

E

WIPO



SCT/17/5
ORIGINAL: English
DATE: March 23, 2007

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

**Seventeenth Session
Geneva, May 7 to 11, 2007**

**ARTICLE 6^{TER} OF THE PARIS CONVENTION:
PROCEDURAL AND SELECTED LEGAL ASPECTS**

Document prepared by the Secretariat

CONTENTS

	<u>Page</u>
I. INTRODUCTION	2
II. PROCEDURAL ASPECTS.....	2
(a) Current Content of a Communication	2
(b) Relevant Contact Details Concerning the Requesting Party	3
(c) Information Concerning the Constituting Charter or Agreement of International Intergovernmental Organizations	3
(i) Constituting agreement or other documents as an enclosure to the communication.....	4
(ii) Reference to the website address of an international intergovernmental organization	4
(d) Information on the Nature of Goods and Services on Which Official Signs and Hallmarks are Used	4
(i) Possible ways of indicating goods and services	4
(e) Electronic Communication.....	5
(i) Notification of update on Article 6ter database.....	6
(ii) Individual e-mail notification	6
(iii) Individual download from FTP server	6
III. SELECTED LEGAL ASPECTS	6
(a) Duration of Protection	7
(b) Procedure for Withdrawal of a Communication	7

ANNEX I: Draft Request for Communication Under Article 6ter(3)(a) of the Paris Convention for the Protection of Industrial Property by a State

ANNEX II: Draft Request for Communication Under Article 6ter(3)(b) of the Paris Convention for the Protection of Industrial Property by an International Intergovernmental Organization

ANNEX III: Draft Request for Communication Under Article 6ter(3)(b) of the Paris Convention for the Protection of Industrial Property by a Program, or an Institution Established by an International Intergovernmental Organization, or by a Convention Constituting an International Treaty

I. INTRODUCTION

1. At the sixteenth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from November 13 to 17, 2006, the SCT requested the Secretariat to prepare a working document dealing with certain procedural aspects of communications under Article 6*ter* of the Paris Convention for the Protection of Industrial Property (Paris Convention), in particular, information on the nature of goods and services on which official signs and hallmarks indicating control and warranty are used, information concerning the constituting charter or agreement of international intergovernmental organizations availing themselves of Article 6*ter*(1)(b), relevant contact details concerning a party requesting a communication under Article 6*ter*, ways of making the content of Article 6*ter* notifications available through means of electronic communication, and draft forms for requesting communications (see document SCT/16/9 Prov., paragraph 154).

2. Section II of this document describes the practice of the International Bureau with regard to the administration of Article 6*ter* communication procedures. This Section also sets forth different possibilities for making the content of Article 6*ter* notifications available through means of electronic communication. Section III contains information on certain legal aspects of Article 6*ter* communication procedures that is complementary to document SCT/15/3. Draft request forms for communication, under Article 6*ter*(3)(a) and (b), are reproduced in Annexes I, II and III.

II. PROCEDURAL ASPECTS

(a) Current Content of a Communication

3. In accordance with Article 6*ter*(3)(a) of the Paris Convention, the countries party to that Convention have agreed to communicate reciprocally the State emblems and signs falling under Article (1)(a), with the exception of flags, for which they seek protection. A similar procedure applies in respect of signs of international intergovernmental organizations under Article 6*ter*(3)(b). The International Bureau fulfils the role of an intermediary with regard to the communication of signs and transmits the communications to the States party to the Paris Convention and, in accordance with Article 3 of the Agreement Between the World Intellectual Property Organization (WIPO) and the World Trade Organization (WTO) of December 22, 1995 (the WIPO/WTO Agreement of 1995), to the Members of the WTO that are not party to the Paris Convention.

4. Once an official request for protection together with 600 copies of the reproduction of the signs, for which protection is requested, are received by the International Bureau, the International Bureau sends circular letters transmitting the request to the Ministries of Foreign Affairs of the States members 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.

5. The standard content of the circular letter indicates the party requesting the communication, the nature of the sign, and whether the communication replaces any previous communication of a sign. The legal nature of programs and institutions established by an international intergovernmental organization or conventions constituting an international treaty, within the meaning of the Guidelines for the Interpretation of Article 6ter(1)(b) and (3)(b) of the Paris Convention adopted by the Assembly of the Paris Union in 1992 (the Guidelines of 1992)¹, is indicated in the circular letter. A reproduction of the signs, for which protection is requested, is attached to the circular letter.

(b) Relevant Contact Details Concerning the Requesting Party

6. A sign protected under Article 6ter may constitute a ground for refusal of an application for the registration of a trademark, or a reason to invalidate a registration or to prohibit the use of a trademark. Therefore, trademark applicants, holders and users may be in a situation where they need to get in contact with the party that had requested the protection of that sign. For this reason, it could be considered to make the contact details of the requesting parties available as part of the communication under Article 6ter(3)(a) and (b).

7. If this idea were to be pursued, it could be contemplated to ask States and international intergovernmental organizations that request a communication under Article 6ter(3)(a) or (b) to indicate, as a standard procedure, contact details which would enable third parties to enter directly into contact with the beneficiary of the Article 6ter protection in order to obtain their consent to potentially conflicting trademark registrations. These contact details would be communicated, together with the reproductions of the signs for which protection is sought.

8. However, it should be recalled that, according to Article 6ter(3)(a) *in fine*, it is up to the States party to the Paris Convention (and WTO Members not bound by that Convention) to make in due course available to the public the signs communicated under Article 6ter(3)(a) and (b). Thus, contact details of requesting parties, if communicated by the International Bureau, should also be made available to the public in that manner. Nevertheless, this would be without prejudice to the eventual inclusion of that information in the Article 6ter database.

9. With regard to existing communications (by December 31, 2006, some 1,100 signs of 65 States and 1,200 signs of international intergovernmental organizations have been communicated by the International Bureau to the Member States of the Paris Union and to the Members of the WTO, not party to the Paris Convention), it could be considered to invite those States and intergovernmental organizations to communicate (or confirm) their contact details to the International Bureau, which, in turn could include that information in the Article 6ter database.

(c) Information Concerning the Constituting Charter or Agreement of International Intergovernmental Organizations

10. As explained in document SCT/15/3 (see paragraph 46 onwards), an international intergovernmental organization that wishes to request the communication of its armorial bearings, flags and other emblems, and of its abbreviation and name contacts the International Bureau informally and transmits documentation concerning its legal status and a list of its Member States. The documentation must include the constituting instrument of the organization, such as its statutes or charter, 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. In particular, it is recalled that the ultimate decision as to the nature of a requesting organization and its eligibility for the purpose of the application of Article 6*ter*(1)(b) and (3)(b) of the Paris Convention remains with the States party to that Convention. A number of different ways for making available that information to parties that receive Article 6*ter* communications appear possible.

(i) Constituting agreement or other documents as an enclosure to the communication

11. One possibility would be the distribution of copies of the constituting instrument or other documents as an enclosure to the circular letter. However, such instruments or similar documents are usually voluminous and the copying of those documents, either by the requesting party or by the International Bureau, and their distribution would require considerable resources.

12. An alternative way of proceeding would be to invite the requesting party to submit copies of those documents directly to the Members States of the Paris Union and to the Members of the WTO, not party to the Paris Convention, which express a wish to receive those documents.

(ii) Reference to the website of an international intergovernmental organization

13. In order to avoid the transmittal of voluminous paper documents, the circular letter could contain a reference to a website where the constituting agreement or other documents establishing the organization, the program, the institution or the convention can be found. In any case, the International Bureau keeps copies of this type of documents on record, and could, in individual cases, make available copies of that documentation to parties that make a request to that effect.

(d) Information on the Nature of Goods and Services on Which Official Signs and Hallmarks are Used

14. The scope of protection of official signs or hallmarks indicating control and warranty adopted by a State is subject to a rule of “specialty” and thus, is more limited as compared to the other signs enumerated by Article 6*ter*(1)(a) (see document SCT/15/3, paragraph 16). Article 6*ter*(2) of the Paris Convention provides that such protection “shall apply solely in cases where the marks in which they are incorporated are intended to be used on goods of the same or similar kind”. The current practice of the International Bureau is not to require information on the products and/or services. However, the International Bureau recommends that the requesting parties submit that information.

(i) Possible ways of indicating goods and services

15. For the purposes of a communication under Article 6*ter*(3)(a), there appear to exist several ways of indicating the goods and/or services on which official signs and hallmarks are used. In some requests the goods and/or services have been identified individually, such as gold articles, milk products, etc. However, a number of indications of goods and services refer to the quality of a range of goods and services without defining them individually, for example, to products or services in the field of agriculture, consumer protection, education, tourism or the environment.

16. It could be considered to make it a standard requirement in requests for communication of official signs and hallmarks indicating control and warranty to indicate the goods and/or services to which those official signs and hallmarks apply. In that respect, it is recalled that Article 6*ter* of the Paris Convention is only applicable in respect of trademarks (i.e., marks that distinguish goods) and that an obligation to apply Article 6*ter* also to service marks does arise only from Article 16 of the Trademark Law Treaty 1994 (see document SCT/15/3, paragraph 31).

17. National industrial property offices tend to research their databases to identify trademarks, which are in conflict with signs, for which protection is requested under Article 6*ter*. In many States, the communications under Article 6*ter* are incorporated in the national trademark database as a search reference. Therefore, the use of the International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (the Nice Classification)² could be envisaged for the indication of the goods and/or services to which official signs or hallmarks apply.

18. However, attention is drawn to the fact that there exists a considerable variety in the application of the Nice Classification at the national level which could lead to questions of interpretation of Article 6*ter* requests using that Classification.

(e) Electronic Communication

19. Currently, individual communications under Article 6*ter*(3)(a) and (b) are made by the International Bureau in paper form only. As described in paragraph 60, onwards of document SCT/15/3, the International Bureau maintains a database of the records of all communications and objections transmitted, of which an updated version is published regularly on CD-ROM and distributed free of charge to all Member States of the Paris Union and to the WTO Members not party to the Paris Convention.

20. Against the background of an ever increasing use of electronic means of communication in contacts between the International Bureau and the trademark offices of the Member States, it appears to be worthwhile to explore ways of making available individual Article 6*ter* communications by use of electronic means of communication.

21. Before elaborating on the details of possibilities for making available Article 6*ter* communications in electronic form, it appears to be useful to recall that Article 6*ter* communications take the form of a verbal note from the International Bureau addressed to the Ministries of Foreign Affairs of the Member States of the Paris Union, 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.

It is the date of receipt of those verbal notes that constitute a legal effect under Article 6ter(4) and (6). Nevertheless, copies of those verbal notes are sent for information to the competent industrial property administrations.

22. With reference to the preceding paragraph, it would have to be determined whether it is feasible, at this point in time, to consider a complete replacement of the paper-based communication procedure by a given form of electronic communication. This would, in particular, hold true for the constitution of the legal effect of an Article 6ter communication. However, electronic communication supplementary to the paper communication of the information copy to competent national industrial property authorities could be one option for developing and putting into place of an electronic communication system for Article 6ter communications.

(i) Notification of update on Article 6ter database

23. As already mentioned above, the International Bureau maintains a database for Article 6ter notifications, which is updated regularly and promptly following the communication of a new request. This database is available, free of charge, from WIPO's webpage. It is thus conceivable to send an electronic communication in the form of an e-mail alert to those industrial property administrations which have expressed a wish to receive such communication, informing about a new entry in the Article 6ter database. Recipients of the e-mail could then download from the Article 6ter database the relevant image and data files and update their own databases. It is worthwhile noting that a similar system is already in place for the notification of the publication of new issues of the *International Designs Bulletin* under the Hague Agreement Concerning the International Registration of Industrial Designs (see Rule 26(3) of the Common Regulations under the Hague Agreement).

(ii) Individual e-mail notification

24. Another form of transmitting Article 6ter communications to interested industrial property administrations could be the sending of individual e-mail messages with the relevant data and image files being transmitted as attachments to such e-mail messages. As far as the actual administration of such a system is concerned, interested administrations could register on a mail server and would receive e-mails with the aforementioned attachments. However, experience shows that this type of communication set up produces regularly kick-backs of e-mail messages that cannot be delivered for various purposes. The administration of such a system would bind considerable resources of the Secretariat and any pros and cons of such an approach would have to be weighed carefully.

(iii) Individual download from FTP server

25. A third option for making available Article 6ter communications in an electronic format would be to upload the relevant data on a WIPO FTP ("File Transfer Protocol") server, from which interested administrations could download the data and incorporate it into their respective databases. Such a solution exists already for the daily updates of the ROMARIN® database under the Madrid System for the International Registration of Marks (see <http://www.wipo.int/madrid/en/romarin/access.htm>). Attention is drawn to the fact that the data made available would be in XML ("eXtended Markup Language") format. The uploading of new data relating to Article 6ter communications could be combined with a short e-mail alert. Alternatively, it could be decided that the data is updated once a month and interested administrations could check regularly on a given date whether updates are available and, eventually, download the data.

III. SELECTED LEGAL ASPECTS

26. At its sixteenth session, the SCT noted that there were some areas relating to Article 6ter communication procedures where clarification would be beneficial and requested the Secretariat to provide further information about those areas. As regards some issues mentioned by the SCT, reference is made to document SCT/15/3, which addresses in detail a number of legal and administrative aspects of the Article 6ter communication procedure, such as the eligible subject matter (paragraphs 10 to 20), grounds of refusal (paragraph 28), effect of prior trademark rights (paragraph 33, onwards), the role of the International Bureau (paragraphs 40 to 52) and an understanding of the status of the database (paragraphs 60 to 62). This portion of the document will deal with the duration (term) of protection and the procedure for withdrawal of a communication.

(a) Duration of Protection

27. As regards the commencement of protection and, in particular, the effect of a protected sign on prior trademarks, a general reference is made to document SCT/15/3, paragraphs 33 to 36, where those issues are dealt with in detail.

28. Article 6ter does not contain any provision that stipulates the duration of protection. In the absence of any such provision, it can be assumed that the agreement among the States members of the Paris Union and the Members of the WTO not party to the Paris Convention (but bound to apply that Convention) to provide the protection foreseen in Article 6ter(1) remains binding at least as long as a particular State (or WTO Member) remains bound by the relevant text of the Paris Convention.

(b) Procedure for Withdrawal of a Communication

29. Article 6ter is silent on the procedure and grounds for withdrawal of a communication. In practice, a similar procedure as for the communication of a sign for which protection is requested may be followed in case a given State or international intergovernmental organization wishes to withdraw a sign from the protection under Article 6ter(1). In practice, such withdrawals occur very rarely. In the majority of cases, where such a withdrawal was requested, it was communicated together with the request for communication of a modified sign replacing the withdrawn sign.

30. The SCT is invited to consider the present document and to express its preferences, if any, concerning the various options outlined in paragraphs 6, 7, 9, 11, 12, 13, 16, 17, 22, 23, 24 and 25, and in Annexes I, II and III.

[Annexes follow]

¹ See document P/A/XIX/4, Report adopted by the Assembly of the Paris Union, p.4.

² Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957, as revised at Stockholm on July 14, 1967, and at Geneva on May 13, 1977, and amended on September 28, 1979.

ANNEX I

Draft Request for Communication Under Article 6ter3(a) of the Paris Convention for the Protection of Industrial Property by a State

[date]

On behalf of the Government of [official name of the country], I would like to request the communication, under Article 6ter(3)(a) of the Paris Convention for the Protection of Industrial Property (Paris Convention), to the States party to the Paris Convention and to the Members of the World Trade Organization (WTO), not party to the said Convention, of the [armorial bearings], [flag], [State emblem] and/or [official sign or hallmark indicating control and warranty] adopted by [official name of the country].

[This communication is without prejudice to the protection of the signs of [official name of the country] circulated in Note No. [circular number] on [date of the circular]].

Sincerely yours,

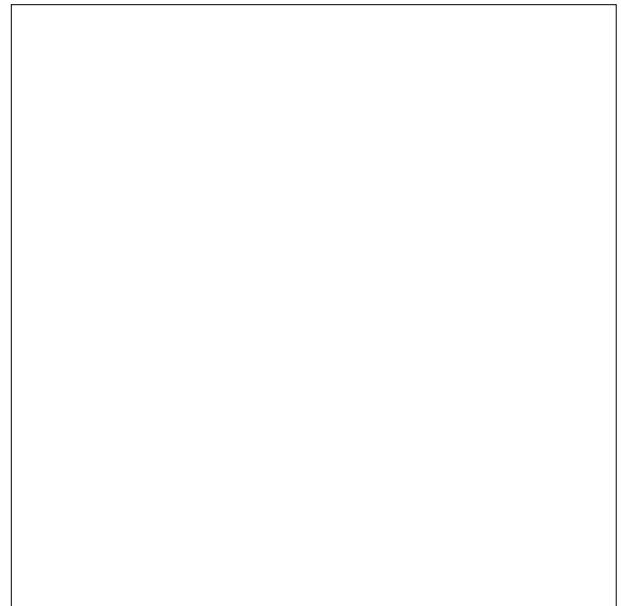
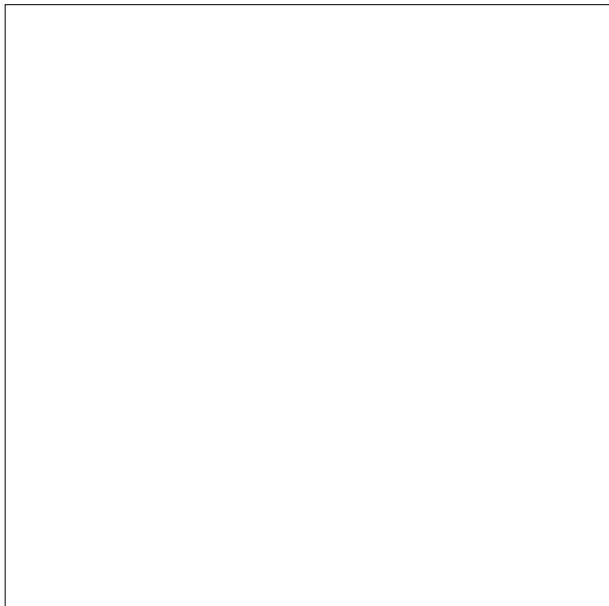
Name and signature of the Minister of [name of the ministry] or any other person duly authorized by him or her.

Enclosure: 600 copies of the reproduction of the [armorial bearings], [flag], [State emblem] and/or [official sign or hallmark indicating control and warranty] adopted by [official name of the country].

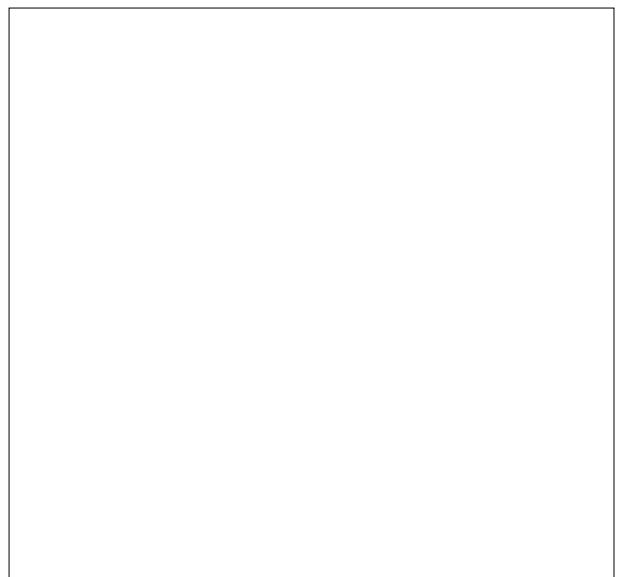
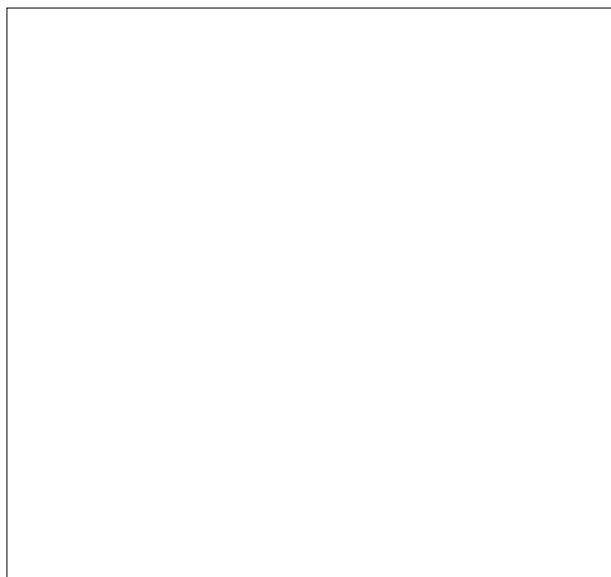
Letter to be addressed to the Director General of the World Intellectual Property Organization (WIPO), 34, chemin des Colombettes, 1211 Geneva 20, Switzerland.

ARMORIAL BEARINGS / FLAG(S) / STATE EMBLEM(S) / OFFICIAL SIGN(S)
INDICATING CONTROL AND WARRANTY / HALLMARK(S) INDICATING
CONTROL AND WARRANTY ADOPTED BY /
ARMOIRIES / DRAPEAU(X) / EMBLÈME(S) D'ÉTAT / SIGNE(S) OFFICIEL(S) DE
CONTRÔLE ET GARANTIE / POINÇON(S) OFFICIEL(S) DE CONTRÔLE ET
GARANTIE ADOPTÉ(S) PAR

ARMORIAL BEARINGS/ARMOIRIES



FLAG(S)/DRAPEAU(X)



STATE EMBLEM(S)/EMBLÈME(S) D'ÉTAT

--	--

OFFICIAL SIGN(S) AND/OR HALLMARKS INDICATING CONTROL AND
WARRANTY/
SIGNE(S) OFFICIEL(S) ET/OU POINÇONS OFFICIELS DE CONTRÔLE ET GARANTIE

--	--

GOODS AND/OR SERVICES/PRODUITS ET/OU SERVICES

.....
.....
.....
.....
.....
.....

[Annex II follows]

ANNEX II

Draft Request for Communication Under Article 6ter(3)(b) of the Paris Convention for the Protection of Industrial Property by an International Intergovernmental Organization

[date]

The [name of the international intergovernmental organization] has the honor to request the communication, under Article 6ter(3)(b) of the Paris Convention for the Protection of Industrial Property (Paris Convention), of the [armorial bearings], [flag], [other emblem], [abbreviation], and [name] of the [name of the international intergovernmental organization] to States party to the Paris Convention and to the Members of the World Trade Organization (WTO), not party to the said convention.

For the purpose of the above communication, the statutes and the list of the Member States of the [name of the international intergovernmental organization] are attached. Furthermore, the statutes are available on the Internet at [...].

Sincerely yours,

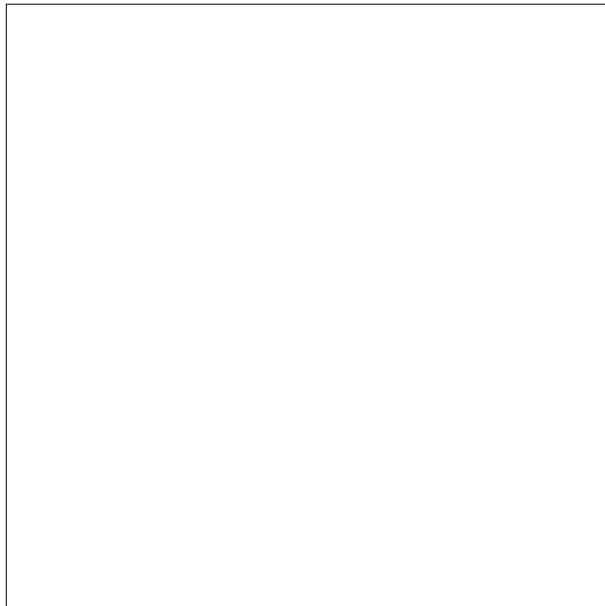
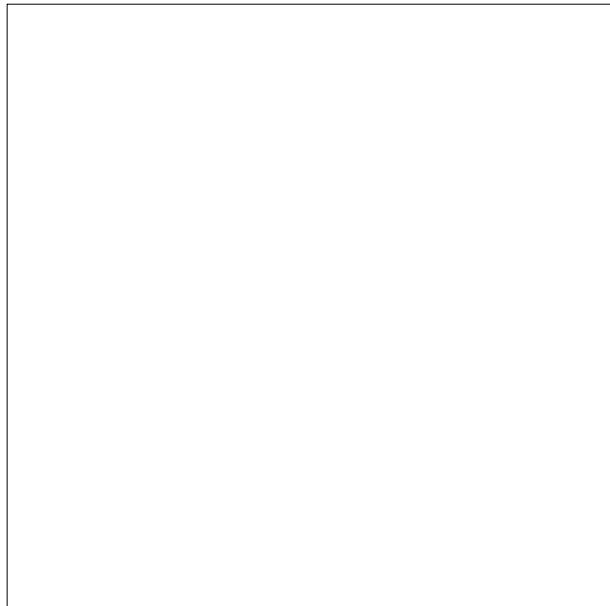
Name and signature of the Director General of the [name of the international intergovernmental organization] or any other person duly authorized by him or her.

Enclosures: 600 copies of the reproduction of the [armorial bearings], [flag], [other emblem], [abbreviation], and/or [name] of the [name of the international intergovernmental organization]; the statutes and the list of the Member States of the [name of the international intergovernmental organization].

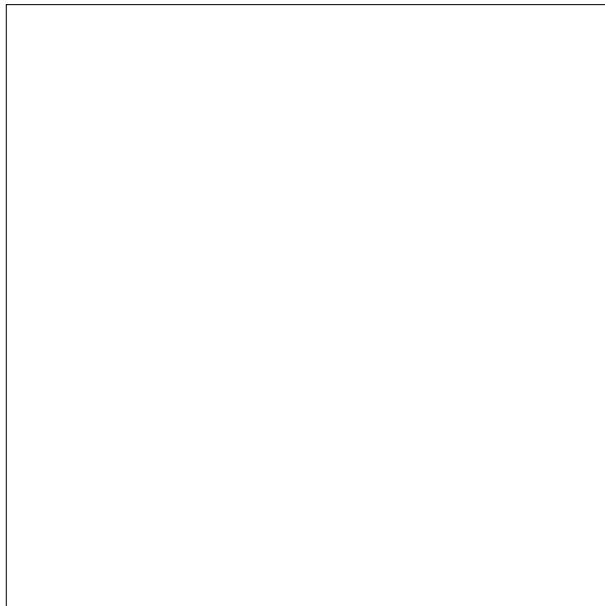
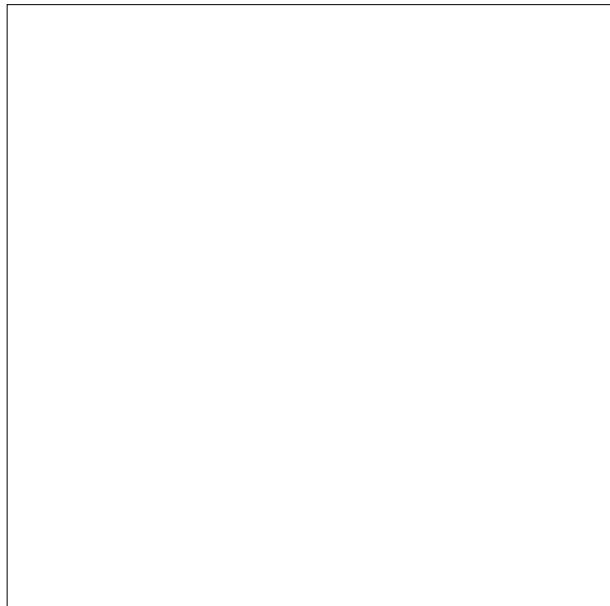
Letter to be addressed to the Director General of the World Intellectual Property Organization (WIPO), 34, chemin des Colombettes, 1211 Geneva 20, Switzerland.

ARMORIAL BEARINGS / FLAG(S) / EMBLEM(S) / NAME / ABBREVIATION
ADOPTED BY /
ARMOIRIES / DRAPEAU(X) / EMBLÈME(S) / DÉNOMINATION / SIGLE
ADOPTÉ(S) PAR.....

ARMORIAL BEARINGS/ARMOIRIES



FLAG(S)/DRAPEAU(X)



EMBLEM(S)/EMBLÈME(S)

--	--

NAME/DÉNOMINATION	LANGUAGE/LANGUE

ABBREVIATION/SIGLE	LANGUAGE/LANGUE

[Annex III follows]

ANNEX III

Draft Request for Communication Under Article 6ter(3)(b) of the Paris Convention for the Protection of Industrial Property by a Program, or an Institution Established by an International Intergovernmental Organization, or by a Convention Constituting an International Treaty

[date]

The [name of the program/institution/convention] has the honor to request the communication under Article 6ter(3)(b) of the Paris Convention of the [armorial bearings], [flag], [other emblem], [abbreviation], and/or [name] of the [name of the program/institution/convention] to States party to the Paris Convention and to the Members of the World Trade Organization (WTO), not party to the said convention. The [name of the program/institution/convention] [is a program/institution established by the {name of the international intergovernmental organization} constituting, within the said organization,] [is a convention constituting an international treaty to which one or more State members of the Paris Union are Party, and which establishes] a permanent entity having specified aims and its own rights and obligations in line with the Guidelines for the Interpretation of Article 6ter(1)(b) and (3)(b) of the Paris Convention adopted, in 1992, by the Assembly of the Paris Union.

For the purpose of the above communication, the statutes and the list of the Member States of the [name of the program/institution and name of the international intergovernmental organization] [name of the convention] are attached. Furthermore, the statutes are available on the Internet at [...].

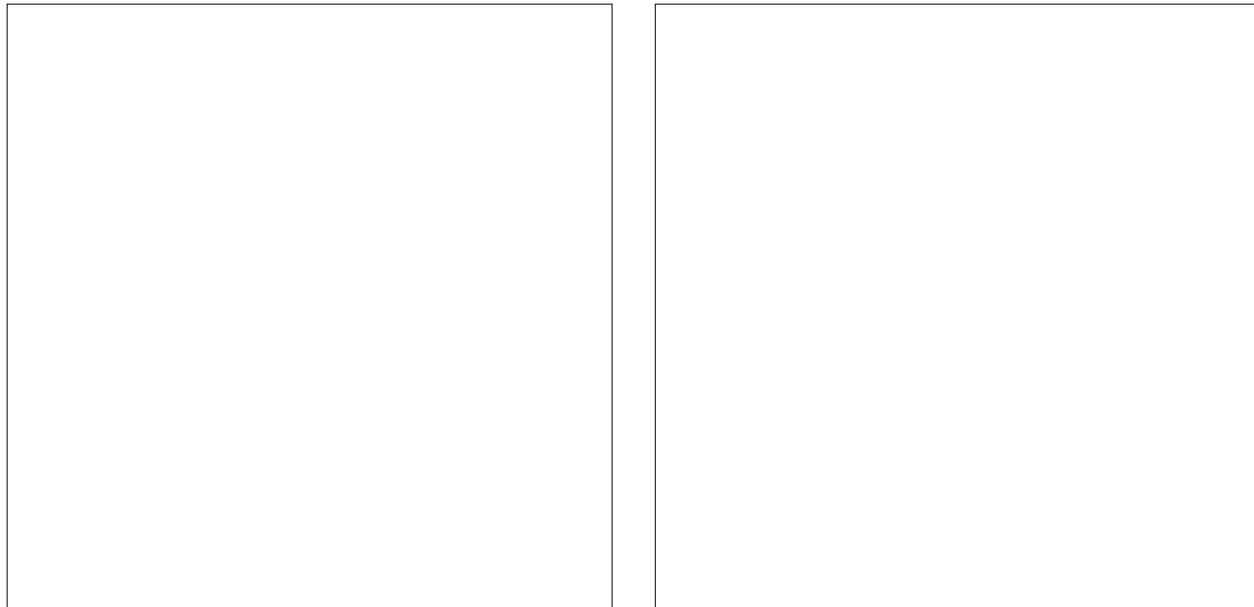
Sincerely yours,

Name and signature of the Administrative Head of the [name of the program/institution/convention], or any other person duly authorized by him or her.

Enclosures: 600 copies of the reproduction of the [armorial bearings], [flag], [other emblem], [abbreviation], and/or [name] of the [name of the program/institution/convention]; the statutes and the list of the Member States of the [name of the program/institution and name of the international intergovernmental organization] [name of the convention].

Letter to be addressed to the Director General of the World Intellectual Property Organization (WIPO), 34, chemin des Colombettes, 1211 Geneva 20, Switzerland.

EMBLEM(S)/EMBLÈME(S)



NAME/DÉNOMINATION	LANGUAGE/LANGUE

ABBREVIATION/SIGLE	LANGUAGE/LANGUE

[End of Annex III and of document]