

Information on the Protection of Country Names in Norway

Our response is based on the terms of reference in document SCT27/10, as well as the issues outlined in the Secretariat's request of November 30th 2012.

Pursuant to the terms of reference, our response is limited to the issue of the protection of country names in the field of registration of trademarks and does not, for example, include the issue of the protection of country names in the field of use of trademarks.

Country names are not as such protected from registration as trademarks in Norway in the sense that there exists a specific provision excluding country names from trademark protection. However, country names are often considered to be either descriptive or deceptive, and are, therefore, "indirectly" protected.

Accordingly, the relevant question according to Norwegian law is whether or not a country name fulfills the requirement for distinctiveness. The general answer to that is "no", since country names usually are considered to be descriptive. In addition, a country name in a trademark application may, under certain circumstances, be considered to be deceptive.

For collective marks, the criteria for assessing distinctiveness are different. Accordingly, it is more likely that a country name is accepted as (part of) a collective mark than a trademark, as shown in the examples in point 2 of this document. It is also possible to register a country name as a geographical indication for food and beverages.

1. Country names in trademark examination

a. Country Names as Descriptive Terms

Pursuant to [Section 14 of the Norwegian Trade Mark Act](#), applications for trademarks which are descriptive must be refused. The rationale behind this is that descriptive terms have to be kept free so that other commercial operators also may be free to use it. Country names will, generally speaking, often be perceived as describing the geographical origin of the applicant and/or the goods or services.

As to whether or not trademarks containing country names are accepted for registration, a distinction must be drawn between a word mark consisting exclusively of a country name, and trademarks containing a country name.

Word Marks Consisting Exclusively of a Country Name

A word mark consisting exclusively of a country name will be refused protection if it is considered to be descriptive of the goods and services in the application. This will usually be the case.

Example:

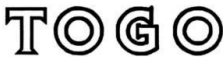
Mark	Goods and services	Result
TOGO	Class 30 (various foodstuffs)	Refused as it only describes the country of origin of the goods.

Trademarks Containing a Country Name

If the country name merely forms part of the trademark in question, and the trademark contains additional elements such as other words, figurative elements or design elements, these other elements may afford the sign distinctiveness. Whether or not the trademark application in question will be refused depends on an overall assessment of the trademark's capability to distinguish the goods and services of the applicant from those of others. If the other elements do not add distinctiveness to the trademark, the application will be refused. If the other elements add distinctiveness to the sign, the trademark will be registered.

However, even if the sign is registered, protection of the country name will, generally speaking, not be considered to be granted. Consequently, other commercial operators may still use the country name, and they may also likewise apply for registration of the country name as part of their trademark. The registration of the trademark containing a country name will therefore not give the proprietor an exclusive right to use or register that country name. This interpretation of the scope of protection stems from long-standing jurisprudence in Norway and in the European Union. A disclaimer is usually not required, nor will a request for a disclaimer normally be granted as we generally consider country names excluded from protection.

An example of a refused application:

Mark	Goods and services	Reasoning
	Class 30 (various foodstuffs)	The text is descriptive of the geographical origin for some of the goods (raw articles) and the design is not sufficiently distinctive

Examples of registrations where the other elements or the totality of elements confer distinctiveness upon the mark:



Consent from the Relevant Authority

An unsuccessful applicant will not be able to overcome a refusal based on descriptiveness by submitting consent from the relevant national authority. The issue is whether or not the relevant public perceives the country name as an indication of commercial origin, or simply as the name of a country. Under the Norwegian Trademark Act, the country name is not as such a proprietary right the country in question controls.

Acquired Distinctiveness

It is, in principle, possible to register a descriptive mark of a country name through acquired distinctiveness. This may apply if the sign in question has become well-known as the applicant's indication of commercial origin in Norway. However, in reality this would be hard to prove for the applicant in respect of trademarks which exclusively is a country name, as the relevant public often

will perceive it as the name of a country, not exclusively as the applicant's indication of commercial origin. It is more a hypothetical issue, rather than of any practical importance.

As to trademarks containing other elements, it would likewise be difficult to prove that the relevant public will perceive the country name as such as an indication of the commercial origin of the applicant; hence if a trademark containing a country name is registered through acquired distinctiveness, the possibility that protection is afforded also to the country name is mostly theoretical.

In the case that a country name is accepted as a trademark for certain goods and services through acquired distinctiveness, this will be indicated in the register.

b. Country Names as Deceptive Terms

In addition to being considered as descriptive, the registration of country names in a trademark may, under certain circumstances, be considered deceptive under [Section 15 of the Norwegian Trademark Act](#).

In respect of country names, the rationale is that the geographical origin is an important and relevant factor for the relevant public when deciding whether or not to buy a product. If the applicant is from a different country than the one indicated in the trademark or the goods are not specified as being from the indicated country, consumers are likely to be misled as they are liable to think that the applicant or the goods are from the country indicated in the trademark. The national trademark registration authority should not sanction the registration of a trademark which is misleading. However, if it is not misleading as to geographical origin, there is no reason to reject the registration of the trademark.

Deceptiveness is applied irrespective of whether the sign exclusively consists of a country name or whether the country name forms part of the sign. It is sufficient that the country name is perceived in the mark. It is furthermore irrelevant whether or not the trademark contains other distinguishing elements. This makes the application of this provision different than when considering whether or not a trademark is descriptive.

Remedies

Deceptiveness may be remedied either by transferring the application to somebody located in the country indicated, or by limiting the list of goods and services for example to "all goods of [country name in adjective form] origin" or likewise. It must be noted that a trademark registration may be revoked in a cancellation proceeding under Section 36 of the Norwegian Trademark Act if it has become deceptive, so an applicant remedying the application in the ways indicated above runs a risk if a change in ownership or list of goods and services does not reflect reality.

Example:



The application was made for beverages in classes 32 and 33 and it was refused as deceptive because the applicant was not from Jamaica, but from Croatia.

The word mark TOGO was also refused as deceptive because the applicant was from Italy, not from Togo.

Official name, variations

The criterion is whether or not the country name will be perceived as indicating the name of a country. This includes the official name and the common name of the country, and very often also adjectives and common abbreviations. As an example, none of the following terms would be given protection as they will all be perceived as an indication of a country name:

- Official name: The United Kingdom of Great Britain and Northern Ireland
- Common name: Great Britain, Britain, United Kingdom
- Adjective: British
- Abbreviation: UK

Similarly, other language equivalents would also be excluded from protection as long as the relevant Norwegian public understands it or associates it with a specific country name. As an example, the equivalent terms in Norwegian of the ones above would therefore also be excluded protection. Also, other language equivalents similar at least to the Norwegian and English versions will often also be excluded from protection. This applies in particular to other Latin based variants, but may also apply to other variations. It is impossible to give an exhaustive list on this.

Procedure for Trademarks

The assessment of country names in the field of registration of trademarks is done by the Norwegian trademark authority as part of a pre-registration *ex officio* examination. Third parties may file

observations (protest) prior to or during the examination. In case a third party should disagree with our assessment, or if they think we have made a mistake, they may file a post-registration opposition. Alternatively, after the opposition period has expired, a third party may file an administrative request or a request to the courts for the cancellation of the trademark registration.

2. Protection of country names as collective marks


A collective mark is a type of trademark which makes it possible for a society or other organization to register a mark for its members to use. Under [Section 14, paragraph 4 of the Norwegian Trademark Act](#), an exception for descriptive signs exists for collective marks which describe the geographical origin of the goods and services at hand. Registration is subject to the acceptance of the regulations stipulating the use of the mark. A collective mark may be used by the members of the organization subject to the conditions indicated in the regulations for its use. This way, the organization in question may control the conditions for use of the collective mark, and may e.g. establish that only members who fulfill certain quality criteria may use the sign.

The procedure concerning collective marks is the same as for trademarks.

The scope of protection of descriptive indications of geographical origins in collective marks is the same as for trademarks. A country name will therefore not have any protection against other trademarks or collective marks. Nevertheless, the system of collective marks is an important instrument for associations who want to indicate to the public and control that the products of its members e.g. have a certain quality.

One example of an application for a collective mark in Norway containing a country name is FIJI PURE MAHOGANY. The Government of the Republic of Fiji is the applicant and the application covers *inter alia* musical instruments, timber and furniture. The proposed regulations have not been accepted so far. The conditions for use have been considered to be too vague. The application is still pending.

Examples of registrations:

	<p>Registered for the Republic of Cuba for class 34. The mark may be used by producers of cigars, cigarettes or cut tobacco who run their business from Cuban territory and who export their goods.</p>
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	<p>Registered for fresh pears by the Pear Bureau Northwest, USA. The mark may be used by persons authorized by the holder to use the mark as an indication of guarantee that the pears bearing this sign have been cultivated in the USA in one of the states Oregon, Washington and California and that they satisfy the standards used by the US Department of Agriculture at the time of packaging or sale.</p>
	<p>The mark was registered by New Zealand Meat Producers Board for goods in class 29. Due to non renewal, it is expired. The regulations contain detailed descriptions of <i>inter alia</i> the goods the collective mark may be used on and who may use it.</p>

3. Protected Geographical Indications and Designations of Origin (Matmerk)

It is possible to apply for geographical names as part of a PDO or PGI for food and beverages. The system is administered by the Norwegian Agricultural Quality System and Food Branding Foundation, and it has its own procedure. For more information, see www.matmerk.no.

The system gives those which have been afforded a right the exclusivity to use the protected term together with one of the following logos, which signifies that it is a protected term:



It is possible that descriptive terms containing a country name may be protected under this system.

The term is protected against trademark applications containing the protected term, and prior registrations are part of the examination undertaken in the field of trademarks by the Norwegian trademark authority.

4. Conclusion

Generally speaking, country names are excluded from trademark protection as they usually only serve to indicate the geographical origin of the applicant/proprietor. This applies irrespective of whether the trademark is refused as descriptive or, when the trademark contains other, distinguishing features, the trademark application is registered. Furthermore, it applies to terms that will be perceived by the relevant public as referring to a specific country. This is consistently applied by administrative authorities *ex officio* and in all other proceedings, as well as by the courts.

In addition, trademarks may be refused or later cancelled if it is or has become misleading as to the geographical origin of the goods and services at hand.

As an alternative, it may be possible to apply for a country name as a collective mark or as part of a collective mark for specific goods and services. It is also possible to apply for a geographical indication or designation of origin which consists of or contains a country name.

Excerpts from the Norwegian Trademark Act:

§ 14. General conditions of registration

A trademark to be registered shall consist of a sign which is capable of being protected pursuant to Section 2 and capable of being represented graphically. It shall have distinctive character as a sign for the relevant goods or services.

A trademark cannot be registered if it exclusively, or only with insignificant changes or additions, consists of signs or indications that:

- a. indicate the kind, quality, quantity, intended purpose, value or geographical origin of the goods or services, the time of production of the goods or of the rendering of the services or other characteristics of the goods or services, or
- b. constitute customary designations for the goods or services according to normal linguistic usage or to loyal, established business practice.

The conditions in paragraphs one and two shall be met on both the date of application and the date of registration. When assessing a proposed trademark pursuant to paragraph one, sentence two, and paragraph two, it is necessary to take into consideration all circumstances that prevailed on the date of application, in particular effects of use of the trademark prior to this time.

A sign that is used in an industrial or commercial undertaking to indicate the geographical origin of goods or services may, without impediment by the provisions in paragraph two, be registered as a collective mark.

§ 15. Trademarks that conflict with public interests

A trademark cannot be registered if it:

- a. is contrary to law or public order or is liable to cause offence,
- b. is liable to deceive, for example in respect of the nature, quality or geographical origin of the goods or services, or
- c. contains, without authorisation, escutcheons or another sign covered by Section 328, paragraph one, no. 4, or paragraph two of the Norwegian Penal Code, a national flag or anything that is liable to be understood as such a sign or flag.

For wine and spirits, it is not permissible to register a trademark that consists of or contains anything that is liable to be understood as a geographical indication of origin, unless the geographical origin of the goods is in accordance with the indication.