

# The Trademark Provisions in the Paris Convention for the Protection of Industrial Property

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## I INTRODUCTION

Of all the subjects of industrial property falling under the umbrella of the Paris Convention for the Protection of Industrial Property (the Paris Convention), those dealing with trademarks are the most extensive, although many matters of substance are not touched upon. This chapter analyses the scope of these provisions, beginning with a brief account of their history and inclusion in the Convention over the course of successive revisions.

## II PRIOR TO THE PARIS CONVENTION

The Paris Convention of 1883 was the first multilateral convention dealing with industrial property.<sup>1</sup> Prior to this, the only international protection for such rights arose in a piecemeal way through a network of bilateral treaties and agreements that had been entered into between many of the industrialized and industrializing countries of Europe and the Americas. In his 1929 treatise, later revised in 1975, Stephen Ladas identified “no less than sixty-nine such acts, divided very unequally between the different countries.”<sup>2</sup> These all dealt with trademarks, and, prior to 1865, were generally included as provisions in broader treaties of commerce between countries, rather than subject-specific treaties or agreements. It was only after this date that more subject-specific agreements occurred; as stated, these invariably dealt with trademarks, but about a third or more covered designs and models as well,<sup>3</sup> while only a handful dealt specifically with patents.<sup>4</sup> By contrast with the more detailed provisions found in the comparable bilateral treaties

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<sup>1</sup> The following section draws on material appearing in SAM RICKETSON, *THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY: A COMMENTARY*, Chs. 1–2 (2015) (RICKETSON).

<sup>2</sup> STEPHEN P. LADAS, *PATENTS, TRADEMARKS, AND RELATED RIGHTS: NATIONAL AND INTERNATIONAL PROTECTION* 43 (2d ed. 1975).

<sup>3</sup> *Id.* at 43.

<sup>4</sup> In this regard, Ladas notes that there was a reciprocal arrangement between Austria-Hungary and Germany made in 1881: Germany and Austria-Hungary Treaty of Commerce, art. 20, 23 May 1881 (*British and Foreign State Papers*, LXXV, 859). There was also a UK agreement with Italy in 1883 which made specific reference to patents for inventions: *Treaty of Commerce and Navigation between Her Majesty and the King of Italy*, 15 June 1883, art. XVII, reproduced in *Commercial No. 12* (1888) (*Trade Marks*), *Extracts from Treaties and Declarations now in force between Great Britain and Foreign Powers relating to Trade Marks, Designs, and Industrial Property*, August 1888, C-5554, London, HMSO, 1888, p. 4.

dealing with literary and artistic works, these agreements were of a limited character, being based essentially on principles of formal, rather than material, reciprocity that were directed at achieving “national treatment” for rights owners in each other’s country – in other words, acquiring access to the other country’s national system and ensuring that, once there, they were treated in the same way as locals.<sup>5</sup> However, the subject matter covered differed from agreement to agreement, as did the conditions for acquiring protection, which usually required the taking of some formal step such as registration or deposit, either in the country of origin or in the country where protection was claimed (or both).

Moves toward the adoption of a multilateral agreement on trademarks did not begin until the end of the 1870s: prior to this, legal and policy discussion at national and international levels was largely focused on patents, with a significant milestone being the International Patent Congress of 1873, which was held in conjunction with the international exhibition in Vienna that year.<sup>6</sup> The latter did not deal with trademarks, but these were the subject of discussion in the International Congress on Industrial Property that was held during the universal exhibition of Paris in 1878. This Congress passed a series of resolutions covering a wide range of industrial property rights, including twenty-three directed at trademarks.<sup>7</sup> Among these were resolutions on requirements for use and the need for a priority system for filing and recognition in other countries following first filing. Most significantly, the Congress expressed the wish “that the requirement for registration of trademarks should be subject to an international regulation, under which it would be possible for a person possessing a mark to make a single filing/registration in one state to thereby assure protection of that mark in all other contracting states.”<sup>8</sup>

### III THE ADOPTION OF THE PARIS CONVENTION AND ITS SUBSEQUENT REVISIONS

The 1878 Paris Congress was the catalyst for the convening of an international conference of states, under the auspices of the French Government, to consider the adoption of a multilateral agreement on the protection of industrial property including trademarks.<sup>9</sup> This meeting was held in 1880 in Paris and, after extensive debates between delegates, resulted in the adoption of a draft text that provided for the establishment of a “Union for the protection of industrial property.” This instrument enshrined the principle of national treatment (subject to the need to comply with formalities and conditions imposed by the domestic laws of each state), inaugurated a system of priority periods for filing in other member states of the Union, and included a number of provisions touching on trademark recognition and enforcement.<sup>10</sup> After minor

<sup>5</sup> See generally SAM RICKETSON AND JANE C. GINSBURG, *THE INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS: THE BERNE CONVENTION AND BEYOND*, Ch. 2 (2006).

<sup>6</sup> See also Thomas Webster, MA, FRS, Report on the International Patent Congress, 1873, in *REPORTS ON THE VIENNA UNIVERSAL EXHIBITION OF 1873*, 1874 [C.1072-IV] House of Commons Parliamentary Papers Online. This Congress adopted a series of wide-ranging resolutions calling for procedural and substantive reform in relation to patents at both the national and international levels.

<sup>7</sup> See also *Congrès international de la Propriété Industrielle tenu à Paris du 5 au 17 septembre 1878, Compte-rendu sténographiques*, No. 24 de la série 1879, Paris imprimerie nationale.

<sup>8</sup> Ministry of Agriculture and Trade, *CONGRÈS INTERNATIONAL DE LA PROPRIÉTÉ INDUSTRIELLE TENU À PARIS DU 5 AU 17 SEPTEMBRE 1878, RÉOLUTION NO. 23 DE LA SÉRIE*, 434 (1879).

<sup>9</sup> On this history generally, see RICKETSON, *supra* note 1, Chs. 3 and 4.

<sup>10</sup> See also *Conférence internationale pour la protection de la propriété industrielle*, Ministère des Affaires étrangères, Paris, 1880 (Actes 1880).

amendments, this text was formally adopted by a second diplomatic conference in 1883,<sup>11</sup> entering into force on 7 July 1884 with an initial membership of fourteen states,<sup>12</sup> including, shortly afterward, the United States.<sup>13</sup> In its early years, however, a significant number of states remained outside, including Germany, Russia and Japan.<sup>14</sup>

In its original form, the Paris Act of the Convention (the Paris Act 1883) was a limited instrument with few substantive obligations extending beyond its system of priorities and obligation of national treatment. Nonetheless, it was intended by its founders to be a dynamic agreement that would be augmented through successive revisions, and, unlike previous bilateral agreements, it was a multilateral instrument open to any state to join, without any other qualification, geographic, linguistic, economic or otherwise, for admission. For its first seventy-five years, this membership tended to be weighted toward Europe and North America and to countries that were industrialized or industrializing, rather than developing.<sup>15</sup> In addition, any aspirations toward the adoption of a universal law of industrial property (such as a global patent or trademark), were only faintly echoed in its text, if at all (in contrast with the more idealistic resolutions of the 1873 and 1878 Congresses). Nonetheless, it provided, for the first time, a basic platform for obtaining protection of industrial property rights in other member states of the newly established Paris Union, and this was a significant achievement in its own right. No guidance was provided in its text as to the content and extent of the rights to be protected in each member state – indeed, no definition even was to be found of the rights themselves – but the hope was that such matters might be filled out in the process of future revisions. By contrast with the Berne Convention for the Protection of Literary and Artistic Works of 1886, this has not proved to be the case; although trademarks represent the one area where the Convention has achieved the most progress. The chronology of revisions since 1883 speaks for itself:

- Two initial revision conferences in Rome 1886<sup>16</sup> and Madrid 1890<sup>17</sup> came to nothing, the first because it was too soon after the coming into force of the Convention in 1884 and the second because too ambitious a programme of proposals touching on trademarks resulted in the adoption of two ancillary agreements to be entered into by those Paris Union members that desired to do so, but without effecting changes to the Paris text itself.<sup>18</sup>

<sup>11</sup> See also *Conférence internationale pour la protection de la propriété industrielle*, Ministère des Affaires étrangères, Paris, 1883 (Actes 1883).

<sup>12</sup> Belgium, Brazil, Spain, France, Guatemala, Italy, Netherlands, Portugal, El Salvador, Serbia, Switzerland, the United Kingdom, Tunisia, and Ecuador. A number of these members, such as the United Kingdom, France, Spain, and the Netherlands, had extensive colonial possessions to whose territories the Convention was also generally extended.

<sup>13</sup> The United States acceded in 1887.

<sup>14</sup> Of these, Germany joined in 1903, Japan in 1899, and Russia not until 1965 (as the former Soviet Union).

<sup>15</sup> Exceptions to this were Brazil and Tunisia, as well as Ecuador and El Salvador, which soon denounced the Convention after their joining on the ground of their lack of development, not re-joining until the end of the twentieth century: see also <http://wipo.int/export/sites/www/treaties/en/documents/pdf/paris.pdf>.

<sup>16</sup> *Conférence de l'Union pour la Protection de la Propriété Industrielle*, Ministère de l'agriculture, de l'industrie et du commerce, Imprimerie Héritiers Botta, Rome 1886 (Actes 1886).

<sup>17</sup> See also *Procès-Verbaux de la Conférence de Madrid de la Union pour la protection de la Propriété industrielle*, Imprimerie Jent et Reinert, Berne 1892.

<sup>18</sup> These were the Madrid Agreement Concerning the International Registration of Marks, Apr. 14, 1891, 828 UNTS 389, and the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods art. 1(1), Apr. 14, 1891, 828 UNTS 389.

- Two revision conferences in Brussels 1897 and 1900, which resulted in some tidying up of the original text.<sup>19</sup>
- A more substantive revision conference in Washington in 1911, which continued this process and added some further provisions.<sup>20</sup>
- A further revision conference in The Hague in 1925, which was notable for including substantive provisions dealing with the repression of unfair competition and the protection of state emblems.<sup>21</sup>
- A further revision conference in London in 1934, which did more of the same.<sup>22</sup>
- A more substantive revision conference in Lisbon in 1958, which made further incremental and “tidying up” changes, but which proved to be the last substantive revision of the Convention.<sup>23</sup>
- The extensive machinery and procedural changes that were made as part of the Stockholm Revision Conference of 1967, but made no change to the substantive provisions of the Convention (with several minor exceptions).
- A prolonged and tragically ineffective series of revision conferences held between 1980 and 1984 in Geneva and Nairobi, which failed even to get down to substantive discussion because of differences between developed and developing countries over the issues of working and compulsory licences of patents. Proposals for further changes with respect to trademarks fell by the way here.<sup>24</sup>

The result is that, as of 2020, notwithstanding its almost universal membership of 177 states, the binding provisions of the Paris Convention are those in the Lisbon text of 1958, as supplemented by the machinery and procedural changes made in the Stockholm Revision of 1967. While a good number of these are concerned with trademarks, more substantive international obligations dealing with the content and scope of such rights have had to await their inclusion in trade-related measures, such as in the Agreement on Trade Related Intellectual Property Rights (TRIPS Agreement; the subject of Chapter 2 in this volume). So far as procedural aspects of trademark protection are concerned, effective international agreements have occurred in the form of special agreements as allowed under Article 19 of the Paris Convention; in particular, the Madrid Trade Marks Registration Treaty 1891, Madrid Protocol 1989, Nice International Classification Agreement 1957, and the more recent World Intellectual Property Organization (WIPO) treaties.<sup>25</sup> Having said this, the Paris Convention remains the starting point for trademark owners seeking protection for their marks in countries other than their own, and this is the subject of the remainder of this chapter.

<sup>19</sup> See also *Actes de la Conférence de Bruxelles, première et deuxième sessions 1897–1900*, Bureau international de l’union, Berne, 1901 (Actes 1897–1900).

<sup>20</sup> See also *Actes de la Conférence réunie à Washington du 15 mai au 2 juin 1911*, Bureau international de l’Union, Berne 1911 (Actes 1911).

<sup>21</sup> See also *Actes de la Conférence réunie à La Haye du 8 octobre au 6 novembre 1925*, Bureau international de l’Union, Berne 1926 (Actes 1925).

<sup>22</sup> See also *Actes de la Conférence réunie à Londres, du 1 mai au 2 juin 1934*, Bureau international de l’Union pour la protection de la propriété industrielle, Berne 1934 (Actes 1934).

<sup>23</sup> See also *Union internationale pour la protection de la propriété industrielle, Actes de la Conférence réunie à Lisbonne, du 6 au 31 octobre 1958*, Bureau international de l’Union pour la protection de la propriété industrielle, Geneva 1963 (Actes 1958). For ease of reference in the text above, the following abbreviations will be used to refer to the versions of the Convention adopted by successive revision conference: Paris Act 1883, Brussels Additional Act 1900, Washington Act 1911, Hague Act 1925, London Act 1934, Lisbon Act 1958 and Stockholm Act 1967.

<sup>24</sup> See also RICKETSON, *supra* note 1, Ch. 5, 5.02.

<sup>25</sup> Notably the Trademark Law Treaty, Oct. 27, 1994, S. Treaty Doc. No. 105-35, 2037 UNTS 35, and the Singapore Treaty on the Law of Trademarks, Mar. 27, 2006, S. Treaty Doc. No. 110-12.

#### IV THE PRINCIPAL PARIS CONVENTION PROVISIONS DEALING WITH TRADEMARKS<sup>26</sup>

##### *A Gaining Protection in the First Place – National Treatment and Priority Periods*

###### **1 National Treatment**

As in the cases of patents and designs, trademarks are the subject of the national treatment obligation under Article 2(1), and this has been the position since the Paris Act of 1883.<sup>27</sup> The scope of this obligation has not changed, with its requirement that nationals of any country of the Union shall, “as regard[ing] the protection of industrial property, enjoy in all other countries of the Union the advantages that their respective laws now grant, or may hereafter grant to nationals.”<sup>28</sup> Since the Hague Act of 1925, this has been “without prejudice to the rights specially granted by this Convention,” although, as will be seen, these are relatively few in number. The consequence of according national treatment is then spelt out in the second sentence of Article 2(1): nationals of any Union country are to have the “same protection” in any other Union country as is granted to nationals, and “the same legal remedy against infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with.”<sup>29</sup> No requirement as to domicile or establishment in the country where protection is claimed may be imposed, but certain matters are expressly reserved to the laws of such countries where specific measures concerned with claimants under the Convention will be permissible, including provisions relating to judicial and administrative procedure and jurisdiction, and the designation of an address for service or the appointment of an agent.<sup>30</sup> As with patents, industrial designs and utility models, however, there is no definition of “trademark,” leaving this as a matter for the national law of each Union country. Several points may be made here:

- (a) As a matter of history, lack of definition may not have been a problem, as “trademark” was generally understood as referring to some kind of visible sign used in relation to goods so as to indicate their source. Accordingly, there may have been a *de facto* harmony of approach among Paris Union countries, at least at the outset, as to what constituted a “trademark,” even if today a range of non-traditional signs, such as sounds and smells, are recognized as marks under many national laws.
- (b) The term “trade mark” or “trademark” (to use the American spelling which is adopted in WIPO publications), so far as the Paris Convention is concerned, refers to marks used in relation to goods, rather than to goods and services. Marks for services, or “service marks,” are referred to separately under Article 6*sexies*, which was added only at the Lisbon Revision Conference in 1958 (see further below). These may receive lesser protection under the Paris Convention, as they are not included in the priority period provisions contained in Article 4, but they are listed as one of the objects of the protection of “industrial property” under Article 1(2) and must therefore receive the benefit of national

<sup>26</sup> The following discussion draws on more detailed treatment that is to be found in RICKETSON, *supra* note 1, Chs. 10 and 12. Further commentaries are to be found in GEORGE H. C. BODENHAUSEN, *GUIDE TO THE APPLICATION OF THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY AS REVISED AT STOCKHOLM IN 1967*, 67–137 (1968), and STEPHEN P. LADAS, *PATENTS, TRADEMARKS, AND RELATED RIGHTS: NATIONAL AND INTERNATIONAL PROTECTION* Vol. II, Chs. 30–34 (2d ed. 1975).

<sup>27</sup> Paris Convention for the Protection of Industrial Property, Mar. 20, 1888, as revised at the Stockholm Revision Conference, July 14, 1967, 21 UST 1538, TIAS No. 6903, 828 UNTS 305, art. 2. [hereinafter Paris Convention].

<sup>28</sup> *Id.*, art. 1(2), “trademarks” are included as one of the objects of the “protection of industrial property.”

<sup>29</sup> *Id.*, as revised at Stockholm 1967, art. 2(2).

<sup>30</sup> *Id.*, art. 2(3).

treatment under Article 2(1), together with trademarks. The protection of service marks is also now enhanced under the provisions of the TRIPS Agreement.

- (c) “Collective marks,” or marks owned by groups or associations, are likewise the subject of a separate provision requiring protection (Article 7*bis*), which was introduced to the Convention in the Washington Revision of 1911 (see further below). However, there is no reference to collective marks in the definition of “industrial property” in Article 1(2), which means that they are excluded from national treatment under Article 2(1). The only basis on which national treatment could be required for such marks would be if they could be regarded as falling nonetheless within the scope of the expression “trademark,” which would be a stretch, given that such marks are, by definition, collectively rather than individually owned (as in the case of trademarks) and their treatment in the Convention differs from the case of service marks (which are specifically included within the definition of “industrial property”).<sup>31</sup>

## 2 Right of Priority

Important as receiving national treatment in each Union country may be, once a foreign trademark owner has arrived there, gaining access to that country in order to be able to enjoy the benefits of that protection is an obvious prior step. In this regard, trademarks enjoy a right of priority for six months in each Union member from the date of filing of the first application, so long as it is a “regular national filing” under the domestic law of any country of the Union.<sup>32</sup> As with patents and industrial designs, trademarks have enjoyed a right of priority since the Paris Act of 1883,<sup>33</sup> and this has been for a period of six months since the Hague Act of 1925.<sup>34</sup> This priority period is fundamental in obtaining trademark protection in other Union countries during this period, as the validity of any subsequent filing in those countries will not be affected by reason of any acts that occur in this period, including use of the mark or third party acts or filings.<sup>35</sup> Until the widespread adoption of the Madrid Protocol in 1989, which enables multiple filings on the basis of an application in one state, Paris priority provided the only route into other national systems for trademark owners.

### *B Independence of Protection and Recognition of Marks Duly Registered in Other Union Countries*

Two important obligations fall for consideration here: first, the requirement under Article 6(3) that Union countries must accord independence of protection to trademarks once registered there, without regard to events or circumstances that have occurred elsewhere, and, secondly, the requirement that Union countries should recognize and protect, subject to certain conditions, trademarks that have been duly registered in another Union country (Article 6*quinquies*). Each

<sup>31</sup> This requirement also applies under the Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 UNTS 299, 33 ILM 1197, art. 2.1 (1994) [hereinafter TRIPS Agreement].

<sup>32</sup> Paris Convention, *supra* note 27, as revised at Stockholm 1967, arts. 4.A(1) and (2) and 4.C(1). “Regular national filing” means any filing that is adequate to establish the date on which the application was filed in the country concerned, “whatever may be the subsequent fate of the application,” that is, whether it was subsequently withdrawn or rejected in that country. Art. 4.A(3).

<sup>33</sup> Paris Convention, *supra* note 27, art. 4, § 3.

<sup>34</sup> *Id.*, as revised at The Hague, art. 4.C. There were unsuccessful attempts at later revision conferences to increase this period to twelve months: *supra* note 22 at 169, 172, 362–63; *supra* note 23 at 538–42.

<sup>35</sup> Paris Convention, *supra* note 27, as revised at Stockholm 1967, art. 4.B.

obligation came into the Convention at different times and went through various iterations before assuming their present form under the Lisbon Act of the Convention.<sup>36</sup>

### 1 *Independence of Protection*

The obligation of independence of protection under Article 6(3) for trademarks, once registered in a Union country, is buttressed by two further provisions in Article 6(1) and (2), which deal with the situation prior to registration.<sup>37</sup>

- (a) *At filing and thereafter*: Under Article 6(1), the conditions for the filing and registration of trademarks are to be determined in each country of the Union by its domestic legislation. On its face, this is an unexceptional application of the general national treatment principle in Article 2(1). Article 6(1) strictly deals only with trademarks, not service marks, but the latter are entitled to national treatment in any event because service marks are included within the concept of “industrial property” under Article 1(2) and are therefore within the scope of the obligation to accord national treatment under Article 2(1). In general, this also implies independence of protection in that it implicitly excludes reference back to any national law with which the applicant or trademark may previously have been associated.
- (b) *No reference to filing, registration or renewal in country of origin*: Independence of protection becomes more evident in the rule applied under Article 6(2), which provides that, where an application for registration of a mark is filed by a national of a country of the Union, registration may not be refused, or any registration so granted invalidated, “on the ground that filing, registration or renewal, has not been effected in the country of origin.”<sup>38</sup> Although not stated, it must be assumed that the filing, registration or renewal in the country of origin is of the same mark or something substantially the same – otherwise, the provision is obviously unnecessary. The term “country of origin” is also undefined, but, in the absence of any contrary direction, some guidance may be derived from Article 6*quinquies*(2), where it is defined as the country of the Union where the applicant has a real and effective industrial establishment, or if he has no such establishment, the country of the Union where he has his domicile or of which he is a national (if he has no domicile within the Union).<sup>39</sup> Therefore, the general effect of Article 6(2) is that a Union country in which protection is sought cannot refuse or nullify protection by reference to the fact that there is no protection for the mark in its country of origin. The language used here is quite general: the terms “filing, registration or renewal” are each discrete stages in the gaining and maintenance of protection, and may not have occurred in the country of origin for a variety of reasons – for example, where is a failure of the mark to satisfy the various substantive and/or procedural requirements of the law of the country of origin or simply because of failure on the part of the applicant to initiate and complete one or other of these steps. Article 6(2) applies in any and all of these circumstances. Oddly enough, however, the prohibition here is limited to what has *not* happened in the country of origin (that is, that there has been no filing, registration or

<sup>36</sup> For more detailed treatment, see RICKETSON, *supra* note 1, Ch. 12, 12.06.

<sup>37</sup> A similar obligation applies with respect to patents under the Paris Convention, *supra* note 27, as revised at Stockholm 1967, art. 4*bis*(1)–(3).

<sup>38</sup> Under art. 3, the phrase “national of a country of the Union” includes nationals of non-Union countries who are domiciled in a Union country or who have “real and effective industrial establishments” in a Union country.

<sup>39</sup> First exploitation of the mark in that country, without anything further, is not included in this definition.



renewal of the corresponding mark), and it makes no mention of the position in any other country. This gives rise to the theoretical possibility that the protecting country could have regard to an applicant's failure to obtain protection in a country other than the country of origin.<sup>40</sup>

- (c) *Position after registration*: Notwithstanding anything in Article 6(2), once a mark is “duly registered in a country of the Union,” Article 6(3) provides for full independence of protection of that mark, namely that it is to be regarded as “independent of marks registered in other countries of the Union, including the country of origin,” underlining the territorial character of the right granted. Again, the reference to “marks registered in other countries” must mean the same or a substantially similar mark, and it is clear that protection is to be unaffected by whatever happens to these marks, whether or not this is in their country of origin.<sup>41</sup> The phrase “duly registered” should be understood as a reference to the law of the protecting country, meaning that the registration has taken place in accord with the conditions imposed under that law.

By way of conclusion, the principle of independence contained in Article 6(3) underlines and reinforces the territorial character of the trademark rights obtained under the Convention, which will then be determined under the laws of the protecting country by reason of the requirement of national treatment under Article 2(1).<sup>42</sup> This interplay between national treatment and independence of protection has important practical and legal implications, particularly with respect to issues of enforcement and exhaustion of rights, if the concept of independence of protection is interpreted as extending beyond the criteria for registration in the protecting country. While there is nothing in the Convention dealing with the exclusive rights to be accorded to trademark owners (this is also the case for patentees and design owners), if these rights, by virtue of the principle of national treatment, extend to the use of protected trademarks on imported goods, then the adoption of a domestic rule of international exhaustion in relation to imported goods bearing marks applied in another country with the authorization of the trademark owner (parallel importations) will potentially cut across the requirement of independence of protection in Article 6(3). Whether the rights of the trademark owner in the country of importation extend to such importations will depend upon what has happened in the country of origin of those goods, or indeed in any other country where the marked goods have been sold, and whether this has occurred with the authorization of the trademark owner (assuming the trademark owner is the same or a related entity in both countries). Such a reference to the legal position in the country of origin of the goods will therefore be inconsistent with the requirement of independence of protection under Article 6(3), leading to the conclusion that international exhaustion of rights is implicitly prohibited under that article.<sup>43</sup> This may be a somewhat bold conclusion to draw, and it must be said that there is no guidance in Article 6(3) as to how far the concept of independence is to be taken once the mark has been registered.

<sup>40</sup> In this regard, it should be noted that Bodenhausen appears to treat art. 6(2) as having a wider effect, namely that the filing and registration of a trademark in each country is “independent of analogous acts regarding the same trademark in other countries, even such acts in the country of origin of the trademark as defined in Article 6quinquiesA(2)”; BODENHAUSEN, *supra* note 26, at 88, § d. This appears to be a generous reading of art. 6(2), and not in accordance with its strict wording.

<sup>41</sup> BODENHAUSEN, *supra* note 26, at 88, § e.

<sup>42</sup> See also NUNO PIRES DE CARVALHO, *THE TRIPS REGIME OF TRADEMARKS AND DESIGNS*, 82, § 2.22 (2011).

<sup>43</sup> *Id.* at 139–40, § 6.38. Note that issues of exhaustion are not addressed one way or the other under art. 6 of the TRIPS Agreement. See also *id.* at 132.



## 2 Recognition of Marks Registered in Country of Origin (Dependence of Protection)

The other side of the coin to independence of protection is the notion that a mark duly registered in its country of origin should be recognized, and therefore entitled to protection, in other countries of the Union. The provisions concerned with this are now contained in Article 6*quinquies*, which was put into its present form at the Lisbon Revision Conference, following a more widely formulated (and subsequently revised) provision that was contained in the original Paris Act 1883.<sup>44</sup> The distinction drawn here by the Lisbon Conference was between “ordinary marks” or marks in general (the subject of Article 6) and marks “as they are” (the subject of Article 6*quinquies*).<sup>45</sup> While this distinction may seem nebulous, it is in fact pointing to a specific and limited situation; namely, where a mark is already registered in one Union country and protection for it is sought in other Union countries. In such a case, it can be argued that international trade and commerce will be facilitated if there is ready acceptance and recognition of the same mark in other Union countries where the trademark owner wishes to do business. On the other hand, any obligation to accord recognition needs to be tempered by reservations to national laws that allow for the withholding of protection in specified circumstances.

**The starting point:** The circumstances in which recognition must occur are set out in Article 6*quinquies*A(1), which provides that every trademark “duly registered in its country of origin shall be accepted for filing and protected ‘as is’ (*telle quelle*) in the other countries of the Union, subject to the reservations indicated in this Article.” The requirement that the mark must be “duly registered” in its country of origin means that the mere filing of an application in that country is not enough (as under the original Paris Act of 1883),<sup>46</sup> and certainly not just use of the mark as might suffice for protection of an unregistered mark under unfair competition law.<sup>47</sup> The expression “country of origin” is defined in some detail in Article 6*quinquies*A(2) (see above).

**Scope of protection to be granted:** Under Article 6*quinquies*A(1), marks fulfilling the above conditions are to be “accepted for filing and protected as is in the other countries of the Union.” The phrase “as is” (*telle quelle* in the authentic French text)<sup>48</sup> receives no further clarification in the text, apart from the phrase which immediately follows: “subject to the reservations indicated in this Article” (this is a reference to the exceptions set out in Article 6*quinquies*B and C, which are discussed below). In the Paris Act of 1883, it was made clear that the requirement of recognition under Article 6 of that Act was a reference to the “form of the mark” as it had been filed in the country of origin and nothing else.<sup>49</sup> This interpretation was not included in later

<sup>44</sup> See Paris Convention, *supra* note 27, art. 6 and, in particular, the subsequent revisions made to art 6 in the Washington Act 1911, *supra* note 20.

<sup>45</sup> Actes 1958, *supra* note 23, at 750.

<sup>46</sup> Paris Convention, *supra* note 27, § 1.

<sup>47</sup> BODENHAUSEN, *supra* note 26, at 105, § c.

<sup>48</sup> It may be noted that in the unofficial BIRPI translations of earlier Acts of the Convention (see Washington Act 1911, *supra* note 20, art. 6, and see also the Hague Act 1925, *supra* note 23, art. 6, and see also Lisbon Act 1958, *supra* note 23, art. 6*quinquies*), the phrase *telle quelle* was rendered as “in its original form” rather than “as is,” as in the established English text of the Paris Convention, *supra* note 27, as revised at Stockholm 1967. As will be seen in the discussion in the principal text, the phrase “in its original form” was undoubtedly a clearer indication of what was intended here, but was far from a literal translation of the words “*telle quelle*.”

<sup>49</sup> Thus, the following interpretation in para. 4 of the Final Protocol to that Act stated that art. 6, para. 1, was to be understood:

in the sense that no trade mark may be excluded from protection in one of the States of the Union for the sole reason that it does not comply, with regard to the signs of which it is composed, with the conditions of the laws of that State, provided it complies on this point with the laws of the country of origin and that it has been properly filed there. Subject to this exception, which concerns only the form of the mark, and subject to the provisions of the other Articles of the Convention, each State shall apply its domestic law.

Paris Convention, *supra* note 27, as revised at Stockholm 1967, § 4

Acts of the Convention, leaving uncertainty as to its scope, in particular whether this required country A to recognize and protect a mark registered in country B, where this would not otherwise have qualified as a trademark under the law of country A. Examples were such things as three-dimensional shapes, even the shape of the article itself, and, more recently, sounds and smells. This was an issue raised by the British delegation to Washington in 1911, noting that while agreeing to the text of what is now Article 6*quinquies*A(1), one could not disregard the fact that in many of the countries of the Union there were diverging interpretations of the expression “trademark” (“marque de fabrique”).<sup>50</sup> Indeed, it was only on the basis of statements by other delegates in committee that it was open to each country to decide for itself what may or may not be admitted as a trademark that the British delegates felt able to agree to the wording of the provision.<sup>51</sup>

As this issue was never clarified in subsequent revisions of Article 6*quinquies*A(1) or its predecessors, some uncertainty arises as to the scope of recognition required under that provision.<sup>52</sup> Thus, if the words “as is” mean the form of the mark, as registered in its country of origin, does this require recognition in a case where the alleged trademark meets the substantive requirements of the law of its country of origin but not of the country in which recognition and protection is now sought (as in the case of shape marks, the example raised by the UK delegation in Washington in 1911)? What if the laws of both countries potentially protect the same elements as a trademark (for example, words or devices which have long been accepted as registrable signs in most national laws) but the law of the country where recognition is sought denies protection on the basis of a particular rule of the forum that certain kinds of words (for example, descriptive or geographical words, are not protected under its law)?<sup>53</sup> A full-blooded application of the recognition principle would imply that all marks, regardless of these differences, should be protected in the event that they are registered in their country of origin, even if this leads to disparities between the positions of locals and foreigners in the country where recognition is sought. Such an interpretation, however, may place too much emphasis on the words “as is” in Article 6*quinquies*A(1) rather than on the words “trademark” which precede it and which do seem to presuppose that a mark will have to be a “trademark” in the protecting country before recognition of its country of origin registration can be required. This was a matter that the programme for the Lisbon Revision Conference sought to address in a somewhat radical proposal that the word “signs” should be substituted for “trademark” in Article 6*quinquies*A(1), so as to read: “[A]ny sign regularly registered as a trade mark in the country of origin shall be accepted.”<sup>54</sup> This proposal, however, was defeated in the third committee of the Conference, largely due to the fears of many countries, such as the United Kingdom, that this would have required giving protection to signs that were not protected under domestic law at the time (this, indeed, would have been the effect of the amendment).<sup>55</sup> A decisive majority favoured retention

<sup>50</sup> Actes 1911, *supra* note 20, at 252 (third plenary session).

<sup>51</sup> Report of the British Delegates to the Washington Conference, Cmnd, p. 98. These “comments” do not appear to be recorded in the Actes 1911, *supra* note 20.

<sup>52</sup> See also BODENHAUSEN, *supra* note 26, at 110–11.

<sup>53</sup> The programme proposals of the International Bureau at the Lisbon Revision Conference cited several instances in French and Austrian law to support these last examples, where registration had been accepted of words that were protected in their countries of origin, but which would not have otherwise been protected under their domestic laws, apart from the obligation of recognition under what was then art. 6A of the London Act: see Actes 1958, *supra* note 23, at 573–74.

<sup>54</sup> Actes 1958, *supra* note 23, at 576.

<sup>55</sup> *Id.* at 601. It was lost decisively in the Third Committee with twenty-two against, seven in favour and six abstentions.

of the present provision, notwithstanding the difficulties of interpretation it raised.<sup>56</sup> But while the resulting uncertainty is unsatisfactory from the perspective of anyone desiring clarity in international agreements, this may not be a problem in practice, when regard is had to the following matters:

- (a) The definition of “trademark” under most national laws has now extended to include the kinds of subject matter that were problematic in earlier times, such as the shape of goods, packaging, sounds and smells. Accordingly, the burden of having to recognize something as a trademark that is not protected as such under one’s own law may not often arise.
- (b) The exceptions reserved to national laws under Article 6*quinquies*B and C may operate to deny protection in specific cases, without necessarily engaging the wider question of whether recognition is required in the first place. These exceptions, which are listed below, have been augmented over time, and do much to temper the absolute character of any obligation of recognition otherwise applying under Article 6*quinquies*A.
- (c) If Article 6*quinquies*A(1) is concerned only with the “form of the mark,” this must mean that protecting countries remain free to apply restrictions on protection that do not relate to these matters.<sup>57</sup> One such matter might be a requirement of prior use of the mark or a condition that applicant must possess an industrial or commercial enterprise.<sup>58</sup> A further one would be requirements as to ownership.<sup>59</sup>
- (d) Finally, it goes without saying that the problems discussed here would not arise if the Convention contained a definition of the subject matter – trademarks – that are to be protected. This, of course, is a problem that bedevils the Convention in other areas such as patents and industrial designs – and is now, to some extent, addressed in the provisions of the TRIPS Agreement.

### 3 Exceptions to the Obligation of Recognition in Article 6*quinquies*A(1)

These exceptions are contained in Article 6*quinquies*B, which provides that trademarks covered by Article 6*quinquies*A(1) may be “neither denied registration nor invalidated” (the principle of recognition), except in the following circumstances:

- (a) when they are of such a nature as to infringe rights acquired by third parties in the country where protection is obtained;
- (b) when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended

<sup>56</sup> *Id.* There were twenty-seven in favour and five against, with no abstentions.

<sup>57</sup> Note here the view of the World Trade Organization Appellate Body in United States – Section 211 Omnibus Appropriations Act of 1998, WT/DS176/ABB/R, §§ 122–48 (Feb. 1, 2002).

<sup>58</sup> BODENHAUSEN, *supra* note 26, at 111, § e.

<sup>59</sup> See also the decision of the World Trade Organization Appellate Body, *supra* note 57, §§ 122–48 concerning such a requirement in § 211 of the United States Omnibus Appropriations Act 1998 law with respect to the recognition of ownership claims regarding confiscated (Cuban) trademarks. And, in another recent proceeding, the WTO Panel said, in relation to the word “protected” in Article 6*quinquies*A(1): “In our view, the text suggests that the term ‘protected’ refers to the protection that flows from the registration of a sign as a trademark in that jurisdiction where the registration is obtained pursuant to the requirements of Article 6*quinquies* A(1). We note that the term ‘protected’ in Article 6*quinquies* A(1) in itself does not provide any guidance as to what the protection flowing from the registration under the domestic law should consist of.” Australia – Certain Measures Concerning Trademarks, Geographical Indications and Other Plain Packaging Requirements Applicable to Tobacco Products and Packaging, Reports of the Panels, WT/DS435/R, WT/DS441/R WT/DS458/R, WT/DS467/R, 28 June 2018, para. 7.1765 and see further 7.1766–7.1775. No issue as to the interpretation of Article 6*quinquies*A was appealed to the Appellate Body in its decision of 9 June 2020: WT/DSB435/AB/R, and WT/DSB441/AB/R, par 6.544, n 1444, and see also par 6.649.

- purpose, value, place of origin of the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed;
- (c) when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public;
  - (d) a final proviso makes Article 6*quinquies*B subject to the application of Article 10*bis* which deals with acts of unfair competition (an instance would be where the use of the mark sought to be registered would be of such a nature as to mislead or create confusion as to the nature or characteristics of the goods to which it is to be applied, as provided for in Article 10*bis*(3)(c)).

While limited to marks falling within Article 6*quinquies*A(1), the exceptions listed in Article 6*quinquies*B can be seen as reflecting guidelines as to substantive standards for the registration of marks that Union members might wish to adopt in their national laws generally and which could therefore become the basis for substantive norms to be embodied in another international instrument, such as the TRIPS Agreement, a special WIPO treaty or even a revised version of Paris itself (if this ever proved possible).

Further provisions in Article 6*quinquies* elaborate upon its field of application and include the following: (a) there is no need for there to be exact identity between marks which differ from the registration in the country of origin of the mark only in relation to “elements that do not alter the distinctive character and do not affect the identity of the marks in the form in which these have been registered in the said country of origin” (Article 6*quinquies*C(2)); (b) no person is to benefit from its provisions if the mark for which protection is claimed is not registered in the country of origin – that is, if registration in the country of origin has lapsed for some reason, such as through non-renewal, forfeiture, or nullification (Article 6*quinquies*D);<sup>60</sup> (c) no obligation to renew arises on the part of any other country in which the mark has been registered pursuant to Article 6*quinquies*A, where renewal has been effected in its country of origin, meaning therefore that it is left to the rightholder to seek renewal in these other countries in the normal way (Article 6*quinquies*E); and (d) the benefits of priority under Article 4 are to be accorded to applications for registration of marks filed within the priority period fixed by Article 4C (six months), even when registration in the country of origin does not occur until after the expiration of such period – in other words, applications falling within the circumstances outlined in Article 6*quinquies*A will still have the same priority rights as other applications (Article 6*quinquies*F) and will not be prejudiced by delays occurring in the registration system of the country of origin – for example, where there have been protracted pre-grant opposition proceedings.

### C Service Marks

From its inception, the provisions of the Paris Convention dealt only with trademarks for manufactured goods. Recognition that marks could be equally important in relation to the provision of services was slow in coming, and received only grudging and limited acceptance in Article 6*sexies*, which was added as late as at the Lisbon Act of 1958, together with their inclusion as a subject for national treatment under the definition of “industrial property” in Article 1(2).

<sup>60</sup> In such a case, the principle of independence of protection should ensure the validity of any registration in the protecting country.

Article 6*sexies* was a compromise provision that provides simply that: “The countries of the Union undertake to protect service marks. They shall not be required to provide for the registration of such marks.” The obligation here is in similar terms to that for industrial designs under Article 5*quinqüies*, albeit even more clearly expressed in that it is stipulated that no registration system is required. In this regard, the General Report to the Conference emphasized that the “modalities” of this protection were for member countries to determine for themselves; for example, that they might do so through the application of domestic unfair competition laws.<sup>61</sup> As a matter of practice, it now seems the case that most Union countries have adopted registration systems for service marks, and this, in turn, is reflected in the Nice classification system which provides for classes of services as well as goods. So far as the Paris Convention itself is concerned, apart from the obligation to give protection under Article 6*sexies* and the general obligation to accord national treatment under Article 2(1), none of the other provisions of the Paris Convention relating to trademarks apply to service marks. In particular, this excludes the priority system established under Article 4, the obligations with respect to well-known marks under Article 6*bis*, the prohibitions on state emblems, flags and the like under Article 6*ter*, the application of Article 6*quater* on assignments, and the obligation of recognition of marks registered and protected “as is” in their country of origin under Article 6*quinqüies*. To the extent that service marks are assimilated to trademarks under the domestic laws of a Union country, such provisions will be extended to the service marks of nationals of other Union countries under the principle of national treatment, but not otherwise. Accordingly, while a protecting country with a registered service mark system might well accord priority to service marks which have been first filed in another Union country, there is no obligation for them to do so under Article 4 of the Paris Convention. This last-mentioned lacuna is now addressed in Article 62.3 of the TRIPS Agreement, which provides that WTO members are to apply Article 4 of the Paris Convention *mutatis mutandis* to service marks.

#### D Well-Known Marks

The protection of well-known marks under the international conventions is the subject of a separate chapter in this work, so will only be touched upon lightly here. The relevant provision of the Paris Convention is found in Article 6*bis*, which has been supplemented by subsequent international agreements, such as the TRIPS Agreement, as well as by developments in national laws. Article 6*bis* was adopted at the Hague Revision Conference,<sup>62</sup> and appears to have received considerable impetus from the work of the Economic Committee of the League of Nations, which had prepared draft articles relating to the prevention of unfair competition and other practices, including the protection of foreign marks where confusion was caused to local consumers.<sup>63</sup> It was refined further at later revision conferences, and the form and content of the present provision in Article 6*bis* of the Stockholm Act is the same as that adopted at Lisbon.<sup>64</sup> In essence, it allows the owners of well-known marks (for goods) to object to the registration by a third party of a corresponding mark that is a reproduction, imitation or translation liable to create confusion with the well-known mark, or to seek its invalidation within a specified period (five years) other than in cases where the mark has been registered or used in bad faith. The

<sup>61</sup> Actes 1958, *supra* note 23, at 118.

<sup>62</sup> Actes 1925, *supra* note 21, at 241–42, 246, 341–42, 453–56, 523, 543–44, 577.

<sup>63</sup> League of Nations, Economic Committee, Conference of Experts, Geneva (5 May 1924).

<sup>64</sup> See also Actes 1934, *supra* note 22, at 187, 275–76, 398–400, 464, 516, and Actes 1958, *supra* note 23, at 637–40, 640–56, 656–66, 757–59, 666–68, 101–02, 117.

requirements here are multi-layered, and embody a carefully limited set of international norms with respect to the protection of well-known marks which are now supplemented under Article 16 of the TRIPS Agreement.<sup>65</sup>

### *E State Emblems, Armorial Bearings, Flags and the Like*

Emblems of sovereignty, governance and public institutions, such as coats of arms and similar symbols, have a considerable history of use in most countries, particularly in Europe. Traders have long recognized the market advantages that may flow from incorporating such elements into their marks and brands. These matters have been the subject of detailed regulation under the Paris Convention from the Hague Act onwards,<sup>66</sup> but had been dealt with to some extent in the Final Protocol of the Paris Act of 1883 in relation to marks that might be refused registration as being contrary to public order where these involved the “use of public armorial bearings and decorations.”<sup>67</sup> The present provision in Article 6ter is a complicated one which includes a facilitative mechanism<sup>68</sup> for member states to communicate, through the medium of WIPO, relevant “armorial bearings, flags and other State emblems” which each member will undertake to recognize and prevent from being incorporated in trademark registrations applied for by third parties, as well as prohibiting the actual use of marks incorporating such elements.<sup>69</sup> This obligation extends to “official signs and hall-marks,”<sup>70</sup> as well as to the bearings, flags, emblems, abbreviations and names of international organizations.<sup>71</sup> The obligations imposed under Article 6ter are the most specific to be found in the Convention, and reflect an early concern of Paris Union countries to protect each state’s emblems against unauthorized exploitation by traders and manufacturers within their jurisdiction. In general, the protection required here applies regardless of whether confusion or deception results from their use in third-party trademarks,<sup>72</sup> and such protection extends to the use of “imitations” of such emblems,<sup>73</sup> with the curious qualification that this only applies to imitations “from a heraldic point of view.”<sup>74</sup> There

<sup>65</sup> Chapter 5 in this volume addresses TRIPS’s treatment of well-known marks.

<sup>66</sup> Actes 1925, *supra* note 21, art. 6ter. Significant proposals here emanated from preliminary documents prepared for the League of Nations, Economic Committee, Conference of Experts on Unfair Competition, *Consideration of an International Draft Convention*, to be held in Geneva, May 5, 1924, dated Oct. 15, 1923 (document in Australian Archives, A432/80, 1938/555, Part 1, No. 2).

<sup>67</sup> Paris Convention, *supra* note 27, Final Protocol, § 4.

<sup>68</sup> Paris Convention, *supra* note 27, as revised at Stockholm 1967, art. 6ter(3) and (4).

<sup>69</sup> *Id.* art. 6ter(1)(a).

<sup>70</sup> *Id.*

<sup>71</sup> *Id.* art. 6ter(1)(b). This excludes armorial bearings, flags, other emblems, abbreviations and names that are already protected under other international agreements; an example of such an agreement is the Convention (I) for the Amelioration of the Condition of the Wounded and Sick in Armed Forces in the Field, art. 44, Geneva (Aug. 12, 1949), covering the use of the Red Cross emblem and flag.

<sup>72</sup> This underlines the different functions played by state insignia and privately owned trademarks.

<sup>73</sup> Paris Convention, *supra* note 27, as revised at Stockholm 1967, art. 6ter(1)(a).

<sup>74</sup> The following explanation of the scope of the “heraldic imitation” offered in a recent WIPO document may be of assistance here as to what the qualification intends:

This qualification effectively narrows down the scope of the impermissible imitation beyond what would normally be considered unacceptable in trademark law. As State emblems frequently comprise common symbols, such as a lion, an eagle or the sun, imitations are forbidden only if they reproduce the heraldic characteristics of the State sign concerned. In consequence, the symbol as such remains free and may be used in the composition of trademarks.

WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, Fifteenth Session, “Article 6ter of the Paris Convention: Legal and Administrative Aspects,” Geneva, 28 November–2 December 2005, SCT/15/3 (Oct. 14, 2005).



is also a provision for countries to object to the protection required under the article within twelve months from the receipt of notification from WIPO,<sup>75</sup> although no grounds for objection are indicated.<sup>76</sup> There is no mechanism for resolving disputes between the country making the notification and the country objecting, apart from the theoretical possibility of seeking a determination from the International Court of Justice under Article 28 (if both countries accept the jurisdiction of that body). In the absence of resolution, therefore, the result of objection will be that the country objecting is not bound to comply with Article 6*ter*(1), although countries not objecting clearly will be. More detailed guidance on the practical operation of Article 6*ter* is to be found on the WIPO website.<sup>77</sup>

### F Assignments of Trademarks without Accompanying Goodwill

From its inception, the Paris Convention has not sought to regulate the way in which the private rights protected under its regime are dealt with by their owners; for example, through assignment or licensing. In the case of trademarks, however, a particular problem arose where marks were assigned without the business enterprise with which they were associated.<sup>78</sup> In some countries this was permissible, although issues of consumer confusion might then arise where the mark was used by the assignee. On the other hand, in many other countries this was not allowed. This, in turn, gave rise to problems where trademarks were owned in several countries and the owner assigned the mark in one country without the accompanying business, for example, to a local distributor that was otherwise unconnected with it: did this lead to the invalidity of the registration of marks registered in those countries where this was not possible? Under some national laws, it was established that assignment of the accompanying business or enterprise referred to the business or enterprise as a whole and wherever located, meaning that assignment of the mark for particular territories would not be possible in the absence of transfer of the business as a whole. The principle of independence of protection, however, would suggest that the requirements for assignments should be limited to each territory, making irrelevant what might happen elsewhere.

It was against this background of national differences that Article 6*quater*, which has remained essentially unchanged in later revisions, was adopted in the London Revision Conference in 1934.<sup>79</sup> Article 6*quater*(1) does not attempt to seek to regulate the way in which assignments of trademarks should be dealt with under national laws, but simply provides that the position in other countries should not affect the validity of registration of marks in any particular Union country, so long as the law of that country on assignments has been complied with. This is a limited provision that has no implications for countries which allow assignment of marks without accompanying business or goodwill, but it imposes a modest limitation in the case of countries with the opposite rule, namely that this is confined to what happens in those countries

<sup>75</sup> Paris Convention, *supra* note 27, as revised at Stockholm 1967, art. 6*ter*(4).

<sup>76</sup> For a summary of possible objections, see the advisory document prepared for the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, Fifteenth Session, "Article 6*ter* of the Paris Convention: Legal and Administrative Aspects," Geneva, 28 November–2 December 2005, SCT/15/3 (Oct. 14, 2005), § 28.

<sup>77</sup> See <http://wipo.int/article6ter/en/>; see also the discussion in RICKETSON, *supra* note 1, at 12.41–12.56.

<sup>78</sup> For a detailed review of this in the United States, see Irene Calboli, *Trademark Assignment "With Goodwill": A Concept Whose Time Has Come*, 57 FLA. L. REV. 772, 777–97 (2005) and, for a more general review of national laws, see STEPHEN P. LADAS, *THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY*, VOL. II, 1303–05 (1938).

<sup>79</sup> Actes 1934, *supra* note 22, at 189–91, 400–05, 466–67, 517.



and should not take account of what may have happened elsewhere. In this regard, it can be seen as simply underlining the territorial nature of trademark protection under the Convention, allowing businesses with trademark registrations in a number of Union countries to assign these marks separately, so long as this is accompanied by the business or goodwill associated with the trademark in each country where this is required. A qualification to this is then contained in Article 6*quater*(2), namely that Article 6*quater*(1) does not impose on Union countries “any obligation to regard as valid the assignment of any mark the use of which by the assignee would, in fact, be of such a nature as to mislead the public, particularly as regards the origin, nature or material qualities of the goods to which the mark is applied.” This would certainly cover the situation where a trademark has been assigned only with respect to some of the goods for which it is registered, and is then continued to be used by the assignor in respect of other similar goods not covered by the assignment.<sup>80</sup>

### *G Nature of the Goods to Which Trademark Is to Be Applied*

The origins of this article can be traced back to the Paris Act of 1883, where it was provided that the “nature of the goods to which the trade mark is to be applied shall in no case form an obstacle to the filing of the mark.”<sup>81</sup> With one important amendment – the substitution of the term “registration” for the term “filing” – it has remained unchanged in subsequent revisions, and the principle involved is a salutary one, namely that the goods for which a mark is registered are quite distinct from the mark itself and should not prove an obstacle to registration in the case of products that require lengthy health or safety assessments before they can be safely marketed, as in the case of pharmaceuticals.<sup>82</sup> It is only “obstacles” to the registration of such marks on the ground of the nature of the goods that are prohibited under Article 7: registration, of course, could be refused on other grounds, such as lack of distinctiveness or if the registration would be liable to cause deception or confusion. Furthermore, the prohibition here applies only to marks of nationals of other Union countries, meaning that it would be open to a Union member to impose such a limitation in relation to its own nationals. There is also nothing in the wording of Article 7 that excludes the possibility of other restrictions being placed on the use of a trademark by its proprietor, once registered – an issue that has become relevant in current discussions about plain packaging restrictions on the use of trademarks on tobacco products.<sup>83</sup> Finally, Article 7 does not extend to service marks; accordingly, it would be open to domestic laws to prohibit the registration of marks for gambling or prostitution services, notwithstanding that these activities may otherwise be lawful in the jurisdiction concerned.<sup>84</sup>

### *H Collective Marks*

Marks, whether for goods or services, usually identify the provenance of those goods or services with a particular source, such as the manufacturer or provider. Equally, however, marks may be

<sup>80</sup> *Id.* at 517 (example raised by the Hungarian delegate).

<sup>81</sup> Paris Convention, *supra* note 27, art. 7.

<sup>82</sup> The example of pharmaceutical products was given by Charles Jagerschmidt in the initial discussions on this provision: Actes 1880, *supra* note 10, at 89 (fifth session, 10 November 1880).

<sup>83</sup> See also TRIPS Agreement, *supra* note 31, art. 20; See also, at the national level, *Tobacco Plain Packaging Act 2011*, § 28 (Austral.); See also Sam Ricketson, *Plain Packaging Legislation for Tobacco Products and Trade Marks in the High Court of Australia*, 3 *QUEEN MARY J. INTELL. PROP.* 224–40 (2013).

<sup>84</sup> This possibility is now excluded under TRIPS Agreement, *supra* note 31, art. 15.4.

used by an association or group of producers to indicate that goods or services emanate from members of that association or group and that they therefore share particular characteristics associated with those producers; for example, a common geographic location, compliance with a particular mode of production or quality standard and so on. It is also possible that such “certification” may be provided by some public or governmental entity. In each of these instances, the application of the association or group mark will provide extra value in the marketing of those goods or services, in addition to the identification with the particular manufacturer or provider that may be provided by the latter’s own mark.

Carefully limited obligations to protect marks of this kind – called “collective marks” – have been in the Paris Convention since the Washington Revision Act of 1911. The principal obligation now contained in Article 7*bis*(1) requires:

- (1) The countries of the Union undertake to accept for filing and to protect collective marks belonging to associations the existence of which is not contrary to the law of the country of origin, even if such associations do not possess an industrial or commercial establishment.

The term “collective marks” is not defined, but it is clear from the words that follow (“belonging to associations”) that these are marks of a collective or group of traders or manufacturers, as distinct from the individual marks that each may have and apply on their own behalf. The function of the “collective mark” is also not indicated in the provision, but the expression appears to cover two distinct kinds of functions, namely that of certification (that goods possess a particular characteristic or set of characteristics), and of collective production (that they have been made by a member of a particular group of producers).<sup>85</sup> These two functions may overlap in many instances, but conceptually are distinct and in some jurisdictions may be classified as “certification” marks on the one hand and collective or association marks on the other.<sup>86</sup>

While Article 7*bis*(1) refers to the need for the marks to belong to “associations,” there is no specific requirement that these should be bodies that are incorporated or recognized in any particular way under the law of the country of origin: all that is prescribed is that the existence of the associations is not to be “contrary to the law of the country of origin.” This relieves a foreign association from having to prove affirmatively that it complies with the laws of the country of origin while reserving the right to the country where protection is sought of refusing protection where the existence of the association is shown to be contrary to those laws. Furthermore, such associations do not need to possess an industrial or commercial establishment of their own, meaning that while they may control who uses the mark and how this is done, they do not have to use it themselves with respect to any goods that they may make and market (an unlikely situation in any event with respect to such associations, but a possibility that is not excluded by the terms of Article 7*bis*(1)). It also appears that, while the word “associations” as used in Article 7*bis*(1) does not specifically exclude governmental or other public bodies that carry out certification functions, it seems clear from Conference records that it was intended to be limited to non-governmental associations of traders or manufacturers, as proposals at the Hague Revision Conference to extend this term more widely to cover marks of such governmental or other public associations were not adopted.<sup>87</sup> Having said this, even if foreign national and regional collective marks lie outside the scope of Article 7*bis*(1), they may be entitled to protection by virtue of the principle of national treatment under Article 2(1) where such protection is available

<sup>85</sup> This seems to have been contemplated in the London Conference programme: See Actes 1934, *supra* note 22, at 193.

<sup>86</sup> See, e.g., Trade Marks Act 1995, Pts 15 (collective marks) and 16 (certification marks) (Austral.); Trade Marks Act 1994, §§ 49 (collective marks) and 50 (certification marks) (UK).

<sup>87</sup> Actes 1925, *supra* note 21, at 248, 467–68, 545, 577.

under the domestic law of the protecting country, while separate protection for “official” emblems, flags and official hallmarks is available, in any event, under Article 6ter.<sup>88</sup>

So long as the obligation to protect under Article 7bis(1) is accorded, there is complete flexibility for Union members under Article 7bis(2) as to how this is done by the protecting country (each country is to be “the judge of the particular conditions under which a collective mark shall be protected”), including the discretion to “refuse protection if the mark is contrary to the public interest.” As to particular conditions that might be applied here by domestic laws, examples given in the report to the plenary committee of the Washington Revision Conference (1911) included conditions as to the character of the association seeking protection and the character of the mark itself,<sup>89</sup> conditions precluding the association itself from making or selling products to which the mark is applied,<sup>90</sup> or prohibitions on assignment.<sup>91</sup> While it is most likely that these conditions will be applied at the time of filing, it would be open for Union countries to impose further conditions at the stage of enforcement. The discretion allowed to Union countries to refuse protection of a foreign collective mark where this is “contrary to the public interest” is also wide-ranging and undefined.<sup>92</sup>

Article 7bis(3) supplements the undertaking contained in Article 7bis(1) by providing that protecting countries are not to refuse protection to the marks of any association “the existence of which is not contrary to the law of the country of origin, on the ground that such association is not established in the country where protection is sought or is not constituted according to the law of the latter country.” While the first part of this paragraph concerning establishment in the protecting country is strictly unnecessary in view of Article 2(2), the second part deals with the question of recognition where the foreign association has no legal counterpart in the protecting country and can be seen as consistent with the general requirement under international law that there should be recognition of bodies regularly constituted under the law of another country.<sup>93</sup>

### *I Use of Trademarks*

Provisions concerning the use of trademarks for which protection is claimed under the Convention are contained in Article 5C. These apply only to trademarks, but Union countries may obviously extend them to apply to service marks, at their own discretion.

- (a) *Where use of a registered trademark is required under national law:* While nothing under the Paris Convention mandates use of a registered trademark as a condition of continued validity of the registration, where this is required under national law Article 5C(1) provides that the registration is to be cancelled “only after a reasonable period” and then only if the person concerned does not “justify his inaction.” It is clear from the debates at The Hague Revision Conference,<sup>94</sup> where this provision was first proposed and approved, that there

<sup>88</sup> See also BODENHAUSEN, *supra* note 26, at 130, § d.

<sup>89</sup> Actes 1911, *supra* note 20, at 309.

<sup>90</sup> Actes 1934, *supra* note 22, at 517 (declaration in second plenary session by British delegate and acknowledged by the president of the session).

<sup>91</sup> Example given in the programme for the London Revision Conference: *id.* at 1994.

<sup>92</sup> Compare here the more restricted language used in art. 6quinquiesB(3) which refers to “contrary to public order,” and seems limited to contravention of some particular rule of the legal or social order of the protecting country – for example, that it is racist, pornographic or liable to deceive the public in that country (the example given in art. 6quinquiesB(3)). “Contrary to the public interest” in art. 7bis(2), by contrast, suggests that issues of wider concern to the protecting country might be taken into account in refusing protection.

<sup>93</sup> Actes 1934, *supra* note 22, at 194 (Conference programme).

<sup>94</sup> Actes 1925, *supra* note 21, at 339–42, 520, 541, 576.

was no desire to impose any positive requirement of “working” in Union countries (as in the case of patents), but only to provide procedural safeguards in relation to cancellation where this was so. The provision is limited to “registered” marks, so it does not touch upon the situation where a national law requires use of the mark as a prerequisite for registration in the first place – such countries remain free to impose such a requirement without any restriction. The determination of what is a “reasonable period” of non-use before cancellation can occur is also left as a matter for national laws.<sup>95</sup> What constitutes “use” of a mark is likewise left to national laws to determine, but there is a comment in the report of the Hague drafting committee that this was understood as meaning that there had been goods bearing the mark on sale in the country where protection was claimed.<sup>96</sup> Finally, no indication is provided in the provision as to what justifications for inaction may be accepted – again a matter left to national laws to determine. Natural disaster, war and the like are obvious candidates; the suggestion by the Hague drafting committee of “special circumstances of trade” would allow for a more generous range of possibilities here.<sup>97</sup>

- (b) *Use of a trademark in a different form*: Article 5C(2) deals with the situation where use of a trademark is required, but the proprietor has used a variation of the mark as registered. Added at the London Revision Conference, this paragraph provides that use of a trademark “in a form differing in elements that do not alter the distinctive character of the mark in the form in which it was registered in one of the countries of the Union” is not to lead to its invalidation or to “diminish the protection granted to the mark.”<sup>98</sup> Particular situations contemplated in the London programme as falling within the scope of this provision were uses of a trademark with translated words where the language in use in the country where goods were being sold was different, or where there were other slight differences in the mark that were made in order to adapt it to the circumstances of the country in question.<sup>99</sup> The obvious intention was to avoid too strict or rigid an application of any rule requiring that the form of the trademark actually used must be the same as the one that was registered.<sup>100</sup> Any differences, however, must be only those that do not alter the distinctive character of the mark, recognizing that this is a far from precise standard that will depend upon the circumstances of each case and the judgement of the judicial or administrative authorities of each country. The provision applies in two distinct contexts. The first is clear enough: use of the altered mark should not lead to invalidation of the registration of the mark in jurisdictions where use is a condition for continued registration. The second – that it should not be used as a way of “diminishing the protection granted to the mark” – goes to the rights granted to the proprietor of the mark under national law, which is not something otherwise addressed by the Paris Convention (unlike in Article 16 of the TRIPS Agreement). Thus, if the mark is used in this altered

<sup>95</sup> While there was a majority in the third subcommittee of the Hague Revision Conference in favour of specifying a period of three years, there was no unanimity on this point and the expression “reasonable period” (“*une délai équitable*”) was adopted by the drafting committee as being “less categoric”: *id.* at 520 (report of general committee) and 541 (report of drafting committee). The minimum three-year period now appears in the TRIPS Agreement, *supra* note 31, art. 19.1.

<sup>96</sup> Actes 1925, *supra* note 21, at 541.

<sup>97</sup> *Id.* (also suggested by the UK delegate at p. 441).

<sup>98</sup> Actes 1934, *supra* note 22, at 178–79, 264–65, 387–88, 460, 515.

<sup>99</sup> *Id.* at 178.

<sup>100</sup> *Id.*

form by a third party without authority, it is to be regarded as much as an infringement as would use of the mark in its original form.

- (c) *Concurrent uses of trademark*: Article 5C(3), which was adopted at the London Revision Conference in 1934, deals with only one particular, and limited, instance of concurrent use of “the same mark on identical or similar goods” by industrial or commercial establishments that are considered to be co-proprietors of the mark under the domestic law of the country where protection is claimed.<sup>101</sup> In such circumstances, this is not to prevent registration of the mark or “to diminish in any way the protection granted to the said mark in any country of the Union” (subject to the rider that such use does not mislead the public and is not contrary to the public interest). The restriction here to co-proprietors is a narrow one, leaving national laws free to legislate how they wish with respect to other situations in which concurrent use of a mark might occur.

### *J Seizure on Importation and “Appropriate Legal Remedies”*

The Paris Convention touches only lightly upon the enforcement within Union countries of the industrial property rights that they undertake to protect under the Convention: in general, the matter of remedies for infringement of these rights is a matter for national treatment under Article 2(1).<sup>102</sup> Limited exceptions to this general approach are to be found in Article 9, which deals with the seizure on importation of goods unlawfully bearing protected trademarks and trade names, Article 10, which extends this protection to goods bearing false indications of source, and Article 10ter, which requires Union countries to provide “appropriate legal remedies” to repress all the acts referred to in the preceding articles (including also Article 10bis on unfair competition). Both Articles 9 and 10 can be traced back to the original 1883 Paris Act. Although framed in apparently stringent terms, on closer inspection it will be seen that they ultimately require little of national laws. The following discussion deals only with Articles 9 and 10ter, which are concerned with trademarks and trade names (the other provisions, Articles 10 and 10bis, being concerned with indications of source and unfair competition, respectively).

The basic obligation under Article 9(1) requires that “all goods unlawfully bearing a trademark or trade name shall be seized on importation into those countries of the Union where such mark or trade name is entitled to legal protection.” Article 9(3) then provides that seizure is to take place “at the request of the public prosecutor, or any other competent authority, or any interested party, whether a natural person or a legal entity, in conformity with the domestic legislation of each country” and, in an interesting gloss, Article 9(2) provides that such seizure is “likewise to be effected in the country where the unlawful affixation occurred or in the country into which the goods were imported.” This last provision, inserted in the Washington Revision Conference, has remained unchanged since this time, and it is noteworthy that, unlike other Paris Convention provisions, it imposes obligations on both the country of importation and the country from which the goods emanate and where the mark was applied unlawfully.<sup>103</sup> Nonetheless, these obligations are not as stringent as might be thought on a first reading. First, under Article 9(4), the seizure obligation under Article 9(1) does not extend to goods that are in transit, although authorities are free under this provision to seize them if domestic law so

<sup>101</sup> Actes 1934, *supra* note 22, at 460–01, 515, and *see also* Actes 1958, *supra* note 23, at 544–46, 546–64, 746–50.

<sup>102</sup> Subject to the express reservation to national laws under art. 2(3) of provisions relating to judicial and administrative procedures and jurisdiction, and the designation of an address for service or appointment of an agent.

<sup>103</sup> Actes 1911, *supra* note 20, at 301–02, 309, 254–55.

provides.<sup>104</sup> Secondly, Article 9(5) and (6) contain a sliding scale of lesser alternative measures that Union countries may adopt at their discretion in lieu of seizure. Under Article 9(5), if the domestic law of the importing country does not permit seizure on importation, seizure “shall be replaced by prohibition of importation or by seizure inside the country.”<sup>105</sup> However, the imperative character of this direction is qualified by Article 9(6), which provides that if domestic law permits neither seizure on importation nor prohibition of importation nor seizure inside the country, “then, until such time as the legislation is modified accordingly, these measures shall be replaced by the actions and remedies available in such cases to nationals under the law of such country.” The mandatory aspects of Article 9(1) and (5) therefore come into play only after implementing domestic legislation is in place; up until that time, national treatment of foreign trademark owners is all that can be expected or required. Furthermore, the words “until such time as the legislation is modified accordingly” in Article 9(6), added in the Hague Revision Conference, do not impose any obligation on Union countries to move to the adoption of seizure or importation prohibition measures at some finite time; rather, they are to be seen as a “simple invitation addressed to countries of the Union which creates no commitment, even moral, for them [to adopt such measures].”<sup>106</sup>

Further aspects of Article 9 that call for comment are:

- (a) *Meaning of “unlawfully applied”*: This applies to both trademarks and trade names which must have been “unlawfully applied” to goods. It is not stated under which law the issue of unlawfulness is to be determined, but it must be assumed that this must at least be the country where the application has occurred (usually the country of export). Support for this conclusion is to be found in the reference to the “country where the unlawful affixation occurred” in Article 9(2), but the further question arises as to whether the unlawfulness must arise under the law of the country of importation as well. The answer to this second question must then be found in Article 9(1) which posits that the trademark or trade name must be entitled to legal protection in the Union country into which such importation occurs. The most likely scenario in which the downwardly cascading obligations contained in Article 9(1), (5) and (6) will be activated in the country of importation will be where the trademarks in question are registered in both that country and the country of affixation and has been applied without authorization in the latter. Such a scenario will usually require that the owner of the trademark is the same in both countries or that they are linked in some other way, for example as part of a larger corporate group or through contractual ties. Other scenarios where the marks are unregistered may also be possible, but will depend on how such protection is applied in both countries, and the same will be true of trade names that are unlawfully applied to goods. For most practical purposes, however, the positive obligations under Article 9 have a restricted scope, and will have no application, apart from the overall national treatment obligation, if the country in question has not yet adopted the required seizure or importation measures in accordance with Article 9(6). On the other hand, if it is accepted (as suggested above) that international exhaustion of rights is inconsistent with the principle of independence of protection embodied in Article 6(3), it would follow that some form of relief, if not seizure, should be provided, even in relation

<sup>104</sup> It appears that this exclusion does not apply to the warehousing of goods while they are in transit: Bureau International de l'Union, *Actes de la Conférence Réunie à Paris 1880–1883*, p. 88 and see further pp. 27 and 97.

<sup>105</sup> Adopted at the Brussels Revision Conference: *Actes 1897–1900*, *supra* note 19, at 45–46, 246–49, 255–56, 311–12.

<sup>106</sup> *Actes 1925*, *supra* note 21, at 470 (report of fourth subcommittee, statement by the French delegate in response to concerns expressed by the Swiss delegate), 525 (repeated in the general report) and 545 (drafting committee).

to the parallel importation of goods bearing marks that have been applied with the authorization of the trademark owner in the country of affixation.

- (b) *Seizure in the country of unlawful application*: This alternative, referred to in Article 9(2), poses practical difficulties of detection and proof, given that there is no trigger point such as importation as in the case of the country of importation where such procedures can be more readily activated at the point of entry into the country. Taken literally, Article 9(2) compels the result that the country of unlawful affixation should have such procedures available at the time the unlawful affixation occurs. In practice, of course, this obligation may be deferred by reason of Article 9(6), so long as the foreign trademark owner can avail itself of the same actions and remedies that are available to nationals of that country.
- (c) *Seizure on importation and seizure inside the country*: From a trademark owner's perspective, seizure at the point of entry into the importing country is obviously the most efficacious, thereby preventing the objectionable goods entering into the marketplace in that country, and this is the primary obligation imposed under Article 9(1). However, the options of prohibiting importation altogether or providing for seizure within the country (after importation) are available under Article 9(5). In practice, these options may be more difficult to implement, and Article 9(5) provides no further direction as to how they are to be activated or by whom, e.g., at the request of the public prosecutor, other competent authority or "interested party," as under Article 9(3). Accordingly, it must be assumed that this will be a matter for domestic laws to determine, with the further option under Article 9(6) of leaving this entirely as a matter for national treatment in the event that these laws do not provide for any of the procedures referred to in Article 9(1) or (5). At the same time, it should be noted that if prohibition or internal seizure procedures (however described) are provided under domestic laws, Article 9(5) obviously requires that these should be available to trademark and business name owners from other Union countries.

### 1 *Appropriate Legal Remedies*

This was adopted at The Hague Revision Conference, on the basis of proposals originally formulated by the League of Nations' Economic Committee.<sup>107</sup> On its face, Article 10ter(1) provides an intriguing set of largely unexplored undertakings by Union countries to "assure" to the nationals of other Union countries "appropriate legal remedies effectively to repress all the acts referred to in Articles 9, 10 and 10bis." Questions of standing with respect to associations and federations of industrialists, producers, or merchants are then addressed in Article 10ter(2).

So far as trademarks and trade names are concerned, the relevant "acts" referred to are those in Article 9, namely the importation of goods bearing trademarks or trade names unlawfully applied. Given that the default position under Article 9(6) is national treatment, Article 10ter(1) appears to mean that something additional is still required by way of provision of "appropriate legal remedies" in order "effectively to repress" the activities proscribed in that Article. However, in view of the specific mention of seizure procedures and importation measures in Article 9(1) and (5), and the default national treatment provision in Article 9(6), these measures could not in themselves be made a requirement through the back door under Article 10ter(1). What else, then, may be required under that article by way of legal remedies? The answer may well be supplied by application of national treatment under Article 2(1), where the country in question already has a wide range of remedial relief available to local claimants. On the other hand,

<sup>107</sup> *Id.* at 93 (proposals made by the Economic Committee, League of Nations, 5 May 1924) and 271 (programme proposals).



national treatment carries with it no prescription as to content, only the requirement that there should be no discrimination against foreigners. It therefore follows that Article 10*ter* embodies a more substantive requirement of a minimum of remedies that should be available to foreign rightholders, even in the unlikely event that these are not enjoyed by locals. What kinds of measures, then, would constitute “appropriate legal remedies to repress” the activities proscribed by Article 9 (and Articles 10 and 10*bis*), notwithstanding the generality of this formulation that leaves considerable discretion to each Union country?

Some pointers on these matters are to be found in the records of the Hague Conference at which Article 10*ter* was adopted.<sup>108</sup> The first is that “appropriate legal remedies” do not extend to the imposition of penal sanctions.<sup>109</sup> Secondly, notwithstanding its generality, there are comments in the report of the fourth subcommittee to the Hague Conference indicating that the minimum kind of civil remedies that might be expected to be available would include: (1) injunctions or orders to cease; (2) damages and interest; (3) punishment, though presumably not of a penal kind, of tortious acts with a preventative as well as a compensatory aim.<sup>110</sup> While there may be some uncertainty about the third of these suggestions, the first two fall squarely within the range of civil remedies ordinarily available in most domestic legal systems, although it cannot be presumed that they will necessarily be available in each country with respect to the various acts specified in Articles 9, 10 and 10*bis*. Accordingly, a strong case can be made that in these instances, at least, remedies such as injunctions and damages are required to be available under Article 10*ter*. Even in the case of the third, there may be other potential forms of relief that will serve a preventative as well as compensatory purpose – for example, awards of exemplary or additional damages, orders for an account of profit that strip a defendant of ill-gotten gains, orders for delivery up of dies or moulds used for the unlawful application of trademarks, removal or erasure of offending signs, etc.<sup>111</sup> While considerable discretion is left to domestic laws as to how they give effect to the obligations under Article 10*ter*, the ultimate goal must be to “repress” or eliminate the kinds of unlawful acts specified in the preceding three articles, and this means something more than reflexive reliance upon whatever remedies may already be available under national treatment.

### K Miscellaneous Provisions

Other provisions of the Paris Convention that touch on trademarks and related topics should be briefly noted here.<sup>112</sup>

- (a) *Grace periods for payment of maintenance fees*: No less than six months should be allowed for the payment of fees prescribed for the maintenance of rights, subject to the payment of a surcharge if prescribed by domestic legislation: Article 5*bis*(1).
- (b) *No marking of goods*: No mention or indication of the registration of the trademark on goods can be required as a condition of the right to protection: Article 5D.

<sup>108</sup> See also *id.* at 349–51, 478–80, 525–6, 547 (report of drafting committee).

<sup>109</sup> It appears that the US delegates were strongly opposed to their inclusion, as originally proposed in the Conference programme: See also *id.* at 252–55, 271, 457, 470, 478–80. See also *id.* at 525–26 (report of general committee), 547 (report of drafting committee) and 581 (adoption in second plenary session).

<sup>110</sup> *Id.* at 479.

<sup>111</sup> See, e.g., Trade Marks Act 1994, §§ 41(2), 15 and 16 (UK).

<sup>112</sup> For the sake of completeness, several other provisions of the Convention touching on trademarks should be noted: art. 6*septies* (measures to be taken where local agents or representatives register the mark of an overseas owner without the latter's permission) and art. 11 (“temporary protection” to be given to patentable inventions, utility models, industrial designs and trademarks in respect of goods exhibited at “official or officially recognized international exhibitions” held in the territory of any Union country). See also RICKETSON, *supra* note 1, Chs. 12, 12.63 and 12.98.

- (c) *Protection of trade names*: Under Article 8, Paris Union countries are required to protect trade names, that is, the names used by traders in relation to their businesses as distinct from marks used in relation to goods or services. This protection is to be without any obligation of filing or registration and is to be given regardless of whether the name forms part of a trademark. This is a positive obligation which leaves considerable discretion to Union countries as to how they accord protection, but goes beyond what might otherwise be required under national treatment (which might be satisfied by providing no protection at all, so long as this was also the case for local claimants).<sup>113</sup>

## V CONCLUDING REMARKS

It is easy to dismiss the provisions of the Paris Convention dealing with trademarks as being of limited significance. Thus, they contain little by way of substantive norms as to what is to be protected, how this is to be done, the length of that protection, or the permissible exceptions that may be made to it. Nor do they deal, other than in minor ways, with the procedural or administrative aspects of obtaining and maintaining protection. Such initiatives at the international level have occurred in the arena of trade-related rights through the TRIPS Agreement, through regional instruments, such as in the EU, and through the development of separate WIPO treaties. On the other hand, the priority system to enable foreign traders to access the legal systems of other countries and the national treatment requirement that applies once they have arrived provide a solid platform on which further protections can be built and have underpinned the international system of trademark protection for nearly 140 years. And, as we have seen, there are some other important, if limited, obligations that apply to Paris Union countries, not the least of which is the independence of protection requirement under Article 6, the recognition of marks already registered under Article 6*quinquies*, and the somewhat idiosyncratic provisions with respect to state flags and emblems under Article 6*ter*. Other matters may be only of marginal significance, representing works in progress that have never progressed to completion, such as the provisions on well-known marks, assignments, agents and seizure on importation. Nonetheless, the important thing about platforms is that they represent starting points for future development, and this is the central and historic role played by the Paris Convention.

<sup>113</sup> See also RICKETSON, *supra* note 1, Chs. 12, 12.81, and 12.82.