

THE PROTECTION OF COUNTRY NAMES

Franck Fougere

The Paris Convention for the Protection of Industrial Property does not prescribe specific rules for the protection of country names, allowing the parties to adopt varied approaches to the matter.

During the 1980s, proposals were made to review the Paris Convention in order to broaden the scope of Article 6^{ter} in order to include the protection of country names.

The last proposal, regarding a full review of Article 6^{ter} for the purpose of possible amendments, was made at a diplomatic conference held in February 1980.

At that conference, under the heading of “alternative B”, a proposal was placed on the table which recommended that the term “as well as the official names of the countries of the Union” should be included under the category of areas that are to be refused for validation as registered trademarks. Such attempt was unsuccessful.

TEXT OF THE ARTICLE 6^{TER} OF THE PARIS CONVENTION

[Marks: Prohibitions concerning State Emblems, Official Hallmarks, and Emblems of Intergovernmental Organizations]

“(1) (a) The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.

(b) The provisions of subparagraph (a), above, shall apply equally to armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations of which one or more countries of the Union are members, with the exception of armorial bearings, flags, other emblems, abbreviations, and names, that are already the subject of international agreements in force, intended to ensure their protection.

(c) No country of the Union shall be required to apply the provisions of subparagraph (b), above, to the prejudice of the owners of rights acquired in good faith before the entry into force, in that country, of this Convention. The countries of the Union shall not be required to apply the said provisions when the use or registration referred to in subparagraph (a), above, is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization.

(2) Prohibition of the use of official signs and hallmarks indicating control and warranty shall apply solely in cases where the marks in which they are incorporated are intended to be used on goods of the same or a similar kind.

(3) (a) For the application of these provisions, the countries of the Union agree to communicate reciprocally, through the intermediary of the International Bureau, the list of State emblems, and official signs and hallmarks indicating control and warranty, which they desire, or may hereafter desire, to place wholly or within certain limits under the protection of this Article, and all subsequent modifications of such list. Each country of the Union shall in due course make available to the public the lists so communicated. Nevertheless such communication is not obligatory in respect of flags of States.

(b) The provisions of subparagraph (b) of paragraph (1) of this Article shall apply only to such armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations as the latter have communicated to the countries of the Union through the intermediary of the International Bureau.

TEXT OF THE ARTICLE 6^{TER} OF THE PARIS CONVENTION

(4) Any country of the Union may, within a period of twelve months from the receipt of the notification, transmit its objections, if any, through the intermediary of the International Bureau, to the country or international intergovernmental organization concerned.

(5) In the case of State flags, the measures prescribed by paragraph (1), above, shall apply solely to marks registered after November 6, 1925.

(6) In the case of State emblems other than flags, and of official signs and hallmarks of the countries of the Union, and in the case of armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations, these provisions shall apply only to marks registered more than two months after receipt of the communication provided for in paragraph (3), above.

(7) In cases of bad faith, the countries shall have the right to cancel even those marks incorporating State emblems, signs, and hallmarks, which were registered before November 6, 1925.

(8) Nationals of any country who are authorized to make use of the State emblems, signs, and hallmarks, of their country may use them even if they are similar to those of another country.

(9) The countries of the Union undertake to prohibit the unauthorized use in trade of the State armorial bearings of the other countries of the Union, when the use is of such a nature as to be misleading as to the origin of the goods.

(10) The above provisions shall not prevent the countries from exercising the right given in paragraph (3) of Article 6quinquies, Section B, to refuse or to invalidate the registration of marks incorporating, without authorization, armorial bearings, flags, other State emblems, or official signs and hallmarks adopted by a country of the Union, as well as the distinctive signs of international intergovernmental organizations referred to in paragraph (1), above".

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

Twenty-Seventh Session Geneva, September 18 to 21, 2012

PROPOSAL BY THE DELEGATIONS OF BARBADOS AND JAMAICA

Following a proposal made by Jamaica at the twenty-first session of the SCT in June 2009, the SCT decided to prepare a draft questionnaire concerning the protection of official names of States against registration or use as trademarks. Following the twenty-third session of the SCT, the revised and final version of the questionnaire (SCT/24/2) was circulated to SCT Members. Returns to the questionnaire were compiled by the Secretariat and presented for consideration at the twenty-fourth session of the SCT (SCT/24/6). At that session, the SCT requested the Secretariat to prepare a draft reference document for consideration at its next session, based on the Committee's work in that area so far and offering a comprehensive overview of the law and practice of Member States with regard to the protection of country names against registration and use as trademarks. Based on the discussion on the reference document (SCT/25/4), the Chair concluded that document SCT/25/4 would be kept open for further comments to be provided by SCT Members through the SCT Electronic Forum. The Secretariat was requested to revise document SCT/25/4 based on the comments received and to present it to the twenty-sixth session of the SCT for consideration. The current proposal is, therefore, aimed at contributing to this process.

What is at stake?

The absence of a common approach to the treatment of country names by IP Offices has, therefore, contributed to some apparent **inconsistency in the registration and use of trademarks containing country names for goods and services.** There is concern that registrations may be considered or given where the use of a country name is **neither authorised nor has a direct relationship with the relevant country.** It is feared that this can potentially cause commercial loss, affect the image and reputation of the country and harm the interests of consumers.

Nation branding

amazing
THAILAND



Incredible!ndia

See: Standing Committee on the Law of Trademarks,
Industrial Designs and Geographical Indications
Twenty-Ninth Session Geneva, May 27 to 31, 2012
(published on April 2, 2013)

**[http://www.wipo.int/edocs/mdocs/sct/en/sct_29/
sct_29_5.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_29/sct_29_5.pdf)**

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.

V. CONCLUSIONS (cont'd)

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.

Need to consider this issue also outside the trademark field:

Ex: new GtIDs ex...

False advertising/misleading/confusing origin of products

Consumer protection and traceability

Geographical indications (Pisco “Peru” vs. Pisco “Chile”?)

Trade names

Labeling of products



ananda

INTELLECTUAL PROPERTY

CONTACT

Franck Fougere

Ananda Intellectual Property Limited

53/3, 4th Floor, A-4 | Goldenland Building | Soi Mahardlekluang 1

Rajdamri Road, Lumpini, Phatumwan | Bangkok 10330, Thailand

T: +66(0)2 684 1145 | F: +66(0)2 684 5990 | E: aip@ananda-ip.com