

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

Thirty-Ninth Session
Geneva, April 23 to 26, 2018

PROPOSAL BY THE DELEGATIONS OF GEORGIA, ICELAND, INDONESIA,
JAMAICA, LIECHTENSTEIN, MALAYSIA, MEXICO, MONACO, PERU, SENEGAL,
SWITZERLAND AND THE UNITED ARAB EMIRATES

Document prepared by the Secretariat

In a communication dated March 6, 2018, the Delegations of Georgia, Iceland, Indonesia, Italy, Jamaica, Malaysia, Mexico, Monaco, Peru, Switzerland and the United Arab Emirates transmitted to the International Bureau of the World Intellectual Property Organization (WIPO) a proposal contained in document SCT/39/8 Rev.2.

In a communication dated April 13, 2018, the Delegation of Liechtenstein requested to be added to the list of co-sponsors of the proposal.

In a communication dated April 18, 2018, the Delegation of Senegal requested to be added to the list of co-sponsors of the proposal.

In a communication dated February 8, 2019, the Delegations of Georgia, Iceland, Indonesia, Jamaica, Liechtenstein, Malaysia, Mexico, Monaco, Peru, Senegal, Switzerland and the United Arab Emirates transmitted to the International Bureau of the World Intellectual Property Organization (WIPO), a revised version of the proposal, contained in the Annex to the present document.

[Annex follows]

THE DELEGATIONS OF GEORGIA, ICELAND, INDONESIA, JAMAICA, LIECHTENSTEIN,
MALAYSIA, MEXICO, MONACO, PERU, SENEGAL, SWITZERLAND
AND THE UNITED ARAB EMIRATES

REQUEST

the SCT to invite the WIPO General Assembly to adopt the following

PROPOSAL

CONCERNING THE PROTECTION OF COUNTRY NAMES AND GEOGRAPHICAL NAMES
OF NATIONAL SIGNIFICANCE

A. OBJECTIVES AND RATIONALE

Registering the name of a sovereign nation or geographical names of national significance by private owners results in a monopolisation of common assets by these private interests. Such misappropriation of national assets has negative consequences. For examples, firms from a country may be prevented from using the name of their own country to market their goods or services, or the reputation of a country may be damaged by the behaviour of the owner of such a registered sign.

Country names and geographical names of national significance shall be protected against their registration as distinctive signs, such as trademarks, if the sign consists exclusively of such names or if it would amount to a monopolisation of the name concerned.

B. PROTECTION OF COUNTRY NAMES AND GEOGRAPHICAL NAMES OF NATIONAL SIGNIFICANCE

The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) has been working on the protection of country names in the context of trademarks since its twenty-first session.

Within this framework, the SCT members have shared information regarding national law and legal practices. On the basis of these contributions, the Secretariat drafted a reference document in November 2015¹. According to this document, country names are excluded from registration as word marks in the majority of countries, as they are deemed to be descriptive and do not distinguish the products and services of one company from those of another company.

This indirect protection of country names against monopolisation by an individual mark is highly relative in its effectiveness. Iceland, for example, has learned this lesson to its detriment, sharing its experience in a note issued at the SCT's thirty-seventh session².

Furthermore, indirect protection does not prevent improper use of a country name deemed to be unknown or generic in the country where the application for the trademark registration has been made.

C. PROPOSED SOLUTION: PROTECTING NAMES ON EXISTING LISTS

In the early 2000s, at the request of several member states, WIPO launched a consultation process on internet domain names, in particular, the issue of registration of domain names that infringe upon indications of source and geographical names. Within this framework, the SCT held two special sessions in December 2001 and May 2002 and adopted the *Second Special Sessions Report* ("Report", SCT/S2/8) that recommends some form of protection for country names against registration or use by persons unconnected with the constitutional authorities of the country in question³. The Report also gave concrete guidance and established principles for the recommended protection⁴. A large majority of delegations approved these recommendations⁵. This strong support has also been noted at the WIPO General Assembly during its autumn session in 2002⁶.

The same criteria to define a country name applies in the field of trademarks:

- (i) The names of countries protected are those listed on the list established by the United Nations Group of Experts on Geographical Names (UNGEGN)⁷, as well as on the standard ISO 3166-1⁸ (alpha 2 codes and alpha 3 codes).
- (ii) Both the long or formal names and the short names of countries are protected.
- (iii) Protection covers the exact names and, in order to include misleading variations, the former name of a country, its common name, the translation and transliteration of that name, as well as the name in a short or adjectival form.
- (iv) Each country name should be protected in the official language(s) of the country concerned and in the six official languages of the United Nations.

As regards the geographical names of national significance, the present proposal also protects them based mainly on existing lists, namely:

- (i) The ISO 3166-2 list concerning regions.
- (ii) The list of sites forming part of the cultural and natural heritage ("World Heritage List") which fall under the scope of the Convention concerning the Protection of the World Cultural and Natural Heritage⁹.
- (iii) The names of capitals as listed in the UNGEGN Geographical Names Database shall also be protected as names of national significance.

In order to give each state the possibility to obtain protection for geographical names that are not capitals, nor listed on the ISO 3166-2 list or on the World Heritage List, the present proposition suggests that each country can, within a timeframe of 18 months, notify to the WIPO Secretariat a list of geographical names with national significance according to its relevant public policy or applicable national law. This list will be published on the WIPO website.

D. RELATIONSHIP TO OTHER ONGOING WORK ON COUNTRY NAMES IN THE SCT

The present proposal serves a specific purpose, namely, as mentioned in Section A, the protection of country names and geographical names against monopolisation. It thus complements the revised proposal by the Delegation of Jamaica ("Jamaican Proposal"; SCT/32/2).

The Jamaican Proposal, tabled at the SCT's thirty-second session, seeks to define a legal framework for the use and registration of trademarks, business identifiers and domain names which consist of or contain a country name.

The Jamaican Proposal does not directly seek to prevent the monopolisation of a country name, but primarily wants to prevent the use of country names in a misleading manner, in other words, in connection with products and services that do not originate from the country concerned.

* * *

On the basis of the above

Acknowledging the importance of country names and geographical names of national significance and the potential of misappropriation of these names by private entities.

Noting that the United Nations Group of Experts on Geographical Names (UNGEGN) establishes regularly a list of formal and short country names, that the alpha 2 codes and alpha 3 country codes are listed in the standard ISO 3166-1 and that the names of regions such as states in federal countries, provinces and departments are listed in the standard ISO 3166-2.

The WIPO General Assembly recommends:

- I. Country names and geographical names of national significance shall be protected against their registration as distinctive signs, such as trademarks, if the sign consists exclusively of such a name or if it would amount to a monopolisation of the concerned name.
The conditions for the registration of country names and geographical names of national significance as distinctive signs, such as trademarks, shall be determined in each country according to its national legislation.
- II. The above principle shall apply to:
 1. The formal and short country names in all language versions contained in the most recent United Nations Group of Experts on Geographical Names (UNGEGN) List of Country Names approved by the United Nations Conference on the Standardization of Geographical Names.
 2. Country names listed under II.1 in translations and transliterations into the national language(s) of the country where a distinctive sign is registered, and for top-level domains, into national languages of all countries.
 3. Country names listed under II.1 in adjectival form in the six official languages of the United Nations and the concerned country's national language(s).
 4. The former name of a country names listed under II.1. in the six official languages of the United Nations and the concerned country's national language(s).
 5. The alpha 2 codes and alpha 3 codes as listed in the standard ISO 3166-1.
 6. The geographical names of national significance, *inter alia*:
 - the name of capitals cities of the countries listed under II. 1, in all language versions contained in the United Nations Group of Experts on Geographical Names (UNGEGN) Geographical Names Database;
 - the names of regions such as states in federal countries, provinces and departments as listed in the standard ISO 3166-2;
 - the names of the UNESCO regions listed as World Heritage Sites; other geographical names with national significance according to the concerned country's relevant public policy or applicable national law. WIPO member states may notify a list of such names to the WIPO Secretariat within a deadline of

18 months following the adoption of this proposal by the WIPO General Assembly.
The list will be published by the WIPO:

[End of Annex and of document]

¹ WIPO/STrad/INF/7.

² SCT/37/6.

³ Document SCT/S2/8, Para 210.

⁴ Document SCT/S2/8. The Report recommended the following protection for Country Name domain names: "(1) A list of Country Names should be made, using both the United Nations Terminology Bulletin 347/Rev. 1 and, as necessary, ISO Standard 3166, including both formal names and the short names of countries and any additional names by which countries are commonly known; (2) protection should cover both the exact names and misleading variations; (3) the Country Names should be protected in the official language (s) of the country concerned and in the six official languages of the United Nations; (4) the protection should be extended to all top-level domains, both gTLDs and ccTLDs; and (5) the protection should be operative against the registration or use of a domain name which is identical or misleadingly similar to a country name, where the domain name holder has no right or legitimate interest in the name and the domain name is of a nature that is likely to mislead users into believing that there is an association between the domain name holder and the constitutional authorities of the country in question." Para 210.

⁵ Document SCT/S2/8: "The Chair concluded that most delegations favored some form of protection for country names against registration or use by persons unconnected with the constitutional authorities of the country in question." Para 210.

⁶ Document WO/GA/28/7, para. 80.

⁷ In 2002, the SCT recommended to base the listing of countries or areas in the six official languages of the United Nations on the Terminology Bulletin No. 347/Rev.1, prepared by the Department of General Assembly Affairs and Conference Services of the United Nations Secretariat (available here: http://www.un.org/en/ga/search/view_doc.asp?symbol=ST/CS/SER.F/347/Rev.1). This document is no more accurate. This proposition is based on the most recent lists of country names established by the UNGEGN Working Group on Country Names as approved at the UN Conference on the Standardization of Geographical Names. This conference takes place every 5 years. The most recent list of country names has been approved at the Eleventh Conference in August 2017. It is available as E/CONF.105/13 here: https://unstats.un.org/unsd/geoinfo/UNGEgn/docs/11th-uncsgn-docs/E_Conf.105_13_CRP.13_15_UNGEgn%20WG%20Country%20Names%20Document.pdf.

⁸ ISO 3166 is the International Standard for country codes and codes for their subdivisions established by the International Organization for Standardization (available at <https://www.iso.org/iso-3166-country-codes.html>).

⁹ Convention concerning the Protection of the World Cultural and Natural Heritage adopted on 23 November, 1972, under the auspices of the United Nations Educational, Scientific and Cultural Organization (UNESCO). The WIPO considered this list as a useful instrument in this regard in its Final Report of the Second WIPO Internet Name Process. The World Heritage List as well as the ISO list have served as the basis for the allocation of rules in the AGB2012.