



IGE | IPI

Eidgenössisches Institut für Geistiges Eigentum
Institut Fédéral de la Propriété Intellectuelle
Istituto Federale della Proprietà Intellettuale
Swiss Federal Institute of Intellectual Property

Protection of Country Names: National and International Perspectives

MIPLC Lecture Series

Munich, 23 May 2019

Felix Addor

Professor, Faculty of Law, University of Bern

Deputy Director General and General Counsel

Swiss Federal Institute of Intellectual Property

www.ipi.ch | felix.addor@ipi.ch

Economic value of country names





'Swissness' Worldwide study, htp St. Gallen, McCann Erickson and University of St. Gallen, 2008, fig.18

Swiss Made premium: Example of a steel watch

Japan	China	India	Italy	Austria	USA	Germany
+ 112 %	+ 69 %	+ 65 %	+ 55 %	+ 54 %	+ 53 %	+ 50 %

France	Switzerland	Russia	Spain	Brasil	UK	South Korea
+ 47 %	+ 42 %	+ 28 %	+ 22 %	+ 27 %	+ 24 %	+ 8 %

Reasons to protect country names

- Free riders **take advantage of the good reputation** of a country by using this country name on products from other countries
- Consumers risk being **misled** and **disappointed**
- → **Loss of reputation**, which may lead to a dilution in the value of the national brand
- Registration of a country name ‘as such’ as a trademark results in an unjustified **monopolization** of a country name by a private party

A practical case (pending): Iceland vs. Iceland (country vs. grocer)



Different rules for different objects and objectives

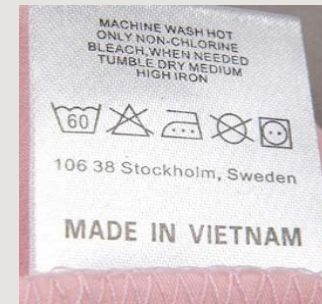
Indications of source

Country names

“Made in France”

Appellations of origin and geographical indications

Rules of origin



Protecting country names at the national level

Adequate rules should:

1. Define the conditions for using a country name and sign
2. Clarify the conditions for their registration as a trademark when combined with a distinctive sign
3. Prohibit the monopolization (= registration as a trademark) of the country name or sign as such



Example

Conditions for using “Swiss Made” or on industrial products

1. At least **60% of the product's manufacturing costs** must be incurred in Switzerland
2. The **activity that gives the product its essential characteristics** must take place in Switzerland



Conditions for using “Swiss Made” or on services

1. A company must have its (registered) **seat** in Switzerland
2. In addition, the company has to have at least one of its **headquarters**, from which the company is run, in Switzerland



SwissLife

CREDIT SUISSE 



Other examples at national level



Protecting country names at the international level

Art. 6^{ter} Paris Convention: requires member states to prohibit on their territory the use and the registration of trademarks of flags and coats of arms unless authorized by the government concerned

Art. 10^{bis} Paris Convention: protects against unfair competition. It requires member states to prohibit on their territory the use of misleading allegations in the course of trade

Advantage of the Paris Convention: Enforcement through the WTO TRIPS mechanism possible

Additional measures at the international level:

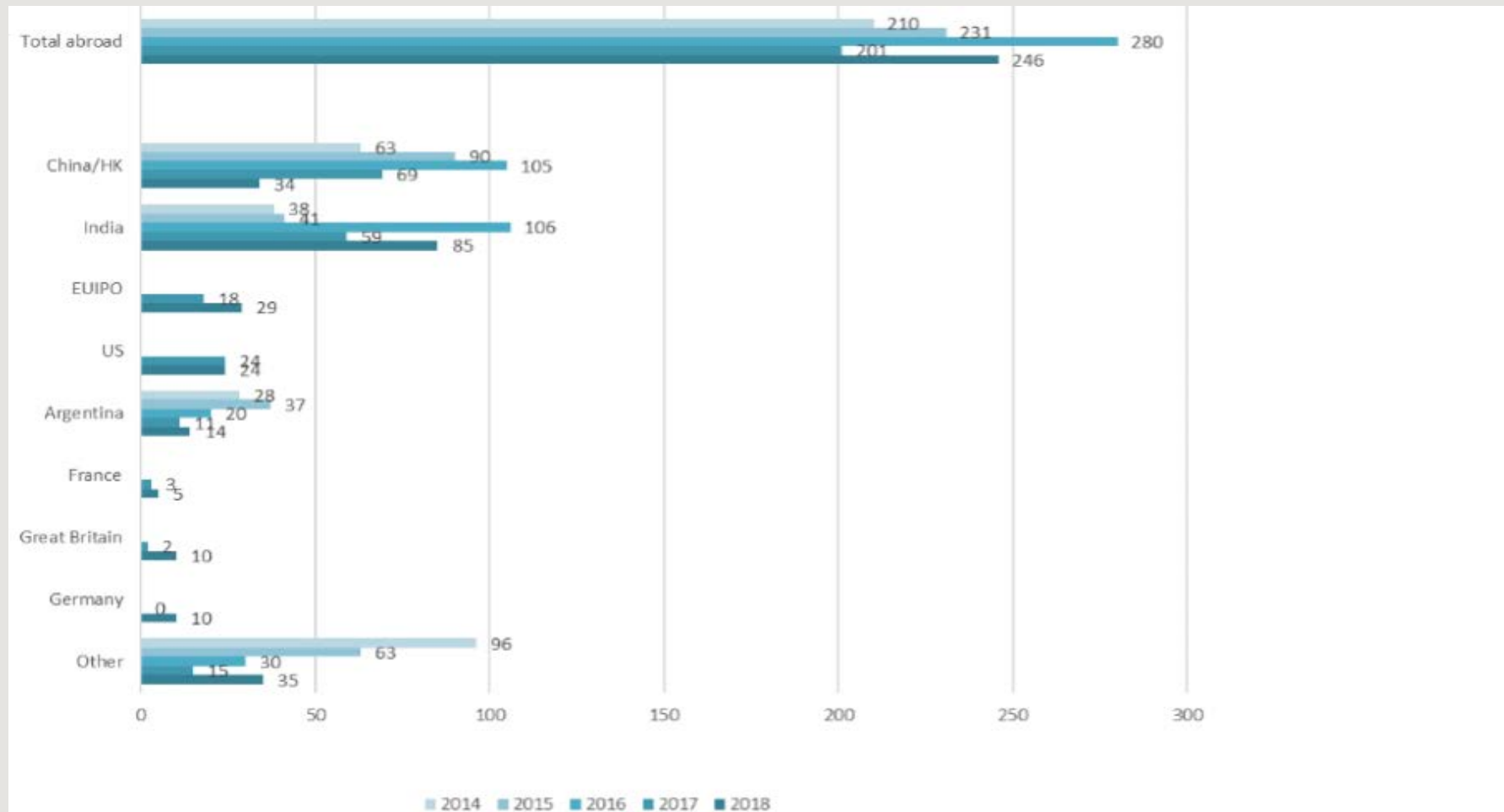
National legislation as a basis for negotiating with third countries

1. Bilateral treaties to protect country names & GIs

2. Free trade agreements with provisions for protecting country names & GIs

3. Effective cooperation between the authorities

4. Opposition against misleading trademarks



* Status as of 31.12.2018

5. Authorization to use a state flag or emblem


WIPO
 WORLD INTELLECTUAL PROPERTY ORGANIZATION

Article 6ter

Article 6ter of the Paris Convention protects the flags and emblems of states that are party to the Paris Convention against unauthorized registration and use as trademarks.



(PHOTO: WIPOMARTINEZ)

Eidgenössisches Institut für Geistiges Eigentum
 Institut Fédéral de la Propriété Intellectuelle
 Istituto Federale della Proprietà Intellettuale
 Swiss Federal Institute of Intellectual Property

Staufferstrasse 65/69a | CH-3003 Bern
 T +41 31 377 77 77
 F +41 31 377 77 78
 info@igi.ch | www.igi.ch

To whom it may concern
Mexican Institute of Industrial Property
 Periférico Sur No. 3106
 Piso 9, Col. Jardines del Pedregal
 Mexico, D.F., C.P. 01900

A U T H O R I Z A T I O N

in accordance with Art. 6^{ter} paragraph (1) subparagraph (a) of the Paris Convention

Competence of the Swiss Federal Institute of Intellectual Property

The Swiss Federal Institute of Intellectual Property (hereinafter, the Institute) is the competent authority in Switzerland in matters of intellectual property law. The Institute is an independent agency established by public law (Art. 1 of the Federal Act of 24 March 1995 on the Statute and Tasks of the Swiss Federal Institute of Intellectual Property [IIPA; *Loi fédérale du 24 mars 1995 sur le statut et les tâches de l'Institut Fédéral de la Propriété Intellectuelle*, RS 172.010.31]). As a government agency constituted as a unit of Switzerland's decentralised federal administration (cf. Federal Act of 21 March 1997 on the Organisation of the Government and the Administration [GAOA; *Loi du 21 mars 1997 sur l'organisation du gouvernement et de l'administration*, RS 172.010]), the Institute is attached to the Federal Department of Justice and Police (cf. Appendix 1 of the Ordinance of 25 November 1998 on the Organisation of the Government and the Federal Administration [GAOO; *Ordonnance du 25 novembre 1998 sur l'organisation du gouvernement et de l'administration*, RS 172.010.1]).

The tasks and powers of the Institute are regulated by the IIPA. Accordingly, in application of Art. 2 let. b IIPA, the Institute is responsible for implementing,

- in keeping with the applicable special legislation, legislative acts governing matters of intellectual property, including, in particular, the Federal Act on the Protection of the Swiss Coat of Arms and Other Public Signs (CAPA; *Loi sur la protection des armoiries de la Suisse et des autres signes publics*, RS 232.21), and
- international treaties concerning matters of intellectual property (Art. 2 let. b IIPA), including, in particular, the Paris Convention for the Protection of Industrial Property (Paris Convention).

In consideration of the foregoing, the Institute is the competent federal authority in Switzerland for the granting of authorisation, in accordance with Art. 6^{ter} paragraph (1) subparagraph (a) of the Paris Convention, permitting registration in foreign countries of trade marks containing a public sign of Switzerland that is subject to protection under the CAPA (cf. Art. 2 let. b IIPA and Art. 21 para. 2 CAPA, mutatis mutandis).

6. Seizure of counterfeit goods



Towards international protection of country names

Goal: To integrate a protection standard specific to country names into the Paris Convention

Method: proposals and discussions within the framework of the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT)

Protection against misleading use of country names

Jamaican proposal (SCT 32/2): intends to prohibit the registration of a TM containing a country name if the TM is misleading

Example: TM application in Chile



Protection against monopolization of country names

Proposals (SCT 39/8 Rev. 3): intends to prohibit the TM registration of country names as single elements or registration that results in monopolization

Iceland v Iceland: country takes legal action against grocer

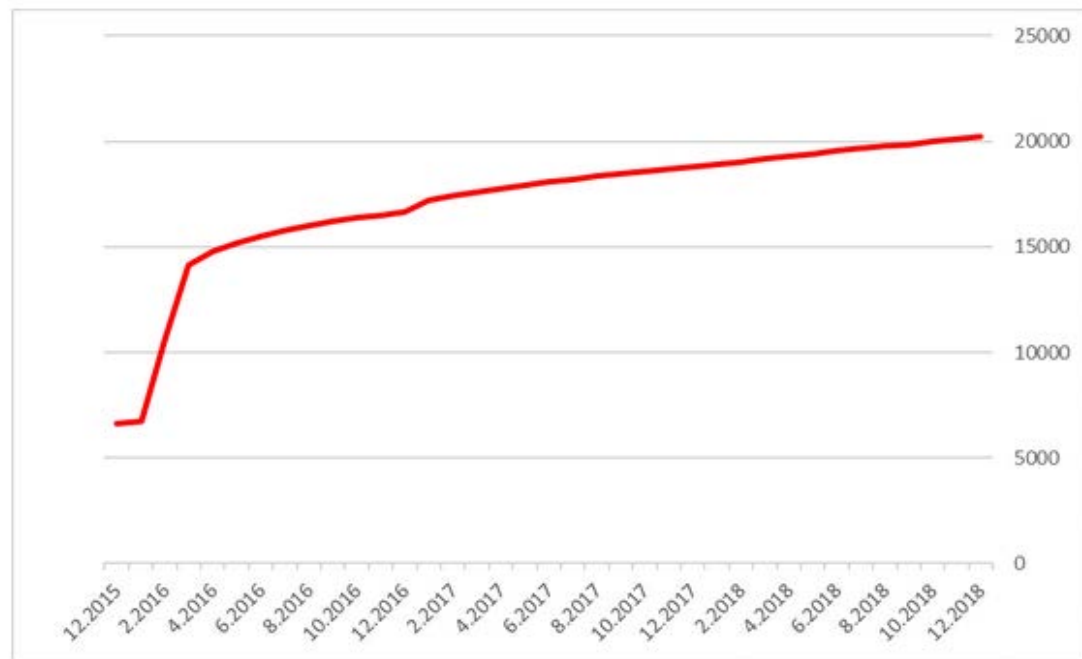
Reykjavik says companies held back as UK frozen-food chain has 'Iceland' trademark



Protection against monopolization of country names

Joint Proposals (SCT 41/6): intends to prohibit the registration of country names as a generic Top Level Domain (gTLD) and other GIs of national significance as a single element

Evolution of the total number of domain names allocated



Protection against monopolization of country names

Joint Proposals (SCT 41/6): intends to prohibit the registration of country names as a generic Top Level Domain (gTLD) and other GIs of national significance as a single element



.swiss Registry Agreement

16 Oct 2014

On 16 Oct 2014, [ICANN](#) and Swiss Confederation entered into a Registry Agreement under which Swiss Confederation operates the .swiss top-level domain. The agreement may be viewed by following the links below:

We need to maintain the positive image and value embedded in a national brand

For further information on ‘Swissness’:

www.ige.ch → Law and Policy → National IP Law → Indications of Source → Swissness

For further information on the SCT:

www.ige.ch → Law and Policy → International IP Law → IP Organizations → TMs

Contact : felix.addor@ipi.ch