

WIPO



SCT/21/6

ORIGINAL: English

DATE: March 30, 2009

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

E

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

Twenty-First Session
Geneva, June 22 to 26, 2009

PROPOSAL BY JAMAICA

Document prepared by the Secretariat

1. In a communication dated March 30, 2009, the Secretariat received a proposal from Jamaica relating to the Amendment of Article 6^{ter} of the Paris Convention for the Protection of Industrial Property for consideration by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), at its twenty-first session to be held in Geneva from June 22 to 26, 2009.
2. The said proposal is annexed to this document.

[Annex follows]

ANNEX

**Proposal by Jamaica
to the Standing Committee on the Law of Trademarks,
Industrial Designs and Geographical Indications**

Article 6ter

- (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.

1. The SCT will recall that during the 1980s, proposals were made to review the Paris Convention in order to broaden the scope of Article 6ter to include the protection of country names. The last proposal, regarding a full review of Article 6ter for the purpose of possible amendments, was made at a diplomatic conference held in February 1980. At that conference, under the heading of “alternative B”, a proposal was placed on the table which recommended that the term “as well as the official names of the countries of the Union” should be included under the category of areas that are to be refused for validation as registered trade marks. This would effectively lead to the expansion of Article 6ter(1)(a) to include the protection of country names.

2. Unfortunately, attempts to review Article 6ter of the Paris Convention, at the Diplomatic Conference were unsuccessful, due to the rejection of the proposal for the protection of country names by a few States.

3. The rejection of such an inclusion in Article 6ter, however, took place against the backdrop of a very different political and socioeconomic reality. Emphasis must be given to the fact that past rejection of the argument to include country names under the protection of Article 6ter(1)(a), such as was the case in 1980 (almost 30 years ago), took place under a starkly different international economic order and global trade regime. The widening and deepening of linkages amongst and between countries, as a result of globalization and trade liberalization has facilitated an increase in the trade in goods which carry unauthorized country names.

4. Jamaica is, therefore, proposing to open discussions in the forum of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) for the provision of Article 6*ter* of the Paris Convention to be amended to reflect the protection of these country names, in addition to the other categories of protection already in existence. For this purpose, therefore, Jamaica wishes to revisit elements of the previous proposal made in 1980.
5. Jamaica also wishes to propose the granting of additional protection to a State's identity by way of a further amendment of Article 6*ter* to allow for the protection of country names of the Union to include homonymous sounds of these country names. An example of this would be the official country name "Jamaica" also being protected as "Jah-mey-ka."
6. It should be noted that a discussion concerning the widening of the categories of protection under Article 6*ter* of the Paris Convention to include the protection of country names, must be approached from a holistic point of view having regard to the political, socioeconomic and legal implications of such an amendment, as well as its direct impact on a country's sustainable development and economic survival. In terms to the implications, it is evident that where country names are not protected then the danger of these names becoming generic exists. This has implications not only for the value of private trade marks but on a country's ability to properly protect their Intellectual Property generally, particularly in third countries. Countries like Jamaica that are heavily reliant on their name as a means of marketing suffer greatly when such widespread use of the name without authorization goes unchecked.
7. Based on the foregoing, Jamaica hereby formally requests that the protection of country names be added to the categories under Article 6*ter*(1)(a) of the Paris Convention, and that this matter be included as an agenda item for discussion at the twenty-first session of the Standing Committee on the Law of Trade Marks, Industrial Designs and Geographical Indications, scheduled to be held from June 22 to 26, 2009.

[End of Annex and of document]