

Conselho Directivo

Only by email

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Sua referência:

Sua comunicação de:

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SUBJECT: COMMENTS ON THE CIRCULAR C. 8199

Mrs Wang Binying,

In reference to the above-mentioned Circular related to the invitation to the SCT Member States to submit information concerning the protection of country names in the field of registration of trademarks in their jurisdiction, I have the pleasure to send you herewith the comments of the Portuguese Institute of Industrial Property (INPI PT).

With regard to the protection of country names in the Portuguese legal system, particularly in the context of industrial property legislation, we must say that there are no provisions which provides direct protection (or not) of such elements.

Indeed, the Article 222 of the Portuguese Industrial Property Code (IPC) allows the use as a mark of any set of elements capable of being represented graphically, so we conclude that there is no prohibition for any applicant to include in their trademarks names of countries.

However, despite not being expressly provided any rule regarding the protection as a mark of a country name, such use cannot be regarded under the Portuguese law as unlimited. It should be noted that the protection of the use of country names is not seen

as a direct protection of country names, but rather as a limit of such use, protecting all the competing users (the names have to be available for all the applicants), and also protecting the consumer.

Considering this, in accordance with subparagraph c) of paragraph 1 of Article 223 of the IPC, signals which consist exclusively of a geographical origin (which logically includes the names of countries) cannot be granted (even though, we can argue that if there is not a connection between the name and the product or service mentioned, the signal can be granted). However, in the case of existing a connection between the name and the product or service, we can also conclude, by the interpretation of this normative, that if the signal is not merely composed by the name of the country, it will be able to be granted (interest competition).

Nevertheless, the possibility suggested in the previous paragraph, it should be noted that even if the signal is not merely composed by a geographical origin, it does not mean that it will be granted immediately. Such limitation may arise from the fact that the sign in question could mislead the consumer about the origin of a product or service, in accordance with subparagraph d) of paragraph 4 of Article 238 of the IPC (consumer interest).

On the other hand, regarding the procedures applied to trademarks with country names, we must say that they are the same applied to any other applications, considering that there is no special provision for the protection of these kinds of applications, there are also no special procedures applied.

Regarding the question posed about the scope of protection, we must say that according the Portuguese IPC, namely the articles referred, the refuse of a solo country name as a trademark can more easily occur than the refuse of an application that contains other

elements, beyond the country name. However, this is not an absolute rule (for instance a trademark with more elements, other than the country name, can be refused if mislead the consumer, about the origin of the product marked and a trademark only composed by the country name can be accepted if considered a fantasy regarding the product or service marked).

Finally, the protection given to the official country names and to their variations is made under the same articles and as we have mentioned, are not special rules.

Yours sincerely,



Leonor Trindade
President of the DC

