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PROCEDURAL ASPECTS OF COMMUNICATIONS UNDER ARTICLE 6TER
OF THE PARIS CONVENTION

prepared by the Secretariat

I. INTRODUCTION

1. At the eighteenth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from November 12 to 16, 2007, the SCT requested the Secretariat to prepare a working document on procedural aspects of communications under Article 6*ter* of the Paris Convention for the Protection of Industrial Property (Paris Convention) (see document SCT/18/9, paragraph 16). This request follows up on previous work of the SCT dealing with legal, administrative and procedural aspects of the application of Article 6*ter* of the Paris Convention (see documents SCT/15/3, SCT/17/5 and SCT/18/5).
2. The communication procedures under Article 6*ter* are to a large extent exclusively paper-based. The Article 6*ter* Express on-line database and the availability of the contents of Article 6*ter* communications in XML format via a PDF server hosted on WIPO's website are features that are supplementary to the paper-based communications, and do not have any legal effect. The workload resulting from the paper-based communication procedure binds considerable personnel and financial resources.
3. Section I of this document summarizes the current procedure for communications under Article 6*ter*, as already described in detail in documents SCT/15/3, SCT/17/5 and SCT/18/5, and provides a brief analysis of its practical implications. Section II sets forth a proposal for a revised communication procedure, which would be essentially conducted through electronic means of communication, thereby rendering the current procedure more efficient. The proposed change of the current procedure will have some important consequences. It is thus suggested to submit such a proposal to the Assembly of the Paris Union for decision. The text of a draft decision to that effect is contained in Annex I to this document.

II. THE CURRENT NOTIFICATION PROCEDURE UNDER ARTICLE 6*TER*

4. In accordance with Article 6*ter*(3)(a) of the Paris Convention, the countries of the Paris Union communicate reciprocally, through the intermediary of the International Bureau, the list of emblems and signs for which protection is sought under Article 6*ter*(1)(a). The same procedure applies to armorial bearings, flags and other emblems, abbreviations and names of international intergovernmental organizations ("IGOs") which are communicated to the countries of the Union through the intermediary of the International Bureau (Article 6*ter*(3)(b)).
5. The legal and administrative aspects of communications under Article 6*ter* are described in detail in document SCT/15/3 and will not be repeated here. In essence, the States and IGOs requesting protection of signs under Article 6*ter* send to the International Bureau, for comments, a draft request for communication of such signs. Once considered in order for notification, the final request for communication, together with 600 reproductions of the signs concerned, is submitted to the International Bureau. The International Bureau communicates the sign or signs in question to all States party to the Paris Convention and, by virtue of Article 3 of the Agreement between the World Intellectual Property Organization (WIPO) and the World Trade Organization (WTO) to all Members of the WTO that are not party to the Paris Convention, but which are bound to comply with the provisions of that latter Convention.

6. By way of illustration, the International Bureau has expedited, in 2006, a total number of 12 communications (four from States and eight from IGOs), containing a total of 205 signs for which protection was requested. In 2007, the respective numbers were 11 communications (five from States and six from IGOs) concerning 84 signs.

Communications are sent by circular letters transmitting a reproduction of the sign(s), and addressed to the following recipients:

- Ministries of Foreign Affairs of the States party to the Paris Convention, as well as their respective Permanent Missions in Geneva;

- Ministries of Foreign Affairs or other competent authorities of the Members of WTO not party to the Paris Convention and their Permanent Missions in Geneva;

- industrial property administrations of States party to the Paris Convention;

- industrial property administrations of WTO Members not party to the Paris Convention;

- the Benelux Organization for Intellectual Property (OBPI) and the African Intellectual Property Organization (OAPI).

7. In sum, WIPO's Conference Service expedites 589 individual items of mail for every request of protection under Article 6*ter* received from a State or an international intergovernmental organization. For this reason, any requesting party has to provide to the International Bureau 600 reproductions of the signs for which protection under Article 6*ter* is sought, each notification including an original reproduction.

8. It is apparent that this form of mail expedition compels the International Bureau to make use of considerable resources. As regards the recipients of these communications, whether they are Ministries of Foreign Affairs of the States party to the Paris Convention or the Members of the WTO, national Offices or other administrative entities, the handling of those documents in paper format inevitably contributes to their workload.

9. Regarding the legal effect of communications under Article 6*ter*(3), Article 6*ter*(4) stipulates that "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".

10. Moreover, with a view to avoiding any retroactive effect of Article 6*ter* communications, Article 6*ter*(6) provides that the protection of a sign in accordance with Article 6*ter* only affects marks registered more than two months after the communication was received under Article 6*ter*(3). This provision, however, does not apply to State flags, for which communication under Article 6*ter* is not compulsory.

11. Consequently, the date of receipt of a given communication under Article 6ter(3) determines the starting date for the calculation of the 12-month objection period under Article 6ter(4), as well as the two-month period under Article 6ter(6). Due to varying postal delivery times throughout the countries of the Paris Union and the Members of the WTO, the starting dates of those time-limits vary from one country to another. In any event, they are not reported to the International Bureau or centrally published.

12. Modern communication technology, already widely used in all areas of industrial property administration, would appear to lend itself also to the modernization of the Article 6ter communication procedure, which has remained unchanged for almost one century. This procedure concerns nearly 600 recipients of official signs for which protection is requested. It is therefore important to render it more efficient and cost-effective by using modern means of communication. Not at least, it would be desirable that the time-limit for objection to Article 6ter communications as well as for the effect of such communications against trademark registrations be computed in a uniform manner. This would contribute to the transparency of those procedures, and be of advantage for the beneficiaries of Article 6ter protection (States and IGOs) and holders of conflicting rights.

13. Section III presents a proposal for the introduction into the current paper-based Article 6ter communication procedure of electronic means of communication. The administration of the actual communication procedure is largely based on the text of Article 6ter itself, a decision by the Paris Union Assembly concerning Guidelines for the Interpretation of Article 6ter(1)(b) and (3)(b) and the administrative practice of the International Bureau. As the proposed changes to the current procedure may entail important consequences – legal as well as administrative – it would appear appropriate that such changes be endorsed by a decision of the Paris Union Assembly, which should be based on a recommendation by the SCT.

III. PROPOSAL FOR THE MODERNIZATION OF THE ARTICLE 6TER COMMUNICATION PROCEDURE THROUGH THE INTRODUCTION OF ELECTRONIC MEANS OF COMMUNICATION

14. This portion of the document sets out a proposal for the modernization of the communication procedures under Article 6ter, and describes the advantages that would result from such procedures. To begin with, it is proposed to replace the actual communication in the form of paper circular letters with a periodical electronic publication of the signs for which protection under Article 6ter is requested (part A). In addition, signs that are published periodically will be recorded in electronic format on a physical carrier to allow their dissemination to users who prefer to receive them in this way (part B). Finally, the proposed procedure will also entail advantages for requesting parties (part C).

A. Replacement of the Paper Circulars by a Periodical Electronic Publication

15. Under the proposal put forward in this document, individual communications of signs for which protection under Article 6ter is requested by States and IGOs and that are currently expedited in an *ad hoc* manner will be replaced by a periodical electronic publication in the Article 6ter Express database. For details concerning that database, reference is made to the following webpage: <http://www.wipo.int/ipdl/en/search/6ter/search-struct.jsp>. A short text,

specifying the nature of the signs concerned as well as the entity (State or IGO) having requested their protection, would be published, in English and French, together with the individual reproductions of the signs concerned.

16. It is proposed to make this publication semi-annually, on the last working day of the months of March and September, respectively, starting in March 2009. A link to the most recent communications will be inserted into the database, which will indicate the publications of communications that were received by the International Bureau during the previous six months. Following the first publication of signs protected under Article 6*ter*, the sending of individual paper communications will be discontinued. Consequently, the publication of the signs concerned at the proposed semiannual dates will be deemed to constitute the date of receipt of the communication by individual States party to the Paris Convention and Members of the WTO not party to the Paris Convention.

17. The creation of a fictional date of receipt for an Article 6*ter* communication by a country of the Paris Union or a WTO Member as being the date on which the periodical electronic communication has occurred has legal consequences. In particular, the time periods provided for in Article 6*ter*(4) and (6) of the Paris Convention should be calculated as from that date of publication for all receiving States party to the Paris Convention and WTO Members not party to the Paris Convention. By consequence, this date will be identical for all States and WTO Members concerned.

18. As regards the publication of the contents of Article 6*ter* communications, this is currently incumbent on the countries of the Paris Union (see Article 6*ter*(3)(a) *in fine*). The present proposal does not intend to amend or abolish this requirement. Nevertheless, individual publications at the national level could be made, for example, through a simple reference to the periodic publication, by WIPO, of newly protected signs.

B. Recording of the Protected Signs in Electronic Format on Hard Carrier and Their Dissemination

19. In addition to the publication of the signs in the Article 6*ter* Express database, the content of such publications will be made available on hard carrier, e.g. on CD-ROM, containing the latest version of the Article 6*ter* Express database. This would allow recipients expressing a preference to that effect, to receive new communications in electronic format on a physical support.

20. CD-ROMs would be sent simultaneously with the electronic publication on the Article 6*ter* Express database. However, only the publication date of the reproductions in the database would have legal effect for the determination of the “date of receipt” of the communication, in accordance with Article 6*ter*(4) and (6).

C. Advantages for Requesting Parties

21. The proposed changes in the Article 6*ter* communication procedure will also have consequences for requesting parties (States and IGOs alike). Most importantly, it will no longer be required that requesting parties submit 600 paper copies of protected signs for distribution. Instead a single paper copy will be submitted to the International Bureau, which the International Bureau will scan it for inclusion in the Article 6*ter* database. Alternatively, representations of signs for which protection is requested can be submitted in an electronic format.

IV. CONCLUSION

22. The procedure for a semiannual electronic communication of Article 6*ter* communications, supplemented by the optional distribution of that publication in electronic format on hard carrier will considerably simplify the administration of Article 6*ter* communication procedures, both for the International Bureau and national and regional trademark registration administrations. It is expected that the proposed change of procedures will result in savings for the trademark registration administrations of receiving parties, requesting parties and the International Bureau of WIPO. Furthermore, it will enhance the legal security for all parties concerned of Article 6*ter* communications, as the semiannual publication dates will create generally applicable starting points for the calculation of the time periods under Article 6*ter*(4) and (6).

23. The SCT is invited to consider the present document and to decide whether it wishes to recommend the draft decision contained in Annex I, in its actual or in an amended form, for adoption by the Assembly of the Paris Union.

[Annexes follow]

ANNEX I

Draft decision by the Assembly of the Paris Union

1. The reciprocal communication through the intermediary of the International Bureau, under Article 6ter(3)(a) and (b) of the Paris Convention for the Protection of Industrial Property (“Paris Convention”), of signs that are protected under Article 6ter(1)(a) and (b) will be made through a biannual publication, in an electronic database on the website of the World Intellectual Property Organization (“WIPO”).
2. This periodical publication will be made on the last working day of the months of March and September, respectively, starting in March 2009.
3. The published signs will be transmitted simultaneously in electronic format stored on a hard carrier to the trademark registration administrations of the States party to the Paris Convention and the Members of the World Trade Organization (WTO) that are not party to the Paris Convention, which have made an express request to that effect.
4. For the purposes of Article 6ter(4) and (6) of the Paris Convention, the date of the electronic publication shall be considered to constitute the date of receipt of a communication by a country of the Paris Union or a Member of the WTO not party to the Paris Convention.
5. This decision is without prejudice to the application of Article 6ter(3)(b) *in fine*.

[Annex II follows]

ANNEX II

TEXT OF ARTICLE 6^{TER} OF THE PARIS CONVENTION

Article 6^{ter}

[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”.

[End of Annex II and of document]