

## **Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications**

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### **STUDY ON THE PROTECTION OF COUNTRY NAMES**

*Document prepared by the Secretariat*

#### **I. INTRODUCTION**

1. At the twenty-first session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) held in Geneva from June 22 to 26, 2009, members initiated discussions on the protection of official names of States against their registration and use as trademarks (paragraph 15 of document SCT/21/7).

2. At that session, the SCT agreed to request the Secretariat to prepare a draft Questionnaire Concerning the Protection of Official Names of States Against Registration or Use as Trademarks (hereinafter "Questionnaire Concerning Names of States"), containing a concise list of questions, to be addressed to SCT members in the second half of 2010 (paragraph 14 of document SCT/22/8). Accordingly, the Secretariat produced the questionnaire contained in the Annex to document SCT/24/2 and circulated it among SCT members on July 22, 2010.

3. The following SCT members provided replies to the questionnaire: Albania, Australia, Austria, Azerbaijan, Bangladesh, Barbados, Belarus, Brazil, Bulgaria, Canada, Chile, China, Croatia, Czech Republic, Denmark, Dominican Republic, Estonia, Finland, France, Georgia, Germany, Greece, Guatemala, Hungary, Iran (Islamic Republic of), Ireland, Italy, Jamaica, Japan, Jordan, Kazakhstan, Kenya, Kyrgyzstan, Latvia, Lithuania, Madagascar, Malaysia, Mexico, Monaco, Montenegro, Morocco, Myanmar, New Zealand, Nigeria, Norway, Oman, Peru, Poland, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation,

San Marino, Serbia, Singapore, Slovakia, Slovenia, South Africa, Spain, Sri Lanka, Sweden, Switzerland, Syrian Arab Republic, Trinidad and Tobago, Turkey, Ukraine, United Kingdom, United Republic of Tanzania, United States of America and Uruguay.

4. The replies to the Questionnaire were compiled in document SCT/24/6, which was presented to the twenty-fifth session of the SCT. At that session, the SCT considered a draft reference document on the protection of country names against registration and use as trademarks (document SCT/25/4), addressing in particular the exclusion of names of States from registration as trademarks, procedural issues relating to the registration of trademarks consisting of containing names of States, protection against use as trademarks, and Article 10 of the Paris Convention for the Protection of Industrial Property (Paris Convention).

5. At that session, the SCT invited interested members to communicate to the Secretariat cases and case studies relevant to the protection of names of States as well as any information on nation branding schemes in which they had engaged including problems encountered in their implementation. The SCT requested the Secretariat to compile those communications into a working document to be presented to the twenty-seventh session of the SCT and to include information on nation branding available at WIPO (paragraph 14 of document SCT/26/8).

6. The following SCT members sent submissions requested by the Committee: Jamaica, Lithuania, Mexico, Poland, Republic of Moldova, Turkey, Uganda and the United States of America. All submissions were posted in their entirety on the SCT Electronic Forum web page at <http://www.wipo.int/sct/en/comments/>.

7. At its twenty-seventh session, held in Geneva from September 18 to 21, 2012, the SCT considered proposals submitted by the Delegations of Barbados and Jamaica contained in documents SCT/27/6 and SCT/27/7. In furtherance of the work previously undertaken, the SCT requested the Secretariat to conduct a study on the current legislative provisions and practices in national or regional legislation relating to the protection of country names in the field of registration of trademarks, as well as best practices related to the implementation of such provisions, in accordance with the Terms of Reference contained in Annex I.

8. Accordingly, the Secretariat has produced the present document, based on its records of national systems and on information made available through submissions by the following SCT members: Antigua and Barbuda, Argentina, Australia, Belarus, Belgium<sup>1</sup>, Belize, Chile, China, Colombia, Costa Rica, Czech Republic, Ecuador, Finland, Georgia, Germany, Greece, Ireland, Italy, Japan, Lithuania, Luxembourg<sup>1</sup>, Myanmar, Netherlands<sup>1</sup>, Norway, Philippines, Portugal, Republic of Moldova, Romania, Russian Federation, Slovakia, Slovenia, Spain, Turkey, Ukraine, United Kingdom, and Viet Nam. All submissions in their entirety were posted on the SCT Electronic Forum web site page at: <http://www.wipo.int/sct/en/comments/>. This document is also based on the submissions presented by the members indicated in paragraph (6), above, for the twenty-seventh session of the SCT.

## PRELIMINARY REMARKS

9. The study contained in this document attempts to provide an overview of national legislation, practice and available jurisprudence in the field of trademarks, involving the protection of country names. In the series of relevant SCT documents, the expressions “country names” and “names of States” have been used interchangeably. In addition, the first note to document SCT/24/2 contains the following explanation: “the expression ‘names of States’ is meant to cover the short name of the State or the name that is in common use, which may or may not be the official name, the formal name used in an official diplomatic context, the historical name, translation and transliteration of the name as well as use of the name in abbreviated form and as adjective”.

10. Since the present study considers SCT members' laws and practice, the latter general notion needs to be looked at in the context of the applicable procedures. Generally speaking, all contributing SCT members have transposed in their national trademark law the principle contained in Article 6*quinquies* B.2 of the Paris Convention for the Protection of Industrial Property (hereinafter "the Paris Convention"), namely the refusal of registration as trademarks of signs which "...consist exclusively of ... indications which may serve, in trade, to designate ... the place of origin of the goods...". The extent to which the "place of origin" includes the official name, the short name, the formal name, the historical name of a State or the translation, transliteration, abbreviation or adjective thereof, varies from country to country.

11. Part II of the document reviews the grounds for refusal of trademark applications which are most commonly used in relation to signs consisting of or containing country names, namely descriptive, misleading or deceptive character and public order exception. This part also looks at *per se* protection of country names since a good number of SCT members have reported that their national trademark law includes this specific ground for refusal. In addition, Section (d) describes a number of specific additional grounds that have been established in national laws to cover, for example short names of States, abbreviations and international country codes.

12. Part III of the document looks at other phases of the registration procedure, namely opposition, invalidation or cancellation procedures and the possibility of submitting observations to the Office concerning the unsuitability of a country name to function as a mark. Such procedures are perceived to provide an additional avenue to prevent the undue registration or use of country names as trademarks.

13. Part IV attempts to look at trademark and non-trademark regulations and best practices developed by SCT members concerning the protection of country names. As such, this part merely points to those measures that have been identified in different contexts. Some of the measures reviewed in this part may arise from local practices and intra-sector analysis and may therefore not lend themselves to generalization.

14. Finally, Part V contains some concluding remarks that attempt to extract best practices that are used by members to deal with the protection of country names, both in trademark registration procedures and in the more general context of trade.

## **II. EXAMINATION PHASE**

15. In order for a trademark to be protected, and for that right to be enforced against third parties, the mark must be validly registered, which means that registration should not be barred by what are usually known as absolute and relative grounds<sup>2</sup>. The distinction between these two types of grounds is not universally accepted and is therefore not used in the present document, which considers examination on the basis of the general requirements that a sign must fulfill in order to function as a trademark. It is not uncommon for certain national laws to protect unregistered or common law trademarks, but this type of trademarks are outside the ambit of the present document.

16. Examination is carried out by each trademark Office in line with national laws and regulations, the detailed provisions of which may vary from one country to another. However, the member State practice described in the submissions received generally distinguishes between applications where the mark consists of a geographical name, i.e., a country name and applications where the mark contains a country name. The distinction has important consequences on the registrability assessment, as in some cases, a mark consisting of a country name is rejected without any further consideration as to whether or not the sign is misleading as to the geographical origin of the goods.

17. In some jurisdictions, a mark containing a country name may only be accepted for registration if that country name appears amongst other elements and subject to prior authorization from the competent authorities, if the sign is not misleading as to geographical origin. When assessing the misleading character of the sign in relation to the goods and services, a link is usually established between the mark applied for and the nationality of the applicant, or the mark and the place of origin of the goods that the sign is intended to cover. In both cases, the existence of a link is the key factor to determine whether the sign can be acceptable, at least in principle<sup>3</sup> (see Figure 1 in Annex II to this document).

18. Under the law of certain countries, a specific ground for refusal has been introduced, which prevents the registration of country names, either the name of the country where the application is received, or the names of foreign nations. However, generally speaking, where national law does not provide for such specific provisions, the usual grounds relating to descriptive or misleading character will apply. Yet in other countries, applications for trademarks containing country names may be refused on the grounds of being deceptive to consumers or contrary to public order and morality.

## DESCRIPTIVE CHARACTER

19. The basic function of a trademark is to distinguish the products or services of one undertaking from those of another. In other words, a trademark must be distinctive and among the criteria that make a trademark distinctive is the absence of any descriptive feature. This potential ground for refusal is invoked by offices in examination, to determine whether the signs applied for are indications used to designate the characteristics of the goods or services, or *inter alia*, their place of origin. This is the most commonly used ground against which the registrability of country names as trademarks is checked, since the interest of the public is that such indications remain available for use by any trader to provide information relating to the goods or services sold or offered.

20. For that purpose, various jurisdictions simply prohibit the registration and use of marks that consist of geographical names<sup>4</sup>. While others adopt the terminology of Article 6*quinquies* B.2 of the Paris Convention and exclude from registration as trademarks of signs or indications which may serve in trade to designate the geographical origin of goods or services<sup>5</sup>. Although this terminology does not expressly refer to country names, it is interpreted by a number of trademark offices as excluding names of States from registration, at least when they constitute exclusively the sign applied for (see Figures 1 and 2 in Annex II to this document).

21. According to the quantitative summary of replies to the Questionnaire Concerning Names of States (Question I.1)b), Annex II of document SCT/24/6), 95.9% of the responding countries indicated that under the applicable legislation, names of States are excluded from registration as trademark for goods if they could be considered descriptive of the origin of the goods in respect of which registration is sought.

22. In addition, according to the individual member State submissions communicated to WIPO to prepare the present study, the following practices were described. When examining applications containing a geographical place name, some Trademark Offices will consider that the sign applied for “consists exclusively” of such a name if it is accompanied by non-distinctive elements. On the contrary, if the sign is combined with elements which are found distinctive, the trademark would be accepted for registration<sup>6</sup>.

23. This understanding derives from the common ground according to which a sign would not be registrable if it consists of a descriptive indication. In this instance, the name of a country would be recognized by the consumers as merely evocative of the place of origin of the goods or services and therefore would lack distinctiveness<sup>7</sup>. Since geographical terms in general may

serve in trade to designate the origin of the goods or services, it is considered that such indications, including country names, should remain available to traders, either as part of a trademark or as a description of the products or services.

24. A clear illustration of this principle is found in the Trademarks Act of the United States of America, which provides that “a mark which, when used on or in connection with the goods of the applicant is (...) primarily geographically descriptive”<sup>8</sup> could be refused registration. Although no specific protection is provided in the law for country names, it should be noted that marks composed of or consisting of geographical signs, including names of States, could be refused if the mark is considered geographically descriptive (see Figure 3).

25. In its submission, the Delegation of Germany recalled the Court of Justice of the European Union decision in joint cases C-108/97 and C-109/97, according to which names designating a geographical origin – for example names of countries – as a rule must be kept available for use by other traders<sup>9</sup>. The Delegation noted that any registrations of country names in the trademark register of Germany usually date from a time prior to that judgment.

26. The Delegation of Germany also noted that a geographical name may be registered as a trademark only if there is special evidence that, exceptionally, it is not capable of serving in trade as a reference to the geographical origin of the goods and services concerned. In this context, it is not only the current need to leave the sign free for use by others that should be considered but, based on a realistic prediction, it should also be considered whether it is reasonable to assume that such a need may be expected in the future<sup>10</sup>.

27. In some cases however, registration is only granted if the applicant files a disclaimer with the Office. Therefore, the trademark would be registered as a whole but the name of the State would not be granted specific protection. In its submission, Jamaica indicated that where the trademark includes as an element the country name, the national Office requires the applicant to include a disclaimer concerning the latter. According to the submission by Belize, the same practice applies in that jurisdiction<sup>11</sup>. In essence, the country name is kept available for other traders, while it can potentially be included in several marks.

28. Another exception to the refusal of the registration of geographically descriptive terms can be found where the Office accepts special evidence that the geographical name in question does not serve in trade to indicate the geographical origin of the goods or services<sup>12</sup>. Similarly, the Examination Guide adopted by the Spanish Patent and Trademark Office (OEPM) specifies that the registration of a geographic designation is not prohibited *per se*, but only to the extent that it constitutes exclusively an indication of origin of the goods or services<sup>13</sup>. It would seem difficult, however, to prove the absence of association, by the consumers, between the country name and the origin of the products or services. Besides, the OEPM Examination Guide clarifies that the exclusion concerning official emblems of Spain does not extend to the denomination “Spain” or the names of other States, which could be protected against appropriation under the general exclusion concerning geographic indications.

29. In its submission, the Delegation of Italy declared that national legislation does not contain a specific provision concerning the exclusion of country names from registration as trademarks. In such cases, the general principles of trademark law apply. In particular, the law provides that “the rights in a registered trademark shall not entitle the proprietor to prohibit another person from using in the course of trade references to the geographical origin of the goods or services...”<sup>14</sup>. However, in carrying out trademark examination of applications containing a country name, the Italian Trademark Office gives particular attention to the distinctive character of the sign applied for.

30. According to one submission<sup>15</sup>, it is in principle, possible to register a descriptive mark of a country name through acquired distinctiveness. This may apply if the sign in question has become well-known as the applicant's indication of commercial origin in the relevant market. However, in reality this would be hard to prove for the applicant in respect of trademarks which exclusively consist of a country name, as the relevant public will often perceive it as the name of a country, not exclusively as the applicant's indication of commercial origin.

#### MISLEADING, DECEPTIVE, FALSE

31. In addition to being descriptive, trademarks containing or consisting of country names may also be likely to mislead the public as to the origin of the goods or services. A false representation through a mark that goods or services originate from a particular place may expose that mark to refusal, if in fact the goods or services have no connection with the country name. The boundaries among the terms misleading, deceptive or false are not clearly defined, and there is a degree of overlap in the subject matter that can be characterized as the one or the other (see Figure 4).

32. According to the quantitative summary of replies to the Questionnaire Concerning Names of States (Question I.1)c), in Annex II of document SCT/24/6), 98.5% of the responding countries indicated that country names are excluded from registration as trademarks if the use of the name of a State could be considered to be misleading as to the origin of the goods and 77.3% said that names of States would be excluded if they can be considered incorrect as to the origin of the products for which registration is sought (Question I.1)e), in Annex II of document SCT/24/6).

33. The law in certain jurisdictions provides for a universal bar to registrability of geographically misleading signs. For example, EC Directive 89/104 provides that trademarks shall not be registered if they are of "such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service"<sup>16</sup>. This provision is designed to protect the public, i.e., the consumers of the goods or services offered under the trademark for which registration is sought.

34. In the United States of America, a mark may not be registered if it is "primarily geographically deceptively misdescriptive of the goods or services named in the application"<sup>17</sup>. To support a refusal to register a mark on this ground, it must be shown that: (1) the primary significance of the mark is a generally known geographical location; (2) the goods or services do not originate in the place identified in the mark; (3) purchasers would be likely to believe that the goods or services originate in the geographical place identified in the mark. However, if the mark is remote or obscure, the public is unlikely to make a goods/place or services/place association; and (4) the misrepresentation is a material factor in a significant portion of the relevant consumer's decision to buy the goods or use the services (see Figure 5).

35. Under the national laws of several States, geographical terms, or names, as well as abbreviations thereof, cannot be registered as trademarks where such indications are likely to mislead the consumers or create confusion concerning the origin of the goods or services<sup>18</sup>. The terminology used in national law to describe misleading character or likelihood of confusion is not always uniform<sup>19</sup>. In addition, two Member States, namely Poland and Ukraine referred to an international standard used by their national Offices to determine the official names of States<sup>20</sup>.

36. In its submission, the Delegation of Australia noted that grounds for rejection of a trademark are only established where it is clear that the trademark as a whole is not capable of distinguishing, or that because of a connotation in the mark, use of the trademark would be

likely to deceive or cause confusion. The trademark must be considered not only as a whole, but also taking into account the impact of the various elements of the trademark, including their relative size and prominence within the mark (see Figure 6)<sup>21</sup>.

37. According to one submission, geographical place names, and figurative trademarks indicating geographical origin, as well as variations of these, where the geographical place has a reputation for the goods or services applied for, should be objected<sup>22</sup>. The reason for such an objection would be that the use of a geographical place name in circumstances where it has a reputation creates an “expectation” in the mind of the consumer which could lead to deception if that expectation is not fulfilled (see Figure 7).

38. In some jurisdictions, the exclusion of geographical indicators from registration as trademarks, where those indicators include country names, receive a particular consideration when the application concerns goods such as wines and spirits. In those cases, the trademark registration of signs which include country names is prohibited if the goods (wines and spirits) do not originate in the relevant geographic location<sup>23</sup>.

#### PUBLIC ORDER OR MORALITY

39. It is a universally accepted principle that signs which are contrary to public order or morality are excluded from registration as trademarks. The appreciation of whether a particular sign is contrary to public order or morality is regularly subject to cultural and historical representations about the meaning of particular signs. Although it might not be *prima facie* evident how this ground could operate in relation to country names, there seem to be relevant examples in national law and practice. For instance, the Trademark Law of the Republic of Korea refers to “trademarks that falsely indicate a connection with, or that criticize, insult or are liable to defame, any nation...”<sup>24</sup>.

40. Some trademark laws stipulate that registration could be denied for trademarks that would disparage national symbols or bring them into contempt, or disrepute, although no specific mention is made of country names<sup>25</sup>. In the United States of America, application for the mark “NOT MADE IN CHINA” was refused by the United States and Patent Trademark Office (USPTO) on the ground that the mark consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols of China, in accordance with Section 2(a) of the Trademark Act<sup>26</sup>. In Italy, a sign which includes a country name may not be registered as a trademark if it is detrimental to the image of the country concerned<sup>27</sup>.

#### PER SE PROTECTION

41. According to the quantitative summary of replies to the Questionnaire Concerning Names of States (Question I.1)a), Annex II of document SCT/24/6), 61.1% of the responding countries indicated that names of States are generally excluded from registration as a trademark for goods and services. The following paragraphs describe the particulars of such protection in various countries.

42. Beyond the grounds that usually apply to all kinds of trademarks, some countries contemplate a specific protection for country names, regardless of whether the sign applied for may be descriptive or misleading. The relevant provisions usually include names of States among absolute grounds for refusal and often as an extension of the protection granted to State emblems, flags and other insignia. This approach creates an absolute bar for registration as trademarks of signs which contain or consist of country names, unless the applicant provides proof of consent by the competent authorities.

43. In some cases, the category country names is qualified as the national State or any State<sup>28</sup>, depending on whether or not it is intended to grant protection to the name of the State where the trademark is applied for or to the name of all States. As mentioned above, generally national laws do not contain specific references to any list of country names, and few of them include additional precisions as to whether protection is extended to the official names only, the common name of the State or an abbreviated version of that name.

44. In Cambodia, marks which are identical or similar with, or contain as an element “a name or abbreviation or initials of the name of (...) any State” cannot be registered<sup>29</sup>. This provision is included in the enumeration of signs which correspond to Article 6*ter* and could therefore be considered as a national extension of that provision. Similarly, the Trademark Act of Bangladesh incorporates country names in the listing of an absolute ground corresponding to that contemplated by the Law of Cambodia<sup>30</sup>. In Iran (Islamic Republic of), a mark cannot be registered if “it is identical with, or is an imitation of or contains as an element, (...) a name or abbreviation or initials of the name of (...) any State”<sup>31</sup> and the legislation of Oman contains an identical ground<sup>32</sup>.

45. In the Republic of Moldova, where the official or historical name of the State (Republic of Moldova), the country name (Moldova), or abbreviations, as well as translations of those names are intended to be registered or used as trademarks, either by themselves or in combination with other verbal or figurative elements, an authorization needs to be sought and granted by a Government appointed Committee<sup>33</sup>. However, any other use of the signs previously mentioned, which does not constitute trademark use, may be considered by the State Agency for Intellectual Property (AGEPI) and authorized where considered appropriate, to any physical or legal person having its domicile or commercial establishment in the Republic of Moldova.

46. So-called extensions of the notion of State emblem appear also in other Member State submissions received after the twenty-seventh session of the SCT. Indeed, the Delegations of Antigua and Barbuda, Argentina, Belarus, Chile, China, Costa Rica, Ecuador, Georgia, Poland and Ukraine<sup>34</sup>, quoted in their submissions the applicable national legal texts containing a specific reference to country names, and in some cases, short names or abbreviations of those names (see Figure 8). Yet, in other member submissions, there is reference to national practice, according to which the provisions of Article 6*ter* have been understood to cover country names<sup>35</sup>. One Member State submission indicates a specific ground for refusal is contemplated in national law to exclude from registration the name of that State only<sup>36</sup>. The text remains silent in relation to the names and other denominations of foreign countries.

47. Apart from the ground for refusal that assimilates country names to State emblems, the laws of certain countries provide for a specific and separate ground for refusal concerning country names. For the purposes of this study, it may be interesting to look at the details of the provisions which have been included for this purpose in national trademark laws.

48. The Trademark Law of Serbia prohibits the registration of the “name or abbreviation of the name of a country”<sup>37</sup>. In Albania, the national trademark law provides that “a sign is not registered as a trademark if it consists of the name of a State”<sup>38</sup>. In addition, the implementing regulation specifies that this absolute ground for refusal was established because of the lack of distinctive character of country names, and that when other distinctive elements accompany that name, the trademark could be registered, provided that the applicant includes a disclaimer concerning the name of the State.

49. In its submission prior to the twenty-first session of the SCT, the Delegation of the Russian Federation mentioned that “[r]egardless of the absence in Article 6*ter* of the Paris Convention of a reference to the names of States, the majority of the world’s countries have appropriate standards in their national trademark legislation, which allow the issue of protection of these names to be resolved. Thus, in accordance with paragraph 1 of Article 1483 of the Civil Code of



the Russian Federation..., State registration as trademarks of designations which do not possess distinguishing capacity or which consist solely of elements which characterize goods, including those indicating their place of production or sale, is not permitted”<sup>39</sup>.

## EXCLUSION OF OTHER VERBAL SIGNS RELATED TO GEOGRAPHICAL ORIGIN

50. It has been considered that an association between goods and services and a country can result from use of signs other than the official name of the country and therefore, certain national laws have extended the exclusion from registration as trademarks to the short name, translation of the name, abbreviation, international code, adjective indicating nationality, etc. Member States submissions have also covered these exclusions. For example, in its submission, the Delegation of Chile noted that, when the name of a country is expressed differently in different languages, a trademark application including any those variations should be refused registration<sup>40</sup> (see Figure 8).

51. Article 7(m) of the Law N°7978 on Trademarks and other Distinctive Signs of Costa Rica provides for an absolute exclusion of any sign that “reproduces or imitates, in full or in part (...) the name or abbreviated name of any State”. In its submission, Costa Rica clarifies that adjectives are not covered by that provision, although protection could be obtained for such indicators through the application of the principle of the exclusion concerning misleading indication of source that would therefore extend to the nationality<sup>41</sup>.

52. In its submission, the Delegation of Australia indicated that words other than a geographic place name may suggest a geographic relationship and this is also considered in examination. For instance, the word *Kiwi* can indicate New Zealand. A ground for rejection could in some circumstances be appropriate where *Kiwi* is a dominant part of the mark in such a way as to render the mark not capable of distinguishing or likely to deceive or confuse in use<sup>42</sup>.

53. The Industrial Property Law of Poland also clearly provides for a prohibition concerning any sign that “incorporates the name or abbreviated name of the Republic of Poland ... [and] the abbreviated names (...) of other countries”<sup>43</sup>. This provision was applied by the Patent Office of Poland, when refusing the registration of a trademark containing the term “Polska” as part of the verbal elements and combined with a figurative element (see Figure 9). The Patent Office decision was confirmed by the Voivodeship Administrative Court<sup>44</sup>.

54. In its submission, the Delegation of Poland reported that the Patent Office also refused the registration of a mark containing the letters “ID” and surrounded by an ellipse on the ground that it consisted of the letter code of Indonesia. The Patent Office took the view that the assessment of the trade mark must be made in respect of the trademark as a whole, but where the letters are the dominant component, the sign must be analyzed taking into account the semantic meaning of the letters. In the present case the abbreviation ID attracts attention of the recipient, being in the central part of the trademark and in the centre of the ellipse (see Figure 10).

55. In Sri Lanka, national law excludes from registration any mark “which is, according to its ordinary signification, a geographical name or surname” and “which reproduces or imitates (...) initials, names or abbreviated names of any State”<sup>45</sup>. Similarly, the law of the Dominican Republic excludes from registration signs that “reproduce or imitate (...) denominations or abbreviations of denominations of any State”<sup>46</sup>.

56. The national law of Argentina prohibits the registration of “letters, words, names (...) that are used or must be used by the State (... and) letters, words, names (...) that are used by foreign States”<sup>47</sup>. In Uruguay, the Trademark Law excludes from registration names identifying the State<sup>48</sup>. However, it should be noted that, according to the survey carried out in preparation of a study presented to the WIPO Committee on Development and Intellectual Property (CDIP),

such prohibitions are generally interpreted by the courts in Latin America in a restrictive manner. Therefore, this could allow the registration of common names of countries, as long as the consumers are not misled<sup>49</sup>.

### III. OPPOSITION PROCEDURES AND OTHER PROCEEDINGS

57. Even in Member States that provide for one of the described grounds for protecting country names from registration as a trademark or part of a trademark, there may be situations in which the examination by the national Office of an applied-for sign consisting of or containing a country name does not result in a refusal of registration. Notably, this may be the outcome in systems in which applications are not examined *ex officio* as to the potential ground for refusing country names. Moreover, there may be instances in which a national Office assumes that an applied-for sign consisting of or containing a country name can be registered.

58. National trademark laws may provide for procedures in addition to the *ex officio* examination that enable third parties to raise the claim that an applied-for sign should not be registered because it consists of or contains a country name. More specifically, opposition, observation, and invalidation procedures may offer additional avenues to prevent or remove a registration.

#### OPPOSITION

59. The availability of opposition procedures is a common feature of trademark registration regimes that is desirable and useful not only for applicants, rights holders and other interested parties but also for trademark administrations and the public at large<sup>50</sup>. Opposition procedures introduce an element of internal checks and balances and enable third parties to provide information and evidence which could prevent the registration of a particular sign as a trademark and which trademark offices otherwise may not have at their disposal<sup>51</sup>. The SCT identified areas of convergence in trademark opposition procedures at its twentieth session, held in Geneva from December 1 to 5, 2008<sup>52</sup>.

60. Opposition procedures can therefore present an additional opportunity for preventing the registration as a trademark of a sign incorporating a country name in cases where the *ex officio* examination of the trademark office concerned alone would not result in a refusal. Providing an additional opportunity to raise a specific point is a characteristic of opposition procedures irrespective of whether a national system provides for pre-registration or post-registration opposition<sup>53</sup>.

#### Grounds for Filing an Opposition

61. In order for opposition procedures to be able to offer an additional avenue for protecting country names, two conditions must be met under national trademark law: firstly, such law must contain a ground for refusing signs from registration as a trademark that consist of or contain a country name<sup>54</sup> and secondly, claiming inconsistency with that provision must be recognized as a ground for filing an opposition.

62. As far as the latter point is concerned, the replies to the Questionnaire Concerning Names of States indicate that in the majority of Member States whose trademark laws contain a possible ground for refusing an applied-for sign consisting of or containing a country name this ground can also be claimed in opposition procedures. Notably, 67.2 % of the replies received stated that if the name of a State is excluded from registration as a trademark in respect of goods this ground can be raised by third parties in opposition procedures. 67.7 % of the replies received stated that if the name of a State is excluded from registration as a trademark in respect of services, this ground can be raised by third parties in opposition procedures<sup>55</sup>.

63. This impression is corroborated by the submissions by the Delegations of SCT members received after the twenty-seventh session of the SCT. In their submissions, a number of Delegations expressly confirmed that it is possible under their national laws to raise the claim in opposition procedures that an applied-for sign consisting of or containing a country name should be refused registration because it is of merely descriptive character. These include the Delegations of Australia (see Figure 11), Chile, Finland, Ireland, Japan, Norway, and the United Kingdom<sup>56</sup>.

64. In Ireland, it may equally be invoked in opposition proceedings that a sign consisting of or containing a country name should be refused registration because it is devoid of any distinctive character. Moreover, the Delegations of Ireland, Finland, Japan, Norway, and the United Kingdom stated that their respective national laws allowed oppositions based on the claim that a sign consisting of or containing a country name should be refused registration because it is misleading, deceptive, or false. Finally, the national laws of Chile and Greece provide for *per se* protection of country names and also allow oppositions based on that ground<sup>57</sup>.

65. In Argentina, the national trademark law provides for *per se* protection of the official name of a state. In addition, the Office also refuses the registration as a trademark of a sign containing a country's common name if the country concerned files an opposition showing that a registration would damage its interests<sup>58</sup>.

#### Entitlement to File an Opposition

66. Whether a particular entitlement must be demonstrated in order to file an opposition is a question that is answered differently in national trademark laws. In some systems, any person may file an opposition. There are other systems, however, where opponents must have a legitimate interest in filing or must show that they would be damaged by the registration of the applied-for sign. Sometimes, still, the necessary entitlement depends on the grounds asserted and is determined by the Office<sup>59</sup>.

67. In systems limiting the circle of potential opponents the question arises who would be entitled to oppose the registration of a sign consisting of or containing a country name. In general, most concerned would appear to be the Government of the country whose name is the subject of an application for registration as a trademark or as part of a trademark. In this case, however, there may be doubts as to which body or authority within the Government would have the necessary standing. In Greece, for example, officially represented Governments may file oppositions<sup>60</sup>.

68. Apart from Governments, others may equally have an interest in preventing the registration of a sign as a trademark that consists of or contains a country name. One could, for example, think of nationals of the country or competitors of the applicant. Determining who has the necessary standing to file an opposition will ultimately depend on the applicable national trademark law.

#### Time Limit for Filing an Opposition

69. It is common practice that an opposition may only be raised within a certain time limit<sup>61</sup>. Typically, national trademark laws provide for time limits of either two or three months and in some countries this period may be extended<sup>62</sup>. The SCT considered that ideally an initial opposition period would be two months and in any case not more than six months<sup>63</sup>.

## OBSERVATIONS

70. A further potential avenue for claiming that an applied-for sign should not be registered because it consists of or contains a country name may be the filing of observations. The laws of some Member States foresee that written observations may be submitted in relation to trademark applications<sup>64</sup>. The person presenting the observation does not become a party to the proceedings and, usually, Offices do not reply to observations<sup>65</sup>. Observations are intended to provide an Office with any information that could lead to the refusal of the registration of an applied-for sign. This may be particularly helpful and effective where the issue raised is not known to the examiner, for example in situations in which the descriptiveness of an applied-for sign is known only to a specialized sector of the public<sup>66</sup>.

71. Where national laws allow for the submission of observations, the grounds upon which such observation can be based are usually not limited although some jurisdictions exclude claims based on prior third-party rights<sup>67</sup>. As the question whether a country name can be registered arises irrespective of any third-party rights, observations appear to be suitable means of protecting a country name from registration as a trademark or as part of a trademark in all national systems providing for a possible ground for refusing such signs and allowing observations.

72. Where national trademark laws permit observations, these may usually be submitted by anybody and no particular entitlement needs to be shown. Likewise, there is no specific time limit to respect and observations may be presented at any point prior to the registration of trademark<sup>68</sup>. Some Member States have explicitly confirmed that the fact that an applied-for sign consists of or contains a country name may be raised by way of observations, notably Ireland, Norway, and Slovakia. In Argentina, the Office will reject an application to register a sign containing a country's common name if that country submits an observation to this effect showing that its interests would be damaged by the registration<sup>69</sup>.

## INVALIDATION

73. Where a sign consisting of or containing a country name was registered as a trademark although the relevant national trademark law provides for possible grounds for refusing such registration, invalidation proceedings offer a final avenue to protect the country name in question. Through invalidation proceedings, the claimant seeks to remove an existing registration from the register. Amongst national trademark systems no uniform terminology exists and proceedings aimed at removing a granted registration may also be referred to as cancellation, nullification, or revocation.

74. More important than the respective terminology is the effect with which a trademark may be removed from the register. As a general rule, if a trademark is removed on grounds that already existed at the time of registration, upon removal the sign is treated as if it had never been registered. If a trademark is removed on grounds, the conditions of which are only satisfied at a certain point in time after registration, the sign will only be removed with effect from the moment in which the removal was requested. As far as country names are concerned, where the registration of a sign is removed on the basis that the sign consists of or contains a country name, this is a circumstance which in all likelihood will already have been present when the sign was registered. In such a case, the sign should have never been registered as a trademark, and as a consequence of the invalidation, it will be treated as if it had never been registered.

75. The Paris Convention mentions the possibility for Contracting Parties to cancel registrations in case of non-use of the trademark (Article 5 C.(1) and (2)) and stipulates the undertaking of the Contracting Parties to cancel registrations of signs conflicting with earlier well-known marks pursuant to Article 6*bis* or signs of States and certain international intergovernmental organizations under the scope of Article 6*ter*.

76. Invalidation procedures may take the form of administrative or judicial proceedings. According to Article 15(5) of the Agreement on Trade-related Aspects of Intellectual Property Rights, Members of the WTO shall afford a reasonable opportunity for petitions to cancel the registration of a trademark. Cancellation and invalidation proceedings were also a topic addressed by the SCT Questionnaire on Trademark Law and Practice<sup>70</sup>. About half of the 76 responses to the Questionnaire indicated that cancellation and invalidation proceedings were carried out at judicial level, although in some cases the initial procedures must happen before the Office<sup>71</sup>. It should also be noted that national trademark laws may provide the Office with a possibility to remove a trademark *ex officio* if it has been registered mistakenly<sup>72</sup>.

#### Grounds for Requesting Invalidation

77. In order to remove a registered trademark consisting of or containing a country name from the register, at least two conditions must be regularly present under the relevant national trademark law: firstly, there must be a ground for refusing the registration as a trademark of signs consisting of or containing a country name and secondly, a claim that the sign was registered in contravention of the former provision must be recognized as a valid ground for requesting the invalidation.

78. The replies to the Questionnaire Concerning Names of States<sup>73</sup> suggest that in the Member States the national trademark law of which contains a possible ground for refusing an applied-for sign consisting of or containing a country name, non-compliance with this provision would be a valid ground for requesting invalidation. Notably, 93.8 % of the replies received stated that if the name of a State is excluded from registration as a trademark in respect of goods, this ground can be raised by third parties in post-registration invalidation procedures. According to 92.6 % of the replies received, if the name of a State is excluded from registration as a trademark in respect of services, third parties may raise this ground in post-registration invalidation procedures.

79. This impression is corroborated by the submissions of the Delegations of SCT members received after the twenty-seventh session of the SCT. Several Delegations expressly confirmed that invalidation procedures may be based on the claim that a registered sign consisting of or containing a country name should not have been registered because of its descriptive character. More specifically, this is the case in Finland, Ireland, Japan, Norway, Slovakia and the United Kingdom<sup>74</sup>.

80. In the Czech Republic, Ireland, and Slovakia, it may be invoked in invalidation proceedings that a sign consisting of or containing a country name should not have been registered because it is devoid of any distinctive character. However, there is an important qualification to that rule: even if the sign was devoid of any distinctive character at the time of registration, it will not be invalidated if during the period between registration and invalidation request it has acquired distinctiveness through use<sup>75</sup>.

81. Several delegations specifically confirmed that invalidation procedures may be based on the claim that the registered sign consisting of or containing a country name should not have been registered because it is misleading, deceptive or false. These include Belize, the Czech Republic, Finland, Ireland, Japan, Norway, Slovakia and the United Kingdom<sup>76</sup>.

82. In the Czech Republic, invalidation procedures may also be based on the claim that a sign consisting of or containing a country name should have been refused registration because it is contrary to public policy. Finally, it has been confirmed by the Delegations of Chile, China, Costa Rica and Greece that invalidation may be requested where a sign has been registered in contravention of the *per se* protection of country names that exists under the respective national trademark laws<sup>77</sup>.

#### Entitlement to Request Invalidation

83. As is the case with opposition procedures, national trademark laws may require the claimant to demonstrate entitlement to request the invalidation of a mark. In the specific context of country names, the Delegations of Belize, China and Ireland have reported that invalidation may be requested by any person and under the trademark law of the Czech Republic, Norway, and Slovakia, invalidation proceedings may be instigated by third parties. In Costa Rica and Greece, the Government of the country concerned may request the invalidation<sup>78</sup>.

#### Time Limit for Requesting Invalidation

84. It should also be noted that national trademark laws may provide for specific time limits for requesting the invalidation of a trademark. Examples of countries providing for such time limits are Chile (five years from registration) and Costa Rica (four years from registration). In Costa Rica no time limit needs to be observed if the sign was registered in bad faith<sup>79</sup>.

#### TORT LAW AND UNFAIR COMPETITION

85. The use of a country name may also be prohibited under legal bases other than trademark law. One such basis may be found in tort laws or laws against unfair competition. Article 10*bis* of the Paris Convention binds the countries of the Paris Union to assure effective protection against unfair competition. The replies to the Questionnaire Concerning Names of States show that in 51.7 % of the countries in which the use of country names as a trademark is excluded this exclusion is based on the law against unfair competition. In 48.1 % of the countries it is based on general tort law or passing off<sup>80</sup>. In its reply, the Benelux Office for Intellectual Property confirms that the abuse of a country name may be prevented by tort law<sup>81</sup>.

86. Rules to prevent false indications of products are another area of law through which the use of a country name may be restricted. Article 10 of the Paris Convention provides that it may be a ground for seizure if goods bear false indications of their source. The vast majority of countries that replied to the Questionnaire Concerning Names of States (82.6 %) considered the use of country names as trademarks on goods and/or services as a potential case of application of the provision<sup>82</sup>. In Italy, the question of whether the applied-for signs directly or indirectly use false indications of the source of goods is taken into account when trademark applications are being examined<sup>83</sup>. In Australia, protection against misuse on labeling and presentation of goods is governed by a range of consumer protection provisions including the Competition and Consumer Act 2010<sup>84</sup>.

#### **IV. DIFFERENT APPROACHES AND POSSIBLE BEST PRACTICES DEVELOPED BY MEMBERS ON THE PROTECTION OF COUNTRY NAMES**

87. The review of WIPO Member States trademark laws and practices regarding examination, opposition or invalidation of signs consisting of or containing country names reveals that such signs may be excluded from registration and use as trademarks during all of those procedural phases. The present part concentrates on other measures described by members, which may be used alternatively or in addition to trademark law, to provide additional protection to country names or to ensure the permanence and validity of the rights granted by registration or use.

88. Among others, three particular sets of measures have been identified namely: “norms relating to the import and export of goods”, “norms and practices relating to country name identifiers” and “nation branding schemes”. Admittedly, these are not the only areas in which country names can be used; however, the processes and modalities of use appear to be of relevance for the subject of this study.

#### NORMS AND PRACTICES RELATING TO THE IMPORT AND EXPORT OF GOODS

89. International and regional trade rules provide that goods imported from or exported to a foreign market should bear labels that disclose the country of origin for customs controls purposes. Following this usually mandatory requirement, rules and practices to declare the country of origin on goods have been established and their numbers have progressively increased in national systems around the world. Under customs regulations, it has become compulsory to indicate the place of origin in the labeling of raw materials and agricultural products including seeds<sup>85</sup>. The declaration of the place of origin of services is an emerging although important issue. In addition to customs purposes, the country of origin label – or rather the false labeling – or indication of the country of origin has also consequences under industrial property law (see in particular Article 10 of the Paris Convention, providing for certain remedies in cases of direct or indirect use of a false indication of the source of goods).

90. One of the results of the Uruguay Round of multilateral trade negotiations was the Agreement on Rules of Origin, which entered into force on January 1, 1995<sup>86</sup>. According to this text, rules of origin are “those laws, regulations and administrative determinations of general application applied by any Member to determine the country of origin of goods...<sup>87</sup>” Rules of origin are the criterion used to define where a product was made and are mainly an instrument of commercial policy used to fulfill labeling and marking requirements.

91. At national level, several countries have applied mandatory measures to declare the country of origin of goods. For example, the Federal Register Department of Agriculture of the United States of America, has implemented a mandatory country of origin labeling (COOL)<sup>88</sup> which provides that, for all covered commodities, “any person engaged in the business of supplying a covered commodity to a retailer, whether directly or indirectly (i.e. growers, distributors, handlers, packers, and processors,) must inform subsequent purchaser about the country(s) of origin and method of production, as applicable, of the covered commodity.” This information may be provided either on the product itself, on the shipping container, or in a document that accompanies the product.

92. In the United Kingdom, Section 2 of the Trade Descriptions Act ,1968 (TDA)<sup>89</sup>, defines the term “trade description” as including amongst others, an indication, however given, of the “place of manufacture, production, processing or reconditioning” of the goods and prohibits in Section 16 importation of goods bearing a false indication of origin. In addition, the Consumer Protection from Unfair Trading Regulations, 2008, implement European Directive 2005/29/EC, with regard to the geographical or commercial origin of products. Regulation 9 provides that a trader is guilty of an offence if he engages in a commercial practice, which is a misleading action<sup>90</sup>.

93. The national law of at least one SCT member provides for the obligation to identify the origin of goods in export markets. Law No. 8063 of Costa Rica called Law to Identify Bananas from Costa Rica in International Markets provides that the obligation to identify these products at the point of export will be fulfilled by placing a seal “*Banano de Costa Rica*” on each banana cluster and on each box, regardless of its weight. The obligation would also be fulfilled, when, below the trademark under which the bananas are exported to international markets, the phrase is included in a legible and visible form<sup>91</sup> (see Figure No. 12).

94. Bilateral Agreements may also be the source of regulations concerning the protection of country names. According to the submission of the Czech Republic, for the purposes of trademark registration of country names, their variations, common names and abbreviations, the national Intellectual Property Office applies bilateral agreements between the Czech Republic (former Czechoslovak Socialist Republic) and Austria<sup>92</sup>, Portugal and Switzerland<sup>93</sup>.

## NORMS AND PRACTICES RELATING TO COUNTRY NAME IDENTIFIERS

95. According to the submission of the Delegation of Lithuania, country names may consist of different words and may sound differently according to the language used to refer to them. This presents difficulties in recognizing the respective country. For example, the country name Lithuania is called *Lietuva* in Lithuanian language, *Lituanie* in French, *Litwa* in Polish, etc.<sup>94</sup> The problem highlighted by the Delegation of Lithuania is one that potentially affects every country name and efforts have been made in different forums to reach a certain level of harmonization.

96. The United Nations (UN) Group of Experts on Geographical Names was set up by the UN Secretary-General in pursuance of the Economic and Social Council resolution 715 A (XXVII) of April 23, 1959. Its mandate was mainly to consider the technical problems of domestic standardization of geographical names, to prepare draft recommendations for the procedures (mainly linguistic) that might be followed in the standardization by individual countries of their own names and sponsoring working groups based on linguistic systems<sup>95</sup>.

97. The Standard Country or Area Codes and Geographical Regions List is established for statistical use under the UN Secretariat Statistics Division for those countries or areas for which statistical data is compiled by this UN Division and is generally referred to as "M49" Standard<sup>96</sup>. Each country is assigned a unique three-digit numerical code by the Statistics Division and a three-digit alphabetical code by the International Organization for Standardization (ISO).

98. The M49 system was first developed in 1969 to facilitate information transmission and the standardization of material for data processing. It has since evolved as an international standard coding system for other purposes outside statistical compiling and computing applications<sup>97</sup>. The names of countries or areas are the short names used in day-to-day UN operations and not necessarily the official name that is used in formal documents<sup>98</sup>. The last publication presents this list in the six UN official languages: Arabic, Chinese, English, French, Russian and Spanish<sup>99</sup>.

99. The International Organization for Standardization (ISO) has developed through global consensus international standards for products, services and good practices covering almost all aspects of technology and business<sup>100</sup>. ISO has developed an International Standard for Country Codes: ISO 3166 first published in 1974. New names and codes are added automatically when the UN publishes new names in either the Country Names Terminology Bulletin or in the Country and Region Codes for Statistical Use maintained by the UN Statistics Division<sup>101</sup>.

100. The ISO code 3166-1: 2006–Part 1 "Country codes" for the representation of names of countries is the most recent version of the standard. Within the standard, names of countries are represented by a two-letter code (alpha-2), which is recommended as the general purpose code; a three-letter code (alpha-3), which is more closely related to the country name, and a three-digit numeric code (developed and assigned by the UN Statistics Division), which can be useful when codes need to be understood in countries that do not use Latin scripts.

101. ISO 3166-1 is the most well known and widely used standard for coding country names and is used by many organizations, businesses and governments. For example all national postal organizations throughout the world exchange international mail in containers bearing their country code for identification. In machine-readable passports, the ISO 3166-1 codes are used



to determine the nationality of the user. In addition, internet domain name systems use the codes to define top-level domain names such as '.fr' for France, '.au' for Australia and '.br' for Brazil.

102. Growth of internet connections and influence of this new technological tool, as a means of information and commerce involved the introduction of standards to designate “domain names”<sup>102</sup>. The Internet Corporation for Assigned Names and Numbers (ICANN), created in 1998, is responsible for the coordination of the global Internet system of unique identifiers. Within ICANN, the Country Code Names Supporting Organization (ccNSO) is the body charged with developing policy for global issues such as the attribution of country code top-level domains (ccTLD).

103. According to the Applicant Guidebook of the ICANN new Generic Top Level Domain (gTLD) Program, applications for strings that are country or territory names will not be approved, as they are not available under the New gTLD Program in the current application Round. The footnote to Section 2.2.1.4.1 “Treatment of Country or Territory Names” states that: “Country or territory names are excluded from the process based on advice from the Governmental Advisory Committee in recent communiqués providing interpretation of Principle 2.2. of the GAC Principles regarding New gTLDs to indicate that strings which are a meaningful representation or abbreviation of a country or territory name should be handled through the forthcoming Country Code Policy Development Process (ccPDP) and other geographic strings could be allowed in the gTLD space if in agreement with the relevant government or public authority<sup>103</sup>”.

#### NATION BRANDING SCHEMES

104. At its twenty-seventh session (Geneva, September 18 to 21, 2012), the SCT considered document SCT/27/5 containing information on cases and case studies relevant to the protection of names of States and on nation branding schemes<sup>104</sup>. This document described the work concerning the protection of names of States that the SCT had undertaken thus far, it summarized information submitted by members in relation to the protection of names of States and on nation branding schemes, and provided an overview of the information on nation branding available at WIPO.

105. One of the studies mentioned in this document<sup>105</sup> referred to a nation brand as the particular image or reputation that a country has in the eyes of both people inside and outside of that country. Nation branding thus transcends the realm of IP and can be understood as the process of training countries and people to channel their behavior in a common direction that is positive and productive for the country’s reputation. Such active management of a nation’s brand was seen as an advantage in the competition for that nation’s share of the world’s consumers, capital, aid, tourists, students, investors and for the attention and respect of the media and of the global community<sup>106</sup>.

106. Often, the name of a country is an essential element of its nation branding campaign and frequently a prominent part of the nation brand itself (see Figure 13). When designing a nation brand experts usually dip into a country’s cultural heritage, communicated through symbols, emblems, icons and other popular associations. Collective identification with these symbols built up over time and shared among generations makes them a rich source of trademarks. However in more than one case the strongest association with a country, that says more about its cultural heritage is made through its name.

107. When designing the Peru nation brand, the country’s Promotion and Export Commission (PROMPERÚ) considered several alternatives of verbal and figurative elements, which would best communicate the nation’s history and values. PROMPERÚ’s experts believed that their nation brand should be credible, relevant and different. They discovered that the

greatest communication potential was found in the country's name: Perú. The name is short (four letters), has a good sound that it is consistent in different languages and the last letter has a distinctive accent<sup>107</sup>. These attributes seemed quite convincing and PROMPERÚ decided to accompany this verbal element with a design of the Nazca lines.

108. Equally, prior to the twenty-seventh session of the SCT, the Delegation of the Republic of Moldova reported the launch of a nation branding strategy that focused on the notion "quality driven". The submission also contained the visual sign adopted to represent this branding strategy: a three-dimensional cube used with the country name "Moldova". The sign has been registered as a national trademark for all 45 classes by the Minister for Economy. The Delegation of Uganda also reported on concrete activities in the area of nation branding. There has been a "Proudly Ugandan" campaign to support products that originate in Uganda, the "Gifted by Nature" campaign to brand the country more generally, and trade and investment initiatives aimed at promoting tourism, exports, and encourage foreign direct investment<sup>108</sup>.

109. The powerful messages communicated by country names, and other national icons and symbols also create the need for management, at the national and international level, to prevent inappropriate use that could denigrate or dilute their core meaning. This objective must be balanced against the public's access to and ownership of, national symbols, as well as the investment made by commercial interests to promote their offerings that use a distinctive representation of the country's national icons and symbols<sup>109</sup>.

## V. CONCLUSIONS

110. The review of available examination, opposition, observation and invalidation procedures has revealed that there are several opportunities at various stages before and after the registration of a trademark where the protection of country names may be invoked. If national laws provide for grounds that, irrespective of their technical construction, may prevent signs consisting of or containing a country name from being registered, these grounds are not only relevant when the Office assesses an application *ex officio*. Rather, third parties also appear to avail themselves of at least one of the outlined avenues for claiming, based on the respective ground that a sign consisting of or containing a country name should not be or should not have been registered.

111. In order to raise awareness of the already widely existing possibilities to refuse or invalidate the registration as a trademark of signs consisting of or containing a country name, the protection of country names could be addressed in trademark examination manuals. More specifically, it would appear useful to emphasize country names as a possible application of the general grounds for refusing signs that lack any distinctiveness, are descriptive, are contrary to public policy, or are misleading, deceptive, or false.

112. Regulations and measures to protect country names have been identified not only in relation to the registration of trademarks but more generally in the fields of trade and communications. Use of country names as a prominent part of nation branding identifiers highlights the need to preserve such names from misuse and promote their positive exploitation in country branding strategies to the benefit of the broader national collectivity.

[Annexes follow]

## ANNEX I

### BARBADOS AND JAMAICA REVISED PROPOSAL FOR A STUDY ON THE PROTECTION OF COUNTRY NAMES 20 SEPTEMBER 2012<sup>110</sup>

#### **Purpose**

The purpose of the work outlined below is to determine possible best practice for the protection of country names from registration as trademarks, or as elements of trademarks.

#### **Terms of Reference**

In furtherance of the work previously mandated by the SCT on country names, contained in documents SCT/24/6 and SCT/25/4, the Standing Committee on the law of Trademarks, Industrial Designs and Geographical Indications (SCT), at its 27<sup>th</sup> session, mandates the WIPO Secretariat to carry out the following activities.

The Secretariat, drawing on outside expertise as appropriate, shall conduct a study on the current legislative provisions and practices in national or regional legislations relating to the protection of country names in the field of registration of trademarks, as well as best practices related to the implementation of such provisions.

In addition to any existing or impending legislations, this study shall also draw on available jurisprudence, in the field of trademarks, involving the subject of country names, which may be available within the national and regional jurisdictions of WIPO member States.

The outcome of the study shall provide a focused presentation of the different trademarks law and where used in the alternative, non-trademark legislation and practices developed by Member States, including grounds for refusal and/or cancellation, which protect country names. The study should aim to provide a detailed overview of the different approaches used to protect country names and to highlight elements or features that may be considered possible best practice or elements which could enhance the protection of country names.

#### **Decision**

*The Standing Committee on the law of Trademarks, Industrial Designs and Geographical Indications (SCT), at its 27<sup>th</sup> session, requests the WIPO Secretariat to carry out the study on the protection of country names, and to submit the study to the 29<sup>th</sup> Session of the SCT.*

[Annex II follows]

## ANNEX II

The examples contained in this Annex were provided by SCT Members in their submissions.

### Figure 1

The sign consists exclusively of a country name

#### Norway

Application

**TOGO**

Class 30 (various foodstuffs)

The text is descriptive of the geographical origin for some of the goods (raw articles) and the design is not sufficiently distinctive

Refused as it only describes the country of origin of the goods.

Application

**T O G O**

Class 30 (various foodstuffs)

The text is descriptive of the geographical origin for some of the goods (raw articles) and the design is not sufficiently distinctive

Refused as it only describes the country of origin of the goods.

#### United States of America

**NEDERLAND** for beer – serial no. 75/853926

“The geographic dictionary published in the United States demonstrates that the primary significance of “NEDERLAND” in this country is geographic, i.e., that it is synonymous with “the Netherlands.” The other evidence submitted by the Examining Attorney establishes that the Netherlands is well known as a source of beer. From this evidence we can conclude that beer purchasers in this country would associate beer with “NEDERLAND.” In that applicant admits that its beer will be produced there, the third prong of the test for geographic descriptiveness is plainly satisfied.”

Refused on 8/29/03 under Section 2(e)(3) as primarily geographically deceptively misdescriptive.

Figure 2

The sign contains a country name

Belarus

 **BELARUS**

The official names of States can be registrable as unprotected elements of trademarks if there is consent of the respective competent authority.

Registration granted for combined mark N° 2723.

Russian Federation



Inclusion as a non-protectable element in a trademark of an official name of a State (Sweden), in which the applicant has its place of business.

Granted



Application No. 2005719567

Inclusion as a non-protectable element in a trademark of an official name of a State (Switzerland), in which the applicant has its place of business.

Granted

Turkey



Classes 9, 16, 35 and 41  
Refused

Romania

**INSTALATIE ALIMENTARE GAZE IRAN** (*installation d'alimentation gaz — Iran*),  
classes 35 and 42  
Refused

Figure 3

The sign is primarily geographically descriptive

United States of America

**BRITISH POST OFFICE:** “the evidence clearly establishes that BRITISH is the name of a place known generally to the public. It identifies a specifically defined geographic area, albeit involving more than one political entity. Further, the term BRITISH POST OFFICE retains the primarily geographic character of BRITISH because, in the context of the entire mark, it indicates the nation in which the involved POST OFFICE is located, and from which the goods and services would emanate. The applicant is a corporation of the United Kingdom (Great Britain) and is located there. Thus, applicant has a specific and clear legal connection to the place named in the mark. Thus, we presume a public association of the goods and services with the place from the fact that applicant’s goods and services would come from the geographical place named in the mark”.

Refused as primarily geographically descriptive.

Figure 4

The application was refused on both lack of distinctiveness and misleading character

Japan

Applied mark: **LEBANON**

Designated goods: Class 1 Fertilizers, Plant growth regulating preparations

Summary: When the applied mark is used for the designated goods, traders and consumers would merely recognize that the designated goods were produced or sold in the Republic of Lebanon, i.e., the applied mark is considered to be an indication of the place of origin of the designated goods. Therefore, the applied mark lacks distinctiveness. In addition, if the applied mark is used for goods produced in countries other than Lebanon, it is considered to be likely to cause confusion as to the origin/quality of the goods.

Application refused under Article 3 (1) (iii) and Article 4 (1) (xvi).



Figure 5

The sign is primarily geographically deceptively misdescriptive

United States of America

The following applications were refused

**SWISSGOLD**, applied for watches, was refused on the ground that the “SWISS” portion of the mark misdescribed the goods, including those goods not comprised wholly or partially of gold. Because the term “SWISS” is highly associated with watches and clocks, its misdescriptiveness was not considered eliminated by its combination with the word “GOLD”.

**MEXICAN WATER** for bottled drinking water – serial no. 74/716067 – application refused under Section 2(e)(3) because mark is “primarily geographically deceptively misdescriptive of the goods:

“In sum, we find that purchasers and prospective purchasers encountering the asserted mark MEXICAN WATER for bottled drinking water are likely to believe, mistakenly as it turns out, that the goods have their origin in Mexico.”

**KUBA KUBA** for cigars, tobacco and related products – serial no. 77/099522 – application refused under Section 2(e)(3) as primarily geographically deceptively misdescriptive:

“In the present case, the evidence is sufficient to establish a reasonable predicate that a substantial portion of relevant consumers would understand that KUBA KUBA refers to Cuba, and thus we may infer from the evidence showing that Cuba is famous for cigars, that a substantial portion of relevant consumers would be deceived.”

**LINEA ITALIA** for furniture, serial no. 75/ 450847 – application refused under Section 2(e)(3) as primarily geographically deceptively misdescriptive:

“It is true that “if there be no connection of the geographical meaning of the mark with the goods in the public mind, that is, if the mark is arbitrary when applied to the goods, registration should not be refused” on the ground that the mark is primarily geographically deceptively misdescriptive. In re Nantucket, Inc., supra, 213 USPQ at 893. However, as discussed above, the evidence of record in this case shows that consumers are likely to assume that a connection exists between the country of Italy and a line of furniture of the type identified in the application. The existence of that goods/place association belies applicant’s claim that its mark is arbitrary as applied to its goods.”

**AUSTRALIAN KINGDOM** for clothing for men, women and children – serial no. 75/410279 – application refused under Section 2(e)(3) as primarily geographically deceptively misdescriptive:

“In summary, the primary significance of the mark sought to be registered is geographic; a goods/place association would be made between the goods specified in the application and place named in the mark; and the goods will, in fact, not originate in the place named in the mark. Accordingly, the refusal to register under Section 2(e)(3) of the Lanham Act must be affirmed.”

Norway



The application was refused as deceptive because the applicant was not from Jamaica, but from Croatia.

Figure 6

The country name is not a prominent element of the mark

Australia



*Bavaria NV v Bayerischer Brauerbund eV [2009] FCA 428 (30 April 2009* was an appeal to the Federal Court of Australia from a decision of the Registrar. In this case the Judge was not satisfied that the trade mark connoted that the beer had characteristics attributable to a Bavarian origin, and further found, in part due to the inclusion of the word Holland, that the evidence was insufficient to establish that the Australian consumer would be confused or deceived by the trade mark to think that the goods had certain characteristics attributable to a Bavarian origin.

Application refused

Figure 7

The name of the country has a reputation for the goods or services applied for

United Kingdom

Under Section 3(3)(b) of the Trademarks Act, the following applications would be refused.

**PIAZZA D' ITALIA** for clothing, because the public would be deceived if the goods or the cloth were not made in Italy, which has a strong reputation for quality cloth and clothing.

**SWISSTEX** for watches, because Switzerland is famous for high quality watches.

Figure 8

Extension of the notion of State emblem

Costa Rica

Applications refused



 **educadores de colombia**



Chile



The trademark was refused on the grounds that it contained the name of the Republic of Korea in Korean language.

Figure 9

The trademark incorporates the name or abbreviated name of the country

Poland



Refusal of protection for the word-figurative trademark Geo Globe Polska Polska Z-359999 applied for the Polish company GEO GLOBE POLSKA sp. z o.o. sp. k.a.

Figure 10

The trademark consists of a country code

Poland



Figurative trademark ID as shown above was filed at the Patent Office to designate the goods and services classified in classes: 3, 8, 37 40 and 42. The Patent Office refused to register a trade mark ID on the basis of Article 8, section 6 of the Trade Marks Act. Justifying its decision, the Patent Office indicated that the abbreviation ID is the letter code of Indonesia. These codes are defined in international standard ISO 3166:1993, and in the Polish version of that standard which is ISO 3166 PN.

Figure 11

The trademark is likely to deceive or confuse (refused in opposition)

Australia



*Federation of the Swiss Watch Industry FH v K-Swiss Inc [2009] ATMO 78 (7 October 2009)* was an opposition to the registration of K-SWISS for goods which included time pieces. The decision maker in that case found it likely that a significant number of members of the buying public would be confused into thinking that the goods of the application, which included *horological and chronometric instruments and watches* were of Swiss origin.



Figure 12

Country of Origin Branding



Figure 13

Country name as part of a Nation Brand\*



[End of Annex II and of document]

\* Source : IP Tango, Tuesday, May 3, 2011, ¿Qué es la Marca País?, <http://iptango.blogspot.ch/search/label/Nation%20Brand>

<sup>1</sup> The information on the protection of country names in Belgium, Luxembourg, and Netherlands was submitted by the Benelux Office for Intellectual Property (BOIP) on behalf of those countries.

<sup>2</sup> The terms “absolute” and “relative” in respect of grounds for objection to registration are not universally used nor statutorily apposite, but they are nonetheless becoming more widespread as a legal shorthand for referring to issues concerning the innate characteristics of the mark, such as its dictionary or trade significance (absolute grounds) and issues of mark-against-mark conflicts with established third party rights (relative grounds).

<sup>3</sup> Submission by the Delegation of Belarus, available at <http://www.wipo.int/sct/en/comments/>.

<sup>4</sup> This is the case in Venezuela (Article 33(5) of the Industrial Property Law of September 2, 1955).

<sup>5</sup> Submission by the Delegation of Jamaica: Article 11((1)(c) of the Trademark Act of July 26, 1999; The same Paris Convention wording is used in the Trademarks Act of Barbados (Section 9(1)(b) of the Trademarks Act of December 21, 1981). See also the submission by the Delegation of Spain (Article 5 of the trademark Law N°17/2001 of December 7, 2001); by the Delegation of Norway: Trademark Act Section 14; by the Delegation of Germany: Trade Mark Act Section 8(2), n° 1, 2 and 4. Likewise, the legislation of Slovakia adopts the same bar (Act N° 506/2009 Coll on Trade Marks). For Europe, see Article 7(1)(c) of the Regulation (EC) No 207/2009 of 26 February 2009 on the Community Trademark. In the United Kingdom, the applicable provision is Section 3(1)(c) of the Trademark Act of July 21, 1994. The Law of Bulgaria equally provides for an exclusion concerning signs that indicate the geographic origin of the goods or services: Article 11(4) of the Law on Marks and Geographical Indications of September 1, 1999, amended in 2010.

<sup>6</sup> Submission by the Delegation of the United Kingdom and submission of the Delegation of Benelux. The Benelux Office considers in general that country names could be registered if combined with a distinctive element.

<sup>7</sup> This is the case for instance in the legislation of Morocco: Article 134(b) of the Law N° 17-97 Relating to the Protection of Industrial Property of March 16, 2000.

<sup>8</sup> Section 2 (15 U.S.C. § 1052) of the Trademark Law of July 5, 1946.

<sup>9</sup> *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) And Boots- und Segelzubehör Walter Huber (C-108/97), Franz Attenberger (C-109/97)*, Judgement of May 4, 1999. See also submissions by the Delegations of the United Kingdom and the Benelux Office for Intellectual Property (BOIP).

<sup>10</sup> *BGH [Bundesgerichtshof – Federal Court of Justice of Germany] - I ZB 10/01*, July 17, 2003 - *Lichtenstein*; *I ZB 53/05*, March, 13 2008 (Nos. 12, 18, 23) - *SPA II*; - *I ZB 107/08*, May 20, 2009 (No. 15) – *Vierlinden*.

<sup>11</sup> Submissions by the Delegations of Belize and Jamaica.

<sup>12</sup> Submission by the Delegation of Norway.

<sup>13</sup> *Oficina Española de Patentes y Marcas (OEPM)*, Guide on Examination of Registration Prohibitions (Part I, Absolute Prohibitions), which is available at

[http://www.oepm.es/es/signos\\_distintivos/marcas\\_nacionales/Guia\\_examen\\_prohibiciones\\_registro/](http://www.oepm.es/es/signos_distintivos/marcas_nacionales/Guia_examen_prohibiciones_registro/)

<sup>14</sup> Article 1 bis(1)(b) of the Legislative Decree No. 499 of October 8, 1999.

<sup>15</sup> Submission by the Delegation of Norway.

<sup>16</sup> EC Council Directive 89/104, Article 3(1)(g).

<sup>17</sup> Lanham Act, Section 2)(e)(3); 15 USC, Section 152)(e)(3).

<sup>18</sup> Submission by the Delegation of Mexico. The same type of registration would be refused in Canada according to Article 9 of the Trademarks Act, R.S.C., 1985, c. T-13, last amended on December 31, 2008. In Brazil, the corresponding provision is Article 124(IX) and (X) of the Industrial Property Law N°9.279 of May 14, 1996, and in Bulgaria, Article 11(7) of the Law on Marks and Geographical Indications of September 1, 1999, amended in 2010.

<sup>19</sup> See Article 7(1)(g) of the European Regulation (EC) No 207/2009 of February 26, 2009. See also submission by the Delegation of the United Kingdom. In addition, see also Article L711-2(b) and L711-3(c) of Intellectual Property Code of France, July 1, 1992 and Article 135(c) of the Law N° 17-97 Relating to the Protection of Industrial Property of Morocco, March 16, 2000.

<sup>20</sup> In their submissions, Poland and Ukraine referred to International Standard ISO 3166 and WIPO Standard ST.3.

<sup>21</sup> Submission by the Delegation of Australia.

<sup>22</sup> Submission by the Delegation of the United Kingdom.

<sup>23</sup> Submissions by the Delegations of the Czech Republic and Slovakia. See also Section 7(7) of the Trademark Act of December 11, 1998 of Singapore and Section 1210.08 (a) of the Manual of Trademark Procedures of the United States of America.

<sup>24</sup> Article 7(1)(ii) of the Trademark Law of November 28, 1949, as amended on May 21, 2009.

<sup>25</sup> Submission by the Delegation of Trinidad and Tobago: Section 13(a)(ii) of the Trademarks Act of 1955. see also submission by the Delegation of United States of America.

<sup>26</sup> Submission by the Delegation of the United States of America.

<sup>27</sup> Submission by the Delegation of Italy.

<sup>28</sup> In Section 3(2) the Trade Marks Act 2003 of Antigua and Barbuda, Article 10(2) of the Trademark Law of China, Article 4(4) of the Law N°2181-XII on Trademarks and Service Marks of February 5, 1993 of Belarus.

<sup>29</sup> Article 4(d) of the Law Concerning Marks, Trade names and Acts of Unfair Competition, January 8, 2002.

<sup>30</sup> Article 8(e) of the Trademark Act (Act N° XIX) of March 24, 2009.

<sup>31</sup> Article 32(d) of the Patents, Industrial Designs and Trademarks Registration Act of October 29, 2007.

<sup>32</sup> Section 36(2)(iv) of the Industrial Property Rights and their Enforcement for the Sultanate of Oman (Royal Decree No. 67/2008) of May 12, 2008.

<sup>33</sup> Submission by the Delegation of the Republic of Moldova.

<sup>34</sup> See the respective submissions at <http://www.wipo.int/sct/en/comments/>.

[Endnote continued from previous page]

- <sup>35</sup> Submissions by the Delegations of Colombia and Slovenia.
- <sup>36</sup> Submission by the Delegation of Lithuania.
- <sup>37</sup> Article 5(13) of the Law on Trademarks of December 11, 2009.
- <sup>38</sup> Article 142(1)(g) of the Law N° 9947 on Industrial Property, of July 7, 2008.
- <sup>39</sup> See paragraphs 4 and 5 of Annex I to document SCT/21/5.
- <sup>40</sup> Submission by the Delegation of Chile.
- <sup>41</sup> Submission by the Delegation of Costa Rica.
- <sup>42</sup> Submission by the Delegation of Australia.
- <sup>43</sup> Article 131(2) of the Industrial Property Law of June 30, 2000, as amended on January 23, 2004 and June 29, 2007.
- <sup>44</sup> Judgment of November 22, 2011 (case VI SA/Wa 1749/11).
- <sup>45</sup> Article 103(1)(h) and (i) of the Intellectual Property Act of November 12, 2003.
- <sup>46</sup> Article 73(1)(k) of the Law N°20-00 on Industrial Property of April 4, 2000.
- <sup>47</sup> Article 3(f) and (g) of the Trademark Law N°22.362 on Trademarks and Designations of December 26, 1980.
- <sup>48</sup> Article 4(1) of the Law N°. 17.011 Establishing Provisions on Trademarks of September 25, 1998.
- <sup>49</sup> See the Study on Misappropriation of Signs, WIPO document CDIP/9/INF/5 available at [http://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=216882](http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=216882)
- <sup>50</sup> See Trademark Opposition Procedures – Areas of Convergence, document WIPO/STrad/INF/4, Area of Convergence No. 1.
- <sup>51</sup> See Trademark Opposition Procedures – Key Learnings, document SCT/18/3, p. 2.
- <sup>52</sup> See Trademark Opposition Procedures – Areas of Convergence, document SCT/STrad/Inf/4. According to Article 15.5 of the Agreement on Trade-related Aspects of Intellectual Property Rights members of the WTO may afford an opportunity for the registration of a trademark to be opposed.
- <sup>53</sup> Whether a national system allows for oppositions before or after the registration for a trademark is a policy choice dictated by strategic factors. For an overview of the advantages and disadvantages of either variant see Trademark Opposition Procedures, document SCT/17/4, p. 14.
- <sup>54</sup> For a more detailed overview of the various possibilities of protecting signs consisting of or containing a country name see Section II above.
- <sup>55</sup> Summary of the Replies to the Questionnaire Concerning the Protection of Names of States Against Registration and Use as Trademark, document SCT/24/6, Annex II, p. 3.
- <sup>56</sup> See the respective submissions at <http://www.wipo.int/sct/en/comments/>.
- <sup>57</sup> *Idem*.
- <sup>58</sup> Submission by the Delegation of Argentina.
- <sup>59</sup> See Summary of Replies to the Questionnaire on Trademark Law and Practice (SCT/11/6), document WIPO/STrad/INF/1 Rev.1, replies to V.4.A (pp. 99-100), Trademark Opposition Procedures, document SCT/17/4, pp. 6-7, and Trademark Opposition Procedures – Key Learnings, document SCT/18/3, p. 3.
- <sup>60</sup> Submission by the Delegation of Greece.
- <sup>61</sup> See Trademark Opposition Procedures – Key Learnings, document SCT/18/3, pp. 7-8.
- <sup>62</sup> See the comparative table in Trademark Opposition Procedures – Key Learnings, document SCT/18/3, Annex.
- <sup>63</sup> See Trademark Opposition Procedures Areas of Convergence, document WIPO/STrad/INF/4, Area of Convergence No. 5.
- <sup>64</sup> See Trademark Opposition Procedures, document SCT/17/4, p. 13.
- <sup>65</sup> See Trademark Opposition Procedures – Areas of Convergence, document SCT/STrad/Inf/4, Annex p. 5.
- <sup>66</sup> See Trademark Opposition Procedures – Areas of Convergence, document SCT/STrad/Inf/4, Annex p. 5.
- <sup>67</sup> See Trademark Opposition Procedures – Areas of Convergence, document SCT/STrad/Inf/4, Annex p. 5.
- <sup>68</sup> See Trademark Opposition Procedures – Key Learnings, document SCT/18/3, pp. 4-5.
- <sup>69</sup> See the respective submissions at <http://www.wipo.int/sct/en/comments/>.
- <sup>70</sup> See Questionnaire on Trademark Law and Practice, document SCT/11/6, part X of the Annex.
- <sup>71</sup> Summary of Replies to the Questionnaire on Trademark Law and Practice (SCCT/11/6), document SCT/14/5 Rev., pp. 159-160.
- <sup>72</sup> Submissions by the Delegations of the Czech Republic and Slovakia.
- <sup>73</sup> See note 54 above.
- <sup>74</sup> See the respective submissions at <http://www.wipo.int/sct/en/comments/>.
- <sup>75</sup> Section 32(2) of Act No. 441/2003 on Trade Marks of the Czech Republic and section 52(1) of the Trade Marks Act 1996 of Ireland.
- <sup>76</sup> See the respective submissions at <http://www.wipo.int/sct/en/comments/>.
- <sup>77</sup> *Idem*.
- <sup>78</sup> *Idem*.
- <sup>79</sup> *Idem*.
- <sup>80</sup> Summary of the Replies to the Questionnaire Concerning the Protection of Names of States Against Registration and Use as Trademark, document SCT/24/6, Annex II, p. 5.
- <sup>81</sup> Submission by the Benelux Office for Intellectual Property, p. 1.
- <sup>82</sup> Summary of the Replies to the Questionnaire Concerning the Protection of Names of States Against Registration and Use as Trademark, document SCT/24/6, Annex II, pp. 40-41.

[Endnote continued on next page]

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<sup>83</sup> Submission by the Delegation of Italy.

<sup>84</sup> Submission by the Delegation of Australia, p. 1.

<sup>85</sup> Reference is made to the Geneva Convention relating to the Simplification of Customs Formalities (1923) under the League of Nations. See: "The American Journal of International Law", Vol. 19. No. 4 Oct. 1925 p. 146-166 at: <http://www.jstor.org/stable/2213197?seq=10> and the Kyoto Convention on International Merchandise Trade Statistics (1973-1974), the revision of which entered into force on February 3, 2006.

See <http://unstats.un.org/UNSD/trade/WS%20Bangkok06/Workshop%20materials/KYOTO%20Convention.pdf>

<sup>86</sup> F. Dehousse & P. Vincent : Les règles d'origine, les négociations de l'Uruguay Round et la Communauté Européenne, Revue Belge de Droit International 1993/2 – Editions Bruylant, Bruxelles  
<http://rbdi.bruylant.be/public/modele/rbdi/content/files/RBDI%201993/RBDI%201993-2/Etudes/RBDI%201993.2%20-%20pp.%20470%20%C3%A0%20499%20-%20Franklin%20Dehousse%20et%20Philippe%20Vincent.pdf>

<sup>87</sup> Article 1.1 of the WTO Agreement on Rules of Origin at: [http://www.wto.org/english/docs\\_e/legal\\_e/22-roo.doc](http://www.wto.org/english/docs_e/legal_e/22-roo.doc) and also: [http://www.wto.org/english/thewto\\_e/whatis\\_e/tif\\_e/agrm9\\_e.htm#origin](http://www.wto.org/english/thewto_e/whatis_e/tif_e/agrm9_e.htm#origin)

<sup>88</sup> Federal US Register Department of Agriculture 7 CFR Parts 60 and 65. The final rule to implement country of origin labeling (COOL) took effect on March 16, 2009. See at:

<http://www.ams.usda.gov/AMSV1.0/getfile?dDocName=STELPRDC5074925>

<sup>89</sup> See the Trade Descriptions Act, 1968 (TDA) at: <http://www.legislation.gov.uk/ukpga/1968/29>

<sup>90</sup> See the Consumer Protection from Unfair Trading Regulations, No. 1277, 2008 at:

[http://www.legislation.gov.uk/ukksi/2008/1277/pdfs/ukxi\\_20081277\\_en.pdf](http://www.legislation.gov.uk/ukksi/2008/1277/pdfs/ukxi_20081277_en.pdf)

<sup>91</sup> See: [http://www.sice.oas.org/int\\_prop/nat\\_leg/Costa/18063.asp](http://www.sice.oas.org/int_prop/nat_leg/Costa/18063.asp)

<sup>92</sup> Article 4 "Agreement between Austria and the Czechoslovak Socialist Republic on Indications of Source on Goods, Appellations of Origin of Products and other Marking Concerning the Origin of Agricultural and Industrial Products". See the submission by the Delegation of the Czech Republic.

<sup>93</sup> Article 3 of the "Agreement between Portugal and the Czechoslovak Socialist Republic on Indications of Source on Goods, Appellations of Origin of Products and other Geographical Denominations". *Idem* for the Agreement with Switzerland. See the submission by the Delegation of the Czech Republic.

<sup>94</sup> See submission by the Delegation of Lithuania.

<sup>95</sup> See [http://unstats.un.org/unsd/geoinfo/UNGEEN/docs/gegn\\_26\\_3.pdf](http://unstats.un.org/unsd/geoinfo/UNGEEN/docs/gegn_26_3.pdf)

<sup>96</sup> See <http://unstats.un.org/unsd/acsub/2006docs-8th/SA-2006-15-Grouping-UNSD.pdf>

<sup>97</sup> <http://unstats.un.org/unsd/methods/m49/m49alpha.htm>

<sup>98</sup> These names are based on the Terminology Bulletin No. 347/Rev.1: Country Names.

<sup>99</sup> See: <http://unstats.un.org/unsd/methods/m49/m49.htm> and See United Nations Publication, Standard Country or Area Codes for Statistical Use, Revision 4 (UN publication, Sales No. 98.XVII.9).

<sup>100</sup> See <http://www.iso.org/iso/home/about.htm>

<sup>101</sup> [http://www.iso.org/iso/country\\_codes.htm](http://www.iso.org/iso/country_codes.htm)

<sup>102</sup> "Domain name" means an alphanumeric string that corresponds to a numerical address on the Internet. See Article 1(v) of the WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, 1999, WIPO publication, No. 833 at: [http://www.wipo.int/about-ip/en/development\\_iplaw/pdf/pub833.pdf](http://www.wipo.int/about-ip/en/development_iplaw/pdf/pub833.pdf)

<sup>103</sup> ICANN Applicant Guidebook (version 2012-06-04) Module 2, Section 2.2.1.4.1. See at:

<http://newgtlds.icann.org/en/applicants/agb>

<sup>104</sup> WIPO document: SCT/27/5 on Information on cases and case Studies relevant to the protection of names of States and on Nation Branding Schemes. See at: [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_27/sct\\_27\\_5.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_27/sct_27_5.pdf)

<sup>105</sup> Simon Anholt: "Brand Jamaica feasibility Study", February 14, 2006 and commissioned by the former WIPO Intellectual Property and Economic Development Division (IPEDD).

<sup>106</sup> See paragraph 28 of document SCT/27/5, p. 5

<sup>107</sup> Presentation made by Ms. Carmen Julia García Torres, *Especialista en Gestión de Marca, Dirección de Promoción de Imagen País, PROMPERÚ, at IX Congreso Internacional sobre Marcas Turísticas, Cancún, Mexico, November, 2011.*

<sup>108</sup> See paragraphs 35 and 36 of document SCT/27/5.

<sup>109</sup> See "The trademark protection of country brands: Insights from New Zealand", by Magdalena Florek and Andrea Insch, Journal of Place Management and Development, Vol. I, No. 3, 2008, pp. 292 – 306.

<sup>110</sup> This document was the Annex to the Summary by the Chair of the twenty-seventh session of the SCT (September 18 to 21, 2012), contained in document SCT/27/10.