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Industrial Property Statistics for 1989 (Publication A)

### INDUSTRIAL PROPERTY LAWS AND TREATIES (INSERT)

Editor's Note

### UNITED KINGDOM

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### WIPO 1990

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## Notifications Concerning Treaties

### WIPO Convention

#### Communication by Germany

The Permanent Representative of Germany to the Office of the United Nations and to the other International Organizations in Geneva has requested that the following contents of his letter addressed to the Director General of WIPO, dated October 3, 1990, and received on that date, be communicated:

"[T]hrough the accession of the German Democratic Republic to the Federal Republic of Germany with effect from 3 October 1990, the two German states have united to form one sovereign state, which as a single member of the World Intellectual Property Organization remains bound by the provisions of the Convention Establishing the World Intellectual Property Organization. As from the date of unification, the Federal Republic of Germany will act in the World Intellectual Property Organization under the designation of 'Germany'."

*WIPO Notification No. 150, of October 12, 1990.*

### Patent Cooperation Treaty (PCT)

#### New Member of the PCT Union

#### POLAND

The Government of Poland deposited, on September 25, 1990, its instrument of accession to the Patent Cooperation Treaty (PCT), done at Washington on June 19, 1970, amended on October 2, 1979, and modified on February 3, 1984.

The said instrument contains the following declaration:

"The Republic of Poland decides to accede to the said Treaty declaring, pursuant to Article 64(2)(a)(i) and (ii) of the Treaty that:

– it shall not be bound by the provisions of Article 39(1) with respect to the furnishing of a

copy of the international application and a translation thereof;

– the obligation to delay national processing, as provided for under Article 40, shall not prevent publication, by or through the Patent Office of the Republic of Poland, of the international application or a translation thereof." (*Translation*)

The said Treaty will enter into force, with respect to Poland, on December 25, 1990.

*PCT Notification No. 59, of September 25, 1990.*

### Budapest Treaty

#### Extension and Clarification of the List of Kinds of Microorganisms and Related Fees

EUROPEAN COLLECTION OF ANIMAL  
CELL CULTURES (ECACC)

(United Kingdom)

The following notification addressed to the Director General of WIPO by the Government of the United Kingdom under Rule 3.3 of the Regulations under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure was received on October 10, 1990:

In accordance with Rule 3.3 of the Regulations under the Treaty, the Government of the United Kingdom of Great Britain and Northern Ireland hereby notify you of the following extensions to and clarification of the list of organisms that the ECACC will accept for deposit under the Budapest Treaty:

- (a) Animal cell cultures including human cell lines, genetically modified cell lines and hybridomas.
- (b) Viruses as described in the communication of April 3rd, 1985.<sup>1</sup>
- (c) Plant cell suspension cultures.

<sup>1</sup> See *Industrial Property*, 1985, p. 163.

(d) Eukaryotic and viral recombinant DNA as naked DNA or cloned into a host organism.

Organisms up to and including ACDP Category 3\* and ACGM Category 3\*\* deposits are accepted by the Collection.

Notwithstanding the foregoing, the ECACC reserves the right to refuse to accept any material for deposit which in the opinion of the Curator presents an unacceptable risk or is technically unsuitable to handle. The ECACC will accept organisms which do not significantly change after long-term liquid nitrogen freezing or freeze drying. A statement regarding potential pathogenicity and storage conditions is required when a deposit is made.

#### *Schedule of Fees*

##### *Plant cell suspension cultures*

Storage for the 30-year period	£750
Issue of a viability statement (Rule 10.2)	35
Furnishing of a sample in accordance with Rule 11.2 or 11.3 (plus cost of carriage)	60

##### *Eukaryotic and viral recombinant DNA as naked DNA or cloned into a host organization*

Storage for the 30-year period	400
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Issue of a viability statement (Rule 10.2)	35
Furnishing of a sample in accordance with Rule 11.2 or 11.3 (plus cost of carriage)	60

Fees for other deposits remain unaltered from the previous notification (April 3rd, 1985, April 1st, 1987)<sup>2</sup> and should be made payable to the Public Health Laboratory Service Board.

\* Advisory Committee on Dangerous Pathogens: Categorisation of Pathogens according to Hazard and Categories of Containment, HMSO, London, 1984.

\*\* Advisory Committee on Genetic Manipulation, HSE Note 7, HMSO, London, 1988.

[End of text of the notification of the Government of the United Kingdom]

Pursuant to Article 7(2)(b) of the Budapest Treaty, the extension of the list of kinds of microorganisms accepted for deposit by ECACC and the related fees will apply as from November 30, 1990 (date of the present issue of *Industrial Property*).

*Budapest Notification No. 65 (this notification is the subject of Budapest Notification No. 92, of October 19, 1990).*

<sup>2</sup> *Ibid.*, 1985, p. 163; 1987, p. 147.

# WIPO Meetings

## Paris Union

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

Second Session  
(Geneva, June 25 to 29, 1990)

#### 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 second session in Geneva from June 25 to 29, 1990.<sup>1</sup>

The following States members of the Paris Union were represented at the session: Algeria, Austria, Belgium, Canada, Central African Republic, China, Czechoslovakia, Democratic People's Republic of Korea, Denmark, Finland, France, German Democratic Republic, Germany (Federal Republic of), Greece, Hungary, Indonesia, Iraq, Ireland, Italy, Japan, Libya, Mexico, Netherlands, New Zealand, Norway, Portugal, Republic of Korea, Romania, Soviet Union, Spain, Sweden, Switzerland, Turkey, United Kingdom, United States of America (35). In addition, the European Communities (EC) were represented.

The following States members of WIPO were represented by observers: Angola, Chile, Ecuador, India, Swaziland (5). Representatives of two inter-governmental organizations and 24 non-governmental organizations also participated in an observer capacity. The list of participants follows this Note.

The discussions of the second session of the Committee of Experts were based on the following document prepared by the International Bureau of WIPO: "Draft Trademark Law Treaty (Articles 1 and 2, 101 to 103 and 201 to 209)" (document HM/CE/II/2).

In the present Note, any references to "the Draft Treaty," as well as to any given "draft Article" and

"draft paragraph" are references to the Draft Treaty, the given draft Article or draft paragraph as proposed by the International Bureau in document HM/CE/II/2.

After hearing general statements from two delegations, the Committee of Experts discussed the questions contained in document HM/CE/II/2 and set out below.

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

Article 1 of the Draft Treaty as submitted by the International Bureau read as follows:

*"The Contracting Parties 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:

"It was agreed that this draft Article should be maintained in the Draft Treaty and that the following observations should be taken into consideration.

One delegation pointed out that the text of the draft Article could have been more explicit, and that it would have been desirable to have the object of the Draft Treaty specified."

#### *Article 2: Definitions*

Article 2 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:*

\* Prepared by the International Bureau.

<sup>1</sup> For a note on the preceding session, see *Industrial Property*, 1990, p. 101.

(i) 'mark' means a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises and shall be construed as including both trademarks and service marks;

(ii) 'Office' means the governmental or intergovernmental agency entrusted with the registration of marks by a Contracting Party;

(iii) references to a 'registration' shall be construed as references to a registration of a mark by an Office;

(iv) references to an 'application' shall be construed as references to an application for registration;

(v) references to a 'person' shall be construed as references to both a natural person and a legal entity;

(vi) 'applicant' means the person who files the application and shall be construed as including his successor in title;

(vii) 'official language' means the language or languages in which the Office concerned publishes details of marks registered by it;

(viii) '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;

(ix) 'priority date' means the filing date of the application (whether filed with the same or another Office) whose priority is claimed;

(x) 'territory of a Contracting Party' means, where the Contracting Party is a State, the territory of that State and, where the Contracting Party is an intergovernmental organization, the territory in which the constituent treaty of that intergovernmental organization applies;

(xi) 'Union' means the Union referred to in Article 1;

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

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

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

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

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

"It was agreed that this draft Article should be maintained in the Draft Treaty and that the following observations should be taken into consideration.

*Item (i).* One delegation pointed out that the definition proposed was incomplete as it spoke only of a sign, whereas it was common and

indeed acceptable for a mark to be constituted by a combination of signs.

One delegation said that, as far as it was concerned, the definition proposed did not present any particular problem insofar as account was also taken of the text of draft Article 101(1). Although able to accept the proposed text, it would nevertheless prefer to have the definition in draft Article 2(i) and the text of draft Article 101(1) combined in one and the same definition.

One delegation commented that, if the term 'mark' were to denote both trademarks and service marks, the English title of the Draft Treaty should not refer only to the former, which might suggest that the subject matter of the Treaty was confined to them.

The same delegation, and others, also pointed out that the word 'sign' was not defined, and that it would be useful to give it a definition. It was pointed out moreover that an office did not register signs but rather marks, and that it would be more correct, in the context of this draft Article, to speak of signs capable of constituting marks.

*Item (ii).* One delegation expressed the view that it was not necessary to state that the agency entrusted with the registration of marks by a Contracting Party could be governmental or intergovernmental.

*Item (iii).* One delegation pointed out that the definition proposed spoke of the registration of a mark, whereas draft Article 101(1) spoke of the registration of a sign, and that the terminology used should therefore be made consistent.

Another delegation drew attention to the fact that the definition proposed did not cover the case of marks registered by the International Bureau under the Madrid Agreement Concerning the International Registration of Marks, and that it should be amended to make allowance for such marks.

One delegation considered on the other hand that any international mark had the effect of the registration of a national or regional mark, and was therefore covered *ipso facto* by the proposed definition.

*Item (iv).* The representative of an observer organization was of the opinion that, at the application stage, there was good reason not to speak of a mark, and that it was rather a question of an application for the registration of a sign as a mark.

*Item (v).* One delegation considered that the reference in the proposed definition to a 'legal entity' was too restrictive, and that account should also be taken of legal entities which, without actually having legal personality, could be enti-

tled, under the legislation to which they were subject, to hold industrial property rights.

A number of delegations supported the above view, pointing out in particular that, in certain countries, cultural or sporting associations were sometimes entitled to own marks, and that reference should be made to the national law governing such entities, in order to prevent them from being denied the right to file a mark in other countries. It was also suggested that the Treaty should attempt to define those persons who were entitled to be the owners of marks.

The representative of an observer organization pointed out, moreover, that the word 'enterprise' was used in item (i), whereas 'person' was used in item (v), and that the same term should always be used when the context was the same.

*Item (vi).* One delegation said that the French term '*ayant cause*' was not applicable to the person who became the owner by virtue of an assignment, and that it would be more appropriate to use the two terms '*ayant cause*' and '*ayant droit*' (the English term 'successor in title' covers both).

Another delegation considered for its part that the phrase 'the person who files the application' should be replaced with 'the person in whose name the application is filed.'

*Item (vii).* One delegation felt that it was perhaps not necessary to define the expression 'official language,' which was used only once, in draft Article 203. It also pointed out that it would be preferable to use the expression 'language of procedure,' and not to define the expression by just one procedural act, namely publication. The definition could, for instance, be: "language of procedure" means the language or languages that should be used in procedures before the office concerned.'

One delegation considered that, even if the expression 'official language' were used only in draft Article 203, it still had to be defined.

*Item (viii).* It was pointed out that the 'International Classification' in question was mentioned only once, in draft Article 202, and that it would perhaps be preferable to mention it only in the body of that draft Article, without giving it a definition in draft Article 2.

*Item (ix).* A number of delegations and representatives of observer organizations were of the opinion that it was not desirable to make any reference to the concept of internal priority, that the bracketed phrase could be deleted and that it would be preferable to make a reference to Article 4 of the Paris Convention.

One delegation pointed out in that connection that, even if the bracketed phrase were deleted,

Contracting States would still be free to provide for a system of internal priority. It suggested, moreover, that the formulation proposed in the French version, which spoke of a '*date de dépôt*' (suggesting deposit), was perhaps not appropriate in the case of marks registered under the Madrid Agreement.

*Items (x) to (xv).* These items did not give rise to any comment."

#### *Article 101: Registrable Signs*

Article 101 of the Draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

*"(1) [Signs Capable of Being Represented Graphically] Subject to Article 102(1), any sign capable of being represented graphically shall be eligible for registration, including, in particular, the following:*

- (i) words, including names;*
- (ii) letters and numerals;*
- (iii) pictures; images and designs;*
- (iv) three-dimensional forms, including the shape of products and the shape of their packaging and their containers;*
- (v) colors;*
- (vi) sounds, including musical phrases;*
- (vii) combinations of the above-mentioned signs.*

*(2) [Other Signs] Any Contracting Party shall be free to consider signs that are not capable of being represented graphically as eligible for registration, provided that the applicant supplies a description of the sign in writing."*

The portion of the report of the Committee of Experts concerning the discussion of Article 101 reads as follows:

"It was agreed that this draft Article should be maintained in the Draft Treaty and that the following observations should be taken into consideration.

*Paragraph (1).* With regard to the enumeration in draft Article 101(1), one delegation considered that a list should be given of signs on which there was a very strong consensus. The Secretariat pointed out in that connection that a harmonization treaty should not content itself with recording what was commonly accepted, but should rather attempt to make things progress, taking due account in particular of technological developments that could have a bearing on the field of marks.

Certain representatives of observer organizations expressed the wish that the list of signs

capable of constituting marks should be based on the Directive of the European Communities.

With regard to drafting, it was also pointed out that the French and Spanish texts of draft Article 101 contained a mistranslation liable to suggest that what was mandatory under the English text would be optional under the other two.

The following comments were made on the list of signs in draft Article 101(1):

*Item (i).* With regard to the expression 'names' it was requested that surnames be expressly referred to.

*Item (iii).* A number of delegations and representatives of observer organizations considered that the word 'designs' ('dessins') was inappropriate and liable to create confusion with industrial designs. It was further pointed out that it was not possible to make a real distinction between 'pictures' and 'images,' and that it should be possible to replace the words 'pictures, images and designs' with a single word, for instance, the English term 'devices.'

*Item (iv).* After an exchange on the subject of 'three-dimensional forms,' it was generally agreed that such forms, while including the shape of products and the shape of their packaging and their containers, were not, however, confined to those shapes, and that the present text, the formulation of which was sufficiently broad, should be retained. One delegation nevertheless expressed the view that the shape of a product could not constitute a mark.

*Items (v) and (vi).* A number of delegations expressed reservations regarding the mention of 'colors' and 'sounds.'

With regard to 'colors,' certain delegations said that only combinations of colors could be protected in their countries, whereas others mentioned that, in theirs, a mark could be constituted by a single color insofar as it was a shade of color that was clearly defined.

As for 'sounds,' several delegations expressed reservations on the question whether they could constitute a mark at all. One delegation considered, moreover, that sounds could not be considered signs capable of being represented graphically, and that they could only be protected under specific laws like the laws on copyright.

*Item (vii).* In reply to a question raised by one delegation, the Secretariat stated that the combinations of signs referred to concerned not only signs mentioned in different items (for instance, a word and a design), but also signs mentioned in one and the same draft item (for instance, letters and numerals).

*Paragraph (2).* This paragraph did not give rise to any comments."

#### *Article 102: Absolute Grounds for Refusal of Registration*

Article 102 of the Draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

"(1) [Absolute Grounds] *Registration of a sign as a mark shall be refused on each of the following grounds:*

(i) *the sign is devoid of any distinctive character;*

(ii) *the sign has become generic on the territory of the Contracting Party where protection is claimed;*

(iii) *the sign may serve, in trade, to designate the kind, quality, quantity, intended purpose, value or place of origin of the goods or services, or the time of production of the goods or of rendering of the services;*

(iv) *the sign is contrary to morality or public order;*

(v) *the sign is susceptible of deceiving the public.*

(2) [Partial Refusal] *Where any of the grounds referred to in paragraph (1) apply to only some of the goods or services in respect of which registration is sought, registration shall be refused only in respect of those goods or services.*

(3) [Consideration of Factual Circumstances] *In determining whether any of the grounds referred to in paragraph (1) applies, all factual circumstances shall be taken into consideration."*

The portion of the report of the Committee of Experts concerning the discussion of Article 102 reads as follows:

"It was agreed that this draft Article should be maintained in the Draft Treaty and that the following observations should be taken into consideration.

*Paragraph (1).* A number of delegations and representatives of observer organizations said that a distinction should be made between the question of the harmonization of absolute grounds for nullity and that of the harmonization of procedures, and considered that the Treaty should confine itself to harmonizing rules of law, and not impose the observance of certain procedures. In that connection, it was pointed out that draft Article 102 should only state the grounds on which a mark could be refused or invalidated. It was recalled, moreover, that the expression 'registration of a sign' should be avoided, even if it were accompanied by the phrase 'as a mark.'

Some delegations considered, on the other hand, that *ex officio* examination of absolute grounds for invalidation should be mandatory.



Several delegations and representatives of observer organizations were of the opinion that an exhaustive list should be drawn up of the grounds for refusal or invalidation of the mark, as had been done in the Directive of the European Communities, and that the list appearing in the draft under consideration should be extended and made more precise: a list that was too concise, and written in too-general terms, could, as one delegation pointed out, give rise to an excessively broad interpretation, which could lead to the introduction of grounds other than those expressly provided for.

It was suggested that draft paragraph (1) should embody the principle that the applicant had a right to registration except where one of the grounds for refusal mentioned in that paragraph existed.

It was pointed out in particular that the list should expressly mention the case of Article 6ter of the Paris Convention.

One delegation suggested mentioning signs that were prohibited under national legislation, as those signs were not necessarily covered by the concept of public order violations.

Several delegations were of the opinion that it would be desirable to reproduce the actual terms of Article 6quinquies of the Paris Convention, as that Article was in any event still applicable, and that case law had evolved in the light of its wording.

In that connection, one delegation and the representative of an observer organization pointed to the difference between Article 6quinquies of the Paris Convention and draft Article 102, in that the former limited the possibility of refusal of a mark registered in another country of the Paris Union to cases that were expressly mentioned in that provision, whereas the latter was intended to oblige the Contracting Parties to refuse a registration on the grounds stated.

One delegation desired, moreover, not only that the list of grounds for refusal and invalidation be exhaustive, but also that its exhaustiveness be specified in the Article itself.

*Item (i).* Certain delegations said that account should be taken of the use of a mark when ascertaining whether or not it had distinctive character. In that respect the Treaty should expressly recognize that distinctive character could be inherent in the mark or could have been acquired. One delegation, for its part, wanted the item to be amended to reflect that distinctive character could be acquired.

*Item (ii).* It was pointed out that the sign constituting a mark could not only have become generic, but be at the outset generic by nature, and that in such a case the sign could not consti-

tute a mark susceptible of registration, because it would not have distinctive character.

*Item (iii).* Some delegations regarded the formulation of Article 6quinquies as being more explicit. It was pointed out, in particular, that the expression 'when they [the marks] ... consist exclusively of signs....'

*Item (iv).* It was pointed out by one delegation that the use of certain signs could be prohibited by national legislation for reasons of public order, but that they could nevertheless be registered as marks.

Another delegation wished to emphasize that the 'contrary to public order' concept could not be extended to all the cases mentioned in paragraph 102.07 of the Notes on draft Article 102, in other words, including the cases in which the mark was contrary to national law.

*Paragraph (2).* One delegation suggested that it would be difficult to allow a partial registration, as a result of a partial refusal, without the applicant having amended his application.

*Paragraph (3).* With regard to consideration of factual circumstances, an examination was requested whether circumstances other than long use of the mark could exist, including, for instance, intensive advertising, which could give the mark distinctive character in a very short time.

As a general comment, one delegation asked for the Draft Treaty to specify that, in the examination of absolute grounds for invalidation, account should be taken of the overall impression and not of each element of the mark individually."

#### *Article 103: Conflicts with Prior Rights*

Article 103 of the Draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

"(1) [Conflict With a Registered Mark] (a) *Registration of the sign that is the subject of the application shall be refused if the sign is identical or confusingly similar to a mark of another enterprise registered with effect in the territory of the Contracting Party for which registration of the sign is sought, and registration of the sign is sought in respect of the same goods or services as the said mark, or in respect of other goods or services in connection with which the sign under examination would be likely, in view of the said mark and the goods or services for which it is registered, to mislead the public, provided that the application on which the said mark has been registered had an earlier filing or, where appli-*

cable, priority date than the application for the registration of the sign.

(b) Registration of the sign referred to in subparagraph (a) shall also be refused if the mark referred to in that subparagraph has not been registered but is the subject of an application with an earlier filing or, where applicable, priority date than the application for the registration of the sign, provided that the mark is subsequently registered.

(2) [Conflict with a Well-Known and Exceptionally Well-Known Mark] Registration of the sign that is the subject of the application shall be refused

(i) if the sign is identical or confusingly similar to a well-known mark of another enterprise and registration of the sign is sought in respect of the same goods or services as those for which the well-known mark is known in the territory of the Contracting Party, or in respect of other goods or services in connection with which the sign under examination would be likely, in view of the notoriety of the well-known mark, to mislead the public; or

(ii) if the sign is identical or confusingly similar to an exceptionally well-known mark of another enterprise, regardless of the goods or services for which registration of the sign is sought.

(3) [Conflict with an Unregistered but Used Mark] Any Contracting Party shall be free to provide that registration of the sign referred to in subparagraph (1)(a) shall be refused even if the mark referred to in that subparagraph has not been registered and is not the subject of an application, provided that the mark has been continuously used in good faith in commerce in the territory of the Contracting Party, in respect of the same goods or services as those for which registration of the sign is sought, or in respect of other goods or services in connection with which the sign under examination would be likely, in view of the goods or services in respect of which the mark has been so used, to mislead the public, from a date preceding both the date of commencement of any continuous use of the sign in commerce in the territory of the Contracting Party by the applicant or his predecessor in title, in respect of such goods or services, and the filing or, where applicable, priority date of the application for registration of the sign.

(4) [Conflict with Other Prior Rights] Any Contracting Party shall be free to provide that registration of the sign that is the subject of the application may be refused on any of the following grounds:

(i) the sign is identical or confusingly similar to a trade name of another enterprise and the sign would be likely, in view of the trade name, to mislead the public;

(ii) the sign reproduces a protected industrial design or a work protected by copyright;

(iii) the sign is identical or confusingly similar to a protected geographical indication;

(iv) the sign would constitute a violation of personal rights such as the right to a personal name or the right to a personal portrayal.

(5) [Partial Refusal] Where any of the grounds referred to in paragraphs (1), (2)(i) and, where applicable, (3) and (4) apply to only some of the goods or services in respect of which registration is sought, registration shall be refused only in respect of those goods or services.

(6) [Effect of Consent of Holder of Prior Right] Where the owner of any of the rights referred to in paragraphs (1), (2) and, where applicable, (3) and (4) consents to the registration of the sign referred to in those paragraphs, the registration of the sign shall be refused only if, in view of the prior right, the public would be likely to be misled.

(7) [Non-applicability of Anteriority Examination] Any Contracting Party that does not provide for the ex officio examination of the application to determine whether the registration of the sign that is the subject of the application is prevented by virtue of the rights of any person other than the applicant in respect of the sign shall be free not to apply paragraphs (1) and (2), provided that, if it does not apply those paragraphs, it shall also not apply paragraphs (3) or (4)."

The portion of the report of the Committee of Experts concerning the discussion of Article 103 reads as follows:

"It was agreed that this draft Article should be maintained in the Draft Treaty and that the following observations should be taken into consideration.

*Paragraph (1).* One delegation referred to the problems it had experienced with the notion of 'registration of the sign,' which should be replaced in the next version of the Draft Treaty by the words 'registration of the mark.'

It was suggested that the taking into account of the priority date of the application as referred to in draft subparagraph (1) should apply in the same way to subparagraphs (a) and (b) of the draft paragraph.

Several delegations stated that, whilst supporting the principle of harmonizing matters of conflict with prior rights, questions of procedure

should not be dealt with in the same place as questions of substance. However, it would have to be specified that the applicant had a right to a registration except in the event of one of the grounds for refusal referred to in draft Articles 102 and 103.

Some delegations stated that, where the marks and the goods or services were absolutely identical, there should be no additional conditions for establishing a conflict. On the other hand, where the sign was similar and the goods or services were different, it was held that the criterion given in draft Article 103(1), according to which it had to be established that the examined sign was likely to mislead the public, was too restrictive. In such case, conflict would have to be determined on the basis of a possibility of confusion for the public. Consequently, the introduction of the term 'confusingly' in respect of the term 'similar' was superfluous.

One delegation held that the approach adopted in the draft paragraph (1) was too complicated and that the notions of similarity between marks and identity or difference of the goods or services should be combined. It added that it was not favorable to the criteria of possibility of confusion for the public, but rather to the concept under which the examined sign would be likely to mislead the public, particularly as regards the origin of the goods or services.

As regards draft subparagraph (b), doubts were expressed as regards its stringency and automatic application.

It was generally held that it would be necessary to specify whether draft paragraph (1) was to set out minimum requirements or a standard.

It was suggested that draft Article 103 should explicitly mention international marks registered under the Madrid Agreement.

One delegation noted that draft subparagraph (b) did not cover the exceptional case of two applications for registration being filed on the same day and understood that the search for a solution had been left to the national laws. This understanding was shared by the Secretariat.

One delegation stated in reply to that question that in its country the two marks would both be considered valid.

One delegation declared that it supported in principle draft Article 103, but considered that the exception of honest concurrent user which existed in most common law countries should be maintained.

In reply to the various comments made, it was explained that the provisions in draft Article 103 were absolute and not minimum and that, consequently, subject to draft Article 103(7), the rules laid down in draft paragraph (1) would have to be fully applied. In the case of two applications for

registration filed on the same date, it was felt that the solutions to such exceptional cases should be left to national laws. As for international marks registered under the Madrid Agreement, the wording of draft paragraph (1) would cover them since it referred to 'a mark ... registered with effect in the territory of the Contracting Party.' It was added that the next version of draft Article 103 could explicitly mention international marks.

It was further agreed in relation to draft Article 103 that the next Draft Treaty would deal with matters of procedure separately and that the various concepts appearing in draft paragraph (1) would be separated. Additionally, the definition of conflict would be reexamined, taking into account the suggestion that the criterion of possible confusion be used.

*Paragraph (2).* As regards draft item (i), it was stated that the term 'confusingly' similar mark should not be maintained, as had been decided in respect of draft paragraph (1).

Several delegations held that draft item (i) should simply repeat the provisions of Article 6bis of the Paris Convention for the Protection of Industrial Property. Otherwise, it would be necessary to define the well-known mark referred to in draft item (i) and to state which authority would decide that it was well known. One delegation noted that, contrary to the above-mentioned Article 6bis, draft item (i) required States to give a refusal and this led to an excess of work for those offices that would have to decide whether a mark was well known. Only invalidation of a mark could be made compulsory in that context.

The Chairman held that the matter of well-known marks was one of the most important and one of the most difficult points, particularly since subjectivity was involved. He added that certain factors, such as the rapid dissemination of communication through the media, could accelerate the acquisition of notoriety and the prestige enjoyed by a well-known mark could lead to the wish for products that differed from those for which the mark was used to also enjoy that prestige.

As regards item (ii), it was suggested that the wording of Article 4(3) and (4)(a) of the Directive of the European Communities be adopted since it afforded extended protection to marks enjoying a reputation both at Community level and in the Member States, on condition that they be registered. However, protection was only extended in that way if without due cause unfair advantage had been taken of such repute.

That suggestion was supported by several delegations and observer organizations. It was explained that in a case of 'repute' rather than of an 'exceptionally well-known mark,' the protec-

tion of the mark should be extended beyond Article 6bis of the Paris Convention without, however, broadening the field of protection to the extent envisaged in draft item (ii). In that respect, the broader protection, that constituted an exception to the principle of speciality, was justified if it was wished to avoid a loss of the attractiveness and distinctive nature of a mark of repute. An extension of the protection provided by Article 6bis of the Paris Convention could be used in those cases where advantage had been taken of the repute of a mark, particularly in cases of parasitism and of dilution.

One delegation pointed out that it might be difficult to base protection of marks on the fact that they had acquired a reputation because any mark used for a period of time had acquired some reputation.

*Paragraph (3).* It was stated that account would be taken in that optional provision of the comments made on draft paragraphs (1) and (2), particularly as regards the phrase 'would be likely to mislead the public.'

One delegation had doubts as to that provision that he considered an inducement not to register marks. If the notion of a used mark was to be recognized, exaggerated scope should not be given to it, and a limit could be found in the form of a restricted period during which a mark in use could oppose an application for registration without itself being registered.

A number of delegations suggested that those cases in which the holder of a right in a used mark could oppose an application for registration or a registration should be left to the judgment of the national laws. Consequently, draft paragraph (3) could end after the words 'and was not the subject of an application' in line four.

One delegation held that the provisions of draft paragraph (3), and draft paragraph (2), relating to well-known marks that were used but not registered, overlapped and that the matter should be regulated by the Treaty.

Several delegations held that the provisions set out in draft paragraph (3) would be difficult to implement in an *ex officio* examination since an office could not know whether use was continuous and in good faith. Refusal of registration should only be pronounced at the request of the user.

One delegation, whilst supporting the principle proposed in draft paragraph (3), held that it was not readily compatible with those systems in which registration generated the right and that the matter required further examination.

The representative of an observer organization held that the notion of continuous use was too stringent and should be replaced by the notion of use within the normal course of trade.

It was suggested by the representative of an observer organization that draft Article 103(3) should provide that any Contracting Party could maintain in its legislation provisions under which a used mark could be cited against an application for registration or a registration.

In view of the comments that had been made, it was pointed out that matters of procedure would be dealt with separately in the future version of the Treaty. It was also stated that the optional nature of paragraph (3) should be maintained in order to take into account the differences that existed between systems under which the right was declared by registration and systems under which the right was generated by registration, particularly as regards the degree of substantive examination carried out by the offices. The simplest solution, as proposed, would be to leave application of that provision to the national laws. However, it was held preferable to maintain draft paragraph (3) in its entirety and to make the desired amendments.

*Paragraph (4).* One delegation held that the list of other prior rights was too restrictive and that it should be generally extended to further intellectual property rights. It noted that draft item (i) did not mention names of establishments and that draft item (ii) did not mention utility models. Furthermore, draft item (ii) should not be limited to reproduction but should also extend to imitation.

One delegation, supported by further delegations and the representative of an observer organization, accepted the principles of draft paragraph (4) on an optional basis, on condition that the list of other prior rights be exhaustive. Without going into detail, draft paragraph (4) should comprise at least a reference to collective marks, warranty marks and certification marks.

A number of delegations stated that draft item (iii) should explicitly mention appellations of origin.

One delegation wondered why the Draft Treaty, instead of presenting an exhaustive list, had not adopted a more general approach such as that in Article 6quinquies.B.1 of the Paris Convention.

In reply to the question why geographical indications were mentioned in draft item (iii) as 'prior rights,' it was stated that draft Article 102(1) already said that a registration was to be refused if the mark was likely to mislead the public. However, the optional inclusion of draft item (iii) was justified on the grounds that certain national laws provided specific protection for appellations of origin that covered not only misleading the public but also simple use without possible deceit.

In view of the comments made, it was noted that, in principle, draft paragraph (4) was generally accepted in an optional form and conditional on extension of the list of prior rights to include, in particular, utility models, business signs, trade names, collective marks, warranty marks and certification marks, in order to make it exhaustive. Furthermore, as for the other provisions of draft Article 103, the procedural aspects would have to be dealt with separately and, in that context, the notion of invalidation of a mark would be added to that of refusal.

*Paragraph (5).* One delegation stated that practice in its country did not permit an application for registration to cover more than one class of goods or services and that, therefore, it would enter a reservation on that paragraph, as well as on draft Article 102(2), if draft Article 202(2) enabled a single application to cover several classes. It added that if, on the contrary, draft paragraph (5) was applicable to a system such as that adopted in its country, it would not be incompatible with that provision. It nevertheless explained that, in its country, where there were grounds, even partial grounds, for refusing an application, the application was refused in whole if the applicant did not avail himself of the possibility he was given of limiting the list of goods or services in his application.

*Paragraph (6).* One delegation raised the question whether that provision would oblige the Contracting Parties to introduce a system in which account was taken of the consent of the holder of the prior right or if it was only applicable to those Contracting Parties that already possessed such a system. It further wondered whether, *a contrario*, that provision did not constitute an exception to the application of the provisions of draft paragraphs (1) and (2) where a mark was not likely to mislead the public.

Several delegations and representatives of observer organizations supported draft paragraph (6) since it recognized the practical importance of the consent of the holder of the prior right. It was explained that, if the holder of a prior right gave his consent then he considered that the public was not likely to be misled. In that respect, it was suggested that the phrase 'the registration of the sign shall be refused only if, in view of the prior right, the public would be likely to be misled' be deleted. Without going that far, one delegation, supported by the representative of an observer organization, suggested that the phrase be replaced by a more general wording such as 'unless there are special circumstances....' in order to give offices the possibility of not taking into account consent in specific cases. A further dele-

gation stressed that the phrase should be maintained.

In view of the comments that had been made, it was decided that the forthcoming version of the Draft Treaty should contain that provision together with the provisions on procedural matters. It was also explained that the provision was of a compulsory nature.

*Paragraph (7).* In view of the amendments that would have to be made to draft Article 103 in the forthcoming version of the Draft Treaty, particularly as regards procedural matters, it was decided not to examine draft paragraph (7) at the present session of the Committee of Experts."

*Article 201: Conditions and Effects of Registration of Marks for Goods and of Marks for Services*

Article 201 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] (a) *The conditions and effects of registration shall be the same for all marks, irrespective of whether registration is for goods, for services or for both.*

(b) *The right of priority provided for in the Paris Convention for the Protection of Industrial Property, and any other kind of right of priority provided for by a Contracting Party, for marks for goods shall apply also and on the same terms to marks for services.*

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

The portion of the report of the Committee of Experts concerning the discussion of Article 201 reads as follows:

"It was agreed that this draft Article should be maintained in the Draft Treaty and that the following observations should be taken into consideration.

*Paragraph (1)(a) and (b).* No objections were made as to the general substance of draft paragraph (1).

One delegation questioned whether it was appropriate to place this provision, which dealt with an aspect of the conditions and effects of registration, in Chapter II concerning the procedures for application and registration.

*Paragraph (2).* All of the delegations and the representatives of observer organizations which spoke welcomed the principle embodied in draft paragraph (2) that the nature of the goods and

services for which the mark was to be registered should not form an obstacle to its registration, except for the Delegation of India, which expressed its desire that Contracting Parties be free to legislate with respect to this question. It was pointed out by delegations which supported draft paragraph (2) that the registration of a mark granted certain exclusive rights to its owner but did not grant an unconditional right to use the mark for the goods or services for which it was registered. In light of this basic principle of trademark law, it was only fair and logical that the nature of the goods or services for which a mark was to be registered should not form an obstacle to its registration. Although it was recognized that an Office could refuse the registration of a mark on the grounds of public order, the nature of the goods or services for which the mark was to be registered should not constitute a basis for refusing registration on the grounds of public order. This did not mean that Contracting Parties could not forbid the marketing or use of specific goods or services for which a given mark was registered and thus, in effect, render the mark unusable. However, where such a case arose, there was no harm in allowing the registration of the mark, as such registration did not necessarily mean that the mark could be used for any given goods or services."

#### *Article 202: International Classification*

Article 202 of the Draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

"(1) [Obligation to Apply International Classification] *Goods and services listed in each registration and in each publication of the registration shall be classified in accordance with the International Classification.*

(2) [Single Application and Registration for Goods or Services in Several Classes] *Goods and services belonging to any number of classes of the International Classification may be covered by one and the same application and shall be covered by one and the same registration on such an application."*

The portion of the report of the Committee of Experts concerning the discussion of Article 202 reads as follows:

"It was agreed that this draft Article should be maintained in the Draft Treaty and that the following observations should be taken into consideration.

*Paragraph (1).* One delegation considered that this provision should be optional.

One delegation suggested that it be made clear that, although draft paragraph (1) required that goods and services listed in each registration and publication should be classified in accordance with the International Classification, this did not mean that the International Classification had to be applied necessarily as the primary or principal classification, but that it would be sufficient if it were applied as a secondary classification.

One delegation suggested that the text should specify that goods and services had to be classified merely in accordance with, but not in the order of, the International Classification. It also considered that, since the scope of protection of a mark was determined by the goods and services for which the mark was registered, draft paragraph (1) could make it clear that goods and services, as listed at the time of filing the application, be classified in accordance with the International Classification.

One delegation and the representatives of several observer organizations were of the opinion that it should be made clear that the International Classification was only an instrument for the purposes of administrative convenience and efficiency and was not meant to ensure or affect substantive rights accorded by registration. It should also be made clear that, if given goods or a service listed at the time of filing the application was classified under one or more classes of the International Classification, draft paragraph (1) allowed the applicant subsequently to classify the goods and services under additional classes, without losing the original filing or priority date of his application with respect to that mark and the goods or services originally listed in the application.

*Paragraph (2).* A majority of delegations and representatives of observer organizations which spoke expressed their support for draft paragraph (2), which makes a multiple class system mandatory for Contracting Parties. However, a number of delegations expressed their opposition to this provision, at least in its mandatory form. Two delegations stated that, although they had some doubts about a multiple class system, they were willing to study the question and in particular the practical and legal reasons which might justify changing to such a system in their national laws.

It was noted that the multiple class system had always been applied under the Madrid Agreement Concerning the International Registration of Marks, to the satisfaction of the countries party thereto whether or not they applied a multiple class system at the national level.

It was agreed to maintain paragraph (2) in its present form."

### Article 203: Filing Date

Article 203 of the Draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

*“(1) [Requirements] The filing date of the application shall be the date of receipt by the Office of documents in the official language that contain:*

*(i) an express or implicit indication that registration is sought;*

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

*(iii) a reproduction of the sign for which registration is sought;*

*(iv) the listing by name of the goods and services for which registration is sought.*

*[(2) [Permitted Additional Requirement] Notwithstanding paragraph (1), a Contracting Party may continue to require, for purposes of the filing date, the payment of a filing fee, if it applies that requirement at the time of becoming party to this Treaty.]*

*(3) [Prohibition of Further Requirements] The filing date may not be subjected to the fulfillment of any requirements that are additional to or different from those set forth in paragraph[s] (1) [and (2)].*

*(4) [Date of Receipt] Each Contracting Party shall be free to treat the date of receipt of any document by a national Office on behalf of an intergovernmental organization having the power to register marks with effect in more than one State, or by an official postal service, as the date of receipt by the Office.”*

The portion of the report of the Committee of Experts concerning the discussion of Article 203 reads as follows:

“It was agreed that this draft Article should be maintained in the Draft Treaty and that the following observations should be taken into consideration.

*Paragraph (1).* Draft paragraph (1), in its overall essence, met with general approval. It was understood that draft paragraph (1), in its present form, was intended to establish an absolute standard which Contracting Parties had to require for purposes of according a filing date.

As regards the requirement in item (i), reservations were expressed about whether merely an ‘implicit’ indication that registration was sought was sufficient for filing date purposes.

As regards the requirement in item (ii), some delegations suggested that, in order to establish the identity of the applicant, an indication of his

address should be required. It was decided that this question could more adequately be dealt with through a clarification in the Notes on draft Article 203 or by including a Rule in the Draft Regulations.

As regards the requirement in item (iii), one delegation suggested that the provision refer to ‘a reproduction or graphic representation of the sign for which registration as a mark is sought.’”

As regards the requirement in item (iv), some delegations wanted to see this provision worded in a more flexible fashion so as to make it clear that, for filing date purposes, goods and services could be listed in a general sense (according to one representative of an observer organization, possibly even by just referring to the corresponding class or classes under the International Classification) and that a more specific listing of goods and services could only be required at a later stage of the registration procedure.

In respect of the requirement in draft paragraph (1) concerning the submission of documents in the ‘official language,’ a question was raised whether this requirement should be retained, in particular with respect to item (iv) regarding the listing of goods and services for which registration was sought. There was general agreement to the requirement that all of the items indicated under draft paragraph (1), including item (iv), be in the official language, subject possibly to a drafting change from ‘the’ to ‘an’ official language.

One delegation considered that the priority claim, if any, should constitute an additional requirement for filing date purposes. A number of delegations expressly opposed this suggestion. It was pointed out that, under Article 4 of the Paris Convention, countries party to that Treaty were free to determine the date on which a priority claim must be made and that the recognition of a filing date did not imply the recognition of the priority claim where priority had been claimed, since, as stated in Article 4D, the consequences of failure to comply with the formalities for claiming a priority under the Paris Convention could in no case go beyond the loss of the priority right itself. Several delegations and representatives of observer organizations, however, thought that it might be useful for the Draft Treaty to attempt to harmonize the requirements for claiming a Paris Convention priority, in a separate provision dealing with that specific question and unrelated to filing date requirements.

Some delegations suggested that the use of a form should also constitute a requirement for filing date purposes. This position was contradicted by a number of delegations, although it was recognized that the use of a form could constitute a formal requirement whose non-

compliance could result in the refusal of the application.

Several delegations expressed their concern that, given the definition of 'Office' in draft Article 2(ii), draft Article 203(1) might not take into account those systems where an application could be filed with regional branches of the Office or another entity authorized to receive applications on behalf of the Office. They wanted to ensure that the filing date of the application could also be the date on which such regional office or authority received the documents listed in draft paragraph (1).

One representative of an observer organization suggested that the signature by the applicant or his agent should be a requirement for filing date purposes.

*Paragraph (2).* The majority of delegations which spoke on this issue expressed their support for retaining this provision and for eliminating the square brackets so that Contracting Parties could continue to require the payment of a filing fee for purposes of according a filing date. Nevertheless, several delegations and all of the representatives of observer organizations which spoke were opposed to this provision. Some representatives of observer organizations mentioned the difficulty that international money transfers and other payment problems posed for applicants. On the other hand, various delegations which wanted to retain draft paragraph (2) referred to the burden that the receipt of piecemeal applications represented for Offices, in particular those Offices which received a significant number of applications or which did not have the resources for modernizing registration procedures.

It was suggested that an approach similar to that adopted by the Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions in its eighth session for the Draft Treaty on the harmonization of patent laws (Article 8(2), dealing with optional filing date requirements, and Rule 6, dealing with the details concerning the filing date) could also be adopted in the Draft Treaty on the harmonization of trademark laws, that is, that Contracting Parties would be free to require the payment of a filing fee, within a prescribed time limit, but only for purposes of maintaining, and not according, the filing date. This suggestion was supported by some delegations and a number of representatives of observer organizations.

*Paragraph (3).* In reply to an inquiry, it was clarified that draft paragraph (3) did not prohibit Contracting Parties from imposing requirements as to how and when a priority right could be claimed in accordance with Article 4 of the Paris Convention.

One delegation suggested that it be made clear that additional documents could be required for purposes of obtaining registration.

One delegation stated that, in its country, an application should be deemed to have been filed at the date of a certain exhibition if additional documents were submitted within a certain period of time, and it understood that such a requirement did not conflict with draft paragraph (3).

The Delegation of the United States of America expressly reserved its position with respect to draft paragraph (3).

*Paragraph (4).* In response to the concerns already raised by several delegations that draft paragraph (1) take into account those systems where applications can be filed with regional branches of an office or other entity authorized to receive applications on behalf of the Office, it was agreed that draft paragraph (4) would be redrafted along the lines agreed by the Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions in its eighth session for amending Rule 6 of the Draft Regulations under the Draft Treaty on the harmonization of patent laws, to the effect that each Contracting Party would be free to determine the conditions under which an application or any other document should be deemed to have been received by the Office."

#### *Article 204: Certain Requirements Concerning Registration*

Article 204 of the Draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

*"(1) [Permitted Requirements] Any Contracting Party may provide that any of the following requirements shall be complied with, in default of which the application may be rejected:*

*(i) that the application be filed by using a prescribed form;*

*(ii) that fees be paid;*

*(iii) that the application be signed by the applicant or his duly authorized representative;*

*(iv) that the application contain a declaration of intent to use the mark;*

*(v) that, where the sign for which registration is sought is a sound, the application, for the purposes of the reproduction of the mark, contain a graphic notation of the sound, such as sheet music, if the sound can be represented graphically, or describe the sound and be accompanied by a recording of the sound if the sound cannot be represented graphically;*

*(vi) that, where the sign for which registration is sought cannot be represented graphically*



and is not a sound, the application contain a description of the sign;

(vii) that, where the applicant is not domiciled and does not have an establishment in the territory of the Contracting Party, he be represented by a person permitted to practice before the Office or have an address for service in the territory of the Contracting Party.

(2) [Prohibition of Further Requirements] Subject to Articles 101 to 103, 203 and 205, no Contracting Party may provide for any requirement as a condition of registration that is additional to or different from those set forth in paragraph (1). In particular, the following requirements shall not be permitted:

- (i) the authentication of any signature;
- (ii) the furnishing of any certificate of or extract from a register of commerce;
- (iii) the carrying on of an industrial or commercial activity by the applicant;
- (iv) the carrying on of an activity by the applicant corresponding to the goods or services listed in the application."

The portion of the report of the Committee of Experts concerning the discussion of Article 204 reads as follows:

"It was agreed that this draft Article should be maintained in the Draft Treaty and that the following observations should be taken into consideration.

*Paragraph (1).* It was noted that the list of requirements in draft paragraph (1) was intended to be exhaustive and that the Contracting Parties would be free to provide for a less strict approach.

The great majority of delegations expressed their general support for the idea of establishing an exhaustive list of permitted requirements in respect of trademark applications.

One delegation proposed to clarify the term 'rejected' in the first sentence of draft paragraph (1) in order to make it clear that it also comprised as a possible sanction the cases where the application was deemed abandoned or withdrawn.

Several delegations indicated that, since their laws provided for protection of certification marks and collective marks to which certain special requirements applied, paragraph (1) should be drafted in such a way as not to affect the existing practices in respect of such special types of marks. It was pointed out that certification marks and collective marks were not covered by the definition of 'mark' in draft Article 2(i).

One delegation drew attention to the provision in the national law of its country requiring translation into English or French of word marks

which were not in either of those languages. Such a requirement should be permitted under the Draft Treaty.

Several delegations proposed that the possible transfer of certain existing and possible additional requirements in paragraph (1) into a Rule to be included in the Draft Regulations be considered. In this connection, reference was made to Rule 8 of the Madrid Agreement (Marks) which contained a more detailed list of requirements than the list in draft paragraph (1).

A number of delegations and representatives of observer organizations expressed concern in respect of possible excessive requirements which might be included in the prescribed forms under paragraph (1)(i).

It was proposed that the possibility of establishing a universal application form and a form for the power of attorney be considered. This idea was welcomed by the great majority of the delegations and the representatives of observer organizations while a number of delegations stated their reservation concerning a universal form for the power of attorney.

It was underlined that harmonization of procedural issues within the framework of the Draft Treaty was of equal, if not greater, importance compared with harmonization of substantive provisions of trademark laws.

A number of delegations expressed the view that draft paragraph (1)(iv) should not appear in the Draft Treaty, since at present a declaration of intent to use a mark was required only in a few countries, and it did not seem expedient to encourage the Contracting Parties to introduce such a requirement which was not necessary in a system under which failure to use had certain consequences and could, in particular, lead to the cancellation of the mark.

One delegation proposed to broaden the content of draft paragraph (1)(v) and (vi) in order to apply the requirement to provide a graphic representation not only to sound signs but also to other signs, for example, three-dimensional signs.

(a) It was concluded that further consideration should be given to the question of supplementing the Draft Treaty by Draft Regulations, thus making it possible to transfer certain details, for example, from Article 204, to a corresponding Rule.

(b) As to the term 'rejected,' it was agreed that a corresponding definition would be introduced in the next draft, similar to that contained in the Draft Treaty on the harmonization of patent laws.

(c) It was noted that the question of establishing a universal application form deserved further consideration.

*Paragraph (2).* Several delegations expressed their general support for the idea of expressly mentioning certain requirements which were additional to or different from those set forth in paragraph (1) and therefore prohibited.

The Delegation of Japan asked whether it was possible under paragraph (2)(i) to use a seal instead of a signature.

It was underlined that the term 'authentication' in draft paragraph (2)(i) applied both to notary and consulate certification of signatures and that this provision should be made applicable to all kinds of documents to be submitted to Offices.

It was concluded that draft paragraph (2) was generally acceptable. It would become important to expressly establish in draft paragraph (2) a negative list of requirements which should be excluded from possible future additions to a list of permitted requirements contained in a Rule."

#### *Article 205: Use as a Condition of Registration*

Article 205 of the Draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

*"Any Contracting Party that, at the time of becoming party to this Treaty, requires, as a condition of registration, that the applicant furnish evidence of bona fide use, started within a certain period of time, on its territory of the sign for which registration is sought, may continue to apply that requirement. The said period of time shall not be less than six months counted from the date on which the Office notifies the applicant that the mark will be registered if the applicant furnishes evidence of bona fide use within the said period of time."*

The portion of the report of the Committee of Experts concerning the discussion of Article 205 reads as follows:

"The Delegation of the United States of America was in favor of Article 205 but suggested that the sentence in paragraph 205.01 of the Notes on Article 205 should be amended by adding the phrase 'unless an application is based on Article 6quinquies of the Paris Convention for the Protection of Industrial Property.' The said provision provided a way for applicants with a registration in another country of the Paris Union to obtain a registration in the United States of America without use. Furthermore, the Delegation expressed the belief that the requirement of use prior to registration existed in the laws of Canada and the Philippines.

The Delegation of Canada affirmed that use prior to registration was a requirement in Canada,

subject to the provision of Article 6quinquies of the Paris Convention for the Protection of Industrial Property.

A number of delegations and representatives of observer organizations opposed the inclusion of draft Article 205. It was stated that it was difficult for applicants to effect use prior to registration, especially for companies that have not started business in countries requiring evidence of such use. It was widely accepted that there should be sanctions against non-use of a registered mark, but use as a requirement for the registration of a mark should disappear and should be prohibited. Reference was made to the discussion of this point in other fora.

One delegation felt that reliance on the provisions of Article 6quinquies of the Paris Convention for the Protection of Industrial Property favored applicants with registrations in other countries and discriminated against those who did not or could not secure such registrations.

The representative of an observer organization stated that the requirement of *bona fide* use as a prerequisite to registration in the United States of America did provide certainty to applicants because, after examination, a notice of allowance was sent and the trademark applicant had altogether three years from filing within which to engage in *bona fide* use of the mark.

The representatives of several observer organizations underlined that the United States of America had recently amended its trademark law to accommodate the possibility of filing an application for a mark based upon intent to use, rather than upon actual use. They further observed that this amendment had taken place after study by, and at the instigation of, users' groups in that country. Therefore, it was highly unlikely that the United States of America would amend its laws in the near future to dispense with a requirement for *bona fide* use as a prerequisite to registration.

On the basis of the discussions, it was concluded that draft Article 205 should be retained in the Draft Treaty, but possibly could be placed in brackets."

#### *Article 206: Notification of Grounds for Refusal and Observations*

Article 206 of the Draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

*"No application may be rejected on the basis of any of the grounds for refusal of registration set forth in Articles 102 and 103 unless the applicant has been notified of the ground and given the opportunity to make observations thereon."*

The portion of the report of the Committee of Experts concerning the discussion of Article 206 reads as follows:

"The draft Article was considered generally acceptable.

Several delegations expressed the view that draft Article 206 should contain a more general idea providing for the applicant to be notified and heard at all stages of trademark registration procedure where his interests might be affected.

It was suggested that the expression 'notify' should be replaced by a term allowing a less formal type of communication."

*Article 207: Expeditious Processing of the Application*

Article 207 of the Draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

"(1) [Examination as to Absolute Grounds Only, without Possibility of Opposition] *Where the application is not examined ex officio as to the rights referred to in Article 103 and no provision is made for allowing interested parties to oppose registration, the Office shall either register the mark and publish the registration, or it shall notify the applicant of the decision to reject the application, within four months of the filing date of the application.*

(2) [Examination as to Absolute Grounds Only, with Possibility of Opposition] *Where the application is not examined ex officio as to the rights referred to in Article 103 and interested parties are allowed to oppose registration, the Office shall either publish the application for the purposes of opposition, or it shall notify the applicant of the decision to reject the application, within four months of the filing date of the application.*

(3) [Examination as to Absolute Grounds and as to Anteriority, without Possibility of Opposition] *Where the application is examined ex officio as to the rights referred to in Article 103 and no provision is made for allowing interested parties to oppose registration, the Office shall either register the mark and publish the registration, or it shall notify the applicant of the decision to reject the application, within eight months of the filing date of the application.*

(4) [Examination as to Absolute Grounds and as to Anteriority, with Possibility of Opposition] *Where the application is examined ex officio as to the rights referred to in Article 103 and interested parties are allowed to oppose registration, the Office shall either publish the application for*

*the purposes of opposition, or it shall notify the applicant of the decision to reject the application within eight months of the filing date of the application.*

(5) [Term Allowed for Filing Oppositions] *Where paragraph (2) or paragraph (4) applies, the term allowed for filing opposition shall be three months counted from the date of publication of the application.*

(6) [Decision on Opposition] *Where an opposition is filed, the Office shall, unless the commencement of the opposition proceedings must be postponed pending a decision on the registrability of a sign which is the subject of another application, notify the parties of its decision and, where applicable, publish the registration, within six months of the date on which the opposition was filed."*

The portion of the report of the Committee of Experts concerning the discussion of Article 207 reads as follows:

"In the introduction that was made on the subject of this draft Article, it was pointed out that it was an attempt to bring about a speeding up of examination and registration procedures, at the same time taking due account of the various types of procedure that were applied.

Most of the delegations that spoke, while recognizing the soundness of the objective pursued by draft Article 207, considered that the time limits proposed were unrealistic, and that a new approach should be worked out. It was, in particular, mentioned, as a general comment, that it was difficult for an office to meet time limits at all procedural stages, in view of the fact that it had to liaise with agents and applicants, the latter being sometimes resident abroad.

Two delegations also pointed out that draft Article 207 seemed to take account of only four types of procedure, to the exclusion of any other procedure that might exist in some countries. One of those delegations said that its system was close to the one appearing in draft paragraph (4), but differed from it in that the examination of absolute grounds for refusal occurred after publication, and therefore at the same time as the opposition procedure. Another delegation said that its country's draft law on marks provided that the time limit for filing opposition did not start to run until the mark had been registered. Those two delegations considered that the Draft Treaty should not privilege certain systems at the expense of others. It was added that certain time limits could be proposed without it being necessary to refer to any procedural system at all.

One delegation said that its country could not agree to the Draft Treaty containing provisions

that the Contracting Parties would not be capable of observing by reason of uncontrollable circumstances, such as a sudden increase of the number of trademark applications.

In the light of the remarks that had been made, it was pointed out that the International Bureau had attempted, on the basis of the discussions of the first session of the present Committee of Experts, to propose solutions to expedite the examination and registration procedure and to solve the problem of unwarranted delays. The wish was expressed that it be given guidance, notably with regard to reasonable time limits.

Some delegations suggested applying the 18-month time limit adopted under the Protocol of June 28, 1989, Relating to the Madrid Agreement Concerning the International Registration of Marks. One delegation suggested that a period of 18 months could be set as a time limit between the publication of the application and the registration of the mark.

Other delegations considered that it would be difficult for the reference to the system of international registration of marks to be adopted in a strictly national framework, in view of the fact that the time limits of 12 or 18 months started to run for marks that were already in order with respect to form.

One delegation considered that a draft Article on the time limits for the examination of an application for the registration of a mark should confine itself to setting a maximum time limit by which the office had to have issued a first notification of refusal.

The representative of an observer organization said that users were of course in favor of the procedure being conducted as rapidly as possible, at the same time recalling that it was a matter not only for offices but also for applicants and their agents. He considered that such a provision had at least to attempt to set the period during which the office had to issue a first notification of refusal, and apart from that the minimum period, as from the publication of the application, during which the registration of a mark could be opposed.

In the light of the discussions that had taken place on draft Article 207, it was noted that it had won no support in its present form, and that it would not appear in that form in the next version of the Draft Treaty. It was, however, pointed out that there was general agreement on the principle of speeding up the procedure of examination and registration of marks. The next version of the Draft Treaty could contain a first period, of 12 or 18 months, for instance, during which the office would have to issue a first notification of refusal, a second period, being the minimum time during which the registration of a published application could be opposed, and finally an overall period,

of three or four years, for instance, during which an office would have to have dealt with an application. In the latter case, the draft provision would specify certain consequences of inaction on the part of the office.

With regard to the time limit proposed, one delegation had a reservation regarding such a provision, even if it were of a general nature."

#### *Article 208: Publication of Applications and Registrations*

Article 208 of the Draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

*"(1) [Publication of Applications Where Opposition Allowed] (a) Where interested parties are allowed to oppose registration, the Office shall publish in its periodical gazette an entry in respect of each application not rejected which shall contain or indicate at least the following: a reproduction of the sign that is the subject of the application; the application number; the name and address of the applicant; the filing date of the application; if priority is claimed, an indication of this fact with the identification of the Office with which the application whose priority is claimed was filed, as well as the number and the filing date of that application; the name of the representative, if any; the listing by name of the goods and services for which registration of the sign is sought with an indication of the corresponding class or classes of the International Classification; where applicable, an indication that the mark is three-dimensional.*

*(b) Where signs that cannot be represented graphically are eligible for registration and the subject of the application is such a sign, the entry referred to in subparagraph (a) shall include a statement that the sign is of such a nature and a description of the sign.*

*(2) [Publication of Registrations] (a) The Office shall publish in its periodical gazette an entry in respect of each registration, which shall contain or indicate at least the following: a reproduction of the mark; the number under which it has been registered; the name and address of the holder of the registration; the filing date of the application and the date of registration; if priority is claimed, an indication of this fact with the identification of the Office with which the application whose priority is claimed was filed, as well as the number and the filing date of that application; the name of the representative, if any; the listing by name of the goods and services in respect of which the mark has been registered with an indication of the*

corresponding class or classes of the International Classification; where applicable, an indication that the mark is three-dimensional.

(b) Where a sign that constitutes the registered mark cannot be represented graphically, the entry referred to in subparagraph (a) shall include a statement that the mark is of such a nature and a description of the mark.

(3) [Access to the Register by the Public] (a) The register maintained by the Office shall be open to inspection by the public.

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

(c) Where a sound that constitutes the registered mark cannot be represented graphically, the Office shall maintain a sound recording of that sound and shall provide an opportunity to any interested person to listen to and, against payment of any fee that it may require, make a copy of that recording."

The portion of the report of the Committee of Experts concerning the discussion of Article 208 reads as follows:

"It was agreed that this draft Article should be maintained in the Draft Treaty and that the following observations should be taken into consideration.

One delegation, supported by a number of other delegations, suggested that draft paragraph (1) should not oblige Contracting Parties to republish at the national level registrations of international marks already published by WIPO in its review *Les Marques internationales*, as provided in the Madrid Agreement.

It was replied that draft paragraph (1) did not concern the procedure for the international registration of marks, and consequently did not oblige Contracting Parties to carry out republication in the case mentioned in the preceding paragraph.

Several delegations and one observer organization considered that, at the national level, an office did not have to republish a mark as registered when it had already been published in full in connection with the opposition procedure. One of those delegations said that if, after the opposition procedure, the mark underwent substantial changes, those changes were published, but that otherwise it was merely mentioned that the mark was registered. It was suggested that the next version of draft Article 208 should contain a provision according to which publication of the registration would be required only if there had been no publication in connection with opposition.

Two delegations said that the detailed provisions contained in draft Article 208 could appear in implementing regulations.

One delegation said that draft paragraphs (1) and (2) mentioned the application number, and the registration number, respectively, whereas in certain countries those numbers were identical.

With regard to draft paragraph (3)(b), one delegation said that one should speak of 'copies of entries made in the register on the subject of a registration,' and not of 'copies of the register.'

The representative of an observer organization considered that draft paragraph (3) should allow the public access not only to the register but also to applications and to files, and that the latter should be kept up to date, notably with regard to the mention of renewals and of the recording of changes and assignments.

In the light of the remarks made on draft Article 208, it was agreed that certain details would have to be transferred to implementing regulations, and that the texts should be clarified in order to establish that there was no obligation on offices to carry out a second publication in cases where the application for registration had already been published for the purposes of an opposition procedure."

#### *Article 209: Changes in Registrations*

Article 209 of the Draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

*"Changes may be made in the registration, provided that no change shall be made*

*(i) in the sign constituting the registered mark,*

*(ii) in the list of goods or services, except where the change restricts that list."*

The portion of the report of the Committee of Experts concerning the discussion of Article 209 reads as follows:

"It was agreed that this draft Article should be maintained in the Draft Treaty and that the following observations should be taken into consideration.

*Item (i).* One delegation questioned, with respect to draft item (i), the necessity of prohibiting changes in the registered mark.

Some delegations indicated, with respect to draft item (i), that changes to a registered mark should be allowed to some extent, in particular where the distinctive character of the mark was not altered. In this connection, reference was made to Article 5C(2) of the Paris Convention for the Protection of Industrial Property.

*Item (ii).* Some delegations suggested amending draft item (ii) to accommodate a

change to the list which results in an expansion, whereupon the mark would have two priorities, one priority for the goods or services on the original list and a second, later priority, for the goods or services on the expanded list. In this respect the representative of an observer organization stated that providing two priority dates for the same mark would lead to uncertainty in the perception of third parties as to whether their goods fell into a part of the list of goods or services corresponding to the registered mark having an old or a new priority date.

It was pointed out that changes that merely consisted in replacing certain items in the list of goods or services by other items in order to clarify the said list should in any case be permitted, if no extension resulted from such changes.

In response to a question as to whether draft Article 209 applied to changes in applications as well as to changes in registrations, it was explained that the provision only applied to registrations but that one could consider including in the Draft Treaty a corresponding provision in respect of applications."

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## Studies

### Danish Experience with the Patent Cooperation Treaty System

L.D. ØSTERBORG\*

#### 1. Introduction

The Patent Cooperation Treaty (PCT) was signed 20 years ago this year. Colleagues returning from the Diplomatic Conference in Washington said that the PCT had become very complicated compared with the originally conceived idea. Today, the impression is totally different. It is obvious to everybody that the PCT system is a worldwide success. It is a success from an international point of view and on the national level of its member States. More and more countries choose to become members, and thereby offer to their industry and inventors the benefits of a system for inexpensive patent protection abroad.

During the 12-year history of the PCT, more than 40 countries have joined the PCT Union, from all parts of the world. The annual number of filed applications increases every year. Ten years ago the number was less than 3,000, and it now amounts to almost 15,000. Yet a further increase is expected in the years to come. Eighty percent of the international applications come from the United States of America, the United Kingdom, Sweden, Germany (Federal Republic of), France and Japan, but the remaining 20% come from 35 different countries.

In the last couple of years, more than 200 international applications were filed per year in Denmark. The average number of Contracting States designated per international application filed in Denmark was 24. The international average number was 15. This is one of the symptoms of the fact that the PCT system has a structure which makes it a qualified instrument for seeking patent protection abroad, particularly for applicants representing small and medium-sized industry.

#### 2. The Use of the PCT System in Denmark

##### 2.1 A Few Characteristics of the Danish Patent System

In order to put the Danish experience with the PCT into perspective, allow me a few words about the Danish Patent Office.

The Danish Patent Office is almost 100 years old. In total, 270 persons, calculated on a full-time basis, work in the Office. The annual budget is 120 million Danish kroner equal to 18.5 million US dollars. Seventy engineers work on a full-time basis in our Office, carrying out search, examination and information service tasks. The income from information and documentation services was 2.5 million Danish kroner last year. The Office also examines trademarks prior to their possible registration.

The increase in the most recent years (see *Table A<sup>1</sup>*) reflects an international trend for which the explanation must partly be attributed to expectations related to the internal market in the European Economic Community (EEC). The number of applications from nationals has been at a level of about 1,100 in recent years. The Patent Office has done much to publicize patent protection and that could be the explanation for the increase. As usual, 16% of all patent applications were filed by Danish applicants.

For almost 25 years, the Danish Patent Authority has belonged to the ever growing group of countries which publishes all patent applications 18 months after their date of filing or priority date.

The annual number of granted patents is found in the last column. In Denmark the opposition period of three months runs before the grant. We are contemplating a change in this to make the sequence the same as that of the European Patent Convention

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<sup>1</sup> The Tables appear at the end of this study.

(EPC). In that case, laying open for public inspection will be substituted by the grant.

## 2.2 The Danish Patent Office as a Receiving Office within the PCT System

Table B illustrates the growing number of filings of international applications in Denmark. Filing in Denmark is only allowed for natural and legal persons who are Danish citizens or have their residence in Denmark.

The reason why the percentage of the total number of international applications is decreasing in spite of the growth in the number of applications received is that more and more countries have become members of the PCT Union, in particular countries bigger than Denmark.

It is clear from the next column that most Danish applicants start out by filing a national Danish patent application from which they claim priority when filing an international application within 12 months from the filing date in Denmark. As the Danish Patent Office is a searching and examining patent authority, the Danish applicants who file a patent application in Denmark for the first time in a member State of the Paris Union for the Protection of Industrial Property receive a preliminary report on novelty and patentability less than 10 months from the first filing date. This is a cost-saving factor for Danish applicants when considering whether to file abroad or not.

It is worth mentioning that in more than 90% of all international applications filed with our receiving Office the applicant uses a patent attorney.

In general, 33% are filed in Denmark by large companies, 25% by medium-sized enterprises and more than 40% by individual inventors and applicants.

The Table also shows that international applications filed in Denmark may be searched either by the Swedish Patent Office or the European Patent Office (EPO). The Swedish Patent Office is able to search and examine an application in English or Danish, the EPO only in English. It is considerably cheaper to have the international search carried out by Sweden than by the EPO, because the fee in Sweden is much lower. By using the Swedish Office as an International Searching Authority the applicant gets a further postponement of the moment when he has to translate his application into English. However, the English version of the application must be ready for the 18-month publication of the application which the International Bureau of WIPO has to prepare. Perhaps this is indeed one of the reasons why so many international filings are made in English on the international filing date.

In the beginning, one clerk, who was specially trained by the lawyers in the Office, spent most of

her time handling the files of the receiving Office, performing the formality control and the transmission of copies to the International Searching Authority in question and to the International Bureau. Later on we used the resources of one person on a full-time basis, and at present one and a half persons work full-time in the receiving Office. Part of the clerks' time is spent on giving information and advice about how to use the PCT system from a practical point of view and the legal implications. Questions of a more difficult or delicate nature are answered by lawyers working in the Legal Department. In general, the handling of an international application by the receiving Office takes about five hours.

From Table C you will see the development in the number of designations. First of all, the enormous increase is obvious, and from the last column it is evident that the increase is not only due to the higher number of applications: each application itself contains a growing range of countries. The leap in 1985 reflects the success in simplifying the PCT and the initiative to make it more user-friendly the year before.

On a worldwide scale, the average number of Contracting States designated per international application was 15 in 1988. The reason behind the leap in the average number of designations in 1985 may be attributed to the fact that as from that year each designation beyond the first 10 for which designation fees are due is free of charge.

It is worth noting that, whereas the number of designations has increased continuously, the number of Member States of the European Patent Organisation designated in applications where a European regional patent is applied for has remained stable.

These statistics are interesting from another point of view, too. The second column shows the number of international applications filed by Danes in which a European patent is applied for. The number in 1988 was almost 200. The total number of European patent applications filed that year by Danish applicants was a little less than 300 (288). In 60% of the cases, the Danish inventors and applicants profited from the PCT membership to file in Denmark using a Danish patent attorney—and even in many cases in the Danish language at the moment of filing. In the same year, a modest number of applications were filed by applicants from countries not (yet) members of the PCT with the EPO. If one compares the number of national applications filed by nationals in such countries, respectively, and Denmark with one another and maintain the same relationship between the two figures, applicants from such countries ought to have filed about four times as many European applications. I am sure the PCT route has had a say in this difference. It is not just a question of export capacities that differ.

Denmark is designated in international applications filed in Denmark. The explanation for this



phenomenon is the following. About nine to 10 months after the filing of a Danish first application the applicant knows the result of the search and patentability examination carried out by the Danish Patent Office. In the meantime, the applicant has continued his work on the invention: perhaps he has found one or two new uses he wants to claim additionally, or he wants to change the wording of some of the original claims taking the report of the Patent Office into account. Under such circumstances, the designation of Denmark in the international application is a combination of seeking patent protection abroad and of amending, typically extending, the protection in Denmark. Often the first national application, or patent in the meantime, is not withdrawn until the broader patent has been granted on the basis of the international filing.

### 2.3 *The Danish Patent Office as a Designated or Elected Office*

This part concerns the so-called "national phase."

According to the PCT, the national phase may start at different points in time, primarily depending on the choice of the applicant (see *Table D*). If you are a citizen of a country which has ratified both Chapter I, on international searching, and Chapter II, on international preliminary examination, the applicant may choose to enter the national phase after 20 months, knowing only the result of the international search. In such cases, the national Offices designated in the application act as designated Offices. The same is the situation where you happen to be a citizen of a country which has made a reservation concerning PCT Chapter II. If you are a citizen of a country which has made no reservation concerning Chapter II, and you have chosen to have your international application also subjected to an international preliminary examination, the time limit for entering the national phase, or for proceeding further with the application in a selection of the countries originally designated in the international application, is 30 months.

Most States have chosen to ratify both Chapters at the same time. In Denmark, in 1970, when the PCT was adopted, Danish industry focused on the advantages of Chapter I, principally being the centralization of novelty searches and a speedy result of the search. With regard to Chapter II, it was feared that the result of the international preliminary examination, in spite of provisions to the contrary, would be binding on national authorities. In 1977, Danish industry and other parts of the interested circles maintained their view, and Denmark made a reservation concerning Chapter II when we joined the PCT. Denmark withdrew its reservation with effect from November 1, 1988.

Denmark was designated in one third of all international applications during the 1980s (see *Table E*). The applications from the United States have shown an increasing interest in designating Denmark, but Japanese industry has not shown a similar trend. In Denmark, we often deplore the lack of Japanese interest in investing and seeking patent protection in our country. It can easily be seen from the statistics. In order to obtain patent protection in Europe, the Japanese clearly seem to have a preference for the European patent system. The Japanese filed more than 8,000 European patent applications in 1988, but only 800 Euro-PCT applications. In Denmark, 5% of all applications are filed by the Japanese and 25% by Americans. In the EPO, the corresponding percentages are 18% and 25%. The Japanese tend to forget the European countries outside the EPO—even when they are members of the PCT. For Denmark, this is history now because Denmark became a member of the European Patent Organisation in January 1990.

One question concerns the designation, but of more importance are the applications which are further prosecuted or really enter the national phase. The figures are important to the enterprises, because they are going to respect these future exclusive rights likely to come into effect, and important to the national Office, because they represent an income in fees. In the case of Denmark, the rate between designations and further prosecuted applications is 45%.

*Table F* reflects not only the geographical distribution of international applications entering the national phase in Denmark, but also clearly shows who the important trade partners of Denmark are. Sweden has remained one of them in spite of Sweden not being a member of the EEC. The Federal Republic of Germany is important, too.

It is interesting to note that the EEC figure is almost equal to that of the United States of America.

From *Table G*, it is of particular interest to note the percentage in the last column. In spite of a growing number of applications filed yearly—the percentage of applications which are further processed—international applications are increasing each year. This tendency will continue for some years, for three reasons: firstly, because the number of nationally filed applications will fall drastically due to Denmark's membership of the EPO. Secondly, because the number of international applications will increase on a worldwide basis, and thus also in Denmark. Thirdly, because Denmark has now joined both Chapters I and II of the PCT. This represents an advantage to applicants from all parts of the world in their relationship with Denmark. For patent offices, the increasing share of national applications being PCT applications entering the national phase means a way of economizing on engineer resources for searching. In a country like Denmark and in other countries, whose legislation requires absolute novelty and inventive step, and whose specific

national patent literature is not included in the PCT minimum documentation, the national Office can limit its searching and examination to a small number of patent specifications only filed in the country in question because the main part of the work will have been performed by the International Searching and Examination Authority.

#### 2.4 International-Type Search

International-type searching is a special phenomenon. The Patent Cooperation Treaty in its Article 15(5) provides that if the national legislation of a PCT member State so permits, an applicant who files a national application with the national Office may request that a search similar to an international search be carried out on such application. In 1978, when the Patents Act was amended, *inter alia*, in order to harmonize it with the EPC and to make it possible for Denmark to join the PCT, a specific section (Section 9) to that effect was also introduced.

This implies that any national Danish patent application may be subject to an international-type search, if the applicant so wishes, by either the Swedish Patent Office or by the EPO acting as International Searching Authority for Denmark. To my knowledge, it is only the four Scandinavian countries and Switzerland which have made such a procedure possible for national applicants. From one point of view, you could say that it is peculiar that exactly the Scandinavian countries which, for almost one hundred years, have had patent offices carrying out searches and examinations before the grant of a patent have decided to give this possibility to their national applicants who anyway would have their national, traditional patent applications searched and examined.

The philosophy behind it is the following. According to Rule 41 of the Regulations under the PCT, an International Searching Authority shall use the results of an international search and refund the fee for the international search to the extent that its search report can be based upon the results of an international-type search of the same invention. To an applicant who asks for a patent in Denmark through a national patent application, and who within one year intends to file an international application concerning the same invention, claiming priority from the Danish application, it will be an advantage if the Danish application may already be the subject of an international search.

In the Danish Patent Office today, we have a collection of 25 million patent specifications from almost all the major countries of the world. But even if we make a search in these collections of prior art, we will not be able to carry out what is called an "international search," because we do not have at present the so-called "PCT minimum documentation" as enumerated in PCT Rule 34. In particular, we are

lacking the Japanese and Soviet Union abstracts in English.

The request that a search similar to an international search (the type search) be carried out on a national application must be filed within three months from the date of filing. The application must be in Danish or translated into English depending on which of the two possible International Searching Authorities the applicant wants to carry out the international-type search; secondly, the application or translation must fulfill the requirements of the PCT as regards formalities and the prescribed fee must be paid.

You will notice, in *Table H*, a considerable increase through the decade. In the last year of the table it was almost 8% and, except for one or two each year, all international-type searches were carried out by the Swedish Patent Office. In Switzerland, an even greater percentage of national applications were subjected to an international-type search.

In my view, countries should consider applying the Scandinavian/Swiss model when ratifying the PCT. To a national enterprise, which subsequently wishes to apply for patents abroad within the priority year of 12 months, it would be a great advantage to have an opportunity, via its national authority, to obtain an international search. Another possibility is also available, that of using PCT Article 15(5)(b). This is a provision of particular interest to countries which do not carry out searches of all patent applications prior to the grant or opposition period. The wording of Article 15(5)(b) is the following:

"If the national law of the Contracting State so permits, the national Office of or acting for such State may subject any national application filed with it to an international-type search."

It seems to me to be a good idea for countries which are contemplating joining the PCT. It implies that the burden and costs of searching inventions prior to grant is taken away from local enterprises and is placed on those—in many cases foreigners—who want an exclusive right for the country in question, and these exclusive rights are to be respected by the national enterprises. Furthermore, it will make the conditions for obtaining patent protection equal, irrespective of whether patent protection is obtained via the PCT system in an international application designating the country in question or the traditional route via the national patent office. This could be of particular interest to countries whose national patent authority does not carry out novelty searching.

### 3. The Advantages of the PCT System

#### 3.1 Advantages for National Applicants

It is a cheap way to what comes closest to the ideal of a "world patent," i.e., the applicant can file

a patent application in his home country. If he has a novelty search carried out in his home country within one year, he will know or have an idea of whether it is worthwhile filing an international application claiming the priority of the national application. Even if he does not have a novelty search carried out within 12 months in his native country, it is an advantage to use the PCT route. The applicant may designate as many PCT member States as he wishes. The designation fees can never exceed 10 times the current amount of each designation even if he designates all 44 member States.

The applicant does not need to pay the extremely heavy costs connected with the granting of patent protection (which is the price to be paid to the patent attorney in each country where protection is sought for the translation into the respective national languages) until a time when the applicant knows the result of the international search carried out by the International Searching Authority. Thereby he gets a good basis for estimating if he really wants protection in each of the countries originally designated. This decision has to be taken at the latest 20 months from the international filing date or, when priority is claimed, from the priority date. If the home country of the applicant has ratified both Chapters I and II of the PCT, that decision may be postponed until 30 months from the international filing date or priority date if the applicant avails himself of the possibility of also having an international preliminary examination carried out before entering the national phase. This effect has often been described as a "prolongation of the 12-month priority period" to 20 or 30 months.

If a PCT member State enters into an agreement with an International Searching Authority that is able to read and carry out a search on the basis of applications written in a country's language (e.g., the Swedish Patent Office accepts international applications within the PCT system in the Danish or Norwegian languages), this is a further advantage to applicants.

If the national patent office of a PCT member State agrees to act as a so-called "receiving Office" within the PCT, it implies the advantage for a national applicant that he can start obtaining international protection by filing with his own national patent authority, with which he is able to discuss correction of formalities, get advice, pay fees for the PCT application, pay in the national currency and use a national patent attorney, if necessary, etc.

At the time of expiry of the time limit of 20 or 30 months, the applicant—apart from knowing the outcome of the qualified novelty search—is in a better position from a commercial point of view to evaluate whether he really wants and needs protection in all the countries originally designated, and thereby to seek protection only where commercially indicated,

or where he can grant or is likely to succeed in granting a license to a third party.

Moreover, the "extension" of time before substantial expenses must be incurred gives the applicant the opportunity to limit his application, when entering into each of the countries designated, to the subject matter which is most important to him or which does not infringe existing rights.

The PCT system is connected with the European patent system in several ways. One of the advantages for applicants whose home country has ratified the PCT (even if not the EPC) is that it is possible to apply for a European patent by filing a PCT application for a European patent in their home country; for example, in Japan or in the United States of America.

Another advantage is described under 2.4, above. If a State at the time of its ratification of the PCT so decides and an International Searching Authority agrees to it, national applicants who have only filed an ordinary national patent application may ask for a so-called "international-type search" to be carried out (PCT Article 15(5)(a)).

If the international search report shows that the invention cannot be patented, the applicant may withdraw his international application before the international publication takes place and before he has to pay filing fees, translation costs and patent attorney costs in the designated countries in which he wants to proceed with the application.

The very qualified novelty search report is normally issued about four months only (!) after the international filing date.

National applicants who have obtained a PCT originating patent abroad can, to a greater extent than before, be sure that their foreign patents are valid and will not be revoked in courts.

A few more advantages of PCT membership may be mentioned.

By using that route one can obtain a complete preliminary examination report via the EPO before 28 months have expired from the filing or priority date, that is to say, before the greatest costs abroad and with the EPO are due.

A patent attorney abroad is not necessary in the international phase of the granting procedure. All the preparatory work necessary before filing, the actual filing and the further processing may be handled by just one and the same person.

It is a relief to applicants that they only need to obtain one certified copy of the priority application. In many countries, it takes time to prepare a priority document and very often it is rather expensive.

### *3.2 Advantages for National Patent Attorneys*

After a country has ratified the PCT, patent protection will more often be sought abroad. The

patent attorney is responsible for filing the PCT application. He will be the channel through which all contact with further countries (designations) has to pass when the international application enters each designated or elected country after international searching or even preliminary examination has been carried out.

The number of applications coming from abroad via the PCT system, which have to be translated and filed before having legal effect, will increase after ratification.

### 3.3 Advantages for National Offices

Acting as a receiving Office (which is a choice made by each Contracting State—it is not mandatory, but of great advantage to national users) creates clerical work in the Patent Office at a high level. Thus it can be used as an attractive post implying promotion for its holder.

Working resources of engineers normally carrying out search and examination can be saved for other purposes, e.g., a much more detailed and improved novelty search of traditionally filed patent applications, information and documentation, dissemination and, at the same time, at least the novelty search is better than that which a small national patent office is able to deliver.

The national patent authority will eventually be able to offer international type-searching of nationally filed applications. This is only of interest to applicants without priority from abroad.

## 4. Combination of the PCT and EPC

The PCT does not live in an international vacuum. The EPC plays another important and different role. Denmark became the fourteenth European State to become a member of the European Patent Organisation. Having talked in great detail about the PCT system and taking the future further increase in membership into account, the following question seems relevant: which route should European applicants choose?

This question cannot be answered unambiguously or equally for all cases. Each invention of an enterprise and its prospective market has to be decided on its merits. Three parameters will form part of the choice of the individual applicant when he has to choose the way of seeking patent protection or a combination of patent systems.

They are:

(1) In how many countries does the applicant need or estimate that he needs patent protection?

(2) What kind of guarantee does the applicant want for the validity of the patent?

and

(3) Which fees, etc., does he have to pay when using one or the other route of patenting, and at what time in the granting procedure does the heavy part of the fees have to be paid, including the costs for translations and possible professional help, that is to say, a patent attorney?

Even if one has to decide in each individual case which solution is the most advantageous, it is possible to formulate certain guidelines.

For instance, for a Danish inventor or a Danish enterprise, it will almost always be the easiest, the fastest and the cheapest way to start with filing a patent application in Denmark only. Hereby, a priority date for the invention is obtained, which may, within 12 months, form the basis of a corresponding application abroad. The novelty of the invention will be determined in the other countries, too, in relation to the state of the art on the date of filing in Denmark. Furthermore, the applicant has the opportunity to ask for his national patent application in Denmark to be subjected to a so-called "international-type search."

Less than nine months after the filing date, the applicant will know the outcome of the search, which will allow him the necessary time for considering how and in which countries he will possibly try to obtain a patent, if the search indicates that the invention may be considered patentable. If an applicant only wants protection in, for example, Denmark and a few foreign countries, the best route is likely to be to seek national patent protection in each of the countries separately, claiming priority from the filing date of the Danish application. This is the classic procedure—and, until a few years ago, the only one. The much talked-about "world patent" does not exist, not even today. However, the number of countries in which the applicant wants protection need not be very high, and it will be advantageous to the applicant either to use the PCT system or the European system. The decisive fact will be in which foreign countries the Danish or other European enterprise or inventor wants patent protection. If only Japan and/or the United States of America are among the countries for which protection is sought, an international application under the PCT system will be the proper procedure as these two countries are among the 44 members of the PCT Union. If protection in more than 10 countries is necessary, and some of them are not members of the EPO, here, too, the PCT system is the appropriate system to use, as in such cases the fees for the additional designations will be reduced, that is to say, they are free of charge.

By using the PCT system, the applicant will obtain another considerable advantage. He does not have to pay national fees for entering the national phase until 30 months after his priority date in, for instance, Denmark, and only if the international search and preliminary examination have shown

positive results. The applicant only needs to proceed further with his international application in those specific countries, among the originally designated countries, where the applicant still considers it worthwhile to seek patent protection. In the case of some of the designated countries it has perhaps turned out in the meantime that there is no market for the product for which patent protection was sought. On the other hand, some of the countries where the applicant wants to proceed with the PCT application are likely to require that the international application be translated into the official language of the countries in question. This is extremely important work and generally very expensive for the applicant. This is precisely why it is a great advantage to the applicant using the PCT system to know the chances of having a patent issued before the extensive costs of translation must be paid.

It is possible to combine the PCT system and the European system. In an international application, the applicant may designate among others the European countries, which are members both of the PCT and the EPC, in such a way that for these countries a regional patent—as it is called in the PCT system—in contrast to a national patent, is applied for. This means that after the search or after both the search and the international preliminary examination, the application may be processed at the EPO with a view to the grant of a European patent which again will be valid in those countries where the applicant eventually chooses to fulfill the national requirements. By combining the PCT and the EPC, the point in time when the applicant has to translate his application into each of the languages of the PCT-designated countries where he wants to proceed with the application is postponed until after the application has been proceeded further at the EPO, has been handled there and led to a European patent based on a Euro-PCT application, as it is called in patent jargon. If the applicant had applied for a national patent via his PCT application covering the same countries, he would already at the expiry of the 30-month time limit have had to translate it into each of the national official languages, whereas by filing a Euro-PCT application at the expiry of the 30-month limit, he already has translated into English in preparation for the international publication after 18 months by the International Bureau. In many cases it will be to the advantage of a European applicant if he uses a combination of PCT and EPC.

From a fee point of view, the indicated procedure will be the most favorable, too. The fees to be paid to national Offices for making the European patent, which is based on a Euro-PCT application, valid in each designated country are then not due until the ultimate point in time. Typically, three months after the mention of the grant of the European patent in the *European Patent Bulletin*.

One may add that there are sure to be some European enterprises which are domiciled in countries where the official language is not English but which will consider it appropriate and beneficial from the outset to draft their patent application in English; for instance, if members of a research team in the enterprise are English-speaking. That may imply that it is preferable to file an international application under the PCT system directly at the EPO.

The conclusion is that for each invention for which patent protection is sought in several countries, one has to consider carefully which one of the above-mentioned parameters should predominate.

### 5. Can Other Countries Use Danish Experience?

I think the answer is clearly yes. For many years, Denmark was characterized as a country primarily manufacturing agricultural products. Today, however, agriculture only counts for less than 5% of the yearly GNP. During the last 20 years, a number of countries have experienced the same development. In a couple of years, industry in many countries that are not yet members of the PCT will become aware of the need for patent protection to a much larger extent than today.

It has been said by some skeptics that the PCT system is only meant for countries with a great number of national patent applicants. European experience does not confirm this. Belgium, Italy, Luxembourg, the Netherlands, Portugal and Denmark are the countries of the EEC with the lowest percentage of national patent applicants. Except for Portugal, all the countries mentioned have been members of the PCT for many years already. Did they all make a mistake in joining the PCT and even the same mistake? I have never heard anyone even mumble a remark indicating such a fact—indeed the opposite is true.

One fifth of all international applications come from 35 different countries. The average number of Contracting States designated per international application filed in Denmark is 24, the international average is 15. These figures, which were mentioned at the beginning of this study, clearly show that so-called “small countries”—going to be industrialized—are among the prime beneficiaries of the PCT system.

To the users it is very simple to write just one application in the international phase, to correspond with just one authority and not numerous national patent offices and foreign patent attorneys. In more than 90% of all international applications filed with the Danish receiving Office the applicant uses a patent attorney.

More than 40% of all the PCT applications filed in Denmark are filed by individual inventors and

applicants—even most of the so-called “large enterprises” in Denmark are medium-sized by a European yardstick.

One could also say in a more general way that the PCT system rationalizes the filing of patent applications and the application procedure. This is a fact of growing importance. The reason being that

products and goods today typically have a shorter life span than, for instance, 40 years ago. Add to this that today almost no enterprises are able to survive by just selling goods on their national market. This implies that patent protection abroad is indispensable to enterprises in any country as well as to Danish enterprises.

*Table A*  
*The Processing of Patent Applications in the Patent Department 1978-89*

Year	Applications						Granted Patents
	In Total	Hereof Further Processed PCT Application	With Danish Applicant	18-Month Publications	Laid Open for Public Inspection	Oppositions	
1979	5,540	97	895	5,193	1,910	48	2,141
1980	5,569	334	964	5,186	1,660	35	1,645
1981	5,830	511	1,085	5,086	1,450	29	1,439
1982	5,803	575	1,095	3,776	1,451	51	1,530
1983	6,987	640	1,167	6,506	1,150	40	1,155
1984	6,278	720	966	5,429	1,100	41	1,089
1985	6,092	859	856	5,800	1,180	39	1,054
1986	6,349	1,041	963	5,770	1,120	23	958
1987	6,953	1,163	1,035	6,077	1,589	31	1,128
1988	7,346	1,350	1,196	6,487	3,100	102	2,815
1989	6,754	894	1,123	6,480	2,523	68	2,616

*Table B*  
*Applications Filed with the Danish Patent Office as Receiving Office 1979-88*

Year	Filed in Total	% of all International Applications	Applications with Priority	Filing Language Danish	Filing Language English	Searched by EPO	Searched by Sweden
1979	61	2.2	59	37	24	1	60
1980	80	2.3	75	37	43	1	79
1981	121	2.6	115	57	64	3	118
1982	116	2.5	111	55	61	1	115
1983	127	2.5	115	58	69	7	120
1984	122	2.1	118	67	55	0	122
1985	126	1.8	118	74	52	0	126
1986	137	1.7	127	70	67	5	132
1987	164	1.8	150	85	79	2	162
1988	225	1.9	213	115	110	7	218

*Table C*  
*Designations in International Applications Filed with the Danish Patent Office as a Receiving Office 1979-88*

Year	In Total	Applications Requesting EP Patent	Number of Designations of EPO States in These	Designations of Denmark	Average Number of Designations per Application
1979	453	40	137	17	7.4
1980	600	62	343	14	7.5
1981	1,307	81	511	32	10.8
1982	1,534	97	748	41	13.2
1983	1,834	104	929	61	14.4
1984	1,589	104	902	47	13.0
1985	2,620	110	1,056	61	20.9
1986	2,822	133	1,300	78	20.6
1987	3,503	133	1,327	83	21.4
1988	5,501	192	1,920	134	24.5

Table D

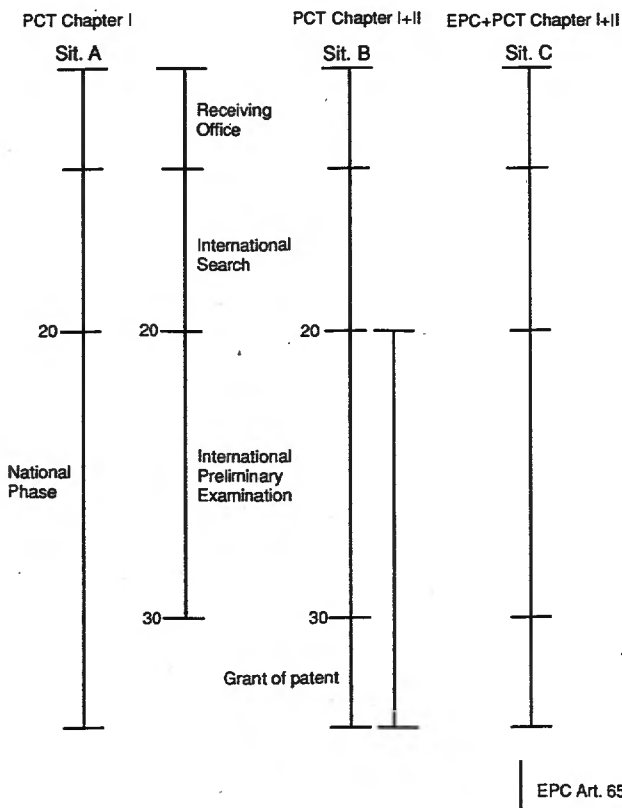


Table F  
International Applications Further Prosecuted in Denmark by Nationality in 1988

Denmark	39
Norway	30
Sweden	208
Finland	60
Germany (Federal Republic of)	144
EEC in total	402
United States of America	462
Japan	45
Other countries	143
Total	1,350

Table G  
Further Prosecution of International Applications in Denmark in 1979-88

Year	Designation of Denmark	International Application Further Prosecuted in Denmark	Total Number of Applications Filed	Further Prosecuted Applications (% of all Applications Filed)
1979	643	97	5,540	1.8
1980	1,056	334	5,569	6.0
1981	1,524	511	5,830	8.8
1982	1,430	575	5,803	9.9
1983	1,513	640	6,087	10.5
1984	1,767	720	6,278	11.5
1985	2,201	859	6,092	14.1
1986	2,563	1,041	6,349	16.4
1987	2,994	1,163	6,953	16.7
1988	3,893	1,350	7,346	18.4

Table E  
Designation of Denmark in International Applications in 1979 and 1985-88

Receiving Office	1979	1985	1986	1987	1988
Australia	—	103	138	167	203
Germany (Federal Republic of)	34	125	106	151	168
EPO	29	211	223	247	325
France	36	101	112	133	186
United Kingdom	85	186	283	337	435
Japan	18	35	39	66	76
Sweden	131	337	409	415	468
United States of America	233	726	804	1,022	1,396
Others	77	377	449	456	636
Total	643	2,201	2,563	2,994	3,893
No. of international applications	2,734	7,305	8,082	9,610	11,996
Percentage	24%	30%	32%	31%	32%

Table H  
Danish First Applications for Which an International-Type Search was Requested 1979-88

Year	Requests	Applications Filed by Danish Applicants
1979	17	895
1980	34	964
1981	46	1,085
1982	41	1,095
1983	48	1,167
1984	50	966
1985	52	856
1986	59	963
1987	79	1,035
1988	91	1,196

## New Items

### COSTA RICA

*Director,  
Industrial Property Register*

We have been informed that Licda. Lilliana Alfaro Rojas has been appointed Director of the Industrial Property Register.

### GERMANY

*German Patent Office*

We have been informed that, with the accession of the German Democratic Republic to the Federal Republic of Germany on October 3, 1990, the German Patent Office in Munich, with a branch office in Berlin, is the sole German central authority in the field of industrial property. The functions of the former Patent Office of the German Democratic

Republic are exercised, as from the aforementioned date, by the German Patent Office.

### SOMALIA

*Registrar of Patents and Trade Marks*

We have been informed that Mr. Husein Mohamed Farah has been appointed Registrar of Patents and Trade Marks.

### VENEZUELA

*Registrar of Industrial Property*

We have been informed that Mrs. Thaimy Marquez has been appointed Registrar of Industrial Property.



# Calendar of Meetings

## WIPO Meetings

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

### 1990

**December 10 to 14 (Geneva)**

#### **PCT Committee for Administrative and Legal Matters (Fourth Session)**

The Committee will continue to examine proposals for amending the Regulations under the Patent Cooperation Treaty (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.

### 1991

**April 15 to 18 (Geneva)**

#### **WIPO Permanent Committee for Development Cooperation Related to Copyright and Neighboring Rights (Ninth Session)**

The Committee will review and evaluate the activities undertaken under the WIPO Permanent Program for Development Cooperation Related to Copyright and Neighboring Rights since the Committee's last session (April 1989) and make recommendations on the future orientation of the said Program.

*Invitations:* States members of the Committee and, as observers, States members of the United Nations not members of the Committee and certain organizations.

**June 3 to 28 (The Hague)**

#### **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:* States members of the Paris Union and, as observers, States members of WIPO not members of the Paris Union and certain organizations.

**July 1 to 4 (Geneva)**

#### **WIPO Permanent Committee for Development Cooperation Related to Industrial Property (Fourteenth Session)**

The Committee will review and evaluate the activities undertaken under the WIPO Permanent Program for Development Cooperation Related to Industrial Property since the Committee's last session (May/June 1989) and make recommendations on the future orientation of the said Program.

*Invitations:* States members of the Committee and, as observers, States members of the United Nations not members of the Committee and certain organizations.

**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.

## UPOV Meetings

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

### 1991

March 4 to 19 (Geneva)

**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

### 1991

September 15 to 20 (Lucerne)

International Association for the Protection of Industrial Property (AIPPI): Council of Presidents

September 30 to October 4 (Harrogate)

International Federation of Industrial Property Attorneys (FICPI): Congress



