THE PROTECTION OF THE NAME, ACRONYM AND EMBLEM OF THE OECD

Information note prepared by the Directorate for Legal Affairs

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I. The protection of names, acronyms and emblems of international organisations

The protection of names, acronyms and emblems of international organisations is ensured in international law by the Paris Convention for the Protection of Industrial Property (Paris Convention). This Convention was concluded in 1883 and is the first international instrument for the protection of industrial property (invention, trademark, industrial designs). It entered into force in 1884 and today has 169 Parties, including all OECD Members and most other countries.

Article 6ter of the Paris Convention provides protection against unauthorized commercial use, as trademark, of the names and acronyms of intergovernmental organisations. This article is also part of the WTO system and binds WTO Members including those which are not Party to the Paris Convention, through article 2.1 of the Agreement on Trade – Related Aspects of Intellectual Property Rights (TRIPS).

More specifically, article 6ter of the Paris Convention obliges a Party to refuse or invalidate the registration and to prohibit the use, either as trademarks or as elements of trademarks, of the distinctive signs of the countries party to the Convention and of international organisations. For international organisations, the distinctive signs that are protected are the following: names, abbreviations, armorial bearings, flags and other emblems.

To give effect to the provisions of article 6ter, a procedure is established according to which the name or the distinctive signs of the international organisation concerned are communicated to the International Bureau of WIPO, which in turn transmits those communications to all Parties.

Art. 6ter has been incorporated in the legislation of most countries. Herewith are some examples:

- European Community: article 3 of the Directive 89/104/EEC of the Council, of 21 December 1988 (Council Directive to Approximate the Laws of the Member States Relating to Trade Marks) refers to art. 6ter in the list of non – registrable trademarks (similar provisions have been introduced in the implementing legislation of the EC Member States);

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1 The text of article 6 is reproduced in Annex.

2 Article 3 of the Agreement between the World Intellectual Property Organization and the World Trade Organization disciplines the cooperation between the two organisations on the implementation of Article 6ter of the Paris Convention for the purposes of the TRIPS Agreement.
• United States: the Lanham Trademark Act incorporates the Paris Convention through paragraph 1126;³

• Canada: the Trade – marks Act includes in the list of prohibited marks all the armorial bearings, flags, emblems or abbreviations which have been communicated under article 6ter of the Paris Convention (article 9.1.i.3.).⁴

II. Registration of the name, acronym and emblem of the OECD

In accordance with the procedure set up by article 6ter of the Paris Convention, on 5th February 2002, the following has been notified to the WIPO Secretariat⁵:

• The name, abbreviation and emblem⁶ of the Organisation for Economic Co-operation and Development (OECD);

• The name, abbreviation and emblem of the International Energy Agency (IEA); and

• The name, abbreviation and emblem of the OECD Nuclear Energy Agency (OECD/NEA).

Subsequently, on 20th March 2002, the WIPO Secretariat has circulated the notification to all the countries that are parties to the Paris Convention and to the WTO Members which are not bound by the said Convention.⁷ Since then, OECD, IEA and NEA enjoy article 6ter protection in most countries and economies of the world.

III. The scope of the protection given by article 6ter

The protection of article 6ter implies that no legal or physical person should be able in the countries where it applies to register any trademark with the name, the acronym or the emblem of OECD, IEA, NEA.

In general terms, it could be said that the level of protection is comparable to the one enjoyed by a trademark. Therefore it is possible to defend OECD name and emblem any time they are used as a mark or there is the likelihood of confusion. Likelihood of confusion comprises

³ For the specific implementation of article 6ter, see paragraph 1205.02 of the US Trademark Manual of Examining Procedure.

⁴ National legislation which implements article 6ter may partially differ in the scope of the protection. One source of difference is in how countries interpret the exception which permits the registration of a mark when it is not of «such nature as to mislead the public as to the existence of a connection between the user and the organization».

⁵ Letter of the Secretary General to the Director General of WIPO of 5 February 2002 and related response of 20 March 2002.

⁶ The emblem is the logo of the Organisation.

⁷ Registration of name, acronym and emblem of OECD, IEA, NEA can be checked in the database dedicated to article 6ter within the WIPO website.
the case in which it is impossible or very difficult to distinguish the genuine and the false product (e.g. counterfeiting of an OECD publication). Likelihood of confusion has also been consistently interpreted in broader terms, to include the concept of association (e.g. a publication with an unauthorised OECD logo or a meeting where an OECD logo is used without authorization). Each of these types of action is deemed to be illegal and could be challenged in court.

On the contrary, it would not seem possible to bar the use of the name “OECD” (or “OECD Statistics” or “OECD Economic Outlook”) when it is used in a descriptive way, for example in a context of an article or a book.

The Paris Convention also protects - in the US and other jurisdictions where this legal principle exists - against trademark “dilution”. Dilution does not imply confusion, but implies the “blurring” or “tarnishing” of the product. Assuming that OECD’s name or logo were to be found to be sufficiently well known, the Organisation would have a case of dilution if the OECD name or logo were weakened or associated with a product which is of inferior or degrading nature.

**IV. Could the OECD be protected through national registrations?**

Could the protection of the OECD name, acronym and emblem be further protected through their registration in single countries? Is that necessary?

To answer these questions, a brief review of trademark registration is useful. Trademarks are normally registered in a given country and they are protected in the country where they are registered. For example, if a trademark is registered in France, the registrant will be protected exclusively in France. There are some legal systems, e.g. the United States, in which the simple use can give trademark rights, without or before any formal registration. However, also in this case, rights, which are based on the legitimate use of the mark, can be established exclusively in the country of use.

To extend trademark protection beyond the jurisdiction of registrations, the following means would be available:

- to register the trademarks in each of the countries where the protection is sought;
- to proceed to an ‘international registration’ according to the Madrid system (Madrid Agreement and its Protocol): a mark may be subject of international registration only if it has already been registered in a national office of a country which is member of the Madrid system. The international registration request must be made to the WIPO Bureau through a national Office. The international registration gives protection in the countries which are Parties to the Madrid system and which are specifically designated in the registration. An international registration is equivalent to a bundle of national registrations. More than sixty countries are Parties to the Madrid Agreement, of which 27 OECD Members;
- to seek protection through the Community Trade Mark (CTM): this mechanism is based on European Community Council Regulation No. 40/94 of 20 December 1993. In this case, the trademark is protected in all the EC countries indivisibly.
Applications for a CTM are made either directly at the Office for Harmonization in the Internal Market (OHIM) in Alicante, Spain, or at the national office of a EC Member State, at the choice of the applicant.

The registration of the OECD name, acronym and emblem at the national level or through the international and European mechanisms do not seem to add much value to the existing framework in term of legal protection. However, registration may be considered in two cases:

- in the unlikely case that protection is sought under jurisdictions which are not bound by article 6ter of the Paris Convention or where this article is not adequately implemented;

- to defend single OECD products which are not adequately covered by the protection provided by article 6ter, such as products the name of which is not systematically used in conjunction with the term “OECD”. An example could be products which the general public referred to as “PISA” instead of the full name “OECD PISA”.

V. Conclusions

Thanks to the notification under article 6ter of the Paris Convention, the name, acronym and emblem of the Organisation enjoy a very high degree of protection in a very wide geographic area.

It is possible to register the OECD names in single countries and also at the European and international level through the Madrid system. However, this registration seems at this stage unnecessary. Ad hoc registration of certain OECD products or in certain countries should be considered if there are specific needs. These needs should be examined on a case-by-case basis and required resources and financial costs should be considered.

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8 In addition to trademark registration, the OECD may be able to rely on other legal theories to defend its name and products in individual countries.
ANNEX – ARTICLE 6TER OF THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY

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

(1) 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) 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.