

**UNITED STATES
PATENT AND TRADEMARK OFFICE**





**Protection systems for official designations:
Article 6ter of Paris Convention and U.S. laws
protecting national trademarks and certification marks**

Office of Policy and International Affairs

UNITED STATES
PATENT AND TRADEMARK OFFICE



Article 6ter of Paris Convention

(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.”

Article 6ter of Paris Convention

(1)

“(b) The provisions of subparagraph (a), above, shall apply equally to **armorial bearings, flags, other emblems, abbreviations, and names**, of international **intergovernmental organizations [IGO]** 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.”

Example of exception: “Red Cross” and emblems protected by the Geneva Convention of August 12, 1949



Article 6ter

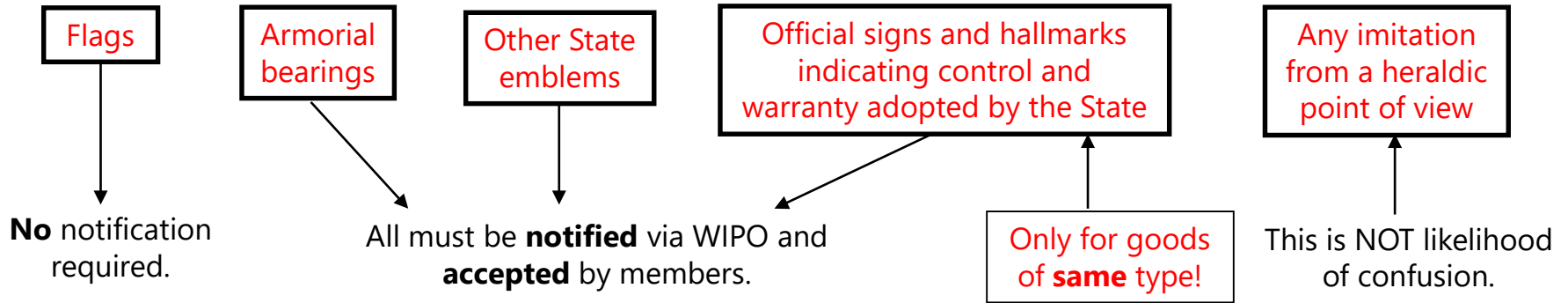
- To clarify certain aspects of Article 6ter(1)(b) and (3)(b), in 1992, the Assembly of the Paris Union adopted the **Guidelines for the Interpretation of Article 6ter(1)(b) and (3)(b)**.
 - www.wipo.int/article6ter/en/legal_texts/guidelines.html
- In applying these guidelines, “any program or institution 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.”
 - From WIPO website

Article 6ter

- Purpose of Article 6ter:
 - Contracting countries agree to **protect (by refusing or invalidating registration and prohibiting unauthorized use)** armorial bearings, flags, and other state emblems of the member countries, official signs and hallmarks indicating control and warranty adopted by member countries, and any imitation from a heraldic point of view.
 - Protection as an official sign indicating control and warranty is more limited than protection as a State emblem. Article 6ter(2) 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."
- Rationale for Article 6ter:
 - Registration or use would violate the right of the state to control the use of symbols of its sovereignty and might mislead the public with respect to the origin of the goods on which such marks would be applied.

Article 6ter

Article 6ter 1(a): "...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."



State emblems frequently contain symbols that are **common, such as a lion, a bear, or the sun**, which it must be possible to **freely adopt** in trademarks **unless** the imitation of the emblem concerns the heraldic characteristics that distinguish one emblem from another.

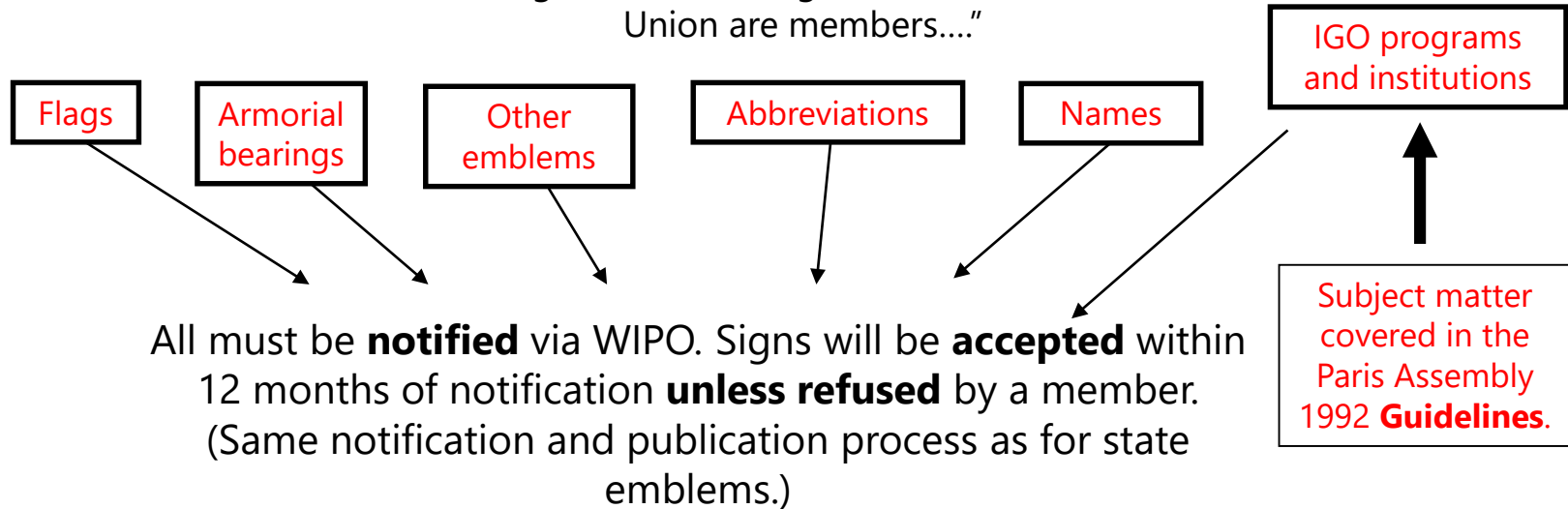
Armorial bearings, coats of arms, other insignia

- **Armorial bearings** of states → protection against registration or use as trademarks
 - but also protection against any unauthorized use in trade if the use is misleading as to the origin of the goods (e.g., use as decoration, not as trademarks).

This would typically arise **outside** trademark (TM) ex parte examination – civil action in court for unfair competition.

Article 6ter

Article 6ter 1(b): "...shall apply equally to armorial bearings, flags, and other emblems, abbreviations, and names, of international intergovernmental organizations of which one or more countries of the Union are members...."



Refusals/invalidations/use prohibitions as to IGO emblems, abbreviations, names, etc., are limited to **only** those which would **mislead the public** as to the existence of a connection between the user and the organization.

**Examples of armorial bearings, flags,
signs, hallmarks, and other emblems**

Examples of armorial bearings/coat of arms

Emblem of Thailand
ตราแผ่นดินของไทย



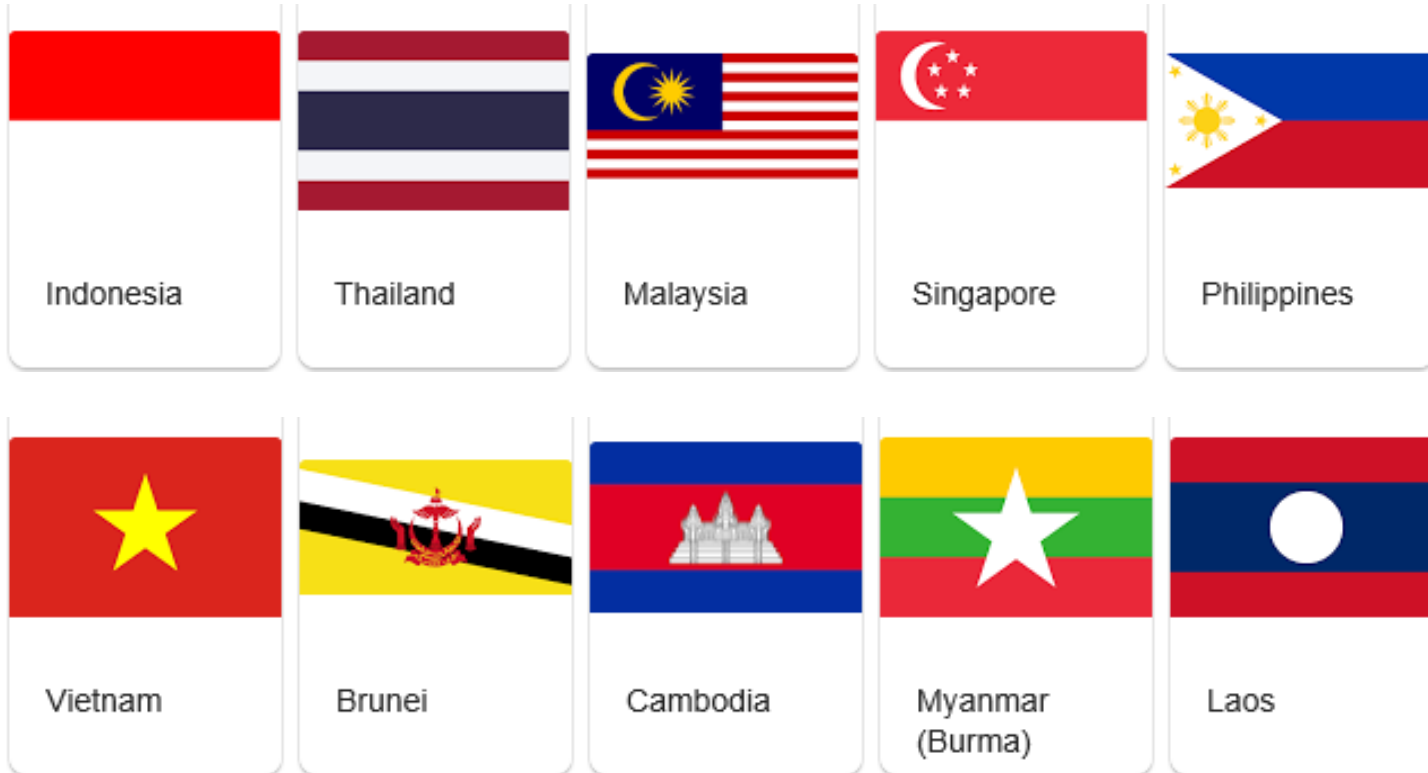
Coat of arms of Singapore



Coat of arms of the Philippines
Sagisag ng Pilipinas



Examples of flags



Examples of signs, hallmarks, and other emblems



National Emblem of the Socialist Republic of Viet Nam



National Emblem of the Lao People's Democratic Republic



Examples of U.S. signs, hallmarks, and other emblems

Great seal of the United States



Coat of arms of the United States



Seal of the President of the United States

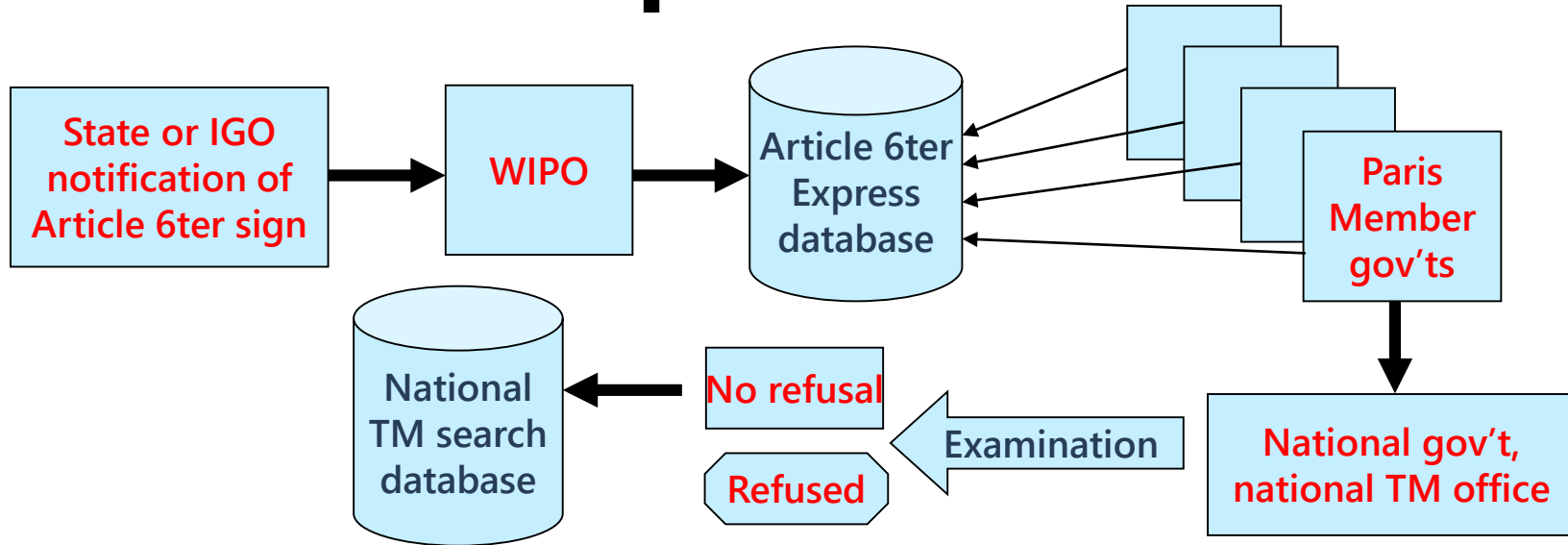


Official seal of a U.S. government agency—Department of Commerce



Article 6ter–international model and WIPO notification process

Notification process



- **States communicate** Article 6ter signs to WIPO on a special form, identifying the nature of the sign and contact details for more information.
- **WIPO publishes** signs in the **Article 6ter Express** twice a year.
- **Members access** WIPO Article 6ter Express database and determine whether to **refuse** the notifications within **12 months** from WIPO's publication date.
 - If not refused → images can be uploaded into national TM search database.

Article 6ter Structured Search

[Simple Search]

This facility allows you to search the 3888 documents contained in the 6ter data collection. The last data update occurred on: 31.03.2020.

Documents of the last publication (31.03.2020)

> Sort Results:

Chronologically Relevance

>

Search

OR	<input type="checkbox"/>	Abbreviation	=	<input type="text"/>
OR	<input type="checkbox"/>	Name	=	<input type="text"/>
OR	<input type="checkbox"/>	Details	=	<input type="text"/>
AND	<input type="checkbox"/>	State	=	<input type="text"/> <input type="button" value="v"/>
AND	<input type="checkbox"/>	Organization	=	<input type="text"/>
AND	<input type="checkbox"/>	Category	=	<input type="text"/> <input type="button" value="v"/>
AND	<input type="checkbox"/>	Pub. Date	<input checked="" type="radio"/> All <input type="radio"/>	From <input type="text"/> <input type="button" value="v"/> To <input type="text"/> <input type="button" value="v"/>
AND	<input type="checkbox"/>	Circular Number	=	<input type="text"/>
AND	<input type="checkbox"/>	Vienna Classification	=	<input type="text"/>
AND	<input type="checkbox"/>	Objection	=	<input type="text"/> <input type="button" value="v"/>

> Display Options

WIPO Article 6ter structured search

www.wipo.int/ipdl/en/6ter/search-struct.jsp

Link to see
recently
published
list of
notifications.

uspto

Searching SIXTER...

[Search Summary]

Results of searching in SIXTER for:

CD/2020/3/31->2020/7/30: 25 records

Showing records 1 to 25 of 25 :

Refine Search

No.	Title
1.	(SG27) State emblem
2.	(QQ2047) بروتوكول القضاء على الاتجار غير المشروع بمنتجات التبغ
3.	(QQ2046) 消除烟草制品非法贸易议定书
4.	(QQ2045) Protocole pour éliminer le commerce illicite des produits du tabac
5.	(QQ2044) Первая сессия Совещания Сторон Протокола о ликвидации незаконной торговли табачными изделиями
6.	(QQ2043) Protocolo para la Eliminación del Comercio Ilícito de Productos de Tabaco
7.	(QQ2042) Protocol to Eliminate Illicit Trade in Tobacco Products
8.	(QQ2041) Protocol to Eliminate Illicit Trade in Tobacco Products
9.	(QQ2040) RC
10.	(QQ2039) Rotterdam Convention on the Prior Informed Consent Procedure for Certain Hazardous Chemicals and Pesticides in International Trade
11.	(QQ2038) BRS Conventions
12.	(QQ2037) BC
13.	(QQ2036) Stockholm Convention on Persistent Organic Pollutants
14.	(QQ2035) Basel Convention on the Control of Transboundary Movements of Hazardous Wastes and their Disposal
15.	(QQ2034) Basel, Rotterdam and Stockholm Conventions on the Control of Transboundary Movements of Hazardous Wastes and their Disposal, on the Prior Informed Consent Procedure for Certain Hazardous Chemicals and Pesticides in International Trade and on Persistent Organic Pollutants
16.	(QQ2033) GGGI
17.	(QQ2032) 글로벌녹색성장연구소
18.	(QQ2031) Global Green Growth Institute
19.	(QQ2030) Global Green Growth Institute
20.	(QQ2029) The Vienna Convention for the Protection of the Ozone Layer and its Montreal Protocol on Substances that Deplete the Ozone Layer
21.	(QQ2028) OIML
22.	(QQ2027) Organisation Internationale de Métrologie Légale
23.	(QQ2026) International Organization of Legal Metrology
24.	(QQ2025) International Organization of Legal Metrology
25.	(QQ2024) Organização Internacional do Trabalho

WIPO Article 6ter published list

www.wipo.int/cgi-6te/ilist5?ENG+SIXTER+15-00+0-REVERSE+1+F+1+1+SEP-0/HITNUM,B+25+CD%2f2020/3/31->2020/7/30

Date range
and number
of records.

Sign up for WIPO
email alerts to receive
notifications
automatically.

WIPO Article 6ter notification objection

www.wipo.int/cgi-6te/ifetch5?ENG+SIXTER+15-00+21624175-KEY+256+0+-1+F-ENG+14+14+1+25+SEP-0/HITNUM,B+CC%2fES

6ter Number:	ES1
State:	Spain
6ter Category:	Official sign / Hallmark
Goods:	Official warranty sign for export promotion "SPANIA" (Eng) Signe officiel de garantie pour la promotion des exportatio "SPANIA" (French)
Circular Date:	02.03.1971
Circular Number:	1201
Details:	SPANIA (Spanish; Castilian)
Vienna Classification:	24.03.01, 24.03.02, 24.03.07, 24.03.18, 29.01.01, 29.01.0 29.01.13
Objections:	Germany - 31.05.1972



uspto

Article 6ter–U.S. implementation

USPTO practice for reviewing Article 6ter notifications

- Search: The USPTO searches its trademark database for marks that conflict with the Article 6ter notification (similar to likelihood of confusion search).
 - The USPTO does not conduct full examination or publish notification for opposition.
- Accept/Refuse: The USPTO accepts or refuses the Article 6ter notification.
 - Accept:
 - Notification is assigned a serial number beginning with “89” (sometimes referred to as “non-registrations”).
 - Notification information is entered in the USPTO trademark search database and should be discovered in conflicting mark searches.
 - Refuse:
 - Issue a letter stating the reasons/basis for refusal of notification.

USPTO Article 6ter examination checklist

6ter Number(s):	
6ter Category:	armorial bearing, flag, State emblem, official sign or hallmark indicating control and warranty adopted by a Paris Union country, name/abbreviation/emblem of IGO
Organization Name:	
Organization Type:	Country/IGO/IGO Program or Institute/Treaty
Official armorial bearing, flag, or State emblem?	
Consists of 1 or more Paris Union Member?	
IGO Program or Institution/International Convention or Treaty with 1 or more States who are members of Paris Union	
Permanent entity established for an indefinite period of time; thus entities established to promote a particular issue or celebrate a special event within a limited period of time (for example, programs such as "year of ...") are excluded.	
Specified aims - 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 - 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.	



USPTO Article 6ter examination checklist cont'd


Search:		Cites?	
Prior Notifications?		Accepted?	
Date(s) <u>Accpt.</u> <u>Notif.</u>			
Final Disposition:			
Refusal Grounds:			
Date Letter(s) Drafted:			
Date Letter(s) Sent:			

USPTO guidelines on reviewing Article 6ter notifications

Reasons/grounds for refusal:

- Is not an emblem of the State or IGO;
- Is not an official sign or hallmark of the state indicating warranty and control;
- Is already an emblem of the country reviewing the notification;
- Was communicated as that of another country;
- Has fallen into the public domain in the United States;
- Would be likely to cause confusion with a mark previously registered in the United States by another, or to cause mistake or to deceive;
- Is an official sign or hallmark indicating control and warranty but does not identify the goods and services to which the subject of the notification is applied;
- If the sign is registered or used in commerce as a mark, it is not appropriate for Article 6ter.

Example: Article 6^{ter} notification accepted and added into USPTO database

Mark Type:		
TM5 Common Status Descriptor:		OTHER
Status:	This serial number identifies non-registration matter in the USPTO database.	
Status Date:	Jun. 13, 2008	
▼ Mark Information ▼ Expand All		
Mark Literal Elements:	HONI SOIT QUI MAI Y PENSE DIEU ET MON DROIT	
Standard Character Claim:	No	
Mark Drawing Type:	3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)	
Description of Mark:	The Royal Arms of Her Majesty Queen Elizabeth II in use in England, Wales and Northern Ireland.	
Design Search Code(s):	03.01.02 - Lion insignia (heraldic lion) 04.05.04 - Unicorns 05.05.03 - Fleur-de-lis 09.03.13 - Belts, clothing; Beltbuckles (Belt buckles); Belts, Weight lifting; Buckles, belt or shoe; Jump ropes 22.01.07 - Fiddles (musical instrument); Autoharps; Harp; Mandolins; Violins 24.01.02 - Shields or crests with figurative elements contained therein or superimposed thereon 24.09.07 - Banners; Advertising, banners 24.11.01 - Crowns closed at the top 26.01.08 - Letters, numerals or punctuation forming or bordering the perimeter of a circle; Circles having punctuation as a border; Circles having letters or numerals as a border	
▼ Goods and Services		
For:	No Description Entered	
International Class(es):	001, 002, 003, 004, 005, 006, 007, 008, 009, 010, 011, 012, 013, 014, 015, 016, 017, 018, 019, 020, 021, 022, 023, 024, 025, 026, 027, 028, 029, 030, 031, 032, 033, 034, 035, 036, 037, 038, 039, 040, 041, 042, 043, 044, 045	U.S. Class(es): 001, 002, 003, 004, 005, 006, 007, 008, 009, 010, 011, 012, 013, 014, 015, 016, 017, 018, 019, 020, 021, 022, 023, 024, 025, 026, 027, 028, 029, 030, 031, 032, 033, 034, 035, 036, 037, 038, 039, 040, 041, 042, 043, 044, 045, 046, 047, 048, 049, 050, 051, 052, 100, 101, 102, 103, 104, 105, 106, 107, 200, A, B - Primary Class
Class Status:	ACTIVE	
Basis:	Basis Not Found	
▼ Current Owner(s) Information		
Owner Name:	Government of the United Kingdom	
Owner Address:	C/O Wipo 34 Chemin des Colombettes Geneve 20 SWITZERLAND 1211	
Legal Entity Type:	GOVERNMENT OF THE UNITED KINGDOM	State or Country Where Organized: UNITED KINGDOM



Example: Article 6ter notification refused; not added into USPTO database

6ter Number: FR4
State: France
Address: Service d'information du Gouvernement 19 rue Constantine
Paris
75007
France
6ter Category: Armorial bearings
Publication Date: 31.03.2016
Vienna Classification: 02.03.01, 02.03.04, 02.03.16, 29.01.01, 29.01.04, 29.01.06
Objections: China - 30.03.2017



- www.wipo.int/cgi-6te/ifetch5?ENG+SIXTER+15-00+21599092-KEY+256+0+686+F-ENG+120+120+101+25+SEP-0/HITNUM,B+CD%2f01%2f03%2f2016%2d%3e31%2f03%2f2016
- Reason for rejection: sign identified a government-owned, commercially used service mark for a lower public body that provides information to the public concerning government actions.

Example: Article 6ter notification refused; not added into USPTO database

6ter Number: IT40
State: Italy
Address: Ministry of Defence Italian Air Force Viale dell'Universita no 4
Rome
00185
Italy
6ter Category: Armorial bearings
Publication Date: 31.03.2016
Vienna Classification: 18.05.01, 18.05.03, 23.01.05, 24.01.05, 24.15.01, 29.01.01,
29.01.02, 29.01.03, 29.01.04



- www.wipo.int/cgi-6te/ifetch5?ENG+SIXTER+15-00+21599092-KEY+256+0+1022+F-ENG+112+120+101+25+SEP-0/HITNUM,B+CD%2f01%2f03%2f2016%2d%3e31%2f03%2f2016+
- **Reasons for rejection:**
 1. Sign identified a government-owned, commercially used service mark for a lower public body—Italian military's aerobatic demonstration team; and
 2. Italy owns a U.S. trademark registration (under Madrid Protocol) for the same sign, which demonstrates the commercial nature of the mark: it identifies a service and is not a symbol of the sovereignty of a state.

Example: Article 6ter notification refused; not added into USPTO database

- Reasons for reiection – continued:

US Serial Number:	79098331	Application Filing Date:	Dec. 17, 2010
US Registration Number:	4058328	Registration Date:	Nov. 22, 2011
Register:	Principal		
Mark Type:	Trademark		
TM5 Common Status Descriptor:	LIVE/REGISTRATION/Issued and Active		
	The trademark application has been registered with the Office.		
Status:	A partial Section 71 declaration has been accepted.		
Status Date:	Jun. 13, 2018		
Publication Date:	Sep. 06, 2011		



▼ Goods and Services			
For:	[Protective helmets for sports and industry, spectacles, spectacle frames, spectacle chains]		
International Class(es):	009 - Primary Class	U.S Class(es):	021, 023, 026, 036, 038
Class Status:	SECTION 71 - CANCELLED		
Basis:	66(a)		
For:	[Trunks,] traveling bags [and umbrellas, and goods made of leather or imitations of leather, namely, handbags, suitcases, clutch bags, vanity cases sold empty, purses, billfolds, attache cases, wallets, briefcases, key-cases, business and credit card cases]		
International Class(es):	018 - Primary Class	U.S Class(es):	001, 002, 003, 022, 041
Class Status:	ACTIVE		
Basis:	66(a)		
For:	Clothing, namely, [shorts,] shirts, pants, [tops; coats, mantles, raincoats, dusters, furs, dresses, suits, skirts,] jackets, bomber jackets, [overcoats,] polo knit tops, [skirts and dresses,] polo shirts; [pullovers;] knitwear, namely, knit shirts, knitted caps [and knitted underwear] ; trousers, [shorts sets,] bermuda shorts, [jeans, bermuda jeans, waistcoats,] T-shirts, [vests, blouses, jerseys,] sweaters, sweat shirts, sweat suits, [turtleneck sweaters, blazers, cardigans, underwear, corsets, brassiere, underpants, nightgowns, pajamas, bathrobes,] bathing suits [beach wraps, sun suits, sport jackets]; waterproof clothing, namely, [waterproof jackets and pants, wind-resistant jackets, anoraks, sleepwear, suspenders, ties, neckties, scarves, shawls, mufflers, foulards,] caps, [hats, hoods, gloves, sashes, belts,] footwear, namely, [beach footwear,] sports shoes, boots, shoes [and slippers, sandals and beach shoes] ; clothing of leather, namely, [pants, coats, skirts, trousers,] jackets, [coats, fur lined coats; dressing gowns,] caps being headwear [cap peaks; ear muffs being clothing, cyclists' clothing, namely, shorts and jerseys; leggings]		
International Class(es):	025 - Primary Class	U.S Class(es):	022, 039
Class Status:	ACTIVE		
Basis:	66(a)		

▼ Current Owner(s) Information			
Owner Name:	AERONAUTICA MILITARE - STATO MAGGIORE		
Owner Address:	Viale dell'Universita', 4 I-00185 ROMA ITALY		
Legal Entity Type:	federal agency	State or Country Where Organized:	ITALY



Protection of Article 6ter notified designations–U.S. model

USPTO practice of reviewing Article 6ter notifications

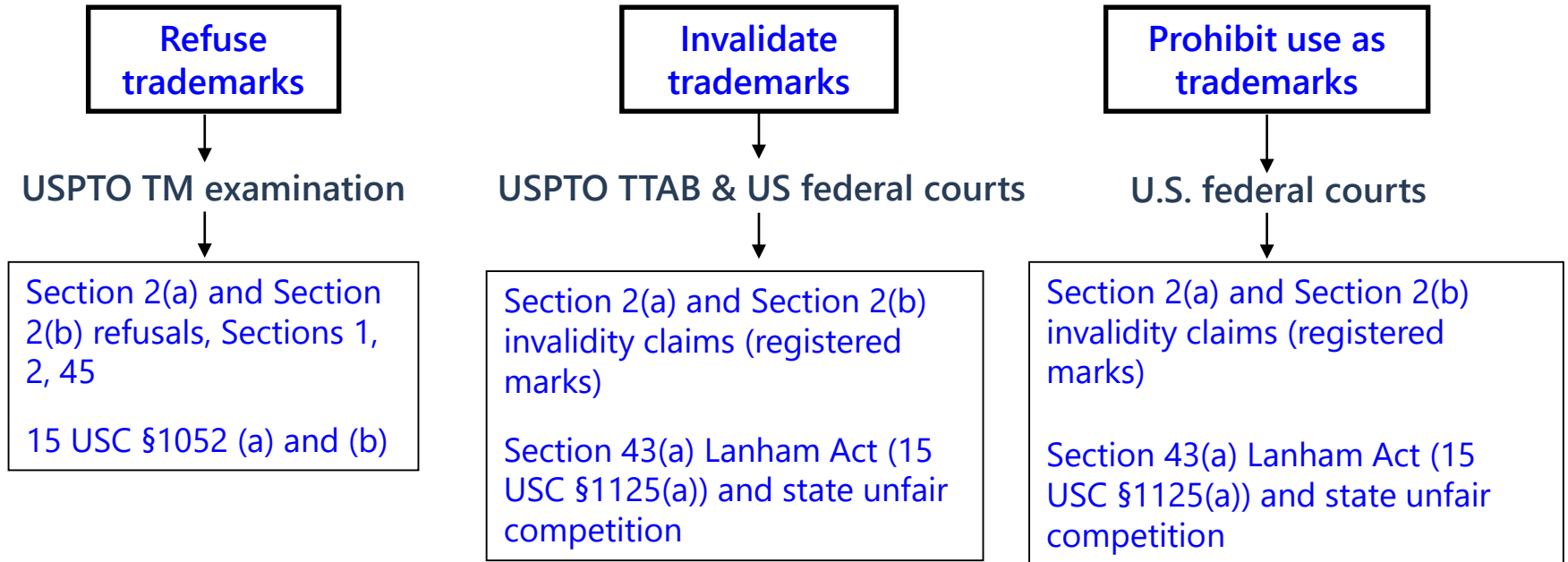
- Paris Convention is not self-executing.
- There is no independent cause of action in the United States under Paris Convention or under Article 6ter of Paris Convention.
- Article 6ter notifications provide examiners information as to what states and IGOs are claiming as state and IGO emblems.

Article 6ter: U.S. obligation to prevent TM registration and use


- Paris Convention requires the U.S. "to refuse or to invalidate the registration" of Article 6ter state emblems.
- The U.S. meets this obligation through:
 - Ex parte examination process at USPTO; and
 - If the USPTO examining attorney does not refuse → interested party may oppose or cancel the mark.
 - Inter partes cases filed by interested party.

Article 6ter: U.S. obligation to prevent TM registration and use

Article 6^{ter} 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..."



Trademark Trial and Appeal Board (TTAB) and federal court cause of action

- Section 43 (15 USC §1125):
 - Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—
 - (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person...
 - shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.
- 
- Unregistered trademark infringement, federal unfair competition and false advertising (not limited to use as a trademark, but any use in trade).
 - Injunctive relief is available. State law unfair competition claims might also be available.

USPTO examination refusals

- The USPTO **does not** refuse based on Article 6ter notification.
- The USPTO **does not** refuse based on Section 2(d) likelihood of confusion.
- U.S. implements Article 6ter via Sections 2(b) and 2(a), so the USPTO **does refuse** on these two grounds:
 - Section 2(b): designation conflicts with a State emblem; and, if relevant
 - Section 2(a): designation is misleading or presents a false connection as to the source (as to a governmental entity or IGO).
- Other countries may have different practices.

U.S. Trademark Act, **Section 2** (15 USC §1052)

No trademark by which the goods of the applicant may be distinguished from the goods of others **shall be refused registration** on the principal register on account of its nature **unless it:**

Section 2(a)

Consists of or comprises immoral, **deceptive**, or scandalous matter; or matter which may disparage or **falsely suggest a connection** with persons, living or dead, **institutions**, beliefs, or **national symbols**, or bring them into contempt, or disrepute....

35 See TMEP §1203.03, et seq.

Section 2(b)

Consists of or comprises the **flag or coat of arms or other insignia** of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

See TMEP §1204



§2(a): deceptive or false connection

- Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute....
- Government agencies and instrumentalities are included in definition of "person."
- Registration is refused if the mark, the goods/services and the impact on consumers of such use convey a false connection to the U.S. government.
 - U.S. government agency or instrumentality would be presumed to be the source or sponsorship of the applicant's goods/services.

§2(a): deceptive or false connection

- Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute....
- National symbols:
 - Because of its meaning, appearance, and/or sound, national symbol immediately suggests or refers to the country for which it stands.
 - “[A]re more enduring in time, . . . and immediately conjure up the image of the country as a whole.” *In re Consol. Foods*, 187 USPQ 63, 64 (TTAB 1975).
 - Includes symbols of foreign countries and the United States.
 - Not the same as “insignia” of nations, mentioned in §2(b).
 - U.S. trademark law allows registration of national symbols but only if NOT used to falsely suggest connection between mark owner and the national symbol.
 - Other U.S. laws protect many names, acronyms, titles, terms, and symbols.

§2(a): deceptive or false connection

- Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute....
- Examples of national symbols:
 - Bald eagle;
 - Statue of Liberty;
 - Designation "Uncle Sam" and the unique human representation thereof;
 - Heraldry and shield designs used in governmental offices;
 - Certain uses of the letters "U.S."
- Examples of names that are not national symbols:
 - Name of a country or use of the name of a country as a mark, by itself;
 - Common names of, and acronyms for, government agencies and instrumentalities.

§2(a) examples–national symbols: USPTO not refused

- Designations held not national symbols:
 - HOUSE OF WINDSOR not a national symbol of England, but merely the name of its present reigning family (*W. H. Snyder & Sons, Inc. v. Ladd*, 227 F. Supp. 185, 140 USPQ 647 (D.D.C. 1964)).
 - MOHAWK not suggestive of the United States and not a national symbol (*In re Mohawk Air Serv. Inc.*, 196 USPQ 851, 854 (TTAB 1977)).
 - UNION JACK, used on packages of frozen fish marked "English cut cod" and in its restaurant near representations of the British national flag, does not suggest a particular country (*In re Gen. Mills, Inc.*, 169 USPQ 244 (TTAB 1971)).
 - Portion of the Statue of Liberty does not falsely suggest a connection with the Statue of Liberty or the United States government, the Court "[a]ssuming without deciding" that the statue is a national symbol (*Liberty Mut. Ins. Co. v. Liberty Ins. Co. of Texas*, 185 F. Supp. 895, 908, 127 USPQ 312, 323 (E.D. Ark. 1960)).

§2(a) examples–false connection: USPTO refused

- NATIONAL INTELLIGENCE ACADEMY, for educational and instructional services in intelligence gathering for law enforcement officers, falsely suggests connection with U.S. government; intelligence gathering and training of officers in intelligence gathering is a function of government agencies (*In re Nat'l Intelligence Acad.*, 190 USPQ 570, 572 (TTAB 1976)).
- U. S. AQUA and design, for canned drinking water, falsely suggests connection with U.S. government; purchasers would mistakenly assume approval or sponsorship by the U.S. government given the mark, including a red, white, and blue shield design, the goods and record evidence of a program for stocking emergency supplies of water in fallout shelters and the setting of standards for drinking water by U.S. government agencies (*In re Teasdale Packing Co.*, 137 USPQ 482 (TTAB 1963)).
- SYDNEY 2000, for advertising and business services and communication services, falsely suggests connection with Olympic Games, since general public would recognize phrase as referring unambiguously to Olympic Games to be held in Sydney, Australia, in 2000; entire organization that comprises Olympic games qualifies as "institution" (*In re Urbano*, 51 USPQ2d 1776 (TTAB 1999)).

§2(a) examples–false connection: USPTO not refused

- NOTRE DAME and design, for cheese, does not falsely suggest connection with the University of Notre Dame. "‘Notre Dame’ is not a name solely associated with the University. It serves to identify a famous and sacred religious figure and is used in the names of churches dedicated to Notre Dame, such as the Cathedral of Notre Dame in Paris, France. Thus it cannot be said that the only ‘person’ which the name possibly identifies is the University and that the mere use of NOTRE DAME by another appropriates its identity" (*Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1377, 217 USPQ 505, 509 (Fed. Cir. 1983), *aff’g* 213 USPQ 594 (TTAB 1982)).
- APOLLO 8, for moth preventatives and mothproofing agent-air freshener, does not falsely suggest connection with NASA; while NASA is a juristic person and prior user of the terms APOLLO and APOLLO 8 for its space missions, it is unlikely that purchaser of applicant’s goods would assume NASA to be source or sponsorship of the goods or mistakenly believe that the goods are of NASA space exploration technology (*NASA v. Record Chem. Co. Inc.*, 185 USPQ 563 (TTAB 1975)).
- FBI FABRICATION BRIL INTERNATIONAL, for clothing, does not falsely suggest connection with FBI; it is unreasonable that the public would assume applicant’s goods originate with, are sponsored or endorsed by, or associated with the Federal Bureau of Investigation, finding that "FBI" represents "Fabrication Brill International" and purchasers will see the entire composite mark on the goods and not just "FBI," (*FBI v. Societe: "M.Brill & Co."*, 172 USPQ 310 (TTAB 1971)).

§2(b): absolute bar to registration

- Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any state or municipality, or of any foreign nation, or any simulation thereof.
- Cannot register marks containing flags, coats of arms, or other insignia of U.S. or foreign governments.
- Cannot disclaim the prohibited element to overcome refusal.
- Cannot register under acquired distinctiveness (Section 2(f)) to overcome refusal.
- No exception to register own flag/insignia: countries, states or municipalities cannot register their own flags or insignia, even if filed by the relevant country, state, or municipality.

§2(b) examples—flags, coats of arms, insignia: USPTO refused

Flags



Seal of the president of the U.S.



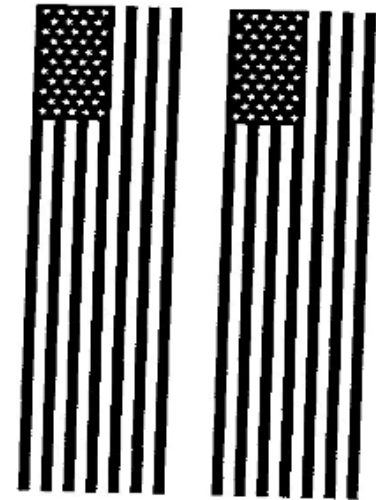
Coat of arms of the U.S.



Official seal of a U.S. government agency—Department of Commerce

§2(b) examples—flags, coats of arms, insignia: USPTO not refused

- Stylized or incomplete forms are allowed.



§2(b) examples–insignia: USPTO not refused

Government departments



Monuments, statues, buildings




Objects used by the government

Example: refuse mark if Article 6ter notification in USPTO TM database?



- Should the mark be refused for:
 - “Clothing?”
 - “Coffee?”
 - “Legal services?”

Article 6ter notification of armorial bearing in USPTO database

Mark Type:	OTHER	
TM5 Common Status Descriptor:		For the situation where the status is uncertain, unknown, or other than those previously identified.
Status:	This serial number identifies non-registration matter in the USPTO database.	
Status Date:	Nov. 15, 2007	
▼ Mark Information ▼ Expand All		
Mark Literal Elements:	None	
Standard Character Claim:	No	
Mark Drawing Type:	2 - AN ILLUSTRATION DRAWING WITHOUT ANY WORDS(S)/ LETTER(S)/NUMBER(S)	
Description of Mark:	Armorial Bearings of Sweden - Armorial bearings with supporters	
Design Search Code(s):	03.01.02 - Lion insignia (heraldic lion) 24.01.02 - Shields or crests with figurative elements contained therein or superimposed thereon 24.03.01 - Orbs; Scepters 24.11.01 - Crowns closed at the top 24.11.02 - Crowns open at the top	
▼ Goods and Services		
For:	No Description Entered	
International Class(es):	001, 002, 003, 004, 005, 006, 007, 008, 009, 010, 011, 012, 013, 014, 015, 016, 017, 018, 019, 020, 021, 022, 023, 024, 025, 026, 027, 028, 029, 030, 031, 032, 033, 034, 035, 036, 037, 038, 039, 040, 041, 042, 043, 044, 045	U.S Class(es): 001, 002, 003, 004, 005, 006, 007, 008, 009, 010, 011, 012, 013, 014, 015, 016, 017, 018, 019, 020, 021, 022, 023, 024, 025, 026, 027, 028, 029, 030, 031, 032, 033, 034, 035, 036, 037, 038, 039, 040, 041, 042, 043, 044, 045, 046, 047, 048, 049, 050, 051, 052, 100, 101, 102, 103, 104, 105, 106, 107, 200, A, B - Primary Class
Class Status:	ACTIVE	
Basis:	Basis Not Found	
▼ Current Owner(s) Information		
Owner Name:	Government of Sweden	
Owner Address:	SWEDEN	
Legal Entity Type:	GOVERNMENT OF SWEDEN	State or Country Where Organized: SWEDEN



Example: refuse mark if Art 6ter notification in USPTO TM database?

- Refuse registration? **YES**
- Under U.S. Trademark Act Section 2(b) because the design includes a simulation of the armorial bearings of Sweden.
- It does not matter what the goods are!
- Also, under U.S. Trademark Act Section 2(a) because the design is used in a way that falsely suggests a connection with the government of Sweden.
- How about refusal for “likelihood of confusion” with the Article 6ter notification in the USPTO database? **NO!**



Flags: State and IGOs

No refusal if:

Flag **forms** a letter, number or design

Flag is substantially **obscured** by words or designs

Flag is not a **shape** normally seen in flags

Flag appears in different **colors** from those normally used in the national flag

A significant feature is **missing or changed**

- State flags: Notification will likely not appear in the search database (notification is not required for state flags) so examining attorneys look to other sources, such as the internet or encyclopedias.
- IGO flags: Must notify so flag may appear in the search database.
 - If not notified, the USPTO may still refuse under Section 2(a) if U.S. consumers would falsely assume a connection with an IGO.

Flags: State and IGOs

No refusal if:

Flag **forms** a letter, number or design

Flag is substantially **obscured** by words or designs

Flag is not a **shape** normally seen in flags

Flag appears in different **color** from that normally used in the national flag

A significant feature is **missing or changed**

- In determining whether the mark will be perceived as a flag, consider:
 - Color;
 - Presentation of the mark;
 - Words or other designs on the drawing;
 - Use of the mark on the specimens.
- Stylized flag designs are not refused registration:
 - Marks containing elements of flags in a stylized or incomplete form are not refused under Section 2(b).
 - Mere presence of some significant elements of flags, such as stars and stripes (U.S. flag) or a maple leaf (Canadian flag), does not necessarily warrant a refusal.

Example: refuse mark if no Article 6ter notification in USPTO TM database?

Born in Canada 
Spreading all over the world.

Example: refuse mark if no Article 6ter notification in USPTO TM database?



- Refuse registration? **NO**
 - Regardless of whether Article 6ter notification in USPTO TM database
- The USPTO TTAB held:
 - Not the flag of Canada (missing a bar; mark contains other wording); and
 - Not an insignia of Canada because Canada does not use the maple leaf by itself as a State emblem.
 - NOTE: If the goods had not originated in Canada, registration would have been refused as geographically misdescriptive or deceptive.

Example: refuse mark if no Article 6ter notification in USPTO TM database?



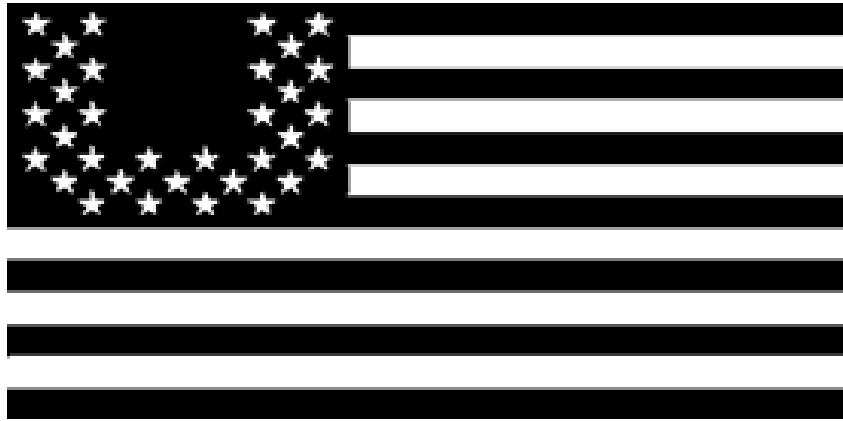
- Should the mark be refused for:
 - “Canned food?”
 - “Transportation services?”
 - “Life vests?”

Example: refuse mark if no Article 6ter notification in USPTO TM database?



- Refuse registration? **YES**
 - Regardless of whether Article 6ter notification in USPTO TM database
- Under U.S. Trademark Act Section 2(b) because the design includes a simulation of the Italian flag.
- Refuse if the design would be perceived by the public as a flag, whether or not other matter appears with or on the flag.
- Correct colors of the Italian flag.
- The wording "That's Italian" emphasizes and reinforces that the banner design is a simulation of an Italian flag.

Example: refuse mark if no Article 6ter notification in USPTO TM database?



Example: refuse mark if no Article 6ter notification in USPTO TM database?



- Refuse registration? **No**
 - Regardless of whether Article 6ter notification in USPTO TM database.
- A significant feature of the U.S. flag has been changed.

Article 6ter is not a trademark substitute

- Article 6ter's purpose → notification regarding government designations that should not be used for commercial purposes.
 - Article 6ter is not intended to be used to notify of designations used in commerce for commercial purposes.
- Government designations used for commercial purposes → may be protected as:
 - Trademarks,
 - Service marks, or
 - Certification marks.

**Protection via trademarks and
certification marks–U.S. model**

U.S. definition of trademark

- **Very broad definition:**
 - ... any word, name, symbol, or device, or any combination thereof [] used ... to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods....

Section 45 of the Trademark Act, 15 U.S.C. §1127
- **A word, phrase, symbol, or design (or combination) that:**
 - Identifies a business' goods/services to its customers; and
 - Allows customers to distinguish those goods/services from the goods/services of competitors.

Examples: USPTO registrations of trademarks of foreign governments

- ETHIOPIAN THE NEW SPIRIT OF AFRICA and design and non-Latin characters, for air transportation; "ETHIOPIAN" and the non-Latin characters that transliterate to "ye ethiopia" disclaimed; Ethiopian Airlines Enterprise wholly owned entity and an instrumentality of the Government of the Federal Democratic Republic of Ethiopia. (Reg. No. 6039390)
- MAKE IN INDIA and design of lion, for numerous goods in various classes including clothing, bags, games; "MAKE IN INDIA disclaimed;" Secretary, Department of Industrial Policy and Promotion, Ministry of Commerce and Industry, Government of India. (Reg. No. 5193318)
- QUEBEC ORIGINAL, for various goods and services including printed guides and catalogs, travel information, ticket reservations; "QUEBEC" disclaimed; Government du Quebec, Ministry of Tourism ministry of the provincial government of Quebec, Canada. (Reg. No. 4483346)
- CAYMAN ISLANDS and design of turtle, for travel and tourism promotion and information services; "CAYMAN ISLANDS" disclaimed; Cayman Islands Department of Tourism a division of the Government of Cayman Islands Cayman Islands. (Reg. No. 3221581)

U.S. definition of certification mark

- ... any word, name, symbol, or device, or any combination thereof—
 1. Used by a person other than its owner, or
 2. Which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this chapter, to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

Section 45 of the Trademark Act, 15 U.S.C. §1127

- Goods: distinguish origin, material, mode of manufacture, quality, accuracy.
 - Includes geographical indications (GIs).
- Services: Signifies work/labor was performed by members of a particular organization.

Examples: USPTO registrations of certification marks of foreign governments

- FIJI PURE, for plantation grown mahogany timber; owned by Government of the Republic of Fiji. (Reg. No. 4518137)
- THAI SILK and design of peacock, for silk fabrics; "SILK" disclaimed; The Queen Sirikit Institute of Sericulture, Office of the Permanent Secretary, Ministry of Agriculture and Cooperatives, Government of Thailand. (Reg. No. 3577857)
- INDIAN SPICES and design, for spices; "SPICES" disclaimed; Spices Board, Ministry of Commerce & Industry, Government of India. (Reg. No. 2356495)
- BORDADO DA MADEIRA and design, for embroidery; English translation is "embroidery of Madeira;" "BORDADO" disclaimed; Instituto do Vinho, do Bordado e do Artesanato da Madeira, IP-RAM an official agency of the regional government of Madeira - an autonomous region of Portugal. (Reg. No. 1772117)

Summary of Article 6ter, trademarks and certification marks

- Incoming Article 6ter notifications from WIPO–review:
 - Accept → entered in U.S. trademark database:
 - Discovered during search for conflicting marks.
 - Provides information that an examining attorney may consider when determining whether to issue a refusal under 2a or 2b.
 - Refuse → WIPO is notified, and the sign is not entered in U.S. trademark database.
- Incoming applications–trademark and certification examination:
 - Accept (if no applicable refusals),
 - Refuse (can be refused under various sections of the Trademark Act, regardless of whether a similar sign notified to WIPO under Article 6ter appears in the U.S. trademark database).

Article 6ter resources

- Information about Article 6ter of the Paris Convention is available on the WIPO website at www.wipo.int/article6ter/en/.
- Guidelines for the Interpretation of Article 6ter(1)(b) and (3)(b) are available on the WIPO website at www.wipo.int/article6ter/en/legal_texts/guidelines.htm.
 - These guidelines clarify the conditions under which a program or institution established by an international intergovernmental organization, and any convention constituting an international treaty, may benefit from the protection granted by Article 6ter(1)(b) of the Paris Convention.



Thank you!

Attiya Malik

attiya.malik@uspto.gov

Daniel Stringer

daniel.stringer@uspto.gov

www.uspto.gov