

**ITU-T GUIDELINES RELATED TO THE INCLUSION OF MARKS IN ITU-T
RECOMMENDATIONS**

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ITU-T GUIDELINES RELATED TO THE INCLUSION OF MARKS IN ITU-T RECOMMENDATIONS

1. Introduction

1.1 Purpose

Intellectual Property Rights (IPR) include patents, copyrights, marks and trade secrets.¹ The intent of this document is to provide guidance to ITU-T Study Groups in their consideration of the use of trademarks, service marks and certification marks in ITU-T Recommendations. Included is some general information on the issues to be addressed when considering the use of one or more marks, and some guidance on actions to be taken should the Study Group decide to reference any such marks.

1.2 Background – Trademarks, Service Marks and Certification Marks as Forms of Intellectual Property

These types of marks serve as a very different kind of intellectual property from patents and copyrights. Generally, a “trademark” is any word, name or symbol (or any combination thereof) that is used to distinguish the trademark owner’s products from competing ones, in large measure by serving as an indication of the source of those products.² A “service mark” is virtually the same except that it is used to identify the source of services and distinguish the service provider’s services from those of its competitors. A “certification mark” is a mark used by a person or entity other than the owner of the mark. Usually such person or entity seeks to use the mark to indicate that its product or service meets the necessary criteria for which the mark stands. It should be noted that statutes and regulations on marks, including trademarks, differ from country to country.³

In the context of ITU-T Recommendations, marks often can be referenced legitimately without acknowledging the mark or seeking prior permission from the mark’s owner. If referenced properly, marks rarely (if ever) will constitute an essential intellectual property right vis-à-vis a Recommendation that would require the ITU or those seeking to implement the Recommendation to obtain a license from the mark’s owner in order to implement the Recommendation. However, certain non-referential uses of a mark may require permission or a license from the mark’s owner.

A trademark license is generally required when Party A’s mark indicates sponsorship, authorization, certification, approval, or some other association with Party B’s product or service.

¹ For the treatment of copyrighted material included in ITU-T Recommendations, please see ITU-T Recommendation A.1, Section 3.1.5 and the Software Copyright Guidelines. For the treatment of patented material included in ITU-T Recommendations, please see the ITU-T Patent Policy and the related Guidelines for Implementation of ITU-T Patent Policy.

² Annex A hereto provides information on the steps the ITU has taken to protect its name, abbreviation, flag and emblem as well as the names and abbreviations of the three sectors.

³ WIPO has explained that: “Almost all countries in the world register and protect trademarks. Each national or regional office maintains a Register of Trademarks which contains full application information on all registrations and renewals, facilitating examination, search, and potential opposition by third parties. The effects of such a registration are, however, limited to the country (or, in the case of a regional registration, countries) concerned. In order to avoid the need to register separately with each national or regional office, WIPO administers a system of international registration of marks. This system is governed by two treaties, the Madrid Agreement Concerning the International Registration of Marks and the Madrid Protocol.” For further information regarding trademarks, please see http://www.wipo.int/about-ip/en/about_trademarks.html.

For example, a license is probably required if Party B's product displays Party A's compatibility logo, or if Party B's product name includes Party A's trademark.

However, if Party B is using Party A's mark merely to refer descriptively to Party A's technologies — not Party B's — then a trademark license is generally not required in connection with such a referential use of the mark. For example, a license is generally not required for Party B to say in advertising text that its product is compatible with Party A's Widget® software, so long as Party B does not use Party A's Widget Compatible Logo® to make that statement.⁴

In any event, confusion should be avoided in the use of a mark. If the intended audience of a document might be confused into thinking that there is an association between a mark and a certain product, service or technology, the use of that mark in that fashion must be reconsidered. Similarly, confusion may stem from the use of a name or an acronym that is similar to an existing mark.

The primary concern relating to the use of a mark in a Recommendation is whether it would appear as if the Recommendation is endorsing one particular proprietary product or service over competing ones.

2. General Approach to the Use of Marks in ITU-T Recommendations

As a general rule, ITU-T Recommendations should provide a description of features from which competing and interoperable implementations can be developed. The appearance that a Recommendation endorses any particular products, services or companies/organizations must be avoided. Any explicit, qualitative endorsement is not acceptable. Therefore, proper names, trademarks, service marks or certification marks of specific companies/organizations, products or services should not be included in the text of an ITU-T Recommendation or in an appendix (or the equivalent) if it appears that they might cause this effect on a reader of an ITU-T Recommendation.

Furthermore, in practice, if the use of a mark is such that it would require a license, then it should not be included in the Recommendation.

Study Groups should exercise great care when including a mark in an ITU-T Recommendation. If a Study Group is unsure whether the inclusion of a particular mark would be appropriate, it should consult the TSB Director. All inclusions of marks in ITU-T Recommendations are subject to approval by the TSB.

3. Exceptions to the General Approach

3.1 Non-Endorsement Uses of Marks

There are situations when it may be permissible to include trademarks, service marks or certification marks in an ITU-T Recommendation in order to describe certain technologies or services pertaining to the relevant marks. Such descriptive use of a mark, if properly stated, would avoid infringement of rights relating to the mark. Typically these situations arise when the mark in question is an abbreviated reference to a standard or standardized technology, and its inclusion in the Recommendation would not create the appearance of endorsing a particular proprietary product or service. While it is not possible to delineate all such situations, the following are some examples when the inclusion of a mark may be appropriate:

1. The mark or proper name serves as a reference to a particular facility that is widely recognized as a sole authorized source. For example, a Recommendation may reference a branded service associated with a specific network identifier allocated by the ITU-T.
2. The mark is contained in the designation of a referenced standard. For example, many standards bodies use their name as part of the designation of the standards that they

⁴ Indicators of marks such as the symbol “®” or “™” can vary by country. The TSB ultimately will decide whether to use an indicator symbol and, if so, which symbol is most appropriate.

promulgate. As a result, an ITU-T Recommendation may include a reference to “ETSI xxx”, “ISO/IEC xxx”, “TIA xxx”.

3. The mark is a well-known short-hand reference to a certain standardized approach. For example, it may be appropriate to reference WiFi technology, cdma2000 technology, Bluetooth technology, GSM technology, UMTS technology, etc.

If a Study Group wants to refer to a mark for the aforementioned purposes within an ITU-T Recommendation, it should be a descriptive use that is compliant with the proper use guidelines set forth in Section 3.2 below in order to avoid infringement of rights relating to the mark.

3.2 Proper Use References to Marks Owned Outside the ITU

If there are justifiable reasons for referencing one or more marks owned outside the ITU in an ITU-T Recommendation, Study Groups are encouraged to do so in an acceptable manner. Generally it is permissible to make “proper use” references to marks as part of accurate, factual statements or to reference a mark as a means to identify (but not to endorse) a particular object (such as the designations of referenced standards in the text of a Recommendation). Usually this can be done without the express permission of the standards body or other mark’s owner, or explicit identification of any related marks. This type of use would not be perceived as a vehicle for deceiving customers as to the source of any particular goods or services. In order to be considered a “proper use” reference to a mark, Study Groups should make the reference in good faith and as a means of describing the source of something as opposed to using it in a manner that arguably uses the mark to describe something, or would impair the mark owner’s goodwill in its related products or services.

When making proper use references to marks in the text of an ITU-T Recommendation, Study Groups should consider the following:

- a. Marks are proper adjectives that indicate the source of goods, services or things. Accordingly, a mark should be used as a proper adjective followed by a generic name or noun. Do not use a mark as a verb or noun. *Example:* Incorrect: “This protocol can be used for transport over WiMax and WiFi.” Correct: “This protocol can be used for transport over WiMax infrastructure and WiFi infrastructure.”
- b. Do not combine marks in a single reference. Rather, call them out separately. *Example:* Incorrect: “This protocol can be used for transport over WiMax/WiFi infrastructure.” Correct: “This protocol can be used for transport over WiMax infrastructure and WiFi infrastructure.”
- c. Do not shorten or abbreviate a mark. *Example:* Incorrect: “This specification supports the use of an AP Services Router.” Correct: “This specification supports the use of an Access Point Services Router.”

4. Marks that Arise From the Work of a Study Group

If, during the development of an ITU-T Recommendation, a Study Group devises a name, mark or proprietary description of the Recommendation or its standardized approach that it believes should be protected for use by those implementing the Recommendation, the Study Group should so advise the TSB Director.

The ITU-T expressly does not waive any of its rights in any terms that identify any technological approach that arises out of the development of an ITU-T Recommendation. It is preferred that the ITU-T’s interests in any mark that is used to identify an ITU-T Recommendation or the certification of products to such Recommendation be protected.

ANNEX A

ITU Protected Name and Logo

ITU Protected Name and Logo

The ITU name and logo are not trademarks in the usual sense. They are protected through a specific intellectual property regime created by the Paris Convention for the Protection of Industrial Property to which 169 states are currently contracting parties. Furthermore, World Trade Organization (WTO) member states have also agreed to apply the Paris Convention by virtue of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS).

The Paris Convention, in its Article 6ter, provides for the protection of armorial bearings, flags and other official signs of States or international organizations against their registration and use as trademarks or as elements of trademarks by unauthorized third parties.

Currently, the flag, name, abbreviation, emblem/logo of ITU, and the names and abbreviations of the three Sectors (in English, French and Spanish) have been communicated to the World Intellectual Property Organization (WIPO) to receive the protection afforded by the Paris Convention.

This protection includes a prohibition to contracting States to allow registration of the flag, name, abbreviation, or emblem/logo of ITU as industrial properties, especially trademarks, by third parties for their commercial use and does confer on the ITU the right to protect its name, abbreviation, flag and emblem/logo as well as the names and abbreviations of the three Sectors⁵.

In addition to the protection afforded by the Paris Convention, national laws implementing Article 6ter may widen the scope of their protection against registration of intellectual property rights other than trademarks. Generally speaking, remedies for infringement range from administrative and civil procedures to criminal sanctions. The remedies could include cancellation of the trademark, injunctions and money damages.

The Paris Convention does not prevent ITU from authorizing a third party to use (for instance) the logo and acronym of the Union and choose the conditions under which to do so.



⁵ More information from WIPO on the protection regime afforded by article 6ter of the Paris Convention can be found at <http://www.wipo.int/article6ter/en/>