

## Protection of country names against registration as trademarks

### *Italy's reply to the call for elements*

#### *by the WIPO "Standing Committee on the Law of Trademarks, Designs and Geographical Indications"*

*(October 2016)*

#### **(I) Definition of country name**

Since 1942 art. 20 of the Italian Trademark Law had devoted an *ad hoc* discipline to geographic names, allowing their registration at certain conditions. The Industrial Property Code (C.P.I., Legislative Decree. n. 30/2005) currently in force, in line with EU harmonized law and international standards, provides for a differentiated treatment of collective and individual trademarks. As regards collective marks, according to art. 11 para. 4 of C.P.I., a geographic mark may be registered, provided that "*it does not create situations of unjustified privilege and/or undue advantage*" and "*it does not hinder the development of similar initiatives in the region*"<sup>1</sup>. What qualifies the collective mark and sets it apart from individual marks lies not in the existence of a certain '*de facto*' guarantee of quality (which is present in both cases) or in the collective use, which might also occur in the case of individual marks (through non-exclusive licenses), but rather in that the collective mark must provide for a set of quality or productive specifications, to be lodged at the Registration Office, rules of use and, especially, controls and sanctions. Therefore, the collective mark responds to the logic of a stronger consumer protection through the controls element.

#### **(II) No registration of the mark if descriptive**

The current standard for the registration of individual marks containing geographical elements in Italy is derived from the general provision on distinctiveness, *i.e.* art. 13, para. 1 of C.P.I., which prohibits registration of signs devoid of any distinctive character, including "*those made solely by the generic names of goods or services or of descriptive indications which*

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<sup>1</sup> CPI Legislative Decree no. 30/2005 - Art. 11, paragraph 4: "*Notwithstanding Article 13, paragraph 1, a collective mark may consist of signs or indications which may serve in trade to designate the geographical origin of products or services. In this case, however, the Italian Patent and Trademark Office may refuse, for justified reasons, recording when the marks applied for might create situations of unjustified privilege or otherwise be detrimental to the development of similar initiatives in the region. The Italian Patent and Trademark Office has the right to ask about the notice of government departments, categories and interested bodies or competent. The successful registration of the collective mark consists of a geographical name does not entitle the proprietor to prohibit a third party from using the trade name, provided he complies with the principles of professional integrity*".

relate to them”, in particular those “which may serve in trade to designate (...) the geographical origin of the product or service for which they are registered”<sup>2</sup>.

It is thus left open the possibility to protect individual marks which consist exclusively of geographical names or of names of States, regions or locations provided that they do not refer to - in the perception of the relevant public (consumers/buyers of that specific merchandise sector) - the characteristics, nature or features of the goods or services to which they apply and therefore they appear in the eye of the public mostly as arbitrary or fantasy names (see para. III).

Attached are a few examples of international trademarks who have sought protection in Italy, for which the Italian Patent and Trademark Office (UIBM) issued a decision of refusal of registration because of the descriptive nature of the sign in relation to the products/services (please see annex 1.A).

### **(III) Use of the geographical name as trademark**

Consequently, it is possible to register a trade mark containing a geographical name, region or locality, whenever the mark is not composed exclusively of a geographical name or of a name of region or locality or, if it is, when the name, in relation to the products and/or services requested, is perceived by consumers as a fancy name and, therefore, consumers will not automatically associate a geographical origin or quality of production to the traded goods or to service delivery.

Examples of national trademarks which have been considered as “fantasy names” with respect to the goods claimed, are “*Capri*” for cigarettes and “*Roma*” for a fragrance or perfume.

Any limitations or indications based on geographical origin in the list of products or services is not accepted by the Italian Patent and Trademark Office (UIBM), which aligns itself to the Nice Classification, designed to identify products and services with respect to their market sector (merchandise) and not with respect to their geographical origin.

Please find enclosed herewith some examples of findings issued UIBM related to international brands who have requested protection in Italy (please see annex 1.B).

### **(IV) Procedures for the opposition or cancellation of trademarks containing country names**

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<sup>2</sup> CPI Legislative Decree no. 30/2005 Art. 13 para 1. *"They can not be registered as a trade mark the marks lack distinctive character, in particular those made solely by the generic names of goods or services or by indications descriptive and refer to them as the signs that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the product or the service, or other characteristics of the product or service.*

There are no records at the Italian Patent and Trademark Office (UIBM) of relevant cases of opposition or cancellation procedures regarding trademarks containing names of countries.