

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

Twenty-Seventh Session
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PROPOSAL BY THE DELEGATIONS OF BARBADOS AND JAMAICA

Document prepared by the Secretariat

In a communication dated May 16, 2012, the Delegations of Barbados and Jamaica transmitted to the International Bureau of the World Intellectual Property Organization (WIPO) the proposal contained in the Annex to this document.

[Annex follows]

THE PROTECTION OF COUNTRY NAMES

I. INTRODUCTION

1. The SCT will recall that 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. This would have effectively led to the expansion of Article 6*ter*(1)(a) to include the protection of country names.
2. Unfortunately, attempts to review Article 6*ter* of the Paris Convention at the Diplomatic Conference were unsuccessful due to the rejection of the proposal for the protection of country names by a number of States.
3. The rejection of such an inclusion in Article 6*ter*, however, took place against the backdrop of a very different political and socioeconomic reality. The widening and deepening of linkages amongst and between countries, as a result of globalization and trade liberalization has facilitated a dramatic increase in the trade in goods including those which carry unauthorized country names.
4. Following a proposal made by Jamaica at the twenty-first session of the SCT in June 2009, (see document SCT/21/6), the SCT decided to prepare a draft questionnaire concerning the protection of official names of States against registration or use as trademarks for consideration by the SCT. 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.

II. PROPOSAL

5. 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.
6. At the national and regional levels, a cursory analysis shows that IP legislations frequently foresee a number of situations wherein trademarks containing country names may be refused or the use of such trademarks may be prohibited. A non-exhaustive list of these include, *inter alia*,: (a) non distinctive trademarks; (b) descriptive trademarks; (c) misleading trademarks; (d) incorrect trademarks, etc.

7. Based on the previous work undertaken by the SCT since its twenty-first session, and due to the fact that the questionnaire and the reference document, as commented on during SCT/24 and SCT/25, provide only a somewhat limited explanation of the current legislative measures and practices in place, concerning the registration of trademarks containing country names, we are of the view that further work needs to be done to strengthen our understanding of the *status quo*.

8. The results obtained from the questionnaire suggest that the importance of the need to protect country names is recognised by many countries, and is addressed in domestic law and trademark practice. This supports the position that there *could* be convergence among Members on an agreed approach to the protection of country names in the trademark/IP system having regard to differences that now exist in the protection afforded to country names across Member States. 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.

9. The future work of the SCT concerning the protection of country names, should be approached in a more holistic manner and take into account the socioeconomic and legal implications, including in particular, the impact on a country's sustainable development. It is evident that where country names are not protected, the danger that the reputation associated with these names becoming diluted or denuded exists, resulting in the loss of their branding value. This has implications not only for the value of trademarks but also for a country's ability to effectively protect its Intellectual Property rights generally, and particularly in third countries. Countries which are heavily reliant on their name and "nation branding" as a critical trade and market development tool, and especially small developing countries whose firms lack marketing resources and consequently rely heavily on such nation branding, suffer greatly when use of their country names goes unchecked.

10. In light of the systemic importance of establishing effective and appropriate measures for protecting country names and addressing the concerns arising from the impact of trademarks containing country names, which are used without due regard for the concerns of the countries in which those names originate, we propose that a work programme be established within the SCT in order to advance this issue in a constructive and balanced way in three phases.

11. The first phase shall promote the exchange of more detailed information on the protection and use of country names consisting of: (1) an empirical review of the status of the use, abuse and protection of country names taking into account, where relevant, the outcome of the questionnaire on the use of country names, including national branding initiatives; and (2) a detailed study on the current legislative provisions and practices in national or regional legislations relating to the protection and legitimate use of country names, as well as the experiences and best practices in the implementation of such provisions.

12. The second phase would investigate what provisions and practices may better afford effective and appropriate protection of country names, taking into account the particular needs and concerns of developing countries, in particular the LDCs. It should address conditions for their implementation and evaluate how national capacities may affect the use of the legal measures at a country's disposal.

13. The third phase shall consider the elaboration of a guide or a manual and/or a joint recommendation on the protection of country names which would guide WIPO Member States in developing, through best endeavours, a common approach to the appropriate and effective protection of country names.

[End of Annex and of document]