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Contents

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Activities of the International Bureau

The World Intellectual Property Organization in 1984*

Industrial Property and Patent Information Activities

I. Revision of the Paris Convention for the Protection of Industrial Property

Objective

The objective is to revise the Paris Convention for the Protection of Industrial Property in order to introduce in it new provisions and to change certain existing provisions to meet better the needs of developing countries. Furthermore, the revision should introduce new provisions giving full recognition to "inventors' certificates," a form of protection of inventions existing in several socialist countries.

Activities

The fourth session of the Diplomatic Conference on the Revision of the Paris Convention for the Protection of Industrial Property took place in Geneva from February 27 to March 23, 1984.

The said session was attended by 364 persons. Altogether, 92 countries were represented.

Among the 93 countries members of the Paris Union the following 69 were represented: Algeria, Argentina, Australia, Austria, Belgium, Brazil, Bulgaria, Cameroon, Canada, Central African Republic, Congo, Cuba, Czechoslovakia, Denmark, Dominican Republic, Egypt, Finland, France, Gabon, German Democratic Republic, Germany (Federal Republic of), Ghana, Greece, Holy See, Hungary, Indonesia, Iran (Islamic Republic of), Iraq, Ireland, Israel, Italy, Ivory Coast, Japan, Lebanon, Libya, Liechtenstein, Luxembourg, Madagascar, Mexico, Monaco, Morocco, Netherlands, New Zealand, Nigeria, Norway, Philippines, Poland, Portugal, Republic of Korea, Romania, Senegal, Soviet Union, Spain, Sri Lanka, Sudan, Sweden, Switzerland, Syria, Trinidad and Tobago, Tunisia, Turkey, Uganda, United Kingdom, United Republic of Tanzania, United States of America, Uruguay, Viet Nam, Yugoslavia, Zaire.

The following countries represented were not members of the Paris Union but were members of WIPO: Byelorussian SSR, Chile, China,[1] Colombia, El Salvador, Guatemala, Honduras, India, Jamaica, Mongolia, Pakistan, Panama, Peru, Qatar, Saudi Arabia, Somalia, Ukrainian SSR, Yemen (18).

The following countries represented were members of the United Nations but were not members either of the Paris Union or of WIPO: Angola, Bolivia, Democratic Yemen, Ecuador, Venezuela[2] (5).

Ten intergovernmental organizations and 10 international non-governmental organizations were represented by observers.

The following main officers of the Conference continued in their functions during the fourth session: the President of the Conference, Ambassador A. Sène (Senegal); the Chairman of Main Committee I, Ambassador F. Jiménez Dávila (Argentina); the Chairman of Main Committee II, Dr. Gy. Pusztai (Hungary); the Chairman of Main Committee III, Commissioner G.J. Mossinghoff (United States of America).

The Plenary of the Conference proceeded to the election of officers to vacant posts. Of the nine posts of Vice-President of the Conference, six were vacant, and they were filled by Mr. D.S. McCracken (Canada), Ambassador K. Chiba (Japan), Mr. F.J. Cruz González (Mexico), Mr. J.J. Bos (Netherlands), Mr. C. Fernández Ballesteros (Uruguay), and Mr. D. Ćemalović (Yugoslavia). Of the two posts of Vice-Chairman for Main Committee I, one was vacant and was filled by Mr. T. Kivi-Koskinen (Finland). Both posts of Vice-Chairman of Main Committee II were vacant, and they were filled by Mr. C.H. Friemann (Australia) and Mr. T.C. Choi (Republic of Korea). Of the two posts of Vice-Chairman of Main Committee III, one was vacant and was filled by Ambassador H.J. Brillantes (Philippines). A vacant post in the composition of the Credentials Committee was filled by Ghana (replacing Kenya). The Credentials Committee elected a new Chairman in the person of Mr. A. McCarthy (Ghana). The Drafting Committee elected

* This article is the second part of a report on the main activities of WIPO in general and in the fields of industrial property and patent information. Activities in the fields of copyright and neighboring rights are covered in a corresponding report in the review *Copyright*.

The first part dealt with the activities of WIPO as such and with development cooperation activities in the field of industrial property. This second part deals with other activities in that field as well as in the field of patent information.

[1] China acceded to the Paris Convention on December 19, 1984; the Convention entered into force with respect to China on March 19, 1985.

[2] Venezuela became a member of WIPO on November 23, 1984.

a new Chairman in the person of Mr. J.-C. Combaldieu (France), and a new Vice-Chairman in the person of Mr. B. Saci (Algeria).

During the fourth session, the Plenary of the Conference held four meetings, Main Committee I held seven meetings, and Main Committee II held six meetings. All three Regional Groups held one or more meetings on almost every one of the working days of the fourth session. The following delegates were the Spokesmen of the three Groups: Mr. E.E.E. Mtango (United Republic of Tanzania) for the Group of Developing Countries; Mrs. E. Steup (Federal Republic of Germany) for Group B (industrialized market economy countries); Mr. I. Nayashkov (Soviet Union) for Group D (socialist countries).

In order to discuss Article 5A (which deals with compulsory licenses and with forfeiture of patents) of the Paris Convention and other provisions concerning patents, Main Committee I set up a Working Group on Questions Relating to Patents composed of the members of seven delegations from each Regional Group. All delegations were admitted to follow the discussions in the Working Group. The Working Group held five meetings and was chaired by the Chairman of Main Committee I, Ambassador F. Jiménez Dávila (Argentina). Following the discussions in the Working Group, Main Committee I continued its debates on Article 5A. Certain ideas were put forward by the Group of Developing Countries for consideration by the other Groups, but no new proposals for amendment were made by any of the delegations and no agreement on Article 5A could be reached.

The meetings devoted to Article 10*quater* of the Paris Convention, which concerns geographical indications and trademarks, were presided over by Mr. T. Kivi-Koskinen (Finland), First Vice-Chairman of Main Committee I. During those meetings, a proposal made by 23 delegations of Group B was discussed; however, it was neither rejected nor adopted by Main Committee I.

Main Committee II discussed two new documents containing proposals concerning the definition of patents and inventors' certificates to be inserted in Article 1 of the Paris Convention. None of the proposals were rejected or adopted by Main Committee II, but they were the subject of thorough discussions.

In its meeting on March 23, 1984, and on the proposal of the Spokesmen of the three Regional Groups, the Plenary of the Conference adopted the following resolution:

"1. The Diplomatic Conference on the Revision of the Paris Convention for the Protection of Industrial Property, in its meeting held at Geneva on March 23, 1984, recommends to the Assembly of the Paris Union for the Protection of Industrial Property that it convene, in what will be its fifth session, the Diplomatic Conference, as soon as it finds prospects for positive results.

"2. The countries participating in the Diplomatic Conference ask for the convocation, in September 1984, of an extraordinary session of the Assembly of the Paris Union to consider the setting up of a machinery for consultations designed to prepare, on substance, the next session of the Diplomatic Conference."

In September 1984, WIPO submitted the draft summary minutes of the fourth session of the Diplomatic Conference to the speakers at that session for their comments. On the basis of those comments, WIPO issued the *Revised Provisional Summary Minutes of the Fourth Session of the Diplomatic Conference* in December 1984.

The Assembly of the Paris Union for the Protection of Industrial Property met at Geneva in an extraordinary session from September 24 to 28, 1984. Taking into account the recommendation adopted by the Diplomatic Conference at its fourth session, it decided that "the machinery referred to in the [recommendation] will consist of consultative meetings of up to 10 representatives of States, including the Spokesman, for each Group of countries" and that "the three Spokesmen will, by consensus, agree on the dates, duration, agenda, chairmanship and documentation of the consultative meetings and any distribution of documents" and that "a preparatory meeting between the three Spokesmen will take place at the Headquarters of WIPO on December 20, 1984" (WIPO document P/A/IX/3, paragraph (3) (i), (ii) and (vi)).

The three Spokesmen—Mr. Mohamed Daghash (on behalf of the Group of Developing Countries), Mr. Ivor J.G. Davis (on behalf of Group B) and Mr. Victor F. Zubarev (on behalf of Group D)—met in Geneva, at the headquarters of WIPO, on December 20, 1984. At their invitation, Dr. Arpad Bogsch (Director General, WIPO) participated in part of the discussions.

It was agreed that the first consultative meeting would take place in Geneva from June 24 to 28, 1985, and that it would consider:

(i) any new compromise solutions on Articles 1 and 5A, as proposed before the first consultative meeting by any of the Spokesmen or any of the countries that will be members of the first consultative meeting;

(ii) Articles 10*quater*, A and B on the basis of any new proposal as well as the existing proposals;

(iii) it was also agreed that, where no compromise solutions are proposed, the first consultative meeting would indicate directions in which new compromise solutions should be sought in respect of Articles 1 and 5A and, where necessary, in respect of Articles 10*quater*, A and B, and the first consultative meeting would determine who should prepare, and by what date, in written form proposals or alternative proposals on the basis of the said directions.

II. Industrial Property Questions of Topical Interest

Objective

The objective is to look for solutions to specific questions of a legal nature, and of topical interest, in the

field of the protection of industrial property. These questions are of topical interest because they are raised by recent changes in the social, economic or technological environment.

Activities

Joint Inventive Activity. In February 1984, WIPO published in English, French and Spanish, and in June 1984, in Russian, a *Joint Inventive Activity Guide,* based on the discussions of the WIPO Committee of Experts in May 1983. The *Guide* gives advice on what questions should be borne in mind when partners from different countries—particularly where such countries have different economic structures and are at different levels of development—negotiate the terms of their cooperation in a joint undertaking expected to lead to inventions, new know-how or new trademarks.

The Legal Protection of Computer Software. A *Working Group on Technical Questions Relating to the Legal Protection of Computer Software* met in Canberra (at the invitation of the Government of Australia) in April 1984. The convening of this Working Group had been recommended by the Committee of Experts on the Legal Protection of Computer Software at its second session (Geneva, June 1983). Twenty-five experts participated in the meeting, in their personal capacity, from the following countries: Australia, Brazil, Canada, Finland, France, Germany (Federal Republic of), India, Japan, Netherlands, New Zealand, Republic of Korea, Singapore, Switzerland, United Kingdom, United States of America. The meeting was opened by the Attorney-General of Australia and the Director General of WIPO.

The Working Group dealt mainly with definitions and technical explanations, in particular with the definition of a "computer program," and noted six suggestions, made by participants, for a definition of that term. It agreed that it was not possible, useful or necessary to attempt definitions of "computer software" or "firmware" for the purposes of legal protection. It also examined in detail the technical aspects of the stages of preparing a computer program, in particular the question of the nature of the transformation of a program specification into computer program source code and of computer program source code into computer program object code (the latter being the machine-readable version of the computer program).

The Working Group examined the question whether the use of a computer program in the control of the operations of a computer necessarily required the reproduction of the program. It agreed that this was not the case and that, even where reproduction took place, reproduction was not always full, but merely one of single elements of the program in a sequence.

Furthermore, the Working Group also identified technical means for preventing or hampering unauthorized use of a computer program, concluding, however, that the existence of such technical means did not affect the need for legal protection.

Finally, the Working Group examined possibilities of setting up a classification of computer programs.

In connection with the meeting of the Working Group, a *Seminar* was held on international developments concerning the legal protection of computer software, jointly organized by the Attorney-General's Department of Australia, the Australian Computer Society, the Copyright Society of Australia, the Victorian Industrial Property Society and WIPO. The participants in the Working Group, as well as other persons having an interest in the creation, use and protection of computer programs, participated in the Seminar. Lectures were given by experts from Australia, Germany (Federal Republic of), Japan, the United Kingdom, the United States of America and WIPO. The discussions which followed each lecture concerned the protection of computer programs in the aforementioned countries, taking into account the existing international conventions and recent technical developments.

Public Disclosure of an Invention by Its Inventor Prior to Filing an Application. With the assistance of a *Group of Consultants,* which met in Geneva in February 1984, WIPO prepared a study on the question—with arguments for and against—whether patent laws should provide that, where an invention is publicly disclosed by the inventor before an application is filed in respect of that invention, such disclosure will not affect the invention's patentability if, within a certain period (six or 12 months) (the so-called "grace period"), an application is filed by the inventor of the said invention. The study dealt particularly with the question of the desirability of having a uniform solution to this question among all countries and the possible measures to promote or secure such uniformity.

The study was submitted for discussion to a *Committee of Experts on the Grace Period for Public Disclosure of an Invention Before Filing an Application,* which held its first session in Geneva in May 1984. Eleven States—Brazil, Denmark, France, Germany (Federal Republic of), Italy, Japan, Sweden, Switzerland, Soviet Union, United Kingdom, United States of America—one intergovernmental organization and eight international non-governmental organizations were represented.

Several delegations and most of the organizations expressed strong support for a general grace period system, uniform in all countries. Other delegations, however, expressed reservations as to the said system.

As recommended by the Committee of Experts, WIPO revised its study and circulated it for comments, together with the report of the session of the Committee of Experts, to all member States of the Paris Union and to all interested intergovernmental and non-govern-

mental organizations. The Committee of Experts noted that the International Bureau of WIPO would, after examining any comments received from governments and organizations, convene its second session with the purpose of continuing in more detail the consideration of the question under study and possibly of considering other questions of harmonization of patent laws. In addition to studying the question of the grace period, the objective of the study, in particular, would be to deal with those questions that are relevant for the introduction of automated patent procedures and for facilitating entry into the national phase of the procedure under the Patent Cooperation Treaty.

Biotechnological Inventions and Industrial Property. A *Committee of Experts on Biotechnological Inventions and Industrial Property* met in Geneva from November 5 to 9, 1984. Twenty-three States members of WIPO or of the Paris Union participated in the session: Austria, Belgium, Brazil, China, Denmark, Dominican Repuhlic, Egypt, Finland, France, Germany (Federal Repuhlic of), Hungary, Indonesia, Italy, Japan, Madagascar, Netherlands, Saudi Arabia, Soviet Union, Spain, Sweden, Switzerland, United Kingdom, United States of America. Five intergovernmental organizations and 13 international non-governmental organizations participated as ohservers.

The Committee of Experts had been convened in order to give advice on a study to be prepared by the International Bureau of WIPO on the existing situation concerning the protection, by patents or other means, of inventions in the field of biotechnology (including "genetic engineering") and on possihle means of providing for industrial property protection for such inventions, both at the national and international levels. In order to prepare that study, the International Bureau of WIPO had issued a memorandum outlining the questions to be examined. The memorandum dealt with the question of the definition of biotechnology, with technological developments in that field (in particular, the emergence of genetic engineering methods, in addition to the traditional methods of plant and animal breeding and isolation of microorganisms), with the categories of biotechnological inventions, and with questions concerning the legal protection of such inventions (in particular, the application of the concept of invention, the exclusion of patentability of certain sectors of biotechnology, the application of the conditions of patentability, special considerations concerning the disclosure of hiotechnological inventions for the purposes of patent procedure and the rights conferred hy titles of protection in respect of biotechnological inventions). The memorandum also presented suggestions on the possihle purpose of the WIPO study, in particular, whether it should make recommendations concerning the improvement of the existing protection of hiotechnological inventions, hoth at the national and international levels.

The Committee of Experts discussed in detail the questions raised in the memorandum; it concluded that all kinds of biotechnological inventions (including plant varieties, for which a special system of protection had been estahlished in a number of countries) should be covered hy the WIPO study and that all aspects of industrial property protection of hiotechnological inventions should be examined, including the question whether the special system of protection for plant varieties should be an exclusive one or whether it should be possihle for certain cases, for example, plants created by genetic engineering, to ohtain patent protection, either in addition to special plant variety protection or as an alternative to that protection.

The Committee of Experts also considered the requirement of deposit of microorganisms for the purposes of supplementing the description contained in a patent application, and dealt in particular with inventions involving biological material such as cell lines and plasmids, which are not living organisms as such but which may nevertheless have to be deposited for the purposes of patent procedure.

The Committee of Experts recommended that the International Bureau prepare a guide for depositors under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure. Finally, the Committee of Experts recommended that the WIPO study not only analyze the existing situation, but also explore all possihilities of improving that situation, and should deal with various possibilities of how such an improvement could be achieved.

III. Information and Teaching in the Field of Industrial Property

Objective

The objective is to increase and spread knowledge about the theory, legislation, frequency of use and practical administration of industrial property.

Activities

The periodicals *Industrial Property* and *La Propriété industrielle* continued to be puhlished each month. To mark the one hundredth anniversary of the entry into force of the Paris Convention, the November 1984 issue of those periodicals was devoted to the publication of studies on the historical conditions surrounding the ratification of or accession to the Convention in nine of the founding States.

Collection of Industrial Property Laws and Treaties. WIPO continued to keep up to date its collection of the texts of industrial property laws and regulations of all countries and of treaties dealing with industrial property, both in their original languages and

in English and French translations. The most important texts were published in *Industrial Property Laws and Treaties,* annexed to the periodical *Industrial Property.*

Supplements to the WIPO *Directory of National and Regional Industrial Property Offices* were published in January and October 1984.

Surveys of the Practical Administration of Industrial Property Laws. In February and March 1984, draft country reports were sent to industrial property offices and other relevant institutions of 26 countries in the Asian and Pacific region for comments and checking. Taking into account the comments received, the final version of the survey, entitled *The Situation of Industrial Property in the Countries of Asia and the Pacific,* was completed in December 1984.

Industrial Property Statistics. Detailed tables of the industrial property statistics (publication "B") for 1982 were distributed in January 1984; basic industrial property statistics (publication "A") for 1983 were published in August 1984, and detailed tables (publication "B") for 1983 were published in December 1984.

Patent Information Fair. In order to provide up-to-date information and guidance in searching through the technological information contained in patent documents, WIPO organized the first *Patent Information Fair* in Geneva in September 1984. The theme of the Fair was the on-line retrieval of patent information using computer data bases.

The exhibitors consisted of eight industrial property offices—those of Brazil, France, Germany (Federal Republic of), Spain, Sweden, Switzerland, the United Kingdom and the United States of America—and of the following 10 organizations in addition to WIPO: Carl Heymanns Verlag, Chemical Abstracts Service, Derwent Publications Ltd., Japan Institute of Invention and Innovation, Japan Patent Information Center, Mead Data Central Corp., Pergamon Infoline, Research Publications Inc., Télésystèmes-Questel and Télésystèmes-Darc, and Walter Rentsch S.A.

More than 400 visitors attended the Fair. They were able to use computer data bases located in several European countries, in the United States of America and in Japan to retrieve information concerning virtually any technical subject, and were able to discuss with the world's leading experts the role that information services can play in their own fields of interest.

The *International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP)* held the fourth session of its Assembly and its annual meeting at the headquarters of WIPO in Geneva in September 1984. WIPO provided conference facilities and financial support for the travel expenses of some members from developing countries. Fifty-five professors and researchers from 26 countries participated in the meeting. WIPO was represented by an observer.

The Director General of WIPO, in welcoming the participants, congratulated the Association on its effective role in promoting understanding of intellectual property law and its development, and expressed the hope that the Association would continue, together with other international non-governmental organizations, to make a contribution to the objectives of securing the protection of intellectual property throughout the world.

The Assembly of ATRIP noted with satisfaction the reports on the activities and accounts of the Association, as well as the reports presented by the chairmen of the Working Committees on curriculum materials for the teaching of intellectual property law, on graduate study fellowships and teacher exchange programs and on the administration and exploitation of university research results.

The Assembly considered and referred to the Executive Committee proposals for the program of activities for 1985, which dealt, *inter alia,* with the continuation of the Working Committees, the preparation of a resolution on the use by universities and research institutions of works protected by copyright, and the collection and dissemination of information, and courses of instruction, on the various subjects of intellectual property. In addition, the Assembly expressed its satisfaction that the membership of ATRIP had grown from 69 in July 1981, when the Association was founded, to 225 at the beginning of the 1984 meeting (from 43 countries, including 49 members from 16 developing countries).

At the annual meeting, papers were presented on a "Curriculum for the Teaching of Intellectual Property," "The Teaching of Intellectual Property in Lesotho," and "Recent Developments in France in Patent Infringement." Furthermore, three working sessions were held at which reports were presented by the chairmen of the sessions and comments were made by various members on the following topics: the role and functions of teaching and research institutes in the development of the law of intellectual property; the organization and administration of industrial property rights of universities and research institutes; and the use of copyright protected works for teaching or instructional activities.

IV. Promotion of Patent Information and Development of Patent Classification

Objective

The objectives are to continue to improve the cooperation with the International Patent Documentation

Center (INPADOC) and the cooperation between patent offices in all aspects of patent documentation and patent information (standardization, modernization of reproduction and dissemination of patent documents, etc.), as well as to continue the improvement of the International Patent Classification (IPC) by continuously revising it.

Activities

The *WIPO Permanent Committee on Patent Information (PCPI)* consists of the States members of the Paris Union which have informed the Director General of their desire to be members, States members of the PCT Union, States members of the IPC Union, and (without the right to vote) the EPO, the Industrial Property Organization for English-Speaking Africa (ESARIPO) and OAPI. At the end of 1984, the members of the PCPI were Algeria, Australia, Austria, Belgium, Brazil, Bulgaria, Burkina Faso, Cameroon, Canada, Central African Republic, Chad, the Congo, Cuba, Cyprus, Czechoslovakia, Democratic People's Republic of Korea, Denmark, Dominican Republic, Egypt, Finland, France, Gabon, German Democratic Republic, Germany (Federal Republic of), Ghana, Hungary, Iran (Islamic Republic of), Ireland, Israel, Italy, Japan, Kenya, Liechtenstein, Luxembourg, Madagascar, Malawi, Mauritania, Monaco, the Netherlands, Norway, the Philippines, Poland, Portugal, Republic of Korea, Romania, Rwanda, Senegal, the Soviet Union, Spain, Sri Lanka, Sudan, Suriname, Sweden, Switzerland, Togo, Trinidad and Tobago, Uganda, the United Kingdom, the United States of America, Viet Nam, Yugoslavia, Zambia, EPO, ESARIPO and OAPI (65).

The Permanent Committee held its eighth session in Geneva in September 1984, jointly with the seventh session of the Committee for Technical Cooperation of the Patent Cooperation Treaty (PCT/CTC). Twenty-four members were represented; four organizations were represented by observers.

The Permanent Committee noted a compilation of project files, which was attached to an explanatory note on PCPI documents and identification codes used on those documents; it entrusted to the International Bureau the task of issuing every year an updated compilation, which was felt indispensable for reference purposes.

The Permanent Committee approved a report prepared by the International Bureau on the various tasks assigned to it in 1984. Taking note of the Annual Technical Reports for 1983 prepared by 26 PCPI members and submitted in 1984, the Permanent Committee encouraged its members to continue their efforts to submit such reports also in 1985, at the same time adhering to the Guidelines which it had formulated in that respect. The Permanent Committee further stressed the importance of including in such reports statements on imminent or foreseen changes in procedures and working methods in the offices.

In respect of the CAPRI System (the Computerized Administration of Patent Documents Reclassified According to the International Patent Classification) the Permanent Committee noted that the total of subclasses covered was 590 out of a total of 614, and that it was very likely, in view of further commitments taken, that the said project might be brought to a successful conclusion by the end of 1985.

In respect of the publications on Industrial Property Statistics, the Permanent Committee underlined again the importance of publishing as soon as possible, in any given calendar year, the most important statistical information of the previous year, as far as it is available.

In respect of the WIPO *Handbook on Patent Information and Documentation* and the *Directory of Patent Information Sources*, the Permanent Committee noted that further updating pages would soon be ready. Similarly, the Permanent Committee noted that the publication *List of Titles of Classes and Subclasses* of the fourth edition of the IPC would soon be available.

Furthermore, the Permanent Committee took note of the interest expressed by some of its members in the *General Information Brochure on the IPC* and asked the International Bureau to update and publish the existing *Brochure* in accordance with the fourth edition of the IPC.

The Permanent Committee reviewed and approved the activities of its Working Groups in 1984 on the basis of the reports of their sessions held in 1984.

The Permanent Committee adopted the revised PCPI Program for the 1984-1985 biennium and decided that the five Working Groups established for 1984 be continued in 1985 with unchanged mandates, namely: the Working Group on Planning, the Working Group on Special Questions, the Working Group on Search Information, the Working Group on Patent Information for Developing Countries and the Working Group on General Information.

The *PCPI Working Group on Search Information* held its eleventh, twelfth and thirteenth sessions in Geneva in January, May and December 1984, respectively. Fourteen States and one intergovernmental organization, members of the Working Group, were represented at each session.

The main task of the Working Group is to examine proposals for amendments to the IPC; amendments adopted by the Working Group (in English and French) are forwarded, through the PCPI, to the Committee of Experts of the IPC Union, which is responsible for the revision of the IPC. After approval by the IPC Committee of Experts, amendments are incorporated in the next edition of the IPC, every five years.

These sessions of the Working Group were the first three of a series of meetings over the next five years which will lead to the fifth edition of the IPC. From

amendment proposals carried over from the 1983 Program, the Working Group rejected two and completed 17, which resulted in amendments to one class and 26 subclasses; from the remaining 10 proposals of the said Program, it agreed on amendments to eight subclasses in both English and French, and, in one language version, to seven subclasses. It created a new subclass for the classification of processes using enzymes or microorganisms. From the amendment proposals of the 1984 Program, the Working Group rejected four and completed 22, which resulted in amendments to 33 subclasses. From the remaining 49 proposals of the said Program, it agreed on amendments to 19 subclasses in both English and French, and, in one language version, to 41 subclasses.

The Working Group considered a number of X-notations (that is, classification symbols on patent documents dealing with subject matter which apparently cannot be satisfactorily classified according to the IPC) allotted by various industrial property offices, and approved, in both English and French, amendments to six subclasses and, in one language, amendments to two subclasses which will permit appropriate classification of the patent documents in question.

The Working Group agreed on a revised text of the Guidelines on the Organization of Search Files Based on the IPC, which now will correspond to the fourth edition of the IPC.

The PCPI Working Group on Planning held its thirteenth session in Geneva in May 1984. Thirteen States and one intergovernmental organization, members of the Planning Group, were represented and one other State was represented by an observer.

The Planning Group decided to recommend to the PCPI that the Working Group on General Information deal with the task of studying, in two phases, the question of the reciprocal admittance of priority documents on microfiche: the said Working Group should first look at the various alternative forms (e.g., paper or microform) in which priority documents could be made available, and should study the cost elements involved in each of these alternatives; the findings of the said Working Group should then be considered by the Planning Group with a view to making recommendations on how this question should be further dealt with. On the question of the filing of patent applications in machine-readable form, the Planning Group, in view of the ongoing efforts at the EPO, decided that work in this area by PCPI bodies should be suspended in order to wait for the results of those efforts.

The Planning Group discussed a proposal for the establishment of an internationally agreed upon program for the elaboration of hybrid systems and decided to recommend to the PCPI that one of the tasks of the 1984-1985 Program be reworded in order to clarify that the said task would include part of the proposal. It also decided to recommend that a detailed proposal concerning means of reducing the bulkiness of search files be put on the program of the PCPI in the present biennium, and be dealt with by the Working Group on Special Questions. It invited its members to submit comments on a proposal concerning the development of hybrid systems.

The Planning Group recommended to the PCPI the adoption of revised working procedures; it also recommended revision of the PCPI Program for the 1984-1985 biennium in respect of certain IPC revision requests and the addition to the said Program of tasks concerning the standardization of official gazettes and other patent "announcement" journals, e.g., abstract journals, and guidelines for the publication of indexes issued periodically by industrial property offices. Finally, the Planning Group began consideration of a proposal on the possible WIPO contribution to offices preparing translations of new editions of the IPC, in order to enable those offices expeditiously to prepare exact translations of the authentic versions, and made arrangements for further information and comments to be submitted.

The Working Group on Planning held its fourteenth session in Geneva in November 1984. Thirteen States and one intergovernmental organization, members of the Planning Group, were represented.

The Planning Group discussed a proposal by the Soviet Union for obligatory printing of IPC indexing codes on those published patent documents which form part of the PCT minimum documentation and invited the members of the Planning Group to submit further comments. It noted the possibility and desirability of achieving the main purpose of the proposal without attempting to make it compulsory for the members of the IPC Union to print indexing codes on their published patent documents.

The Planning Group reviewed, in a first reading, a revised "Long-Term Program of the PCPI" and offered a certain number of preliminary observations and comments. Among those comments was the suggestion that the International Bureau should possibly look into the overall structure of the Program, with a view to reducing overlap of subject matter between the so-called "broad headings." It was felt, however, that the subdivisions under the "broad headings," namely, "objective," "present status," "current work" and "possible future work areas," should be retained. In order to enable it to prepare a final recommendation on this question at its next session, the Planning Group asked all members of the Permanent Committee to submit comments on and make proposals for the revised "Long-Term Program of the PCPI," particularly as regards the following aspects:

(a) proposals for new possible future work areas;

(b) comments, if any, on the "broad headings";

(c) with regard to the presently included "possible future work areas" that had been included in the Long-Term Program for two or more years since its adoption by the Permanent Committee and which were thus

likely to be deleted from the Program by the Permanent Committee at its next session in September 1985, each proponent office should either submit a detailed proposal or declare why the said "possible future work areas" should be kept on the Long-Term Program;

(d) any further observations of a general nature which would enable the Permanent Committee to achieve its goals and objectives as laid down in its Organizational Rules.

The Planning Group emphasized that, in any comments or proposals made, the interests and concerns of developing countries in all questions concerning patent information and documentation should be closely kept in mind.

The Planning Group noted with interest the progress report prepared by the International Bureau concerning the work of the EPO DATIMTEX Working Party on the filing of patent applications in machine-readable form, underlined the importance of this task and agreed that the legal implications and feasibility as well as several basic questions of standardization posed by the filing of patent applications in machine-readable form were matters requiring detailed study by the PCPI and other relevant bodies of WIPO. Accordingly, the Planning Group requested the International Bureau to draft a detailed proposal concerning the presentation of patent applications typed in Optical Character Recognition (OCR) format.

The *PCPI Working Group on General Information* held its sixth session in Geneva in April 1984. Seventeen States and one intergovernmental organization, members of the Working Group, were represented, with observers from four international non-governmental organizations.

The Working Group discussed the standard code for the identification of different kinds of patent documents and requested the International Bureau to prepare a revised updated annex thereto; it discussed a draft of a proposed recommendation concerning name indexes to patent documents and requested the International Bureau to prepare a further draft based upon the conclusions of that discussion; it agreed upon (subject to adoption by the PCPI) a standard format for the exchange in machine-readable form of bibliographic data, abstracts and the full texts of patent documents, and discussed and agreed upon, subject to a further round of comments, a draft standard for the recording of IPC symbols on machine-readable records which takes into account certain changes introduced into the fourth edition of the IPC.

The Working Group approved the proposals of the International Bureau for changes in the structure and coverage of the WIPO industrial property statistics, which would lead, in due course, to improved statistics useful, in particular, for assessing the impact of international or regional agreements in the field of industrial property. It also discussed a proposal by the German Democratic Republic concerning amendments to the existing guidelines for photo-optically generated microfiches.

The Working Group finally agreed to recommend to the PCPI that the code "AP" should be used to represent the Industrial Property Organization for English-Speaking Africa (ESARIPO), and that INID Code 84 should be redefined so that ESARIPO could use that code to indicate designated Contracting States on the front page of patent documents to be issued by ESARIPO.

The *PCPI Working Group on Special Questions* held its fifth session in Geneva in May 1984. Fourteen States and one intergovernmental organization, members of the Working Group, were represented, together with, upon special invitation for discussion of an agenda item on computerized searching aids, observers from eight organizations concerned.

The Working Group completed its study of computerized searching aids by noting demonstrations given by observers from three organizations which had not demonstrated at the session of the Working Group held in September 1982; it gave guidance to the International Bureau on the completion of the inventory of available computerized searching aids that are devoted wholly, or for a substantial part, to patent information, agreed to recommend to the PCPI that the International Bureau discuss with the brokers or vendors of such aids ways and means whereby closer coordination and standardization of the on-line services available could be undertaken, and also agreed to recommend to the PCPI certain steps that should be taken so as to assist developing countries in their access to and use of on-line retrieval of patent information.

The Working Group discussed a study made by the International Patent Documentation Center (INPADOC) concerning the extension of the CAPRI System so as to cover patent documents issued from 1973, and asked the International Bureau to obtain a slightly revised study from INPADOC; it agreed upon a revised text of the IPC Revision Instructions, which will be published in the WIPO *Handbook on Patent Information and Documentation*, had a preliminary discussion of the replies received to a recent circular concerning the continuation of the WIPO *Journal of Patent Associated Literature (JOPAL)* project, and agreed upon the final text of the *Introductory Manual to the IPC*.

The Working Group on Special Questions held its sixth session in Geneva in November 1984. Thirteen States and one intergovernmental organization, members of the Working Group, were represented at the session and INPADOC was represented as an observer.

The Working Group adopted a revised version of the Standardized Recording of International Patent Classification (IPC) Symbols on Machine-Readable Records (WIPO Standard ST.8).

It discussed further actions to be undertaken in respect of summary reports and conclusions prepared by the International Bureau concerning a detailed study of the consistency in the application of symbols of the IPC to patent documents.

The Working Group approved material prepared hy the International Bureau so as to complete the inventory of computerized search systems that are devoted wholly, or to a suhstantial degree, to patent information. It approved a general outline, also prepared by the International Bureau, of a handbook on telex interrogation of on-line patent data bases.

The Working Group approved a proposal hy the International Bureau to publish, generally once a year, in the *PCT Gazette,* corrections to the list of periodicals established according to PCT Rule 34.1(h)(iii), and approved a procedure to enahle such corrections to be so published. The Working Group also approved a revised distribution of work in connection with the selection of articles from the said list of periodicals whose bibliographic details are published in *JOPAL* following the coming into force on January 1, 1985, of a revised list of such periodicals.

Finally, the Working Group discussed the topic of mass storage media for patent documents. It agreed to ask members of the Permanent Committee to identify those aspects of the topic that should receive detailed consideration and at the same time to give information which would enahle the International Bureau to prepare a survey of the present and planned future use of such media within industrial property offices.

The *Working Group on Patent Information for Developing Countries* held its fifth session in Geneva in September 1984. Seventeen States, and one intergovernmental organization, members of the Working Group, were represented and two organizations were represented as observers.

The Working Group assessed the situation under the WIPO State-of-the-Art Search Program and noted that, from September 1975 to August 31, 1984, a total of 2,157 search requests had been received and 1,955 search reports had been furnished. Of this latter total, 1,076 search reports had been provided by Austria, 220 by Germany (Federal Repuhlic of), 214 by Sweden, 134 by the German Democratic Repuhlic, and 115 by other industrial property offices. In 196 cases, the International Bureau had been able to provide search reports itself.

The Working Group noted with appreciation the contributions made hy the various industrial property offices and, in particular, new contrihutions announced hy Japan and Finland and an additional contribution announced by the Soviet Union.

The Working Group stressed the necessities of keeping response times to search requests within reasonable limits and of a flexible approach to search requests that were not formulated with sufficient clarity. In the latter case, at least cross-sectional searches should be attempted in order to assist the user in better identifying his needs. In particular, thè results of on-line searches might serve this purpose. The Working Group endorsed recommendations made by the PCPI Working Group on Special Questions concerning steps to be undertaken hy the International Bureau in order to facilitate access by users from developing countries to patent information data bases.

The Working Group also discussed an analytical summary, prepared hy the International Bureau, of evaluation questionnaires returned by the users and noted that the direct transfer of technological knowledge and the stimulation of indigenous research and development activities have obviously remained the main reasons for requesting the services.

The Working Group noted with appreciation a detailed study prepared hy the Council of Scientific and Industrial Research (CSIR), India, on the technological and economic impact of the free-of-charge search reports, and invited all industrial property offices contributing to the WIPO State-of-the-Art Search Program to comment on the conclusions drawn hy CSIR with regard to possihle improvements of the services rendered.

The Working Group noted a flow chart for establishing technical monographs based on patent documents, and concluded that this flow chart needed to be studied in more depth.

The Working Group underlined the potential importance of monographs hased on patent documents for facilitating access to technological information not only for users in developing countries, but also, for instance, for users in small and medium-sized enterprises in industrialized countries. The International Bureau was requested to compile a hibliographic survey on the monographs hased on patent documents puhlished so far by various industrial property offices and organizations and to explore suitable ways and means of facilitating access to those monographs for users in developing countries.

Finally, the Working Group recommended that the Guidelines for the Planning and Organization of a Patent Documentation and Information Center in a Developing Country (WIPO document PCPI/GEN/1) should be revised and updated, and that the maintenance and regular updating of a price list of patent documents should be a continuing task.

The Working Group also had an exchange of views on *JOPAL* and recommended that the "experimental" character of *JOPAL* should, from 1985 onwards, be changed to a continuing item among the PCPI activities.

WIPO was represented at sessions of the Supervisory Board *(Aufsichtsrat)* of the *International Patent Documentation Center (INPADOC)* in Vienna in March, June and December, 1984. A WIPO official participated in a liaison officers meeting held at the premises of INPADOC in May 1984, at which representatives from

11 patent offices or information centers in Europe and North America were present.

Annual technical reports for 1983 were received from 26 national offices and the EPO for circulation to the members of the PCPI.

Publications. The *fourth edition of the International Patent Classification*, resulting from the completion by the Committee of Experts of the IPC Union in September 1983 of the revision of the third edition, was published in nine volumes, in June 1984. It entered into force on January 1, 1985.

A new edition of tbe IPC is published every five years. This puts a heavy burden on the International Bureau and tbe competent autborities responsible for the preparation of various language versions, but it is felt necessary each time to republish the complete IPC in view of the very substantial revision that takes place during tbe five years preceding a new edition. This revision work is governed by Article 5(3)(i) of the Strasbourg Agreement Concerning the International Patent Classification (of 1971) and is carried out within the framework of the PCPI under the supervision of the Committee of Experts of tbe IPC Union.

The major part of the revision work stems from technical considerations (for example, new technologies whicb bave to be provided for, increase in inventive activity in certain technical fields, new methods or means used by industrial property offices when classifying and searching patent documents and improvement of deficient elaborations in the current IPC). At the same time, during tbe revision work, all parties concerned make an effort also to improve the general quality of the IPC by clarifying the wording, introducing references between related places and presenting the information in a more logical way. In short, the IPC is continuously being made more user-friendly.

It is not only as a by-product of the technical revision that the quality of tbe IPC is improved. The IPC Committee of Experts has defined tbe various kinds of uses of the IPC by declaring tbat the IPC:

> "... has as its primary purpose the establishment of an effective search tool for the retrieval of patent documents by patent offices and other users, in order to establish the novelty and evaluate the inventive step (including the assessment of technical advance and useful results or utility) of patent applications,"

and that it furthermore:

> "... has the important purposes of serving as:
> "(a) an instrument for the orderly arrangement of patent documents in order to facilitate access to the technological and legal information contained therein;
> "(b) a basis for selective dissemination of information to all users of patent information;
> "(c) a basis for investigating the state of the art in given fields of technology;
> "(d) a basis for the preparation of industrial property statistics which in turn permit the assessment of technological development in various areas."

Direct contacts between the International Bureau and interested parties have resulted in the IPC being improved to meet the interests of particular user groups. For example, in the fourth edition of tbe IPC, all notes have been redrafted in a standardized manner and given a more logical and uniform presentation, in order to make it easier for the public to work with the IPC.

The new presentation of the notes, as well as the introduction of the concept of hybrid systems—whicb provides for the indexing of additional information (non-obligatory classification)—and the radical redrafting and simplification of the *Guide*, make the fourth edition of the IPC outstanding in comparison with previous editions. The establishment of this new edition has been made possible through an impressive amount of work by experts baving profound knowledge of the IPC, classification pbilosophies, technical subject matter involved and present inventive activities. The following table gives an indication of this work and also serves as a measurement of the involvement of the International Bureau:

		1979	*1980*	*1981*	*1982*	*1983*
Number of meetings (working days in brackets)	CE*	1 (4)	1 (5)	1 (4)	1 (5)	1 (7)
	SI**	2 (10)	2 (15)	2 (20)	2 (20)	2 (19)
	Sg***	2 (10)	2 (10)	2 (10)	3 (15)	1 (4)
Average-number of experts in the meetings	CE	22	20	20	17	20
	SI	19	21	27	25	27
	Sg	6	8	12	7	7
Workings days multiplied by average numbers of experts (2,944)		338	495	740	690	681
Average-number of pages in the reports (in the technical annexes in brackets)	CE	27 (6)	120 (102)	180 (174)	105 (90)	468 (443)
	SI	33 (16)	99 (71)	116 (84)	192 (145)	196 (140)
	Sg	21 (16)	14 (8)	29 (24)	30 (24)	20 (14)
Number of revision projects introduced in program (projects completed in brackets)		39 (7)	43 (13)	51 (38)	54 (65)	63 (21)

* CE = IPC Committee of Experts
** SI = Working Group on Search Information of the PCPI
*** Sg = ad hoc working groups created by SI

In addition to the time spent at meetings by representatives of the various industrial property offices, it is estimated that 1,200 man-months of work were devoted

by experts in the industrial property offices to the revision of the third edition of the IPC.

The evolution of the IPC is exemplified hy the following table:

Edition	*Classes*	*Subclasses*	*Number of main groups*	*Subgroups*	*Groups (total)*
1	115	607	—	—	48,870
2	116	614	6,467	44,961	51,428
3	118	617	6,602	48,865	55,467
4*	118	614 4	6,701 63	51,395 281	58,096 344

* The first line of figures indicates subdivisions which can be used for classifying; the second line of figures indicates subdivisions which can be used for indexing only.

The IPC is used throughout the world by governmental authorities, industry and the puhlic. The following shows the 43 countries and territory and four intergovernmental organizations which have informed WIPO that they allot the IPC symbols down to its finest subdivisions (that is, subgroup level) and the 20 countries down to the subclass level (the names of the countries members of the IPC Union are in italics):

I. African Intellectual Property Organization (OAPI), Argentina, *Australia*, *Austria*, *Brazil*, Bulgaria, Canada, Cuha, Cyprus, *Czechoslovakia*, Democratic People's Repuhlic of Korea, *Denmark*, *Egypt*, European Patent Office (EPO), *Finland*, *France*, *German Democratic Republic*, *Germany (Federal Republic of)*, Greece, Hong Kong, Hungary, India, Industrial Property Organization for English-Speaking Africa (ESARIPO), *Ireland*, *Israel*, *Japan*, Kenya, Mexico, Mongolia, *Netherlands*, New Zealand, *Norway*, Philippines, Poland, *Portugal*, Republic of Korea, Romania, *Soviet Union*, *Spain*, *Suriname*, *Sweden*, *Switzerland*, *United Kingdom*, *United States of America*, Venezuela, WIPO, Yugoslavia.

II. Bangladesh, *Belgium*, Chile, Colomhia, Costa Rica, Iceland, *Italy*, *Luxembourg*, Malawi, *Monaco*, Morocco, Peru, South Africa, Sri Lanka, Thailand, Turkey, Uruguay, Zambia, Zaire, Zimbabwe.

Twelve issues of *JOPAL* were puhlished in 1984. The said Journal is a compilation of hibliographic data of articles of relevance to patent searching appearing in periodicals included in the list of minimum documentation under the PCT, arranged according to the IPC. The selection and the classification of the said articles is undertaken by the industrial property offices which cooperate in the project (Australia, Austria, Czechoslovakia, France, German Democratic Republic, Germany (Federal Republic of), Japan, Soviet Union, Sweden, United Kingdom, United States of America, EPO).

Four issues of the periodical *World Patent Information* (WPI), a joint periodical of the Commission of the European Communities and WIPO, were published in 1984. A WPI Management Committee meeting was held at WIPO in May 1984.

Exhibition of Existing Language Versions of the International Patent Classification (IPC). In September 1984, an exhihition was held at WIPO of the most recent translations of the IPC. The following 12 language versions were exhibited (the figure in hrackets indicates the edition of the IPC): Chinese (3), Czech (3), English (4), French (4), German (4), Hungarian (3), Japanese (4), Korean (4), Polish (3), Portuguese (3), Russian (4), Spanish (3).

The number of language versions of the IPC is an indication of the extent to which the IPC is used throughout the world. The preparation of each of those language versions demands a great effort hoth on the part of the International Bureau (which prepares the manuscript for the authentic versions of the IPC and provides copies thereof to countries establishing translations) and each competent authority concerned (which translates all amendments to the current edition of the IPC and ensures the publishing of the new edition in its own language).

V. Development of Trademark and Industrial Designs Classifications

Objective

The ohjective is to continue the improvement of the International (Nice) Classification of Goods and Services for the Purposes of the Registration of Marks, an important tool in the orderly registration of trademarks and service marks, and the International (Locarno) Classification for Industrial Designs, an important tool in the orderly registration of industrial designs. "Improvement" means, for the Nice Classification, the covering of new products and services and, for the Locarno Classification, the covering of new kinds of goods in which designs are incorporated, as well as the more precise description and classification of existing products, services and goods, in addition to the updating of the Classifications in various languages.

Activities

A *Classification Service for Marks* began operating at the International Bureau of WIPO on January I, 1984. The Service gives advice, in the form of a classification report, to any national office, to any puhlic or private enterprise or to any person submitting to it a list of goods or services with a request for classification

according to the Nice Classification. On December 31, 1984, 35 classification reports were delivered in response to requests from eight countries.

The *fourth edition of the Nice Classification* was published, in bilingual versions, in English and French in April 1984 and in Dutcb and French in June 1984.

The *Preparatory Working Group established by the Committee of Experts of the Nice Union* beld its seventh session in Geneva in October 1984. Seven States members of the Working Group were represented; two States and one intergovernmental organization participated as observers.

The Working Group adopted recommendations to be made to the Committee of Experts on a number of proposals concerning the improvement of the Classification and on tbe adoption of a Keyword Index, in which the items contained in the Alphabetical List will be published according to their respective keywords.

The *fourth edition of the Locarno Classification* was published in English and in French (single-language versions) in March 1984.

VI. Cooperation with States and Various Institutions in Matters Concerning Industrial Property

Objective

The objective is to ensure that, through regular contact between the International Bureau, on the one hand, and the governments of States and international organizations, on tbe other, there should be full awareness of what is being done and planned on either side, in order to inspire mutually more and more useful activities, to combine forces wherever possible and to avoid all unnecessary duplication.

Activities

Various Forms of Cooperation. WIPO continued to cooperate witb States, with intergovernmental organizations and with international and national non-governmental organizations in matters concerning industrial property. Most of the missions undertaken by tbe Director General and his staff for this purpose, and representation at rnost meetings of organizations of the United Nations system, were covered in the first part of this report, wbich dealt with activities concerning cooperation with governments of developing countries, individually or in groups, and, on general matters, concerning certain intergovernmental institutions of developing countries.

Australia. At the invitation of the Government of Australia, WIPO convened a Working Group on Technical Questions Relating to the Legal Protection of Computer Software in Canberra in April 1984, and, with the Attorney-General's Department of Australia, the Australian Computer Society, tbe Copyright Society of Australia and the Victorian Industrial Property Society, organized a Seminar on international developments concerning the legal protection of computer software (see under "II. Industrial Property Questions of Topical Interest," above). In October 1984, an Intellectual Property Colloquium of Judges in Asia and the Pacific, jointly organized by WIPO and the Law Association for Asia and the Western Pacific (LAWASIA), with tbe assistance of tbe United Nations Development Programme (UNDP), was held in Sydney (see under "LAWASIA," below).

Brazil. In June 1984, a WIPO official, at the invitation of the Government, participated as a speaker in a seminar in Brasilia on legal approaches to computer software.

Bulgaria. In March 1984, two WIPO officials visited Sofia for discussions with representatives of the Organizing Committee for the World Exhibition of Acbievements of Young Inventors (Plovdiv, Bulgaria, 1985), and otber Government officials concerned, on details of cooperation in the organizing of the said Exhibition. The discussions were continued, and agreement was reached, during a visit to WIPO in May 1984 by a representative of the Organizing Committee. In November 1984, the Director General and another WIPO official paid an official visit to Bulgaria wbere they inspected the site of the future World Exhibition in Plovdiv and had discussions with the Chairman of the State Committee for Science and Technical Progress, the Secretary of the Organizing Committee of the Exhibition and the Mayor of Plovdiv.

Greece. In May and June 1984, a WIPO official visited Athens and assisted the Government authorities in the preparation of a project document for cooperation in the modernization of the patent system. In June and July 1984, the Head of the Patent Section of the Ministry of Research and Technology participated in tbe Moscow Training Course on Patent Information. Also in July 1984, three staff members of tbat Patent Section received training, organized by WIPO, at the German Patent Office (Munich). Their travel and daily expenses were borne by the Government of Greece. The Scientific Adviser of that Ministry undertook a study visit, organized and financed by WIPO, to patent documentation and information centers in Paris, Vienna and Munich, and had consultations at WIPO, in July 1984.

New Zealand. In October 1984, the Director General visited New Zealand and had discussions with

the Minister of Trade and Industry, the Deputy Secretary of Justice, the Commissioner of Patents and other Government officials.

Portugal. In August 1984, the Director General paid an official visit to Lisbon, at the invitation of the Government. He was received by the President of the Republic, the Deputy Prime Minister, the Minister for Foreign Affairs, the Minister for Industry and Energy and high officials of the Government.

Soviet Union. In December 1984, the Director General paid an official visit to the Soviet Union where he had discussions, in Moscow, with the Chairman and other officials of the USSR State Committee for Inventions and Discoveries.

Spain. A WIPO official gave lectures and conducted practical exercises on the IPC at a course held by the Spanish Industrial Property Registry in Madrid in September 1984.

Sweden. In June 1984, in Stockholm, the Director General made a speech at the formal celebration of the Swedish Patent and Trademark Centennial, and a WIPO official spoke on "Patents and the Exploitation of Technology Transferred to Developing Countries" in an international symposium organized as part of the Centennial.

Turkey. In May 1984, a WIPO expert mission went to Ankara, and in October 1984, a WIPO official undertook a mission to Ankara, to discuss cooperation, requested by the Government, on the preparation and implementation of a project for the modernization of the industrial property system, including the establishment of a patent documentation and information center. Furthermore, WIPO provided assistance in the ongoing revision of the Patent Law.

United Kingdom. In April 1984, in London, the Director General delivered a speech and was the principal guest at the celebration of the United Kingdom Patent Office Examining Staff Centenary.

Yugoslavia. The Director General, accompanied by another WIPO official, paid an official visit to Yugoslavia in November 1984, which was organized by the Yugoslav Association of Inventors and Authors of Technical Improvements (SPATUJ). The program included visits to Belgrade, Dubrovnik, Kotor, Budva, Sveti Stefan, Cetinje and Titograd, and discussions with the Minister for Industry, the President of the Chamber of Economy, the Director of the Federal Patent Office, the President and Secretary General of SPATUJ and other officials. The Director General also awarded a WIPO gold medal to Mr. Mika Spiljak, a former President of Yugoslavia, and a silver medal to Mr. Ilija Vakić, the President of the Chamber of Economy.

Council for Mutual Economic Assistance (CMEA). WIPO was represented, in Prague in May 1984, at a Conference on "Increasing the Role of Inventions as One of the Important Factors of Scientific and Technical Progress and of the Intensification of the Economy of the Member States of the CMEA."

Customs Cooperation Council (CCC). WIPO was represented at a meeting of the Enforcement Committee of the CCC in Brussels in June 1984 for discussion of an agenda item concerning copyright and industrial property piracy.

European Patent Organisation (EPO). WIPO was represented at the sessions of the EPO Administrative Council in Munich in June and December 1984. WIPO was also represented at the sessions of an EPO working group on filing in machine-readable form (DATIMTEX) in The Hague in July 1984 and in Berlin in November 1984.

International Federation of Inventors' Associations (IFIA). An *International Conference on the Situation of Inventors* was organized jointly in Geneva by WIPO and IFIA in May 1984. There were 78 participants, from 36 countries—Austria, Belgium, Bulgaria, China, Cuba, Denmark, Egypt, Finland, France, German Democratic Republic, Germany (Federal Republic of), Ghana, Greece, Hungary, India, Iraq, Italy, Ivory Coast, Japan, Morocco, Netherlands, Norway, Peru, Philippines, Senegal, Singapore, Soviet Union, Spain, Sweden, Switzerland, United Kingdom, United Republic of Tanzania, United States of America, Yemen, Yugoslavia, Zaire—and from six international organizations.

The participants were inventors, officials of national associations of inventors, officials of IFIA and government officials working in institutions and departments responsible for the promotion of inventiveness. The main purpose of the Conference was to create more awareness among inventors, in official circles, and in the general public about the role of inventors in contemporary society and the legitimate need they have to be better protected and better encouraged.

The discussions took place on the basis of 41 papers presented by WIPO and participants from the following countries: Belgium, Bulgaria, China, Denmark, Finland, France, German Democratic Republic, Germany (Federal Republic of), Greece, Hungary, Ivory Coast, Peru, Soviet Union, Sweden, Switzerland, United States of America, Zaire.

On the question of the importance of the inventor in society, it was agreed that, in order to improve their situation and to achieve a fuller recognition of their importance in economic and social development, inventors should act collectively through national associations and through IFIA.

The Conference noted that the problems of inventors were particularly acute in developing countries,

welcomed the recent formation of national associations of inventors in countries such as the Ivory Coast and Zaire, and considered that WIPO and IFIA, in their future cooperation, should give high priority to programs of assistance to such countries. In this connection, the successful efforts of the Filipino Inventors' Society were hailed as an example to inventors in other countries.

In connection with the rights of the inventor under the patent system, dissatisfaction was expressed on behalf of inventors with patent laws which did not provide for the possibility of non-prejudicial disclosure by the inventor before the filing of a patent application (frequently referred to as the question of a "grace period"). The WIPO study on the possibility of the establishment of a uniform solution was therefore of great interest to inventors.

The Conference noted with pleasure that several national associations of inventors which had not yet joined IFIA were actively considering doing so; IFIA was encouraged to draw the attention of associations in all countries to the advantages of membership (possibly establishing a structure of regional Vice-Presidents for this purpose) and, in cooperation with WIPO, to assist in the establishment of national associations of inventors where they did not yet exist.

The Conference noted with satisfaction that WIPO and IFIA intended to continue their close cooperation, and, in particular, to explore together the possibility of undertaking the following joint activities: assistance to associations of inventors in developing countries, including assistance in establishing such associations; collecting and disseminating information on laws and financial and administrative systems for the promotion, support and protection of inventors; public information through the mass media; organizing further joint conferences; international prizes to inventors.

A *WIPO Exhibition of the Inventor* took place on the occasion of the Conference. It contained displays of pictures, drawings, posters, etc., on some 10 themes, including WIPO prizes, women inventors, youth and inventions, an ambassador-inventor, stamps and the inventor, humor and inventions, etc.

In addition, WIPO was represented at the General Assembly of IFIA in Oslo in August 1984.

LAWASIA. WIPO and LAWASIA, with the assistance of the UNDP, jointly organized an *Intellectual Property Colloquium of Judges in Asia and the Pacific* in Sydney in October 1984. The participants consisted of justices and judges from Australia, Bangladesh, China, Fiji, Germany (Federal Republic of), India, Malaysia, New Zealand, Pakistan, Papua New Guinea, the Philippines, Singapore, Sri Lanka, Thailand, the United States of America and Viet Nam, lawyers from Australia, officials of WIPO and representatives of LAWASIA.

The Colloquium was opened by the Chief Justice of the High Court of Australia and the Director General of WIPO. The discussions were based on a number of papers on specialized topics in the field of intellectual property law and practice, prepared and presented by justices, judges and lawyers from Australia, Germany (Federal Republic of), New Zealand and the United States of America, and on presentations on intellectual property issues in their respective countries by the justices and judges from Bangladesh, China, Fiji, India, Malaysia, Pakistan, Papua New Guinea, the Philippines, Singapore, Sri Lanka, Thailand and Viet Nam.

Other Organizations. The Director General took part in a meeting of the *Kuratorium* of the Max Planck Institute for Foreign and International Patent, Copyright and Competition Law in Munich in March 1984; WIPO officials visited the said Institute in May 1984 for a detailed exchange of information, and WIPO was represented at a seminar at the said Institute in June 1984 on industrial property legislation in developing countries. In March, June and December 1984, the Director General and another WIPO official participated in meetings of the Supervisory Board of INPADOC in Vienna. In May 1984, the Director General participated in a meeting of the Administrative Council of the Center for the International Study of Industrial Property (CEIPI) in Paris and, in October 1984, represented WIPO at CEIPI's 20th Anniversary Symposium and Ceremony in Strasbourg. Also in October 1984, in New York, the Director General delivered a speech on "Emerging Changes in the International Patent and Trademark System: the Role of WIPO and its Impact on Private Business" at a meeting of the United Nations International Business Council, and participated in a discussion on the protection of microchips and computer software at a meeting of the Information Industry Association. In November 1984, the Director General participated in a conference entitled "Safeguards to Innovation" organized in Brussels by the European Council of Chemical Manufacturers' Federations (CEFIC).

WIPO was also represented at the following meetings of other non-governmental organizations: the Executive Committee of, and study sessions on industrial designs organized by, the International Literary and Artistic Association (ALAI) in Paris in April 1984; the Industrial Property Commission of the International Chamber of Commerce (ICC) in Paris in April 1984; the International Exhibition of Inventions in Geneva in April 1984; the Annual Meeting of the United States Trademark Association (USTA) in Toronto in May 1984; the Congress of the Inter-American Association of Industrial Property (ASIPI) in Montreal in May 1984; a discussion meeting organized by the Association of Italian Patent Attorneys in Industrial Property (AsCIPI) in Milan in May 1984; a Symposium organized by the Finnish Group of the International Association for the Protection of Industrial Property (AIPPI) in Helsinki in September 1984; the 29th Conference of the Pharmaceutical Trade Marks

Group in Toulouse in October 1984; the AIPPI Council of Presidents in Milan in December 1984.

In January and December 1984, meetings of international non-governmental organizations concerned with industrial property questions were convened by the Director General in Geneva; current activities were reviewed, and suggestions were invited and offered for the future programs and medium-term plans of WIPO.

VII. Registration Activities in the Field of Industrial Property

Objective

The objective is to maintain the registration and similar activities under tbe Paris Convention, the Patent Cooperation Treaty, the Madrid Agreement (Marks), the Hague Agreement (Industrial Designs) and the Lisbon Agreement (Appellations of Origin), in particular by accurately and promptly providing the services required under those treaties.

Activities

Paris Convention for the Protection of Industrial Property

Communication of State Emblems, etc. WIPO continued the communication of official signs under Article 6*ter* of the Paris Convention. In 1984, three communications of official signs were made under Article 6*ter* of the Paris Convention, coming from two States—Austria and Tunisia—and one international intergovernmental organization—the International Monetary Fund.

Patent Cooperation Treaty (PCT)

Membership. Six States deposited their instruments of ratification of or accession to the PCT in 1984. This brings to 39 the number of PCT Contracting States: Australia, Austria, Barbados, Belgium, Bulgaria, Brazil, Cameroon, Central African Republic, Chad, Congo, Democratic People's Republic of Korea, Denmark, Finland, France, Gabon, Germany (Federal Republic of), Hungary, Italy, Japan, Liechtenstein, Luxembourg, Madagascar, Malawi, Mali, Mauritania, Monaco, Netherlands, Norway, Republic of Korea, Romania, Senegal, Soviet Union, Sri Lanka, Sudan, Sweden, Switzerland, Togo, United Kingdom, United States of America. All those States, except Denmark, Liechtenstein, Norway, tbe Republic of Korea, Switzerland and the United States of America, are bound by Chapter II of the PCT, i.e., they can be elected for international preliminary examination.

The ratification of the PCT by Italy, on December 28, 1984, is of particular importance since it has the consequence that a European patent can, as from March 28, 1985, be obtained through the PCT for all States members of the European Patent Organisation (EPO) (Austria, Belgium, France, Germany (Federal Republic of), Italy, Liechtenstein, Luxembourg, Netherlands, Sweden, Switzerland, United Kingdom).

An official from the Government of the Republic of Korea and an official from the Govemment of Sudan visited WIPO in September 1984 in order to discuss PCT matters in view of the recent accession of their countries to the PCT.

Meetings. The *PCT Union Assembly* held its eleventh session (7th extraordinary) in Geneva in January and February 1984. The following 19 Contracting States were represented at the session: Australia, Austria, Belgium, Brazil, Denmark, Finland, France, Germany (Federal Republic of), Hungary, Japan, Luxembourg, Netherlands, Norway, Romania, Soviet Union, Sweden, Switzerland, United Kingdom, United States of America. The Republic of Korea and Spain participated in the session as observers.

The EPO, having the status of special observer, was represented. The following nine international non-governmental organizations were represented by observers: Asian Patent Attorneys Association (APAA), Committee of National Institutes of Patent Agents (CNIPA), European Federation of Agents of Industry in Industrial Property (FEMIPI), Institute of Professional Representatives Before the European Patent Office (EPI), International Association for the Protection of Industrial Property (AIPPI), International Federation of Industrial Property Attorneys (FICPI), International Federation of Inventors' Associations (IFIA), Union of European Practitioners in Industrial Property (UEPIP) and Union of Industries of the European Community (UNICE).

On the basis of the preparatory work carried out in particular in the framework of two sessions of the PCT Committee for Administrative and Legal Matters, the Assembly amended two provisions in the PCT and 91 Rules in the PCT Regulations. Subject to a few exceptions, all the amendments entered into force on January 1, 1985.

The purpose and a brief description of the most important amendments are indicated below.

Making the Procedure During the International Phase under Chapter I of the PCT Safer and Simpler for the Applicant. The Assembly adopted very important amendments giving the applicant the means to ensure that he will not lose his international application because the record copy has not reached the International Bureau in due time. It is to be noted, in particular,

that the time limit at the expiration of which the international application would be considered withdrawn if the record copy had not reached the International Bureau will start running only when a notification is sent by the International Bureau to the applicant.

Other amendments have the effect that the one-month grace period for the payment of the international fee and the search fee, which up to know could, but did not have to, be granted by the receiving Offices, became, subject to some transitional provisions, applicable in all receiving Offices.

Amendments were adopted which expressly allow the extension of time limits fixed by the receiving Office for the correction of defects and make sure that no international application will be considered withdrawn by the receiving Office for lack of compliance with physical requirements if it complies with those requirements to the extent necessary for the purpose of reasonably uniform international publication.

The time limit within which the applicant may amend the claims during the international phase is now longer in certain cases. Furthermore, the applicant now has the possibility to state more in his explanations of amendments and is now permitted to submit the amendments in the language of publication only.

In connection with amendments which make it possible to withdraw the international application, designations or the priority claim through a notice filed with the receiving Office even after the latter has sent the record copy to the International Bureau, the Assembly noted that the international application would not be published if the withdrawal reached the International Bureau before the completion of the technical preparations for international publication, which is not earlier than 15 days before the expiration of 18 months from the priority date. Furthermore, the Assembly agreed that it was possible for an applicant to make a conditional withdrawal of his international application in the sense that the withdrawal will be effective if it is made early enough for the international publication of the application not to take place and that the withdrawal will not be effective if it is made too late to stop the international publication of the application.

The rules concerning the rectification, during the international phase, of obvious errors in documents were made more liberal by also allowing the rectification of obvious errors which are not errors of transcription. Furthermore, it is now possible for the applicant, if the rectification has been refused during the international phase, to obtain the publication of his request for rectification in the pamphlet publishing the international application. Such publication, however, will not relieve the applicant, during the national phase, from the need to request the designated Offices to authorize the rectification.

New rules were adopted which deal with the excusing by the designated or elected State of delays in meeting certain time limits, in particular, time limits pertaining to the international phase and the time limit for entering the national phase. In that connection, it was understood by the Assembly that the excusing of the delay may take place only during the national phase and under the conditions set forth by the national law.

Making the Procedure under Chapter II of the PCT More Attractive for the Applicant. A very important amendment adopted by the Assembly consisted in modifying the time limit under Article 39(1)(a) for entering the national phase before elected Offices. Subject to some transitory provisions, that time limit, which up to now was 25 months from the priority date, has been extended to 30 months from the priority date. The Assembly also decided to extend the time limit for the establishment of the international preliminary examination report: where preliminary examination has been demanded before the expiration of the 19th month from the priority date, that time limit is 28 months from the priority date (instead of six months after the start of international preliminary examination). The said extensions give applicants more opportunities to present arguments to the International Preliminary Examining Authority and more time for thorough international preliminary examination.

Making it Safer and Simpler for the Applicant to Enter the National Phase. The Assembly modified the time limit under Article 22(2) in order to harmonize it with the time limit under Article 22(1). This amendment means that, subject to some transitory provisions, the time limit for entering the national phase before the designated Offices is now 20 months from the priority date in *all* cases, even where the International Searching Authority declares that no international search report will be established. In the latter case, under the previous text, the time limit was shorter.

The Assembly adopted new rules specifying the requirements for entering the national phase, in particular, the contents of the translation of the international application to be furnished when entering the national phase, and making it clear that certain requirements to be complied with during the national phase must be complied with by the applicant, subject to some transitory provisions, only *after* entering the national phase. Among the latter, it is now made clear that the applicant must be given an opportunity, *after* entering the national phase before the designated Office, for furnishing evidence—where evidence is required under the national law—as to the identity of the inventor, the applicant being the inventor, the applicant's right to file when he is not the inventor or circumstances making an earlier disclosure non-prejudicial. Also, if the applicant did not appoint a local agent when the national phase is entered, that he must be given an opportunity, *after* entering the national phase, to appoint a local agent where he is, under the national law, obliged to be represented by such an agent.

Including Certain Patent Documents Published in the Spanish Language in the PCT Minimum Documentation and Including the Spanish Language Among the Languages of Publication of International Applications. It is expected that the very important amendments adopted by the Assembly in that connection will make it easier for Spain and for Spanish-speaking countries of Latin America to join the PCT Union.

Simplifying the Tasks of the International Authorities Involved in the PCT Procedure and Simplifying the PCT Regulations in General. The Assembly adopted a number of amendments in that connection, in particular, through the transfer of Rules or parts of Rules which are of no direct interest to applicants to the Administrative Instructions under the PCT and the deletion of some obsolete Rules.

It is to be expected that, after this very comprebensive revision of the Regulations, there will be a longer period during which no, or only very few, changes will be necessary in the PCT system.

The Assembly also adopted the following Resolution:

"*The Assembly of the International Patent Cooperation Union (PCT Union)*

"*Noting* thal the number of developing countries which are members of the PCT Union is relatively small,

"*Noting further* thal the number of international applications emanating from those developing countries which are members of the PCT Union is extremely small,

"*Assuming* thal one of lhe reasons for such unsatisfactory silualion may be lhe high cosl of international search and international preliminary examination for applicants from developing couotries,

"*Resolves to:*

"(1) Recommeod lo all States members of the PCT Union lo seek ways and means for financing al leasl part of the fees payahle by applicants from developing countries for international search and international preliminary examination;

"(2) Recommend lo all Ioternational Search and Preliminary Examining Authorities lo sludy the possihility of reducing the amounl of the fees payable by applicants from developing countries for international search and international preliminary examination;

"(3) Recommend lo all States members of the PCT Union lo study whether national or regional funds could be pul al the disposal of the International Bureau or of the Internatiooal Searching and Preliminary Examining Authorities, in order lo be used lo assist such applicants from developing countries in paying such fees."

The *PCT Union Assembly* held its twelfth session (8th extraordinary) in Geneva in September 1984. It fixed new amounts, with effect from January 1, 1985, of the fees specified in the Schedule of Fees annexed to the PCT Regulations. It is to be noted that a maximum amount of the designation fee, corresponding to the amount due for 10 designations for which the fee is due, is provided for. It also approved an amendment to the Agreement between the International Bureau of WIPO and the European Patent Organisation, with a view to the European Patent Office acting, once the United States of America has withdrawn its reservation excluding the application of Chapter II of the PCT, as an International Preliminary Examining Authority for international applications filed with the United States Patent and Trademark Office. Finally, the PCT Union Assembly agreed that an international application which is received by telecopier by a receiving Office is to be accorded an international filing date, and that any formal defect, such as the lack of signature or of fitness for reproduction, may be subsequently corrected without affecting the international filing date. It was understood, however, that no receiving Office would be obliged to make telecopier facilities available to applicants.

The *PCT Committee for Technical Cooperation* held its seventh session in Geneva in September 1984. The Committee discussed, in particular, inventories of patent documents pertaining to the PCT minimum documentation and inventories of English-language abstracts of patent documents.

Meetings were held *on the advantages of the PCT* in Munich in February 1984 (with patent agents), in Khartoum (with Government officials and representatives of university and industry) and in Sofia (with Government officials and representatives of industry) in May 1984, in Frankfurt-am-Main and Düsseldorf (with patent agents), in Seoul (with representatives of industry) and in Osaka and Tokyo (with representatives of industry) in October 1984. In those meetings, WIPO staff gave lectures and answered questions.

WIPO officials visited the Governments of the Federal Republic of Germany in February 1984 (as well as the EPO), of the Sudan and Bulgaria in May 1984, of Finland in September 1984 and of the Republic of Korea and Japan in October and November 1984, in order to discuss questions concerning the implementation of the PCT.

Statistics. During 1984, the International Bureau of WIPO received the "record copies" of 5,719 international applications from the "receiving Offices," that is, the Offices with which international applications were filed.

The number of international applications filed, in the same year, according to information provided by the receiving Offices, amounted to 5,733. The total numbers of international applications filed in each calendar year since the beginning of PCT operations are as follows:

June lo December 1978	687
1979	2,734
1980	3,958
1981	4,321
1982	4,713
1983	5,050
1984	5,733

The increase in filings, which was 13.52% in 1984 as compared with 1983, can be attributed mainly to an increasing awareness of the advantages offered by the PCT on the part of potential applicants.

In the table below, the year's total of *record copies received* is broken down according to the various receiving Offices, and the corresponding percentages are indicated.

Receiving Office (Name of country or organization)	*Record copies received** *Number* / *percentage*
Australia	274 4.79
Austria	44 (48) 0.77 (0.84)
Belgium	24 (28) 0.42 (0.49)
Brazil	6 0.10
Denmark	121 2.12
Finland	96 1.68
France	310 (315) 5.42 (5.51)
Germany (Federal Republic of)	281 (547) 4.91 (9.55)
Hungary	56 0.98
Japan	621 10.85
Luxembourg	— (1) — (0.02)
Netherlands	41 (61) 0.72 (1.07)
Norway	59 1.03
Republic of Korea	10 0.17
Romania	2 0.03
Soviet Union	60 1.05
Swedeo	476 (480) 8.32 (8.39)
Switzerland**	203 (247) 3.55 (4.32)
United Kingdom***	450 (454) 7.87 (7.94)
United States of America	2,233 39.06
EPO*	352 6.15
Total:	5,719 100.00

* Nationals and residents of Austria, Belgium, France, Germany (Federal Republic of), Liechtenstein, Luxembourg, the Netherlands, Sweden, Switzerland and the United Kingdom may use either the EPO or their national Offices as receiving Office, provided that, for nationals and residents of Liechtenstein, national Office means the Swiss Federal Intellectual Property Office. The figures in brackets include the number of record copies received from the EPO which were filed with the EPO by nationals or residents of the said States and indicate the total percentage of record copies of international applications filed by those applicants.

** Receiving Office also for nationals and residents of Liechtenstein.

*** Receiving Office also for residents of Hong Kong and the Isle of Man.

The average number of designations of Contracting States per international application (on the basis of the record copies received in 1984, see above) was 9.89 in 1984. The average number of designation fees payable, however, was 4.76. This difference is due to the fact that in the case of the designation of several countries for regional (European or OAPI) protection, only one designation fee is due. The difference also shows that applicants eliminate a certain number of designations—made at no cost at the time of filing—by the time they pay the designation fee, a natural and desirable result of the PCT procedure. The following table shows the year's total of designations broken down according to the designated States and the ratio of designations of Contracting States per 100 international applications.

Designated State	*Number of designations for national and/or regional protection**	*Ratio of designation per 100 international applications*
Australia	2,391	41.81
Austria	3,182	55.64
Belgium	3,327	58.17
Brazil	1,416	24.76
Bulgaria	56	0.98
Democratic People's Republic of Korea	268	4.69
Denmark	1,767	30.90
Finland	1,408	24.62
France	4,303	75.24
Germany (Federal Republic of)	4,692	82.04
Hungary	386	6.75
Japan	4,408	77.08
Luxembourg	2,853	49.89
Madagascar	131	2.29
Malawi	122	2.13
Monaco	229	4.00
Netherlands	3,736	65.33
Norway	1,695	29.64
Republic of Korea	301	5.26
Romania	341	5.96
Soviet Union	817	14.29
Sri Lanka	124	2.17
Sudan	40	0.70
Sweden	3,605	63.04
Switzerland**	3,430	59.98
United Kingdom	4,613	80.66
United States of America	3,340	58.40
OAPI***	206	3.60

* Only one designation is counted where a State member of the European Patent Organisation is designated for national protection and for a European patent.

** Includes the simultaneous designation of Liechtenstein.

*** Includes the simultaneous designation of Cameroon, Central African Republic, Chad, Congo, Gabon, Mali, Mauritania, Senegal and Togo.

The languages in whicb the international applications received in 1984 by the International Bureau of WIPO were filed and the corresponding percentages are as follows:

Language of filing	*Number of applications*	*Percentage of total*
Danish	65	1.14
Dutch	14	0.24
English	3,463	60.55
Finnish	40	0.70
French	402	7.03
German	769	13.45
Japanese	625	10.93
Norwegian	38	0.66
Russian	60	1.05
Swedish	243	4.25
Total:	5,719	100.00

In 1984, 271 demands for international preliminary examination under Chapter II of the PCT were filed with the Offices indicated below which act as International Preliminary Examining Authorities. In the following table, those demands are broken down according to the International Preliminary Examining Authorities that received the demands, and the corresponding percentages are indicated.

Authority (country or organization)	*Number of demands*	*Percentage of total*
Australia	28	10.33
Japan	8	2.95
Soviet Union	3	1.11
Sweden	140	51.66
United Kingdom	49	18.08
EPO	43	15.87
Total:	271	100.00

Information Services. New brochures containing the text of the PCT and its Regulations as applicable from January 1, 1985, were published in English and French. New brochures in Arabic, German, Italian, Portuguese, Russian and Spanish are under preparation.

Replacement pages were issued in January and July 1984 to update the *PCT Applicant's Guide.*

The fortnightly publication of the *PCT Gazette,* in separate English and French editions, was continued throughout 1984. In addition to a substantial volume of information of a general character, the *PCT Gazette* included entries relating to the 4,996 international applications which were published in the form of PCT *pamphlets* (in English, French, German, Japanese or Russian, depending on the language of filing) on the same day as the relevant issues of the *PCT Gazette.* Two special issues were published consolidating the information of a general character. Two further special issues were published, one containing the text of the decisions of the PCT Union Assembly taken in February 1984 and the other containing the revised text of the Administrative Instructions under the PCT. A revised list of publisbed items of non-patent literature (technical periodicals) included in the PCT minimum documentation, as agreed upon by the International Searching Authorities, was published in the *PCT Gazette* in June 1984. The revised list came into force on January 1, 1985. An updated inventory of the patent documents contained in the PCT minimum documentation was published in the same issue of the *PCT Gazette.* Tbe number of international applications published as pamphlets in each of the above-mentioned languages (and the corresponding percentages) is as follows:

Language of publication	*Number of applications published*	*Percentage of total*
English	3,455	69.15
French	349	6.99
German	623	12.47
Japanese	525	10.51
Russian	44	0.88
Total:	4,996	100.00

Madrid Agreement Concerning the International Registration of Marks

Registration of Marks and Connected Tasks. WIPO continued to perform the tasks provided for in the Madrid Agreement. In 1984, the total number of registrations effected increased to 8,246. To this figure should be added 4,799 renewals under the Nice and Stockholm Acts of the Madrid Agreement. The total number of registrations and renewals effected during the period under consideration was therefore 13,045, as compared with 12,928 in the previous year. The total number of changes recorded in the International Register of Marks increased to 17,501, as compared with 14,536 in tbe previous year.

A second step in the computerization of administrative functions under the Madrid Agreement was defined in respect of the treatment of changes and refusals of protection; in its first phase, the computerization only concerned new registrations and renewals. The programing work concerning the second phase was undertaken.

On the closing of the accounts for 1984 of the Madrid Union (Marks), the member States received the following amounts, in Swiss francs, as their part in the supplementary and complementary fees:

Algeria	137,326.82
Austria	477,135.27
Benelux	979,974.28
Czechoslovakia	449,544.06
Democratic People's Republic of Korea	155,640.12
Egypt	503,375.90
France	423,690.20
German Democratic Republic	263,850.70
Germany (Federal Republic of)	528,021.41
Hungary	473,736.72
Italy	454,823.56
Liechtenstein	130,565.11
Monaco	261,587.12
Morocco	125,802.68
Portugal	732,842.27
Romania	448,762.07
San Marino	92,716.53
Soviet Union	213,349.90
Spain	798,829.64
Sudan	80,302.17
Switzerland	463,110.93
Tunisia	122,597.85
Viet Nam	581,059.77
Yugoslavia	537,852.92
Total:	9,441,498.00

Several member States use part of these amounts for the payment of their contributions to the budgets of Unions administered by WIPO other than the Madrid Union.

Publications and Trademark Search Service. The review *Les Marques internationales,* containing the publication of registrations of marks, renewals and changes recorded in the International Register, continued to appear each month. Since January 1981 it has been published in a regular edition and in microfiche form. In addition, a collection of the review for the years 1963 to 1980 in microfiche form has been established. That collection may be obtained for the price of 2,200 Swiss francs.

WIPO continued to maintain its *Trademark Search Service,* a service open to the public for identifying identical or similar marks among those registered. The total number of trademark searches carried out during 1984 was 1,949 as compared with 2,208 in the previous year.

The Hague Agreement Concerning the International Deposit of Industrial Designs

Receiving Industrial Designs and Connected Tasks. WIPO continued to perform the tasks provided for in

the Hague Agreement, in particular the registration and monthly publication (in the periodical *International Designs Bulletin/Bulletin des dessins et modèles internationaux*) of industrial designs deposited with it. In 1984, the total number of international deposits was 1,936 and the total number of prolongations and renewals was 646, as against 2,038 and 636, respectively, in the previous year.

Lisbon Agreement for the Protection of Appellations of Origin and their International Registration

Registration of Appellations of Origin and Connected Tasks. In 1984 no application was filed for the registration and publication (in *Les Appellations d'origine*) of an appellation of origin under the Lisbon Agreement.

General Studies

The Patentability of Methods of Therapeutic Treatment of the Human Body—A Comparative Survey

Y. TSUR*

This article examines Israeli patent law as well as the statutes and case law of other countries with regard to the issue of whether it is possible to obtain a patent on a method of therapeutic treatment of human beings.

Legislation and Case Law in Israel

Section 7 of the Israeli Patents Law, 1967 states:

> "Notwithstanding the provisions of Section 2, no patent shall be granted for—
> (1) a method of therapeutic treatment of the human body."

The scope of this prohibition has yet to be defined by the courts. On only one occasion has an Israeli court considered the issue of the patentability of a method of therapeutic treatment of the human body. *The Wellcome Foundation Ltd. v. Plantex Ltd. and Another*[1] was an infringement case before the Supreme Court acting as a High Court of Civil Appeal. The patent concerned a pharmaceutical compound for the treatment of gout comprising a known compound. The appellants objected to the patent stating that, because the invention merely consisted in the finding of a new use for an old and known compound, the patent was actually directed at the method of treatment itself and as such was unpatentable.

The patent in issue had been granted prior to 1968 and the new Patents Law could not be applied to the case. The court examined the previous law, the Patents and Designs Ordinance, 1924 (hereinafter the "Ordinance"), finding that it contained no provisions regarding the subject. In the absence of any statutory directives, the court carefully considered the issue and two different opinions were expressed.

Judge Witkon began his opinion by noting that in the administration of the Ordinance the courts are guided by the United Kingdom law on patents. Before reaching any conclusions, he therefore carefully reviewed both the U.K. statutory law and the development of English common law on the subject.

After examining the United Kingdom Patents Act 1949, he found that the prohibition in England against methods of treatment of the human body was not based on any explicit statutory provision.[2] Rather the prohibition was based on a long established practice of the United Kingdom Patent Office. This practice initially developed at a time when the U.K. case law took an exceedingly narrow view of what constituted an "invention" under the "manner of new manufacture" test set out in Section 101 of the Patents Act 1949.

Judge Witkon's examination of the more recent English case law demonstrated that this narrow construction was no longer accepted. He concluded by rejecting the prohibition against patents for methods of therapeutic treatment as both undesirable and illogical and stated as follows:

> "(b) The rule by which no patent is granted for a method of therapeutic treatment of the human body is not at all desirable. There is no logic in such an exclusion as long as it is lawful to obtain a patent on a pharmaceutical product, since in both cases there is an equal need for patent protection. This was stated in *Schering AG's Application* (1971) R.P.C. 337 but it was nevertheless held there that such was the law in England in view of section 41 of the U.K. Patents Act 1949 which enables compulsory licences to be granted in respect of food and medicine but not in respect of a therapeutic method.
>
> "This does not apply in our country because in the Patents and Designs Ordinance (which is applicable to the present patent and not the Patents Act, 1967) there is no corresponding compulsory licence provision. There is thus no ground, either in law or in logic, for holding that a method of therapeutic treatment is unpatentable and any consideration that at one time might possibly have justified such a holding, is nowadays devoid of any substance. It may certainly not be said that such an invention is not within the realm of economic endeavour in accordance with the test laid down in *N.R.D.C.'s Application* (1961) R.P.C. 134, or that it is within the realm of 'fine art' as distinct from 'useful art'."[3]

Judge Witkon was careful to note that the prohibition in Section 7 of the new Law was not under consideration in the opinion. He did, however, draw some conclusions with respect to this new Law:

> "Let us remember that even if we had to consider the matter under the new Israel Patent Act, 1967, Section 7, the prohibition in that section does not concern a therapeutic product but only a method of therapeutic treatment, and where a pharmaceutical product is concerned which is manufactured on an industrial scale and marketed throughout the world, it is to my mind unrealistic to talk about a method rather than a product."[4]

With regard to this statement, it may be argued that the Judge's contention seems to ignore the central issue. While it is well established that newly discovered phar-

* Commissioner of Patents, Designs and Trade Marks of Israel.

[1] (1974) R.P.C. 514, published in Hebrew in P.D.I. (Supreme Court Judgements), vol. 27, p. 29.

[2] *Ibid.*, p. 524.

[3] Footnote 1, above, pp. 536.

[4] *Ibid.*, p. 537.

maceutical products are patentable, the product in the present case was an old compound. If the invention is viewed exclusively as a pharmaceutical product, the patent must fail on the ground that nothing new was invented. Only when the product is viewed as part of a therapeutic treatment can it satisfy the statutory requirements for patentability. It is thus impossible to confine the discussion to the product rather than the method.

Judge Kahn agreed with Judge Witkon that the Israeli courts were not bound to follow the U.K. law on the subject because of the different statutory provisions in the two countries. He did not, however, agree that the prohibition by which no patents are granted on methods of therapeutic treatment of the human body should be abolished entirely. Rather he felt that the prohibition should be preserved in a restricted scope even with respect to matters where the old Ordinance still applied. He noted that there exist strong reasons against permitting monopolies in areas where human health and life were concerned. This was, in his opinion, the view to which the legislators adhered when they enacted Section 7(1) of the Patent Law. In his conclusion, Judge Kahn adopted what he termed to be a "fair compromise":

> "It is therefore my conclusioo that an iovention by whicb a known substance, a known compositioo or a known device is used for the therapeutic treatment of the buman body is patentable. However, where a substance, composition or device has already been used for the tberapeutic treatment of the human body or where it is obvious on the basis of existing knowledge that they are capable of so being used for the therapeutic treatment of bumans, no patent is to be granted to an inveotor wbo discovers a new and until then unknown use for medical treatmeot. For example, it is possible to grant a patent 10 an inventor who discovers that a known substance, which had been used in the food industry and for which it was not known that it can serve for curing humans, is suitable for the treatment of intestinal diseases. Against this, no patent will be granted to an inveotor who discovered thai a medicine used for the treatment of the kidneys can also serve for the treatment of mental diseases."[5]

Judge Kister concurred with Judge Kahn and further explored the approach of Jewish law and tradition on the subject. Thus, this "fair compromise" position is the law in Israel for pre-1968 pharmaceutical patents consisting of old and known substances proposed for new therapeutic uses. It is worthwhile to note that Judge Kahn, similarly to Judge Witkon, was careful to state that he "did not intend to make any ruling on the construction of Section 7 of the Patent Act, 1967."[6] He was not, however, without hope that this might at some later point emerge as the court's interpretation:

> "Possibly it will be construed as I have proposed above, but we have not been called upon to decide tbis questioo and it will therefore be better to leave it opeo for some future occasion."[7]

[5] *Ibid.*, p. 540.

[6] *Ibid.*, p. 541.

[7] *Ibid.*, p. 541.

Law in the United Kingdom

(i) Under the Patents Act 1949

The Patents Act 1949 contains no explicit provision addressing the issue of methods of therapeutic treatment. Most of the case law on the subject, however, arose when this Act was in force.

Under the Act, the test for whether an invention is patentable was whether it was a "manner of new manufature" under Section 101 of the Law:

> "'[I]nventioo' means any manner of new maoufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies and any new method or process of testing applicable to the improvement or control of manufacture, and includes an alleged invention."

The case law in the United Kingdom as to what constitutes a manner of new manufacture reveals a gradual liberalization of the term. According to the original concept, a process or method was considered to be patentable if it led to the manufacture of an article by a cheaper, better or improved method.[8] The crucial criterion was always: have we as an end result and in consequence of the new process or method arrived at a vendible product or preserved from deterioration a vendible product? In the light of this background the practice developed of considering unpatentable a method of medical treatment of the human body.[9]

As the law progressed, greater doubt was expressed as to the soundness of this rigid construction. This doubt was first expressed in the United Kingdom in the decision in *Swift's Application.*[10] The court there managed to avoid a direct decision as to whether a method of tenderizing meat was a manner of new manufacture by stating that a patent application should not be refused in the first instance unless there existed no reasonable view under which it could be said to be within the ambit of the Patents Act. The court proceeded to discuss recent case law in Australia and New Zealand where the High Courts had given broad construction to the "manner of manufacture" test. In view of those decisions the court stated that it could not be held that no reasonable view existed for considering the invention in the present case within the ambit of the Patents Act. Furthermore, the court discussed the desirability of having a homogeneous development of the law in all countries which had adopted the U.K. system of patent regulation. Thus, without explicitly overruling the vendible product requirement and the narrow approach to manner of new manufacture, the *Swift* decision paved the way for future change.

In *Schering AG's Application,*[11] the court made it clear that it was no longer bound by the restrictive approach which had categorized earlier case law. Judge Whitford stated:

[8] Terrell, *On the Law of Patents* (12th ed., Sectioo 34, p. 12).

[9] *Ibid.*, Sectioo 44, at p. 17.

[10] (1962) R.P.C. 37.

[11] (1971) R.P.C. 337.

"It may be thought surprising that the definition of 'invention' in 1971 should still be based upon words in a statute of 1623, but the policy of the courts has always been to avoid putting too precise an interpretation on the word 'manufacture,' and some observations in the judgment of the High Court of Australia in *N.R.D.C.'s Application* (1961) R.P.C. 134 at 142 are as opposite to the development of law in this country as they are to the development of the law in Australia."[12]

He went on to state:

"Though the test of 'vendible product' may often be a useful test, it has long been accepted that it is not a conclusive test which must be passed if a patent is to result."[13]

Today it is recognized that the courts in the United Kingdom have accepted the broad construction of manner of manufacture first formulated by the Australian High Court in *N.R.D.C.'s Application.*[14] This change in case law, however, has not been accompanied by a release from the restriction against allowing methods of therapeutic treatment of the human body. Despite the fact that this prohibition may have initially developed as an outgrowth of the narrow approach to manner of manufacture, the restriction has since become an accepted, although sometimes questioned, practice in its own right.

In *Eli Lilly's Application,*[15] the court clearly stated that the restriction still applied regardless of other changes in the law. There the claim was in respect of certain known compounds which could be used with a beneficial effect in the symptomatic treatment of various inflammatory conditions. After considering the origin of the principle that there could be no patent for a method of medical treatment of a human being, the court refused to allow the patent to proceed. The court took care to note that the refusal was not based upon the application not involving a method of manufacture but upon such a method of manufacture not being patentable in respect of medical treatment.

In a series of cases the court similarly expressed its adherance to the prohibition.[16] This adherance, however, has not gone unquestioned.

In *Schering AG's Application,*[17] the court's acceptance of the prohibition was largely based on its interpretation of the compulsory license provision in Section 41 of the Act. With regard to its own judgment as to the soundness of this policy, the court stated:

"In the circumstances of today, when it must be recognized that research on an ever-increasing scale at great cost may be, and often is, necessary if certain problems in the field of medical treatment are to be overcome, it may well be desirable that the legislators should review the question as to whether applications for patents for medical treatment generally or to some less, and, if so, to what, extent should be permitted."[18]

Similarly, in *Eli Lilly's Application,*[19] the court regarded the prohibition as "technically anomalous and therefore illogical."[20] It went on to explain that the legal justification appeared to be based on ethics rather than logic. The court adhered to the policy but made it clear that it did so out of respect for the legislative process:

"(1) There is to be a change of policy, which would appear to us to be sensible, this ought in our view to be affected by legislation rather than by interpretation."[21]

Beyond simply questioning the reasoning behind the practice against patents for methods of medical treatment, the courts, while refusing to do away with the prohibition, have continually interpreted it in a narrow fashion making exceptions wherever possible.

In *Schering AG's Application,*[22] a method of contraception comprising the administration of gestagen to a woman in small doses, those doses being sufficient to prevent conception but not to suppress ovulation, was allowed to proceed. Although it was agreed that patents for medical treatment in the strict sense of curing or preventing disease had to be excluded, it was held that the application did not appear to fall within that prohibition. Thus, it was accepted that methods of contraception were not therapeutic methods in the sense that would exclude them from patentability.

In *Bio-Digital's Application,*[23] a claim for a diagnostic method for determining which patients required medical treatment was allowed. Referring to the *Schering* decision the court stated:

"This was dealt with at some length in the *Schering* case *(supra),* and it was there made clear that medical treatment in that sense must be regarded as a narrow term which should be confined to the cure or prevention of disease. I do not think it would be right to regard the method of claim 1 here as falling within the term 'medical treatment' in that sense. In fact the whole process covered by the claim is carried out before the question of whether medical treatment is necessary or not is considered at all."[24]

The courts have also demonstrated a willingness to allow applications where the patent comes in the form of a packaging technique. Implicit in these decisions was the recognition that the packaging may not alone have been sufficient, however; the inventive step consisting of a method of treatment may project on the actual packaging patent. In both *Organan Labaratory Ltd.'s Application*[25] and *Blendax Werke's Application*[26] the court observed that when an applicant has invented a valuable process which owing to the law cannot be claimed as such, he may get a monopoly for the packaging and other articles useful in that process. Thus the applicant can rely on the value of his discovery with a

[12] *Ibid.*, p. 340.

[13] *Ibid.*, p. 341.

[14] (1961) R.P.C. 134.

[15] (1975) R.P.C. 438.

[16] *U.S. Rubber Co.'s Application* (1964) R.P.C. 104; *Upjohn Company (Robert's) Application* (1977) R.P.C. 94.

[17] Footnote 11, above.

[18] *Ibid.*, p. 343.

[19] Footnote 15, above.

[20] *Ibid.*, p. 444.

[21] *Ibid.*, p. 445.

[22] Footnote 11, above.

[23] (1973) R.P.C. 668.

[24] *Ibid.*, p. 674.

[25] (1970) R.P.C. 574.

[26] (1980) R.P.C. 491.

claim that, without the newly discovered process, would have had no subject matter.

Regarding these packaging claims, the courts have, however, placed certain restrictive guidelines in order to prevent each inventor of a new therapeutic method from circumventing the prohibition by merely patenting a package and instructions. It has been held that there is no manner of manufacture in simply patenting a package of pills with instructions as to dosage. Rather, in order to patent such a package it is necessary that there be some qualification on modification so that the pack has a particular shape or construction or is in some way suitable for the special purpose for the material intended to be used.[27]

The distinction between curative effects and cosmetic effects is another ground upon which a court may grant a patent which at first glance may appear to be a method of treatment of the human body. In *Oral Health's (Halstead's) Applications,*[28] claims were rejected both for "a method of removing dental plaque from teeth" and for a "method of cleaning teeth" because such methods covered a curative effect even though directed to the cosmetic effect. It was indicated, however, that the claim to the cleaning of teeth would probably be allowable if it were possible to confine it to the cosmetic effect only.

(ii) Under the Patents Act 1977

The Office practice and common law prohibition against patents for methods of treatment was first given statutory effect in Section 4(2) of the Patents Act 1977:

> "(2) An invention of a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body shall not be taken to be capable of industrial application."

The statute continues in Section 4(3) specifically to exempt new substances or compositions from the prohibition in Section 4(2):

> "(3) Subsection (2) above shall not prevent a product consisting of a substance or composition being treated as capable of industrial application merely because it is invented for use in any such method."

Furthermore, the statute explicitly addresses the patentability of old and known compounds for new uses. Because "new" substances or compounds for methods of therapeutic treatments are patentable under Section 4(3), the issue is treated under the statutory section dealing with what constitutes a "new" invention. Section 2(6) states:

> "(6) In the case of an invention consisting of a substance or composition for use in a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body, the fact that the substance or composition forms part of the state of the art shall not prevent the invention from being taken to be new if the use of the substance or composition in any such method does not form part of the state of the art."

There have been only two reported cases in the U.K. interpreting the new Law. In *Unilever Ltd. (Davis's) Application,*[29] a method for immunizing poultry against coccidios was involved. The applicants argued that the term "therapy" in the statute should be construed narrowly to include curative treatments only. The court refused this construction declaring that the term included such prophylactic treatments as immunizations and vaccination.

With regard to the crucial issue of old and known substances discovered to be useful in new ways, the case of *Sopharma S.A.'s Application*[30] construed Section 2(6) to exclude patents for old and known substances unless the substance was being proposed for use for the first time on the human or animal body.

In *Sopharma,* the applicant claimed a compound as an agent for the treatment of cancer. The examiner had objected to the invention as not being new having regard to a prior publication which described and exemplified the compound as one of the range of compounds to be administered as an anti-inflamatory agent. The applicant conceded that the specification did disclose the use of a compound in a method of treatment. However, it was asserted that the compound should be treated as "new" within Section 2(6) and thus it would fall within the exception for substances or compositions in Section 4(3).

The applicant argued that a substance or composition could be treated as new under Section 2(6) provided that the use of the substance or composition is not known in the same method of therapy, surgery or diagnosis to which the invention under consideration relates, or any method similar to it or obvious in view of it. The examiner disagreed with this view and maintained that a known substance or composition can be taken as new by virtue of Section 2(6) only if the use of that substance or composition is not known in any method of treatment of the human or animal body by surgery, therapy or diagnosis.

The Patent Office held in favor of the examiner. Thus the accepted practice in the U.K. today is in keeping with the majority opinion expressed by Judge Kahn in *The Wellcome Foundation Ltd. v. Plantex Ltd. and Pharmaplantex Ltd. and Another.*[31] The only difference is that Judge Kahn's decision involved only the treatment of humans by curative methods; it did not discuss the treatment of animals or surgical or diagnostic methods.

Because there are no other published decisions construing the new provisions, the degree to which courts will adhere to prior case law has not yet been determined. From the face of the statute, however, it is clear that the exceptions made in prior cases regarding methods of treatment of animals and diagnostic methods will no longer be recognized. With respect to

[27] *Ciba-Geigy AG (Durr's) Applications* (1977) R.P.C. 83 at 88.

[28] (1977) R.P.C. 612.

[29] (1983) R.P.C. 219.

[30] (1983) R.P.C. 195.

[31] Footnote 1, above.

contraceptive methods, packaging techniques, cosmetic treatments and the multitude of other issues which may arise in the context of the "medical treatment" area, it is likely that the trend of the case law prior to 1977, away from a broad construction of the prohibition, will continue.

Law in Australia

The Patents Act 1952-1973 of Australia does not directly address the issue of methods of therapeutic treatment. The Act defines invention as follows:

> "'[I]nvention' means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies, and includes an alleged invention."

It is also worth noting that there is no provision in the statute providing for compulsory licenses relating to food or medicine similar to Section 4 of the United Kingdom Act.

The Australian High Court's decision in *N.R.D.C.'s Application*[32] formed the turning point in the case law development of the term "manner of new manufacture." The invention in respect of which the patent was sought in the case concerned a process for the eradication of weeds from certain crop areas. The substance proposed was not novel and the invention lay in the discovery that this substance was useful for this purpose.

The court examined thoroughly the term "manner of manufacture," rejecting the view that this term is confined to the manual or mechanical production of the tangible goods. The court stressed the gradual growth of the law from the old limited concept of vendible product. The test should be whether the process offers some advantage which is material in the sense "that its value to the country is in the field of economic endeavour."

The court summed up the matter as follows:

> "What is meant by a 'product' in relation to a process is only something in which the new and useful effect may be observed. Sufficient authority has been cited to show that the 'something' need not be a 'thing' in the sense of an article; it may be a physical phenomenon in which the effect, be it creation or merely alteration may be observed.... It is, we think, only by understanding the word 'product' as covering every end produced, and treating the word 'vendible' as pointing only to the requirement of utility in practical affairs, that the language of Morton, J.'s rule may be accepted as wide enough to convey the broad idea which the long line of decisions on the subject has shown to be comprehended by the Statute."[33]

In *Joos v. Commissioner of Patents*,[34] the court was confronted with the argument that a process which involved the application of a chemical to improve the strength and elasticity of kerationcis material, especially the human hair and nails, was not manner of manufacture. Describing the *N.R.D.C.* case as a watershed decision the court had little trouble finding that the process involved a manner of manufacture:

> The point is that a process to fall within its limits of patentability which the context of the Statute of Monopolies has supplied must be one that offers some advantage which is material, in the sense that the process belongs to a useful art as distinct from a fine art (see *Re Virginia-Carolina Chemical Corporation's Application*)—that its value to the country is in the field of 'economic endeavour.' In my opinion, that economic value will not always be directly supplied by the nature of the activity which would utilize the process. In the *N.R.D.C.* case, it was the economic advantage to be had from a reduction of weeds in grain crops... which provided the relevant commercial significance. In this case, the processes are to be used io what cannot be described otherwise than as a commercial activity of hairdressing, a sector of activity which accounts, I imagine, for a great deal of employment, I could not assign the skill of the hairdresser to the area of the fioe arts and have little difficulty io placing it in the area of the useful arts. In my opinion, it is an activity in the field of economic endeavour and has commercial significance as those expressions ought to be understood in relation to the grants of pateots. Therefore, it could not be said, in my opinion, that the application should not be allowed to proceed because clearly it had no commercial significance in the relevant respect."[35]

Similar to the United Kingdom, the liberalization of the manner of manufacture test has not meant the outright rejection of the prohibition against methods of therapy in Australia. However, the High Court has made it clear that the prohibition should be narrowly applied.

The *Joos* case was the only decision where this issue was directly raised. There the court avoided a decision on the issue by being able to distinguish between a process for the medical treatment of a human being that was cosmetic in nature in contradistinction to a prophylactic or therapeutic medical process. The current trend in the Australian practice is best summed up by the following passage from *Joos:*

> "In my opinion, if it be accepted that claims for medical treatment of human disease, malfunction, disability or incapacity of the human body or of any part of it cannot satisfy the requirements of an invention under the Act, the class of such claims should be narrowly defined. I can find no warrant in public policy or in the decided cases for including in that Class processes and methods for improving, or at any rate for changing the appearance of the human body or of parts of it. Such cosmetic processes and methods are, in my opinion, not of a like kind with medical prophylactic or therapeutic processes or methods."[36]

The court later, after referring to the process of cosmetic treatment, stated:

> "In my opinion, it does not fall within the class of medical treatment which, for the purposes of this case, may be taken to be an inappropriate subject to the grant of letters patent."[37]

From the wording of these statements, it is arguable that the Chief Justice had some doubt as to the validity of any prohibition at all. He did not explicitily recognize the prohibition, but rather in referring to it he stated "if it be accepted that..." and again later accepted it "for the purposes of this case."

However, at the present time the prohibition against methods of medical treatment is in force in Australia. But it is unclear whether the practice will remain in force if and when the court is confronted with a direct decision on the merits. Until that time, it is clear that the courts will continue narrowly to define the prohibition.

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[32] Footnote 14, above.

[33] *Ibid.*, p. 145.

[34] (1973) R.P.C. 59.

[35] *Ibid.*, p. 67.

[36] *Ibid.*, p. 66.

[37] *Ibid.*

Law in New Zealand

The Patents Act 1953 of New Zealand, like that of Australia, does not directly address the issue under discussion. The Act defines "invention" with the identical language used in Section 101(1) of the United Kingdom Patents Act 1949.[38] Moreover, the New Zealand Act also contains language identical to the United Kingdom Act with regard to the compulsory licensing provision.[39]

The New Zealand case law reveals the same progressive approach to the manner of manufacture concept as seen in the United Kingdom and Australia. The meaning of manufacture adopted hy the Australian High Court in *N.R.D.C.* has been followed in New Zealand. The New Zealand High Court, however, has gone further than the United Kingdom and Australian courts and has completely rejected tbe practice against granting a patent for a process of medical treatment.

In *The Wellcome Foundation Ltd. (Hitching's) Application,*[40] the claims were for certain compounds which were directed to a metbod of treating or preventing meningeal leukemia or neoplasm in the hrain. The chemical compounds were known and the examiner rejected the application stating as one of the grounds that the claims were for a method of treatment of man.

The court first established that the application constituted a method of new manufacture as that term is defined in the light of scientific and legal progress. The court then went on to find that there was no statutory provision in New Zealand as well as no principle of law prohihiting the grant of a patent for a process of medical treatment, nor was there any decision of a New Zealand court prohibiting such a grant.

An extensive study of the English and Australian case law led the court to conclude that there was no satisfactory justification for the practice, and long-established practice could not itself provide an adequate hasis. With respect to the argument made in the *Schering* case that due to the language of the compulsory license provision, specifically including foods or medicine but making no mention of therapeutic methods, it must be assumed that the legislators adopted this prohihition, the court stated:

> "The basis for arriving at that conclusion was that the statute does not mention processes for medical treatment, and no compulsory licence could be granted in respect of them. If, it was said, at the time when the legislation was passed it had been thought that claims of this nature could be granted under the Patents Act, the Sectioo would undoubtedly have been extended so as to have effect in relation to patents in force in respect of processes for medical treatment."[41]

The court rejected the distinctions made in the *Schering* and *Joos* cases between a contraceptive process and a cosmetic process as opposed to medical treatment to cure or prevent disease as distinctions without a difference:

> "In both cases, in my view, the courts establish distinctions without a difference. Both cases were ones where chemical substances were applied to the human body—in one case, externally; in the other, internally—and in both cases the chemical produced a result in a changed condition of the body. Is there any justification in law or in logic to say that simply because, on the one hand, substances produce a cosmetic result or a functional result as opposed to a curative result, the one is patentable and the other is not? I think not. The court must now take a realistic view of this matter in the light of current scientific developments and legal progress. The law must meet the needs of the age. I feel oo hesitation in passing over the barrier of so called non patentability and holding that a process for the medical treatment strictly called of a human being may be the subject of a patent under our New Zealand Patents Act 1953."[42]

The notion that the prohibition might be based on ethical prohibitions was flately rejected by the court. Instead the opinion argued that the practice was based on the earlier case law's narrow definition of manner of manufacture and since that foundation has been removed the courts have been grasping for some other grounds. However, in the opinion of the court none existed and there was no reason to halt the development of the law relating to the patentahility of processes for medical treatment.

Conclusion

The prohibition against granting patents for methods of medical treatment, though criticized and limited in scope, has remained in force in the United Kingdom and throughout most of Europe. It should be noted that New Zealand, whicb has taken the uncommon approach of completely abolishing the restriction, has no statutory provision directly prohihiting such patents. Although such an approach was favored by Justice Witkon, the presence of the 1967 statutory directive ensures tbat the prohibition will be practiced, at least to some extent, in Israel.

The Israeli Law, however, is not nearly as specifically worded as the United Kingdom Act. Thus, the extent of impact which the law will have in Israel will be largely determined by the courts. *The Wellcome Foundation* decision together with the U.K. case of *Sopharma* appear to establish what the position of the courts will be with respect to patents for known compositions or substances where new uses are discovered.[43]

With regard to issues of diagnostic methods, contraceptive methods and treatments of animals, the current practice of the Israeli Patent Office bas been to permit patents in these areas. There have been no recorded decisions where tbose practices have been challenged, however. Future cases dealing with these issues as well

[38] Patents Act 1953, Section 2(1).

[39] *Ibid.*, Section 51(1).

[40] (1980) R.P.C. 305.

[41] *Ibid.*, p. 338.

[42] *Ibid.*, p. 341.

[43] See, however, Decisions Gr 01/83, 05/83 and 6/83, dated December 5, 1984, of the Enlarged Board of Appeal of the European Patent Office.

as with questions of packaging, cosmetic methods and other new issues which may arise will call upon the courts to determine the scope of the law. The vague wording of the statute will permit the courts to interpret the law in an exceedingly narrow fashion if they so choose.

The degree to which the courts will limit the scope of the restriction will depend largely on their analysis of the need for an exclusion at all. Judge Kahn, in *The Wellcome Foundation* decision, believed that there were sound ethical reasons for maintaining the restriction:

> "There exist grave reasons against the creation of a monopoly by a patent in respect of medical treatment. We are confronted here with saving human life or alleviating human suffering and one should take great care lest a restriction on the freedom of action of those who treat, caused by patents, should affect human life or health. This also was the view of the Israeli legislators who laid down in section 7 of the Patents Act, 1967 that no patent shall be granted for methods of therapeutic treatment of the human body."[44]

On the other hand, Chief Justice Davidson of New Zealand argued in *The Wellcome Foundation Ltd. (Hitching's) Application* that no ethical justification existed. His arguments were aimed at undercutting those of Judge Kahn. The Chief Justice noted that the Law permits the granting of a patent for a drug. In that case, the inventor has his rights to it protected and it can be employed in medical treatment only if made available to the medical profession by reason of licensing or compulsory licensing. With regard to methods of medical treatments he argued:

> "If a process for medical treatment is invented can that not be licensed in the same way and cannot the legislature amend the statute to provide for compulsory licences if it is thought desirable to do so? Is any member of the public going to be deprived of a drug under the existing law?"

[44] Footnote 1, above, p. 539.

Chief Justice Davidson's arguments are fairly persuasive. The similarity between new drugs and new medical processes with respect to the ethical consideration of "saving human life and alleviating human suffering" is quite apparent. In view of this recent New Zealand decision, the Israeli courts may be inclined to view the 1967 statutory restriction with the same critical approach demonstrated by Judge Witkon. Although only the legislature may repeal the statute, the courts nonetheless can find a multitude of ways to avoid the ambit of the provision. Contraceptive, cosmetic, diagnostic and perhaps even prophylactic (immunization and vaccination) methods can be found not to be "therapeutic treatments of the human body." Moreover, the courts can readily accept application for packaging techniques and whatever other claims clever inventors propose in order to avoid the statutory restriction.

Should the Israeli courts accept the prohibition on a positive practice, it is still likely that they will construe it somewhat narrowly. The reason for the practice must be found in Judge Kahn's arguments and thus the prohibition should be limited to therapeutic treatments directly "saving human life or alleviating human suffering." Under such an analysis contraceptive and cosmetic methods would not be viewed as therapeutic treatments within the meaning of the statute. However, it can certainly be argued that diagnostic methods as well as prohpylactic treatments should be considered within the ambit of the Law in view of the ethical justification of the statute. Moreover, under the Kahn rationale, the courts would be less accepting of packaging patents and other claims which merely serve as covers for new methods of treatment.

Whatever the approach of the courts turns out to be, it is clear that Section 7 will be construed in a narrow fashion. The question that has yet to be answered is: how narrow?

News from Industrial Property Offices

CHINA

Director, Trademark Office.
State Administration for Industry and Commerce

We have been informed that Mr. Hao Zhixin has been appointed Director of the Trademark Office of the State Administration for Industry and Commerce.

Calendar of Meetings

WIPO Meetings

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

1985

May 6 to 17 (Geneva) – Permanent Committee on Patent Information (PCPI): Working Gronp on Search Information

Jone 6 to 14 (Geneva) – Permanent Committee on Patent Information (PCPI): Working Gronps on Planning and on Special Questions

June 17 to 25 (Paris) – Berne Union: Executive Committee (Extraordinary Session) (sitting together, for the discussion of certain items, with the Intergovernmental Committee of the Universal Copyright Convention)

Jone 26 to 28 (Paris) – Rome Convention: Intergovernmental Committee (Ordinary Session)(convened jointly with ILO and Unesco)

July 8 to 12 (Geneva) – Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions

September 11 to 13 (Geneva) – Permanent Committee on Patent Information (PCPI): Working Gronp on Patent Information for Developing Coontries

September 16 to 20 (Geneva) – Permanent Committee on Patent Information (PCPI) and PCT Committee for Technical Cooperation (PCT/CTC)

September 23 to October 1 (Geneva) – Governing Bodies (WIPO General Assembly, Conference and Coordination Committee; Assemblies of the Paris, Madrid, Hagne, Nice, Lisbon, Locarno, IPC, PCT, Budapest, TRT and Berne Unions; Conferences of Representatives of the Paris, Hague, Nice and Berne Unions; Executive Committees of the Paris and Berne Unions; Committee of Directors of the Madrid Union; Council of the Lisbon Union)

October 7 to 11 (Geneva) – Permanent Committee on Patent Information (PCPI): Working Group on General Information

October 21 to 25 (Geneva) – Nice Union: Committee of Experts

November 4 to 30 (Plovdiv) – WIPO/Bnlgaria: World Exhibition of Young Inventors and International Seminar on Inventiveness for Development Purposes (November 12 to 15)

November 18 to 22 (Geneva) – Permanent Committee on Patent Information (PCPI): Working Gronps on Special Questions and on Planning

November 25 to December 6 (Geneva) – Permanent Committee on Patent Information (PCPI): Working Gronp on Search Information

November 26 to 29 (Geneva) – Committee of Experts on a Treaty fot the Protection of Integrated Circuits

December 9 to 13 (Geneva) – Committee of Experts on the International Registration of Marks

UPOV Meetings

1985

May 8 to 10 (Wageningen) – Technical Working Party on Automation and Computer Programs

June 4 to 7 (Hanover) – Technical Working Party for Agricultural Crops, and Subgroup

June 18 to 21 (Aarslev) – Technical Working Party for Fruit Crops, and Subgroup

June 24 to 27 (Aars and Aarslev) – Technical Working Party for Ornamental Plants and Forest Trees, and Subgroups

July 8 to 12 (Cambridge) – Technical Working Party for Vegetables, and Subgroup

October 14 (Geneva) – Consultative Committee

October 15 and 16 (Geneva) – Meeting with International Organizations

October 17 and 18 (Geneva) – Council

November 12 and 13 (Geneva) – Technical Committee

November 14 and 15 (Geneva) – Administrative and Legal Committee

Other Meetings Concerned with Industrial Property

1985

May 13 to 19 (Rio de Janeiro) — International Association for the Protection of Industrial Property: Executive Committee

May 29 (Paris) — Institut de Recherche en Propriété Intellectuelle Henri Desbois: Symposium on Patent Licenses and Community Law

June 3 to 7 (Augsburg) — International Federation of Industrial Property Attorneys: World Congress

June 4 to 7 (Strasbourg) — Center for the International Study of Industrial Property: Seminar on Transfer of Technology (first module: Nature of License Contracts and of the Transfer of Technology)

June 11 to 14 (Munich) — European Patent Organisation: Administrative Council

September 2 to 6 (Budapest) — Hungarian Group of the International Association for the Protection of Industrial Property and the Hungarian Association for the Protection of Industrial Property: Sixth International Conference on "New Technical Tendencies and Industrial Property Protection"

September 16 to 18 (Geneva) — International Association for the Advancement of Teaching and Research in Intellectual Property: Assembly and Annual Meeting

September 24 to 27 (Strasbourg) — Center for the International Study of Industrial Property: Seminar on Transfer of Technology (second module: Strategy and Procedures for the Transfer of Technology)

September 27 and 28 (Wiesbaden) — International League for Competition Law (formerly International League Against Unfair Competition): *Journée d'études*

October 10 and 11 (Harrogate) — Pharmaceutical Trade Marks Group: 31st Conference on "Generic Prescribing—12 Diverse but Authoritative and Informed Viewpoints"

December 3 to 6 (Munich) — European Patent Organisation: Administrative Council

1986

June 8 to 13 (London) — International Association for the Protection of Industrial Property: XXXIII Congress