doing so, open-ended text questions were avoided wherever possible or the space for replies was limited.
3. This document was posted on the SCT webpage on May 11, 2020, at https://www.wipo.int/meetings/en/details.jsp?meeting_id=55468 and remained open for comments on the SCT E-Forum until May 31, 2020.

4. At the closing date, the Secretariat received comments from the following Member States: Belarus, Chile, Costa Rica, Japan, Peru and the United States of America (6). The European Union also provided the Secretariat with comments (1). In addition, the following non-governmental organizations sent comments to the Secretariat: the International Federation of Intellectual Property Attorneys (FICPI) and the International Trademark Association (INTA) (2).

5. Annex I to the present document contains the finalized version of the Questionnaire on Nation-Brand Protection in Member States prepared by the Secretariat. This version reflects comments received by the Secretariat.

6. An online survey tool will be launched based on the finalized questionnaire. The results of the survey will be presented to the forty-third session of the SCT.

[Annex follows]

QUESTIONNAIRE ON NATION-BRAND PROTECTION IN MEMBER STATES

PART I: DEFINITION OF NATION BRAND, POLICY RATIONALE AND CONTENT

It is noted that there is no commonly agreed definition of the term “nation brand”. The meaning of this term may vary from country to country.

QUESTION 1 – In the respondent’s view, a nation brand can be described as: (More than one answer is possible)

- A sign which serves as a visual element of any policy or strategy intended to promote national identity and/or the country’s image
- Other – please specify
- Not applicable

QUESTION 2 – Has the respondent’s country taken a decision to create and use a sign that can be described as a nation brand?

No Yes Not yet, but there are plans to do so Not applicable

If YES, the decision was taken by:

- A public entity – please specify
- A semi-public entity – please specify
- A private entity – please specify
- Other – please specify

If YES, please upload a reproduction in *jpeg, pdf, doc, docx, png, jpg* or *gif* format of the nation brand(s) used by the respondent’s country.

If you answered “NO” or “NOT APPLICABLE” to Question 2, please proceed directly to Question 30.

QUESTION 3 – What is the policy rationale behind the development of the nation brand referred to in Question 2? (More than one answer is possible)

- To promote tourism
- To attract investments
- To attract workers
- To increase exports
- To promote domestic goods and/or services
- To increase competitiveness
- To enhance foreign relationships
- To promote the country’s culture, traditions, values or positive aspects domestically and abroad
- To increase the country’s visibility
- Other – please specify
- Not applicable

QUESTION 4 – Does the nation brand consist of, in whole or in part:

(a) the country name (in full or in abbreviated form)?

No Yes Not applicable

If NO, why?

(b) sign(s) communicated under Article 6~~ter~~ of the Paris Convention for the Protection of Industrial Property (hereinafter, “the Paris Convention”)?

No Yes Not applicable

(c) elements protected by a registered mark?

No Yes Not applicable

(d) other symbols (for example, animals, plants, monuments)?

No Yes Not applicable

If YES, please specify.

QUESTION 5 – Has the nation brand been replaced or modified in recent years?

No Yes Not applicable

If YES, please indicate, if possible, the number of times, the reasons and the years of the replacement(s) or modification(s).

PART II: RECOGNITION, OWNERSHIP AND ADMINISTRATION

QUESTION 6 – Is the nation brand officially recognized by a dedicated instrument in the respondent’s jurisdiction (for example, a law, regulation, statute or act of recognition)?

No Yes Not applicable

If YES, please provide the link to the relevant dedicated instrument.

QUESTION 7 – Is the term “nation brand” defined in the dedicated instrument referred to in Question 6?

No Yes Not applicable

If YES, please provide the definition.

QUESTION 8 – In the respondent's jurisdiction, does the nation brand have an owner?

No Yes Not applicable

If YES, please indicate the nature of the owner and who the owner of the nation brand is:

- A public authority/entity – please provide the name and website
- A semi-public authority/entity – please provide the name and website
- A private entity – please provide the name and website
- Other – please specify
- Not applicable

QUESTION 9 – In the respondent's jurisdiction, the nation brand is managed by: (More than one answer is possible)

- A public authority/entity – please provide the name and website
- A semi-public authority/entity – please provide the name and website
- A private entity – please provide the name and website
- Other – please specify
- Not applicable

PART III: USE OF RESPONDENT'S NATION BRAND

QUESTION 10 – Is the use of the nation brand subject to compliance with specific laws or rules in the respondent's jurisdiction?

No Yes Not applicable

If YES, please provide the link to the relevant laws or rules.

QUESTION 11 – Who can use the nation brand? (More than one answer is possible)

- Public authorities/entities – please specify
- Semi-public authorities/entities – please specify
- Private entities – please specify
- Other – please specify
- Not applicable

QUESTION 12 – How is the use of the nation brand authorized? (More than one answer is possible)

- It is subject to a license agreement
- It is subject to prior authorization by a competent national authority in the respondent's jurisdiction
- Other – please specify
- Not applicable

QUESTION 13 – Are users required to pay a fee to use the nation brand?

No Yes Not applicable

If YES, please indicate the amount of the fee (in local currency) and to whom the fee is paid.

PART IV: PROTECTION OF THE RESPONDENT'S NATION BRAND AT THE NATIONAL LEVEL

QUESTION 14 – Is the nation brand protected in the respondent's country?

No Yes Not applicable

If YES, please indicate by what means of protection: (More than one answer is possible)

- Trademark
- Collective mark
- Certification mark
- Geographical indication
- Tailored domestic law
- Other means – please specify

Please provide the link to the corresponding registration or certificate, if any.

QUESTION 15 – Protection of the nation brand in the respondent's jurisdiction covers the following goods/services:

- Goods and services belonging to all classes of the international classification under the Nice Agreement
- Some good(s) and/or service(s) only – please indicate the corresponding class(es) of the international classification under the Nice Agreement, if appropriate.
- Not applicable

QUESTION 16 – Is the nation brand considered as an industrial property asset in the respondent's jurisdiction?

No Yes Not applicable

QUESTION 17 – Has the protection of the respondent's nation brand been challenged in the respondent's jurisdiction?

No Yes Not applicable

If YES, please indicate how it has been challenged: (More than one answer is possible)

- An application for registration of the nation brand as a trademark, collective mark or certification mark has been filed in the respondent's jurisdiction and that application has been opposed – please indicate the outcome
- The nation brand is registered as a trademark, collective mark or certification mark in the respondent's jurisdiction and the invalidation of the registration has been requested – please indicate the outcome
- The nation brand is protected through a dedicated instrument (for example, a specific law, regulation, statute, act of recognition) and that instrument has been opposed or otherwise challenged – please indicate the outcome
- Other – please specify

PART V: PROTECTION OF THE RESPONDENT'S NATION BRAND ABROAD

QUESTION 18 – Is the respondent's nation brand protected by countries/regions other than its own (hereinafter referred to as "protected abroad")?

No Yes Not applicable

If YES, please indicate the means of protection: (More than one answer is possible)

- Trademark
- Collective mark
- Certification mark
- Geographical indication
- Tailored domestic law
- Bilateral agreement
- Communication under Article 6 *ter* of the Paris Convention
- Other means – please specify

Please provide the link to the corresponding registration, certificate or other dedicated instrument, if any.

QUESTION 19 – If the respondent's nation brand is protected abroad, please list the countries/regions, with respect to each means of protection (More than one answer is possible).

- Trademark
- Collective mark
- Certification mark
- Geographical indication
- Tailored domestic law
- Bilateral agreement
- Communication under Article 6 *ter* of the Paris Convention
- Other means – please specify

QUESTION 20 – Protection of the respondent's nation brand abroad covers the following goods/services:

- Goods and services belonging to all classes of the international classification under the Nice Agreement
- Some good(s) and/or service(s) only – please indicate the corresponding class(es) of the international classification under the Nice Agreement, where appropriate.
- Not applicable

QUESTION 21 – Has the protection of the respondent's nation brand been challenged abroad?

No Yes Not applicable

If YES, please indicate how it has been challenged: (More than one answer is possible)

- An application for registration of the nation brand as a trademark, collective mark or certification mark has been filed abroad and that application has been opposed – please indicate the outcome
- The nation brand is registered as a trademark, collective mark or certification mark abroad and the invalidation of the registration has been requested – please indicate the outcome
- The nation brand is protected through a dedicated instrument (for example, a specific law, regulations, statute, act of recognition) abroad and that instrument has been opposed or otherwise challenged – please indicate the outcome
- Objections to a communication under Article 6^{ter} of the Paris Convention – please indicate the outcome
- Other – please specify

QUESTION 22 – If the respondent's nation brand is protected abroad, has the respondent experienced what it considers as an infringing use or unauthorized use of its nation brand abroad?

No Yes Not applicable

If YES, please specify the nature of the use: (More than one answer is possible)

- Unauthorized use as trademark
- Other unauthorized use in commerce
- Other unauthorized use
- Other – please specify

PART VI: USE OF ARTICLE 6^{TER} OF THE PARIS CONVENTION TO PROTECT THE RESPONDENT'S NATION BRAND

QUESTION 23 – Has the respondent's nation brand or elements of the respondent's nation brand been the subject of a communication under Article 6^{ter} of the Paris Convention?

No Yes Not applicable

If YES, did the communication cover the entire nation brand or only elements of it?

- Entire nation brand
- Elements of the nation brand

If YES, under which category of signs covered by Article 6 *ter* of the Paris Convention? (More than one answer is possible)

- Flag
- Armorial bearing
- Other State emblem
- Official sign or hallmark indicating control and warranty

If YES, please indicate the reference number(s) of the sign(s) included in the Article 6 *ter* Express database.

QUESTION 24 – If the respondent's nation brand has been communicated under Article 6 *ter* of the Paris Convention, was such communication objected as per Article 6 *ter*(4) of the Paris Convention?

No Yes Not applicable

If YES, the objections were based on the following ground(s): (More than one answer is possible)

- Conflict with a prior registered trademark
- Sign not appropriate subject matter for a communication under Article 6 *ter* of the Paris Convention
- Sign used by a lower public body
- Other – please specify

QUESTION 25 – If the respondent's nation brand has been communicated under Article 6 *ter* of the Paris Convention, has it been confronted with any form of unauthorized use abroad?

No Yes Not applicable

If YES, please specify: (More than one answer is possible)

- Unauthorized use as trademark
- Other unauthorized use in commerce
- Other unauthorized use
- Other – please specify

If YES, was such use successfully challenged under Article 6 *ter* of the Paris Convention?

No Yes

PART VII: MONITORING AND ENFORCEMENT OF RESPONDENT'S NATION BRAND

QUESTION 26 – Is the use of the respondent's nation brand monitored in the respondent's jurisdiction?

No Yes Not applicable

If YES, how and by whom?

QUESTION 27 – Is the use of the respondent's nation brand monitored abroad?

No Yes Not applicable

If YES, how and by whom?

QUESTION 28 – Is the respondent's nation brand enforced in the respondent's jurisdiction?

No Yes Not applicable

If YES, how? (More than one answer is possible)

- Opposition and/or invalidation procedures against conflicting signs
- Infringement procedures against conflicting signs
- Civil and/or criminal action
- Other – please specify

If YES, by whom?

QUESTION 29 – Is the respondent's nation brand enforced abroad?

No Yes Not applicable

If YES, how? (More than one answer is possible)

- Opposition and/or invalidation procedures against conflicting signs
- Infringement procedures against conflicting signs
- Civil and/or criminal action
- Diplomatic channels
- Other – please specify

If YES, by whom?

PART VIII: PROTECTION OF OTHER COUNTRIES' NATIONS BRANDS

QUESTION 30 – Are other countries' nation brands protected in the respondent's jurisdiction?

No Yes Not applicable

If YES, how? (More than one answer is possible)

- Trademark
- Collective mark
- Certification mark
- Geographical indication
- Tailored domestic law
- Bilateral agreement
- Article 6*ter* of the Paris Convention
- Other means – please specify

QUESTION 31 – Has the respondent’s intellectual property office ever refused the registration of a trademark containing a country name on the basis of a nation brand communicated by a third country under Article 6*ter* of the Paris Convention?

No Yes Not applicable

PART IX: SCOPE OF PROTECTION

QUESTION 32 – In the respondent’s jurisdiction, can the intellectual property office reject a trademark application because of a preexistent nation brand?

No Yes Not applicable

If YES, how? (More than one answer is possible)

- Ex officio*, on the basis of Article 6*ter* of the Paris Convention
- Ex officio*, based on any other ground of law – please specify
- On the basis of an opposition
- On the basis of observations
- On the basis of another ground – please specify

QUESTION 33 – If a protected nation brand in the respondent’s jurisdiction contains the country name, together with other elements, does the protection extend to:

- The country name alone
- The country name and the other elements, assessed as a whole
- The other elements, excluding the country name
- Not applicable

[End of Annex and of document]