

WIPO



SCT/15/3

ORIGINAL: English

DATE: October 14, 2005

E

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**STANDING COMMITTEE ON THE LAW OF TRADEMARKS,
INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS**

Fifteenth Session

Geneva, November 28 to December 2, 2005

ARTICLE *6ter* OF THE PARIS CONVENTION:
LEGAL AND ADMINISTRATIVE ASPECTS

Document prepared by the Secretariat

CONTENTS

	<u>Page</u>
A. INTRODUCTION	2
B. LEGAL ASPECTS	3
I. SCOPE OF PROTECTION	3
(a) Signs of States	3
(b) Signs of International Intergovernmental Organizations.....	5
II. LEGAL FRAMEWORK FOR COMMUNICATIONS	6
(a) The International Bureau as Intermediary	6
(b) The Transmittal of Objections.....	7
III. EFFECT ON NATIONAL MARKS	7
(a) Extension to Service Marks.....	7
(b) The Principle of Non-Retroactivity	8
IV. ADDITIONAL PROTECTION MEASURES	8
(a) Use of State Armorial Bearings in Trade	8
(b) Marks Contrary to Morality or Public Order.....	9
C. ADMINISTRATIVE ASPECTS	9
I. COMMUNICATION PROCEDURES	9
(a) Procedure to be Followed by a State	9
(b) Procedure to be Followed by an International Intergovernmental Organization	10
(c) Request for Modification of Protection	11
(d) Objection Procedure	11
II. AGREEMENT BETWEEN THE WORLD INTELLECTUAL PROPERTY ORGANIZATION AND THE WORLD TRADE ORGANIZATION	12
III. STATISTICAL INFORMATION	12
IV. ARTICLE 6ter DATABASE.....	13

ANNEXES

- I. Text of Article *6ter* of the Paris Convention
- II. Guidelines for the Interpretation of Article *6ter*(1)(b) and (3)(b) of the Convention for the Protection of Industrial Property adopted, in 1992, by the Assembly of the Paris Union
- III. Agreement between the World Intellectual Property Organization and the World Trade Organization (1995)

A. INTRODUCTION

1. The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (hereinafter referred to as “the Standing Committee” or “the SCT”), at its fourteenth session, in Geneva, from April 18 to 22, 2005, decided to invite members and observers to submit to the Secretariat, in writing, concise proposals for its future work, including the issues to be dealt with and priorities for addressing them (see document SCT/14/8 Prov., paragraph 354).
2. Mexico, New Zealand, the United Kingdom and the United States of America proposed that the Standing Committee undertake work in the field of Article *6ter* of the Paris Convention for the Protection of Industrial Property of 1883 (hereinafter referred to as “the Paris Convention”), as set forth in the 1967 Stockholm Act (see document SCT/15/2, paragraphs 29 to 31 and Annexes IV, VI, XII and XIII).
3. The Secretariat has prepared the present background document with the purpose of offering information on legal and administrative aspects of the application of Article *6ter* of the Paris Convention, which provides for the protection of certain signs of States and international intergovernmental organizations.
4. Chapter B of the present document contains a legal analysis of Article *6ter* of the Paris Convention. Chapter C deals with practical aspects of the communication procedure under Article *6ter*.

B. LEGAL ASPECTS

5. Article 6*ter* was introduced into the Paris Convention by the Revision Conference of The Hague in 1925. The provision underwent some minor modifications, as to form, at the Revision Conference of London in 1934, and was more thoroughly revised by the Revision Conference of Lisbon in 1958¹.

6. The purpose of Article 6*ter* is to provide a degree of legal protection to armorial bearings, flags and other State emblems as well as official signs and hallmarks indicating control and warranty adopted by States that are members of the Paris Union. The protection was extended to armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organizations, of which at least one member State is a member of the Paris Union, by the Revision Conference of Lisbon in 1958. The text of Article 6*ter* is reproduced in Annex I.

7. Pursuant to the Guidelines for the Interpretation of Article 6*ter*(1)(b) and (3)(b) adopted by the Assembly of the Paris Union in 1992 (hereinafter referred to as “the Guidelines of 1992”), any program or institution established by an international intergovernmental organization, and any convention constituting an international treaty may, under certain conditions, also benefit from the protection resulting from the application of Article 6*ter*². The text of the Guidelines of 1992 is reproduced in Annex II.

8. Article 6*ter* is applicable to the States party to the Paris Convention as well as to all Members of the World Trade Organization (WTO), whether or not party to the Paris Convention, by virtue of Article 2.1 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter referred to as “the TRIPS Agreement”).

9. The following four sections of this chapter discuss in further detail the legal aspects of Article 6*ter*. Section I deals with substantive law aspects of the protection for signs adopted by States (Article 6*ter*(1)(a)) and the protection for signs adopted by international intergovernmental organizations (Article 6*ter*(1)(b)). Section II describes the legal framework for communications under Article 6*ter*(3) through the intermediary of the International Bureau as well as the transmittal of objections pursuant to Article 6*ter*(4). Section III addresses the effect of Article 6*ter* communications on marks registered or used at the national level. Finally, Section IV touches on additional measures for the protection of subject matter falling within the scope of Article 6*ter*, as referred to in Article 6*ter*(9) and (10).

I. SCOPE OF PROTECTION

(a) Signs of States

Signs Eligible for Protection

10. Pursuant to Article 6*ter*(1)(a) of the Paris Convention, armorial bearings, flags and other State emblems as well as official signs and hallmarks indicating control and warranty adopted by States enjoy protection against unauthorized registration or use as trademarks. In accordance with this provision, countries member of the Paris Union are required to refuse or invalidate such trademark registrations and to prohibit by appropriate measures the use of

such marks. The protection of State emblems falling under Article 6ter(1)(a) extends to any imitation “from a heraldic point of view”.

11. The objective underlying Article 6ter(1)(a) is to proscribe the registration and use of trademarks that reproduce or imitate State emblems falling within its scope. The provision excludes State emblems from registration or use as trademarks or as elements of trademarks. The reason for this exclusion is that registration or use of such emblems would encroach upon the right of the State concerned to control the use of the symbols of its identity and sovereignty. Moreover, use of a State emblem as a trademark by an unrelated or unauthorized person is likely to mislead the public as to the origin or sponsorship of the goods to which the mark is attached.

12. The negotiations at the 1925 Revision Conference of The Hague give evidence of the intention of the States party to the Paris Convention to include, in the protection resulting from Article 6ter(1)(a), the emblems of States included in a federal State party to the Paris Convention, as well as escutcheons of reigning houses. It was understood, however, that emblems of lower public bodies, such as provinces or municipalities, should be excluded from the scope of the provision³. As to official signs and hallmarks indicating control and warranty, it is to be noted that Article 6ter(1)(a) only covers signs and hallmarks that are adopted by the State itself. Their adoption by a lower public body or an organization established under public law would be insufficient for those signs or hallmarks to qualify for protection under Article 6ter⁴.

13. The protection of State emblems under Article 6ter(1)(a) concerns not only the registration or use of trademarks that are in whole or in part identical to such emblems, but also trademarks that fall within a specific sphere of similarity, namely imitation “from a heraldic point of view”. This qualification effectively narrows down the scope of the impermissible imitation beyond what would normally be considered unacceptable in trademark law. As State emblems frequently comprise common symbols, such as a lion, an eagle or the sun, imitations are forbidden only if they reproduce the heraldic characteristics of the State sign concerned. In consequence, the symbol as such remains free and may be used in the composition of trademarks⁵.

14. The protection given to State emblems under Article 6ter(1)(a) does not concern only emblems of the countries of the Paris Union but also, by virtue of the TRIPS Agreement, emblems of all Members of the WTO irrespective of whether or not they are party to the Paris Convention. The implementation of Article 6ter for the purposes of the TRIPS Agreement is regulated in Article 3 of the Agreement Between the World Intellectual Property Organization and the World Trade Organization of December 22, 1995 (hereinafter referred to as “the WIPO/WTO Agreement of 1995”), which entered into force on January 1, 1996.

15. Article 6ter(1)(a) prohibits the unauthorized registration or use, as trademarks, of State emblems. The competent authorities of the State to which the emblem belongs are free to authorize such registration and use. Nationals of a country who have obtained from such authorities permission to use certain State emblems of their country may use them, in line with Article 6ter(8), even if they are similar to the signs of another country.

Limitations on Protection of Signs of Control or Warranty

16. Article 6ter(2) of the Paris Convention applies a rule of “speciality” to limit protection of official signs and hallmarks indicating control and warranty. The use of these signs is only prohibited where the marks in which they are incorporated are intended to be used on goods that are identical or similar to the goods to which the affected official sign or hallmark applies. At the 1925 Revision Conference of The Hague, the issue was raised whether it should also be made a condition that such use create confusion in trade, but this additional condition was not adopted⁶.

(b) Signs of International Intergovernmental Organizations

Signs Eligible for Protection

17. Article 6ter(1)(b) of the Paris Convention provides that the protection against registration or use of State emblems and signs as trademarks established in Article 6ter(1)(a) shall equally apply to armorial bearings, flags, other emblems, abbreviations, and names of intergovernmental organizations, of which one or more countries of the Paris Union are members. However, signs of this kind are excluded from the scope of the provision if they are already the subject of international agreements in force which are intended to ensure their protection⁷. Accordingly, Article 6ter(1)(b) is subsidiary to other international agreements serving the protection of signs of international intergovernmental organizations. The exclusion from the scope of Article 6ter(1)(b) avoids double, and potentially conflicting protection of those signs.

18. Pursuant to the Guidelines of 1992⁸, the International Bureau must also communicate armorial bearings, flags, other emblems, abbreviations and names of programs or institutions established by an international intergovernmental organization, or conventions constituting an international treaty to which one or more States members of the Paris Convention is a Party. It is made a condition, however, that the program, institution or convention concerned leads to the establishment of a permanent entity having specified aims and its own rights and obligations.

19. In this respect, the Guidelines of 1992 further clarify that the term “permanent entity” means an entity which is established for an indefinite period of time. The expression “specified aims” indicates that the entity must be competent for certain subject matters which are clearly defined in its enabling statutes or charter, or in resolutions or other decisions concerning its establishment. Similarly, the expression “own rights and obligations” refers to rights and obligations clearly defined in the relevant statutes, charter, resolutions or other decisions. The Guidelines indicate that such rights and obligations may concern tasks like the management of the permanent entity, the election or appointment of its chief executive, finances or reporting of activities.

Limitations on Protection

20. The protection of signs of international intergovernmental organizations may be limited to cases in which their use or registration as trademarks would suggest a connection with the organization concerned. The second sentence of Article 6ter(1)(c) provides that countries are not obliged to apply Article 6ter(1)(b) when the use or registration of armorial bearings, flags, emblems, abbreviations, or names of international intergovernmental organizations as

trademarks or elements of trademarks would not suggest a connection between the mark containing the relevant sign and the organization concerned. The same applies when the use or registration is unlikely to mislead the public as to the existence of a connection between the user of the mark and the organization concerned.

II. LEGAL FRAMEWORK FOR COMMUNICATIONS

(a) The International Bureau as Intermediary

21. The procedure for the protection of State emblems and signs falling under Article 6*ter*(1)(a), with the exception of flags of States⁹, is based on a system of notification. As reflected in Article 6*ter*(3)(a), the countries of the Paris Union agreed to communicate reciprocally the State emblems and signs for which they seek protection.

22. In the case of signs of international intergovernmental organizations, it follows from Article 6*ter*(3)(b) that communication to the countries party to the Paris Convention is a prerequisite for obtaining protection under Article 6*ter*(1)(b). The Guidelines of 1992 extend that communication procedure to signs of programs, institutions and conventions of international intergovernmental organizations eligible for protection under Article 6*ter*(1)(b) (cf. subsection I.(b) above).

23. The International Bureau fulfils the role of an intermediary with regard to the communication of signs under Article 6*ter*(3). Emblems and signs of States and international intergovernmental organizations are first communicated to the International Bureau by the competent authority of the country or organization concerned. The International Bureau then transmits the communication to the States party to the Paris Convention and, in accordance with the WIPO/WTO Agreement of 1995, to the Members of the WTO that are not party to the Paris Convention.

24. The same communication procedure is followed if an emblem or a sign already communicated is modified or withdrawn at a later stage. In this way, it can be ensured that only those emblems and signs currently in use by a State or international intergovernmental organization are placed under the protection of Article 6*ter*. In respect of State emblems and signs, the subsequent communication of modifications to the list of communicated emblem and signs is explicitly set forth in Article 6*ter*(3)(a).

25. Countries receiving a communication of emblems or signs through the intermediary of the International Bureau must make the communicated signs publicly available. This obligation set forth in Article 6*ter*(3)(a) may be fulfilled, for instance, by laying open the communicated signs for public inspection, or by publishing them¹⁰.

26. The task of the International Bureau to act as an intermediary for communications under Article 6*ter*(3) does not imply an obligation for the International Bureau to publish the emblems or signs of States or international intergovernmental organizations which are communicated through its intermediary, or to keep a register of those emblems and signs.

(b) The Transmittal of Objections

27. Pursuant to Article 6*ter*(4), countries receiving a communication of an emblem or sign under Article 6*ter*(3) may, within a period of 12 months from the receipt of the notification from the International Bureau, raise objections to the protection of such emblem or sign in respect of their territory. The International Bureau again fulfils the task of an intermediary in case of objections. Accordingly, an objection must be sent to the International Bureau by the competent authority of the country making the objection, which will then be transmitted to the State or international intergovernmental organization seeking protection for the emblem or sign concerned.

28. Article 6*ter* is silent on the grounds for objections to the protection of a communicated emblem or sign. Such grounds may therefore be determined by each country receiving the communication. An objection may be based, for instance, on a conflict with an emblem or sign of the country raising the objection, or with an emblem or sign of another State or international intergovernmental organization that has already been communicated under Article 6*ter*. It would also be possible to claim that the emblem or sign concerned is not of a nature to qualify for communication under Article 6*ter*, or that it is not an emblem or sign of the State or international intergovernmental organization requesting its protection. An objection might also be based on the fact that a requesting organization does not qualify to claim such protection under Article 6*ter* or the Guidelines of 1992. It could also be objected that the sign concerned has fallen into the public domain in the country raising the objection¹¹.

29. Article 6*ter* does not provide for a procedure for resolving differences of opinion as to objections to emblems or signs communicated under that Article. To settle disputes between States, recourse may be had to the procedures on disputes contained in Article 28 of the Paris Convention, if the provision is applicable between the States involved.

30. As long as the objection stands, the State which raised the objection is not obliged to protect the affected emblems or signs.

III. EFFECT ON NATIONAL MARKS

(a) Extension to Service Marks

31. Article 6*ter* of the Paris Convention is only applicable in respect of trademarks (i.e. marks that distinguish goods). Although, the provision may be applied analogously to service marks, the Paris Convention does not establish an international obligation to do so.

32. An international obligation to apply Article 6*ter* also to service marks does arise from Article 16 of the Trademark Law Treaty 1994. Pursuant to that provision, Contracting Parties must apply to service marks the provisions of the Paris Convention concerning trademarks. When applying Article 6*ter* to service marks, Article 6*ter*(2), which concerns signs and hallmarks indicating control and warranty, must consequently be read to refer not only to goods but also to services “of the same or a similar kind”.

(b) The Principle of Non-Retroactivity

33. The provisions of Article 6ter which regulate the effect on marks already registered or used at the national level rest on the principle of avoiding retroactivity. Under the general rule set out in Article 6ter(6), which concerns all emblems and signs falling within the scope of Article 6ter except for State flags, the protection of an emblem or a sign in accordance with Article 6ter only affects marks registered more than two months after the communication was received under Article 6ter(3).

34. The flags of States are the only category of emblem that need not be communicated to benefit from protection under Article 6ter (cf. subsection II.(a) above). In consequence, communication of State flags cannot serve as a reference point for determining the effect that their protection might have on marks. To regulate this specific case, Article 6ter(5) stipulates that the protection of State flags under Article 6ter(1)(a) only affects marks registered after November 6, 1925, which is the date on which the text of the Paris Convention, as revised at The Hague, was signed¹².

35. In respect of signs of international intergovernmental organizations, the date on which an Act of the Paris Convention providing for their protection – the 1958 Lisbon Act or the 1967 Stockholm Act – entered into force in the country concerned is to be taken into account. In this connection, Article 6ter(1)(c) provides that countries are free not to grant protection for such signs under Article 6ter(1)(b) if that would be to the prejudice of the holders of rights acquired in good faith before a relevant Act of the Paris Convention entered into force.

36. In countries availing themselves of this possibility, the rule set out in Article 6ter(1)(c) overrides the general principle contained in Article 6ter(6). The communication of signs of international intergovernmental organizations pursuant to Article 6ter(3)(b) thus only has effect on marks from the day of entry into force of the relevant Act of the Paris Convention – irrespective of whether the mark in question was registered more than two months after receipt of the communication claiming protection under Article 6ter. The latter date would be relevant under Article 6ter(6). It is noted, however, that an obligation for countries to grant protection in respect of signs of international intergovernmental organizations, without being party to the Paris Convention, may arise from the TRIPS Agreement.

IV. ADDITIONAL PROTECTION MEASURES

(a) Use of State Armorial Bearings in Trade

37. Article 6ter(9) broadens the scope of protection with regard to armorial bearings of States. Under the general provision of Article 6ter(1)(a), State armorial bearings are protected against unauthorized registration or use as trademarks. Article 6ter(9) extends that basic protection to other forms of unauthorized use in trade, such as use of the armorial bearings as decorative elements on the packaging or design of goods, or in advertising material. For this broader protection to apply it is required, however, that the use of the State armorial bearings be of such a nature that it would be misleading as to the origin of the goods concerned.

(b) Marks Contrary to Morality or Public Order

38. Article 6ter(10) clarifies that the specific protection given to emblems and signs of States and international intergovernmental organizations in Article 6ter does not affect the application of Article 6quinquies(B)(3) of the Paris Convention. Accordingly, marks incorporating emblems or signs protected under Article 6ter may be denied registration or invalidated at the national level on the grounds that they are contrary to morality or public order and, in particular, where they are of such a nature as to deceive the public.

39. The reference to Article 6quinquies(B)(3) of the Paris Convention seems to indicate that Article 6ter could be understood to deal with a special case of marks contrary to morality or public order, namely marks that unduly incorporate emblems or signs of States or international intergovernmental organizations¹³. On the basis of the *lex specialis* principle, it could be argued that Article 6ter, to the extent that it contains specific provisions with regard to such emblems and signs, would preempt the application of the general principle reflected in Article 6quinquies(B)(3). To avoid that interpretation Article 6ter(10) makes it clear that Article 6quinquies(B)(3) remains applicable.

C. ADMINISTRATIVE ASPECTS

40. In accordance with Article 6ter(3)(a), the countries of the Paris Union communicate reciprocally, through the intermediary of the International Bureau, the lists of emblems and signs for which protection is requested under Article 6ter(1). The same procedure applies in respect of international intergovernmental organizations under Article 6ter(3)(b). Thus, the International Bureau enables such communication by transmitting the relevant notifications to the members of the Paris Union as well as to the Members of the WTO not party to the Paris Convention. The notifications take the form of a verbal note from the International Bureau addressed to the Ministries of Foreign Affairs of the Paris Union members, to the Ministries of Foreign Affairs of the WTO Members not party to the Paris Convention, and to the competent authorities of those WTO Members not party to the Paris Convention that are customs territories. Copies of those notes are sent for information to the competent national industrial property administrations. As indicated earlier, the International Bureau does not maintain a register of notifications nor does it publish such notifications, the latter being incumbent on the members of the Paris Union and the WTO Members (see Article 6ter(3) *in fine*). Article 6ter does not prescribe administrative details of the notification procedure. However, over the years, a certain administrative practice, as described below, has come into place.

I. COMMUNICATION PROCEDURES

(a) Procedure to be Followed by a State

41. As a first step, the competent authorities of a State wishing to communicate an emblem or sign will usually contact the International Bureau informally, for example by e-mail or telephone. During the subsequent correspondence between the International Bureau and the authorities of the State, the formalities regarding the request for communication are explained and discussed.

42. In order to determine whether a given emblem or sign qualifies for protection under Article 6*ter*, the International Bureau verifies the nature of the emblem or sign for which protection is requested and will insist that the request clearly indicate the type of emblem or sign for which protection is requested. Article 6*ter*(1)(a) enumerates exhaustively the types of signs eligible for protection, namely armorial bearings, flags, other State emblems and official signs or hallmarks indicating control and warranty. Official signs and hallmarks indicating control and warranty have to be adopted by the State itself and not by a lower public body. Written definitions of the features or characteristics of the emblem or sign, and indications of the colors of the sign are not required.

43. Before sending an official request, a State is asked to send a draft request for communication and a draft reproduction of the emblems or signs for which protection is sought, to the International Bureau for its comments. A request for communication may be made in the form of a simple letter, addressed to the Assistant Director General of WIPO, and signed by a person duly authorized to represent the requesting State.

44. The reproduction of the emblem or sign for which protection is sought under Article 6*ter*(1)(a) should be preferably on an A4-size sheet. Written indications, such as the nature of the sign, are requested in English and in French.

45. Once the draft request and the draft reproduction are considered to be in order for communication, the official request together with 600 copies of the reproduction may be sent to the International Bureau. The International Bureau sends circular letters transmitting the request for protection, together with copies of the reproduction of the emblem or sign for which protection is requested, to the Ministries of Foreign Affairs of the Member States of the Paris Union and to the Members of the WTO not party to the Paris Convention. Simultaneously, the International Bureau sends copies of the circular letters to the respective industrial property offices for information. Finally, the International Bureau confirms the transmittal of the requested communication in a letter to the State, at the request of which the communication was made, and attaches to that letter, for information, copies of the circular letters.

(b) Procedure to be Followed by an International Intergovernmental Organization

46. An international intergovernmental organization may request communication of its armorial bearings, flags and other emblems, and abbreviations and names, through the intermediary of the International Bureau, following a procedure similar to that applied in respect of States. As a first step, the international intergovernmental organization contacts the International Bureau of WIPO informally and transmits documentation concerning its legal status and a list of its Member States. The documentation must include the statute or charter of the organization, except in the case of an organization belonging to the United Nations system or an organization that has already communicated such information to the International Bureau.

47. The International Bureau examines the documents in order to verify that the requesting entity qualifies as an international intergovernmental organization for the purposes of Article 6*ter*(1)(b), or as a program or institution established by an international intergovernmental organization or a convention constituting an international treaty in accordance with the Guidelines of 1992. However, this is a *prima facie* determination since the ultimate decision as to the nature of a requesting organization and its eligibility for the

purposes of Article 6ter(1)(b) and (3)(b) remains with the States party to the Paris Convention and the Members of the WTO not party to the Paris Convention.

48. Before sending an official request, an international intergovernmental organization is asked to send to the International Bureau a draft of the request for communication and a draft reproduction of the signs to be protected. A request for communication may be made in the form of a simple letter, addressed to the Assistant Director General of WIPO, and signed by the head of the organization concerned or an officer of that organization duly authorized by him. With regard to the draft reproduction of the signs of an international intergovernmental organization, the requirements are the same as those in respect of communication requested by a State.

49. Once the draft request and the draft reproduction are considered to be in order for communication, the official request together with 600 copies of the reproduction may be sent to the International Bureau. The International Bureau sends circular letters transmitting the request for protection, together with copies of the reproduction, to the Ministries of Foreign Affairs of the Member States of the Paris Union and to the Members of the WTO not party to the Paris Convention, and also sends copies of the circular letters to the respective industrial property offices, for information. Finally, the International Bureau confirms the transmittal of the requested communication in a letter to the organization, at the request of which the communication was made, and attaches to that letter, for information, copies of the circular letters.

(c) Request for Modification of Protection

50. The same procedure is followed in the case of a request for communication of a modification of protection under Article 6ter(3). However a request for communication of a modification must indicate whether the request for protection of the emblems or signs that have been communicated previously, is to be maintained or withdrawn.

(d) Objection Procedure

51. Any State receiving communication of an emblem or other official sign may, in accordance with Article 6ter(4) of the Paris Convention, transmit its objections, if any, through the intermediary of the International Bureau of WIPO, to the State or organization at the request of which the communication was made. Such objections must be notified to the International Bureau within a period of 12 months from the receipt of that communication.

52. A notification of an objection may be made in the form of a simple letter addressed to the International Bureau. Unless the objection is raised against the communication as a whole, the notification should identify the individual items in the request for communication against which an objection is raised.

II. AGREEMENT BETWEEN THE WORLD INTELLECTUAL PROPERTY ORGANIZATION AND THE WORLD TRADE ORGANIZATION

53. In accordance with Article 3(1) of the Agreement Between the World Intellectual Property Organization and the World Trade Organization of December 22, 1995 (reproduced in Annex III), the International Bureau administers the procedures relating to communication of emblems and transmittal of objections under the TRIPS Agreement. As regards the States party to the Paris Convention that are Members of the WTO, the communications sent by the International Bureau by circular letter to all the Member States of the Paris Union also constitute the communication under the TRIPS Agreement.

54. The International Bureau sends separate circular letters to the Ministries of Foreign Affairs of the Member States of the WTO not party to the Paris Convention. At the time of preparation of this document, this applied to the following States: Angola, Brunei Darussalam, Fiji, Kuwait, Maldives, Myanmar, Solomon Islands and Thailand. The International Bureau also sends copies of the circular letters to the industrial property offices of those countries, for information.

55. In addition, the International Bureau sends notes to the European Commission, the Permanent Representation of the Hong Kong Special Administrative Region of China to the WTO, to the Delegation of the Macau Special Administrative Region of China to the WTO and to the Permanent Representative of the Separate Customs Territory of Taiwan, Penghu, Kinmen and Matsu to the WTO.

56. The International Bureau regularly provides to the WTO Secretariat lists of the communications that have been sent out and other information requested in respect of those communications.

III. STATISTICAL INFORMATION

57. By August 31, 2005, a total of 262 requests for communication under Article 6*ter* of the Paris Convention had been sent by the International Bureau of WIPO to the States party to the Paris Convention and to the Members of the WTO not party to the Paris Convention. Both the States and the international intergovernmental organizations use the procedure provided for in Article 6*ter* of the Paris Convention actively, since the number of requested communications by States is 121, and by organizations 141. International intergovernmental organizations have been able to request communication under Article 6*ter*(3)(b) only as of the entry into force of the 1958 Lisbon Act of the Paris Convention. Each communication may contain several individual items, such as armorial bearings, flags, emblems, official signs, hallmarks, abbreviations or names, for which protection is requested under Article 6*ter*(1) of the Paris Convention.

58. Altogether, 64 States and 118 international intergovernmental organizations have requested communication, under Article 6*ter*(3) of the Paris Convention, of their emblems and signs. In application of the Guidelines of 1992, any program or institution established by an international intergovernmental organization and any convention constituting an international treaty may, under certain conditions, benefit from protection under Article 6*ter*(1)(b) of the Paris Convention. Since 1992, 15 communications of signs of programs or institutions established by an international intergovernmental organization, and

11 communications of signs of conventions constituting an international treaty, have been transmitted by the International Bureau.

59. Out of 262 requests for communication transmitted by the International Bureau, objections have been raised against 17 communications requested by States and against six communications requested by organizations.

IV. ARTICLE 6^{ter} DATABASE

60. The International Bureau of WIPO maintains a database of the records of all communications and objections transmitted by the International Bureau under Article 6^{ter} of the Paris Convention. The information contained in the Article 6^{ter} database does not have any legal effect, and it is published only for information purposes.

61. The Article 6^{ter} database is updated several times per year. It may be consulted on-line free of charge at WIPO's Article 6^{ter} website at <http://www.wipo.int/article6ter/en>. In 2005, the Article 6^{ter} website has so far recorded approximately 20,000 hits per month.

62. An updated version of the Article 6^{ter} database is published every year on CD-ROM and distributed free of charge to all members of the Paris Union and to the WTO Members not party to the Paris Convention.

[Annexes follow]

¹ For a detailed legal analysis of Article 6^{ter}, see Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property*, WIPO Publication No. 611, WIPO, Geneva, 2004, pp. 94-103.

² See document P/A/XIX/4, Report adopted by the Assembly of the Paris Union, p.4.

³ See *Actes de La Haye*, pp. 245, 464 and 544.

⁴ See Bodenhausen, *ibid.*, pp. 96-97.

[Endnote continued from previous page]

- ⁵ See *Actes de La Haye*, p. 245. Cf. the deliberations at the 1958 Revision Conference of Lisbon concerning the question whether the confinement to imitations from a heraldic point of view should be abandoned, *Actes de Lisbonne*, pp. 129, 131, 139-140.
- ⁶ See *Actes de La Haye*, p. 460.
- ⁷ See, for instance, Article 44 of the Geneva Convention for the amelioration of the condition of the wounded and sick in armed forces, of August 12, 1949. This provision protects the emblems of the Red Cross on a white ground, the words “Red Cross” or “Geneva Cross” and analogous emblems.
- ⁸ See document P/A/XIX/4, Report adopted by the Assembly of the Paris Union, p.4.
- ⁹ At the 1958 Revision Conference of Lisbon, State flags were considered to be sufficiently well-known, whereas communication was deemed appropriate in the case of flags of States included in a federal State, and flags of international intergovernmental organizations. See *Actes de Lisbonne*, pp. 141-147.
- ¹⁰ At the 1925 Revision Conference of The Hague, no agreement on the obligation to publish communicated signs could be reached. Accordingly, publication is not mandatory. See *Actes de La Haye*, pp. 523-524.
- ¹¹ Cf. the possible grounds for objections mentioned by Bodenhausen, *ibid.*, p. 101.
- ¹² See Bodenhausen, *ibid.*, p. 102.
- ¹³ Cf. the deliberations at the 1925 Revision Conference of The Hague, *Actes de La Haye*, p. 460.

ANNEX I

TEXT OF ARTICLE *6ter* OF THE PARIS CONVENTION

Article *6ter*

[Marks: Prohibitions concerning State Emblems, Official Hallmarks, and Emblems of Intergovernmental Organizations]

“(1) (a) The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.

(b) The provisions of subparagraph (a), above, shall apply equally to armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations of which one or more countries of the Union are members, with the exception of armorial bearings, flags, other emblems, abbreviations, and names, that are already the subject of international agreements in force, intended to ensure their protection.

(c) No country of the Union shall be required to apply the provisions of subparagraph (b), above, to the prejudice of the owners of rights acquired in good faith before the entry into force, in that country, of this Convention. The countries of the Union shall not be required to apply the said provisions when the use or registration referred to in subparagraph (a), above, is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization.

(2) Prohibition of the use of official signs and hallmarks indicating control and warranty shall apply solely in cases where the marks in which they are incorporated are intended to be used on goods of the same or a similar kind.

(3) (a) For the application of these provisions, the countries of the Union agree to communicate reciprocally, through the intermediary of the International Bureau, the list of State emblems, and official signs and hallmarks indicating control and warranty, which they desire, or may hereafter desire, to place wholly or within certain limits under the protection of this Article, and all subsequent modifications of such list. Each country of the Union shall in due course make available to the public the lists so communicated. Nevertheless such communication is not obligatory in respect of flags of States.

(b) The provisions of subparagraph (b) of paragraph (1) of this Article shall apply only to such armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations as the latter have communicated to the countries of the Union through the intermediary of the International Bureau.

(4) Any country of the Union may, within a period of twelve months from the receipt of the notification, transmit its objections, if any, through the intermediary of the International Bureau, to the country or international intergovernmental organization concerned.

(5) In the case of State flags, the measures prescribed by paragraph (1), above, shall apply solely to marks registered after November 6, 1925.

(6) In the case of State emblems other than flags, and of official signs and hallmarks of the countries of the Union, and in the case of armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations, these provisions shall apply only to marks registered more than two months after receipt of the communication provided for in paragraph (3), above.

(7) In cases of bad faith, the countries shall have the right to cancel even those marks incorporating State emblems, signs, and hallmarks, which were registered before November 6, 1925.

(8) Nationals of any country who are authorized to make use of the State emblems, signs, and hallmarks, of their country may use them even if they are similar to those of another country.

(9) The countries of the Union undertake to prohibit the unauthorized use in trade of the State armorial bearings of the other countries of the Union, when the use is of such a nature as to be misleading as to the origin of the goods.

(10) The above provisions shall not prevent the countries from exercising the right given in paragraph (3) of Article 6quinquies, Section B, to refuse or to invalidate the registration of marks incorporating, without authorization, armorial bearings, flags, other State emblems, or official signs and hallmarks adopted by a country of the Union, as well as the distinctive signs of international intergovernmental organizations referred to in paragraph (1), above”.

[Annex II follows]

ANNEX II

GUIDELINES FOR THE INTERPRETATION OF ARTICLE *6ter*(1)(B)
AND (3)(B) OF THE CONVENTION FOR THE PROTECTION OF
INDUSTRIAL PROPERTY ADOPTED, IN 1992, BY THE
ASSEMBLY OF THE PARIS UNION

The Guidelines are copied from document P/A/XIX/4, Report adopted by the Assembly of the Paris Union, p. 4.

In order to clarify certain aspects of Article *6ter*(1)(b) and (3)(b), the Assembly of the Paris Union adopted the Guidelines for the Interpretation of Article (1)(b) and (3)(b) in 1992. In application of these Guidelines, any program or institution established by an international intergovernmental organization, and any convention constituting an international treaty may, under certain conditions, benefit from the protection granted by Article *6ter*(1)(b) of the Paris Convention. The Guidelines provide the following:

“A. For the purposes of the implementation of Article *6ter*(1)(b) and (3)(b) of the Paris Convention for the Protection of Industrial Property, the International Bureau shall also communicate armorial bearings, flags, other emblems, abbreviations and names of

(i) any program established by an international intergovernmental organization, provided that the said program constitutes, or is intended to constitute, within the said organization, a permanent entity having specified aims and its own rights and obligations;

(ii) any institution established by an international intergovernmental organization, provided that the said institution constitutes, or is intended to constitute, within the said organization, a permanent entity having specified aims and its own rights and obligations;

(iii) any convention constituting an international treaty to which one or more States members of the Paris Union are Party, provided that the said convention establishes, or is intended to establish, a permanent entity having specified aims and its own rights and obligations.

B. For the purposes of the present guidelines,

– “permanent entity” means an entity which is established for an indefinite period of time; thus entities established to promote a particular issue or to celebrate a special event within a limited period of time (for example, programs such as “year of ...”) are excluded;

– “specified aims” means that the permanent entity is competent for certain subject matters which are clearly defined in its enabling statutes or charter, or in the resolutions or other decisions establishing such entity;

– “own rights and obligations” means that the permanent entity has rights and obligations which are clearly defined in its enabling statutes or charter or in the resolutions or other decisions by which it has been established. Such rights and obligations may concern the management of the permanent entity, election or appointment of its chief executive, finances, reporting of activities, etc.”

[Annex III follows]

ANNEX III

AGREEMENT BETWEEN THE WORLD INTELLECTUAL PROPERTY ORGANIZATION AND THE WORLD TRADE ORGANIZATION (1995)

Article 3
Implementation of Article 6ter of the Paris Convention
for the Purposes of the TRIPS Agreement

“(1) [*General*]

(a) The procedures relating to communication of emblems and transmittal of objections under the TRIPS Agreement shall be administered by the International Bureau in accordance with the procedures applicable under Article 6ter of the Paris Convention (1967).

(b) The International Bureau shall not recommunicate to a State party to the Paris Convention which is a WTO Member an emblem which had already been communicated to it by the International Bureau under Article 6ter of the Paris Convention prior to January 1, 1996, or, where that State became a WTO Member after January 1, 1996, prior to the date on which it became a WTO Member, and the International Bureau shall not transmit any objection received from the said WTO Member concerning the said emblem if the objection is received by the International Bureau more than 12 months after receipt of the communication of the said emblem under Article 6ter of the Paris Convention by the said State.

(2) [*Objections*] Notwithstanding [paragraph \(1\)\(a\)](#), any objection received by the International Bureau from a WTO Member which concerns an emblem that had been communicated to the International Bureau by another WTO Member where at least one of the said WTO Members is not party to the Paris Convention, and any objection which concerns an emblem of an international intergovernmental organization and which is received by the International Bureau from a WTO Member not party to the Paris Convention or not bound under the Paris Convention to protect emblems of international intergovernmental organizations, shall be transmitted by the International Bureau to the WTO Member or international intergovernmental organization concerned regardless of the date on which the objection had been received by the International Bureau. The provisions of the preceding sentence shall not affect the time limit of 12 months for the lodging of an objection.

(3) [*Information to Be Provided to the WTO Secretariat*] The International Bureau shall provide to the WTO Secretariat information relating to any emblem communicated by a WTO Member to the International Bureau or communicated by the International Bureau to a WTO Member”.

[End of Annex III and of document]