



JAPAN PATENT ATTORNEYS ASSOCIATION

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September 16, 2015

Mr. Wang Binying
Deputy Director General
WORLD INTELLECTUAL PROPERTY ORGANIZATION
34, chemin des Colombettes
1211 Geneva 20, Switzerland
(sct.forum@wipo.int)

Re: Comments on the Revised Draft Reference Document on the Protection of Country Names

Dear Mr. Wang Binying,

The Japan Patent Attorney Association (JPAA) was established under the Patent Attorneys Act in Japan in May of 1915, and it is the sole professional bar association of patent attorneys in Japan. At present, the JPAA has about 10,000 members practicing in intellectual property law in Japan. Its members practice in all areas of intellectual property law including patent, trademark and design law as well as copyright and unfair competition.

The JPAA would like to submit comments on the Revised Draft Reference Document on the Protection of Country Names.

CONTENTS OF SCT34/2

It is noted from SCT34/2, which is a revised version of the Draft Reference Document on the Protection of Country Names Against Registration and Use as Trademarks (SCT30/4) in which replies from SCT member countries to the questionnaire on law and practice concerning the Protection of Names of States Against Registration and Use as Trademarks are compiled, that, in many SCT member countries, signs consisting of or containing country names are:

- Generally excluded from registration or
- Excluded from registration (a) if considered to lack distinctive character or to be descriptive, (b) if considered misleading as to the origin of goods or services or (c) for other reasons such as being considered marks which are contrary to public order or morality, etc.

Also, express authorization by the competent authority or a disclaimer concerning the name of the country seem to be indispensable in many countries where marks consisting of or containing country names are registrable.



It is also noted that there are several opportunities at various stages before and after the registration of a trademark for cancellation or invalidation of trademarks consisting of or containing country names.

Incidentally, SCT34/2 also identifies that there is a country where a descriptive mark consisting of a country name may be registered based on acquired distinctiveness. However, in reality this would be hard to prove for the applicant of a trademark which solely consists of a country name, as the relevant public will often perceive the mark as the name of a country, not exclusively as an indication of commercial origin.

JAPANESE PRACTICES AND LAWS

In Japan, applications for marks containing a country name will generally be rejected as such marks are considered as being or likely to be misleading as to the quality of goods or services unless the designated goods or services are limited to those specifying the origin of goods and services so as not to cause a misleading recognition as to its quality¹, while applications for marks consisting solely of a country name will generally be rejected as such marks are considered descriptive (and are considered as being or likely to be misleading as to the quality of goods and services).

Even if a mark as described above has been granted registration, it would be possible to file an opposition against the trademark registration entirely or partially regarding the designated goods/services for which the registered trademark lacked distinctiveness within a two-month period from the publication date of the registered trademark in a Gazette. Additionally to or separately from such trademark opposition, it would be possible to attempt to invalidate the trademark registration where it has been discovered not to have fulfilled the above requirement, i.e. not to cause a misleading recognition as to its quality.

Incidentally, although invalidation trials cannot be lodged from five years after the registration date if invalidation trials are based on the lacking of distinctiveness of a registered trademark, it is possible to lodge invalidation trials any time after the registration date if the claims are based on being or likely to mislead as to the quality of goods or services.

It should be noted that there are certain numbers of users who legitimately own a trademark registration for a mark containing a country name because marks containing a country name are registrable under the Japanese Trademark Law provided that there would be no likelihood of the marks being misleading as to the quality of goods and services.

Accordingly, it should be taken into account that international harmonization for practice concerning country names may have an undue influence on the economic activities of owners of trademark registration for a mark containing a country name.



CONCLUSION

From SCT33/4, it is considered that, although rules or practices concerning protection for country names vary among the member countries, country names are sufficiently protected under the legislation in many countries.

Also, as there is a certain number of users who legitimately own trademark registration for marks containing a country name and use such marks in many member countries including Japan, it should be taken into account that establishing new international guidelines internationally-harmonized for trademark practice concerning country names may have an undue influence on the economic activities of owners of trademark registration for a mark containing a country name.

ⁱ It is expressly stated in the Japan Patent Office's examination guideline that "A trademark including a state name, a geographical name, etc. which is recognized to indicate the place of production and sale of goods or the nature of the contents of the services or the location of the provision of services in connection with its designated goods or designated services and used for goods produced and sold or services provided in a country or a place other than those where it is inherently produced and sold or provided falls under the provision of this paragraph on the ground that the trademark is liable to be misleading as to the quality of goods or services."

* * *

The JPAA again appreciates the opportunity to submit comments on the Revised Draft Reference Document on the Protection of Country Names. We would be pleased to answer any questions about these comments.

Sincerely,

A handwritten signature in black ink, appearing to read "Masaru Itami", is positioned above the typed name.

Masaru ITAMI
President
Japan Patent Attorneys Association

Friedli, Martha

From: K. Suzuki JPAA <k.suzuki-jpaa@nifty.com>
Sent: Friday, September 25, 2015 3:14 AM
To: Forum, SCT
Cc: gyomukokusai@jpaa.or.jp; 増田さん
Subject: Re: Request for Comments: Revised Draft Reference Document on the Protection of Country Names
Attachments: JPAA_Comments_0916.pdf

Dear Mr. Wang Binying

This is Kumiko Suzuki from Association business Internal affairs section of JPAA.
Please find attached comments from Mr. Itami, President of JPAA.
Please do not hesitate to contact me if you have any questions.

Thank you and best regards,

Kumiko Suzuki
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Japan Patent Attorneys Association(JPAA)
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From: [E-documents](#)
Sent: Monday, August 17, 2015 7:10 PM
To: [E-documents](#)
Subject: Request for Comments: Revised Draft Reference Document on the Protection of Country Names

Please find enclosed circular C. 8467 relating to thirty-third session of the *Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT)*.

Veuillez trouver ci-joint la circulaire C. 8467 concernant la trente-troisième session du *Comité permanent du droit des marques, des dessins et modèles industriels et des indications géographiques (SCT)*.

Tenemos el agrado de enviar adjunto la circular C. 8467 relativa a la trigésima tercera sesión del *Comité Permanente sobre el Derecho de Marcas, Diseños Industriales e Indicaciones Geográficas (SCT)*.

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