

Possible Area of Convergence No. 1
Notion of Country Name

At least for the purposes of examination of marks, and unless the applicable law specifies otherwise, a country name may cover: the official or formal name of the State, the name that is in common use, translation and transliteration of that name, the short name of the State, as well as use of the name in abbreviated form and as an adjective.

Comments and observations: The IPOPHL agrees with the provision considering that the same is being followed in the examination of marks. We have reservations, however, on the use of country names in abbreviated form because there are abbreviations that are not commonly known to examiners such as country names in domain name forms (e.g. "ar" for Argentina; "at" for Austria; "bb" for Barbados, etc.). Are these abbreviations included in the definition of country name? Other abbreviations such as USA, UAE, UK are common and easily recognizable, thus, can be protected. Shall WIPO publish a list of protectable country name abbreviations to be provided by Member States?

Possible Area of Convergence No. 2
Non-registrable if Considered Descriptive

At least for the purposes of examination, trademarks consisting solely of a country name should be refused where the use of that name is descriptive of the place of origin of the goods or services.

Comments and observations: The IPOPHL agrees with the provision considering that it is observed in the examination of marks. Section 123.1 (j) of the IP Code of the Philippines provides that a mark cannot be registered if it consists exclusively of signs or of indications that may serve in trade to designate the geographical origin of goods and services. This provision covers country names. For example, "France" cannot be registered for perfumery and wine if the goods come from France because it is indicative of the geographical origin of the goods. "New Zealand", "Australia" and "Aussie" cannot be registered for milk and milk products coming from those countries. "Japan" cannot be registered for cars and automotive parts originating from Japan.

Possible Area of Convergence No. 5 Invalidation and Opposition Procedures

The grounds for refusal described in possible areas of convergence No. 2, 3 and 4 above should constitute grounds for invalidation of registered marks, and where the applicable law so provides, also grounds for opposition.

Comments and observations: Although the IP Code of the Philippines and its regulations do not specifically enumerate these grounds for invalidation and opposition, these are all taken into account because Section 151 provides that a petition for cancellation may be filed if the registration of a mark was obtained contrary to the provisions of the IP Code. This means that if a country name was registered even if it is descriptive of, or misleading as to the geographical origin of the goods, then it can be cancelled for having been registered contrary to the provisions of the IP Code. Section 134 on opposition, on the other hand, provides that any person who may be damaged by the registration of the mark may file an opposition. It does not provide for specific grounds. For example, if the mark "Italy" or "Italia" was registered for pasta or wine and the goods do not come from Italy, then it can be cancelled or opposed for being misleading. We, therefore, agree with the above area of convergence.

Possible Area of Convergence No. 6 Use as a Mark

Appropriate legal means should be made available for interested parties to prevent the use of country names if such use is likely to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services and to request the seizure of goods bearing false indications as to their source.

Comments and observations: The IP Code of the Philippines already provides for these remedies although the phrase "country names" is not specifically mentioned. Section 166 provides that no article of imported merchandise calculated to induce the public to believe that the article is

manufactured in any foreign country or locality other than the country or locality where it is in fact manufactured shall be admitted to entry at any customhouse of the Philippines. Section 168 provides for acts constituting unfair competition and Section 169 provides for acts constituting false designations of origin; false description or false representation. Thus, if the packaging or trademark of the goods says "Mexico" or "Brazil" and in fact they do not come from those countries, then, it violates at least Sections 166 and 169 of the IP Code. The remedies of search and seizure are available to the complainant under the prescribed rules. We, therefore, agree to this area of convergence.