

Case law and new legislation -Iceland-

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Brynhildur Pálmarsdóttir, Legal expert.

Ministry of Industries and Innovation.

Supreme Court decision in Merck case

- *Dispute over the IPO's refusal to grant an SPC with negative duration.*
- *Supreme Court of Iceland referred a question to the EFTA Court on SPCs with a negative duration.*
 - *In particular, pointing to the fact that Regulations (EC) No. 1901/2006 and 469/2009, which provide for a six-month extension of certain SPCs, had not been incorporated into the EEA Agreement.*
- *EFTA Court ruling from December 2017.*
 - *The grant of an SPC of negative duration is consequently permissible under the SPC Regulation and a competent authority cannot reject an application merely because an SPC's duration is not positive.*

New legislation and legislation on the horizon

- *EU regulations No. 1901/2006 and 469/2009 (pediatric extensions) incorporated into Icelandic law with a revision to the Patent Act.*
 - *Legislation passed by Parliament in May 2018 (No. 40/2018).*
- *Implementation of new EU trademark directive and trade secrets directive in preparation.*
 - *Expected to enter Parliament in late 2019.*

Protection of country names

- *Active trademark watch of ICELAND on behalf of government since 2004.*
- *Increase in watch notices and opposition cases during the last 8 years.*
- *Icelandic businesses experience difficulties obtaining registration and/or registrations are opposed when they include a reference to origin.*

BLUE LAGOON
ICELAND

ICELANDIC
IBÉRICA SA

INSPIRED
BY
ICELAND

Iceland, the supermarket

- *Iceland Foods Limited (IFL) has been using the trademark ICELAND since 1970.*
- *2003: Application for the word mark ICELAND filed in the EU by IFL.*
 - *5 oppositions filed by Icelandic businesses.*
- *2014: Full registration of the word mark ICELAND in 8 classes, including classes 29-32 and class 35.*
- *2016: Invalidity claim filed by the Icelandic government, Promote Iceland and Business Iceland against the word mark.*

Initial steps at WIPO

- *Submission of a note by the delegation of Iceland at the 37th session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications in 2017.*
- *Country names seem not to be offered sufficient protection in the trademark system today.*
- *The protection is indirect and can be inconsistent and unpredictable.*
- *An issue of public interest that country names remain available.*

Proposal on protection of country names

- *Country names and geographical names of national significance should be protected against their delegation as top-level domain names in the DNS and their registration as distinctive signs, such as trademarks, if the sign consists exclusively of such names or if it would amount to a monopolization of the name concerned.*
 - *Reiteration of a principle.*
 - *Implementation to be determined in national legislation.*
 - *Joint proposal by Georgia, Iceland, Indonesia, Italy, Jamaica, Liechtenstein, Malaysia, Mexico, Monaco, Peru, Senegal, Switzerland and the United Arab Emirates.*

Going forward

- *Gather support for the proposal on country names.*
- *ICELAND vs. ICELAND case - waiting for a result from the EUIPO.*
- *The Chile IPO's method?*
- *Additions to 6ter?*

Or should Iceland, the country, just rebrand?



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