

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.

Country names do not form a separate category of protected marks under the current legislation applicable to the United Kingdom but they would be regarded as being an indication of geographical origin. Any sign which designates the geographical origin of the product it is used upon (whether a good or a service), is prevented from registration under Article 3(1)(c) of Directive 2008/95/EC, and Article 3(1)(c) of the UK Trade Marks Act 1994. The wording of Section 3(1)(c) states that “trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services” shall not be registered.

However the law does not prevent country names from being protected as trade marks *per se*. In certain cases, country names would have the inherent capacity to function as trade marks especially where there is no association in the mind of the relevant consumer between the country name and the goods or services, (for example ‘Bermuda’ for snow blowing machines). Also where the country name is used with other matter then the combination could be seen as acting as an indicator of commercial rather than geographic origin (for example, the well-known ‘Canada Dry’ and ‘Canada Goose’ brands used in respect of drinks and clothing respectively).

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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.

Any sign which designates the geographical origin of the product it is used upon (whether a good or a service), is prevented from registration under Article 3(1)(c) of Directive 2008/95/EC, and Article 3(1)(c) of the UK Trade Marks Act 1994. This means that the names of countries, cities, towns and localities will be prevented from registration as trade marks where the consumer makes an association between the place-name and the product. To illustrate, the word ‘Japan’ could never be registered as a trade mark for electronic goods because consumers will perceive it as being nothing more than a reference to the place of manufacture.

Where the consumer does *not* make an association between the product and the geographical place name (for example, because the place has no connection with the product, or because the consumer recognises the product and country as being wholly incompatible), then the country name may be capable of functioning as a trade mark.

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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

Section 47 of the UK Trade Marks Act 1994 provides the grounds for invalidation of a trade mark registration. Specifically, section 47(1) states that “the registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration)”. Because ‘designation of geographical origin’ is a basis for ex officio refusal under section 3, so it is also a basis for invalidation proceedings.

Opposition proceedings can also be brought on the basis of section 3 (Absolute Grounds) and/or section 5 (Relative Grounds). This means that, as is the case with invalidation, opposition proceedings can be based upon an allegation that the published trade mark designates the geographical origin of the goods and/or services.

However, UK law does *not* contain any specific provisions relating to invalidation of, or opposition to, trade marks consisting of country names.

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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.

Sections 38 (2) and (3) of the UK Trade Marks Act allow for any party to file an opposition, or to make observations relating to the proposed registration of a mark. Section 47 allows for any party to challenge an existing registration of a trade mark. The grounds for opposition, observation or invalidity could be based on any of the provisions in Section 3 (absolute grounds for refusal of registration).

However, UK law does not contain any specific provisions which address the use of a trade mark consisting of, or containing, a country name,