

# Industrial Property

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**SOVIET UNION**

Statute on Trademarks (adopted by the USSR State Committee for Inventions and Discoveries on January 8, 1974, and amended by the amendments and additions adopted by the USSR State Committee for Inventions and Discoveries on January 22, 1976, the Decrees of the USSR State Committee for Inventions and Discoveries No. 4(7) of March 22, 1979, and No. 1(15) of July 9, 1982, Order No. 95 of October 12, 1982, and Decrees No. 2(5) of April 14, 1983, and No. 6(15) of June 11, 1987) (*Replacement sheets*) .....

Text 3-001

## Notifications Concerning Treaties

### Budapest Treaty

#### Amendment of the Communication of July 12, 1988

#### AUSTRALIAN GOVERNMENT ANALYTICAL LABORATORIES (AGAL)

(Australia)

The following written communication addressed to the Director General of WIPO by the Government of Australia, amending its previous communication dated July 12, 1988, by which the Australian Government Analytical Laboratories (AGAL) acquired the status of international depository authority under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure was received on March 22, 1990:

I have the honour to refer to the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure done at Budapest on 28 April 1977 ("The Treaty") and to the Written Communication of the Government of Australia, dated 12 July 1988, relating to the Australian Government Analytical Laboratories ("AGAL"). I have the further honour to advise that the following amended communication should be considered as Australia's nomination of AGAL as an International Depository Authority ("IDA").

AGAL's function as an IDA in accordance with Article 7 of the Treaty is set out below. The Government of Australia furnishes its assurances that AGAL complies with and will continue to comply with the requirements specified in Article 6(2) of the said Treaty.

AGAL, which is part of the Commonwealth Department of Administrative Services, has had a continuous existence under various names since it was established in 1901 at the time of Federation of Australia.

The New South Wales Regional Laboratory, located at 1 Suakin Street, Pymble, NSW, 2073, Australia, through which AGAL intends to discharge its responsibilities as an IDA, contains a suite of laboratories specifically designed and built to allow microbiological work of the highest

standard to be performed. AGAL has all the facilities necessary for the culturing, checking and long-term preservation of microbial cells. In addition, a staff of two has been assigned to fulfil the various specialised scientific services required to ensure that deposits are maintained viable and uncontaminated. A Scientific Advisory Committee, which includes the Senior Microbiologist in charge of the Collection, will be responsible to the Australian Government Analyst for the operation of AGAL as an IDA.

As a scientific institution AGAL necessarily performs and will continue to perform its function in an impartial and objective manner.

For the purpose of deposit, AGAL will be available to any depositor under the same conditions.

AGAL will accept for deposit bacteria (including actinomycetes), yeasts and fungi, other than known human and animal pathogens, that can be preserved without significant change to their properties by the methods of preservation in use (these are currently freezing and freeze drying). Microorganisms accepted for deposit by AGAL will be examined for viability and stored as prescribed in the Regulations under the Treaty. AGAL will not at this time accept for deposit animal, plant, algal and protozoal cultures, cultures of viral, rickettsial and chlamydial agents, microorganisms which may require, in the view of the curator, special attention to handling and preparation for storage.

AGAL will, in accordance with the Regulations, issue to the depositor a receipt and any required viability statement.

Patent cultures will be stored in a locked refrigerator and will be subject to regular audit. Only authorised staff will have access to them. AGAL will comply with the secrecy requirements prescribed in the Regulations.

AGAL will also furnish samples of deposited microorganisms under the conditions and in conformity with the procedures prescribed in the Regulations.

In accordance with Rule 6.3(a) of the Regulations, AGAL requires before it will accept microorganisms for deposit:

- (i) that a deposit of a microorganism should be in an adequate form and adequate quantity to enable AGAL to carry out properly its duties under the Regulations;

- (ii) that the written statement referred to in Rule 6.1(a) or 6.2(a) be drafted in English;
- (iii) that the fee for storage referred to in Rule 12.1(a)(i) be paid; and
- (iv) that the depositor complete an Application Form for the purposes of the administrative procedures of AGAL.

The fees, in Australian dollars, that AGAL will charge for storage, viability statements and furnishing of samples of microorganisms are set out below:

For the storage of the microorganism in accordance with the Treaty \$750

For the issue of a viability statement in those cases in which, in accordance with Rule 10.2, a fee may be charged 90

For the furnishing of a sample in accordance with Rules 11.2 and 11.3 60

(The fees will be payable to the Australian Government Analytical Laboratories and will be reviewed annually.)

The official language of AGAL is English.

[End of text of the communication of the Government of Australia]

*Budapest Communication No. 61 (this Communication is the subject of Budapest Notification No. 88, of April 2, 1990).*

# WIPO Meetings

## Paris Union

### Committee of Experts on the Harmonization of Laws for the Protection of Marks

First Session  
(Geneva, November 27 to December 1, 1989)

#### NOTE\*

#### Introduction

The Committee of Experts on the Harmonization of Laws for the Protection of Marks (hereinafter referred to as "the Committee of Experts") held its first session in Geneva from November 27 to December 1, 1989.

The following States members of the Paris Union were represented at the session: Algeria, Argentina, Austria, Belgium, Brazil, Bulgaria, Cameroon, Canada, China, Democratic People's Republic of Korea, Denmark, Egypt, Finland, France, German Democratic Republic, Germany (Federal Republic of), Greece, Hungary, Iraq, Ireland, Italy, Japan, Libya, Mexico, Netherlands, Nigeria, Norway, Portugal, Republic of Korea, Senegal, Soviet Union, Spain, Sri Lanka, Sweden, Switzerland, Tunisia, Turkey, United Kingdom, United States of America, Yugoslavia (40). In addition, the European Communities (EC) were represented.

The following States members of WIPO were represented by observers: Chile, India, Panama (3). Representatives of two intergovernmental organizations and 24 non-governmental organizations also participated in an observer capacity. The list of participants follows this Note.

The discussions of the first session of the Committee of Experts were based on the following documents prepared by the International Bureau of WIPO: "Draft Provisions for a Proposed Treaty on the Harmonization of Laws for the Protection of Marks" (document HM/CE/I/2), "Proposed Further Contents of the Draft Treaty" (document HM/CE/I/3), and "Information on Provisions in

National Laws Corresponding to the Draft Provisions for a Proposed Treaty Contained in Document HM/CE/I/2" (document HM/CE/I/INF/1 Rev.).

The first two documents are quoted hereafter together with the relevant portions of the report of the first session of the Committee of Experts (document HM/CE/I/4).

After hearing general statements from a number of delegations and representatives of intergovernmental and non-governmental organizations, the Committee of Experts discussed the questions contained in document HM/CE/I/2 and set out below.

#### Preamble

The Preamble of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

*"The Contracting States,*

*Desiring to promote, on the international level, increased legal security and greater simplicity in the legal regime governing marks,*

*Considering that adherence to the same principles on the essential features of the legal regime governing marks will effectively contribute to the achievement of such increased legal security and greater simplicity,*

*Have concluded the present Treaty, which constitutes a special agreement within the meaning of Article 19 of the Paris Convention for the Protection of Industrial Property."*

The portion of the report of the Committee of Experts concerning the discussion of the Preamble reads as follows:

"The Delegation of India stated that the Preamble suggested that the Treaty would be

\* Prepared by the International Bureau.

open only to States party to the Paris Convention. That Delegation was, however, interested in the Treaty being open also to States that were not party to that Convention; it would be in the interests of industrial property in general and of marks in particular for the Treaty to be established on the broadest possible basis. In view of that, it might not be necessary to have the reference to Article 19 of the Paris Convention in the third paragraph of the Preamble.

The Delegation of India further considered that a sentence should be added to the Preamble similar to that proposed by the Delegation of Brazil, on behalf of the Latin American Group, at the fifth session (second part, in December 1988) of the Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions, which was worded as follows: 'Taking into account differences in the levels of development of the Contracting States' (see document HL/CE/V/7, paragraph 9).

That position was supported by the Delegations of Cameroon and of Senegal who also wished that the Treaty should have the broadest possible basis and that the Preamble should take into account the special situation of the developing countries.

The Delegation of the European Communities shared the view expressed by India as regards the possibility of acceding to the Treaty even if one was not a party to the Paris Convention. It questioned whether the reference to Article 19 of the Paris Convention was necessary and what its legal effects were. In any event, the Delegation of the European Communities emphasized that all its Member States were party to the Paris Convention and that it strictly followed the provisions of the Paris Convention in the elaboration of its own legislation.

The Delegation of the United States of America was of the opinion that the Paris Convention constituted a minimum for the protection of marks and that membership of the Paris Union should be a condition for acceding to the Treaty. It spoke in favor of the reference made to Article 19 of the Paris Convention and stated that the competent authorities of its country were looking at the possibility of accession by certain intergovernmental organizations to the treaties on the harmonization of laws currently under preparation within WIPO.

As for the request by India that the Preamble should state that account was to be taken of the level of development of the Contracting States, the Delegation of the United States of America held that if there were to be different standards for the different member States, that would negate the very principle of harmonization.

The Delegation of the Federal Republic of Germany stressed the importance of the reference made in the Preamble to Article 19 of the Paris Convention. Traditionally, the special agreements (such as the Madrid Agreement, the Nice Agreement or the Lisbon Agreement) were concluded only between member States of the Paris Convention. It pointed out, however, that new treaties such as the Madrid Protocol permitted accession by intergovernmental organizations that could not become party to the Paris Convention.

The Delegation further stated that, as regards the States not party to the Paris Convention, the fact that they did not recognize the basic principles of that Convention, such as national treatment or priority right, could make it difficult for them to apply the provisions of the Treaty. It was therefore necessary to look at the possibilities of removing the obstacles faced by States that were not yet party to the Paris Convention, for example, by stipulating that accession by such States to the Treaty would imply that those States would be bound by the provisions of the Paris Convention in respect of marks.

As for the request made by India and other delegations that the Preamble should state that account was to be taken of the level of development of the Contracting States, the Delegation of the Federal Republic of Germany was aware of the special situation of certain developing States, but was not convinced of the existence of situations that would justify, in respect of marks, special treatment for the developing countries. It would therefore be preferable, from its point of view, to re-examine the matter once the final text of the Treaty was available and it was possible to evaluate the need to introduce a special provision in the Preamble.

The Delegation of India nevertheless wished to point out that, in its opinion, the reference in the Preamble to the level of development of member States would not affect the efforts towards harmonization. That kind of reference would provide the correct context and a measure of guidance for the harmonization exercise.

The Delegation of Portugal, for its part, stated that it viewed the efforts towards harmonization positively, that it was pleased that States that were not party to the Paris Convention were participating in the discussions and that it was to be hoped that they would accede to the Treaty. As far as the European Communities were concerned, it hoped that the best possible solution could be found to the problems that arose, while noting that the 12 Community Member States were already party to the Paris Convention.

In conclusion, it was agreed that the question of mentioning the special interests of the developing countries would have to be decided once

the content of the Treaty was known. However, at the request of the Delegation of India, it was accepted that the sentence that the Delegation wished to include in the Preamble should be shown within square brackets."

#### *Article 1: Establishment of a Union*

Article 1 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

*"The States party to this Treaty (hereinafter called 'the Contracting States') constitute a Union for the purposes of this Treaty."*

The portion of the report of the Committee of Experts concerning the discussion of Article 1 reads as follows:

"The Delegation of the European Communities wished that the possibility of being party to the Treaty might be available not only to States but also to intergovernmental organizations having competence in trademark matters. The Delegation recalled what the competence of the European Communities was under the First Directive of the Council of the European Communities of December 21, 1988, to approximate the laws of the Member States relating to trade marks (hereinafter referred to as the 'EC Directive'), and pointed out that each of the two treaties that had been adopted in Washington in May 1989 and in Madrid in June 1989 gave certain intergovernmental organizations the possibility of becoming contracting parties of the treaties in question.

The International Bureau, after having recalled that the Governing Bodies of WIPO had decided in September 1989 to give the European Communities the status of Member Delegation in the present Committee of Experts, said that the words 'States party to this Treaty' would be replaced throughout the Treaty with 'Contracting Parties of the Treaty.'

One delegation further expressed the wish that the expression 'Union for the purposes of this Treaty' be made more precise, and that the objectives of the Union be specified, as in the case of the PCT and the Madrid Agreement."

#### *Article 2: Preservation of Rights under the Paris Convention*

Article 2 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

*"No provision of this Treaty shall be interpreted as diminishing the protection that any*

*natural person or legal entity has under the Paris Convention for the Protection of Industrial Property."*

The portion of the report of the Committee of Experts concerning the discussion of Article 2 reads as follows:

"The International Bureau, replying to a question raised by a delegation, made it clear that the national treatment principle provided for in the Paris Convention was applicable also, in respect of matters governed by the Treaty, to the nationals of States that were not party to the Treaty."

#### *Article 3: Definition of "Mark" and "Sign"*

Article 3 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

*"(1) [Definition of Mark] 'Mark' shall mean a distinctive sign used or intended to be used for the purpose of identifying on the market certain goods and/or services.*

*(2) [Definition of Sign] (a) For the purposes of paragraph (1), any static indication that can be perceived by the sense of sight shall be considered to be a sign capable of being used as a mark, including, in particular, the following: words (including personal names), pictures, images, designs (including emblems), letters, numerals, colors, three-dimensional forms (including the shape of products and the shape of their packaging and their containers), and any combination thereof.*

*(b) For the purposes of paragraph (1), sounds, including in particular pronounced words and tunes, whether sung or played on instruments, shall also be considered to be signs capable of being used as a mark."*

The portion of the report of the Committee of Experts concerning the discussion of Article 3 reads as follows:

*"Paragraph (1). One delegation, with the support of a number of other delegations and representatives of non-governmental organizations, considered that the essential function of a mark was not to identify certain goods or services but rather to distinguish the goods of one undertaking from those of another. Reference was made in that connection to the definition given by the EC Directive. Some delegations and representatives of observer organizations also pointed out that it was not appropriate to specify in the Article in question that the sign constituting a mark had to be distinctive: the requirement*

formed part of the grounds on which the registration of a mark could be refused, as indicated in Article 6quinquies of the Paris Convention, and it did not seem desirable to mention such things in the actual definition of the mark.

Some delegations and representatives of non-governmental organizations likewise mentioned that the use of, or the intention to use, the sign constituting the mark had no bearing on the definition of the signs eligible for registration.

On a question of drafting, one delegation further wished to have the expression 'and/or' removed from the English version, and replaced with either 'and' or 'or.' It also raised the question why the subject matter dealt with in Articles 3 and 4 had not been included in one and the same Article.

In conclusion, it was recommended that the following text be adopted for further discussion: "'Mark" shall mean a sign capable of distinguishing the goods or services of one undertaking from those of other undertakings.'

*Paragraph (2).* A number of delegations pointed out that the list appearing in subparagraph (a) contained some elements which, under their national legislation, could not be made into marks. Letters, numerals, colors, three-dimensional forms and surnames were mentioned in particular.

Moreover, the expression 'any static indication that can be perceived by the sense of sight' was considered inadequate by some delegations. It was thought preferable to speak of indications capable of being represented graphically, even though it was also pointed out that modern technology made it possible to file non-static indications, by means of video discs for instance. Similarly, the reference to an 'indication that can be perceived by the sense of sight' was considered too restrictive, owing to the fact that one could quite well imagine the filing of marks in Braille for the benefit of the blind. With regard to the terminology used, some delegations pointed out that the distinction between the words 'pictures,' 'images' and 'designs' was not clear, and that the word 'design' was liable to mislead by creating confusion with industrial designs, which enjoyed specific protection.

It was pointed out that the fact of a design being protected by industrial design legislation did not preclude its protection as a mark insofar as it was used as a mark.

As for sound marks, mentioned in subparagraph (b), not only did many laws not provide for their registration, but recording them in a register was considered liable to present difficulties in that they were not always capable of being represented graphically. It was mentioned in that

connection that a noise not susceptible of graphic representation could nevertheless be the subject of a description. Moreover, the delegation of one country that provided for the registration of sound marks pointed out that the filing of the mark in the form of a recorded magnetic tape was recognized by its regulations. The representative of a non-governmental organization further pointed out that the assessment of similarity between sound marks could present offices with particular problems, but it was indicated that new technical means of dealing with that problem did exist, for example, computerized recording.

The question arose whether a list should be drawn up of those signs that the Contracting Parties would be obliged to recognize as marks, subject to their having distinctive character and to the physical feasibility of entering them in the register, and also a list of the signs that the same Contracting Parties would be free either to recognize or not to recognize as being susceptible of use as marks. In that connection a number of delegations and representatives of non-governmental organizations pointed out that the list of signs registrable as marks, subject to their distinctive character, should be as long as possible. One delegation insisted in addition on the fact that due consideration should be given to all the technological progress to be expected as the 21st century drew near, and to the implications that it might have in the trademark field, including the registrability aspect.

It was, however, generally considered that it was not appropriate, at the present stage, to provide for any obligation concerning the registration of olfactory marks.

The Chairman concluded that, with regard to sound marks, there was some difference of opinion, with certain delegations considering that there were practical problems not only in the means of effecting the filing, but also in the publication of the mark and the assessment of similarity. On the other hand, it was generally acknowledged that the shape of the product had to be able to constitute a mark, unless it was a purely functional shape, and that advertising slogans, where they were used as trademarks, had to be eligible for registration as marks. In that connection the Chairman stressed that the Treaty had to make allowance for the foreseeable development of national legislation and of trademark administration systems."

#### *Article 4: Other Definitions*

Article 4 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:



"For the purposes of this Treaty, unless expressly stated otherwise:

(i) 'industrial property office' means the governmental authority entrusted with the registration of marks by a Contracting State and the regional intergovernmental authority entrusted with the registration of marks by several States at least one of which is a Contracting State;

(ii) references to a 'registration' shall be construed as references to a registration of a mark by an industrial property office;

(iii) references to an 'application' shall be construed as references to an application for the registration of a mark by an industrial property office;

(iv) references to 'national law' shall be construed as references also to any legal provisions of supranational or intergovernmental organizations governing the protection and/or registration of marks;

(v) 'Paris Convention' means the Paris Convention for the Protection of Industrial Property;

(vi) 'International Classification' means the International Classification adopted under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks;

(vii) 'priority date' means the filing date of the application whose priority is claimed according to Article 4 of the Paris Convention;

(viii) 'Union' means the Union referred to in Article I;

(ix) 'Assembly' means the Assembly of the Union;

(x) 'Organization' means the World Intellectual Property Organization;

(xi) 'International Bureau' means the International Bureau of the Organization;

(xii) 'Director General' means the Director General of the Organization."

The portion of the report of the Committee of Experts concerning the discussion of Article 4 reads as follows:

"Item (i). After discussion it was decided that the words 'industrial property office' would be replaced with 'office.'

One delegation wished to have a broader definition that would cover all regional offices.

It was further pointed out that it would be desirable that the wording of item (i) allow the case of marks registered under the Madrid Agreement to be taken into account.

Another delegation wished to have the word 'and' in the second line of item (i) replaced with 'or.'

Items (ii) and (iii). The expression 'industrial property office' should be amended in line with the amendment to item (i).

Item (iii). It was agreed that the words 'the registration of a mark by an industrial property office' would be replaced with the single word 'registration.'

Item (vi). In reply to a question from a representative of a non-governmental organization, who wished to know what would happen if one were to amend the Classification established by the Nice Agreement, the Secretariat replied that it would always be the International Classification, and that in practice amendments were in any event regularly made to that Classification.

The representative of a non-governmental organization asked whether it might not be useful to provide a reference to the Classification of the Figurative Elements of Marks established by the Vienna Agreement. The Secretariat replied that it did not seem appropriate to provide such a reference, in view of the fact that only a small number of States were party to the Vienna Agreement, and that it had no influence on the fees or on the question whether an application could refer to one or several classes of goods or services.

Item (vii). One delegation asked for the possibility to be considered of referring not only to the priority provided for in the Paris Convention but also to any domestic priority that might be provided for in national legislation.

General. One delegation asked whether it might not be appropriate to include other expressions in the definitions, such as 'mark,' 'applicant' or 'owner' and 'register.'"

#### Article 5: Registration System

Article 5 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

"(1) [Obligation to Provide for Registration System] *Each Contracting State shall provide for the possibility of registration of marks in an industrial property office to which it has, or several States including itself have, entrusted the registration of marks.*

(2) [Maintenance of Register] (a) *The industrial property office shall maintain a register in which marks shall be registered, numbered in the order of their registration.*

(b) *The register shall include a copy or graphic representation of each registered mark and at least the following details in respect of each such mark: its registration number; the*

*name and address of the holder of the registration; the dates of application and registration; if priority is claimed, an indication of this fact with the identification of the industrial property office with which the application whose priority is claimed was filed, as well as the number and the filing date of that application; the naming of the goods and services in respect of which the mark is registered with an indication of the corresponding class or classes of the International Classification.*

(3) [Publication of Registered Marks] *The industrial property office shall, promptly after effecting the registration, publish in its periodical gazette an entry in respect of each mark registered by it. The entry shall contain a copy or graphic representation of the mark and at least the data referred to in paragraph (2)(b).*

(4) [Inspection of the Register] (a) *The register shall be open to inspection by the public.*

(b) *Any person may, against payment of any fee that may be required by the industrial property office, obtain copies of or extracts from the register."*

The portion of the report of the Committee of Experts concerning the discussion of Article 5 reads as follows:

*"Paragraph (1). The Delegation of the Commission of the European Communities noted that the wording of the paragraph (taking into account the fact that 'Contracting State' would be replaced by 'Contracting Party') would require the European Communities to set up a Community office. In view of the powers of the European Communities in respect of their Member States, the Treaty could concern them even if a Community Trade Mark Office was not yet established at the time they acceded to the Treaty.*

*It was noted that Article 5(1) contained an obligation to provide for the registration of marks (for both goods and services), whereas Article 6sexies of the Paris Convention did not require the registration of service marks.*

*Paragraph (2). It was agreed at the request of several delegations to delete in subparagraph (a) the requirement that registered marks be 'numbered in the order of their registration.'*

*As for subparagraph (b), and also paragraph (3), some delegations felt that the Treaty should not go too far in the matter of formalities and that the proposed list was too detailed to be included in a treaty. However, the Secretariat was of the opinion that the matter could not be left to domestic law, particularly since subparagraph (b) was directly related to paragraph (3) that laid down what was to be included in the publication.*

Other delegations felt, on the contrary, that the minimum contents of the register should be stipulated as proposed in the draft Treaty and that the content should also be as full as possible. In particular, it should include further information such as claims for color and particulars relating to three-dimensional marks, collective or certification marks and, where appropriate, to representatives. As for modifications made to the registration and particulars relating to renewal, the Secretariat stated that Article 5(2)(b) dealt with the initial registration and that the matter of modifications made to the registration would have to be dealt with separately in a specific article.

As for the requirement to state the registration number of the mark, it was noted that the wording would have to take into account the fact that, in some countries, a registered mark kept the number that had been given to the application for registration.

It was further suggested that, instead of giving the dates of the application and of the registration, it would be more useful to give the date as from which protection began, together with the expiry date of the registration.

As for the claim to a priority right, the Secretariat replied to a question put by one delegation that the text of the Treaty called for a statement of the name of the office (and not of the country) to which the first application had been submitted in order to allow for those cases in which the initial filing was made with the office of a Contracting Party that was not a State. The Secretariat nevertheless agreed that the Treaty could make reference both to a State (where the first application was submitted to a national office) and to an office (where the first application was submitted to the office of a contracting organization).

One delegation further asked that consideration be given to whether it was necessary to include in the mandatory contents of the register the particulars relating to priority deriving from temporary protection at certain international exhibitions under Article 11 of the Paris Convention.

In respect of the terms 'a copy or graphic representation' used at the beginning of subparagraph (2)(b), the International Bureau was asked to examine whether more appropriate terminology could not be used. One delegation proposed that the single term 'reproduction' be used since it appeared sufficiently broad to cover all eventualities and was used in Rule 14(2)(vii) of the Regulations under the Madrid Agreement, dealing with registration of a mark in the International Register. The same observations applied to the second sentence of paragraph (3).

*Paragraph (3). As for the obligation to publish the particulars referred to in subparagraph*

(2)(b), once the registration had been effected, several delegations stated that their national laws required publication of those particulars when the mark was published for opposition, but that the publication made once the mark was accepted for registration then only contained more succinct information, basically the differences between the application as published and the mark as registered. Those delegations asked that the wording of paragraph (3) be suitably redrafted.

One delegation noted that the publication date was of the greatest importance under its national law since numerous statutory time limits had to be calculated as from that date.

*Paragraph (4).* One delegation noted that the expression 'inspection by the public' did not seem the most appropriate in view of its ambiguity. A further delegation suggested that the word 'consultation' be used, whereas yet another delegation noted that the term 'inspection by the public' was that used by the European Communities.

It was generally accepted that the public should not only be able to obtain copies or extracts from the national register, but that it should also have access to the register itself, under conditions to be specified.

The question of access to filed applications that had not yet been registered and to the file containing the documents that were the basis for entries shown in the national register was also raised by several delegations and representatives of observer organizations. The Chairman noted that register within the meaning of paragraph (4) was to be understood as the instrument, whatever its form, containing the data relating to a mark accepted for registration and that the problem raised would have to be dealt with separately."

#### Article 6: Application

Article 6 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

*"(1) [Minimum Contents of an Application] An application shall contain at least:*

*(i) an express or implicit indication that the registration of a mark is sought;*

*(ii) indications allowing to establish the identity of the applicant;*

*(iii) a copy or graphic representation of the sign for which registration is sought;*

*(iv) the naming of the goods and/or services for which the registration of the sign as a mark is sought.*

*(2) [Three-dimensional Marks] Where the sign for which registration is sought is three-dimen-*

*sional, the application shall, for the purposes of paragraph (1)(iii), contain one or several two-dimensional representations of that sign.*

*(3) [Sound Marks] Where the sign for which registration is sought consists of sounds, the application shall, for the purposes of paragraph (1)(iii), contain graphic notations representing the said sounds."*

The portion of the report of the Committee of Experts concerning the discussion of Article 6 reads as follows:

*"Paragraph (1).* Several delegations asked for clarification as to the intended purpose of this provision. If the purpose was to establish minimum formal requirements for the processing of trademark applications, some delegations and representatives of non-governmental organizations questioned the usefulness of such a provision, to the extent that, in its present form, it would impose certain mandatory formal requirements upon Contracting Parties, and consequently upon applicants, but allow Contracting Parties to apply, in addition, any and all other kinds of requirements. For such reasons, these delegations and representatives failed to see the interest of such a provision, in particular for applicants. One delegation suggested that such a provision would be useful if it listed those requirements which Contracting Parties could not provide for.

A number of delegations were of the opinion that it would be more productive and interesting for applicants to envisage a provision which established the requirements for according a filing date to an application, preferably in the form of an absolute or maximum list of requirements beyond which Contracting Parties would not be able to transgress. For such purposes, they considered the four requirements contained in draft Article 6(1)(i) to (iv) as a good starting point for future discussions of such a provision.

All the representatives of non-governmental organizations who spoke expressed their support for this latter position. They considered a harmonization of filing date requirements of utmost importance to applicants and suggested that such requirements be as few and as simple as possible.

It was also recommended by some delegations and representatives of non-governmental organizations that Contracting Parties be expressly prohibited from requiring unnecessarily burdensome, time-consuming and expensive formalities, such as legalization of powers of attorney and extracts from registers of commerce.

Some differences of opinion were, nonetheless, expressed as to the eventual contents of a provision dealing with filing date requirements. One delegation wanted a generally applicable list of

requirements, with national law being free to impose additional requirements. Another delegation preferred a list of prohibited requirements rather than a maximum list. It was recalled that the purpose of such a provision should be to limit the requirements that could be imposed by a Contracting Party.

A number of delegations expressed their desire that requiring the payment of filing fees be allowed for purposes of granting a filing date, at least as an optional requirement.

One delegation suggested that a signature and use of a form be included in the list of filing date requirements.

Another delegation wanted to see a language requirement included in such a list.

Still another delegation requested that the requirement of indicating the basis for filing (use, intent to use, or Article 4 or Article 6*quinquies* of the Paris Convention) at least constitute a permissible requirement.

In conclusion, it was agreed that, for the next version of the proposed Treaty, the International Bureau would prepare three draft provisions covering the issues discussed so as to provide a basis for further discussion. The first such provision would deal with filing date requirements which would be mandatory on all Contracting Parties. These requirements could consist of those outlined in the present draft Article 6(1)(i) to (iv), in addition to a requirement as to the language of the application. A second provision would deal with additional requirements which Contracting Parties could but need not adopt (e.g., payment of fees, signature, use of forms, priority claim, indication of basis for filing). Such requirements would have to be satisfied within a reasonable time period (fixed by law, regulations or in an invitation to correct) and, if so, the filing date (i.e., the date on which the minimum mandatory requirements were satisfied) would be retained. The third provision would establish those requirements that could not be imposed under any circumstances (e.g., legalization of signatures and extracts from the commercial register).

*Paragraphs (2) and (3).* Several delegations explained the problems they encountered with these two paragraphs dealing with the form in which the representation of three-dimensional marks and sound marks should be made. It was suggested that the requirements be drafted in more detail, along the lines of Notes b. and c. on Article 6. Some delegations also suggested that more flexibility be allowed in the way sound marks could be represented, taking into account that certain sound marks could not be reduced to graphic notations.

One delegation asked if paragraphs (2) and (3) implied that Contracting Parties would have to recognize three-dimensional marks and sound marks, as this might create problems under its national law. One representative was also of the opinion that the recognition of sound marks should not be mandatory. Another representative considered that sound marks should be admitted for registration in all Contracting States.

In conclusion, it was agreed that, in the next draft of the proposed Treaty, alternative solutions would be submitted by, on the one hand, making the recognition of three-dimensional marks and sound marks mandatory on Contracting Parties, but, on the other hand, allowing Contracting Parties to make a reservation with respect thereto. It was also agreed that the drafting of paragraphs (2) and (3) had to be refined."

#### *Article 7: Registration*

Article 7 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

"(1) [Equality of Marks for Goods and Marks for Services] *The conditions of registration shall be the same for marks for goods, for marks for services and for marks for goods and services.*

(2) [Nature of Goods or Services] *The nature of the goods or services to which a mark applies shall in no case form an obstacle to the registration of the mark.*

(3) [Goods or Services Classified in Several Classes] *Any application for the registration of a mark may name goods and services irrespective of how many classes of the International Classification they belong to, and the fact that they belong to more than one class shall in no case form an obstacle to their being covered by one and the same registration.*

(4) [Business of Applicant] *The mere fact that the applicant or his enterprise is not engaged in a kind of activity in which the kind of goods or services named in the application are put on the market shall not form an obstacle to the registration of a mark."*

The portion of the report of the Committee of Experts concerning the discussion of Article 7 reads as follows:

*"Paragraph (1).* There was general agreement on the inclusion of a provision establishing the equality of marks for goods and marks for services for the purposes of registration.

In order to assess the objective of this paragraph, one delegation asked for examples of

conditions which could possibly be different for the registration of marks for goods and marks for services. In reply to this query, it was stated that, for example, the objective of the paragraph was to ensure equality of treatment in respect of fees, procedure and the possibility of claiming a priority under Article 4 of the Paris Convention. The purpose of paragraph (1) was to set, for the protection of service marks, standards that went beyond those of Articles 4 and 6*sexies* of the Paris Convention, which had certain limitations in respect of such marks.

The question was raised whether certification marks and collective marks should be understood to be covered by the provision contained in paragraph (1). It was replied that certification marks and collective marks could be the subject of special provisions contained elsewhere in the Treaty and that, for the purposes of such provisions, the principle of equality of goods and services would apply.

*Paragraph (2).* This provision was supported in its present form by a large majority of delegations and representatives of non-governmental organizations. It was noted that paragraph (2) reproduced the text of Article 7 of the Paris Convention with the additional reference to 'services.' Countries which were members of the Paris Convention were already bound by the principle contained in paragraph (2) as regards marks for goods.

The representative of one non-governmental organization pointed out that a literal interpretation of paragraph (2) could result in the obligation to register marks which were generic names of the relevant goods or services, and therefore suggested adding the words 'provided that the mark is otherwise distinctive' at the end of paragraph (2). Some delegations, however, found the proposed addition to be unnecessary because the question of distinctiveness was in all cases an absolute requirement for the registration of a mark, and any words to that effect in the context of paragraph (2) would be superfluous.

One delegation expressed reservations with regard to the provision in paragraph (2) because it believed that the possibility of excluding the registration of marks in respect of goods and services, if such exclusion were to prove necessary in the public interest, should be left open. It indicated that the national legislation of its country prohibited the registration of marks in respect of all single-ingredient dosage forms of certain drugs. With regard to marks for services, marks covering 'immoral services' were not permitted.

*Paragraph (3).* Opinions were divided on the convenience of including a provision in the draft Treaty along the lines of paragraph (3).

Several delegations explained that their national laws required that each application for the registration or renewal of a mark relate to goods or services contained in only one class of the classification. It was stated that the single-class application system was easy to administer because it allowed the work of examining applications to be divided, including search for prior rights, according to classes of products and services. Moreover, that system avoided the problem resulting from an objection raised by the trademark office in respect of one or a few goods or services that would affect, in the case of a multiple-class application, the whole of the application, with consequential inconvenience for the applicant. It was believed that a multiple-class application system would also cause problems for the maintenance and renewal of registrations, the issuance of notices and the checking of compliance with the obligation to use the registered mark. Those delegations, therefore, requested that, before a decision was taken, the advantages and disadvantages of each of the two systems be examined in further detail, and that the corresponding arguments be summarized in the notes to this provision. Some of those delegations proposed that paragraph (3) be included as an optional provision in the Treaty or, if the provision was to be mandatory, that the possibility of making reservations be provided for.

The delegations supporting the inclusion of paragraph (3) in its present form pointed out that the multiple-class application system had clear advantages for both trademark offices and applicants. Among those advantages, in particular the following were mentioned: the Madrid Agreement for the International Registration of Marks already provided for multiple-class applications and the system had proved to be viable, both for the International Registry and for the national trademark offices of the member countries; the administration of marks was facilitated because offices would not have to keep different files for different goods or services (noting that the International Classification of Goods and Services splits goods and services artificially, and functions essentially for the purposes of calculating the fees to be paid for registration); the administration of trademark portfolios was facilitated for trademark owners who need not duplicate files nor the preparation of applications (forms, payment of fees, supporting documentation) for the registration or renewal of their marks when they covered different goods or services; and the problem of determining the class to which particular goods or a service belongs would be reduced, as well as the consequences of any mistake in the indication of such class by the applicant, since a new application would not have to be filed, but only a

request for a transfer of those goods or service from one class to another within the same application.

It was underlined that the multiple-class application system had no incidence in respect of the searches to be performed by the trademark offices, since those searches were performed on the basis of the relevant goods or services, irrespective of the fact that they were listed in a single application or in several applications. Moreover, the multiple class application system would not result in a reduction in the income from fees, since such matter would be left to national legislation which could in any case provide that fees were to be paid on the basis of the number of classes covered, regardless of whether they are contained in a single application or in several applications.

The representatives of some non-governmental organizations mentioned as further advantages the fact that a multiple-class application would avoid the danger of different objections, particularly objections based on absolute grounds for refusal, being raised by different examiners in respect of the same mark, which could occur if several independent applications were filed for the same mark and were examined by different examiners. It was also noted that competitors and the public had an interest in the multiple-class application system because it facilitated the task of monitoring the registration activities of competitors, and also had advantages when it came to opposing the registration of a mark applied for goods or services spread over different classes.

*Paragraph (4).* There was general support for the provision contained in paragraph (4) in its present form. Several delegations from countries whose national legislation provided for limitations in respect of the possibility of obtaining registration for marks to distinguish goods or services which were not in the field of activities of the applicant, said that they planned to or were ready to consider modifying their legislation in the sense of the provision contained in paragraph (4). It was also noted that in some of those countries this issue had been solved by office practice and jurisprudence.

Some delegations wondered whether this provision was related to the issues of the obligation to use a registered mark and the assignment and licensing of marks. It was explained that paragraph (4), as contained in the draft Treaty, had a precise and limited scope and that the issues deriving from the obligation to use a registered mark and the transfer, assignment or licensing of marks were different matters that should be dealt with under other provisions to be

included in the draft Treaty. Moreover, it was clarified that paragraph (4) would not interfere with provisions in national laws relating to use or intent to use a mark as justification for obtaining a registration of the mark.

Some delegations expressed the fear that the provision in paragraph (4) could facilitate 'piracy' or 'trafficking' of marks, in particular by persons who did not have a *bona fide* intention of using the marks they registered. One delegation proposed considering as a possible safeguard the condition that legitimate interest should be the condition ultimately governing the possibility of obtaining registration of a mark. In reply to a question raised by another delegation, it was explained that paragraph (4) would ensure registration of a mark by a person who would engage in the relevant activity only after obtaining registration of the mark, or who could enter arrangements in order that the mark be used by a third party after it had been registered. In that connection, one delegation explained the practice under the national law of its country according to which the application for registration of a mark would be refused where the applicant neither was engaged nor intended to be engaged in the relevant activity.

A few delegations proposed expanding the scope of paragraph (4) in order that it deal also with the case of holding companies or similar entities which were not engaged in any kind of productive or commercial activity in connection with the goods or services to which the mark applied, but were rather engaged in managing or administering a portfolio of marks. It could also include the case of an individual that had licensed a trading company. That would give paragraph (4) a broader and more useful scope in line with the modern trend to allow total independence of marks as objects of commerce.

It was agreed that the notes to paragraph (4) should be expanded to explain in further detail the main issues raised in connection with the scope of this provision."

After discussing document HM/CE/I/2, the Committee of Experts discussed the questions contained in document HM/CE/I/3 ("Proposed Further Contents of the Draft Treaty") and set out below. In the following text references to a "paragraph" mean a paragraph of document HM/CE/I/3.

#### *Trademark Administration (Paragraph 3)*

The portion of document HM/CE/I/3 concerning trademark administration as submitted by the International Bureau to the Committee of Experts read as follows:

"Trademark Administration. In order to promote the expeditious administration of applications for the registration of marks, the proposed Treaty could, in particular,

(i) establish a maximum time limit within which applications must be examined—at least for absolute grounds for refusal—and provide that, if no such grounds are found, the industrial property offices would have to promptly publish the marks for opposition;

(ii) require the maintenance of a system of opposition to registration of marks and fix the term, counted from the date of publication, during which it is possible for any interested party to file opposition with the industrial property office;

(iii) provide that the applicant must be given adequate opportunity to counter any opposition;

(iv) require industrial property offices to use the International Classification adopted under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks;

(v) prohibit any changes to the sign registered as a mark during the whole term of validity of the registration, but allow at any time limitation of the kinds of goods or services in respect of which registration is applied for or granted."

The portion of the report of the Committee of Experts concerning the discussions on trademark administration reads as follows:

"The Delegation of Portugal suggested that the draft should deal with the question of the translation of the mark.

The Delegations of Switzerland, Belgium, Germany (Federal Republic of), the United States of America and Mexico stated that, as regards items (ii) and (iii) of paragraph 3, a system of opposition should be permitted but not required.

The Delegation of the Netherlands indicated that it was in favor of a mandatory system of examination, at least of absolute grounds for refusal. This would increase awareness in the general public of the conditions for the protection of trademarks.

The Delegation of the Federal Republic of Germany stated that the Treaty should apply a modest approach to the question of trademark administration. The objective should be to avoid duplicative work for applicants, as this had been achieved under the Madrid Agreement Concerning the International Registration of Marks and the Protocol to that Agreement. It further stated that there could be other ways of simplification of procedures such as the mutual recognition of registration of marks in different countries.

The Delegation of the United States of America said that item (v) of paragraph 3 could

be in contradiction with Article 5C(2) of the Paris Convention. The Secretariat said that the envisaged prohibition only concerned the registration but not the use of a mark so that Article 5C(2) of the Paris Convention did not seem to be applicable; for more clarity, the first words of item (v) should read 'prohibit the registration of any changes to the sign....'

The Delegations of Japan, the United Kingdom, Finland, Nigeria, Denmark, the Republic of Korea and India declared that they could not support a provision which would set a time limit for examination. In case of unpredictable events, offices may not be able to respect such a time limit.

The Delegation of Canada supported the principle of including a time limit for examination because of the very long delays which currently existed in some countries, but warned that the time limit had to be long enough to allow countries sufficient flexibility to deal with unexpected events.

The Delegation of Italy stated that, with respect to item (i), a time limit should only be applicable to absolute grounds for refusal. With respect to items (ii) and (iii), it stated that, although its legislation did not at present provide a possibility of opposition during the registration procedure, it had no prejudice against such a possibility, since it could be provided in the context of a future revision of the trademark law. As for item (v), the Delegation was in favor of a more flexible approach which would permit minor changes in the sign as registered, including the modernization of the mark as long as it did not concern its essential features.

The Delegation of Denmark stated that, with regard to item (ii), Contracting States should be allowed to establish a system of opposition after registration of the mark. With regard to item (v), the Delegation was also in favor of a more flexible approach.

The representatives of several non-governmental organizations favored the inclusion of a time limit for examination."

#### *Absolute Grounds for Refusal (Paragraph 4)*

The portion of document HM/CE/I/3 concerning absolute grounds for refusal as submitted by the International Bureau to the Committee of Experts read as follows:

"Absolute Grounds for Refusal. The proposed Treaty could contain provisions seeking to establish an exhaustive list of the absolute grounds for refusing registration. Those grounds could be that the sign whose registration is sought:

(i) is not a sign within the meaning of that term in the Treaty (cf. Article 3(2) in document HM/CE/II/2);

(ii) has no distinctive character;

(iii) is exclusively descriptive;

(iv) is exclusively generic;

(v) is contrary to morality or public order;

(vi) is likely to deceive the public concerning in particular the nature, the quality or the geographic origin of the goods or services in respect of which it is used or is intended to be used;

(vii) is a sign whose registration or use is prohibited by Article 6ter of the Paris Convention."

The portion of the report of the Committee of Experts concerning the discussions on absolute grounds for refusal reads as follows:

"The Delegation of the Federal Republic of Germany said that the draft Treaty should contain a list of possible absolute grounds for refusal, which should be as complete as possible and drafted in the terminology used in the Paris Convention.

The Delegation of the United States of America said that one of the possible reasons for refusal should be lack of use of the mark at the time of registration. The International Bureau said that the list in paragraph 4 was intended to list grounds for refusal connected with the nature of the sign and that the requirement of use was dealt with in paragraph 12.

The Delegation of the European Communities said that it supported the inclusion in the draft Treaty of a provision on absolute grounds for refusal. It expressed doubts with respect to the exhaustive nature of the list of grounds. However, there could be an exhaustive list of grounds which Contracting Parties would not be obliged to apply. The International Bureau should also study the question of signs which were not distinctive *per se* but which had acquired distinctiveness through use prior to application. With respect to item (vii), the Delegation indicated that Contracting Parties should be free to go beyond the prohibitions provided for in Article 6ter of the Paris Convention, so that registration and use as marks of certain signs of public authorities could be prohibited if those public authorities had not given their consent for the use of such signs.

The Delegation of India suggested the inclusion of the term 'public interest' in item (v).

The Secretariat said that in the light of the discussions it would try to establish the list of grounds for which the registration of a sign as a trademark could be refused, it being understood that such refusal would not be permitted for any ground other than those mentioned in this list."

### Conflicts with Prior Rights (Paragraphs 5 and 6)

The portion of document HM/CE/I/3 concerning conflicts with prior rights as submitted by the International Bureau to the Committee of Experts read as follows:

"Conflicts with Prior Rights. The proposed Treaty could also seek to establish those grounds on which a sign is not registrable as a mark because of a prior right held by a third party. Those grounds could be:

(i) the existence of an identical or confusingly similar mark registered or applied for by another enterprise in respect of the same or similar goods and enjoying an earlier filing, or, where applicable, priority date;

(ii) the existence of an identical or confusingly similar well-known mark used in respect of the same or similar goods or services;

(iii) the existence of an identical or confusingly similar highly-renowned mark;

(iv) the existence of an identical or confusingly similar collective mark registered or applied for by a third party in respect of the same or similar goods or services and enjoying an earlier filing or, where applicable, priority date;

(v) the existence of an identical or confusingly similar well-known collective mark used in respect of the same or similar goods or services;

(vi) the existence of an identical or confusingly similar highly-renowned collective mark;

(vii) the existence of an identical or confusingly similar trade name;

(viii) the infringement of a protected industrial design or a work protected by copyright;

(ix) the violation of the rules of unfair competition;

(x) the illegitimate use or imitation of a protected appellation of origin;

(xi) the invasion of privacy;

(xii) the violation of Article 6septies of the Paris Convention.

The proposed Treaty could also deal with the circumstances in which the consent of the third party that is the owner of any of the prior rights referred to in the preceding paragraph would serve to allow the registration of a sign as a mark."

The portion of the report of the Committee of Experts concerning the discussions on conflicts with prior rights reads as follows:

"The Delegation of the Federal Republic of Germany declared that it was in favor of a basic obligation of States to refuse or cancel the registration of a mark which was in conflict with prior rights. It could not consider all the items



appearing in paragraph 5 since some of them were not in the nature of prior rights; for example, item (x) concerning appellations of origin and item (xii) referring to Article 6septies of the Paris Convention were not in the nature of conflicts with prior rights.

The Delegation of the Federal Republic of Germany suggested that the International Bureau should examine the question of incontestability of the rights conferred by the registration of a mark after a certain period of time.

The Delegation of Nigeria stated that the legislation of its country recognized the prior right of the proprietor of registered trademarks. As to the rights of applicants whose applications for registration were pending, it indicated that the law had not given absolute rights to them, and they were permitted to pursue their application simultaneously. It further stated that the law had not given any special protection to the owners of well-known or highly-renowned trademarks because it believed that their rights were adequately protected under common law recognized by Section 3 of the Trademark Act of 1965. It further stated that the right to act against invasion of privacy was adequately protected by the Constitution.

The Delegation of Switzerland generally supported paragraph 5 but expressed reservations with respect to items (vii) to (xi), since it considered that only prior rights relating to marks should justify refusal of the registration of a mark.

The Delegation of Canada suggested that among prior rights the right of a *bona fide* continuous prior user of a conflicting mark should be included. Moreover, instead of 'existence,' one should rather speak of 'use' of a mark or trade name.

The Delegation of the European Communities considered that for conflicts with prior marks an exhaustive list should be proposed by the International Bureau, whereas for other prior rights only an optional list should be established.

The Delegation of the United States of America declared that in the proposed list some prior rights were suitable as grounds for refusal and cancellation of the registration of a mark while some other prior rights were only suitable as grounds for cancellation. With respect to item (i), the Delegation suggested that the reference to a mark as applied be deleted since an application would not necessarily mature into a registration. It supported the proposal made by the Delegation of Canada with respect to the inclusion of an unregistered but used mark as a prior right.

The Delegation of Ireland considered that the list proposed was too long and detailed, and that the list should be made partly mandatory and

partly optional, according to types of rights. It further stated that the rights referred to in items (vii) to (xi) were outside the competence of trademark law.

The Delegation of India stated that there was a need for clarification and more detailed studies on the concepts referred to, in particular the concepts of well-known mark and highly-renowned mark, of unfair competition and of invasion of privacy.

As regards paragraph 6, the Delegation of the United States of America declared that the question of consent of the owner of the prior right should not be included in the draft Treaty since it only dealt with part of a larger problem. For example, if the owner of a prior right gave his consent to the registration of a mark, the registration could nevertheless be refused by an industrial property office because of a possibility of misleading the public.

The Secretariat said that it would try to draft paragraph 5 as one that requires the trademark office to refuse registration in the case of items (i) to (vi)."

#### *Examination (Paragraph 7)*

The portion of document HM/CE/I/3 concerning examination as submitted by the International Bureau to the Committee of Experts read as follows:

*"Examination. A variety of systems for the substantive examination of applications for the registration of marks exists in national laws. Some laws require an examination only as to some or all of the absolute grounds for refusal; other laws require an examination both as to those grounds and the grounds referred to in paragraph 5, above (prior rights). In addition, an opportunity for opposition to the registration of marks is allowed by some laws on the basis of the said grounds, or at least on the basis of conflict with prior rights. The proposed Treaty could adopt an approach in which it does not seek to effect any change in the existing variety of examination systems, but seeks to oblige adherence by Contracting Parties to the same essential principles in the administration of each type of system. Alternatively, the proposed Treaty could oblige Contracting Parties to adopt, to a greater or lesser extent, the same kinds of examination systems (by, for example, requiring all Contracting Parties to examine ex officio applications as to absolute grounds for refusal, or to examine ex officio applications as to those grounds and to provide an opportunity for opposition to the registration of marks on the basis of prior rights and even on the basis of absolute grounds for refusal)."*

The portion of the report of the Committee of Experts concerning the discussions on examination reads as follows:

“The Delegation of India indicated that it was in favor of a system of substantive examination of applications in relation to absolute grounds, with a possibility of opposition which could be based also on other grounds, such as the protection of the interests of third parties and the public interest.

The Delegation of the Federal Republic of Germany stated that, whatever system was adopted by Contracting Parties, the provision should provide for a kind of examination which avoided undue delays. Moreover, adequate judicial review should be possible in each case.

The Secretariat said that the Treaty could, for example, require that trademark offices should act within reasonable time limits but that any application must be disposed of within a maximum of five years.”

#### *Term of Registration (Paragraph 8)*

The portion of document HM/CE/I/3 concerning the term of registration as submitted by the International Bureau to the Committee of Experts read as follows:

“Term of Registration. *It is a rule of universal application that the registration of a mark may, subject to the fulfillment of certain requirements (such as use), be renewed indefinitely. Differences exist, however, in respect of the interval after which registrations must be renewed. The proposed Treaty could require Contracting Parties to adopt the same intervals by providing that the initial term of registration must be a uniform period of 10 years and that the term of each renewal must also be a uniform period of 10 years.*”

The portion of the report of the Committee of Experts concerning the discussions on the term of registration reads as follows:

“The Delegation of India indicated that it supported the proposal for 10-year terms.

The Delegation of Nigeria expressed its support for terms of 10 years each starting from the filing date.

The Delegation of Mexico agreed with 10-year terms; the provision should indicate whether the term started from the application date or the registration date.

The Delegation of the Federal Republic of Germany stated that renewal of marks should be as easy as possible as it was in the Madrid Agreement Concerning the International Registration of

Marks which only required the payment of renewal fees without any request for renewal and accompanying documents such as a power of attorney. As regards the starting point of calculating the term of registration, most countries counted from the filing date of the application but this question could be further studied.

The Delegation of Japan expressed its support for terms of 10 years each starting from the date of registration.

The Delegation of the Republic of Korea expressed its support for terms of 10 years counted from the date of registration.

The Delegation of Canada supported the 10-year terms although its country would have to change its law which provided for 15-year terms. However, it opposed a mandatory requirement to count the term from the filing date in view of the advantages for applicants of counting the term from the date of registration.

The representatives of the non-governmental organizations were in favor of 10-year terms. Most of the representatives indicated that the renewal should be as easy as possible.”

#### *Rights Conferred by Registration (Paragraph 9)*

The portion of document HM/CE/I/3 concerning the rights conferred by registration as submitted by the International Bureau to the Committee of Experts read as follows:

“Rights Conferred by Registration. *The proposed Treaty could contain provisions establishing the rights conferred by the registration of the mark. In particular, it could provide that registration confers on the holder of the registration:*

(i) *the right to prevent others from using the same or a confusingly similar sign in respect of the same goods and services for which the mark is registered;*

(ii) *the right to prevent others from using the same or a confusingly similar sign in respect of goods and services other than those for which the mark is registered if the use of the same or confusingly similar sign would, in view of the registered mark, be likely to mislead the public;*

(iii) *the right to prevent others from using the same or a similar mark in respect of any goods and services in such a way as to jeopardize the distinctiveness of the registered mark (for example, by using the registered mark as a generic name).”*

The portion of the report of the Committee of Experts concerning the discussions on the rights conferred by registration reads as follows:

“The Delegation of the Federal Republic of Germany stated that a provision on this matter

should apply a modern approach for the definition of conflicts and take into account use of the mark in dictionaries and use resulting in dilution of the mark. The owner should have the right to prohibit any use which was detrimental to his interests.

The Delegation of the United States of America underlined that, once a mark had become the generic name of a product in the perception of the public, there was no longer a right to prohibit its use as a generic name. It was responded that item (iii) only dealt with the question of a mark being used as a generic name before the public considered it as a generic name.

The Delegation of India said that the *bona fide* use of family names and names of places of business should be permitted even if such names were identical with protected trademarks. It further stated that the prior users' right should be recognized. It finally indicated that the mere fact of a mark being registered should afford no defense in an action for passing off.

The Delegation of Canada indicated that in item (ii) there was no need for a two-step evaluation. As regards item (iii), it supported the inclusion of anti-dilution measures and added that the provision should also deal with the exceptions to prohibited use.

The Delegation of Nigeria stated that it agreed with items (i) and (ii) but indicated that it had problems with item (iii) because the concept of 'any goods and services' was considered too wide.

The Delegation of the European Communities suggested that a list of examples of infringing acts could be inserted in the draft Treaty."

#### *Requirements of Use (Paragraph 12)*

The portion of document HM/CE/I/3 concerning the requirements of use as submitted by the International Bureau to the Committee of Experts read as follows:

*"Requirements of Use. A great variety exists in the provisions in laws concerning requirements for the use of a mark. In this respect, the proposed Treaty could provide for:*

*(i) the prohibition of a requirement of use as a condition of registration or application for registration (but allowing the requirement of a declaration of intent to use);*

*(ii) the prohibition of any requirement of use in association with another mark;*

*(iii) the length of time (e.g., five years) for which uninterrupted failure to use a mark should constitute a ground for the cancellation of a registration or a defense to the use of a registered mark by a third party;*

*(iv) a requirement that, despite continuous non-use for a defined period, the registration of a mark should not be cancelled for that reason, and the holder of the registration should not be deprived of any rights, if the non-use can be justified;*

*(v) the circumstances in which use by a person other than the holder of the registration would have to be considered to constitute use by the holder of the registration."*

The portion of the report of the Committee of Experts concerning the discussions on the requirements of use reads as follows:

"The Delegation of India indicated that it supported in general the ideas put forward by the International Bureau but stated that, with respect to item (ii), a country should be allowed to require that a trademark be used in conjunction with another trademark, for example, for reasons of public interest.

The Delegation of the United States of America stated that item (i) could not be accepted since the entire trademark system in the United States was based on use of the mark before registration. It recalled that the Trademark Law of the United States of America had recently been amended to accept trademark applications based on intent to use but effective use was still necessary to obtain registration of the mark.

The Secretariat said that in the draft to be prepared for the next meeting a solution would be sought. For example, one could allow use as a requirement of registration (not of application) in Contracting States which, at the time of becoming party to the Treaty, had such a requirement in their domestic law.

The Delegation of Canada stated that, with respect to item (i), it had the same concerns as the Delegation of the United States of America but that the proposal to limit the prohibition of the requirement of actual use to the application of the mark was acceptable. As regards item (ii), it considered that the draft Treaty should not interfere with cultural requirements such as translation requirements. It concluded by stating that, with respect to item (iii), it considered a term of three years preferable to five years.

The Delegation of Japan stated that it agreed with item (i) as proposed; with respect to item (iii), it considered three years to be more appropriate than five years.

The Delegation of Nigeria supported items (i), (ii) and (iii) but was against the inclusion of items (iv) and (v).

The Delegation of the Federal Republic of Germany stated that it agreed with item (i) as drafted but that it was ready to study the proposal

limiting the prohibition of a use requirement to the application. As regards item (iii), it considered an adequate grace period to be a condition for the success of the Treaty; it considered five years to be a minimum time limit since trademark owners needed sufficient time to use all their trademarks around the world. As regards item (ii), cultural requirements such as translation requirements should not be permitted.”

*Exhaustion of Rights (Paragraph 10); Cancellation (Paragraph 11); Assignment of Marks (Paragraph 13); Compulsory Licensing (Paragraph 14); Well-Known Marks and Highly Renowned Marks (Paragraphs 15 and 16) and Enforcement (Paragraphs 17, 18 and 19)*

The portions of document HM/CE/I/3 concerning exhaustion of rights, cancellation, assignment of marks, compulsory licensing, well-known marks and highly renowned marks and enforcement as submitted by the International Bureau to the Committee of Experts read as follows:

*“In addition, the proposed Treaty could try to take a stand on the doctrine of exhaustion of rights and, in particular, on whether the rights of the holder of a registration should, following the lawful putting on the market, under the mark, of the goods or services to which the mark relates, be subject to national, regional or international exhaustion in respect of those goods or services.*

*Cancellation. The proposed Treaty could require Contracting Parties to provide for the cancellation of the registration of marks, in judicial proceedings, whether by way of an action for cancellation or by way of defense to an action for infringement, on the basis of any of the absolute grounds for refusal and of any of the prior rights. At the same time, the proposed Treaty could allow Contracting Parties to provide for a procedure for cancellation before the industrial property office, subject to review by a judicial authority.*

*Assignment of Marks. The conditions under which marks may be assigned differ in national laws, particularly as to whether assignments may be effective without the transfer of goodwill or of the part of the enterprise in which the mark is used. The proposed Treaty could seek to set out such conditions and, in particular, could provide that assignments of marks are admissible even without the transfer of goodwill or of any associated part of the enterprise.*

*Compulsory Licensing. The proposed Treaty could contain a prohibition on granting compulsory licenses for the use of marks.*

*Well-Known Marks and Highly-Renowned Marks. The principle of the protection of well-*

*known marks, even if such marks are not registered, is already established in the Paris Convention (Article 6bis). The assessment of the criteria for establishing whether a mark is well known is, however, left to national law by that Convention. The proposed Treaty could specify the criteria for the recognition of well-known marks which must be applied by national law.*

*In addition, the proposed Treaty could contain provisions with respect to the recognition of those marks that are known as highly-renowned marks. Highly-renowned marks are already recognized in the jurisprudence of a number of countries which accord to them a protection, even without registration, against use in respect of any goods or services (whether or not the highly-renowned mark is used in respect of those goods or services).*

*Enforcement. The proposed Treaty could contain provisions requiring minimum remedies for the enforcement of the rights conferred by registration.*

*Enforcement would cover discovery, seizure, injunction and damages.*

*Consideration could be given to whether the proposed Treaty should seek to differentiate between ‘simple’ infringement and counterfeiting and require stricter remedies in respect of the latter.”*

The portion of the report of the Committee of Experts concerning the discussions on exhaustion of rights, cancellation, assignment of marks, compulsory licensing, well-known marks and highly renowned marks and enforcement reads as follows:

*“These matters were only briefly discussed by the Committee of Experts.*

*The Delegation of India supported a proposal of the International Bureau with respect to the prohibition of compulsory licenses; as regards well-known marks and highly-renowned marks, the criteria for their recognition should be left to national laws; as regards enforcement, it agreed that the proposed Treaty should seek to differentiate between simple infringement and counterfeiting. Finally, it stated that minimum remedies for the enforcement of rights conferred by registration should be provided for.*

*The Delegation of the Federal Republic of Germany suggested that with respect to enforcement the proposal should not use the term ‘discovery’ but rather the term ‘obtaining of evidence.’ It added that the freedom to grant voluntary licenses might have to be provided for in the proposed Treaty.*

*The Delegation of the United States of America indicated that on the question of exhaustion of rights the proposal should be limited to*

national exhaustion. It further stated that it welcomed the effort of the International Bureau to develop criteria for establishing whether marks were well known and highly renowned.

The Delegation of Japan considered that the question of enforcement could affect judicial systems governed by national law but that it was not opposed to a further study of this question.

The Delegation of Mexico considered that the question of compulsory licensing should be studied in more depth.

The Delegation of Canada stated that the question of exhaustion of rights should be further studied and that, although it currently did not have a firm position, its preliminary view was that it would be desirable to have a requirement of international exhaustion, with a provision for protection of consumers against misleading practices.

The Delegation of the European Communities stated that it favored the inclusion, in the draft Treaty, of a provision on exhaustion of rights, without, at the present stage, expressing its opinion on the national, regional or international character that the exhaustion should have."

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**Algeria:** H. Yahia-Cherif. **Argentina:** A.G. Trombetta. **Austria:** G. Mayer-Dolliner; M. Stangl. **Belgium:** W. Peeters. **Brazil:** P.R. de Almeida. **Bulgaria:** K. Savova; C. Krasteva-Valchanova; M.R. Popov. **Cameroon:** I. Meutcheye. **Canada:** A.M. Troicuk. **China:** Wu Qun. **Democratic People's Republic of Korea:** C.R. Pak. **Denmark:** J.E. Carstad; A. Fenger; K. Sanders. **Egypt:** N. Gabr. **Finland:** S.-L. Lahtinen. **France:** G. Rajot. **German Democratic Republic:** S. Schröter. **Germany (Federal Republic of):** A. von Mühlendahl; E. Schaefer; M. Bühring. **Greece:** P. Geroulakos. **Hungary:** Gy. Pusztai; E. Boytha-Füzesséry. **Iraq:** J.A. Hamza. **Ireland:** H.A. Hayden. **Italy:** M.G. Fortini; P. Iannantuono; G. Morelli Gradi; G. Jacobacci. **Japan:** S. Uemura; S. Takakura. **Libya:** S. Shaheen. **Mexico:** J. Cornish; A. Fuchs. **Nigeria:** E.O. Jegede. **Netherlands:** H.R. Furstner. **Norway:** K.A. Evjen; P.V. Bergheim. **Portugal:** J. Mota Maia; R.A. Costa de Morais Serrão; J. Pereira da Cruz. **Republic of Korea:** J.K. Kim. **Senegal:** G. Diop. **Soviet Union:** E.G. Koutakova. **Spain:** J. Gómez Montero; A. Fernández Picaza; J.M. González de Linares. **Sri Lanka:** R.N. Abeysekera. **Sweden:** A. Morner; T. Norström; K. Sundström. **Switzerland:** J.-D. Pasche; A. Degen. **Tunisia:** H. Tebourbi. **Turkey:** A. Algan. **United Kingdom:** M. Todd; E.A. Scarff; A.C. Waters. **United States of America:** R.G. Bowie; C. Walters. **Yugoslavia:** T. Lisavać. **European Communities (EC):** A. Brun; H.W. Kunhardt; E.C. Nooteboom.

### II. Observer States

**Chile:** P. Romero. **India:** L. Puri. **Panama:** M. Saavedra Polo.

### III. Intergovernmental Organizations

**Benelux Trademark Office (BBM):** L.J.M. Van Bauwel. **General Agreement on Tariffs and Trade (GATT):** M.C. Geuze.

### IV. Non-Governmental Organizations

**Asian Patent Attorneys Association (APAA):** H.R. Hodgkinson. **Benelux Association of Trade Mark and Design Agents (BMM):** F. Gevers. **Centre for International Industrial Property Studies (CEIPI):** B. de Passemar. **Chartered Institute of Patent Agents (CIPA):** T.L. Johnson. **Committee of National Institutes of Patent Agents (CNIPA):** T.L. Johnson. **Deutsche Vereinigung für gewerblichen Rechtsschutz und Urheberrecht e.V. (DVGR):** R. Freitag. **European Association of Industries of Branded Products (AIM):** G.F. Kunze. **European Communities Trade Mark Practitioners' Association (ECTA):** F. Gevers. **European Federation of Pharmaceutical Industries' Associations (EFPIA):** P. Bocken. **Federation of German Industry (BDI):** R. Freitag. **Institute of Trade Mark Agents, United Kingdom (ITMA):** D. Turner; B. March. **International Association for the Protection of Industrial Property (AIPPI):** H.P. Kunz-Hallstein. **International Chamber of Commerce (ICC):** A.L. de Sampaio; J.H. Kraus. **International Federation of Industrial Property Attorneys (FICPI):** T.L. Johnson. **International Federation of Pharmaceutical Manufacturers Associations (IFPMA):** A.S. Cox. **Italian National Institute for the Defense, Identification and Certification of the Authenticity of Trademarks, Italy (INDICAM):** P. Azzola. **Japan Patent Association (JPA):** K. Namatame. **Licensing Executives Society (International) (LES):** B. de Passemar. **Max Planck Institute for Foreign and International Patent, Copyright and Competition Law (MPI):** H.P. Kunz-Hallstein. **The United States Trademark Association (USTA):** Y. Chicoine. **Trade Marks, Patents and Designs Federation (TMPDF):** A.S. Cox. **Union of European Practitioners in Industrial Property (UEPIP):** R. Harle. **Union of Industrial and Employers' Confederations of Europe (UNICE):** R. Freitag. **Union of Manufacturers for the International Protection of Industrial and Artistic Property (UNIFAB):** A. Thrierr.

### V. Bureau

**Chairman:** J. Mota Maia (Portugal). **Vice-Chairmen:** E.O. Jegede (Nigeria); Gy. Pusztai (Hungary). **Secretary:** L. Baeumer (WIPO).

### VI. International Bureau of WIPO

**A. Bogsch (Director General); A. Schäfers (Deputy Director General); L. Baeumer (Director, Industrial Property Division); P. Maugué (Senior Counsellor, Industrial Property (Special Projects) Division); H. Lom (Senior Legal Officer, Developing Countries (Industrial Property) Section); O. Espinosa (Senior Legal Officer, Industrial Property Law Section); B. Ibos (Legal Officer, Industrial Property (Special Projects) Division); S. Zotine (Legal Officer, Industrial Property (Special Projects) Division); T. Niinomi (Associate Officer, Industrial Property Law Section); G. Leonardos (Consultant, Industrial Property Division).**

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

## Studies

### Considerations on Counterfeiting

Y. PLASSERAUD\*

Throughout the world, hundreds of millions of people wear or use every day articles that are counterfeit, although frequently unawares. Among the social phenomena that have appeared over recent years, mass counterfeiting of industrial and commercial articles is surely one of the most visible, but at the same time one of the least recognized. For some time now, the popular press has inundated its readers with sensational articles on the spectacular raids carried out by the Italian *Guardia di Finanza* on the clandestine workshops that manufacture copies of Hermès handbags or on the no less dramatic steam-rolling of copies of Cartier watches.<sup>1</sup> Elsewhere, the specialized publications devote numerous pages to the legal means of fighting unlawful copying.

It therefore seems to me that somewhere between the newspaper anecdotes and the analytical study of legal remedies there must be a useful place for an attempt at an overall approach to the actual phenomenon of counterfeiting. To make myself clear, I shall speak above all of the counterfeiting of visible objects, that is to say, trademarks and registered designs, and will basically leave aside the counterfeiting of patents whose technical nature lends them quite different characteristics.

#### What is Counterfeiting?

In the legal sense, counterfeiting can be defined as the unlawful-identical (or practically identical) reproduction of objects or of "signs" in which intellectual property rights subsist (trademarks, service marks, industrial designs, literary and artistic rights, and so on). Counterfeiting is therefore as old as trade in packaged goods itself and, indeed, the Museum of

Counterfeits in Paris<sup>2</sup> possesses Gallo-Roman amphoras bearing *sigilla* that imitate with varying degrees of accuracy those of the great wines from Campania.

The law of the *Ancien Régime* in Europe already contained numerous instruments on the repression of the manufacture and marketing of alleged counterfeit merchandise and our present national laws, on the whole, still go no further.

Indeed, up to the 1960s, counterfeiters satisfied themselves with this traditional form of copying the trademarks or designs of others and the phenomenon, although a nuisance, nevertheless remained within controllable limits (if only for the reason that many products were traditionally sold loose).

#### The Domination of Trademarks

With the emergence of a consumer society following the Second World War, the general trend was to create brand articles in the field of everyday products. Although there were many reasons for that development, two are immediately discernible. In our semiotic world, trademarks constitute the optimum means of visual (and sometimes audio) identification for the corresponding goods or services. Although today's consumers are continually looking for best quality for the same price, they are forced to acknowledge that the first-mentioned factor is unfortunately ever less immediately discernible.

When a new product is placed on the market, the part played by marks, whether trademarks or service marks, is initially irreplaceable as a guarantee (and no longer, we may note, an indication of origin as it used to be, as a result of the growing number of licenses that are granted). During the 1960s, in Western Europe, a young, well-informed purchaser knew that, for example, Levi-Strauss did not hesitate to scrap a notable quantity of the jeans produced in its factories in order to respect its quality standards and that, consequently, those put on the market stood

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<sup>1</sup> As for coverage in the media, cf. André Dessot, "Le dernier tombeau suisse des fausses montres Cartier," *Le Monde*, April 13, 1985. For the general problem, see, for example, the article in *Dynasteurs*, March 1986, or *Le Nouvel Economiste*, No. 541, of May 16, 1986.

<sup>2</sup> Union des fabricants, 18, rue de la Faisanderie, 75016 Paris.

every chance of being hard-wearing. Indeed, in the case in point, the trademark constituted a guarantee of the American style that was extremely popular at the time.

As far as the mass market is concerned, certain emblems acquire such prestige over the years, a kind of magical aura, that they become social status symbols<sup>3</sup> and thereby assume many attributes of show business stars. As was most pertinently written by two communications specialists: "Trademarks become stars and the consumers their groupies."<sup>4</sup> The customer who buys a Gucci handbag—or a copy—joins the club of those who are aware of what that symbol means.

### The Age of Plagiarism

The popularization of luxury goods has become, in these times of uncertainty and of the search for security, a general trend within the industrialized societies and many people do not hesitate to sacrifice the basic needs for that which—in theory—is superfluous. It is as if the consumption of luxury goods had now become one of the safe values of our society. Unfortunately, even if *foie gras* from Fauchon or tea from Fortnum & Mason's can be bought on many budgets, the same cannot be said for Cartier watches or Vuitton luggage. Obviously, the more the articles are well known, reputed and expensive, the more they are coveted.

In the face of a potential demand that is as large as it is insolvent, in view of the price of the genuine articles, there has been a rapid development of "alternative" production of fakes that imitate the original with varying degrees of success. This offer is all the more readily accepted for the fact that, in our hasty and mediatised society, appearances are frequently more important than reality.<sup>5</sup> As perfectly demonstrated by Umberto Eco,<sup>6</sup> authenticity is of no importance if the image, for its part, conforms to that of the genuine article! We are in the "age of the fake" to quote a title found in a recent copy of the periodical *Autrement*.<sup>7</sup> This market has rapidly established itself and, it has to be admitted, in view of the prices that are mostly to be paid, the consumer deceived in this field probably is a willing victim.

However, counterfeiting is not limited to articles intended for the broad public; it affects practically all

areas in which copying can be profitable: pharmaceuticals, motor vehicle spares, electronic components, videocassettes, books, compact discs and so on. In most cases, although the quality of the fakes is poor, the damages suffered go no further than the consumer's disappointment. Unfortunately, in some cases, counterfeited products can comprise grave risks and there have been numerous accidents caused by anabolic steroids that are toxic, by pacemakers that are defective or by helicopter rotor blades that are weak.<sup>8</sup>

For those types of products where fashion plays no part, the commercial machinery is somewhat different to the case of luxury articles. Since the copies are practically identical with the originals, the aim is here to attract the final customer by means of a price that is slightly lower than that of the genuine article, but nevertheless sufficiently high to suggest a simple local difference due, for example, to a shorter distribution circuit.

### A Vast Market

Between the 1960s and 1980s, the phenomenon steadily grew, but it was only in the subsequent years that it assumed the proportions it has today. According to the estimates of well-informed national and international sources,<sup>9</sup> the market involves billions of dollars—the International Chamber of Commerce currently speaks of 100 billion dollars, or 5% of international trade—and the loss of hundreds of thousands of jobs (100,000 for the European Communities alone).

### Look-Alikes

During the 1980s, whilst experiencing a sudden increase in volume, counterfeiting also underwent a change in its nature. To begin with, a trader or a provider of services used a more or less accurate copy (leaving aside accidental copies) of a competitor's trademark in order to create the impression that his goods originated in the competitor's workshops. The article itself could indeed be different from the original insofar as the common source remained plausible. For instance, the name of a well-known brand of candle could be usurped for a type that was not included in the firm's production range without any inconvenience for the "effectiveness" of the counterfeit.

This was because in earlier times goods always possessed the external shape dictated by their nature at a given time in the technical development. The

<sup>3</sup> It was Georges Pérec who wrote some years ago that if an object was not signed then it did not exist, in *Traverses*/3, Éditions de Minuit.

<sup>4</sup> Jean-Pierre Vitrac and Jean-Charles Gâté in *Marketing-Mix*, No. 17, November 1987.

<sup>5</sup> Cf. Guy Debord, *La société du spectacle* and *La société du spectacle vingt ans après*, G. Lebovici, 1988.

<sup>6</sup> Umberto Eco, *Lector in fabula*.

<sup>7</sup> "L'ère du faux," *Autrement*, No. 76, January 1986.

<sup>8</sup> *Le Monde diplomatique*, March 1988.

<sup>9</sup> See, in particular, in France, *Rapport de Santis, Conseil économique et social*, June 15, 1983.

goods of one manufacturer were only distinguished, superficially, from those of his competitors by the trademark. Over the last few decades, two basic changes have occurred in that situation:

– Goods frequently possess an original external form based on both the aesthetic aspect and also technical research. This is what is known as design. The article is no longer identified solely by its trademark, but also by its shape.

– Secondly, trademarks are sold or hired (licensing) in a world in which technological trade is present everywhere. This means that a trademark is less and less used to indicate the origin (whether the manufacturer or the locality) of a given item.

This means that it is no longer sufficient to simply copy the trademark (although traditional counterfeiting is far from having disappeared). It is the combination of trademark and product, as a “semiotic structure,” that carries the message and it is this set of symbols that must therefore be completely reproduced.

Such fully imitated goods, frequently indistinguishable from the originals, are also known as look-alikes.

The traditional French use of counterfeiting, as we have seen, designates the copying of protected goods or signs; but what of the case of multiple counterfeiting in which a series of rights are simultaneously infringed and in which the article itself is identically imitated?

From a legal point of view, this constitutes an indivisible mixture of unlawful elements—or even lawful elements where the object or the sign that has been copied is not protected—which, additionally, fall under differing branches of law (industrial property, copyright, unfair competition and so on). English uses the term “counterfeiting” which, despite appearances, is untranslatable into French, and reserves the traditional word “infringement” for what has always been called in French “*contrefaçon*.” So far, no satisfactory notion has emerged in French and even the now frequently used term of piracy is itself misleading insofar as it bears a different meaning in the law of the sea.

Recently, the World Intellectual Property Organization (WIPO) proposed at a meeting of the Committee of Experts on Measures Against Counterfeiting and Piracy that *counterfeiting* be defined as the manufacturing, selling, etc., of goods that infringe industrial property rights (trademarks, etc.), whereas *piracy* would refer to the manufacturing, selling, etc., of copies that infringe rights protected by copyright; in both cases, manufacture has to have been carried out on a commercial scale and without the authorization of the owner of the right.<sup>10</sup> I would

go along with this proposal that excludes use of the term of piracy in the industrial property field.

### A Contribution to the North-South Dialogue

Some 30 years ago, in Europe, counterfeiting was a geographically “regional” phenomenon. European enterprises copied European trademarks with hardly any interference from the outside world. Certainly, it was long a fact that more “professional counterfeiters” were likely to be found in certain European countries than in others, but on the whole the process remained within one and the same system. The situation began to change between the two wars and then, in the 1970s, a rapid change of scale took place and the phenomenon became progressively a worldwide problem. In practice, however, the markets basically remain in the “rich” countries—that is to say, the Western industrialized countries—and the producers (frequently not the commissioners) are to be found more and more in the poor regions of the South. Very recently, no doubt following the repeated successes of customs seizures, there has been a closing up of the production and distribution centers.

This latter event may be readily understood from an economic point of view if it is borne in mind that the goods involved generally derive from “manpower industries” and that slavish copying—which is therefore unimaginative—demands hardly any research and development work (except possibly adaptation to local conditions).

We are today faced with a new set of problems on two counts.

To begin with, since there is an enormous imbalance (frequently by the factor three!) between the manufacturing costs in the “new counterfeiting” countries and the industrialized States, the growth of counterfeiting has often placed the nationals of the industrialized States in a delicate trading position. In order to fight efficaciously against such inequality, the Western manufacturers have often been obliged to carry out a transfer, which they refer to as “delocalization,” of genuine manufacture to the countries of the South, with more speed than would have been wished by those sectors in which “Made in Germany” or a “Made in USA” still represent an essential trading advantage.

Indeed, this issue rapidly entered into the political and economic disputes between the developing countries of the Group of 77 and the States of Group B (to use the United Nations terminology that is common in this respect).

What happens is that goods arrive in Europe through the weak links of customs protection without trademarks and these are then placed on them in assembly centers. Such workshops, that are true clandestine, open air factories (usually known as

<sup>10</sup> Committee of Experts on Measures Against Counterfeiting and Piracy, WIPO document CCE/2 of February 18, 1988.



“auto camps”) themselves receive the merchandise from varying sources and through the activities of a large number of agents. Finally, at the end of the road, it is the European dealers who pocket most of the trading margin.

### Is Counterfeiting Inevitable?

Faced with a rapid proliferation of fakes of all kinds, two types of argument may be heard. To begin with, it is naturally and justifiably indignation that predominates and the representatives of industry, particularly the makers of luxury goods, denounce a crime and demand that exemplary sanctions be taken against counterfeiters.

In France, the Colbert Committee which includes the majority of prestige manufacturers, and, at international level, an international federation of brand industries work untiringly towards a further strengthening of the repressive arsenal.

On the other side, the voices may be heard, less distinctly, of those who willingly acknowledge the unlawful and, in any event, parasitic nature of counterfeiting, but attempt more or less overtly to find an excuse in the name of the economic development of the developing countries.

### An Old Story

If we forget the present for a moment and look at the problem from a historical point of view, we will be struck by the fact that all of the present industrialized States have indeed, in the past, gone through a more or less acute phase of endemic counterfeiting. The same scenario repeats itself for as far back as we can go in the history of industrialization.<sup>11</sup> It would seem that most countries, at the beginning of their own industrial development, have gone through a phase of copying more advanced products.

What logic is to be found in a process that repeats itself with such regularity? If we leave aside the present criminal nature of trade in fakes, how may we explain the almost systematic transition of young economies through a phase of plagiarism?

### A Tried and Tested Development Learning Tool

On reflection, the reason for such a constant state of affairs is simple. It is extremely difficult for enterprises that are generally lacking in capital, without technological tradition and which belong to differing

cultural systems to find their place in an advanced industrial world. In those, rare, cases where they succeed it is practically always empirically and by dint of great resourcefulness.

To obtain the essential foreign currency (in order to buy machines, for instance), they must trade with industrialized market economy countries. However, what can they sell them if they are only beginning to tool up (it should be borne in mind that we are talking here at a micro-economic level and within the framework of capitalist economies) and the goods required by the domestic market are 20 years behind the international standards? The fact that a given State may be a large exporter of sought-after raw materials—and therefore rich in foreign currency as far as the State bank is concerned—has no effect at the micro-economic level of the enterprises.

The simplest thing to do is obviously to copy, without changing anything, but at a lower price, articles whose success is already established and therefore sell themselves (even if it is necessary to associate with not altogether recommendable agents).

Thus, to begin with, counterfeited goods always comprise simple technologies, with a low production cost, that correspond to the development level of the industrial structure of the country concerned. As that development progresses, the means used become more sophisticated and new fields are then entered into. To take the case of data processing, a start is made with microprocessors, via video games, and from there to office computers and so on. The sectors that are left behind are themselves rapidly occupied by new operators who then begin their own “technological and industrial revolution.”

It is therefore not erroneous, as some maintain, to hold that counterfeiting constitutes a kind of informal school of technology and, perhaps more importantly, of commercial marketing know-how. Nevertheless, does the fact that counterfeiting obviously has a “function” make it excusable and, perhaps more importantly, useful for development?

### An Effective, But Double-Edged Tool

Although the systematic practice of industrial copying still avoids today, as it did yesterday, the hazards of research and experimentation and may therefore be considered in that respect as a short cut towards development, on the other hand, too much emphasis cannot be put on the handicap constituted by the mentality, habits and reflexes acquired by years of copying. In yesterday’s world, where things moved slowly and territories were sealed off, that was no great problem and time was available for mentalities to adapt progressively to the needs of indigenous creation. However, that world is disappearing, communication is now instantaneous and any delay costs a heavy price.

<sup>11</sup> Cf., for example, Yves Plasseraud and François Savignon, *Paris 1883, Genèse du droit unioniste des brevets*, Litec, Paris, 1983, pp. 117 et seq.

To be a "copier" is to be left rapidly on one side since technical progress does not wait. Already, in certain fields, manufacturers do not bother to file patent applications because technology becomes so speedily obsolete.<sup>12</sup> What about those, therefore, who have to wait before an article has become a success, before attempting to copy it? To continue to copy, therefore, is paramount to abdicating from creativity and establishing technological dependency.

Furthermore, when development arrives—and there are always individuals who do not simply follow—the negative image of the copier sticks to the country and its original and quality productions suffer a long-term handicap.

### The Repressive Arsenal

The prestige industries being the most effective exporters these days, the industrialized States were not slow to protest as soon as their markets became seriously affected by the fake virus. Using all the possibilities open to them, the manufacturers in those countries frequently spend up to 2% of their turnover to fight against counterfeiting. Alas, the results are not always in line with the efforts made. Although most of the national laws—frequently civil and not criminal laws—indeed contain provisions to repress traditional counterfeiting, they soon proved ill-adapted to a phenomenon that is essentially international and which crosses frontiers. To seize a few copies of a product became pointless if thousands of others were to reappear the next day on other markets.

Confronted with that situation, the associations of manufacturers and other industrial bodies incited governments and international organizations to draw up rules that would go beyond the frontiers of States. Since the counterfeit goods generally came from abroad, and were then distributed by a network of cut and run sellers, it was at the frontiers that they had to be seized.

Successively, the General Agreement on Tariffs and Trade (GATT), WIPO, the European Economic Community (EEC), the Customs Co-operation Council (CCC) and Interpol dealt with this matter.

GATT, following an ambitious project for a code of counterfeiting, is now in the process of adopting a catalog of model clauses for protection.

WIPO, following lengthy and painstaking work (in which the author participated), is envisaging the publication of an important model law (therefore optional), the CCC and the EEC, for their part, rapidly completed concrete projects. The most

advanced text—it is at present in force<sup>13</sup>—is that of the Council of the European Communities. That text provides for customs seizure of goods suspected of being counterfeit. The substantive decision must then of course be taken by a court within 15 days of the seizure. The CCC text<sup>14</sup> published in 1988 also provides for retention in customs of goods that are presumed to be counterfeited and transmission of the file to the competent administrative or judicial authorities for a substantive decision.

### Identification of Fakes and Their Authors

However, although it may seem surprising, the victims of counterfeiting are often faced with the problem not of discovering the counterfeits when the cargo is unloaded—that is the task of specialized detectives—but indeed to distinguish their own products from the imitated goods. In a number of fields, the copy is basically indistinguishable from the original. There are even cases, these are far from being exceptions, where the counterfeited product is manufactured with the same raw materials, technology and means as that of the true creator.

One solution that is often used is that of invisible marking (laser, hologram, for example) applied during production by the true owner of the mark to his authorized products.<sup>15</sup>

There exist a number of well-established firms that specialize in the "technical" fight against counterfeiters, particularly highly specialized detective agencies, that efficaciously supplement the law.

In view of current trends—both as regards national and international legislative and regulatory drafts and the progress made in the physical means of detection—it is probable that the arsenal available to fight counterfeiting will be fully developed. Case by case, field by field, it will then be possible to effectively repress what is at present a curse for many manufacturers (loss of earnings, damaged image, or even rejection of the genuine trademark, and so on). However, as far as society is concerned, it is far from certain that the problem will be resolved.

### A Learning Necessity

The history of this offense unfortunately shows that each step forward in the technique of repression

<sup>13</sup> Council Regulation (EEC) No. 3842/86 of 1 December 1986 laying down measures to prohibit the release for free circulation of counterfeit goods, *Official Journal of the European Communities*, No. L 357 of December 18, 1986, p. 1; see *Industrial Property Laws and Treaties*, MULTILATERAL TREATIES – Text 3-003.

<sup>14</sup> Annex VI to document 34.411f.

<sup>15</sup> Gilles Lipovetsky, *L'empire de l'éphémère*, Gallimard, pp. 80 et seq.

<sup>12</sup> It is, in particular, often the case in the domaine of micro-processors.

is accompanied by an equivalent advance in criminal practice. In the long term, only a sociological change can prove truly effective. In the 19th century, the disappearance of absinth was due as much to a change in consumer habits who moved towards "softer" aniseed beverages as to its statutory prohibition. Likewise, counterfeiting, one of the endemic problems of our society, will only be genuinely reduced, in my opinion, if there is a change in mentalities.

However that may be, irrespective of the outcome of the progressive industrialization of the States referred to above, a number of factors will probably help in the end to marginalize counterfeiting:

1. As far as technological articles are concerned, greater education of consumers and manufacturers should result in a better awareness of their true interests and of the drawbacks of copies which they should gradually reject.

2. A number of well-known names are currently considering the abandon of the "decorative trademark" in order to return to more sober products whose quality would then be their main and best flag.

3. The "breaking up" of fashion, which today has crowned the "individualist," will perhaps make

fashion items less and less imperative and, therefore, make copies less worthwhile.

4. Finally, and this is perhaps the most promising approach, various manufacturers of luxury goods have realized that it is their own policies that to a large extent destroy their trademarks: they have undertaken to collect themselves the derived profits that traditionally fall to the counterfeiters.

The method is simple, it is to propose a range of less expensive items under the well-known mark which can be readily distinguished from the "pilot" goods, but which in view of the trademark they bear will maintain the appeal of the prestige articles. In those fields where this can be done, the consumer is generally satisfied and the counterfeiter beaten on his own ground.

On the other hand, an attempt made some years ago to market so-called "no-name products," that is to say, without trademarks, and which would have obviously constituted a radical solution, has had little success so far and that is understandable if we bear in mind that most of the fields affected by counterfeiting are those in which sales are due to the use of trademarks!

## New Items

### The International Union for the Protection of New Varieties of Plants (UPOV) in 1989

#### State of the Union

On February 1, 1989, Australia deposited its instrument of accession to the International Convention for the Protection of New Varieties of Plants of December 2, 1961, as revised at Geneva on November 10, 1972, and October 23, 1978 (Revised Act of October 23, 1978). The accession of Australia took effect on March 1, 1989.

On October 11, 1989, Poland deposited its instrument of accession to the Revised Act of October 23, 1978. The accession of Poland took effect on November 11, 1989.

Since then, the Union has comprised 19 member States: Australia, Belgium, Denmark, France, Germany (Federal Republic of), Hungary, Ireland, Israel, Italy, Japan, Netherlands, New Zealand, Poland, South Africa, Spain, Sweden, Switzerland, United Kingdom, United States of America. All, except Belgium and Spain, are parties to the Revised Act of October 23, 1978.

#### Sessions

During 1989, the various bodies of UPOV met as described below. Unless otherwise specified, the sessions took place at Geneva.

#### *Council*

The Council held its twenty-third ordinary session on October 17 and 18, under the chairmanship of Mr. W.F.S Duffhues (Netherlands). The session was attended by observers from nine non-member States,<sup>1</sup> four intergovernmental organizations<sup>2</sup> and six international non-governmental organizations.<sup>3</sup>

<sup>1</sup> Argentina, Czechoslovakia, Egypt, Kenya, Morocco, the Philippines, Poland—whose accession had not yet taken effect at the time of the session—, the Republic of Korea, Turkey.

<sup>2</sup> European Communities (EC), European Free Trade Association (EFTA), European Patent Organisation (EPO), Organisation for Economic Co-operation and Development (OECD).

<sup>3</sup> Association of Plant Breeders of the European Economic Community (COMASSO), International Association for the Protection of Industrial Property (AIPPI), International Association of Plant Breeders for the Protection of Plant Varieties (ASSINSEL), International Chamber of Commerce (ICC), International Community of Breeders of Asexually Reproduced Ornamental and Fruit Tree Varieties (CIOPORA), International Federation of the Seed Trade (FIS).

At that session, the Council took the following main decisions:

(i) it approved the Secretary-General's report on the activities of the Union in 1988 and the first nine months of 1989;

(ii) it adopted the Union's program and budget for the 1990-91 biennium;

(iii) it took note of the medium-term plan for the period 1992-1995 presented by the Secretary-General;

(iv) it approved the progress reports on the work of its various subsidiary bodies and drew up or approved plans for their work in the year ahead. In that connection, it decided that the next diplomatic conference on the revision of the Convention would be held in March 1991, and that preparations for that conference should be entrusted to preparatory meetings to be held in April, June and October 1990;

(v) it elected the members of the bureaux of certain subsidiary bodies for a term of three years expiring at the end of the twenty-sixth regular session of the Council, in 1992: Mr. J.-F. Prevel (France) and Mr. H. Kunhardt (Federal Republic of Germany) were respectively elected Chairman and Vice-Chairman of the Administrative and Legal Committee; Dr. G. Fuchs (Federal Republic of Germany) and Mrs. J. Rasmussen (Denmark) were respectively elected Chairman and Vice-Chairman of the Technical Committee; Dr. M.S. Camlin (United Kingdom) was elected Chairman of the Technical Working Party for Agricultural Crops.

#### *Consultative Committee*

The Consultative Committee held its thirty-ninth session on April 14 and its fortieth session on October 16, under the Chairmanship of Mr. W.F.S Duffhues (Netherlands).

Discussions at the thirty-ninth session were mostly devoted to preparations for the fourth Meeting with International Organizations, reconsideration of the list of States and organizations invited to the meetings of UPOV, consideration of the necessity and periodicity of the "statistical" documentation submitted to the regular sessions of the Council, and a general debate on the preparation and date of the meeting of the (joint UPOV/WIPO) Committee of

Experts on the Interface Between Patent Protection and Plant Breeders' Rights, which was subsequently scheduled for the period January 29 to February 2, 1990. The fortieth session was mostly devoted to preparing the twenty-third ordinary session of the Council.

#### *Administrative and Legal Committee*

The Administrative and Legal Committee held its twenty-fourth session from April 10 to 13, under the chairmanship of Mrs. C. Holtz (Sweden), and its twenty-fifth session from October 11 to 13, under the chairmanship of Mr. J.-F. Prevel (France). Observers from the following States and organizations participated in the twenty-fourth session: Argentina, Austria, Brazil, Bulgaria, Finland, Norway, World Intellectual Property Organization (WIPO), EC, EFTA, EPO; observers from the following States and organizations participated in the twenty-fifth session: Argentina, Austria, Brazil, Bulgaria, Canada, Finland, Norway, WIPO, EC, EPO.

The Committee devoted both sessions almost entirely to the revision of the Convention. At the twenty-fourth session, it also took note of a draft document drawn up in preparation for the session of the (joint WIPO/UPOV) Committee of Experts on the Interface Between Patent Protection and Plant Breeders' Rights (document CAJ/XXIV/4).

#### *Technical Committee*

The Technical Committee held its twenty-fifth session on October 5 and 6, under the chairmanship of Mr. J.K. Doodson (United Kingdom).

On the basis of the preparatory work carried out by the Technical Working Parties, the Technical Committee adopted Test Guidelines for the following eight taxa (the asterisk denotes a revised version): (1) banana; (2) chestnut; (3) black currant\*; (4) gerbera\*; (5) Protea; (6) sorghum; (7) triticale; (8) walnut.

The Committee considered the progress reports on the work of the Technical Working Parties and defined the main features of their future work. It also examined the matters raised by the Technical Working Parties on the basis of the experience gained by the member States in carrying out the examination for distinctness, homogeneity and stability of new plant varieties.

Furthermore, the Committee took the following main decisions:

(i) as regards fodder grasses, it formally approved the replacement of the present method of examination for distinctness, in which data are analyzed separately for each vegetation cycle, by the combined over-years analysis (COY), including the

modified joint regression analysis (MJRA). The significance level to be used was set at 1% over two years of testing; the same level is to be used over three years of testing. However, in order to facilitate the transition, member States would be allowed to apply the 5% level for a period of three years;

(ii) it further recommended that the COY analysis should be applied, whenever possible, to the measured characteristics of agricultural and vegetable species;

(iii) it requested the Technical Working Party on Automation and Computer Programs to continue to study the possibility of replacing the criterion applied in examining homogeneity in cross-fertilized plants by a criterion which would also be based on the analysis of data from several years;

(iv) it approved the modification of several standard forms used in variety examination.

Lastly, the Committee examined reports on three workshops, namely, on the examination of varieties of *Elatior Begonia* and *Pelargonium*, the examination of varieties of soybean and the examination of varieties of maize (see below).

#### *Technical Working Parties*

The Technical Working Parties each held one session in 1989, outside Geneva, as follows:

(i) the *Technical Working Party on Automation and Computer Programs (TWC)* held its seventh session from May 17 to 19 in Madrid (Spain), under the chairmanship of Dr. F. Laidig (Federal Republic of Germany);

(ii) the *Technical Working Party for Ornamental Plants and Forest Trees (TWO)* held its twenty-second session from May 29 to June 1 at Hanover (Federal Republic of Germany), under the chairmanship of Mr. C.J. Barendrecht (Netherlands);

(iii) the *Technical Working Party for Agricultural Crops (TWA)* held its eighteenth session from June 13 to 16 at Belfast (United Kingdom), under the chairmanship of Mr. D.P. Feeley (Ireland);

(iv) the *Technical Working Party for Vegetables (T WV)* held its twenty-second session from July 3 to 7 at Tsukuba (Japan), under the chairmanship of Mr. R. Brand (France);

(v) the *Technical Working Party for Fruit Crops (TWF)* held its twentieth session from September 26 to 29 at Wageningen (Netherlands), under the chairmanship of Mrs. E. Buitendag (South Africa).

The basic task of four of these Working Parties is to draw up Test Guidelines. In addition to the drafts submitted to the Technical Committee for adoption, they drew up further drafts, for the following taxa, to be submitted to the professional organizations for comment (the asterisk denotes a draft revised

edition): bent\*, Kentucky bluegrass\*, ryegrass\*, safflower (TWA); red and white currants\* (TWF); carnation\*, chinchinchee, Dieffenbachia, Hydrangea, rose\*, Spathiphyllum, Norway spruce (TWO); asparagus, carrot\*, parsley, Brussels sprouts\*, tomato\* (T WV).

In addition, the *Technical Working Party for Agricultural Crops* decided to include characteristics obtained by electrophoresis in the Test Guidelines for wheat, barley and oats, which are at present under revision; in this connection, it plans to regard the clear absence or presence of a band as a new characteristic, without an asterisk; examination for such a characteristic would therefore be optional. The *Technical Working Party for Ornamental Plants and Forest Trees* noted that in several countries applications for protection must be accompanied by color photographs of the variety. It expressed the opinion that the other member States should adopt the same practice.

### Workshops

Three workshops were organized jointly by the authorities of the host country and UPOV in 1989:

(i) a *Workshop on the Examination of Varieties of Elatior Begonia and Pelargonium* was held on June 1 and 2 at Hanover (Federal Republic of Germany). It was opened by Dr. D. Böringer, President of the Federal Varieties Office;

(ii) a *Workshop on the Examination of Varieties of Soybean* was held from September 27 to 29 at New Carrollton (Maryland, United States of America). It was opened by Dr. K.H. Evans, Commissioner of the Plant Variety Protection Office, and Mr. C.A. Reed, Director of the Commodities Scientific Support Division, Department of Agriculture.

(iii) a *Workshop on the Examination of Varieties of Maize* was held on October 2 and 3 at Versailles (France). It was opened by Mr. P.-L. Lefort, Director of GEVES (Study and Control Group for Varieties and Seed) and Mr. F. Rapilly, President of the Versailles Center of the National Institute of Scientific Research.

At each of these workshops, a number of lectures were given on a variety of technical and legal topics by speakers from public services, scientific and legal circles and industry. Practical demonstrations were given in glasshouses and field plots, and discussions led to the identification of general trends in variety examination, minimum distances between varieties and the revision of the Convention, including the introduction of a principle of "dependency."

As regards *Elatior Begonia* and *Pelargonium*, the general conclusion was reached that the varieties should have minimum distances which are in balance between the scientific possibilities and the interests

of breeders and growers. In these species, an average expert should be able to distinguish varieties. As regards soybean, the participants requested that characteristics of a biochemical nature, notably as obtained by electrophoresis, should be included in the Test Guidelines in the next revision. Lastly, the workshop on maize provided an opportunity to review available methods of examining hybrids and to look into the potential of examination methods based on agronomic, morphological, biochemical and genetic characteristics (restriction fragment length polymorphism).

### Contacts with States and Organizations

On January 16, the Vice Secretary-General paid an official visit to the Commission of the European Communities in Brussels (Belgium) where he met with officials of the Directorate General for Agriculture.

On January 30, the Vice Secretary-General received a visit from Mr. T. Okada, Director of the Seeds and Seedlings Division of the Ministry of Agriculture, Forestry and Fisheries of Japan, and Mr. T. Oobayashi, official of that same Ministry responsible for the International Garden and Greenery Exhibition to be held in Osaka in 1990.

From January 31 to February 3, the Vice Secretary-General participated at Anaheim (California, United States of America) in a working group dealing with the problems, challenges and prospects of plant patents. The event was organized, with the financial assistance of the Department of Agriculture, by the American Society of Agronomy, the Crop Science Society of America, the Soil Science Society of America, the American Agricultural Economics Association and the American Society for Horticultural Science.

On February 13 and 14, an official of the Union participated in Paris (France) in a meeting of the designated authorities responsible for the implementation of the OECD Scheme for the Control of Forest Reproductive Material Moving in International Trade.

In February and March, the Vice Secretary-General had contacts with various persons in India and with the Secretariat General of the International Association of Plant Breeders for the Protection of Plant Varieties (ASSINSEL) in respect of a symposium that was to be held on March 13 in New Delhi (India). Further contacts also took place in the meantime as a result of the growing interest in plant variety protection in India.

On March 1, the Vice Secretary-General paid a visit to the Secretary-General of ASSINSEL to discuss matters of mutual interest.

On March 8, the Vice Secretary-General received a visit from Academician B.A. Runov, a depart-

mental director of Gosagroprom (Central Committee for Agriculture) of the Soviet Union. It should be noted in this respect that the new draft patent law provides that plant and animal varieties are to be protected under a special law.

On March 9, the Secretary-General and the Vice Secretary-General received a visit from Mr. Arpad Szabó, Director of the Department for International Economic Cooperation of the Federal Ministry of Agriculture and Food of Czechoslovakia. Discussions concerned, in particular, the conformity of the draft Czechoslovak law on the legal protection of new varieties of plants and breeds of animals with the UPOV Convention.

On March 10, the Vice Secretary-General received a visit from Mr. A. Calvelo, Honorary Secretary of the Argentine Cereal Exchange, and Mr. A.G. Trombetta, Second Secretary at the Permanent Mission of Argentina in Geneva.

On March 20, the Vice Secretary-General received a visit from Mr. N. Monya, professor of intellectual property law at Seikei University, and Mr. A. Yamaguchi, of the Food and Agriculture Research and Development Association, of Japan.

On April 5, the Vice Secretary-General participated in London (United Kingdom) in a working group on intellectual property protection for innovation in farm animals and poultry, organized by the British Animal Production Society, and presented a paper on the plant variety protection system.

From April 13 to 16, UPOV participated in the International Exhibition of New Varieties of Plants in Geneva (Expoflore).

From April 17 to 20, the Vice Secretary-General participated in Rome (Italy) in the third session of the FAO Commission on Plant Genetic Resources.

On April 21, the Vice Secretary-General paid an official visit to the United Kingdom where he met the officials responsible for plant variety protection.

At the end of April, the Office of the Union was requested by the French authorities to produce a translation into Chinese of the UPOV Convention. The request was made in relation to a visit by a high-level delegation from China. The translation was produced in the early part of May and given by the French authorities to the Vice Minister for Agriculture Wang Liang Zheng.

On May 16, the Vice Secretary-General paid an official visit to Lisbon (Portugal) mainly to discuss the state of progress of the draft Portuguese plant variety protection law.

In the course of the session of the Technical Working Party on Automation and Computer Programs held in Madrid (Spain) from May 17 to 19, the Vice Secretary-General had discussions with the officials responsible for plant variety protection in Spain.

From May 22 to 24, the Vice Secretary-General participated in Paris (France) in the annual meeting

organized by OECD of the representatives of the designated authorities responsible for the implementation of the OECD Schemes for the Varietal Certification of Seeds Moving in International Trade.

On May 31 and June 1, an official of the Union participated in Brussels (Belgium) in a meeting of the Working Group of the European Economic Community "Seeds and Propagating Material: Plant Breeders' Rights," whose task it is to consider a proposal by the Commission relating to a regulation of the Council of the European Communities on Community breeders' rights.

On this occasion, the said official also paid a visit to the Secretary-General of the General Committee for Agricultural Co-operation in the European Economic Community (COGECA) and of the Committee of Agricultural Organisations in the European Economic Community (COPA).

On June 1 and 2, the Vice Secretary-General participated in Tel-Aviv (Israel) in the annual world congress of ASSINSEL.

From June 5 to 8, the Vice Secretary-General participated in Amsterdam (Netherlands) in the World Industrial Property Congress of the International Association for the Protection of Industrial Property (AIPPI) and gave a lecture.

On June 9, the President of the Council and the Vice Secretary-General participated in Amsterdam (Netherlands) in a meeting of the Committee for Novelty Protection of the International Association of Horticultural Producers (AIPH).

On June 12, the Vice Secretary-General received a visit from Mr. Makoto Tabata, Assistant Director of the Seeds and Seedlings Division of Japan, and from an official of the Ministry of Agriculture, Forestry and Fisheries and discussed the organization and financing of a UPOV seminar proposed to be held in Japan in 1991.

On June 16, an official of the Union gave a lecture on plant variety protection in Zurich (Switzerland) in the framework of a training course for patent agents organized by the Association of Patent Agents from Industry of Switzerland (VIPS) and the Association of Swiss Private Patent Practitioners Registered with the European Patent Office (VESPA).

From June 20 to 22, the Vice Secretary-General and an official of the Union paid an official visit to the German Democratic Republic at the invitation of the German Democratic Republic Group of AIPPI and the German Democratic Republic Association for the Protection of Industrial Property. In addition to the discussions on the protection of intellectual property in the field of plants which they had with various interested circles in restricted groups or in a colloquium, a visit was made to the premises of the Central Organization for Variety Matters (*Zentralstelle für Sortenwesen*) in Nossen.

From June 26 to 29, an official of the Union

participated in Edinburgh (United Kingdom) in the twenty-second congress of the International Seed Testing Association (ISTA) which took place from June 21 to 30.

From July 1 to 7, the Vice Secretary-General paid an official visit to Japan where: he participated in Tsukuba Science City in part of the session of the Technical Working Party for Vegetables; he participated in Tokyo in a symposium on the protection of new plant varieties and biotechnology and gave a lecture; he participated, also in Tokyo, in the celebration of the tenth anniversary of plant variety protection in Japan; he met with high officials of the Ministry of Agriculture, Forestry and Fisheries and the Patent Office; he paid a visit to a number of professional organizations; he visited several undertakings and institutions in Tokyo, Yokohama and Tsukuba.

From July 10 to 18, the Vice Secretary-General paid an official visit to Australia where: he participated in Canberra in a workshop on intellectual property protection for plants; he participated in Perth in a conference on the production and marketing of Australian flora; he gave a lecture in Toowoomba at the Queensland Wheat Research Institute to members of that Institute and representatives from the seeds industry; he met with the members of the Plant Variety Rights Advisory Committee and the Acting Commissioner of Patents, and also with representatives of interested circles in Canberra, Sydney and Toowoomba.

On July 26 and 27, an official of the Union participated in Brussels (Belgium) in the meeting of the EEC Working Group "Seeds and Propagating Material: Plant Breeders' Rights."

On August 21, the Vice Secretary-General went to Cambridge (United Kingdom) to discuss the program of future work concerning the revision of the Convention and other questions of general interest with the United Kingdom authorities.

On August 22, the Vice Secretary-General went to Paris (France) for a similar purpose.

On September 1, the Vice Secretary-General went to Hanover (Federal Republic of Germany) for a similar purpose.

On September 11 and 12, the Vice Secretary-General received a visit from Mr. Peter Slimák, Director of the Principal Division for Legislative Affairs, Federal Ministry of Agriculture and Food of Czechoslovakia, and Mr. Vladimír Duris, Third Secretary at the Permanent Mission of Czechoslovakia in Geneva. Detailed discussions took place on the conformity of the draft Czechoslovak law on the legal protection of new varieties of plants and breeds of animals with the UPOV Convention and on the

procedure to be followed in relation to accession to the Convention.

On September 20, the Vice Secretary-General participated in Brussels (Belgium) in the meeting of the EEC Working Group "Seeds and Propagating Material: Plant Breeders' Rights."

On September 21 and 22, the Vice Secretary-General participated in Cambridge (United Kingdom) in the Fifth Conference on Plant Variety Protection, Biotechnology and Intellectual Property, organized by Queen Mary College (University of London), and gave a lecture.

On September 26, in connection with the Workshop on the Examination of Varieties of Soybean, the Vice Secretary-General and an official of the Union met in Washington, D.C. (United States of America) with high officials of the Department of Agriculture and with representatives of interested circles.

On October 23, the Vice Secretary-General participated in Brussels (Belgium) in the meeting of the EEC Working Group "Seeds and Propagating Material: Plant Breeders' Rights."

On October 25, the Vice Secretary-General participated in Paris (France) in a conference on recent legal developments in the field of biotechnology in Europe, the United States and Japan, and gave a lecture.

On November 16 and 17, the Vice Secretary-General paid an official visit to Moscow (Soviet Union) where he met high-ranking officials and members of the V.I. Lenin Academy of Agricultural Science.

On December 4 and 5, the Vice Secretary-General and an official of the Union participated in Brussels (Belgium) in the meeting of the EEC Working Group "Seeds and Propagating Material: Plant Breeders' Rights."

On December 13 and 14, the Vice Secretary-General participated in a conference organized at Cambridge (United Kingdom) by the National Institute of Agricultural Botany on the theme "new technologies—cultivated plants of the 1990s," at which he gave a lecture.

On December 14 and 15, an official of the Office of the Union participated in Geneva in an informal meeting for coordination between a number of inter-governmental organizations involved in the field of environmental protection and the conservation of fauna and flora.

### Publications

In 1989, the Office of the Union published two issues of *Plant Variety Protection*.



## CZECHOSLOVAKIA

*President,  
Federal Office for Inventions*

We have been informed that Ing. Ladislav Jakl has been appointed President of the Federal Office for Inventions.

## PANAMA

*Director General,  
Directorate General of the Industrial  
Property Registry*

We have been informed that Lic. Pedro O. Bolívar C. has been appointed Director General of the Directorate General of the Industrial Property Registry.

## Calendar of Meetings

### WIPO Meetings

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

1990

- May 28 to June 1 (Geneva)**      **Committee of Experts on the International Protection of Geographical Indications**
- The Committee will examine a document prepared by the International Bureau of WIPO on the need for a new multilateral treaty on the international protection of geographical indications and its possible content.  
*Invitations:* States members of the Paris Union and, as observers, certain organizations.
- June 5 to 8 (Geneva)**      **Consultative Meeting of Developing Countries on the Harmonization of Patent Laws**
- This consultative meeting will, on the basis of a working document prepared by the International Bureau of WIPO, study problems of particular relevance to developing countries in connection with the preparation of a treaty supplementing the Paris Convention as far as patents are concerned (patent law treaty).  
*Invitations:* Developing countries members of the Paris Union or WIPO.
- June 11 to 22 (Geneva)**      **Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions (Eighth Session)**
- The Committee will continue to examine a draft treaty supplementing the Paris Convention as far as patents are concerned (patent law treaty).  
*Invitations:* States members of the Paris Union and, as observers, States members of WIPO not members of the Paris Union and certain organizations.
- June 19 to 22 (Geneva)**      **Preparatory Meeting for the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as Far as Patents Are Concerned**
- The Meeting will prepare the organization of the diplomatic conference which will be convened to negotiate and adopt a treaty supplementing the Paris Convention as far as patents are concerned (patent law treaty).  
*Invitations:* States members of the Paris Union.
- June 25 to 29 (Geneva)**      **Committee of Experts on the Harmonization of Laws for the Protection of Marks (Second Session)**
- The Committee will continue to examine a draft trademark law treaty.  
*Invitations:* States members of the Paris Union, the European Communities and, as observers, States members of WIPO not members of the Paris Union and certain organizations.
- July 2 to 6 (Geneva)**      **PCT Committee for Administrative and Legal Matters (Third Session)**
- The Committee will examine proposals for amending the Regulations under the Patent Cooperation Treaty (PCT), in particular in connection with the procedure under Chapter II of the PCT.  
*Invitations:* States members of the PCT Union and, as observers, States members of the Paris Union not members of the PCT Union and certain organizations.
- July 2 to 13 (Geneva)**      **Committee of Experts on Model Provisions for Legislation in the Field of Copyright (Third Session)**
- The Committee will continue to consider proposed standards in the field of literary and artistic works for the purposes of national legislation on the basis of the Berne Convention for the Protection of Literary and Artistic Works.  
*Invitations:* States members of the Berne Union or WIPO and, as observers, certain organizations.
- September 24 to October 2 (Geneva)**      **Governing Bodies of WIPO and the Unions Administered by WIPO (Twenty-First Series of Meetings)**
- Some of the Governing Bodies will meet in ordinary session, others in extraordinary session.  
*Invitations:* As members or observers (depending on the body), States members of WIPO or the Unions and, as observers, other States and certain organizations.

- October 15 to 26 (Geneva)**      **Committee of Experts Set Up Under the Nice Agreement (Sixteenth Session)**  
 The Committee will complete the fifth revision of the classification established under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks.  
*Invitations:* States members of the Nice Union and, as observers, States members of the Paris Union not members of the Nice Union and certain organizations.
- October 22 to 26 (Geneva)**      **Committee of Experts on the Settlement of Intellectual Property Disputes Between States (Second Session)**  
 The Committee will examine principles for a possible multilateral treaty.  
*Invitations:* States members of the Paris Union, the Berne Union or WIPO or party to the Nairobi Treaty and, as observers, certain organizations.
- October 29 to November 2 (Geneva)**      **Committee of Experts on a Protocol to the Berne Convention (First Session)**  
 The Committee will examine whether the preparation of a protocol to the Berne Convention for the Protection of Literary and Artistic Works should start, and—if so—with what content.  
*Invitations:* States members of the Berne Union and, as observers, States members of WIPO not members of the Berne Union and certain organizations.
- October 29 to November 2 (Geneva)**      **Working Group on a Possible Revision of the Hague Agreement (First Session)**  
 This working group will consider possibilities for revising the Hague Agreement Concerning the International Deposit of Industrial Designs, or adding to it a protocol, in order to introduce in the Hague system further flexibility and other measures encouraging States not yet party to the Hague Agreement to adhere to it and making it easier to use by applicants.  
*Invitations:* States members of the Hague Union and, as observers, States members of the Paris Union not members of the Hague Union and certain organizations.
- November 26 to 30 (Geneva)**      **Working Group on the Application of the Madrid Protocol of 1989 (Second Session)**  
 The working group will continue to study Regulations for the implementation of the Madrid Protocol of 1989.  
*Invitations:* States members of the Madrid Union, States having signed or acceded to the Protocol, the European Communities and, as observers, other States members of the Paris Union expressing their interest in participating in the Working Group in such capacity and certain non-governmental organizations.
- December 10 to 14 (Geneva)**      **PCT Committee for Administrative and Legal Matters (Fourth Session)**  
 The Committee will continue the work started during its third session (July 2 to 6, 1990).  
*Invitations:* States members of the PCT Union and, as observers, States members of the Paris Union not members of the PCT Union and certain organizations.
- 1991**
- January 28 to 30 (Geneva)**      **Information Meeting(s) on the Revision of the Paris Convention**  
 An information meeting of developing countries members of the Paris Union and China and, if it is so desired, information meetings of any other group of countries members of the Paris Union will take place for an exchange of views on the new proposals which will have been prepared by the Director General of WIPO for amending the articles of the Paris Convention for the Protection of Industrial Property which are under consideration for revision.  
*Invitations:* See the preceding paragraph.
- January 31 and February 1 (Geneva)**      **Assembly of the Paris Union (Fifteenth Session)**  
 The Assembly will fix the further procedural steps concerning the revision of the Paris Convention and will take cognizance of the aforementioned proposals of the Director General of WIPO. It will also decide the composition of a preparatory meeting which will take place in the first half of 1991.  
*Invitations:* States members of the Paris Union and, as observers, States members of WIPO not members of the Paris Union and certain organizations.
- June 3 to 28  
(dates and place to be confirmed)**      **Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as Far as Patents Are Concerned**  
 This diplomatic conference will negotiate and adopt a treaty supplementing the Paris Convention as far as patents are concerned (patent law treaty).  
*Invitations:* To be decided by the preparatory meeting to be held from June 19 to 22, 1990 (see above).

- September 23 to October 2 (Geneva)** **Governing Bodies of WIPO and the Unions Administered by WIPO (Twenty-Second Series of Meetings)**  
 All the Governing Bodies of WIPO and the Unions administered by WIPO meet in ordinary sessions every two years in odd-numbered years. In the sessions in 1991, the Governing Bodies will, *inter alia*, review and evaluate activities undertaken since July 1990, and consider and adopt the draft program and budget for the 1992-93 biennium.  
*Invitations:* States members of WIPO or the Unions and, as observers, other States members of the United Nations and certain organizations.
- November 18 to December 6 (dates and place to be confirmed)** **Diplomatic Conference on the Revision of the Paris Convention for the Protection of Industrial Property (Fifth Session)**  
 The Diplomatic Conference is to negotiate and adopt a new Act of the Paris Convention.  
*Invitations:* States members of the Paris Union and, without the right to vote, States members of WIPO or the United Nations not members of the Paris Union as well as, as observers, certain organizations.

## UPOV Meetings

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

### 1990

- June 25 to 29 (Geneva)** **Administrative and Legal Committee (Twenty-Seventh Session)**  
 The Committee will continue the preparations for the Diplomatic Conference for the Revision of the UPOV Convention.  
*Invitations:* Member States of UPOV and, as observers, certain non-member States and inter-governmental organizations.
- October 10 and 11 (Geneva)** **Fifth Meeting with International Organizations**  
 The meeting is to enable international non-governmental organizations to express views on questions concerning the revision of the UPOV Convention.  
*Invitations:* Member States of UPOV and certain international non-governmental organizations.
- October 12, 15 and 16 (Geneva)** **Administrative and Legal Committee (Twenty-Eighth Session)**  
 The Committee will continue the preparations for the Diplomatic Conference for the Revision of the UPOV Convention.  
*Invitations:* Member States of UPOV and, as observers, certain non-member States and inter-governmental organizations.
- October 17 (Geneva)** **Consultative Committee (Forty-Second Session)**  
 The Committee will prepare the twenty-fourth ordinary session of the Council.  
*Invitations:* Member States of UPOV.
- October 18 and 19 (Geneva)** **Council (Twenty-Fourth Ordinary Session)**  
 The Council will examine the reports on the activities of UPOV in 1989 and the first part of 1990 and approve documents for the Diplomatic Conference for the Revision of the UPOV Convention.  
*Invitations:* Member States of UPOV and, as observers, certain non-member States and inter-governmental and non-governmental organizations.

### 1991

- March 4 to 19 (dates and place to be confirmed)** **Diplomatic Conference for the Revision of the UPOV Convention**  
*Invitations:* Member States of UPOV and, without the right to vote, States members of the United Nations not members of UPOV as well as, as observers, certain organizations.

## Other Meetings Concerned with Industrial Property

### 1990

- September 12 to 16 (Brussels)** **International League for Competition Law (LICD): 31st Congress**