

State names as trademarks

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The issue of registration of state names as trademarks has recently been the subject of a Paris Court of Appeal ruling (22 September 2017).

The US company France.com Inc. was the proprietor of the domain name “france.com” registered since 1994. The Dutch company Traveland Resorts registered in its own name a number of French and EU trademarks (word and figurative) “France.com” in 2009 and 2010. The US company brought proceedings against the Dutch company before the French courts in 2014. Subsequently, the Dutch company transferred the trademarks to the US company.

The French State and the GIE Atout France (the French national tourism organization) intervened in the court proceedings between the two companies asking initially that all the marks and the domain name be transferred to the French State and subsequently that the marks be annulled or surrendered.

The Paris Court of First Instance found the intervention admissible and ruled that all marks and the domain name be transferred to the French State. Upon appeal

(by the US company), the Paris Court of Appeal for the most part confirmed the first instance ruling, namely to the extent that the French marks were annulled and the domain name had to be transferred to the French State. As regards the EU trademarks, the Court of Appeal held that their validity was for the EUIPO to judge.

The arguments of the appellant included a) that art. 6^{ter} of the Paris Convention on the protection of state emblems, flags and other insignia was not applicable, and b) that the French State did not own any prior rights, the term “France” being a mere geographic indication, different to the official name(s) of the French State as per the French Constitution.

The French State, in turn, relied on bad faith, on deceptiveness of the marks or their being against public order, and a monopoly to “France.com” for a US tour operator being against public interest.

The annulment of the French marks and transfer of the domain name were based on bad faith and public order and, in addition, it was found that the French State had prior rights to the denomination “France”. The word “France” constituted for the French State an “element of identity” similar to those of natural persons, as it indicated the national territory in its economic, geographical, historical, political and cultural identity. The suffix “.com” did not differentiate the signs at issue adequately. Therefore, the public would identify the goods and services under the marks as emanating from the French State or under the auspices of the French State.

The more general questions addressed in the ongoing WIPO study were not the center of attention in the Court proceedings.

WIPO has been conducting a study across various countries and territories of the Paris Convention regarding the issue of state names as trademarks. The landscape is quite diverse: some countries have in their trademark legislation a reference to article 6 *ter* of the Paris Convention listing the symbols, flags etc. that are excluded from registration. Others have expressly prohibited the registration of state names as trademarks, again others have provided for categories of state names trademarks that are registrable (e.g. only official names) and those that are not (see WIPO/Strad/INF/7, November 23, 2015). Among the few countries that have an express legislative prohibition (since 2012) is Greece.

It is worth noting that the word mark “France.com” no 8791808 was rejected by

EUIPO as non-distinctive and descriptive and a figurative mark “France.com” (application no. 13158597) has been refused based on an opposition brought by the French State; the case is pending before the General Court (T-71/17).

The General Court (T197/13) previously refused trademark protection to the Principality of Monaco for the word mark “MONACO” on absolute grounds stating that the “need to be freely used by all” principle applies to states in the same way as to individuals (par. 43) and affirming the BoA finding that “a public or government body [had] no special entitlement to a trade mark” (par. 33).

This is a complex issue that demands a fair balance of the different legal interests. It remains to be seen whether the traditional absolute and relative grounds shall be able to provide adequate solutions.