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## World Intellectual Property Organization

### Cooperation Agreement between the World Intellectual Property Organization and the Council (Junta) of the Cartagena Agreement

The World Intellectual Property Organization, hereinafter referred to as WIPO, and the Junta of the Cartagena Agreement, hereinafter referred to as the Junta, considering:

1. that industrial property is an important factor in the attainment of the objectives of developing countries, particularly with respect to technology transfer and industrialization, and that it should serve those objectives;
2. that for the attainment of those objectives it is essential to have up-to-date industrial property legislation and an administrative infrastructure organized in such a way that the advantages that an industrial property system has to offer are available;
3. that the member countries of the Cartagena Agreement are concerning themselves with the revision of their industrial property standards both at the national and at the sub-regional level, notably through their approval of Decision 85;
4. that it is necessary to define the functions to be performed by the industrial property offices of the member countries of the Cartagena Agreement and give them the structure that is most appropriate to the needs of such countries and to the application of national and subregional provisions on industrial property, and also to give due attention to the maintenance of the appropriate staff;
5. that the results of the Introductory Courses on the International Patent and Mark Classifications jointly organized in Lima by WIPO and the Junta in January 1979 for the benefit of the industrial property offices of the Andean countries have been positive,

#### AGREE

1. to enter into the present Cooperation Agreement, the main purpose of which shall be the study, financing and implementation of a program of

technological cooperation comprising the following action:

- (a) preparation of a study in order to determine, in close consultation with the member countries of the Cartagena Agreement, the ideal structure that should be given to the industrial property office of each country and the manner in which it should be incorporated in the operational and organizational framework of the country concerned;
  - (b) preparation of a plan, on the basis of the study mentioned in the preceding subparagraph, to bring about the gradual reorganization of the industrial property offices of the member countries, which plan shall in particular include a program of approximately three years' duration for the training of the appropriate staff; and
  - (c) preparation of the budget for the costs of the program and budgets for its financing;
2. to remain in close contact and consultation with the member countries of the Cartagena Agreement with a view to proceeding rapidly to the discussion and preparation of the program of technological cooperation and the securing of the resources necessary to finance its implementation;
  3. that the program of technological cooperation may have short-term and medium-term objectives, in order to make coherent cooperation possible, with due provision for the preparation of each stage, and also allow, insofar as the necessary finance is available, priority to be given to the remedying of what are at present the most serious shortcomings of the industrial property offices of Andean countries, particularly with respect to training;
  4. that WIPO, in view of its functions, shall provide all the technical and financial assistance within its power for the carrying on of the activities provided for in this Cooperation Agreement;
  5. that this Cooperation Agreement is concluded for a period of five years from the time of its signature;
  6. that the Junta and WIPO, jointly with representatives of the member countries, shall evaluate every year the results of the activities carried on under this Cooperation Agreement;

7. that the Junta and WIPO may each year suggest revision of the terms of this Cooperation Agreement to the other party, in which case, if revision is agreed to by both parties, proposals for its amendments shall be drafted.

Lima, November fourteenth, nineteen hundred and seventy-nine.

Arpad Bogsch  
 Director General  
 of the World Intellectual Property Organization  
 Pedro Carmona Estanga  
 Coordinator  
 Junta of the Cartagena Agreement  
 (WIPO translation of the original Spanish)

## Activities of the International Bureau

### The World Intellectual Property Organization in 1979\*

#### I. Membership of WIPO

During 1979, the Governments of four States deposited instruments of ratification of or accession to the Convention Establishing the World Intellectual Property Organization: Barbados, El Salvador, Indonesia, Uruguay. The number of States party to the WIPO Convention is 88.<sup>1</sup>

#### II. Governing Bodies

##### A. Membership

The membership of the Governing Bodies of WIPO and of the Unions administered by WIPO appears in the January 1980 issues of *Industrial Property* and *Copyright*.

##### B. WIPO Budget Committee

The third session of the WIPO Budget Committee was held in May 1979. Thirteen of the 14 members designated by the WIPO Coordination Committee were represented. The Budget Committee considered documents presented by the Director General concerning program and budget cycles, the question of

the use of Arabic, Portuguese, Russian and Spanish as working languages of WIPO, the form and content of reports on meetings, contribution systems and the draft program and budget for 1980, 1981 and 1982, and plans for 1983, 1984 and 1985. Subject to certain recommendations and to positions taken by individual delegations, reflected in its report, the Budget Committee recommended that the documents considered by it be submitted for examination and decision to the competent Governing Bodies in their sessions in September and October, 1979.

In preparing the draft program for 1980, 1981 and 1982, and plans for 1983, 1984 and 1985, submitted to the Budget Committee, the Director General took into account suggestions made by governments in response to a request for such suggestions sent to member States in November 1978, and suggestions made by international non-governmental organizations both in writing and at a meeting held for that purpose in January 1979. The draft program concerning copyright and neighboring rights activities took into account, and was based on, the conclusions reached on a first draft of the said program at an extraordinary session of the Executive Committee of the Berne Union, with the participation of the Intergovernmental Copyright Committee established by the Universal Copyright Convention and representatives of the Secretariat of Unesco, in February 1979.

##### C. Tenth Series of Meetings

The tenth series of meetings of the Governing Bodies of WIPO and the Unions administered by WIPO was held in September/October 1979. Twenty Governing Bodies, including the WIPO General Assembly and Conference and the Assemblies of the Unions, held sessions; 81 States, members of WIPO,

\* This article covers the main activities of the World Intellectual Property Organization as such (that is, as distinguished from those of the Unions administered by WIPO) in the year 1979. The main activities of the said Unions in 1979 will be covered in separate articles to be published in the March 1980 issues of *Industrial Property* and *Copyright*.

<sup>1</sup> The list of Member States as of January 1, 1980, appears in the January 1980 issue of this review.

the Paris Union or the Berne Union or of one or more of these, were represented at the tenth series of meetings. In addition, eight other States, eleven intergovernmental organizations and nine international non-governmental organizations sent observers.

On the basis of the nomination made by the WIPO Coordination Committee at its twelfth session, the WIPO General Assembly appointed Dr. Arpad Bogsch, unanimously and by acclamation, as the Director General of WIPO for a further period of six years.

The Governing Bodies reviewed reports by the Director General on the finances of the International Bureau in 1978, the accounts for 1976, 1977 and 1978 and the activities of the International Bureau from September 1976 to September 1979. The said reports, accounts and activities were approved by each of the Governing Bodies concerned.

The Governing Bodies concerned decided to change from the existing system of triennial and annual programs and budgets to a system of biennial programs and budgets for WIPO and the nine Unions which have independent budgets.

The Governing Bodies decided to extend the use of Arabic, Portuguese, Russian and Spanish by the International Bureau, mainly in the field of publications, and to the extent permitted by budgetary considerations. English and French remain the basic working languages.

The program approved for 1980 and 1981 includes, among many others, the following activities.

The International Bureau will continue its systematic, yearly training program for the training of government officials of developing countries, individually or in groups (in courses with pre-established curricula), in the law and the practical implications, including patent information, of industrial property and copyright and neighboring rights; it will cooperate, on request, with individual governments or groups of governments of developing countries on the adoption of new laws and regulations, or the modernization of existing laws and in the creation or modernization of institutions in the fields of industrial property and copyright and neighboring rights in order to ensure that they serve better their economic and social goals.

The Diplomatic Conference on the Revision of the Paris Convention for the Protection of Industrial Property will take place in 1980. The last major substantive revision of the Convention took place in 1958, whereas, in 1967, it was mainly the administrative provisions that were revised. The revision now contemplated should introduce new provisions and should change certain existing provisions to meet better the needs of developing countries as countries which are mainly importers of technology. Furthermore, the revision now contemplated should intro-

duce new provisions giving full recognition to "inventors' certificates," a form of protection of inventions existing in the Soviet Union and some other countries. The revision of the Paris Convention is expected to result in an increase in the membership of developing countries in the Paris Union (only about half of them are members today).

The Governing Bodies concerned adopted the budgets for 1980 and 1981 (each year approximately 30,000,000 Swiss francs) corresponding to the adopted programs. They also decided that a study of the possible reform of the contribution system of WIPO and the Unions administered by WIPO should be started, with the objective of finding a solution according to which the burden of contributions will be more equitably distributed among the member States than it is under the present system. The study should concentrate on finding such a solution, within the present multiple contribution system, having the effect of increasing the difference between the share of those countries paying the highest percentage of contributions and the share of those countries paying the lowest percentage of contributions.

Following the decision of the WIPO Coordination Committee in 1977, the Governing Bodies had on their agenda an item entitled "The exclusion of the racist régime of South Africa from any participation in meetings of WIPO and its bodies and Unions." After extensive discussions which lasted several days, the WIPO Conference voted on a proposal that "the WIPO Conference exclude from WIPO South Africa, which the United Nations has found to be flagrantly and persistently pursuing an official policy of racial discrimination in its legislation." Adoption of the proposal would have required a two-thirds majority. The proposal was voted upon in a secret ballot and was rejected by 37 votes in favor, 25 votes against and three abstentions. However, the decision made by the WIPO Coordination Committee in 1977 and according to which South Africa is not to be invited to the meetings of WIPO or the Unions administered by WIPO has not been repealed and will continue to be applied.

The Assemblies of the Paris and Berne Unions unanimously elected the members of the Executive Committees of the Paris and Berne Unions, respectively, and the WIPO Conference unanimously designated the ad hoc members of the WIPO Coordination Committee. With Switzerland continuing to occupy its *ex officio* membership, and as a consequence of the elections, the following States are members of the WIPO Coordination Committee: Algeria, Argentina, Australia, Austria, Belgium, Brazil, Bulgaria, Cameroon, Canada, Cuba, Czechoslovakia, Egypt, El Salvador, Finland, France, German Democratic Republic, Germany (Federal Republic of), Haiti, Hungary, India, Italy, Ivory Coast, Japan, Mexico, Mongolia, Morocco, Nigeria, Philippines, Poland, Senegal,

Soviet Union, Spain, Sri Lanka, Sudan, Switzerland, Tunisia, Turkey, United Kingdom, United States of America, Upper Volta, Uruguay, Yugoslavia, Zaire (43).

A note reporting more fully on the main items discussed and the principal decisions taken was published in the January 1980 issues of the reviews *Industrial Property* and *Copyright*.

### III. Development Cooperation Activities

#### A. Permanent Program and Permanent Committee (Industrial Property)

##### *Permanent Committee (Industrial Property)*

**Membership.** Six States—Benin, Indonesia, Mongolia, Niger, the Republic of Korea and Yemen—became members of the Permanent Committee (Industrial Property), bringing the total membership to 64.

**Sixth Session.** The Permanent Committee (Industrial Property) held its sixth session in March 1979, in Dakar, at the invitation of the Government of Senegal. The session was addressed by the Minister of Industrial Development of that Government. Thirty-nine States members of the Permanent Committee were represented; seven other States, three intergovernmental organizations and two international non-governmental organizations were represented by observers.

In accordance with the special provisions contained in the approved budget of WIPO, travel and subsistence expenses were paid by WIPO for one delegate from each of the countries represented at the session which are members of the Permanent Committee and are regarded as being among the least developed of the developing countries.

The Permanent Committee (Industrial Property) reviewed past and current activities and plans for future activities under the Permanent Program (Industrial Property). Its recommendations are referred to below in connection with the following summary of those activities.

##### *Permanent Program (Industrial Property)*

##### *Promotion of Technological Innovation in Developing Countries*

The Permanent Committee (Industrial Property) discussed the results achieved by the Working Group on Technological Innovation at its first session held in July 1978. It considered that the question of the

promotion of national inventive and innovative capabilities was of particular interest to all States, it approved proposals for a second meeting of the Working Group, composed of representatives of various institutions concerned from developing and developed countries, in June 1979, and it recommended that the results of the Working Group be made known as widely as possible.

The second meeting of the Working Group on Technological Innovation was held in June 1979. The participants were experts designated by national institutions from 16 States (Egypt, France, German Democratic Republic, Germany (Federal Republic of), Ghana, India, Ivory Coast, Japan, Kuwait, Mexico, Peru, Philippines, Senegal, Soviet Union, Sudan, Sweden), observers from three international organizations (International Labour Organisation (ILO), United Nations Industrial Development Organization (UNIDO), International Federation of Inventors' Associations (IFIA)) and two consultants, from the Andean Group Secretariat and from IFIA, specially invited by the Director General.

The Working Group examined and discussed papers presented by the two consultants on "Elements which Contribute to a Favorable National Innovative Climate in Developing Countries" and on "Draft Guidelines for the Creation and Administration of Appropriate Institutions in Developing Countries." After an exchange of experience and information, the Working Group addressed recommendations to WIPO concerning the patent system, training and institutional arrangements and, in particular, called for in-depth studies of typical institutional arrangements in a limited number of countries at different stages of development and with different social and economic systems, and for guidelines for institutional arrangements which could offer effective solutions to the problems encountered by developing countries.

##### *WIPO Prizes for Inventions*

From time to time, WIPO receives invitations to participate in manifestations organized by others for the recognition and encouragement of inventive activity, for example, the *Salon international des inventions et des techniques nouvelles* in December 1979 in Geneva (under the patronage of the Swiss authorities) and the Philippines Inventors' Week in April 1980 in Manila (partly sponsored by the Philippine authorities). In both these manifestations, prizes are awarded for inventors. The International Bureau agreed to offer two prizes at each of these events for inventors having made inventions particularly suited for exploitation in developing countries. Each prize consists of a medal and a diploma. In the Geneva *Salon*, the WIPO prizes were awarded for inventions in the field of solar energy.

It is believed that such participation by WIPO in the said and other similar events will not only underline WIPO's interest in inventive activity, particularly in and for developing countries, but will also contribute to a better understanding by the general public of the aims and activities of WIPO.

#### *Technological Information from Patent Documents*

*State-of-the-Art Search Reports.* On the basis of the agreement between the Government of Austria and WIPO for the furnishing by the Austrian authorities to developing countries, free of charge, of state-of-the-art search reports based on patent documentation, and taking into account the increasing number of requests for such reports, WIPO proposed arrangements for the processing of additional requests. The Austrian authorities agreed to increase the number of requests to be processed in 1980 to 200. During 1979, 211 search requests were submitted by 28 countries (Argentina, Bolivia, Brazil, Chile, Colombia, Cuba, Democratic People's Republic of Korea, Egypt, El Salvador, Guyana, Honduras, India, Iraq, Madagascar, Mauritania, Mexico, Nigeria, Peru, Philippines, Portugal, Republic of Korea, Senegal, Singapore, Sri Lanka, Syria, Thailand, Turkey, Uruguay) and by the Industrial Development Centre for Arab States (IDCAS). Sixty of the said requests were submitted through the Industrial Inquiry Services of the United Nations Industrial Development Organization (UNIDO) under an agreement of cooperation concluded in January 1979 between the Austrian authorities, WIPO and UNIDO. In the same period 198 search reports were furnished by the Austrian authorities to 24 countries (Algeria, Argentina, Brazil, Chile, Cuba, Democratic People's Republic of Korea, Egypt, El Salvador, Guyana, India, Madagascar, Mauritania, Mauritius, Mexico, Peru, Senegal, Singapore, Sri Lanka, Suriname, Syria, Thailand, Turkey, Uruguay, Zaire), as well as to the African Intellectual Property Organization (OAPI), to the Industrial Development Centre for Arab States (IDCAS) and to the United Nations Economic Commission for Africa (ECA).

In addition, the German Patent Office (of the Federal Republic of Germany) carried out six free searches on requests received through WIPO, in technical fields in which mechanized search systems are operational in that Office, from Brazil, Egypt, India and Thailand.

As a first result of discussions with the European Patent Office (EPO), with a view to the establishment of programs for the provision of search reports and similar technological information in response to requests from developing countries, a pilot project was commenced for the provision by the EPO of technological monographs in selected sectors.

In November 1979 agreement was reached between WIPO, the Patent Office of Sweden and the Swedish International Development Agency (SIDA) on a program to provide to developing countries, free of charge, search reports and consultancy services based on patent documents.

*Users' Guides to the International Patent Classification (IPC).* In cooperation with UNIDO, user-oriented Guides to the IPC were prepared in two sectors (iron and steel, fertilizers), the technical work being performed under contract by the European Patent Office (EPO). Further Guides are in the course of preparation for agro-industries and for agricultural machinery and implements.

*Availability of Patent Documents to Developing Countries.* WIPO continued its activity of arranging, and seeking to arrange, for collections of patent documents and related material to be made available and to be received by developing countries requesting them. A further circular letter seeking information on the availability of such collections was issued in July 1979. A collection of patent documents of the United States of America, made available by the Patent Office of the United Kingdom, was provided to China. An offer to make available a collection of abridgments of United Kingdom patents, made by the Patent Office of the United Kingdom, was accepted on behalf of the Industrial Property Organization for English-Speaking Africa (ESARIPO), for the purposes of its planned patent documentation and information center. A collection of patent documents of France, made available by the United States Patent and Trademark Office, was provided to Algeria. Collections were also provided to Brazil by the United States of America, and to OAPI by France and Switzerland. Offers of collections of documents of various countries, covering various periods of publication, were made by Austria, France, Hungary, Sweden, Switzerland and the United States of America.

#### *Strengthening National and Regional Infrastructures: Industrial Property Offices Survey and Study*

The Permanent Committee (Industrial Property) considered a report containing a general analysis of information received from 56 countries and one organization for the purposes of a survey of the functions, administration and role in the governmental structure of industrial property offices in selected developing and developed countries. The report, as requested by the Permanent Committee, contained also a study analyzing the possibilities open to developing countries and suggesting appropriate functions and structures. The report was accompanied by the interim results of the survey itself, which included a

published survey of the industrial property situation in 21 Arab States.

The Permanent Committee recommended that regional surveys on the state of industrial property similar to that done for the Arab States should be undertaken in the near future and that it should receive at its next session a study containing all necessary facts and proposals for organizing a World Intellectual Property Day.

#### *Model Laws for Developing Countries*

*New Model Law for Developing Countries on Inventions and Know-How.* The eighth, and final, session of the Working Group on the Model Law for Developing Countries on Inventions and Know-How was held in March 1979. Experts from the following 15 countries participated: Algeria, Argentina, Cuba, Egypt, France, Germany (Federal Republic of), Hungary, Kenya, Mexico, Soviet Union, Spain, Tunisia, United Kingdom, United States of America, Zaire. Two intergovernmental organizations and seven international non-governmental organizations were represented by observers.

The Working Group examined the remaining parts of the new Model Law, namely, those concerning know-how, the examination and registration of licensing contracts, inventors' certificates, technovations and transfer of technology patents.

The Permanent Committee (Industrial Property) noted that, according to the decisions of the Governing Bodies made in September 1978, Part I of the new Model Law, devoted to patents and examined by the Working Group at its seventh session held in May 1978, would be published in 1979. The said publication took place in August 1979. The Permanent Committee further noted and approved that, according to the same decisions, the texts of the remaining Parts would be submitted to it at its next session and would be published thereafter.

#### *Trademarks*

In December 1979 consultants invited personally by the Director General from Bangladesh, Ghana, Singapore and Tunisia discussed and gave advice on a preliminary outline report entitled "Trademarks for Development."

#### *License Agreements: Guide for Developing Countries*

The Permanent Committee (Industrial Property) noted with satisfaction the recent publication in

Arabic of the *WIPO Licensing Guide*, in addition to the English, French and Spanish versions, and the arrangements made, in cooperation with the Governments of Brazil and Portugal, for the preparation of a Portuguese language version; it also expressed the view that the question of the elaboration of a possible Licensing Guide for the specific use of government officials should wait at least until that part of the WIPO Model Law concerning the registration of licensing contracts was published.

The *WIPO Licensing Guide* was used as a basic working document in training workshops held in Bangalore (India) in August and September, and in Shanghai (China) in October and November 1979.

#### *Industrial Property Glossary and Manual for Developing Countries*

*Industrial Property Glossary.* The Glossary was published in four languages (Arabic, English, French, Spanish), in one single volume, in March 1979, and made available to the participants in the sixth session of the Permanent Committee (Industrial Property). It is composed of some 350 main terms, some of which are subdivided into a number of other terms. The publication is composed of four main parts. In each part, i.e., Arabic, English, French and Spanish, the terms are listed in alphabetical order in the first column, with three corresponding columns setting out the equivalent terms in each of the other three languages. The first term in each part is followed by references to the relevant sources, that is to say, the various industrial property treaties administered by WIPO (but primarily the Paris Convention for the Protection of Industrial Property (Stockholm Act), the Patent Cooperation Treaty and the Trademark Registration Treaty), the draft WIPO Model Law on Inventions and Know-How, the BIRPI Model Law on Marks, Trade Names, and Acts of Unfair Competition and the *WIPO Licensing Guide for Developing Countries*.

The Permanent Committee (Industrial Property), noted with satisfaction the publication in Arabic, English, French and Spanish of the *WIPO Industrial Property Glossary*, noted that the Portuguese and Brazilian industrial property services were ready to prepare the part of the Glossary in Portuguese and that the industrial property services of the Soviet Union were ready to prepare the part of the Glossary in Russian, and recommended the publication of the Portuguese and Russian versions of the Glossary.

*Industrial Property Manual.* The Permanent Committee (Industrial Property) considered and approved general principles for the preparation of this Manual, as follows: the primary users would be developing countries in general, and the personnel of interested

government administrations, including existing and future industrial property offices, and professors and students of industrial property in particular; the Manual will be an introduction to industrial property in general and a guide supplying practical information; the form will be generally that of questions and answers.

*Training, Regional Meetings, Seminars, etc., in the Field of Industrial Property*

*Training.* One hundred and forty-one applications for training in the field of industrial property in 1979 were received by WIPO from 62 developing countries, from the African Intellectual Property Organization (OAPI) and from the United Nations High Commissioner for Refugees (UNHCR) (including applications, following consultations with the Organization for African Unity, from the Zimbabwe National Liberation Movement). Eighty-two of the persons nominated from the following 51 countries, OAPI and the UNHCR received training: Afghanistan, Algeria, Argentina, Bangladesh, Bahrain, Botswana, Burundi, Central African Republic, Chad, Cbile, Colombia, Congo, Costa Rica, Cuba, Democratic Yemen, Ecuador, Egypt, El Salvador, Fiji, Gambia, Ghana, India, Indonesia, Ivory Coast, Jamaica, Kenya, Kuwait, Madagascar, Malaŵi, Mauritania, Mexico, Niger, Nigeria, Pakistan, Panama, Philippines, Republic of Korea, Samoa, Senegal, Sierra Leone, Somalia, Sudan, Syria, Thailand, Togo, Trinidad and Tobago, Uganda, Upper Volta, Zaire, Zambia.

The training arranged in 1979 took the following forms:

(a) for 27 trainees, attendance at a general introductory course at Strasbourg, organized by WIPO and the Center for the International Study of Industrial Property (CEIPI), with the cooperation of the National Institute of Industrial Property (INPI) of France; this course was preceded by a visit to WIPO headquarters and followed, in most cases, by practical training in industrial property offices or other establishments of the following countries and organizations: Bulgaria, Czechoslovakia, Egypt, France, Germany (Federal Republic of), Hungary, Italy, Netherlands, Switzerland, United Kingdom, the European Patent Office (EPO) and the African Intellectual Property Organization (OAPI);

(b) for 27 trainees, practical training in the industrial property offices of the following countries and organization: Canada, Japan, Netherlands, Soviet Union, Sweden, Switzerland, United Kingdom, United States of America and the European Patent Office (EPO);

(c) for 14 trainees, attendance at a training course in the use of patent documentation as a source of technological information, in Vienna, organized jointly by WIPO and the Government of Austria;

(d) for five trainees, study tours including visits to and discussions in institutions in from two to five of the following countries or WIPO: Belgium, Cameroon, Canada, France, Luxembourg, Sweden, Switzerland, United States of America;

(e) for 14 trainees, attendance at a Seminar organized by WIPO, the European Patent Office and the Commission of the European Communities (CEC) on technological information as an aid to industrial development:

(f) for nine trainees, attendance at a course organized by WIPO, the Spanish Government and the Industrial Property Registry in Madrid on the theoretical and practical aspects of industrial property.

To the extent possible, the arrangements for training in 1979 included visits to the headquarters of WIPO.

Taking together the training program in the field of industrial property and that in the field of copyright and neighboring rights, the total number of applications received in 1979 was 208 from 72 countries, UNHCR, OAPI, and the Palestine Liberation Organization (PLO), as compared with 102 applications received in 1978 from 57 countries and OAPI. In 1979, a total of 120 applications were accepted from 61 countries, UNHCR, OAPI and the PLO; in 1978, 88 applications were accepted from 46 countries and OAPI. In 1979, 25 applications were accepted (20% of the total acceptances) from 19 countries regarded as least developed among the developing countries, and 32 applications were accepted (25% of the total acceptances) in respect of women. In 1979, five developing countries and OAPI contributed to promoting cooperation among developing countries by receiving 17 trainees.

The following 15 countries, three intergovernmental organizations and one study center agreed to contribute in full or in part to the payment of the travel expenses and subsistence allowances of the trainees:

(i) full payment: Austria, Canada, France, Germany (Federal Republic of), Italy, Spain, Sweden, Switzerland, United Kingdom, European Patent Office (EPO), Economic Commission of the European Communities (CEC) and United Nations Development Programme (UNDP);

(ii) partial payment: Austria, Bulgaria, Czechoslovakia, Hungary, Japan, Netherlands, Soviet Union, Center for the International Study of Industrial Property (CEIPI).

The remainder of the cost was borne by the budget of the WIPO Legal-Technical Assistance Program.

Discussions were held with the government authorities of the Soviet Union in March 1979 in Moscow, with a view to planning a training course on patent information in 1980, with financing from UNDP funds held in non-convertible currency.

*Regional Meetings, Seminars, etc.* In January 1979, WIPO organized, with the cooperation of the *Junta del Acuerdo de Cartagena* (JUNAC), Introductory Courses in the Use of the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification), and in the Use of the International Patent Classification (IPC). Bolivia and Peru sent four participants to the Course on the Nice Classification; Bolivia, Ecuador and Peru were represented by 11 participants at the IPC Course. The Courses were designed to give a practical approach to the use and utility of these two Classifications.

Also in January 1979, WIPO organized, with the financial support of the Swedish International Development Authority (SIDA) and in cooperation with the United Nations Conference on Science and Technology for Development (UNCSTD) and the United Nations Economic and Social Commission for Asia and the Pacific (ESCAP), a Seminar on Technological Information Contained in Patent Documents, held in Bangkok (Thailand). The following Governments nominated participants: Afghanistan, Bangladesh, Burma, China, Fiji, India, Indonesia, Malaysia, Mongolia, Nepal, Pakistan, Philippines, Republic of Korea, Samoa, Sri Lanka, Thailand, Australia, Japan and the United States of America, and the United Nations Development Programme (UNDP), sent observers.

The Seminar was organized as part of the preparatory phase of the UNCSTD, and dealt with the role of patent information in the transfer of technology, the technological and information needs of the Asian and Pacific region, international cooperation in the field of patent information, the value of patent documents as a source of technological information and means of access to that information, the IPC, etc.

The participants in the Seminar discussed each of eight main subjects and agreed on a number of conclusions, including the recognition of the fact that training based upon the international exchange of information and experience was a key element in the modernization and strengthening of scientific and patent information sources, the wish that particular attention be paid to the needs of users of patent information and the opinion according to which training of the users of the patent information services was as important as the training of the providers of such services.

In February 1979, WIPO organized jointly with the National Research Council and the Department of

Commercial Registration of the Government of Thailand a meeting of a Group of Experts on the Legal Protection of Inventions, Innovations and Know-How in the Countries of the ASEAN Region, in Pattaya, Thailand. The Governments of the five countries of the Association of South East Asian Nations (ASEAN) designated the experts. The Group, after an extensive discussion and exchange of information, recommended a framework for continuation in the future of similar contacts and exchanges of views.

In March and April 1979, WIPO organized a Training Course on the Use of the International Patent Classification (IPC), with the cooperation of the Japanese Patent Office, at the Patent Office of the Republic of Korea in Seoul. The Course was designed as an introduction to the use of the IPC for the examiners of the Korean Patent Office.

A Workshop for Government Officials on Industrial Property Licenses and Technology Transfer Arrangements was organized by WIPO in association with the United Nations Economic and Social Commission for Asia and the Pacific (ESCAP) and with the cooperation of the United Nations Development Programme (UNDP) at the ESCAP Regional Centre for Technology Transfer (RCTT) in Bangalore (India) in September 1979. Forty-two government officials from the following 19 countries participated in the Workshop: Afghanistan, Bangladesh, Bhutan, China, Democratic People's Republic of Korea, Fiji, India, Indonesia, Iran, Malaysia, Nepal, Pakistan, Papua New Guinea, Philippines, Republic of Korea, Samoa, Sri Lanka, Thailand, Viet Nam. In addition, representatives of ESCAP, UNDP and RCTT attended the meeting.

The purposes of the Workshop were to advise the participants how to identify legal problems which are likely to arise in the negotiation and preparation of industrial property licenses and technology transfer agreements, to increase their awareness of existing commercial practices, and to indicate the possible solutions, and to promote among the participants the exchange of information and sharing of experience concerning such legal problems, practices and solutions. The discussions were primarily based on the *WIPO Licensing Guide for Developing Countries* and a series of background documents prepared by WIPO.

The participants concluded that the Workshop had been very valuable as an opportunity to exchange experiences, to have the benefit of consultations with a number of experts, to develop an awareness of the problems arising in the negotiation and preparation of license agreements, the difficulties encountered and possible solutions, and to improve their skills; they expressed the desire that similar workshops on a regional, sub-regional and national basis be organized, which could be devoted also to an in-depth

treatment of license agreements in given industrial sectors, and could include simulated negotiations and drafting of license agreements, with the participation of not only government officials but also members from industry and related professions; consideration should also be given to the possibility of making available experts to countries, at their request, to assist them in special problems connected with license agreements to be negotiated.

Immediately before the Workshop, similar discussions were organized at the national level for the benefit of government officials of India.

#### *Assistance to Certain Developing Countries and Regional Institutions of Developing Countries*

*In General.* At its sixth session, the Permanent Committee (Industrial Property) considered a report containing information on recent and current activities in providing advice and assistance to developing countries in legislation, institutions and related matters, and noted that information with satisfaction.

During 1979 assistance was given to the following developing countries or groups of developing countries, or requests for assistance were under active consideration, in connection with the preparation of legislation, the establishment or modernization of national or regional institutions or related matters.

#### *Countries*

*Algeria.* WIPO cooperated with the national authorities in organizing, and providing documents for and experts as lecturers in, two national seminars in Algiers, the first on the International Patent Classification in October, the second on industrial property licenses and technology transfer arrangements.

*Bangladesh.* Following the acceptance by the Government of the recommendations of a WIPO mission report and the preparation and transmission by WIPO of a preliminary draft of a new law on patents, WIPO prepared and transmitted in May 1979 a preliminary draft of a new law on trademarks. Discussions on the draft patent law took place at WIPO in December 1979.

*Barbados.* Mission by WIPO officials; establishment of proposals for assistance in modernizing industrial property laws and administration; preparation and sending of drafts of new legislation.

*Bolivia.* At the request of the Government, comments on a draft industrial property code are being prepared.

*Brazil.* WIPO is continuing to carry out the United Nations Development Programme (UNDP) project for the modernization of the Brazilian patent system, with the assistance of experts from Denmark, France, Germany (Federal Republic of), Israel, Japan, Netherlands, Norway, Sweden, the United Kingdom and the United States of America. The sixth tripartite review of the project was held in Rio de Janeiro in July 1979, with the participation of representatives of the Brazilian Government, the UNDP and WIPO. It was noted that the input from the project for the establishment of the patent bank of the Brazilian National Institute for Industrial Property (INPI) was virtually completed, the bank comprising some 13 million documents. On the other hand, it was recognized that a continuation of the training program for two more years was necessary in order to attain the objectives of the project. Consequently, prolongation of the project until the end of 1981 was decided; in this period 40 examiners would be trained, in addition to the 100 examiners who would be trained by the end of 1979, and the possibility would be explored of convening a sub-regional seminar for the training of experts from industry. The representatives of both the Brazilian Government and the UNDP expressed satisfaction with the progress of the project.

*Indonesia.* Mission by a WIPO consultant in November and December 1979 to study and advise on means to ensure adequate legal protection for Indonesian industrial designs.

*Iraq.* WIPO cooperated with the national authorities in organizing, and providing documents for and experts as lecturers in, a national seminar in Baghdad on industrial property in October 1979.

*Ivory Coast.* At the request of the Government, a WIPO consultant from the Federal Bureau of Intellectual Property of Switzerland undertook a mission in May 1979 to advise on the administration of the industrial property service, taking into account the responsibilities of that service in relation to OAPI.

*Madagascar.* Consultations by correspondence and in discussions during a WIPO mission in December 1979 with a view to achieving conformity between a draft new industrial property law and the Paris Convention and the Patent Cooperation Treaty.

*Mali.* Mission in July 1979 to assist in preparing a plan for WIPO cooperation in the introduction of new industrial property legislation, the establishment of administrative services and accession to international conventions.

*People's Democratic Republic of Korea.* Following the visit of a WIPO official in October 1979, planning of training at WIPO and of WIPO consultant missions.

*Republic of Korea.* At the request of the Government, following an expert mission in 1978, preliminary drafts of new industrial property laws were prepared and transmitted and, together with the Government's comments, were discussed during visits for that purpose to WIPO in June and October 1979 by officials of the Korean Patent Office. A training seminar on the IPC was held in Seoul.

*Sri Lanka.* Following discussions and the presentation by WIPO to the Government of a draft new code of intellectual property, a new code, based on the said draft, was adopted by the Parliament of Sri Lanka in May 1979. WIPO prepared and transmitted draft regulations and forms under the new Code of Intellectual Property Act, covering patents, marks and industrial designs; WIPO staff members and consultants undertook missions to Colombo in August, September and November 1979.

*Suriname.* A WIPO mission, composed of a staff member and a consultant from the Patent Office of the Netherlands, visited Suriname in February and March 1979 to advise on legislation, the organization of the industrial property office and the training of its staff. The report of the mission, including recommendations was transmitted to the Government in June 1979.

*Swaziland.* At the request of the Government, which was transmitted by the UNDP Resident Representative, a WIPO mission, composed of two staff members, had extensive discussions in Swaziland in June 1979 on possibilities of modernizing the industrial property system. Following those discussions, a report with detailed recommendations and a draft trademark law were prepared by the WIPO mission and submitted to the Government.

*Thailand.* A WIPO mission, composed of two staff members and consultants from the industrial property offices of Canada, Sweden and the United States of America, carried out in April 1979, at the request of the Government, extensive discussions on the implementation of the new Patent Act of Thailand, and presented to the Government a detailed report on the next steps to be taken, both nationally and with intergovernmental cooperation.

The mission's report was approved by the Government of Thailand in June, and its detailed recommendations, particularly as regards the preparation of draft Ministerial Regulations, Forms and Administrative Instructions, are being implemented by WIPO in

cooperation with the national industrial property offices which provided consultants for the mission. The possibility is being explored of further assistance through wider intergovernmental cooperation. Further missions by a WIPO official took place in July and October 1979.

*Trinidad and Tobago.* A mission took place in July 1979 to assist in the preparation of a project for the establishment of a patent system, to be executed by WIPO, provided for in the Government's UNDP Country Programme.

*Turkey.* A WIPO staff member undertook a mission in February 1979 to advise the industrial property office on the modernization of its trademark administration.

*Zaire.* Following earlier written advice and a preparatory mission, detailed discussions took place at WIPO in April 1979 with a delegation from Zaire on the final text of new industrial property legislation to be submitted for enactment.

### *Regional Institutions*

*African Intellectual Property Organization (OAPI).* Cooperation continued on the preparations for the entry into force of the revised Libreville Agreement. At the request of the Director General of OAPI, WIPO prepared and transmitted draft Administrative Instructions.

The project for the establishment by OAPI of a patent documentation and information center entered its operational phase in April 1979, following the adoption of the counterpart budget by the Administrative Council of OAPI and approval by the UNDP of the project document submitted by the Government of the host country (Cameroon) and endorsed by other member States. In addition to financing from the UNDP, the project is receiving support in the form of financing, expert services, training and equipment from the Governments of France, Germany (Federal Republic of) and Switzerland, and the European Development Fund has allocated money for the necessary extension of the OAPI headquarters building.

The first tripartite review (by OAPI, UNDP and WIPO) of the project for the establishment by OAPI of a patent documentation and information center was held in Yaoundé in August 1979. The work program for 1979 and 1980 was approved, and recommendations were made to OAPI and to WIPO concerning staff recruitment, equipment procurement and training. Both the UNDP and OAPI expressed satisfaction with the progress of the project.

*Industrial Property Organization for English-Speaking Africa (ESARIPO)*. Jointly with the Secretariat of the United Nations Economic Commission for Africa (ECA), WIPO continued to act as the Interim Secretariat of ESARIPO.

The text established by the ESARIPO Committee for Trade Mark and Industrial Design Matters, and endorsed by the ESARIPO Council at its second session, of the Model Law for English-Speaking African Countries on Trade Marks was prepared by WIPO in its final form and distributed to the Governments of the member and potential member States in June 1979.

With the cooperation and financial assistance of the UNDP, the United Kingdom Patent Office, the Commonwealth Fund for Technical Cooperation and the authorities of the Government of the Federal Republic of Germany, missions in preparation for the project to establish a patent documentation and information center in the framework of ESARIPO were undertaken in August 1979 to Somalia and Tanzania, in September 1979 to Botswana, Lesotho, Mauritius, Kenya and the Seychelles and in October and November 1979 to Ethiopia, the Gambia, Ghana, Liberia, Malaŵi, Nigeria, Sierra Leone and Zambia. Officers of the ESARIPO Council and members of the staff of ECA, WIPO and the United Kingdom Patent Office participated in the missions.

The third session of the *Council of ESARIPO* was held in Nairobi (Kenya) in December 1979. All States members of ESARIPO (the Gambia, Ghana, Kenya, Malaŵi, the Sudan, Uganda and Zambia) and six observer States (Ethiopia, Lesotho, Sierra Leone, Somalia, Swaziland and Tanzania) were represented. The session of the Council was preceded by a seminar (with participants from the States referred to above and also from Botswana and Liberia) and by the fifth session of the Committee for Trade Mark and Industrial Design Matters.

The *Seminar* was organized by the Interim Secretariat with assistance from the Governments of the Federal Republic of Germany and of the United Kingdom and from the Commonwealth Fund for Technical Cooperation. The topics discussed were international and regional cooperation in the field of industrial property, patent and trademark registration procedures under the ESARIPO Model Laws, the technical contents and structure of patent documents, and patent documents as the basis for state-of-the-art searches. These topics were introduced respectively by members of the staff of WIPO and the ECA, by the Comptroller-General of the Patent Office of the United Kingdom and by an official of the Patent Office of the Federal Republic of Germany.

The *Committee for Trade Mark and Industrial Design Matters* expressed continued support for the draft Protocol on the Protection of the Olympic Symbol to be considered at the Diplomatic Confer-

ence on the Revision of the Paris Convention in 1980. It considered draft model provisions on the protection of the Olympic symbol and a draft agreement between national authorities and the International Olympic Committee. It requested WIPO to revise the drafts, in the light of observations made during the discussions and the results of the Diplomatic Conference, to send the revised drafts, with commentaries, to the member and potential member States, and to submit them to the next session of the Committee. The Committee also requested WIPO to prepare, for its next session, a study of the possibilities of organizing efficient protection of geographical indications in the member and potential member States, taking into account questions raised in the discussion of this matter and the results of the Diplomatic Conference.

The *Council* approved the report and recommendations of the missions to member and potential member States referred to above, and requested the Interim Secretariat to proceed with negotiations for the operational phase of the establishment of a patent documentation and information center (ESAPADIC). It adopted a list of initial tasks of the Office of ESARIPO and decided on the basis for the payment of contributions to the budget and on the procedure for the appointment of the Director of the Office. The Council also dealt with questions concerning the headquarters agreement, the headquarters building, the choice of an emblem for ESARIPO, the protection of the words "ESARIPO" and "ESAPADIC" under the Paris Convention, representation at the Diplomatic Conference on the Revision of the Paris Convention, the introduction of modernized national legislation, prospects of increasing the membership of ESARIPO and cooperation with the African Intellectual Property Organization (OAPI) and its patent documentation and information center (CADIB).

*Latin American Industrial Property and Technology Transfer Data Service*. The number of countries participating in the Service increased by five, making a total of 14 (Bolivia, \* Chile, \* Colombia, Costa Rica, Ecuador, \* El Salvador, Honduras, Mexico, Nicaragua, Panama, \* Paraguay, Peru, \* Uruguay, Venezuela). The third issue of the Bulletin, containing data relating to patents, trademarks and offers and requests to supply technology for the period from October to December 1978, was published in January 1979, and the fourth issue, covering the period from January to March 1979, was published in July 1979.

*Andean Group*. A five-year agreement on a program of technical cooperation between WIPO and the Council (*Junta*) of the Cartagena Agreement (An-

\* New participant.

dean Group)<sup>2</sup> was signed in November 1979. Introductory courses on classification were jointly organized in January 1979 in Lima (Peru).

*Organization of Patent and Trademark Activities of Enterprises in Developing Countries*

The Permanent Committee (Industrial Property) approved plans for the preparation of guidelines which would give advice and provide a practical source of information on the organization of activities of enterprises in developing countries relating to the securing and defense of industrial property rights and to the use of information resulting from the industrial property system, as well as on policy and internal procedures, with the aim of stimulating creative activity within the enterprises and of reinforcing their positions in national and international markets.

The Permanent Committee recommended the sending of a questionnaire on this subject to developing countries members of the Committee, and the establishment of a working group of experts selected after consultation with governments.

*Cooperation Among Developing Countries*

The Permanent Committee (Industrial Property) took note with appreciation of information concerning the measures taken by WIPO to support and assist cooperation among developing countries. The said information included reports on cooperation with OAPI and with ESARIPO, on the organization of the Latin American Industrial Property and Technology Transfer Data Service, and on cooperation with the countries of ASEAN, with IDCAS, with the United Nations regional commissions, particularly in respect of regional centers for technology, and with the UNDP in following up the results of the 1978 United Nations Conference on Technical Cooperation among Developing Countries.

Cooperation among developing countries in the WIPO training program for 1979 is referred to under "Training," above.

*United Nations Conference on Science and Technology for Development (UNCSTD)*

WIPO continued to cooperate with the Secretariat of UNCSTD, and was represented at the third (January/February 1979) and fourth (April/May) sessions of the Preparatory Committee for the Conference, in New York, and at related interagency meetings in New York and Geneva. A seminar on Technological Information Contained in Patent Documents was held in January 1979 in Bangkok.

At the request of the Secretary-General of UNCSTD, WIPO provided office premises and part of the time of a senior official to serve as the UNCSTD Liaison Office in Geneva.

At its sixth session, the Permanent Committee (Industrial Property) recommended that the Director General should continue to give, so far as resources permit, full support to the Secretary-General of UNCSTD, and should present to the next session a report on the contribution which the Permanent Program (Industrial Property) could and ought to make to the implementation of any action program approved by the Conference. The Permanent Committee also recommended that governments should help to ensure, in the positions that would be adopted by their representatives in the Preparatory Committee and the Conference, that the Conference stress the importance of the technological information contained in patent documents.

In June 1979, WIPO distributed to governments' national focal points for UNCSTD a background paper prepared for the Conference at the request of the Preparatory Committee; this paper sets out the experience of WIPO in the application of science and technology to development.

The Conference was held in Vienna in August 1979. WIPO was represented by the Director General (during part of the Conference) and two officials of the staff of WIPO (during the whole Conference). The Director General addressed the Conference in plenary session during the general debate.

The program of action adopted by the Conference contains references to the need to include in scientific and technological information services for the benefit of developing countries the technological information contained in patent documents, to the modernization of national industrial property systems and to the revision of the Paris Convention for the Protection of Industrial Property.

The Governing Bodies of WIPO, at their tenth series of meetings, noted, on the basis of the documentation available concerning the conclusions reached by the Conference, that the implementation of the results of the Conference by WIPO within its area of competence was fully provided for in the program for 1980 and 1981 and plan for subsequent years adopted at the said meetings.

**B. Permanent Program and Permanent Committee (Copyright and Neighboring Rights)**

*Permanent Committee (Copyright)*

*Membership.* Five States—Japan, Malawi, Soviet Union, Togo and Yemen—became members of the Permanent Committee (Copyright), bringing the total membership to 48.

<sup>2</sup> For the text of the five-year agreement, see p. 51 of this issue of *Industrial Property*.

*Third Session.* The Permanent Committee (Copyright) held its third session in March 1979 in Dakar, at the invitation of the Government of Senegal. The session was addressed by the Minister for Industrial Development of that Government. Thirty-three States members of the Permanent Committee were represented; 16 other States, three intergovernmental organizations and eight international non-governmental organizations were represented by observers.

The Permanent Committee (Copyright) reviewed past and current activities and plans for future activities under the Permanent Program (Copyright). Its recommendations are referred to below in connection with the following summary of those activities.

#### *Permanent Program (Copyright)*

##### *Support of National Authors and Performers*

The Permanent Committee (Copyright) noted that replies had been received from 33 countries to a circular requesting information for the purposes of a study, to be submitted to a working group, of the legislative and institutional arrangements in the field of copyright and neighboring rights in developed and developing countries for the support of national authors of literary and artistic works (including musical works) and other creative artists. Progress was also noted in the evaluation of statutes and decrees governing the activities of societies of authors in more than 30 countries (including ten developing countries), an evaluation undertaken with a view to the preparation, in consultation with Unesco, of model statutes for such societies, taking into consideration the more important aspects of existing statutes and the needs and interests of developing countries in different continents, as reflected by the recent developments of national laws and international conventions.

The Working Group on the Support of National Authors and Performers was convened by WIPO in September 1979. The Group consisted of experts from 15 countries, who participated in the meeting in a personal capacity. The meeting was also attended, in an observer capacity, by representatives of one intergovernmental and eight international non-governmental organizations. The study submitted to the group was based on relevant information provided, in response to a request by the International Bureau, by 34 countries (19 developing and 15 developed), and on other available information.

The Working Group felt that the problem of support of national authors and performers should be viewed not only from the legal, institutional and contractual angles, but also in the context of the socio-economic, fiscal and technological conditions

influencing the development of creative and performing activities, and the public use of works and performances. In any case it felt that WIPO's activities in this field should be extended and continued. The Working Group adopted detailed recommendations, with special regard to the needs of developing countries, which were published in the November 1979 issue of *Copyright*.

##### *Access to and Dissemination of Protected Works*

In accordance with decisions of the Executive Committee of the Berne Union and the Intergovernmental Committee of the Universal Copyright Convention, a Working Group on the Overall Problems Posed for Developing Countries by Access to Works Protected under Copyright Conventions was convened by WIPO and Unesco in Paris in July 1979. Experts from 14 countries participated in a personal capacity. Six national copyright information centers and 11 international non-governmental organizations were represented by observers.

The Working Group based its discussions on replies received from 25 States to a questionnaire sent by WIPO and Unesco in June 1978, and on an analysis of those replies. It was noted that the problems examined were not confined to legal aspects but extended also to practical aspects such as information dissemination, economic, financial and others. The Working Group considered measures for facilitating and promoting the licensing systems provided for in the revised 1971 texts of the two Copyright Conventions for the benefit of developing countries.

The Working Group adopted extensive recommendations for submission to the October 1979 sessions of the Copyright Committees, with a view to facilitating the effective application of the said revised texts in order to permit easier and quicker access to the international repertoire of protected works, and thus to encourage translation and reproduction of these works in developing countries as a means of promotion of teaching, scholarship and research.

The said recommendations, addressed to governments, private or public organizations concerned, WIPO and Unesco, are directed towards, *inter alia*, the adoption or updating of legislation, accession to the revised texts of the Copyright Conventions, assistance by WIPO and Unesco in legislation, training and strengthening infrastructure, the preparation of guidelines and model procedures, the granting of rights at preferential rates, the establishment of national bibliographies, the dissemination of publishers' lists of newly published titles, the operations of national copyright information centers, and evaluation of the implementation of the recommendations by WIPO, Unesco and the Copyright Committees.

In February 1979, the Director General of WIPO made concrete suggestions to Unesco for the joint administration by Unesco and WIPO of the present International Copyright Information Centre of Unesco, including suggestions for the division of work. Following correspondence and discussion, agreement was reached in November 1979 between WIPO and Unesco on the establishment of a Joint International Unesco-WIPO Service for Facilitating the Access by Developing Countries to Works Protected by Copyright, and a Joint Consultative Committee, and on the division of work.

#### *Glossary of Terms of the Law of Copyright*

The Permanent Committee (Copyright) considered a draft Glossary of Terms of the Law of Copyright and Neighboring Rights, containing 265 terms with their equivalents in five languages (Arabic, English, French, Portuguese and Spanish) with explanations, at the then incomplete stage of drafting, in one language (English). The Permanent Committee noted with appreciation that suggestions for improving the draft would be taken into account in preparing the final edition, and that the possibility of including the Russian language was being studied. The manuscript of a first edition in three languages (English, French and Spanish), including the explanations, was prepared in 1979 for printing and publication in 1980.

#### *Protection of Folklore*

Taking into account a report on the February 1979 session of the Executive Committee of the Berne Union, at which the draft program of work for 1980 to 1982 was considered and Unesco's work was noted on a study on all aspects—cultural, social, legal, etc.—of folklore, the Permanent Committee (Copyright) noted with appreciation that WIPO had prepared a draft text of provisions for the protection of folklore, with a draft definition of the concept of folklore; it recommended that a working group be convened jointly by WIPO and Unesco as soon as possible. The said working group was convened for January 1980.

#### *Guide to the Berne Convention*

The Permanent Committee (Copyright) noted with appreciation that reasonable quantities of the *Guide to the Berne Convention* could be made available free of charge to governments.

In addition to the original French and the English version published in 1978, a Spanish version was published in April 1979; Arabic and Japanese trans-

lations have also been prepared and printed; arrangements have been made for translation and publication in the German, Portuguese and Russian languages.

#### *Training Program in the Field of Copyright and Neighboring Rights*

A separate report on the 1979 training program in the field of copyright and neighboring rights was published in the December 1979 issue of *Copyright*.

#### *Regional Meetings*

At the invitation of the Government of Argentina, a Regional Copyright Seminar for Latin American and Caribbean Countries was convened in Buenos Aires in November 1979. The Seminar was organized jointly by WIPO and Unesco, in cooperation with the Interamerican Copyright Institute, on the basis of recommendations made by the Group of Latin American Experts on Copyright which met in Geneva in March 1978. Thirty-eight participants from 14 countries and seven non-governmental international organizations attended the Seminar; recommendations were adopted, addressed to governments and to WIPO and Unesco, on the strengthening of copyright protection by the adoption of new national laws and accession to international conventions, and on the continuation of legal-technical assistance to the countries of the region.

#### *Assistance to Certain Developing Countries and Regional Institutions of Developing Countries*

*In General.* The Permanent Committee (Copyright) noted with satisfaction a report on recent and current activities in providing advice and assistance to developing countries in legislation, institutions and related matters.

The Permanent Committee took note of the fact that the recommendations of the Subcommittee of the Intergovernmental Committee of the Rome Convention, at its meeting held in January and February 1979, would, before being submitted to the Intergovernmental Committee for endorsement, be published by WIPO, so that governments could already make use of them as a basis for domestic measures to establish infrastructures for neighboring rights. The said recommendations were published in the April 1979 issue of *Copyright*.

During 1979, advice and assistance were given to the following developing countries or their regional institutions, or requests for advice and assistance were

under active consideration, in connection with the preparation of legislation, the establishment or modernization of national or regional institutions or related matters.

### *Countries*

*Angola.* Discussions with Government officials on training requirements, and preparation of comments on, and discussion of, draft copyright legislation.

*Barbados.* Preparation and transmission of draft copyright law.

*Bolivia.* Preparation of comments on draft copyright legislation. Communication of the same to the Government of Bolivia.

*Cameroon.* Mission by a WIPO staff member in October 1979; discussion with Government officials on training, new legislation and the possibility of organizing a national or regional seminar.

*Congo.* Preparation and transmission of comments on draft copyright legislation.

*The Gambia.* Request for assistance in preparing draft copyright legislation and acceding to international conventions.

*Ivory Coast.* Preparation of draft implementing provisions for legislation on authors' societies. Mission in March 1979 by a Deputy Director General, accompanied by a consultant from the International Federation of Producers of Phonograms and Videograms (IFPI), to discuss with Government officials the national legislation necessary for the implementation of the Rome Convention and the Phonograms Convention. Preparation of draft legislation for this purpose.

*Madagascar.* Preparation and transmission of comments on draft copyright legislation; agreement on assistance in establishing administrative services.

*Niger.* Preparation and transmission of comments on draft copyright legislation.

*Rwanda.* Participation by a WIPO official in, and financial contribution to, a National Congress of Artists, Composers and Publishers; comments on draft legislation establishing an authors' society.

*Sri Lanka.* New copyright law adopted in May 1979 by the Parliament on the basis of a draft prepared by WIPO, following the Tunis Model Law. Preparation

and transmission of draft legislation on neighboring rights (which would enable Sri Lanka to accede to the Rome Convention).

*Suriname.* Mission by a WIPO staff member and a consultant from the Netherlands in February and March 1979; report advising on intellectual property legislation and administration, including copyright.

*Togo.* Preparation and transmission of comments on draft copyright legislation.

*Zaire.* Preparation and transmission of comments on draft copyright legislation; discussion at WIPO with an official of the Ministry of Culture and Arts.

### *Regional Institutions*

*African Intellectual Property Organization (OAPI).* Assistance in preparing for the entry into force of the revised Libreville Agreement.

### **C. Training Opportunities in the Fields of Industrial Property and Copyright and Neighboring Rights**

In October 1979, the International Bureau announced the program for training opportunities in 1980 and subsequent years in the fields of industrial property and copyright and neighboring rights, and invited the governments of developing countries to propose candidates for the 1980 general introductory courses and/or for training at national patent offices or copyright offices of certain countries.

### **D. Special Contributions by Certain Countries to Development Cooperation Activities in the Fields of Industrial Property, Copyright and Neighboring Rights**

For the purposes of the development cooperation activities in the fields of industrial property, copyright and neighboring rights, referred to above, the governments of certain countries made the following special contributions in the form of the provision of the services of experts, or documents, or the payment of all or part of the cost of certain activities, in addition to the contributions referred to above in the provision of search reports, the organization of training courses, etc.

(a) The Government of France has made available experts from its National Institute of Industrial Property (INPI) and has provided training facilities and equipment for the OAPI project for the establishment of a patent documentation and information center.

(b) The Government of the Federal Republic of Germany continued to assign one of the officials of its Patent Office to work full time in the International Bureau on WIPO projects on development cooperation. The official was selected in agreement with the Director General of WIPO. The Government of the Federal Republic of Germany not only covers the salary of the said official but also reimburses the International Bureau's overhead expenses due to the presence of that official in the International Bureau and the expenses of that official's missions. From a fund of 895,000 Swiss francs, placed at the disposal of the International Bureau by the Government of the Federal Republic of Germany pursuant to an agreement concluded in August 1977 between WIPO and that Government for the financing of specified development assistance projects between 1977 and 1982, allocations were made for the services of the consultant official provided by that Government to work on development cooperation projects and for the provision of expert services, training facilities and equipment. The said agreement was revised in December 1979.

(c) The Government of Hungary organized in cooperation with WIPO a general introductory training course on copyright and neighboring rights in Budapest in October and November 1979, contributing the major part of the subsistence allowances of the 22 trainees and the accommodations and honoraria of four lecturers.

(d) The Swedish International Development Authority (SIDA) provided funds to assist in the organization of the Seminar held in Bangkok in January 1979 on Technological Information Contained in Patent Documents, and the Symposium on Copyright and Neighboring Rights held in Stockholm in June 1979. SIDA also agreed to provide funds for consultative services and state-of-the-art searches to be provided by the Swedish Patent Office.

(e) The Government of Switzerland has provided funds, expert services and training facilities for the OAPI project for the establishment of a patent documentation and information center.

(f) The Government of the United Kingdom provided funds and expert services for the purposes of missions to member and potential member States of the Industrial Property Organization for English-Speaking Africa (ESARIPO) in preparation for the project to establish a patent documentation and information center in the framework of ESARIPO, and in organizing a seminar preceding the third session of the Council of ESARIPO. It also sent experts to Sri Lanka to assist in the preparations for the putting into effect of the new Code of Intellectual Property Act.

(g) Full or partial payment of the travel expenses and subsistence allowances of trainees in the fields of industrial property and of copyright and neighboring

rights under the WIPO Fellowships Program for 1978 was made by the following countries: Austria, Bulgaria, Canada, Czechoslovakia, France, Germany (Federal Republic of), Hungary, India, Italy, Japan, Mexico, Netherlands, Soviet Union, Spain, Sweden, Switzerland and United Kingdom.

(h) Collections of patent documents were provided to Algeria and to Brazil by the United States of America, to China by the United Kingdom, to OAPI by France and Switzerland. State-of-the-art search reports were provided by Austria and Germany (Federal Republic of) to a number of developing countries.

## E. Other Relations with Developing Countries

### *Missions and Visits to WIPO*

On the occasion of his participation in the Bangkok Seminar on Technological Information Contained in Patent Documents and in the Pattaya Meeting of a Group of Experts on the Legal Protection of Inventions, Innovations and Know-How in the Countries of the ASEAN Region, in January and February 1979, the Director General met a Deputy Prime Minister, the Ministers for Foreign Affairs and for Commerce and other high officials of the Government of Thailand.

On the occasion of his participation in the sessions in Dakar of the Permanent Committees (Industrial Property and Copyright) in March 1979, the Director General was received by the President and by the Prime Minister of Senegal.

The Director General participated in the 6th Congress of the Law Association for Asia and the Western Pacific ("Lawasia"), held in Colombo in August 1979. He gave the keynote address in the Industrial Property Law Committee of the Congress. On this occasion he met the President, the Minister of Trade and Shipping and other high officials and personalities of Sri Lanka.

In June 1979, the Director General received a visit by the President of the Republic of Colombia.

Missions were undertaken by WIPO officials to Algeria, Argentina, Barbados, Bolivia, Botswana, Brazil, Cameroon, Democratic People's Republic of Korea, Ethiopia, the Gambia, Ghana, Guinea Bissau, India, Iraq, Ivory Coast, Kenya, Lesotho, Liberia, Madagascar, Malawi, Mali, Mauritania, Mauritius, Morocco, Nigeria, Peru, Philippines, Republic of Korea, Rwanda, Senegal, Seychelles, Sierra Leone, Somalia, Sri Lanka, Suriname, Tanzania, Thailand, Togo, Trinidad and Tobago, Turkey, Upper Volta and Zambia for the purpose of exchanging views with the Government authorities of those countries on matters

relating to WIPO, particularly industrial property, transfer of technology and copyright and neighboring rights. In a number of instances, these discussions took place at the time when WIPO officials were participating also in meetings organized by WIPO or by organizations of the United Nations system.

A delegation from Zaire had discussions with members of the staff of WIPO in Geneva in April 1979 for the purpose of establishing a final draft of industrial property legislation to be submitted for enactment. Officials of the Government of the Republic of Korea visited WIPO in June and October 1979 and held discussions with the Director General and other officials of WIPO for the same purpose.

#### IV. Relations with States and Organizations

##### A. In General

WIPO pursued its contacts with States and international organizations during the period under review.

##### B. Relations with States

###### *Relations with Developing Countries*

See Section E of Chapter III of this report.

###### *Relations with Other States*

A delegation, mainly consisting of high officials of the State Science and Technology Commission of China, visited the headquarters of WIPO from May 18 to 20, 1979. It discussed with the Director General matters of mutual interest, including in particular plans for technical cooperation between China and the International Bureau. It is foreseen that in part of such technical cooperation the national industrial property offices of several States members of the Paris Union will be involved under the overall responsibility of WIPO.

Following on the said discussions, WIPO organized two national seminars in China in 1979. The first, which took place in Shanghai in October and November 1979, and lasted two weeks, dealt with industrial property licenses and technology transfer arrangements. About 100 participants took part in the discussions, which were prepared by working papers and lectures given by a WIPO official and consultants from Japan, the Netherlands, Switzerland and the United States of America. The second seminar was

held in Beijing in November 1979 and lasted three weeks; it dealt with patent information and the International Patent Classification. About 75 participants took part in the discussions, which were prepared by working papers and lectures by two officials of WIPO and consultants from the Netherlands, the United Kingdom and the United States of America.

At the invitation of the Government of the China, the Director General paid an official visit to China in November 1979. He was accompanied by three other officials of WIPO. He held discussions with the Head of the State Science and Technology Commission (a Deputy Prime Minister, member of the State Council and a Vice-Chairman of the Central Committee) and with other high officials of the Government of China. Plans for technical cooperation within the framework of WIPO were prepared, particularly for the implementation of the future patent law of China.

Training visits were arranged, and partly financed, by WIPO for 14 Chinese officials in the national industrial property offices of Canada and the United States of America, and in the International Bureau.

The Director General paid an official visit to Poland in May 1979 at the invitation of the Government of that country. He was received by the Deputy Chairman of the Council of Ministers, the Ministers for Foreign Affairs and for Culture and Fine Arts and other high officials concerned with industrial property and copyright. He visited Warsaw and other places in Poland.

In April 1979 the Director General received a visit by the President of the Swiss Confederation.

Other missions were undertaken by the Director General to Austria, Hungary, Spain, Sweden and the United States of America and by officials of WIPO to the same countries and to Australia, Belgium, Bulgaria, France, Germany (Federal Republic of), Greece, Netherlands, Soviet Union and the United Kingdom to discuss with Government authorities matters relating to WIPO, industrial property, copyright and neighboring rights. In a number of instances, these discussions took place at the time when WIPO officials were participating also in meetings organized by WIPO or by organizations of the United Nations system or in other meetings. In Austria, the Director General delivered an address on the occasion of the celebration of the 80th anniversary of the Austrian Patent Office; in Hungary and Sweden, he opened the training course and the symposium, respectively, on copyright and neighboring rights; also in Hungary he attended the 20th anniversary of the Conference of Heads of Offices for Inventions of the CMEA countries; in Spain, he attended the Diplomatic Conference on the Avoidance of Double Taxation of Copyright Royalties; in the United States of America, he met with representatives of private organizations to discuss with them the prospects of accession by the said country to the Berne Convention.

### C. Relations with Other Organizations of the United Nations System

#### *General Coordination of Policies and Activities*

The Director General and other officials of WIPO participated in the work of a number of inter-secretariat bodies of the United Nations system established for the purpose of facilitating coordination of the policies and activities of the organizations of the system. These bodies included the Administrative Committee on Coordination (ACC), composed of the executive heads of all the organizations and programs of the system under the chairmanship of the Secretary-General of the United Nations, which met at the headquarters of WIPO in April 1979, and its Organizational Committee, which met in March, June and October 1979, the Consultative Committee on Substantive Questions (Programme) (CCSQ (Prog)) and the Consultative Committee on Administrative Questions (CCAQ), which met in March, February and October 1979, as well as other subsidiary bodies of the ACC, working groups and interagency meetings convened to deal with various matters of common interest, including procurement of goods and services, indexing of documents, information systems, legal questions, publications, consumer protection, assistance to the Palestinian people, action against apartheid, public information, statistical activities, science and technology, technical cooperation among developing countries and preparations for the new international development strategy, for the United Nations Conference on New and Renewable Sources of Energy and for the special session of the General Assembly to be held in 1980. WIPO was also represented at a meeting of the Board of the United Nations Joint Staff Pension Fund in Manila in July 1979. A special agreement extending the jurisdiction of the United Nations Administrative Tribunal to the World Intellectual Property Organization with respect to applications by staff members of WIPO alleging non-observance of the regulations of the UN Joint Staff Pension Fund was signed on behalf of WIPO and the United Nations in August and September 1979, respectively. The agreement entered into force on October 6, 1979.

#### *Representation at Meetings of United Nations Bodies*

WIPO was represented at various meetings of United Nations bodies at which questions of direct interest to WIPO were discussed. These included: the Committee of the Whole established by the United Nations General Assembly in order to assess and review the progress of the implementation of United Nations resolutions related to the New International

Economic Order, in New York in February 1979; the Preparatory Committee for the new International Development Strategy (a committee of the whole of the General Assembly of the United Nations) in New York in February and in June 1979 (on the latter occasion the Director General addressed the Preparatory Committee); the Preparatory Committee for the United Nations Conference on Science and Technology for Development, in New York in January and February and in April and May 1979 and the Conference itself (UNCSTD) in Vienna in August 1979; the Economic and Social Council in Geneva in July 1979; and the United Nations Advisory Committee on the Application of Science and Technology to Development, in Geneva in March 1979.

WIPO was represented at the African Preparatory Meeting for the Fifth United Nations Conference on Trade and Development (UNCTAD V), held in Addis Ababa in January and February 1979, at the Group of 77 preparatory meeting for UNCTAD V, held in Arusha (Tanzania) in February 1979, and at UNCTAD V, held in Manila in May and June 1979. At that Conference a resolution was adopted on UNCTAD's contribution to economic, commercial and development aspects of the industrial property system in the context of its ongoing revision; the resolution welcomed the decision of WIPO to convene the Diplomatic Conference for the Revision of the Paris Convention, stressed that one of the main objectives of the revision should be the promotion of indigenous inventive and innovative capacity and the working of protected inventions, reaffirmed certain conclusions and recommendations relating to trademarks endorsed by UNCTAD's Committee on Transfer of Technology, and urged all States members of UNCTAD to attend the said Diplomatic Conference.

WIPO was represented at two sessions of the United Nations Conference on an International Code of Conduct on Transfer of Technology held in Geneva in February and in October and November 1979, at sessions of the Trade and Development Board of UNCTAD in Geneva in March and October 1979, at the United Nations Conference on Olive Oil, also in Geneva in March 1979, at the Fifth Conference of Ministers of the Economic Commission for Africa held in Rabat in March 1979, at an UNCTAD meeting of a group of experts on restrictive business practices in Geneva in April 1979, at the session of the Governing Council of the UNDP held in New York in June 1979, and at the United Nations Conference on Restrictive Business Practices in Geneva in November and December 1979.

WIPO was also represented at a session of the United Nations Special Committee on the Policies of Apartheid held in Atlanta (United States of America) in January 1979 in conjunction with a ceremony commemorating the late Dr. Martin Luther King, and

at an Interregional Symposium on Development Process and Technological Options in Developing Countries, organized by the United Nations in cooperation with the Government of Togo, in Lomé in May 1979. The conclusions and recommendations of the Lomé Symposium were submitted to UNCSTD.

#### *Resolutions and Decisions of the United Nations General Assembly and of the United Nations Economic and Social Council (ECOSOC)*

*Resolutions and Decisions of the United Nations General Assembly and Economic and Social Council.* The United Nations General Assembly at its thirty-third session (September-December 1978) and the Economic and Social Council at its sessions in April/May and July/August 1979 adopted a number of resolutions and decisions which call for action by the organizations of the United Nations system in general or are otherwise relevant to the work of WIPO. They were brought to the attention of the Governing Bodies of WIPO together with comments and proposals by the Director General.

#### *Information for Studies and Reports of the United Nations*

WIPO provided information for inclusion in reports prepared by the Secretary-General of the United Nations for the General Assembly, the Economic and Social Council and other organs of the United Nations.

Among the subjects of direct concern to WIPO which these reports dealt with were science and technology, consumer protection, assistance to developing island countries, assistance to South African student refugees, cooperation with the Organization of African Unity, assistance to African countries facing special difficulties, assistance to the Palestinian people, and the status and role of women.

#### *Reports to United Nations Bodies*

WIPO submitted a report on its activities related to industrialization to the Committee of the Whole established by the General Assembly of the United Nations to review progress in the implementation of its resolutions on the establishment of the new international economic order, and a report, submitted to and endorsed by the WIPO Governing Bodies, to the General Assembly on such progress within WIPO.

#### *Relations with United Nations Regional Commissions*

Close cooperation continued with the secretariats of the United Nations regional commissions, particularly with the Economic Commission for Africa (ECA) as concerns the Industrial Property Organization for English-Speaking Africa and the African Regional Centre for Technology (ARCT), established by ECA member States at Dakar (Senegal), and with the Economic and Social Commission for Asia and the Pacific (ESCAP) as concerns the Bangkok Seminar on Technological Information Contained in Patent Documents and the planning of assistance to the ESCAP Regional Centre for Technology Transfer (RCTT) at Bangalore (India). An official of the ARCT visited WIPO for briefing in December 1979. A WIPO consultant took part in a meeting in Vienna in July 1979 for the purpose of planning information services within the RCTT.

#### *Relations with the United Nations Conference on Trade and Development (UNCTAD)*

WIPO continued to follow the work of UNCTAD, particularly by the attendance of staff members at preparatory meetings for the Fifth Conference and the Conference itself, at the sessions of the UNCTAD Trade and Development Board and at meetings of groups of experts convened by UNCTAD.

#### *Relations with the United Nations Industrial Development Organization (UNIDO)*

Cooperation continued with UNIDO, particularly as concerns Users' Guides to the International Patent Classification and state-of-the-art searches.

In addition, WIPO provided information, particularly on the revision of the Paris Convention, for the purposes of UNIDO's Joint Study of International Industrial Cooperation.

WIPO was represented at an interagency meeting convened by UNIDO in July 1979 in Vienna to consider a draft of the said Study, prepared for the Third General Conference of UNIDO (UNIDO III), held in New Delhi in January and February 1980.

Following the interagency meeting referred to in the preceding paragraph, the Director General wrote to the Director General for Development and International Economic Cooperation of the United Nations expressing his concern with regard to certain difficulties which could arise from the method of preparation, the content and the distribution of the draft document prepared by the UNIDO Secretariat.

The draft document referred to above, and the document in its final form, contained a proposal for the establishment of an international patent examination center and a request that UNIDO III should designate an agency to initiate steps for this purpose. After discussion of this matter in the WIPO Governing Bodies at their tenth series of meetings in October 1979, and further correspondence with the United Nations, WIPO prepared, and UNIDO agreed to circulate as a document for UNIDO III, a paper on the examination of patents in developing countries, and the Director General informed governments of the situation by means of a note verbale.

WIPO was represented at preparatory meetings for UNIDO III convened by the Economic Commission for Latin America (ECLA) and UNIDO in Cali (Colombia), by the Economic Commission for Africa, the Organization of African Unity and UNIDO in Nairobi, both in September 1979, and by the Industrial Development Centre for Arab States (IDCAS) in Algiers in November 1979.

#### *Relations with the United Nations Educational, Scientific and Cultural Organization (UNESCO)*

Close cooperation continued with Unesco in connection with copyright activities, including matters concerning development cooperation related to copyright, as well as in respect of other matters in the field of copyright and neighboring rights. In November 1979, agreement was reached on the establishment of a Joint International Unesco-WIPO Service for Facilitating the Access by Developing Countries to Works Protected by Copyright.

WIPO was represented at the Intergovernmental Conference on Scientific and Technological Information for Development (UNISIST II), organized by Unesco in Paris in May and June 1979, and at the second session of the Intergovernmental Council for the General Information Program of Unesco in Paris in November 1979.

#### *Relations with the United Nations Educational, Scientific and Cultural Organization (UNESCO) and the International Labour Organisation (ILO)*

Close cooperation also continued with Unesco and the ILO in connection with activities in the field of neighboring rights, including matters concerning development cooperation and neighboring rights, particularly in respect to the study of the administration of the rights provided for by the Rome Convention.

#### **D. Relations with Other Intergovernmental Organizations**

WIPO continued to cooperate with other intergovernmental organizations, particularly, in the field of development cooperation, with the African Intellectual Property Organization (OAPI) (WIPO was represented at the sessions of the Administrative Council of OAPI held in Ouagadougou (Upper Volta) in February 1979 and in Nouakchott (Mauritania) in December 1979), the Andean Group, the Commonwealth Fund for Technical Cooperation (CFTC), the Commission of the European Communities (CEC), the European Patent Organisation (EPO), the Industrial Development Centre for Arab States (IDCAS) (WIPO was represented at the session of the Board of Directors of IDCAS held in Tunis in May and at the IDCAS Conference held in November 1979), the Industrial Property Organization for English-Speaking Africa (ESARIPO) and the Organization of African Unity (OAU).

Relations with intergovernmental organizations in fields other than development cooperation, in particular representation at meetings of such organizations, will be covered in the reports on the main activities of the Unions administered by WIPO in the fields of industrial property and of copyright and neighboring rights, to be published separately in the March 1980 issues of *Industrial Property* and *Copyright*, respectively.

#### **E. Relations with International and National Non-Governmental Organizations**

Relations with international and national non-governmental organizations, in particular representation at meetings of such organizations, will be covered in the reports on the main activities of the Unions administered by WIPO in the fields of industrial property and of copyright and neighboring rights, to be published separately in the March 1980 issues of *Industrial Property* and *Copyright*, respectively.

#### **V. WIPO Publications**

*Reviews.* The reviews *Industrial Property* and *Copyright* continued to appear every month in English and French. The first three issues of a newsletter in Spanish, *Noticias de la OMPI*, appeared in April, July and October 1979.

An updated list of *Member States of the World Intellectual Property Organization (WIPO) and the International Unions*, as of January 1, 1980, was published in English and French in January 1980.

*WIPO General Information Brochure.* Updated versions of the *WIPO General Information Brochure* were published in Russian in February, in Arabic in April, in English and French in June, in Spanish in July and in German in December 1979.

A new leaflet, *WIPO—What It Is, What It Does*, was published in English and French in August and December 1979.

A new catalog of *WIPO Publications (1979)* was published in May 1979.

*Official Texts.* The official texts of a number of conventions, agreements and other treaties administered by WIPO were published.

*Other Publications.* The *WIPO Licensing Guide for Developing Countries* was published in Arabic in February 1979. The *WIPO Model Provisions on the Protection of Computer Software* were published in Russian in March 1979. A general information brochure on INPADOC was published in English, French and German in April 1979. The *Guide to the Berne Convention* was published in Arabic in July and in Japanese in August 1979. The *WIPO Model Law for Developing Countries on Inventions and Know-How, Part I (Patents)* was published in English, French and Spanish in August 1979. A brochure containing general information on the third edition of the *International Patent Classification* was published in English in August and in French in October 1979. Summary tables of the *Industrial Property Statistics of 1976* were published in September 1979. A leaflet containing basic facts about the *Patent Cooperation Treaty* was published in English in December 1979.

A number of other publications dealing with specific matters in the fields of industrial property and copyright were also published.

Displays of the publications of WIPO were presented at international fairs at Leipzig in March, at Milan in April, at Warsaw in May, at Madrid in May and June, at Moscow in September and at Frankfurt in October 1979. Displays were also presented at a demonstration of patent information held in Vienna in conjunction with the United Nations Conference on Science and Technology for Development in August and at the *Salon des Inventions* at Geneva in November and December 1979.

## VI. Public Information

*Information Meetings and Relations with the Press.* Lectures on WIPO and its activities were given by officials of WIPO at information meetings held at the headquarters of WIPO or elsewhere in Geneva for the benefit of groups of students from universities in Mexico and Switzerland and other groups from Belgium, Romania, the Soviet Union and Switzerland.

A lecture was also given for the members of a training course organized by the United Nations Institute for Training and Research (UNITAR).

A delegation from the *Association internationale des parlementaires de langue française* (International Association of French-Speaking Parliamentarians) visited the WIPO headquarters in July 1979, and were given an account of the activities of WIPO.

Interviews were given to newspaper and radio correspondents; a group of correspondents accredited to the United Nations in Geneva was received by the Director General; WIPO officials participated in the weekly press briefings given at the *Palais des Nations* in Geneva.

## International Unions

### The Hague Agreement Concerning the International Deposit of Industrial Designs

#### Ratification of the Protocol of Geneva (1975)

##### FRANCE

The Government of France deposited on January 18, 1980, its instrument of ratification of the

Protocol of Geneva of August 29, 1975, to the Hague Agreement Concerning the International Deposit of Industrial Designs of November 6, 1925.

The Protocol of Geneva (1975) of the said Agreement will enter into force, with respect to France, on February 18, 1980.

The Hague Notification No. 14, of January 22, 1980.

### Nice Agreement (Classification/Marks)

#### Ratification of the Geneva Act (1977)

##### FRANCE

The Government of France deposited on January 18, 1980, its instrument of ratification of the Geneva Act of May 13, 1977, of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957.

The said instrument contains the following declaration:

"Referring to Article 13 of the Act, the Government of France declares that the Act is applicable to the territory of the French Republic, including the Overseas Departments and Territories."  
(Translation)

The Geneva Act (1977) of the said Agreement will

enter into force, with respect to France, on April 22, 1980.

Nice Notification No. 47, of January 22, 1980.

### Patent Cooperation Treaty (PCT)

#### Accession

##### AUSTRALIA

The Government of Australia deposited on December 31, 1979, its instrument of accession to the Patent Cooperation Treaty (PCT) done at Washington on June 19, 1970.

The said Treaty will enter into force, with respect to Australia, on March 31, 1980.

PCT Notification No. 30, of January 7, 1980.

## WIPO Meetings

### WIPO Seminar on Industrial Property Licenses and Technology Transfer Arrangements

(Shanghai, October 22 to November 2, 1979)

#### NOTE\*

The WIPO Seminar on Industrial Property Licenses and Technology Transfer Arrangements was held in Shanghai, China, from October 22 to November 2, 1979. The Seminar was organized by WIPO on the invitation of the State Science and Technology Commission of the People's Republic of China and took place at the Shanghai Institute of Scientific and Technological Information.

The participants were staff members of the Bureau of Scientific Research Attainments of the State Science and Technology Commission (in Beijing and Shanghai), the Institute of Scientific and Technical Information of China (Beijing), the Shanghai Institute of Scientific and Technical Information, the General Administrative Bureau for Industry and Commerce (Beijing), the China Council for the Promotion of International Trade (Beijing), various other Government ministries, commissions and departments responsible for given sectors of industry, trade or commerce, and managers and advisers of national export and import corporations and other state production and distribution enterprises. Over 100 such persons attended the Seminar.

The purposes of the Seminar were to inform the participants of the role of WIPO in promoting technological development and the function of industrial property in the technological process and industrial development, to acquaint them with the legal princi-

\* This Note has been prepared by the International Bureau.

ples involved in the protection of inventions, industrial designs, trademarks and know-how, to advise the participants on how to identify legal problems which are likely to arise in the negotiation and preparation of industrial property licenses and technology transfer agreements, to increase their awareness of existing commercial practices in the acquisition, development and use of technology, to indicate the possible solutions to those legal problems in light of those practices and to exchange information and experiences concerning such legal principles, problems, practices and solutions.

The discussions were based on background documents prepared by the International Bureau of WIPO and on the *WIPO Licensing Guide for Developing Countries* as well as on case studies of license agreements or negotiations for the acquisition of technology in the electronics, petro-chemical, pharmaceutical, food, mechanical, hydraulic and electro-mechanical and computer equipment industries. Most of the documents, including the *WIPO Licensing Guide for Developing Countries*, had been translated into Chinese.

The discussions were preceded by lectures given by a staff member of WIPO and by four specialists on matters relating to the negotiation and preparation of license agreements—from Japan, the Netherlands, Switzerland and the United States of America—occupying responsible positions in well-known transnational corporations or currently engaged in the practice of law.

The participants took a very active part in the discussions. Many were generally familiar with the subject matter or had actual experience in negotiating technology transfer arrangements. The subjects of the Seminar were treated in depth by the participants in study groups organized as a prelude to and as a follow-up of the lectures and discussions, thus enhancing the exchange of views which took place in the Seminar itself. The participants posed a number of diverse and thought-provoking questions and listened with keen interest to the responses.

The Seminar thus afforded an opportunity to the participants to become better acquainted not only with the principles of industrial property and the role which it can play in development but also with the attitudes of the holders of technology as to the terms and conditions upon which commercial arrangements for the acquisition of technology are usually negotiated, thereby enabling the participants to understand better the concepts upon which the successful importation of advanced technology depends.

## **WIPO Seminar on Patent Information and the International Patent Classification (IPC)**

(Beijing, November 12 to 30, 1979)

### NOTE\*

The WIPO Seminar on Patent Information and the International Patent Classification (IPC) was held in Beijing, China, from November 12 to 30, 1979. The Seminar was organized by WIPO on the invitation of the State Science and Technology Commission of the People's Republic of China.

The participants were staff members of the Bureau of Scientific Research Attainments of the State Science and Technology Commission (Beijing and Shanghai) and various Institutes of Scientific and Technical Information (in Beijing, Chungking, Honan Province, Shensi, Shanghai, Szechuan and Tientsin), officials of the China Council for the Promotion of International Trade (Beijing), other Government Ministries, and Commissions and Departments responsible for scientific and technological information in various institutes and State production and distribution enterprises. The total number of participants was more than 70.

The Seminar dealt with the following main subjects:

- General introduction to the usefulness and the use of patent documents as a source of technological information
- Study of patent documents and means of access to their technical content
- The International Patent Classification (IPC)
- The dissemination of patent information to research organizations and enterprises
- The planning and creation of a patent information and documentation center.

Discussions were based on 14 background documents prepared by the International Bureau and on the text of the third edition of the IPC. Some of the documents and five Sections of the International Patent Classification had been translated into Chinese. Practical exercises in classification were conducted using examples of patent documents and on the formulation of search strategies with respect to given technical problems.

Discussions were preceded by lectures given by two staff members of WIPO and by three specialists—experts in patent information in general and the International Patent Classification in particu-

\* This Note has been prepared by the International Bureau.

lar—from the Industrial Property Offices of the Netherlands, the United Kingdom and the United States of America.

The participants took a very active part in the discussions. Many of them were already familiar with the subject of patent information in general and with the International Patent Classification. The subjects referred to above were considered in depth by the participants in nine small working groups set up primarily to facilitate the execution of the practical exercises, thus enhancing the active exchange of views which took place throughout the Seminar.

The participants formulated technical questions relating to patent information generally and to the International Patent Classification, and posed several legal questions pertaining to the procedures for the granting of patents in various countries.

The Seminar gave the participants the opportunity to become better acquainted with problems of patent information and the use of the International Patent Classification for search and retrieval, and the way in which patent information could be disseminated to enterprises and research institutions.

level in various parts of the world and to promote the advancement of this branch of law and its practical application.

The discussions were based, in part, on summaries of the teaching of industrial property law in various countries, presented by the participants, and on a list of basic or reference works for French-language university teaching, prepared by the International Bureau of WIPO. In addition, the participants gave an account of the experiences gained by them in the teaching of industrial property law and had an exchange of views on this subject.

The participants concluded that the teaching of and research in the law of industrial property and other fields of intellectual property should receive their appropriate place in the curriculum and related programs of research of universities and other educational institutions and that, in general, at the present time not enough importance was being given to the teaching of and research in industrial property at the university level. The participants identified a number of reasons for the diversity in approach and emphasis on the teaching of the law of industrial property and agreed that a reorientation should take place which would ensure that a greater number of students could be afforded an opportunity to receive information about and an exposure to the essential elements of the subject, in an organized and concentrated manner, in an independent course on the law of industrial property or on the law of that subject taught in conjunction with the law of copyright, unfair competition and other subjects of intellectual property. Assistance was needed, especially to educational institutions in developing countries, in planning an appropriate curriculum, in the compilation of a list of basic reference works, in the preparation of specialized works on the various subjects and in the preparation of classroom teaching materials. Further, universities and other institutions of higher learning with specialized programs in the law of industrial property could stimulate the introduction and conduct of appropriate courses in technical schools or provide extension services for the benefit of engineers and technical and scientific personnel.

The participants noted that the teaching of and research in industrial property law had an important influence on the development of the legal, administrative and judicial aspects of industrial property and on commercial, industrial and technological development, but that in developing countries fewer specialists in the field of industrial property existed and these were, for the most part, university professors who were thus more likely to be called upon to assist in the formulation of legislation dealing with intellectual property matters. They also noted that visiting professorships and exchanges and academic sojourns in various countries were an essential element of an orientation program to enhance the teaching of and

## WIPO

### Round Table of University Professors on the Teaching of Industrial Property Law

(Geneva, October 10 to 12, 1979)

#### NOTE \*

The Round Table of University Professors on the Teaching of Industrial Property Law was organized by WIPO and took place in Geneva from October 10 to 12, 1979.

Professors from the following 16 countries had been invited by the Director General of WIPO to participate in the Round Table: Argentina, Colombia, France, Germany (Federal Republic of), India, Kuwait, Mexico, Netherlands, Peru, Philippines, Poland, Soviet Union, Spain, Thailand, United Kingdom, United States of America. The list of participants follows this Note.

The purpose of the Round Table, the first meeting of its kind organized by WIPO, was to provide a forum for the discussion and exchange of views on the teaching of industrial property law at the university

\* This Note has been prepared by the International Bureau.

research in intellectual property law, but that formalized programs and procedures involving government channels did not seem appropriate for university professors; instead, financial assistance to professors and researchers especially in developing countries needed to be increased, particularly through facilitating a more effective exchange of information on existing fellowship programs. To this end, it was suggested that a clearing house of information on such opportunities and specialized programs be established and that such a function could be entrusted to WIPO or to an international association of university professors of industrial or intellectual property law. It was also suggested that WIPO provide assistance through fellowships abroad for professors from developing countries, by sending professors to such countries to advise on curricula and related teaching materials, by making its publications available on a larger scale to interested professors, by assisting universities and professors in publishing teaching materials and by disseminating information about such courses and materials.

Finally, the participants recommended that, with a view to enlarging and intensifying contacts between academicians teaching and/or doing research in the field of intellectual property law at universities or research institutes, an international association of intellectual property specialists be formed, which could, for example, be called "The International Association for the Advancement of Teaching and Research in Intellectual Property." After an exchange of views on the name, membership, objectives, activ-

ities, organizational form, organs and financing of such an association, the participants recommended that a small group should meet by mid-1980 and prepare a draft of the statute of the association and present that draft for comments to the other participants and subsequently to a constitutive assembly which might meet on the occasion of a future Round Table of Professors, to be hosted by WIPO in Geneva, in 1981, and which would be composed of an enlarged circle of professors, including not only those concerned with industrial property but also those concerned with copyright and other subjects of intellectual property.

#### LIST OF PARTICIPANTS\*

##### I. University Professors

H. Abbas (*Kuwait*); E. D. Aracama Zorraquin (*Argentina*); E. Bautista (*Philippines*); U. Baxi (*India*); F.-K. Beier (*Federal Republic of Germany*); A. Bercovitz Rodríguez-Cano (*Spain*); J.-J. Burst (*France*); W. R. Cornish (*United Kingdom*); B. Kresalja (*Peru*); Krit Garnjana-Goonchorn (*Thailand*); M. Pachón (*Colombia*); D. Rangel Medina (*Mexico*); J. Szwaja (*Poland*); G. Weston (*United States of America*).

##### II. WIPO

A. Bogsch (*Director General*); G. A. Ledakis (*Legal Counsel*); M. Porzio (*Director, Office of the Director General*); A. Dávila (*External Relations Officer, External Relations Section, Development Cooperation and External Relations Division*).

\* A list containing the titles and functions of the participants may be obtained from the International Bureau.

## General Studies

### Recent Developments in Spanish Case Law in the Field of Industrial Property and Related Rights\*

A. DE ELZABURU and M.-A. BAZ\*\*

As a starting off point, it should be noted that, following the entry into force of Law No. 10 of March 17, 1973, Amending the Law on Contentious-

Administrative Jurisdiction,<sup>1</sup> the number of Supreme Court rulings on judicial and administrative appeals has dropped. This fact is naturally due to the passing of jurisdiction on such appeals to the Regional Courts (although the Third Chamber of the Supreme Court retains some jurisdiction in this area, being competent to rule on appeals brought against decisions handed down by the Regional Courts). Despite this change we cannot say that the interpretive criteria have been substantially modified; in most areas, they continue to evolve on lines similar to those of the earlier period; which is to be expected since the basic legislation has remained the same.

\* This is the second of two studies dealing with recent developments in industrial property in Spain. The first, devoted to recent trends in Spanish legislation, was published in *Industrial Property*, July/August 1979, p. 179.

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<sup>1</sup> Published in the Official Journal (*Boletín Oficial del Estado*) of March 21, 1973.

### Inventions

We should first of all mention a decision of the Fourth Chamber of the Supreme Court of June 17, 1971,<sup>2</sup> which concerned the forfeiture of two patents that had been pronounced by the Industrial Property Registry for want of proper evidence of working and also for failure to offer them for licensing within the deadlines provided by the Industrial Property Law. The Supreme Court held that the decision of the Industrial Property Registry<sup>3</sup> conflicted with the provisions of Article 5A(4) of the Paris Convention and that, in view of the pre-eminence of the Convention as a result of its ratification by the Spanish State, forfeiture was not in order.

This Supreme Court ruling<sup>4</sup> seemed to betoken a real change; however, the matter seems to have returned to the conception of an earlier decision of November 8, 1961,<sup>5</sup> with the decision of the Third Chamber of the Supreme Court of February 22,

<sup>2</sup> *Repertorio de Jurisprudencia Aranzadi*, 1971 (case law record), No. 3191 (hereinafter: *Ar.*, followed by the year and the number of the decision).

<sup>3</sup> As we know, the Spanish Industrial Property Law (hereinafter, both in the text and in the notes: the Law) provides, in order to avoid the forfeiture of patents—and utility models—that the formality of proving the working of the subject matter of those titles has to be complied with within three years following the date of grant, or alternatively a license has to be offered through the Industrial Property Registry for the working of the subject matter of the patent or utility model concerned. The penalty for failure to comply with any of those formalities is the forfeiture of the patent or utility model. See Sections 84, 89, 97, 116(3) and 175 of the Law.

<sup>4</sup> In the same vein, see the decision of the Third Chamber of the Supreme Court of June 17, 1974 (*Ar.* 1974, No. 2849).

<sup>5</sup> The ruling of the Fourth Chamber of the Supreme Court of November 8, 1961 (*Ar.* 1961, No. 3731), stated that "the person to whom a patent is granted may keep it, even without working it, for the three years following grant, and even longer if it is offered to the public for licensing, subject to two conditions only: the annual fee laid down in Section 111, necessary for the control of the patent, has to be paid, and the license to work has also to be offered to the Industrial Property Registry until someone applies for it, on the understanding that failure to comply with one of these conditions has the effect of invalidating the patent." Consequently, the contention of the appellant that a patent should not be declared forfeit in spite of working not having been proved or an exploitation license not having been offered under the conditions laid down by the Law "cannot be considered founded: (1) because this prohibition of forfeiture has established itself only for the hypothetical case of the first license having been granted, but not for any other situation prior to such grant; (2) because the principle is not absolute, but is a basis of development for the national laws of the States of the Paris Union; (3) because Article 2 of the Convention, which already appears in the Hague Act thereof, protects nationals of countries of the Union, subject to compliance with the conditions and formalities imposed on nationals; one of the conditions and formalities imposed in Spain is that written into Sections 89 and 90 of the Law, which require the offering of a license to work as a means of achieving a grant of the first such license in order to bring into play the system, and bring about the application of the paragraph, introduced by the London Act, whereby no proceedings for forfeiture may be taken until two years have elapsed following the grant of the first license; ... (5) because, if such a broad interpretation of the paragraph were made as is sought by the appellant, it would not likewise be possible to apply sanctions for failure to pay the annual fee for enjoyment of the patent ...; (6) because Article 5(2) of the London Act, and before it the Hague

1977,<sup>6</sup> which confirmed the decision of the First Chamber of Contentious-Administrative Jurisdiction of the Regional Court of Madrid. In its decision, the Regional Court of Madrid held that the obligation to work an invention or to offer licenses to work it was not at variance with the provisions of the Paris Convention since "the protection of the Convention is without prejudice to compliance with the conditions and formalities imposed on nationals; one of those formalities is precisely that of offering licenses when evidence cannot be provided for the working of patents or utility models."

In these circumstances, as long as there has been no express amendment of the Law and of the obligation imposed by it of proving the working of patents and utility models or of replacing that formality by offering licenses, it would be preferable to continue to comply with both formalities and to pay the requisite annual fee. Of the reasons brought forward by the Supreme Court, at least the following are sufficiently convincing to support the argument in favor of continuing to provide evidence of the working of patents or utility models, or alternatively offering them for licensing:

(1) According to the Paris Convention, a patent cannot be declared forfeit before a period of two years has expired from the grant of the first compulsory license; this principle presupposes the grant of that license, but there is nothing to indicate its applicability to any other state of the patent prior to the grant of the license.

(2) One gathers from Article 2 of the Convention that protection requires compliance with the conditions and formalities imposed by each country on its nationals; one such formality under Spanish legislation is that of having to offer unworked patents for licensing, and this provides a means of bringing about the grant of the first license, whereupon the system provided for in Article 5 of the Convention can come into play.

(3) If a patent really cannot be declared forfeit before two years have expired following the grant of the first license, one would be bound, if Article 5 of the Convention has to be interpreted that strictly, to conclude that there was no need to effect payment of the annual fees either, which of course is absurd.

(4) Since Article 5A of the Paris Convention leaves it to the countries of the Union to take measures to

Act, describes failure to work as an abuse of the exclusive right conferred by the patent, and gives countries of the Union the right to take legislative measures to prevent it; ... (7) because, even if any conflict in the provisions were to be found (none was in fact found), ... such conflict would have to be resolved in a logical way, without reaching the absurd conclusion of forfeiture of the patent being contingent on the validity of the first license, and at the same time denying member States the possibility of adopting measures in their legislation that would bring about the attainment of that first license."

<sup>6</sup> *Ar.* 1977, No. 725.

prevent abuse of the exclusive rights conferred by the patent, one of those measures can be—and indeed is in Spain—the obligation to offer licenses to work and to repeat the offer in the event of the non-working of the patent, without there being any conditioning of the forfeiture of the patent on the prior existence of a granted license, or any denial of the applicability of the legislative provisions that allow the grant of that license.

In view of the above, it appears desirable to continue for the time being to abide by the letter of the relevant provisions of the Law only since they guarantee the effectiveness of patents and utility models, which is particularly necessary when their validity and effectiveness have to be asserted in actions against third parties who appropriate the subject matter of protection.

On the subject of compulsory licenses, a decision which deserves mentioning is that of the Supreme Court (Fourth Chamber) of December 18, 1973,<sup>7</sup> according to which “there is no principle that prevents applicants (for licenses) from prosecuting their applications until such time as the contract granting exclusive rights has been registered.” This means that, as long as there is no record of a contract conferring exclusive rights, the possibility has to be recognized of several applicants competing for licenses to work a patent or utility model under the compulsory license system.<sup>8</sup>

## Patents

### Patentability

In one case the Industrial Property Registry had denied a patent for a method to control the growth of plants on the grounds that its subject matter was not a real process within the meaning of Section 46 of the Law;<sup>9</sup> the denial was upheld by the Regional Court of Madrid. The Supreme Court (Third Chamber) on December 11, 1978,<sup>10</sup> confirmed that such a process was indeed not patentable because it did not involve anything other than the unknown application of a product, without any sequence of operations, whereas in fact “what is allowed is the registration and protection of the process whereby an application is

achieved, and not the application itself, regardless of the sequence of operations which the provisions of the law require as being fundamental.”<sup>11</sup>

### Examination

A patent had been denied on the grounds that the process claimed was incorporated in a sequence of mechanical operations that were already public property, both the nature and the application of which were known and widely used in other industrial sectors. A contentious-administrative appeal was consequently filed with the Regional Court of Madrid on the grounds that the decision rendered was at variance with, among other provisions, Section 61 of the Law, the essence of which was that “patents shall be granted without prior examination of novelty or utility.” The Regional Court of Madrid considered, in the light of other sections of the Law, that the Registry “has to effect not only an examination of form but also, in some way, even if only cursory and superficial, an examination of the substance or subject matter of the patent, this being the only way of ascertaining whether the subject matter in question falls, according to Section 106(4), under any of the prohibitions specified in Section 48, ... as it is neither practicable nor permissible, as claimed in the appeal, for paragraph (1) of Section 61 of the Law, by virtue of which patents are granted without prior examination of novelty or utility, to be applied strictly, owing to the fact that the text of that provision cannot be interpreted as a bar to the exercise of a right of examination as to form and substance conferred on the Patents Section by the Sections referred to, because the statement of a legal precept, especially if it is isolated and not systematized, cannot be allowed to produce an absurd result, and such a result would indeed be produced by the Administration having to grant any patent applied for without any examination, other than the merely bureaucratic one of the documentation, as referred to in Sections 102 and 104. This means that the Registry's power to examine *ab initio* the conditions of patentability of the invention in accordance with legal provisions (Sections 62, 63 and 106 of the Law) being thus confirmed, it is evident that there is no foundation for the applicant's claim of excessive use or misuse of power or of infringement of legal texts.” This decision of the Regional Court of Madrid was fully upheld by the Third Chamber (of

<sup>7</sup> Ar. 1973, No. 5166.

<sup>8</sup> As an alternative to the obligation on the owner to prove working, as we saw above.

<sup>9</sup> The provision is as follows: “Any improvement the purpose of which is to alter the essential conditions of a process in order to gain certain advantages over what is already known may be the subject matter of a patent, and therefore processes or sequences of chemical or mechanical operations which are totally or partly unknown with regard to their nature or their application in Spain or abroad are patentable, provided that they are directed towards the achievement of an industrial result or product....”

<sup>10</sup> Ar. 1978, No. 4082.

<sup>11</sup> There is no doubt that this subject and that of the patentability of chemical and pharmaceutical products are bound to be among the most affected when the present patent legislation is eventually amended, which will be particularly necessary in the event of our country's accession to the European Economic Community and to the Munich Convention on the European Patent (regardless of the present misgivings as to the possible advantages of the latter for Spain, which this is neither the time nor the place to analyze).

contentious-administrative jurisdiction) of the Supreme Court in its decision of May 16, 1978.<sup>12</sup>

### Utility Models

#### Novelty

The subject matter of a utility model does not lose its validity if it incorporates elements from other, earlier subject matter or from subject matter which is already public property,<sup>13</sup> so that in all cases where models are compared, care has to be taken to ascertain the discernible differences between them, in order to establish whether those differences constitute novelty,<sup>14</sup> although, in any event, the differences eligible for protection are the essential ones, namely those that offer a new industrial result.<sup>15</sup>

With regard to the proof used to show lack of novelty—particularly in connection with administrative opposition—the Supreme Court has ruled that it is the responsibility of the party alleging lack of novelty,<sup>16</sup> that catalogs are insufficient in themselves if they do not state the date of their publication and distribution,<sup>17</sup> and that the same shortcoming may be attributed to technical reports attesting knowledge of subject matter by scientific bodies, in view of the fact that such knowledge does not necessarily prove production or even disclosure of the subject matter concerned.<sup>18</sup>

<sup>12</sup> Ar. 1978, No. 2764. The line taken here was a very bold one, attributable no doubt to the confusion caused by the very provisions of the Law that serve to define the scope of the administrative examination of patents. As we know, the Law was the result of a compromise between the advocates of prior examination and the champions of the system without prior examination, and contains sections that are hard to reconcile entirely with either of the two systems, particularly Section 48(6), which denies patentability to inventions that are manifestly, and known to be, devoid of novelty, a question which according to Section 62, has to be considered by the Patents Section; this is in contradiction to the absolute terms of Section 61 as quoted in the main text. To some extent, the decision we are commenting on aligned itself with, without actually mentioning, the attitude expressed previously by the Supreme Court itself (Fourth Chamber) on January 21, 1970 (Ar. 1970, No. 195).

<sup>13</sup> Cf. the decisions of the Third Chamber of the Supreme Court of June 5 and 6, 1978 (Ar. 1978, Nos. 2159 and 2162), confirming those handed down by the Regional Courts of Barcelona and Madrid, respectively, and ultimately in line with constant judicial doctrine (see *Industrial Property*, 1971, p. 353).

<sup>14</sup> Decision of June 6, 1978, referred to in the preceding note.

<sup>15</sup> Decision of the Fourth Chamber of the Supreme Court of March 5, 1973 (Ar. 1973, No. 974). See *Industrial Property*, 1971, pp. 353 and 354.

<sup>16</sup> Decision of the Fourth Chamber of June 15, 1973 (Ar. 1973, No. 2869).

<sup>17</sup> Decision of the Fourth Chamber of the Supreme Court of April 24, 1971 (Ar. 1971, No. 2297).

<sup>18</sup> Decision referred to in the preceding note. Section 178 of the Law provides that "the following may be put forward as grounds for opposition and, consequently, may not be granted as utility models:

#### *Difference in Relation to Industrial Designs*

The Supreme Court has been consistent<sup>19</sup> in its contention that, while industrial designs protect the new form, not reflected in the result, effect, advantage or function of the article, it is a condition for utility models that both requirements, namely novelty of form and usefulness or value of result, be met.<sup>20</sup>

### Industrial Designs

#### Novelty

Although there are legal scholars<sup>21</sup> who are opposed to the interpretation according to which the utility model requires relative novelty and the industrial design absolute novelty,<sup>22</sup> the Supreme Court has ruled<sup>23</sup> that subject matter cannot be validly protected as an industrial design unless the conditions laid down in Section 49 of the Law are complied with, the essence of those conditions being that "for the purposes of this Decree-Law, what is not known or has not been carried out in Spain or abroad shall be considered new."<sup>24</sup> According to this interpretation then, the subject matter of an industrial design has to

... (3) those that have been produced in Spain or notoriously divulged prior to the date of the application." This requirement of wide knowledge contrasts with that derived from Section 180 for cases of nullity reserved to the courts according to which "utility models shall be regarded as null and void: (1) when the statement that the interested party has to make in the application for registration, to the effect that the subject matter is not known or used in Spain, is proved to be unfounded." It seems, therefore, that refusal of registration as a result of opposition should be pronounced only where there is proof of notorious divulgation, whereas nullity may be pronounced by judicial means where there is proof of mere knowledge of the subject matter.

<sup>19</sup> We have already mentioned this in *Industrial Property*, 1971, p. 353.

<sup>20</sup> Cf. the decision of the Third Chamber of January 27, 1975 (Ar. 1975, No. 283), citing those of June 24 and 26 and November 30, 1974, in its support.

<sup>21</sup> This subject was dealt with most recently by Otero Lastres, J.M.: "El requisito de la novedad de los dibujos y modelos industriales," *Actas de Derecho Industrial* 1, 1974, p. 115 et seq.; and "El modelo industrial," Madrid, 1977, especially p. 461 et seq.

<sup>22</sup> The difference may be seen in the fact that the Law refers repeatedly to the requirement of novelty in Spain with regard to utility models (Sections 174, 178(3) and 180(1)), and mentions only novelty with regard to industrial designs (Section 188(3)), without any qualification, so that it is interpreted in the general terms derived from Section 49 of the Law (cited below in the text).

<sup>23</sup> Decision of the Fourth Chamber of the Supreme Court of June 15, 1973 (Ar. 1973, No. 2869), which endorsed the important decision of the First (Civil) Chamber of the same Supreme Court of April 16, 1966 (Ar. 1966, No. 1778).

<sup>24</sup> This provision, although drafted in general terms ("for the purposes of this Law"), nevertheless appears in Chapter I ("Patents of Invention in General") of Title II ("Patents") of the Law, which is one of the weapons used by those who argue that it is not applicable to industrial designs.

have absolute novelty in order to secure valid protection.<sup>25</sup>

### Distinctive Signs

Although the majority of the disputes that go to court, and therefore jurisprudential criteria for general application in the interpretation of legal provisions, occur in the field of trademarks, many of the conclusions that can be drawn from analysis of the decisions handed down can be applied to distinctive signs in general.<sup>26</sup> This is why we are dealing with them under this heading.

### Subject Matter of Protection

Some indecision has been noted in the application of the *speciality principle*, according to which the protection afforded by the registration of a distinctive sign does not go beyond the industrial or commercial area in which the goods, services or activities identified by the sign in question are traded, and on account of which there is nothing to be gained by seeking to prevent the registration and use of a similar, or indeed identical, sign for subject matter of a completely different kind. Although this principle applies clearly and consistently in cases of mere similarity between the signs compared,<sup>27</sup> which similarity has to be assessed with greater strictness if the goods, services or activities for which the signs are used are the same,<sup>28</sup> such application is not as clear-cut where the signs are alleged to be identical or almost identical. While in certain cases it is considered that "two marks of the same denomination can co-exist peacefully when the products for which they are used are so different in nature and purpose as to preclude all possibility of doubt in the mind of the purchasing

public, owing to the fact that they belong to different commercial areas,"<sup>29</sup> there are others in which the prevailing criterion is just the opposite, because two identical signs cannot distinguish between themselves, and because confusion could arise between the goodwill associated with each.<sup>30</sup>

As far as we can see, however, the speciality principle is tending to become established, undoubtedly owing to the influence of the views of the more qualified legal writers, and notwithstanding the absolute terms of Section 150 of the Law.<sup>31</sup>

### Criteria for the Assessment of Similarity

Generally speaking, the traditional criteria continue to be applied: similarities have to be assessed by considering the distinctive signs as a whole, without isolating individual elements,<sup>32</sup> or the everyday appearance or sound of the signs has to be assessed, without any structural analysis.<sup>33</sup> Others are appearing, however, or existing ones are being strengthened, which, to our way of thinking, are more progressive and more in accord with the real nature of commercial transactions, dominated as they are by competitiveness and fluidity. Every day there are more cases of good faith being invoked as the principle that should preside over commercial relations and should prevent the registration of signs perilously similar to others that have priority over them;<sup>34</sup> this even includes the

<sup>25</sup> For more detailed coverage of this subject, see Elzaburu, A.: "Sobre la novedad requerida para el registro en España de objetos como dibujos y modelos industriales," *Revista Mexicana de la Propiedad Industrial y Artística (RMex PIA)* No. 21-22, January-December 1973, p. 163; *et seq.* and "La protection des dessins et modèles en Espagne" "Traité des dessins et des modèles" by P. and F. Greffe, Paris, 1974.

<sup>26</sup> Apart from marks, this typical condition of Spanish law applies also to trade names and business styles, which identify—according to the Law in general and its Section 214 in particular—goods or services, the trading enterprise and the place in which a business is carried on, respectively.

<sup>27</sup> According to the decision of the Third Chamber of the Supreme Court of October 5, 1978 (*Ar.* 1978, No. 3052), which is in line with what has already been stated in many others, "only between similar goods may there be any hypothesis of confusion or doubt, and not when the goods are clearly distinguishable, which is why the legal doctrine is that, for refusal, the mere similarity between the words constituting the marks is not sufficient if the goods to which they are to be applied are different and also easy to differentiate from those covered by marks that have priority."

<sup>28</sup> *Cf.*, *inter alia*, the recent decision of the Third Chamber of the Supreme Court of October 10, 1978 (*Ar.* 1978, No. 3062).

<sup>29</sup> Decision of the First (Civil) Chamber of the Supreme Court of November 24, 1978 (*Ar.* 1978, No. 4172), which cites those of September 25 and October 24, 1970, April 15 and November 17, 1971, October 11, 1972, April 5 and May 23, 1973, November 12 and 28, 1974, and February 14, March 25 and May 21, 1977; and which supports that of the Third Chamber of the same Supreme Court of March 6, 1976 (*Ar.* 1976, No. 1388), where the fact of phonetic identity was not sufficient to prevent the protection of the legal sign, in spite of the fact that in the case at issue the prior sign was very well known, because it was well known precisely in a field different from that in which the new one was destined to be used.

<sup>30</sup> *Cf.*, *inter alia*, the decision of the Third Chamber of the Supreme Court of November 27, 1978 (*Ar.* 1978, No. 3826).

<sup>31</sup> This provision lends effectiveness to the authorization for the registration of a mark (and, by extension, any other distinctive sign) given by the owner of another considerably similar, priority mark, adding however that, "if the question were one of identicalness, ... the authorization would not be effective." We refer again to this subject below.

<sup>32</sup> *Cf.* the decisions of the Third Chamber of the Supreme Court of April 27, October 10 and November 27 and 30, 1978 (*Ar.* 1978, Nos. 2864, 3062, 3825 and 4076), and of the First (Civil) Chamber of November 24 of the same year (*ibid.*, No. 4172).

<sup>33</sup> The most recent examples of this reasoning are the decisions of the Third Chamber of the Supreme Court of April 27 and November 30, 1978, cited in the preceding note, and that of May 29 of the same year (*Ar.* 1978, No. 2675), or that—also cited in the preceding note—of the First Chamber of November 24, 1978.

<sup>34</sup> *Cf.* the decision of the Fourth Chamber of the Supreme Court of July 6, 1971 (*Ar.* 1971, No. 3925), according to which one of the effects of registration of a mark is "that no person who is not the owner of the mark granted may take advantage of the benefits associated with use of that mark, and that therefore the owner has the right, derived from such ownership, to prevent other persons

highest level of good faith, the Roman *uberrima fides*.<sup>35</sup>

#### *Value of Earlier Registrations by the Same Owner*

Basically the same value is still recognized,<sup>36</sup> so that it may be said in general that a sign for which registration has been obtained in the intervening period—between two registrations effected by the same owner—“cannot now be invoked against the registered owner of the distinctive sign that has priority,”<sup>37</sup> so that the existence of the latter is the determining factor for the grant of registration of the new sign, notwithstanding any opposition based on the former.<sup>38</sup>

Nevertheless, and inasmuch as the Supreme Court is not tied down by administrative precedents that have not been submitted to it and may owe their origins to errors made by examiners,<sup>39</sup> one cannot assume in every case that an earlier sign gives its owner the right to register another later one for different products, thereby enlarging the market area of the earlier sign, because in such a situation opposition based on another intermediate sign might have to be taken into consideration.<sup>40</sup>

who might be using a denomination similar to that of his mark from securing registration for the new mark at the Registry by way of a subtle phonetic or graphic differentiation, which would result in the latter being able to use the registration as a means of obtaining those benefits in prejudice of the rights and at the cost of the owner of the first mark, which would be contrary not only to the purposes of protection and the guarantees inherent in registration, but also to the fundamental principle of trade law *verdad sabida y buena fe guardada* (knowledge of the truth ensures good faith).”

<sup>35</sup> Reference taken from the decision of the Third Chamber of the Supreme Court of January 28, 1976 (*Ar.* 1976, No. 961), for which “the fundamental guiding principle underlying the legislation on the Industrial Property Registry, intimately involved as it is with commercial transactions, is good faith; and if good faith is inherent in every manifestation of social life . . . which is reflected in the rapid and continuous flow of commercial transactions, good faith is sublimated, in other words it is required to a superlative degree, and a positive exquisiteness of behavior, an *uberrima fides* is created . . .”

<sup>36</sup> See *Industrial Property*, 1971, p. 354.

<sup>37</sup> Decision of the Third Chamber of the Supreme Court of April 29, 1975 (*Ar.* 1975, No. 1908). Cf. also the decisions of the same Chamber of March 6 and 25, 1976 (*Ar.* 1976, Nos. 1212 and 1467).

<sup>38</sup> Decisions of the Third Chamber of the Supreme Court of June 27, 1978 (*Ar.* 1978, No. 2211). According to the same argument, with respect to derived marks, the distinctive sign that constitutes the principal mark is not open to attack; the only thing that can be attacked in an application for the registration of a derived mark is the complementary element or elements of the design (Decision of the Fourth Chamber of the Supreme Court of March 5, 1973, *Ar.* 1973, No. 1013).

<sup>39</sup> Decision of the Third Chamber of the Supreme Court of March 11, 1976 (*Ar.* 1976, No. 1401).

<sup>40</sup> Decisions of the Fourth Chamber of the Supreme Court of May 29, 1973 (*Ar.* 1973, No. 2192) and of the Third Chamber of March 11, 1976, cited in the preceding note. The correction to the general principle which this ruling makes is no more than a consequence of the principle of speciality commented on above.

## Marks

### *Foreign Word Forms*

Although the criterion according to which such word forms are to be treated as fanciful is still considered generally applicable,<sup>41</sup> some adjustments have been made to it. For instance, a decision of the Supreme Court (Third Chamber) of March 11, 1976,<sup>42</sup> confirmed the refusal of an application for registration of the mark “Babyfood” on the grounds that it constituted a generic term in English and that therefore, “if it were registered, it would prevent any food product imported from an English-language country from indicating its nature in that language.”

### *Authorization for Registration*

Correctly interpreting the second paragraph of Section 150 of the Law,<sup>43</sup> the Supreme Court has repeatedly emphasized that, in the same way as one should not attribute any validity to the authorization to register a mark given by the owner of another priority mark when both marks are identical—even where the products for which they are to be used are different<sup>44</sup>—the opposite occurs where the marks are merely similar.<sup>45</sup>

On the other hand, a too-strict interpretation of whether or not the submission of a declaration of consent in a contentious-administrative proceeding is effective<sup>46</sup> has been relaxed somewhat, inasmuch as a document of this kind is considered effective if it is submitted “within the period of contentious appeal advocated by the doctrine . . . according to which, in such cases, the court can and must take due account of a change of circumstances that can be regarded as corresponding to a hypothesis provided for by the legislator.”<sup>47</sup> The purpose of this was certainly more

<sup>41</sup> See *Industrial Property*, 1971, p. 354.

<sup>42</sup> *Ar.* 1976, No. 1399.

<sup>43</sup> According to this provision, notification of the pronouncement of suspension of the processing of the application for registration of a mark has to take place in the form legally provided for in order that, within the time limit set, “the petitioner may bring forward the reasons that he considers relevant to his right, modify the mark or present the authorization of the original owner that allows the registration applied for. If the case were one of identical marks, the mark could not be modified neither could the authorization be effective.”

<sup>44</sup> Decision of the Third Chamber of June 13, 1978 (*Ar.* 1978, No. 2179). This way of thinking is not universal and therefore presupposes the separation of the principle of speciality of the distinctive sign (see above).

<sup>45</sup> Decisions of the Third Chamber of the Supreme Court of February 18, 1976 (*Ar.* 1976, No. 397), and November 24, 1978 (*Ar.* 1978, No. 3722).

<sup>46</sup> See the decisions of November 17 and 21, 1970, referred to in *Industrial Property*, 1971, p. 354.

<sup>47</sup> Decision of the Third Chamber of the Supreme Court of February 18, 1976 (*Ar.* 1976, No. 397).

to comply with equity and justice than to respect the letter of the law, which limits the action of the contentious-administrative jurisdiction to a task purely of verification of the legality of administrative measures.

### *Value of Lapsed Registrations*

Jurisprudence still exists<sup>48</sup> to the effect that the registration of a mark that has lapsed for want of renewal or for want of timely payment of the fees for its maintenance in force continues to be an obstacle to the subsequent registration of another potentially confusing mark during the time<sup>49</sup> that rights of reinstatement still exist in favor of the owner.<sup>50</sup>

### *Invalidation of Registration*

This is perhaps the one issue that has been the subject of the most controversy in Spanish trademark law,<sup>51</sup> the most varied and conflicting jurisprudential and doctrinal interpretations<sup>52</sup> and that has caused the most difficulty with regard to the organization of the different criteria and solutions available. The problem stems from differing interpretations of Section 14 of the Law<sup>53</sup> and therefore, if one disregards the con-

tinuing lack of any uniform criteria, a solution could perhaps be found by reference to the following conclusions or principles:

(a) registration does not constitute ownership of a mark; it is merely declaratory;<sup>54</sup>

(b) the unregistered use of a mark gives its owner the right to cause the invalidation of a third party's subsequent registration of the same mark or of another confusingly similar to it;<sup>55</sup> the period for bringing the invalidation action under these circumstances would be three years,<sup>56</sup> as laid down in Section 14 of the Law, because what that provision in fact regulates is the consolidation of dominion over a mark in the face of potential owners of unregistered rights in it;<sup>57</sup>

(c) Section 14 of the Law is not applicable to cases of double registration<sup>58</sup> of the same mark—or of two marks confusingly similar to each other—in the name of different owners; in such cases we have to consider that there is a presumption of absolute or radical nullity<sup>59</sup> inasmuch as there is no possibility of differentiating between the two marks concerned, which therefore lose their character as distinctive signs for the goods or services of one enterprise in relation to those of another,<sup>60</sup> or a presumption of mere liability to invalidation, which can be claimed within the prescription period of 15 years provided for in the Civil Code as being applicable to personal actions that are not subject to any other fixed time limit;<sup>61</sup>

<sup>48</sup> See *Industrial Property*, 1971, p. 354.

<sup>49</sup> Three years as from publication of the declaration of lapse in the Official Bulletin of Industrial Property (Section 160 of the Law).

<sup>50</sup> Of all those that have been handed down on this subject, we would mention the recent decision of the Third Chamber of the Supreme Court of October 5, 1978 (*Ar.* 1978, No. 3052).

<sup>51</sup> This subject has been discussed for a number of years within IAPIP, with the participation of the most highly qualified experts of various countries. It resulted in an important resolution adopted by the Venice Congress, held from June 8 to 14, 1969; see *Annuaire de l'AIPPI*, 1969/II, p. 224, and, for previous discussions and developments, *les Annales de l'AIPPI*, 1961, Part 2, pp. 117 *et seq.* and 131; 1962, Part 1, pp. 13 *et seq.* and Part 2, pp. 43 *et seq.*; 1963, Part 1, pp. 83 and 96, and Part 2, p. 39 *et seq.*; 1964/I, p. 13 *et seq.*; 1964/II, pp. 80 *et seq.*, 119 *et seq.*, and 129 *et seq.*; 1965/II, pp. 29 *et seq.*; 1966/I, pp. 43 *et seq.*; 1966/II, pp. 18 *et seq.*, and pp. 43 *et seq.*; 1967/II, pp. 13 *et seq.* (With a report concerning Spain, pp. 25 to 38); 1967/III, pp. 79 *et seq.*, 123 *et seq.*, and 135; 1968, pp. 131 *et seq.* (with another report on Spain, pp. 143 to 145); 1969/I, pp. 25 *et seq.* and 1969/II, pp. 200 *et seq.*, and 222 *et seq.*

<sup>52</sup> The following have dealt with this subject: Banus Durán, J., "Los signos distintivos en Propiedad Industrial. Modos de adquirir su propiedad. Acciones de nulidad y acciones reivindicatorias. Jurisdicciones competentes," *I Cursillo sobre Propiedad Industrial* (Spanish group of IAPIP), October-December 1966, pp. 23 *et seq.*; Botana Agra, M., "En torno a la consolidación de la marca registrada," *Actas de Derecho Industrial (ADI)*, volume III (1976), pp. 323 *et seq.*; Fernández-Novoa, C., "El nacimiento del derecho sobre la marca," *Revista de Derecho Mercantil (RDM)*, October-December 1966, pp. 187 *et seq.*; Pedemonte Feu, J., "Prescripción de las acciones de impugnación de una marca," *Estudios e Informes sobre Propiedad Industrial* (Spanish group of IAPIP), Barcelona 1977, pp. 285 *et seq.*; del Valle Sanchez, J., "Comentarios al artículo 14 del Estatuto sobre Propiedad Industrial," *Estudios cit.*, pp. 299 *et seq.*

<sup>53</sup> Section 14(1) of the Law is as follows: "The certificate of grant of registration of a mark and the trade name shall constitute a presumption *iuris tantum* of ownership. The dominion over the mark shall be confirmed three years after registration has been effected, during which time there shall have been uninterrupted working or undisturbed, fair possession in good faith."

<sup>54</sup> This is the wording of the decisions of the First Chamber of the Supreme Court of November 25, 1975 (*Ar.* 1975, No. 4236), and May 11, 1977 (*Ar.* 1977, No. 2046).

<sup>55</sup> Decisions of the First Chamber of the Supreme Court of October 24, 1972 (*Ar.* 1972, No. 3076), May 11, 1977 (cited in the preceding note), and December 16, 1978 (*Ar.* 1978, No. 3636), the latter referring to a trade name.

<sup>56</sup> It should be borne in mind that this period has to be considered extended to five years in the case referred to in Article 6bis of the Paris Convention. This was the understanding in the decision of the First Chamber of the Supreme Court of March 3, 1978 (*Ar.* 1978, No. 762), although, in our opinion, it committed the error of considering the principle and the period to be applicable to a confrontation between registered and unregistered rights in a mark, without making the action contingent on the notoriety of the mark, which is after all the basic condition for the application of the Section in question.

<sup>57</sup> See the decisions of the First Chamber of the Supreme Court of June 26 and November 25, 1975 (*Ar.* 1975, Nos. 3353 and 4236), and May 11, 1977 (*Ar.* 1977, No. 2046).

<sup>58</sup> This is the expression used in the three decisions cited in the preceding note.

<sup>59</sup> As in the case of the registration of the mark which has been granted in violation of an absolute prohibition on registration, for instance that of Section 124(5) of the Law (prohibition on registration of generic denominations); see the decision of the First Chamber of the Supreme Court of June 1, 1971 (*Ar.* 1971, No. 3092). In such cases an invalidation action has been considered inprescriptible: see the decision of the same Court of February 18, 1977 (*Ar.* 1977, No. 504).

<sup>60</sup> These are the terms used in the decision of November 25, 1975, cited in footnote 57, above.

<sup>61</sup> See, *inter alia*, the decision of the First Chamber of the Supreme Court of May 20, 1975 (*Ar.* 1975, No. 2190) (see also that of May 11, 1977, cited in footnote 54, above, which refers indirectly to the period in question).

(d) in any event it is clear that, once administrative validity has been established for the registration of a mark, the hearing of actions for the invalidation of that registration is governed by ordinary civil jurisdiction.<sup>62</sup>

### Trade Names

#### Article 8 of the Paris Convention

As we well know, the protection of the trade names of persons not domiciled in Spain rests on Article 8<sup>63</sup>—inasmuch as the persons concerned are nationals (or assimilated to nationals) of countries party to the Convention—because Section 203 of the Law denies them the possibility of registration.<sup>64</sup>

The courts continue to interpret Article 8 in the already familiar way<sup>65</sup> according to which nationals of countries of the Union can invoke trade names in Spain mainly in order to oppose the use or registration by a third party of a confusingly similar name—whether as a trade name or as a mark or business style—or in order to seek the invalidation of conflicting registrations.<sup>66</sup> In the same way, it is still a valid argument that the right derived from Article 8 of the Convention cannot extend to the claim of registration as a mark of the name that constitutes the trade name<sup>67</sup> when that claim interferes with prior rights.

Of course, according to this interpretation, Article 8 of the Paris Convention also authorizes nationals (or persons assimilated to nationals) of countries of the Union to use their trade names as trade names in Spain, that is, as elements identifying their enterprises, and not as signs identifying goods, as the latter would constitute use as a mark.

### Violation of Industrial Property Rights and Unlawful Competition

It should be mentioned as a general point that the violation of industrial property rights comes under

<sup>62</sup> See the decisions of the First Chamber of the Supreme Court of May 7, 1973 (*Ar.* 1973, No. 2007), and May 20, 1975 (cited in the preceding note).

<sup>63</sup> On this subject see Fernández-Novoa, C., "En torno a la aplicación del art. 8º CUP por la jurisprudencia española," in *ADI I* (1974), pp. 301 et seq.

<sup>64</sup> According to its first paragraph, "trade names may only be registered by Spanish nationals or foreigners established in Spain." There is a complementary provision in Section 197, according to which "trade names shall be registered for the whole of Spain, ... without prejudice to the provisions of Article 8 of the 1883 Paris Convention."

<sup>65</sup> See *Industrial Property*, 1971, pp. 354 and 355.

<sup>66</sup> This is what the Third Chamber of the Supreme Court did, for instance, in its decision of December 9, 1976 (*Ar.* 1976, No. 5770), or the First Chamber in that of March 3, 1978 (cited above in footnote 56).

<sup>67</sup> See, *inter alia*, the decisions of the Third Chamber of the Supreme Court of March 2, 1974 (*Ar.* 1974, No. 1274), May 16, 1975 (*Ar.* 1975, No. 2039), and March 3, 1977 (*Ar.* 1977, No. 865).

Section 534 of the Criminal Code,<sup>68</sup> the provisions of which have been repeatedly described in the decisions of the Second Chamber of the Supreme Court<sup>69</sup> as being "blank" provisions which have to be completed with the definitions of the types of offenses that appear in the Industrial Property Law of May 16, 1902,<sup>70</sup> which regulates unlawful competition<sup>71</sup> and the infringement and unlawful appropriation of industrial property.<sup>72</sup>

Moreover, for there to be an offense it is necessary that, in addition to the unlawful act defined as such—infringement, unlawful appropriation, imitation—there be intention<sup>73</sup> or deliberate ill-will,<sup>74</sup> in other words criminal premeditation, which, when the facts are covered by a Section of the Criminal Code, is presumed, and it is for the defendant to prove that his conduct had no deliberate character.<sup>75</sup> Premeditation can be declared not to exist even where there is evidence that the person who committed the acts had knowledge of the third-party right if it is believed in good faith that another older or priority right is owned.<sup>76</sup>

With regard to the *infringement of patents*, it has already been mentioned that this does not require the subject matter of the infringed patent and that of the

<sup>68</sup> See above. This Section of the Criminal Code provides the following: "Any person who intentionally infringes the rights of authors shall be punished by the penalties of major imprisonment and a fine of 20,000 to 400,000 pesetas, independently of the sanctions provided for in the special laws. The same penalty shall be applied to persons who in the same way infringe industrial property rights. Second offenses shall in both cases be punished by a penalty of minor imprisonment" (the penalty of *arresto mayor* entails privation of liberty for a month and a day to six months, and that of *prisión menor* six months and a day to six years—Section 30 of the Criminal Code).

<sup>69</sup> *Cf.*, *inter alia*, the decisions of May 4, 1974 (*Ar.* 1974, No. 2082), and February 16, 1976 (*Ar.* 1976, No. 777).

<sup>70</sup> Although this is the subject of a derogation in transitional provision 6 of the Royal Decree-Law of July 26, 1929, the immediate predecessor of the current Law—revised text of April 30, 1930—it was nevertheless declared in force with respect to its criminal provisions—in simultaneous express derogation of Sections 233 to 243 of the Industrial Property Law—by the Decree of May 22, 1931, made law by the Law of the following September 16.

<sup>71</sup> Title X, Sections 131 and 132.

<sup>72</sup> Title XI, Sections 133 to 144.

<sup>73</sup> Decision of the Second Chamber of the Supreme Court of November 29, 1978 (*Ar.* 1978, No. 3837).

<sup>74</sup> Decisions of the same Second Chamber of the Supreme Court of May 4 and November 18, 1974 (*Ar.* 1974, Nos. 2082 and 4348), and June 13, 1977 (*Ar.* 1977, No. 2734). Unless otherwise stated, the quotations in this part of the text all refer to decisions of the Second (Criminal) Chamber of the Supreme Court.

<sup>75</sup> Decision of March 21, 1977 (*Ar.* 1977, No. 1135).

<sup>76</sup> Decision of June 13, 1977, cited in footnote 74, above. Of course, according to this decision and another of May 8, 1973 (*Ar.* 1973, No. 2403), there may not, for want of premeditation, be an actual offense, but there may nevertheless be a prejudicial illicit act of another kind which is punishable by non-criminal means. In any event, in order to remove any validity from the claim of ignorance of the rights infringed, it is generally advisable to start proceedings with an extrajudicial request to the infringer, as already recommended in *Industrial Property*, 1971, p. 355.

activity constituting the infringement to be identical,<sup>77</sup> although it may in no case be claimed that the law protects the technical principles or purpose of a patent, that which it covers being the concrete application of the principles.<sup>78</sup>

With regard to the *violation of trademark rights*, the decision of May 18, 1976,<sup>79</sup> systematized the three types of offenses contemplated by our legal system in relation to distinctive signs, which is a field in which the legal institution protected is expressly stated as being "exclusive use." In concrete terms, the decision defined the three types of offenses—infringement, unlawful appropriation and imitation—as being graduated in decreasing order of seriousness, and being characterized, respectively, by the "reproduction of the sign constituting the mark applied to the product it distinguishes in such a way that it passes for authentic"; by the use of signs constituting the authentic mark "accompanied by secondary or complementary elements (legends, labels, wrappers, etc.) which are not part of the actual reproduction"; and by the use, without reproduction, of "a mark which confuses by its similarity to the lawfully registered mark."

In the same decision of May 18, 1976, it was stated that there was no need to establish proof of prejudice<sup>80</sup> suffered by the plaintiff for the offense to be regarded as effectively existing. This view was taken because it had been declared proved that the defendant had placed an aerated wine on the market with a mark similar to the plaintiff's and in a bottle similar to his bottle, using labels and collars of very similar color and design, all of which gave rise to an "imitation or copy capable of misleading the consumer with respect to the goods covered by the legitimate mark."

Another decision that deserves mention is that of May 14, 1976,<sup>81</sup> which upheld the lower court's condemnation of an act of trademark infringement involving the defendant's replacement of original eau-de-cologne with another, using that other to fill the bottles of the plaintiff, thereby "consciously and fraudulently reproducing the mark of a third party by affixing it to a product different from that party's product, the identity of which it was intended to guarantee." This decision, apart from declaring irrelevant the question of whether the cologne with which the defendant filled the original bottles was of superior or inferior quality, also ruled that Sections 131 and 132 of the Industrial Property Law of May 16, 1902, which deal with unlawful competition, "are carefully considered, and contemplate only hypothe-

tical disputes between traders where one of them tries to take undue advantage of the industrial or commercial reputation obtained through the efforts of the other, whose property is protected by law and recorded at the Registry, punishing those who disloyally and unlawfully infringe the rules of the game, which have to be applied in accordance with trading customs and practices and the appropriate professional rectitude, by committing acts that are liable and indeed intended to prejudice a person operating a competing enterprise, and by thus endeavoring to divert his clientele." It added that the difference between this hypothesis and that of unlawful imitation, which was the one being judged, is that infringement does not presuppose evidence of a different product, but merely the "intention to achieve personal gain at the expense of the prestige" of the mark infringed.

Comparable cases involving the filling of containers were considered and ruled on in decisions dated January 17, 1972,<sup>82</sup> and March 21, 1977.<sup>83</sup> In the second of these, the description of acts as a culpable offense due to negligence, made by the Provincial Court, was corrected in the face of proof that the defendant had been filling the bottles of the third party and closing them with a stopper bearing his own mark. On considering the appeal presented by the prosecutor, the Supreme Court changed the description of the offense and condemned the defendant for having committed a premeditated infringement, considering his presumed intention and deliberate ill-will to be in no way diminished by the fact that, in any case, "as the mark of the third party was clear and visible" on the bottles filled, "there was a risk, which was undoubtedly present (in the mind of the offender), of misleading buyers, and this is precisely what constitutes premeditated fraud, which is a criminal offense contrary to and punished by Sections 131, 132(b) and 138 of the Industrial Property Law, to which the 'blank' provision in Section 534 of the Criminal Code refers."

In conclusion, it should be mentioned that, in principle, for criminal illegality to exist, in other words for there to be an offense, it is necessary that the right violated or infringed be registered,<sup>84</sup> because otherwise the only course of action available against the infringer would be bringing the civil action against illicit acts of this kind provided for in Section 1902 of the Civil Code.<sup>85</sup>

<sup>77</sup> Decision of June 24, 1971 (*Ar.* 1971, No. 3019).

<sup>78</sup> Decision of May 4, 1974, cited in footnote 74, above.

<sup>79</sup> *Ar.* 1976, No. 2272.

<sup>80</sup> Previously the decision of April 24, 1972 (*Ar.* 1972, No. 1800), had stated that, although there was no prejudice, there might be appropriation of the mark, as the mere thought of damaging third-party rights was sufficient.

<sup>81</sup> *Ar.* 1976, No. 2229.

<sup>82</sup> *Ar.* 1972, No. 206.

<sup>83</sup> *Ar.* 1977, No. 1135.

<sup>84</sup> See, for instance, the decisions of May 4 and November 18, 1974, cited in footnote 74, above.

<sup>85</sup> This Section regulates the obligation to indemnify in cases of culpable injury—the "Aquilian fault" of the Roman *Lex Aquilia*. It is worded as follows: "Any person who by action or omission causes injury to another person, through fault or negligence, is obliged to give redress for the injury caused."

## News Items

### UNITED STATES OF AMERICA

#### *Commissioner of Patents and Trademarks*

We have been informed that Mr. Sidney A. Diamond has been appointed Commissioner of Patents and Trademarks.

## Book Reviews

**Forms and Agreements on Intellectual Property and International Licensing** (3rd ed.), by L.W. Melville. Sweet & Maxwell and Clark Boardman, London and New York, 1979. — looseleaf binder.

The first edition of Melville appeared in the mid-1960s, the second edition in 1972 and this, the third edition, early in 1979. It says much for the esteem in which Melville is held by his readers that his work has required three editions in less than 15 years. It is also a reflection of the changes which have occurred in licensing law during the same period.

There is a significant change in the title. The "Precedents on Intellectual Property" of the second edition has now become the "Forms and Agreements on Intellectual Property" of the third edition. This change is due partly to the wish of the author and the publishers—one on each side of the Atlantic—to make the book more attractive to American readers. It is also an indication of the internationalization of licensing law during the last ten years, that is, the growing interaction between different legal systems. It is today just as important for the American practitioner to know about the effect of the law of the European Communities on licensing intellectual property rights as it is for the European practitioner to know about the effect of American antitrust law. In any case the enterprise of the author as well as the two publishers is to be commended in producing a book aimed at readers on both sides of the Atlantic.

The third edition contains much new material in comparison with the second edition of 1972. The 1972 edition ran to 360 pages of text, the 1979 edition has more than 600 pages. Admittedly the third edition has been set in a larger type with a more generous page layout. These changes mean that the book is much easier to read. The new material is apparent from the chapter headings. There are entirely new chapters on

- marketing
  - arbitration
  - taxation of intellectual property
  - intangible property generally
- in addition to the chapters which appeared in the second edition on
- know-how
  - patents
  - copyright; fine arts & applied art
  - trademarks and goodwill
  - quality certification
  - contractual and other terms.

The treatment of the subject matter remains the same; each main chapter comprises a general introduction and commentary followed by a comprehensive collection of specimen clauses. The chapter on patents, for instance, contains 19 pages of commentary and 85 pages of precedents. A similar pattern is found in the other main chapters.

The most important part of such a book for the user is the explanation and commentary. It is rarely possible in practice to adopt the specimen clauses verbatim; they nearly always need to be adapted. This process of adaptation can only properly be carried out if the principle is clearly understood: this understanding can be given only by the explanation and commentary.

In conclusion, the appearance of Melville's third edition confirms and strengthens his position as an authority on the licensing of intellectual property. His attempt to draw together the various strands of American, European Community and English law on the subject and make it into a coherent whole is to be commended.

The publication of the third edition of Melville is welcome for another reason; it serves to emphasize the importance of a subject that has long been neglected. Figures published by the Deutsche Bundesbank in August 1978 (*Statistische Beihefte zu den Monatsberichten der Deutschen Bundesbank. Reihe 3, Zahlungsbilanzstatistik, Nr. 8, August 1978*) are a reminder of the economic importance of licensing intellectual property rights. The total payments made and received during 1975 by eleven industrialized countries (Belgium/Luxembourg, France, Italy, Netherlands, Austria, Sweden, Japan, United Kingdom, United States of America, Switzerland and Federal Republic of Germany) in respect of licensing intellectual property rights amounted to DM 30,808 million.

B.I. CAWTHRA

**Les marques collectives**, published by the Centre Paul Roubier. Librairies techniques, Lyons, 1979. — 136 p.

This work reproduces the proceedings of the various conferences and follow-up discussions which took place during the seminar (*Journée d'étude*) on collective marks organized in January 1979, under the sponsorship of Professors Chavanne and Azéma, by the Centre Paul Roubier at Lyons.

The discussions during the seminar dealt with collective marks in French law, pursuant to the Trademark Law of 1964 and the most recent case law. Reports, which dealt with the nature of collective

marks in French law and, more particularly, with the question of determining whether such a mark has an optional (i.e., there is a choice between the adoption of a collective or an individual mark) or compulsory (i.e., only legal entities are authorized to file collective marks) nature, were presented by Mrs. J. Boucourechliev and Professors Chavanne, Burst and Mathély. The administration's point of view was then detailed by Mrs. Hiance and that of trademark applicants by Mr. Thrierr. The work concludes with an explanation by Professor Françon on collective marks in Law No. 78-23 of January 10, 1978, and by a summation of the proceedings by Mr. Corre.

This work should be of interest to all theoreticians and practitioners of French trademark law.

GRW

#### Selection of New Publications

- ALLEN (T.J.). *Managing the Flow of Technology*. The MIT Press, Cambridge, Mass., 1977. — 320 p.
- ASSANTI (A.M.). *Le licenze obbligatorie*. A. Giuffrè, Milano, 1978. — 146 p.
- BAUMANN (D.). *Droit de la consommation*. Librairies techniques, Paris, 1977. — 210 p.
- Brevets et échanges technologiques — Situation de la France*. La documentation française, Paris, 1979. — 199 p.
- DELEUZE (J.M.). *Le contrat de transfert de processus technologiques (know-how)*. Masson, Paris, 1979. — 246 p.
- Inventors' Certificates as a Form of Legal Protection of Inventions*. State Committee of the USSR for Inventions and Discoveries, Moscow, 1978. — 77 p.
- KRAMER (E.A.), MAYRHOFER (H.), etc. *Konsumentenschutz im Privat- und Wirtschaftsrecht*. Manz, Wien, 1977. — 190 p.
- KUKIMOTO (A.). *Japanese Patent and Trademark Law — A Critical Analysis of Recent Revisions*. INSIDE R. & D. and Technical Insights, Fort Lee, N.J., 1978. — 184 p.
- LIEDEL (D.). *Das deutsche Patentnichtigkeitsverfahren*. Carl Heymann, Köln (etc.), 1979. — 323 p.
- MODIANO (G.). *Le contrat de licence de brevet*. Librairie Droz, Genève & Paris, 1979. — 319 p.
- Protecting and Profiting from Trade Secrets, 1979*. R.M. Milgrim, Chairman. Practising Law Institute, New York, 1979. — 472 p.
- REBOULY (Y.). *Les contrats de recherche*. Librairies techniques, Paris, 1978. — 324 p.
- ROBBINS (F.E.). *The Defense of Prior Invention — Patent Infringement Litigation*. Practising Law Institute, New York, 1977. — 277 p.
- SCHULTE (R.). *Patentrecht*. Carl Heymann, Köln (etc.), 1978. — 166 p.
- SORDELLI (L.). *Marchio e "Secondary Meaning"*. A. Giuffrè, Milano, 1978. — 183 p.
- UEXKÜLL (J.-D., Frbr. von). *German Laws Relating to Patents, Utility Models and Trademarks and to Inventions of Employees* (3rd ed.). Carl Heymann, Köln (etc.), 1978. — 157 p.
- WINKEL (F.N.). *Formalschutz dreidimensionaler Marken*. Carl Heymann, Köln (etc.), 1979. — 311 p.

## Calendar

### WIPO Meetings

(Not all WIPO meetings are listed. Dates are subject to possible change.)

#### 1980

- February 4 to March 4 (Geneva) — Revision of the Paris Convention — Diplomatic Conference
- March 17 to 21 (Geneva) — Nice Union — Preparatory Working Group
- March 17 to 28 (Geneva) — International Patent Cooperation (PCT) Union — PCT Budget Consultants Meeting
- April 28 to 30 (Geneva) — Permanent Committee for Development Cooperation Related to Industrial Property
- June 9 to 16 (Geneva) — International Patent Cooperation (PCT) Union — Assembly (Extraordinary Session)
- June 13 to 19 (Geneva) — Budapest Union (Microorganisms) — Interim Committee (or Assembly)
- June 23 to 27 (Geneva) — Permanent Committee for Patent Information (PCPI) — Working Group on Search Information
- September 8 to 12 (Geneva) — Permanent Committee on Patent Information (PCPI) — Working Group on Planning
- September 22 to 26 (Geneva) — Governing Bodies (WIPO Coordination Committee; Executive Committees of the Paris and Berne Unions; Assembly of the International Patent Cooperation (PCT) Union)
- October 14 to 17 (Geneva) — Permanent Committee on Patent Information (PCPI) — Working Group on Patent Information for Developing Countries
- October 20 to 24 (Geneva) — Permanent Committee on Patent Information (PCPI)
- December 15 to 19 (Paris) — Berne Union and Universal Copyright Convention — Committee of Governmental Experts on Problems Arising from the Use of Computers (convened jointly with Unesco)

## UPOV Meetings

1980

March 18 and 19 (Geneva) — Technical Committee  
April 14 and 15 (Geneva) — Subgroups of the Administrative and Legal Committee  
April 16 (Geneva) — Consultative Committee  
April 17 and 18 (Geneva) — Administrative and Legal Committee  
April 27 to May 11 (Nelspruit) — Technical Working Party for Fruit Crops  
May 12 to 14 (Wageningen) — Technical Working Party for Agricultural Crops  
June 23 to 25 (Geneva) — Subgroups of the Administrative and Legal Committee  
August 26 to 28 (Hanover) — Technical Working Party for Forest Trees  
September 16 to 18 (Lund) — Technical Working Party for Ornamental Plants  
September 23 to 25 (Lund) — Technical Working Party for Vegetables  
October 14 (Geneva) — Consultative Committee  
October 15 to 17 (Geneva) — Council  
November 10 to 12 (Geneva) — Technical Committee  
November 13 and 14 (Geneva) — Administrative and Legal Committee

## Meetings of Other International Organizations Concerned with Industrial Property

1980

**European Patent Organisation:**

*Administrative Council:* June 2 to 6, December 8 to 12 (Munich)

*Inauguration of the New Building and Administrative Council (Special Session):* September 18 and 19 (Munich)

**International Association for the Protection of Industrial Property:** November 16 to 21 (Buenos Aires) — 31st Congress

**Licensing Executives Society:** April 28 to 30 (Geneva) — International Conference on Licensing and the International Economic Order, Product and Process Liability and New Trends in Technology Transfer



