

# ***Case law and new legislation -Iceland-***

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# ***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.*

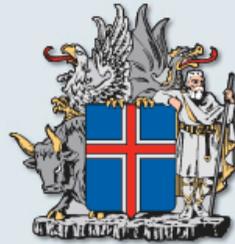
# *Proposal on protection of country names*

- *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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