

Industrial Property

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Editor's Note

REPUBLIC OF KOREA

Patent Law (No. 950 of December 31, 1961, wholly amended by Law No. 4207 of January 13, 1990) (<i>This text replaces the one previously published under the same code number</i>)	Text 2-001
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WIPO 1991

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Notifications Concerning Treaties

Lisbon Agreement

Ratification of the Stockholm Act (1967)

PORTUGAL

The Government of Portugal deposited, on January 16, 1991, its instrument of ratification of the Stockholm Act of July 14, 1967, of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of October 31, 1958.

The Stockholm Act (1967), as amended on October 2, 1979, of the said Agreement will enter into force, with respect to Portugal, on April 17, 1991.

Lisbon Notification No. 19, of January 17, 1991.

Budapest Treaty

I. Change in Fees under Rule 12.2 of the Regulations under the Budapest Treaty

AMERICAN TYPE CULTURE COLLECTION (ATCC) (United States of America)

The Director General of WIPO was informed by a notification received on January 3, 1991, dated December 12, 1990, from the Government of the United States of America of a change in the fees charged by the American Type Culture Collection (ATCC) as an international depositary authority under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure.

We have received a notification from the American Type Culture Collection regarding a new schedule of fees and the kinds of microorganisms and material accepted by that organization. In accordance with Rule 12.2(a) of the

Regulations under the Budapest Treaty, I am pleased to notify you of the following changes in the fees:

ATCC Cultures *Per Item*

Algae, bacteria, bacteriophages, fungi, plant tissue cultures, plasmids, protozoa, vectors and yeasts (except Preceptrol and Uniplus)	\$49
U.S. Non-Profit Institutions	49 ¹
Foreign Non-Profit Institutions	75
Other U.S. and Foreign Institutions	75

ATCC Preceptrol and Uniplus Cultures

All Institutions.	15
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ATCC Cell Lines and Oncogenes

U.S. Non-Profit Institutions	59
Foreign Non-Profit Institutions	59 ²
Other U.S. and Foreign Institutions	90

ATCC Viruses, Animal and Plant, Rickettsiae and Chlamydiae

U.S. Non-Profit Institutions	45
Foreign Non-Profit Institutions	45 ³
Other U.S. and Foreign Institutions	70

Fees to Maintain and Notification of Requestors of Cultures for Patent Purposes

Maintenance of culture for 30 years	600 ⁴
Notification of name and address of requestors of cultures for 30 years	330

Minimum invoicing is \$45. Orders received for lesser amounts will be invoiced at the minimum.

¹ There is an additional \$26 handling and processing charge per culture.

² There is an additional \$31 handling and processing charge per culture.

³ There is an additional \$25 handling and processing charge per culture.

⁴ There is a freight charge made to depositors for returning samples for verification of properties if a culture is provided to ATCC as a test tube or a flask culture.

[End of text of the notification of the
Government of the United States of America]

The fees set forth in the said notification of the Government of the United States of America will apply as from the thirtieth day following the date (February 28, 1991) of the publication of the said fees in the present issue of *Industrial Property*, that is, as from March 30, 1991 (see Rule 12.2(c) of the Regulations under the Budapest Treaty), and will replace the fees published in the April 1989 issue of *Industrial Property*.

Budapest Notification No. 66 (this notification is the subject of Budapest Notification No. 95 of January 18, 1991).

II. Change in Fees under Rule 12.2 of the Regulations under the Budapest Treaty and Clarification of Name and Address

NATIONAL COLLECTIONS OF INDUSTRIAL
AND MARINE BACTERIA LTD. (NCIMB)

(United Kingdom)

The Director General of WIPO was informed by a notification received on January 14, 1991, from the Government of the United Kingdom of a change in the fees charged by the National Collections of Industrial and Marine Bacteria Ltd. (NCIMB), an international depositary authority under the Budapest Treaty, as follows:

Storage of the microorganism	£400
Issuance of a viability statement in those cases in which, in accordance with Rule 10.2, a fee may be charged	50
Furnishing of a sample in accordance with Rule 11.2 or 11.3	40
(plus actual cost of carriage)	

The fees are payable to NCIMB Ltd. and are subject to Value Added Tax where applicable.

Further, as stated in the said notification of the Government of the United Kingdom, the full and correct name and address of the said international depositary authority are the following:

National Collections of Industrial and Marine
Bacteria Ltd. (NCIMB)
23 St. Machar Drive
Aberdeen AB2 1RY
Scotland
United Kingdom.

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

The fees set forth in the said notification of the Government of the United Kingdom will apply as from the thirtieth day following the date (February 28, 1991) of the publication of the said fees in the present issue of *Industrial Property*, that is, as from March 30, 1991 (see Rule 12.2(c) of the Regulations under the Budapest Treaty), and will replace the fees published in the January 1989 issue of *Industrial Property*.

Budapest Notification No. 67 (this Notification is the subject of the Budapest Notification No. 96 of January 21, 1991).

III. Notification of the European Patent Organisation (EPO)

DSM-DEUTSCHE SAMMLUNG VON
MIKROORGANISMEN
UND ZELLKULTUREN GmbH (DSM)

(Germany)

The following notification from the European Patent Organisation (EPO), dated November 26, 1990, was received on November 30, 1990, by the Director General of WIPO under the Budapest Treaty:

1. Pursuant to Rule 33 of the Regulations under the Budapest Treaty, I have the honor to notify you that the assurances given by the European Patent Organisation in its communications of July 23, 1981, March 8, 1988, and July 4, 1990, to the effect that the Deutsche Sammlung von Mikroorganismen und Zellkulturen GmbH (DSM), in its capacity as international depositary authority, complies and will continue to comply with the requirements specified in Article 6(2) of the Treaty, are extended, with certain limitations, to the following kinds of microorganisms:

—animal and human cell cultures.

Annex I hereto reproduces the entirety of the kinds of microorganisms now accepted by the authority.

2. With reference to Rule 12 of the Budapest Treaty, I have the honor to inform you that DSM will charge the fees shown in Annex II hereto in respect of animal and human cell cultures.

3. Finally, I would advise you that, in compliance with the requirements that DSM wishes to apply under Rule 6.3 to animal and human cell

cultures, it will be necessary to deposit 12 cryo-ampoules for each cell culture.

Annex I

Kinds of Microorganisms Accepted for Deposit by the Depositary Authority

The following are accepted for deposit:

1. bacteria, including actinomycetes,
2. fungi, including yeasts,
3. bacteriophages,
4. plasmids
 - (a) in a host,
 - (b) as an isolated DNA preparation,
5. plant viruses,
6. plant cell cultures,
7. animal and human cell cultures.

Re Kinds 1, 2, 3 and 4:

The DSM accepts for deposit only those bacteria, fungi, bacteriophages and plasmids which, pursuant to DIN 58 956 Part 1 (supplementary sheet 1), belong to hazard group I or II.

Re Kinds 1, 2, 3, 4, 5, 6 and 7:

The DSM must be able to process genetically manipulated strains or isolated DNA and also genetically manipulated plant viruses, plant cell cultures and animal and human cell cultures in accordance with Laboratory Safety Measures L1 or L2 contained in "Richtlinien zum Schutz vor Gefahren durch in-vitro neukombinierte Nukleinsäuren" (5th revised version, German Federal Ministry for Research and Technology, May 1986, Bundesanzeiger Verlagsgesellschaft mbH, Cologne) (Guidelines on protection against hazards resulting from in vitro recombinant nucleic acids).

Re Kind 5:

Plant viruses which cannot multiply through mechanical infection of plants cannot be accepted for deposit.

Re Kind 6:

Plant cell cultures can only be deposited in the form of callus or suspension cultures with non-differentiated growth. The material for deposit must be free from contamination by foreign organisms.

Re Kind 7:

Before being dispatched to the DSM, animal and human cell cultures must be examined to ensure they are free of viruses.

Contaminated material (particularly material contaminated by *mycoplasma*) cannot be accepted for deposit.

It should be borne in mind that it takes the DSM four to six weeks to check for contamination by *mycoplasma*.

For all deposits:

Notwithstanding the restrictions mentioned above, the DSM reserves the right to refuse to accept for deposit material which in its view represents an unacceptable hazard.

In all instances, it must be possible to preserve the deposited material by lyophilization or storage in liquid nitrogen or by some other method of long-term preservation without significant change.

Annex II

Fee Schedule (Rule 12.1 of the Budapest Treaty)

The fees for the deposit of animal and human cell cultures are as follows:

	DEM
1. (a) storage according to Rule 12.1(a)(i) of the Budapest Treaty.	2,400
(b) conversion of a deposit made outside the Budapest Treaty into a deposit according to the Budapest Treaty	2,400
(c) prolongation of the duration of the storage over the one provided by Rule 9 of the Budapest Treaty, per year	80
2. issuance of a viability statement (Rule 12.1(a)(iii) of the Budapest Treaty)	
(a) where a viability test is also requested	200
(b) on the basis of the last viability test	40
3. furnishing of a sample (Rule 12.1(a)(iv) of the Budapest Treaty) (plus current freight costs)	200
4. communication of information under Rule 7.6 of the Budapest Treaty	40
5. attestation referred to in Rule 8.2 of the Budapest Treaty	40

As a general rule, the fees under 1, 2, 4 and 5, above, are subject to VAT, currently at the rate of 7%. Where samples are furnished, VAT is payable only by requesting parties in Germany.

[End of text of the notification of the European Patent Organisation]

The list of kinds of microorganisms specified in Annex I of the notification of the EPO and the amendments to the requirements provided for by Rule 6.3 of the Regulations under the Budapest

Treaty will take effect as from February 28, 1991, the date of publication of the said notification in the present issue of *Industrial Property*. The said list of kinds of microorganisms and the said requirements will supplement the list of kinds of microorganisms and the requirements published in the September 1990 issue of *Industrial Property*.

The fees set forth in Annex II of the said notification will apply as from the thirtieth day following

the date of publication (February 28, 1991) of the said fees in the present issue of *Industrial Property*, that is, as from March 30, 1991 (see Rule 12.2(c) of the Regulations under the Budapest Treaty).

Budapest Notification No. 68 (this notification is the subject of Budapest Notification No. 93, of December 10, 1990).

Activities of Other Organizations

International Association for the Protection of Industrial Property (AIPPI)

Executive Committee

(Barcelona, September 30 to October 5, 1990)

NOTE*

Introduction

The International Association for the Protection of Industrial Property (AIPPI) held a meeting of its Executive Committee in Barcelona (Spain) from September 30 to October 5, 1990. About 500 members of AIPPI participated in the meeting, which was opened by the Minister of Industry and Energy of Spain, Mr. Claudio Aranzadi, and presided over by the Executive President of AIPPI, Mr. Masahiko Takeda (Japan), and other officers of AIPPI.

The World Intellectual Property Organization (WIPO) was represented by its Director General, Dr. Arpad Bogsch, Dr. Alfons Schäfers (Deputy Director General), Dr. Ludwig Baeumer (Director, Industrial Property Division) and Mr. Francis Gurry (Special Assistant, Office of the Director General).

At the opening ceremony, the Director General of WIPO delivered an address which is reproduced below.

The Executive Committee dealt with the following questions: negotiation within GATT on trade-related aspects of intellectual property rights; parallel import of patented products; protection of unregistered but well-known trademarks and protection of highly renowned trademarks; dependent patents and their exploitation; international registration of marks; harmonization of trademark law; harmonization of certain provisions of the legal systems for protecting inventions; early publication and provisional protection of patent applications; intervention of third parties in the patent granting

and amendment procedures; effects of patent or trademark invalidity on license agreements.

During the same period, the Council of Presidents of AIPPI held several meetings. At the conclusion of the meeting, the Executive Committee adopted a number of resolutions. Except for those relating to the harmonization of patent law, which have been superseded by a subsequent meeting of the Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions, the essential contents of the resolutions adopted are reproduced below.

Address by the Director General of WIPO

*"His Excellency Mr. Claudio Aranzadi, Minister for Industry and for Energy,
Mr. Fernando Panizo, Under Secretary, Ministry of Industry of Energy,
Madame Regina de Revilla, Director General of Technology Policy,
Mr. Julio Delicado Montero-Ríos, Director General, Registry of Industrial Property,
Mr. Masahiko Takeda, Executive President of AIPPI,
Mr. Martin Lutz, Secretary General of AIPPI,
Mr. Marcelino Curell Suñol, President of the Spanish National Group of AIPPI and of the Organizing Committee,
Ladies and Gentlemen,*

It is an honor for both the World Intellectual Property Organization, in whose name I speak today, and for me to be able to address you at the opening of this Executive Committee meeting of the International Association for the Protection of Industrial Property, so ably organized by the Spanish National Group of the Association.

Twenty years have passed since, in Madrid in 1970, the Spanish National Group last organized the

* Prepared by the International Bureau of WIPO.

meeting of the Executive Committee. Those 20 years have witnessed a continued intensification of international economic and commercial cooperation in all spheres and it is thus fitting that it should now be Barcelona, the next city of that symbol of internationalism, the Olympic Games, that welcomes the meeting of the Executive Committee.

The meetings of AIPPI hold a special importance for the World Intellectual Property Organization. They offer a window onto the direct experience of those working daily on the transactions and affairs which constitute international commerce, at least international commerce in the small, but nonetheless important, field of intellectual property. Such a window is essential if the framework administered by WIPO is to remain responsive to the needs of those operating within it. In the hope that the process of interaction between the work of WIPO and the work of AIPPI will continue to produce mutually stimulating and positive results, I should like to recount briefly the main highlights of the work of WIPO since the last meeting of AIPPI, the Congress held in Amsterdam in June of last year.

The first element of the framework administered by WIPO comprises those treaties and agreements which are aimed at making the task of obtaining protection for intellectual property rights quicker, cheaper and more effective. I speak of our so-called registration activities and I am happy to report that not only have these activities continued to flourish, but also there have been significant Spanish associations with the successes of the two most important treaties in this area, the Patent Cooperation Treaty and the Madrid Agreement.

The PCT, now in its twelfth year, saw during the last 12 months the much welcomed accession of Spain, as well as the accessions of Canada, Greece and, last week, Poland; those accessions bring the total number of Contracting States to 45.

During the calendar year 1989, almost 15,000 international patent applications were filed worldwide, an increase of 24% over 1988. During the present calendar year, approximately 19,000 international applications are expected to be filed, having the effect, in the PCT Contracting States, of some 380,000 national applications.

The Madrid Agreement Concerning the International Registration of Marks also experienced both an increase in the number of Contracting States and an increase in the number of registrations. China and Cuba became new Contracting States, bringing the total number of Contracting States to 28, and Poland announced that it would shortly become a Contracting State. The total number of new registrations in the calendar year 1989 rose to some 15,000, an increase of about 14.5% over 1988, and continues to rise at the same rate in 1990.

A big new event for the international registration of marks was the successful adoption of the Protocol

to the Madrid Agreement Concerning the International Registration of Marks. The Madrid Protocol was concluded at Madrid on June 27, 1989, and has been signed by 28 States. As you know, the Madrid Protocol offers the possibility of welcoming into the Madrid system for the international registration of marks a broader membership and of making that system interactive with the future Community trademark system. As regards the broader base of membership, some encouraging news has just recently come to hand. The United Kingdom Government has published a White Paper in which it announces its intention to ratify the Madrid Protocol. On a non-official but decisive level, the Board of Directors of the United States Trademark Association has also recently decided to examine the Madrid Protocol to determine whether to recommend accession by the United States of America.

Work has also started within WIPO on the drafting of regulations for the application of the Madrid Protocol, and the Working Group met on this subject in March of this year and will meet for a second time in November of this year.

Our third registration activity, conducted under the Hague Agreement Concerning the International Deposit of Industrial Designs, also continues to grow. A total number of some 4,000 deposits and renewals under the Hague Agreement occurred in 1989, an increase of 12.6% over 1988. In addition, work has commenced on the study of the question of the advisability of revising the Hague Agreement, or adding to it a Protocol, in order to introduce in the system further flexibility aimed at encouraging broader participation in the Hague system. In particular, it is envisaged to study the desirability of introducing special provisions designed to take into account the needs of the textile industry that result from the rapidly changing seasonal fashion trends that affect that industry. A working group on those questions will meet next year.

A fourth and new kind of registration activity should commence at WIPO in the near future. In April 1989, the Treaty on the International Registration of Audiovisual Works was adopted in Geneva. Three ratifications have already been received. Two more are needed for the opening of the Registry which will be located in Vienna. It will make the task of proving copyright in a work simpler and more effective and will add an important new weapon to the fight against piracy of films.

I shall now turn from the registration activities to WIPO's activities for the establishment of standards for the protection granted to intellectual property rights. I shall be brief and shall refer only to two broad categories of activities.

The first category embraces the negotiation and conclusion of new treaties directed at establishing standards. In this area, committees of experts are working on three draft treaties, namely,

- one for the harmonization of patent laws,
- another for the harmonization of laws for the protection of marks,
- the third, for the settlement of intellectual property disputes between States,

and committees of experts are examining

– the desirability of a new treaty for the international protection of indications of source and appellations of origin, and

– the desirability of a protocol to the Berne Convention for the Protection of Literary and Artistic Works.

In this first category of activities concerning standards, undoubtedly the most important immediate task for WIPO is the conclusion of the Patent Law Harmonization Treaty. The present draft of that Treaty contains 37 Articles and 8 Rules. The negotiations for the Treaty are in their final stages. The next and probably last meeting of the Committee of Experts will be held in October and November of this year and a Diplomatic Conference to conclude the Treaty will be held in The Hague from June 3 to 28, 1991.

The second category of activities in the area of standard-setting comprises the exploration and examination of areas that are rapidly evolving and that may need norms to be established. In this area, WIPO either has been studying over the past year, or will commence studying over the course of the next year, a variety of questions, including

- the protection of biotechnological inventions,
- the desirability of establishing a mechanism for the resolution of intellectual property disputes between private parties,
- the improving of the collective administration of certain rights in the field of copyright, of the protection against unfair competition, the questions of franchising, of character merchandizing and of insurance against the risk of litigation concerning the validity of patents. In addition, we shall be convening a worldwide symposium on the intellectual property aspects of artificial intelligence.

Mr. Minister, Distinguished Guests, all these plans and activities are of primary interest to the membership of AIPPI. Without their advice and broad agreement, these plans cannot lead to practical results. Consequently, and as was done also in the past, WIPO will continue to invite AIPPI to all its meetings and will give your representatives an opportunity to express your views and your advice. I am confident that you will make full use of this possibility, and I thank you in advance for your cooperation.

I should like to reiterate my thanks to Mr. Marcelino Curell Suñol and the Bureau of the Spanish National Group for the excellence of the organizational arrangements for this meeting and to

ensure you of WIPO's closest attention to your very important deliberations."

Resolutions Adopted

QUESTION 51

Utilization of the International Convention for the Protection of New Varieties of Plants of 1961 (UPOV)

RESOLUTION

1. AIPPI

– reaffirms its resolutions made in Rio de Janeiro in May 1985 on Question 82 (*Annuaire* 1985/III D 348, F 276, E 312) and in April 1988 in Sydney (*Annuaire* 1988/II D 237, F 199, E 221) on Question 93 (Biotechnology),

– welcomes the convening of a diplomatic conference for the revision of the Convention for the Protection of Plant Varieties of 1961 (UPOV) to be held in Geneva in March 1991, having regard to the developments in the field of the creation and breeding of new plant varieties and the resulting overlap with patent laws which made a revision of the Convention urgent.

2. Having studied the draft text of the Convention prepared by the Office of the Union (UPOV document IOM/V/2 of August 22, 1990), AIPPI notes with approval–

(a) that the prohibition of double protection according to Article 2(2) of the present text has been abolished;

(b) that it is intended to incorporate definitions of certain concepts of the Convention and notably the concept of varieties;

(c) that the general principle of national treatment has been incorporated;

(d) that the effect of the breeder's right should no longer be confined to the propagating material only and shall in all contracting States extend also to the harvested material of the protected variety derived from the reproductive or vegetative propagating material, as indeed demanded by AIPPI in its resolution of Munich in May 1978 on Question 51;

(e) that the general minimum duration of the breeder's rights is to be not less than 20 years and not less than 25 years for trees and vines; and

(f) that a measure of provisional protection of limited scope is contemplated during the period between the publication of the application for the grant of a breeder's right and the decision thereon, by way of remuneration from any person who also uses the variety in question.

3. It is, moreover, noted with satisfaction that the "Collision Norm" contained in the previous draft of June 22, 1989 (UPOV document IOM/IV/2) and by which a granted plant variety right would intervene in other laws by way of expropriation or compulsory licenses, have been completely removed.

In this regard, AIPPI reaffirms its position concerning breeders' rights that compulsory licenses should be granted only in the public interest.

4. AIPPI is satisfied that the new text has retained the existing provision by which, for the purpose of offering

for sale and distribution of a protected plant variety, it is admissible to use together with the varietal denomination as generic name also a specific mark.

5. The proposals in the draft for the farmers' privileges as well as the specific provisions for the breeders' privileges appear obscure on several points and require further study.

QUESTION 97

Dependent Patents and their Exploitation

RESOLUTION

A.-(1) A dependent patent is a patent which as a matter of law cannot be worked without falling within the scope of protection of another patent. The latter patent will be referred to as the dominant patent.

By way of examples of dependent patents, mention may be made of a patent which protects a novel process for the production of a product which is protected by the dominant patent, a patent granted in respect of a novel application of a product or a process protected by the dominant patent, or an improvement patent.

(2) Consequently, use of the patent would constitute infringement of the dominant patent. That means that in principle the proprietor of the dependent patent must obtain consent from the proprietor of the dominant patent for working his invention. Likewise the proprietor of the dominant patent cannot work the invention of the dependent patent without having obtained consent from the proprietor of the dependent patent. That is the normal consequence of the basic principle of patent law which is a prohibition right.

....

B. AIPPI affirms that a compulsory license of dependency constitutes a serious derogation from the fundamental right of the patentee, which runs the risk of being reduced to a simple right to recompense. Consequently AIPPI is opposed to the principle of compulsory licenses of dependency, and affirms that, at the least, if provision were made for such licenses in domestic law, such licenses could be granted only if extremely strict conditions were met.

C. Noting that many countries make provision in their domestic law for a compulsory license of dependency which is granted under differing conditions from one country to another, AIPPI considers that the conditions under which such a license is to be granted should be harmonized and should comprise at least all of the following:

- (a) considerable importance of the invention of the dependent patent;
- (b) that the invention of the dependent patent cannot be worked at all without the license;
- (c) payment of fair compensation to the owner of the dominant patent having regard to the particular circumstances of the case, which compensation should be higher when the two patents are worked in competition with each other;
- (d) that the license be non-exclusive and not freely transferable;
- (e) grant of a license on the dependent patent to the proprietor of the dominant patent if the latter so wishes.

QUESTION 98

Early Publication and Provisional Protection of Patent Applications

RESOLUTION

A. Having regard to the fact that any governmental publication of the application makes available the technology of the invention to everyone, AIPPI recognizes that from the date of such publication the applicant should enjoy protection against acts falling within the extent of protection of the published application insofar as such acts also fall within the extent of protection of the ultimately granted patent, in particular including:

- (1) the right to initiate court proceedings before grant of the patent;
- (2) the right to seek an injunction in countries with a pre-grant opposition procedure, from the date of publication of acceptance of the application;
- (3) the right to the same monetary remedy as for infringement after grant from the date on which the defendant is given notice of the applicant's allegations against him;
- (4) the right for at least one year after the date of patent grant to seek monetary remedy under point (3), notwithstanding any statute of limitation;
- (5) the right to obtain accelerated prosecution of the application where infringement is alleged.

B. The foregoing rights of the applicant shall be balanced by rights safeguarding the position of the defendant, in particular including:

- (a) the right to seek to stay court proceedings until grant or, in countries with a pre-grant opposition procedure, until the date of publication of acceptance of the application;
- (b) the right to obtain accelerated prosecution of the application.

....

QUESTION 99

Intervention of Third Parties in the Patent Granting and Amendment Procedures

RESOLUTION

The Executive Committee of AIPPI, meeting in Barcelona on September 30 to October 5, 1990, taking into account the drafts of the Harmonization Treaty under discussion at WIPO, in particular Articles 17 and 18 of document HL/CE/VIII/3, and the Resolutions of the Amsterdam Congress in 1989 in the framework of the study of Question 89, has adopted the following Resolution:

1. Intervention of Third Parties in the Pre-Grant and Post-Grant Proceedings of Patents

Considering that the offices in charge of the examination of patent applications cannot have at their disposal all the pertinent elements for determining patentability, and whereas, in the public interest, only valid patents which are well defined relative to the state of the art should be issued;

Considering that, in the countries which do not provide for a substantive examination, it is also in the interest of the public to be informed of the existence of factors susceptible to put into question the validity of the patent;

1.1 AIPPI is favorable to the intervention of third parties in the patent pre-grant and post-grant proceedings.

In the case of opposition proceedings, AIPPI *recommends*:

- the establishment of a system providing for opposition by third parties after grant in those countries having substantive examination,

- the replacement, after a possible transitional period, of a pre-grant opposition system with a post-grant opposition system in those countries now having a pre-grant opposition system.

In the case of countries with or without substantive examination, AIPPI *recommends*:

- providing the possibility for third parties to file observations after publication of the patent application or of the patent;

- in countries with substantive examination, the third party submitting the observations shall be informed by the office that it has taken the action it deemed necessary.

1.2 As concerns the practice of the post-grant opposition proceedings, AIPPI *recommends* that:

- an opposition period be fixed, and that this period be not less than six months and not more than nine months, after publication of the patent grant;

- the opposition grounds be limited to substantive grounds and exclude formal grounds, the latter including the lack of unity of invention;

- the opposition grounds should extend to all requirements of patentability, and not only to the lack of novelty or inventive step (non obviousness) resulting from printed publications;

- during the course of opposition proceedings, the opponent and the owner of the patent should be able to present, at least in written form, their arguments, before the office in charge of the opposition proceedings.

1.3 In the case of countries having re-examination proceedings which can be initiated by a third party throughout the life of the patent, AIPPI *is of the opinion* that it is not desirable to cumulate the opposition proceedings, as defined hereinabove, with such re-examination proceedings due to the increased insecurity that this would bring to the patentee.

In any event, in most countries the third party has the right to contest the validity of the patent before the courts.

AIPPI recognizes that the national legislation may authorize the courts to ask the patent office which conducts substantive examination for its opinion on the validity of the patent if it is contested by a third party.

1.4 In countries with substantive examination and which authorize the owner of the patent to request re-examination of his patent after grant, AIPPI *recommends* that:

- the office in charge of the re-examination take the necessary steps to inform the public that such re-examination has been requested by the patentee;

- a period be fixed for enabling third parties at least to present observations on the pertinency of the grounds for re-examination;

- the period should be three months from the date of publication of the re-examination request;

- the Office inform the public of the result of the re-examination, and allow the public to have full access to the re-examination file.

1.5 In the countries without substantive examination and in the absence of opposition proceedings, AIPPI *recommends* that:

- a period be fixed after the publication of the patent application or of the patent for allowing third parties to present observations on patentability,

- this period be of the same duration as the one foreseen in the case of opposition, namely between six and nine months;

- the observations may cover grounds identical to those set out hereinabove for opposition proceedings;

- the patent office concerned should take the necessary steps to inform the public that observations have been filed and to grant the public full access to the file.

II. Intervention of Third Parties in the Proceedings for Changes in Patents

Insofar as the owner of a patent is authorized to ask for changes to his granted patent (as in reissue proceedings), AIPPI recommends that third parties should be authorized at least to present observations during such proceedings and that the patent office should inform the public of the request for any such changes and publish the same.

....

QUESTION 100

Protection of Unregistered but Well-Known Trademarks (Article 6bis Paris Convention) and Protection of Highly Renowned Trademarks

RESOLUTION

AIPPI, *having considered* that

- as a general rule, marks are protected only against use or registration in respect of goods and services which are identical or similar to those for which they are registered or used and in many countries such a protection depends on registration;

- there are marks, however, which deserve protection which goes beyond the protection described above;

- protection of well-known marks under Article 6bis of the Paris Convention needs to be reviewed in the context of developments in international trade;

- domestic laws often do not provide for sufficient protection of marks which have acquired a reputation;

and having regard to previous resolutions of AIPPI, in particular the Resolution of Berlin in 1963, and to the work undertaken by WIPO

adopts the following Resolution:

A. With Regard to the Question of Well-Known Trademarks (Article 6bis)

To ensure better protection against misappropriation, the protection of well-known marks should conform to the following minimum standards:

(1) Concept of a well-known mark: a mark which is known to a large part of those involved in the production or trade or use of the goods concerned, and is clearly associated with such goods as coming from a particular source.

(2) The mark should be well known in the aforementioned sense in the jurisdiction where protection is sought. However, in deciding whether a mark is well known, it is right to take into consideration the fact that the mark is well known internationally.

(3) No condition of use in the jurisdiction where protection is sought should be required.

(4) These provisions should apply to service marks *mutatis mutandis*.

B. With Regard to Marks Having a Reputation

(1) As already stated, trademark law normally gives protection to marks only against use or registration in respect of goods and services which are identical or similar to those for which the mark is registered or used. However, some marks by reason of their reputation have acquired a value not confined to the basic distinguishing function of a mark, so that they should be entitled to protection beyond that scope.

(2) The owner of such a mark should be able to prevent third parties from taking undue advantage of or causing detriment to the distinctive character or repute of the mark. The scope of such protection may be dependent upon the nature of the mark and the degree of its repute. Such protection may be made dependent on registration in the jurisdiction concerned.

(3) For some marks which have acquired a high reputation in a particular jurisdiction, such as to give them an autonomous attractive power in themselves, protection ought to be given against use or registration for any goods or services without the need to prove any undue advantage or detriment as mentioned above.

(4) Such marks, to be referred to as "marks having a high reputation" ("*marques de haute renommée*" in French, "*berühmte Marke*" in German) are those which are known to a large part of the public in general and which are of such a nature and repute that there does not appear to be any justification for the use or registration of the mark by others. Since such marks are known to a large part of the public they are also necessarily well known in the sense of Chapter A, above.

(5) The protection of marks having a high reputation should apply not only against marks which are identical but also against marks which would be seen clearly to have been derived from the mark concerned.

(6) The protection of marks having a high reputation should not be dependent upon registration in the jurisdiction concerned.

(7) Such greater protection given to marks having a high reputation is to be regarded as exceptional and should be limited to protection against misappropriation by use or registration. Consequently, any registration of such marks should be subject to cancellation on the ground of non-use in the same way as other trademarks; if that were not the case, no account would be taken of the possibility of a future reduction in the degree of reputation, and such marks could unreasonably inhibit the registration of subsequent marks which are similar but would not be seen clearly as derived from the mark in question.

C. With Regard to Trade Names and Other Signs

(1) The greater protection given to marks having a high reputation should be applied also to trade names, and other signs identifying businesses, having a high reputation.

(2) The protection of highly reputed indications of geographical origin may raise different questions and ought to be the subject of further study by AIPPI.

D. With Regard to Acts of Bad Faith

In many cases, unauthorized use or registration of marks or other signs which are well known or have a reputation is done in bad faith. National courts and legislatures should be particularly concerned to eliminate such acts of bad faith, and the questions of what constitutes bad faith and what further measures are required should be the subject of further study by AIPPI.

QUESTION 101

Parallel Import of Patented Products

RESOLUTION

AIPPI has considered the question of the parallel import of patented products and the ability of a patentee to invoke his patent to block such import. Parallel import of a patented product is defined as the importation by a third party of a product into a country (hereinafter country A) where it falls under the protection of a patent, from another country (hereinafter country B), where it has been put on the market by the patentee or with his consent.

AIPPI notes that this question relates solely to patents and that it has not considered any other intellectual property rights.

AIPPI, having considered the question of the parallel import of patented products, adopts the following resolution:

AIPPI resolves that a patentee be able to invoke his patent against the parallel import of a patented product, notwithstanding the circumstances under which such product has been put on the market in country B, subject to exception by contractual agreement authorizing import of the product into country A.

The ability to invoke the patent against the parallel import of patented products is a logical consequence of the fundamental principle of territoriality of patent rights. The inability to prevent parallel imports diminishes the value of patents and the benefits deriving therefrom.

AIPPI observes that arrangements may exist where a number of countries decide to form a single regional market, in effect defining a single regional territory. In such an arrangement, a requirement for freedom of movement of goods within the single market may lead to acceptance of the legitimacy of parallel imports between countries which are party to the arrangement, provided that those countries together agree among themselves that such a restriction of the rights of a patentee is necessary for the realization of such single market.

QUESTION 102

Effects of Patent or Trademark Invalidation on License Agreements

RESOLUTION

AIPPI notes that the legal issues raised by this Question pertain not so much to the laws of intellectual property as to the law of contracts and other laws in the realm of civil law.

The jurisprudential principles underlying these laws differ markedly from country to country. Nevertheless the practical solutions recognized or proposed in most countries are quite similar.

Frequently, countries start out with quite divergent initial rules, and apply thereto exceptions and qualifications which in practice lead to much the same results.

AIPPI therefore believes that it is possible to propose solutions which reflect the underlying common private and public needs without undertaking debates of legal philosophies.

AIPPI urges that national laws and rules be applied in accordance with the following guidelines,

In formulating these guidelines, AIPPI was motivated by the following considerations:

(1) The validity of a patent is fundamental to a license agreement, and ought not to be immune to challenge by the licensee.

(2) It is unreasonable to provide for the continuance in force of an agreement whose cause or object is non-existent.

(3) In most cases, other than fraud, it is equally unreasonable or impractical to attempt to undo the effects of an agreement to the extent that it has been executed.

(4) The guidelines are intended to define the rights of the parties on points not controlled by contractual provisions. It is desirable that parties foresee possible difficulties by entering into contractual provisions covering the same.

General Rules in the Absence of Contractual Provisions at Variance Therewith, and of Fraud

(1) A licensee has the right to contest the validity of the licensed patent.

(2) The total invalidity of the patent has as a consequence either the invalidity or termination of the license agreement, or the creation of a right on the part of the licensee to terminate the agreement. The ground for the invalidity of the patent is irrelevant.

(3) A final decision by a court or other competent authority holding the patent to be invalid is effective, insofar as concerns the license agreement, as of the date upon which the legal action leading to such a decision was begun, if instituted by the licensee; or as of the date of the final decision, if the legal action was begun by a party other than the licensee.

(4) The licensee is not entitled to seek recovery of royalties paid prior to the effective date of the invalidity or termination of the license agreement. The licensor is entitled to lay claim to the payment of royalties due up to the effective date of the invalidity or termination of the license agreement.

The court or other competent authority may, nevertheless, make a total or partial exception to this general rule to the extent that the licensor or the licensee proves that this is justified by the circumstances and on grounds of equity.

(5) If a patent license agreement also provides for the communication of know-how, the consequence of the invalidity of the patent depends upon the extent to which the know-how has a value separate from that of the patent. If the know-how is merely incidental to the patent, the consequence of the invalidity of the patent is the same as in the case of a license agreement covering a patent only. If the know-how is capable of conferring upon the

licensee an economic benefit independently of the patent, the license agreement can survive as to the know-how. It lies within the competence of the court to decide whether the know-how license can have a separate life of its own. If the license agreement does not allot royalties separately to the patent and to the know-how, it lies equally within the competence of the court to determine the proportion of the royalties attributable to the know-how. The same solutions apply to the cases of other mixed licenses, such as those which include trademarks and designs.

(6) The consequence of the partial invalidity of the licensed patent depends upon the extent to which this partial invalidity frustrates the essential purpose which the licensee reasonably expected to achieve from the license agreement (the same formulation may be applied to the situation of a license agreement covering several patents, where less than all of the licensed patents are held invalid).

Where the partial invalidity frustrates the essential purpose of the license agreement, the agreement is invalid or terminable on the same terms as in the case of the complete invalidity. Where the essential purpose of the license agreement remains achievable, the license agreement can continue in force. The court may direct a reduction of the amount of the royalties payable by the licensee. It is within the competence of the court to determine whether the essential purpose of the license agreement remains achievable, and if so whether and to what extent the royalties are reduced.

Contractual Provisions at Variance with or in Addition to the General Rules

On the basis of the general principle of the freedom of parties to enter into contractual agreements, the patentee or licensor and the licensee are entitled to adopt contractual provisions in the license agreement at variance with or in addition to the general rules set forth above. Exceptions to this general principle may be made, depending upon all of the circumstances of fact of a particular case, for reasons of public policy.

Fraud

In case of fraud by the licensor, the licensee shall not be bound by the above guidelines.

AIPPI recognizes that it is necessary to study equally the effects on license agreements of the invalidity of other industrial and intellectual property rights, such as trademarks, models and designs, copyrights, topography rights and commercial names.

WIPO Meetings

Paris Union

Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as far as Patents are Concerned

(The Hague, June 3 to 28, 1991)

I. The "Basic Proposal" for the Treaty and the Regulations Submitted, under Rule 29(1) of the Draft Rules of Procedure, by the Director General of WIPO (PLT/DC/3)

DRAFT TREATY SUPPLEMENTING THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY AS FAR AS PATENTS ARE CONCERNED (PATENT LAW TREATY)

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The Contracting Parties,

Alternative A

Desiring to strengthen international cooperation in respect of the protection of inventions,

Considering that such protection is facilitated by a harmonization of patent law,

Recognizing the need to take into consideration the public policy objectives underlying national patent law,

Taking into account development, technological and public interest objectives of the Contracting Parties,

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

Alternative B

Note: Same text as Alternative A, without the third and fourth paragraphs.

Article 1 Establishment of a Union

The States and intergovernmental organizations party to this Treaty (hereinafter called "the Contracting Parties") constitute a Union for the purposes of this Treaty.

Article 2 Definitions

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

(i) references to an "application" or "application for a patent" shall be construed as references to an application for a patent for invention;

(ii) "priority date" means the filing date of the application for a patent, utility model or other title protecting an invention which has been filed with another or, where the Contracting Party so provides, the same Office and the priority of which is claimed; where the priorities of two or more such applications are claimed, the priority date,

(a) for the purposes of computing time limits, shall be the filing date of the earliest-filed of those applications,

(b) for any other purpose, shall be, for each element of the invention, the filing date of the earliest-filed of those applications which contains that element;

(iii) "prescribed" means prescribed in the Regulations under this Treaty that are referred to in Article 29;

(iv) references to a "patent" shall be construed as references to a patent for invention;

(v) "Office" means the governmental or intergovernmental agency entrusted with the granting of patents by a Contracting Party;

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

(vii) "Director General" means the Director General of the World Intellectual Property Organization;

(viii) "published" means made accessible to the public;

(ix) "substantive examination" means the examination of an application by an Office to determine whether the invention claimed in the application satisfies the conditions of patentability referred to in Article 11(2) and (3);

(x) references to an "instrument of ratification" shall be construed as including references to instruments of acceptance and approval;

(xi) "Assembly" means the Assembly of the Union;

(xii) "Union" means the Union referred to in Article 1;

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

(xiv) "Regulations" means the Regulations under this Treaty that are referred to in Article 29.

Article 3 Disclosure and Description

(1) *[Disclosure]* (a) The application shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

(b) Where the application refers to biologically reproducible material which cannot be disclosed in the application in such a way as to enable the invention to be carried out by a person skilled in the art and such material is not available to the public, the application shall be supplemented by a deposit of such material with a depositary institution. Any Contracting Party may require that the deposit be made on or before the filing date or, where priority is claimed, the priority date of the application.

(2) *[Description]* (a) The application shall contain a description.

(b) The description shall have the prescribed contents, and such contents shall be presented in the prescribed order.

(3) *[Prohibition of Other Requirements]* In respect of the disclosure or the description, no requirement additional to or different from those provided for in this Article and in the relevant provisions of the Regulations may be imposed.

Article 4 Claims

(1) *[Requirement of Claims in the Application]* The application shall contain one or more claims.

(2) *[Contents of the Claims]* The claims shall define the matter for which protection is sought.

(3) *[Style of the Claims]* Each claim shall be clear and concise.

(4) *[Relation of the Claims with the Description]* The claims shall be supported by the description.

(5) *[Manner of Presentation of the Claims]* (a) The claims shall be presented in the prescribed manner.

(b) A Contracting Party shall be free not to require compliance with all of the requirements prescribed under subparagraph (a).

(6) *[Prohibition of Other Requirements]* In respect of the claims, no requirement additional to or different from those provided for in paragraphs (1) to (4) and (5)(a) may be imposed.

Article 5 Unity of Invention

(1) *[Requirement of Unity of Invention]* The application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

(2) *[Validity of Patent Not Affected by Lack of Unity of Invention]* The fact that a patent has been granted on an application that did not comply with the requirement of unity of invention shall not be a ground for the invalidation or revocation of the patent.

Article 6 Identification and Mention of Inventor; Declaration Concerning the Entitlement of the Applicant

(1) *[Identification of the Inventor in the Application]* (a) The application shall, as prescribed, identify the inventor or, where there are several inventors, all of them.

(b) No patent may be granted on an application that does not identify an inventor.

(2) *[Mention of the Inventor in Publications of the Office]* Any publication of the Office, containing the application or the patent granted thereon, shall mention the inventor or inventors as such, provided that any inventor may request, in a declaration signed by him and filed with the Office, that such publications should not mention him as inventor, in which case the Office shall proceed accordingly.

(3) *[Indication of the Applicant's Entitlement]* Any Contracting Party may require that the applicant

indicate the legal grounds of his entitlement to file the application.

(4) [*Prohibition of Other Requirements*] In respect of the identification or mention of the inventor or in respect of the indication of the applicant's entitlement, no requirement additional to or different from those provided for in the preceding paragraphs may be imposed.

Article 7 Belated Claiming of Priority

(1) [*Delayed Submission of Priority Claim*] Where the application ("the subsequent application") could have claimed the priority of an earlier application but, when filed, did not contain such priority claim, the applicant shall have the right to claim such priority in a separate declaration submitted to the Office within a period to be fixed by the Contracting Party which shall be at least two months from the filing date of the subsequent application and not more than four months from the date on which a period of 12 months from the filing date of the earlier application expired.

(2) [*Delayed Filing of the Subsequent Application*] Where the application ("the subsequent application") which claims or could have claimed the priority of an earlier application is filed after the date on which a period of 12 months from the filing date of the earlier application expired but before the expiration of a period of two months from the date on which that 12-month period expired, the Office shall restore the right of priority upon an express request submitted to the Office before the expiration of the said two-month period, if the request states and the Office finds that, in spite of all due care required by the circumstances, the subsequent application could not have been filed within the said 12-month period. The request for restoration shall state the grounds on which it is based, and the Office may require the production of corresponding evidence.]

Article 8 Filing Date

(1) [*Absolute Requirements*] The filing date of the application shall be the date of receipt by the Office of at least the following elements:

- (i) an express or implicit indication that the granting of a patent is sought;
- (ii) indications allowing the identity of the applicant to be established;
- (iii) a part which, on the face of it, appears to be a description of an invention.

(2) [*Permitted Additional Requirements*] (a) A Contracting Party may provide that the filing date may be refused if either of the following requirements is not satisfied within the prescribed time limit:

- (i) the application contains a part which, on the face of it, appears to be a claim or claims;
- (ii) the required fee is paid.

Where a Contracting Party provides for any of the foregoing requirements and the requirements are complied with later than the date of receipt by the Office of the elements referred to in paragraph (1), but within the prescribed time limit, the filing date of the application shall be the date of receipt by the Office of the said elements.

(b) A Contracting Party may apply a requirement referred to in subparagraph (a) only if

- (i) it applied such requirement at the time of becoming party to this Treaty, or
- (ii) it has, after having become party to this Treaty, to apply such requirement in order to comply with an obligation under a treaty concluded before the date of entry into force of this Treaty.

(3) [*Drawings*] If the application refers to drawings but such drawings are not received by the Office at the date of receipt of the elements referred to in paragraph (1), at the option of the applicant either any reference to the drawings shall be deemed to be deleted or the filing date of the application shall be the date on which the drawings are received by the Office.

(4) [*Replacing Description, Claims and Drawings by Reference to Another Application*] Notwithstanding paragraphs (1), (2) and (3), [*Alternative A: each Contracting Party shall*] [*Alternative B: any Contracting Party may*] provide that a reference in the application to another previously filed application for the same invention by the same applicant or his predecessor in title may, for the purposes of the filing date of the application, replace any of the following elements:

- (i) the part which, on the face of it, appears to be a description of an invention,
- (ii) the part which, on the face of it, appears to be a claim or claims, or
- (iii) any drawings,

provided that the said parts and drawings and, where the other application was not filed with the same Office, a certified copy of the other application are received by the Office within the prescribed time limit. If the said parts and drawings, and, where required, the certified copy, are received by the Office within the said time limit, the filing date of the application shall, provided that the other requirements concerning the filing date are fulfilled, be the date on which the application containing the refer-

ence to the previously filed application was received by the Office.

(5) [Language] (a) Any Contracting Party may require that the indications referred to in paragraph (1)(i) and (ii) be in the official language.

(b) Any Contracting Party may, if any of the parts referred to in paragraph (1)(iii) and paragraph (2)(a)(i) or any text matter contained in any drawings is in a language other than the official language, require that a translation thereof in the official language be received by its Office within the prescribed time limit. If the translation is so received, the filing date of the application shall be the date of receipt by the Office of the elements referred to in paragraph (1) in the language in which they were first received.

(c) Any Contracting Party may require that the parts referred to in paragraph (4)(i) and (ii) and any text matter contained in drawings referred to in paragraph (4)(iii) be furnished in the official language within the time limit referred to in paragraph (4).

(d) For the purposes of this paragraph, "official language" means the official language of the Office or, if there are several such languages, any of them.

(6) [Prohibition of Other Requirements] (a) In respect of the filing date, no requirement additional to or different from those provided for in the preceding paragraphs may be imposed.

(b) Notwithstanding subparagraph (a), a Contracting Party may, for the purposes of any treaty providing for the grant of regional patents, require that an application for a regional patent contain the designation of at least one State party to that treaty.

Article 9 Right to a Patent

(1) [Right of Inventor] The right to a patent shall belong to the inventor. Any Contracting Party shall be free to determine the circumstances under which the right to the patent shall belong to the employer of the inventor or to the person who commissioned the work of the inventor which resulted in the invention.

(2) [Right Where Several Inventors Independently Made the Same Invention] Where two or more inventors independently have made the same invention, the right to a patent for that invention shall belong,

(i) where only one application is filed in respect of that invention, to the applicant, as long as the application is not withdrawn or abandoned, is not considered withdrawn or abandoned, or is not rejected, or

(ii) where two or more applications are filed in respect of that invention, to the applicant whose

application has the earliest filing date or, where priority is claimed, the earliest priority date, as long as the said application is not withdrawn or abandoned, is not considered withdrawn or abandoned, or is not rejected.

Article 10 Fields of Technology

Alternative A

(1) Patent protection shall be available for inventions in all fields of technology which are new, which involve an inventive step and which are industrially applicable, except for:

(i) inventions whose use would be contrary to public order, law or morality or injurious to public health;

(ii) plant or animal varieties or essentially biological processes for the production of plants or animals;

(iii) discoveries and materials or substances already existing in nature;

(iv) methods of medical treatment for humans or animals;

(v) nuclear and fissionable material.

(2) Contracting States may, on grounds of public interest, national security, public health, nutrition, national development and social security, exclude from patent protection, either in respect of products or processes for the manufacture of those products, certain fields of technology, by national law.

(3) Contracting States shall notify the Director General of such exclusions by a written declaration. Any such declaration may be withdrawn at any time totally or partially by notification addressed to the Director General.

Alternative B

Patent protection shall be available for inventions, whether they concern products or processes, in all fields of technology.

Article 11 Conditions of Patentability

(1) [Patentability] In order to be patentable, an invention shall be novel, shall involve an inventive step (shall be non-obvious) and shall be, at the option of the Contracting Party, either useful or industrially applicable.

(2) [Novelty] (a) An invention shall be considered novel if it does not form part of the prior art. For the determination of novelty, items of prior art may only be taken into account individually.

(b) The prior art shall consist of everything which, before the filing date or, where priority is claimed, the priority date of the application claiming the invention, has been made available to the public anywhere in the world.

[(c) Notwithstanding subparagraph (b), any Contracting Party shall be free to exclude from the prior art matter made available to the public, by oral communication, by display or through use, in a place or space which is not under its sovereignty or, in the case of an intergovernmental organization, under the sovereignty of one of its member States.]

(3) [*Inventive Step (Non-Obviousness)*] An invention shall be considered to involve an inventive step (be non-obvious) if, having regard to the prior art as defined in paragraph (2), it would not have been obvious to a person skilled in the art at the filing date or, where priority is claimed, the priority date of the application claiming the invention.

Article 12

Disclosures Not Affecting Patentability (Grace Period)

(1) [*Circumstances of Disclosure Not Affecting Patentability*] Disclosure of information which otherwise would affect the patentability of an invention claimed in the application shall not affect the patentability of that invention where the information was disclosed, during the 12 months preceding the filing date or, where priority is claimed, the priority date of the application,

(i) by the inventor,

(ii) by an Office and the information was contained

(a) in another application filed by the inventor and should not have been disclosed by the Office, or

(b) in an application filed without the knowledge or consent of the inventor by a third party which obtained the information direct or indirectly from the inventor,

or

(iii) by a third party which obtained the information direct or indirectly from the inventor.

(2) [*"Inventor"*] For the purposes of paragraph (1), "inventor" also means any person who, at the filing date of the application, had the right to the patent.

(3) [*No Time Limit for Invoking Grace Period*] The effects of paragraph (1) may be invoked at any time.

(4) [*Evidence*] Where the applicability of paragraph (1) is contested, the party invoking the effects of that paragraph shall have the burden of proving,

or of making the conclusion likely, that the conditions of that paragraph are fulfilled.

Article 13

Prior Art Effect of Certain Applications

(1) [*Principle of "Whole Contents"*] (a) Subject to subparagraph (b), the whole contents of an application ("the former application") as filed in, or with effect for, a Contracting Party shall, for the purpose of determining the novelty of an invention claimed in another application filed in, or with effect for, that Contracting Party, be considered as prior art from the filing date of the former application on condition that the former application or the patent granted thereon is published subsequently by the authority competent for the publication of that application or patent. Any Contracting Party may consider the whole contents of the former application to be prior art also for the purpose of determining whether the invention satisfies the requirement of inventive step (non-obviousness).

(b) Where the former application referred to in subparagraph (a) claims the priority of an earlier application for a patent, utility model or other title protecting an invention, matter that is contained in both the former application and such earlier application shall be considered as prior art in accordance with subparagraph (a) from the priority date of the former application.

(c) For the purposes of subparagraph (a), the "whole contents" of an application consists of the description and any drawings, as well as the claims, but not the abstract.

(2) [*Applications No Longer Pending*] Where the former application referred to in paragraph (1)(a) has been published in spite of the fact that, before the date of its publication, it was withdrawn or abandoned, was considered withdrawn or abandoned, or was rejected, it shall not be considered as prior art for the purposes of paragraph (1)(a).

(3) [*International Applications Under the PCT*] As regards international applications filed under the Patent Cooperation Treaty, any Contracting Party may provide that paragraph (1) shall apply only if the acts referred to in Article 22 or, where applicable, Article 39(1) of that Treaty have been performed.

(4) [*Self-Collision*] [(a)] Paragraph (1) shall not apply when the applicant of, or the inventor identified in, the former application, and the applicant of, or the inventor identified in, the application under examination, is one and the same person.

[(b) Any Contracting Party that considers the whole contents of the former application to be prior art only for the purpose of determining the novelty

of the invention shall be free not to apply subparagraph (a).]

Article 14 **Amendment or Correction of Application**

(1) [*Amendments or Corrections Following Office Findings*] Wherever the Office finds that the application does not comply with any requirements applicable to it, it shall give the applicant at least one opportunity to amend or correct the application or to comply with the said requirements. Such an opportunity need not be given before the application has a filing date.

(2) [*Amendments or Corrections on Applicant's Initiative*] The applicant shall have the right, on his own initiative, to amend or correct the application or to comply with a requirement applicable to the application up to the time when the application is in order for grant; however, any Contracting Party which provides for substantive examination may provide that the applicant shall have the right to amend or correct, on his own initiative, the description, the claims and any drawings, only up to the time allowed for the reply to the first substantive communication from the Office.

(3) [*Limitation of Amendments or Corrections*] No amendment or correction of the application may go beyond what has been disclosed in the application as filed.

Article 15 **Publication of Application**

(1) [*Requirement to Publish the Application*] (a) Subject to paragraphs (2) to (4), the Office shall publish the application as soon as possible after the expiration of 18 months from the filing date or, where priority is claimed, the priority date.

(b) Notwithstanding subparagraph (a), any Contracting Party that, at the time of depositing its instrument of ratification of, or accession to, this Treaty, does not provide for the publication of applications as provided in subparagraph (a) may notify the Director General at the said time that it reserves the right to publish applications as soon as possible after the expiration of 24 months, rather than 18 months, from the filing date or, where priority is claimed, the priority date.

(2) [*Earlier Publication at Applicant's Request*] If, before the expiration of the time limit referred to in paragraph (1), the applicant requests that the application be published, the Office shall, without delay after the receipt of the request, publish the application.

(3) [*National Security*] Any Contracting Party shall be free not to publish an application for reasons of national security.

(4) [*Circumstances in Which Publication May Not Take Place*] (a) No application may be published if it is withdrawn or abandoned or is considered withdrawn or abandoned

(i) earlier than two months before the expiration of the time limit applicable under paragraph (1) or,

(ii) where the Office completes the technical preparations for publication later than two months before the expiration of the time limit applicable under paragraph (1), prior to the completion of such preparations.

(b) No application may be published if it has been rejected.

Article 16 **Time Limits for Search and Substantive Examination**

(1) [*Time Limits for Search*] (a) If a Contracting Party provides for substantive examination, its Office shall publish, at the same time as the application is published under Article 15, a report, established by or on behalf of that Office, citing any documents that reflect the prior art relevant to the invention claimed in the application (hereinafter referred to as "the search report").

(b) Notwithstanding subparagraph (a), where Article 15(2) applies, the search report need not be published at the same time as the application, provided that it shall be published as soon as possible, but not later than the expiration of the time limit applicable under Article 15(1).

(c) If, notwithstanding subparagraphs (a) and (b), for any exceptional reason, the search report cannot be published as provided for in those subparagraphs, it shall be published as soon as possible and in no case later than six months after the expiration of the time limit applicable under Article 15(1).

(2) [*Time Limits for Substantive Examination*] (a) If a Contracting Party provides for substantive examination, its Office shall start the substantive examination of the application not later than three years from the filing date of the application.

(b) Notwithstanding subparagraph (a), a Contracting Party shall be free to provide that no substantive examination shall be carried out and the application shall be considered withdrawn or abandoned, or shall be rejected, if a request is not made, within three years from the filing date of the application, to its Office by the applicant or any third party that substantive examination should start. Where such a request is made, the Office shall start the substantive examination promptly after receipt of the request.

(c) The Office shall, wherever possible, reach a final decision on the application not later than two years after the start of substantive examination.

Article 17 Changes in Patents

(1) *[Limitation of Extent of Protection]* The owner of a patent shall have the right to request the competent Office to make changes in the patent in order to limit the extent of the protection conferred by it.

(2) *[Obvious Mistakes and Clerical Errors]* The owner of a patent shall have the right to request the competent Office to make changes in the patent in order to correct obvious mistakes or to correct clerical errors.

(3) *[Additional Changes That May Be Allowed]* Each Contracting Party may provide that the owner of a patent shall have the right to request the competent Office to make changes in the patent in order to correct mistakes or errors, other than those referred to in paragraph (2), made in good faith, provided that, where the change would result in a broadening of the extent of protection conferred by the patent, no request may be made after the expiration of two years from the grant of the patent and the change shall not affect the rights of any third party which has relied on the patent as published.

(4) *[Changes Affecting the Disclosure]* No change in the patent shall be permitted under paragraphs (1) or (3) where the change would result in the disclosure contained in the patent going beyond the disclosure contained in the application as filed.

(5) *[Decision in Respect of the Request and Publication of the Changes]* If, and to the extent to which, the competent Office changes the patent according to paragraphs (1), (2) or (3), it shall publish the changes.

Article 18 Administrative Revocation

(1) *[Administrative Revocation]* (a) Where a patent was granted after substantive examination, any person shall have the right to request the competent Office to revoke the patent, in whole or in part, at least on the ground that, because of one or several documents available to the public, the conditions of novelty or inventive step are not satisfied.

(b) The request for revocation may be presented during a period to be fixed by the Contracting Party which shall commence from the announcement in the official gazette of the grant of the patent and shall not be less than six months.

(c) No request for revocation may be based on grounds of non-compliance with formal or procedural requirements.

(d) No decision may be made by the Office departing from the request unless the person having made the request has had at least one opportunity to present his arguments on the grounds on which the Office intends to depart from the request.

(e) The Office may not revoke the patent, in whole or in part, at the request of a third party, unless the owner of the patent has had at least one opportunity to present his arguments on the grounds on which the Office intends to revoke the patent.

(2) *[Prohibition of Pre-Grant Opposition]* (a) No Contracting Party may allow any party to oppose, before its Office, the grant of patents ("pre-grant opposition").

(b) Notwithstanding subparagraph (a), any Contracting Party which, at the time of becoming party to this Treaty, provides for the possibility of pre-grant opposition may, for a period not exceeding the expiration of the tenth calendar year after the year in which this Treaty was adopted, continue to do so and, for the same period, it shall not be obliged to apply paragraph (1).

(c) Any Contracting Party that wishes to avail itself of the faculty provided for in subparagraph (b) shall address a corresponding notification to the Director General. As long as the notification has effect, any reference in this Treaty or in the Regulations to the time when the application is in order for grant shall be replaced, with respect to that Contracting Party, by a reference to the time when the application is in order for publication for the purposes of pre-grant opposition.

Article 19 Rights Conferred by the Patent

Alternative A

Note: No article on the rights conferred by the patent.

Alternative B

(1) *[Products]* Where the subject matter of the patent concerns a product, the owner of the patent shall have the right to prevent third parties from performing, without his authorization, at least the following acts:

- (i) the making of the product,
- (ii) the offering or the putting on the market of the product, the using of the product, or the importing or stocking of the product for such offering or putting on the market or for such use.

(2) *[Processes]* Where the subject matter of the patent concerns a process, the owner of the patent

shall have the right to prevent third parties from performing, without his authorization, at least the following acts:

- (i) the using of the process,
- (ii) in respect of any product directly resulting from the use of the process, any of the acts referred to in paragraph (1)(ii), even where a patent cannot be obtained for the said product.

(3) [Exceptions to Paragraphs (1) and (2)] (a) Notwithstanding paragraphs (1) and (2), any Contracting Party may provide that the owner of a patent has no right to prevent third parties from performing, without his authorization, the acts referred to in paragraphs (1) and (2) in the following circumstances:

(i) where the act concerns a product which has been put on the market by the owner of the patent, or with his express consent, insofar as such act is performed after that product has been so put on the market in the territory of that Contracting Party or, where the Contracting Party is a member of a group of States constituting a regional market, in the territory of one of the member States of such group;

(ii) where the act is done privately and on a non-commercial scale or for a non-commercial purpose, provided that it does not significantly prejudice the economic interests of the owner of the patent;

(iii) where the act consists of making or using exclusively for the purpose of experiments that relate to the subject matter of the patented invention [or for the purpose of seeking regulatory approval for marketing];

(iv) where the act consists of the preparation for individual cases, in a pharmacy or by a medical doctor, of a medicine in accordance with a medical prescription or acts concerning the medicine so prepared.

(b) The provisions of paragraphs (1) and (2) shall not be interpreted as affecting the freedom that Contracting Parties have under the Paris Convention for the Protection of Industrial Property to allow, under certain circumstances, the performance of acts without the authorization of the owner of the patent.

(4) [Contributory Infringement] (a) Subject to subparagraph (b), a patent shall also confer on its owner [at least] the right to prevent a third party from supplying or offering to supply a person, other than a party entitled to exploit the patented invention, with means, relating to an essential element of that invention, for carrying out the invention, when the third party knows, or it is obvious in the circumstances, that those means are suitable and intended for carrying out that invention. This provision shall not apply when the means are staple commercial products and the circumstances of the supply of such products do not constitute inducement to infringe the patent.

(b) Persons performing the acts referred to in paragraph (3)(a)(ii), (iii) and (iv) shall not be considered to be parties entitled to exploit the invention within the meaning of subparagraph (a).

Alternative C

(1) [Products] Where the subject matter of the patent concerns a product, the owner of the patent shall have the right to prevent third parties from performing, without his authorization, at least the following acts:

- (i) the making of the product,
- (ii) the offering for sale of the product, and the using of the product.

(2) [Processes] Where the subject matter of the patent concerns a process, the owner of the patent shall have the right to prevent third parties from performing, without his authorization, the using of the process.

(3) [Exceptions to Paragraphs (1) and (2)] (a) Notwithstanding paragraphs (1) and (2), any Contracting State shall be free to provide that the owner of a patent has no right to prevent third parties from performing, without his authorization, the acts referred to in paragraphs (1) and (2) in the following circumstances:

(i) where the act concerns the offer for sale or the use of a product which has been offered for sale by the owner of the patent, or with his express consent, insofar as such an act is performed after the product has been so offered for sale in the territory of that Contracting State;

(ii) where the act is done privately and on a non-commercial scale;

(iii) where the act consists of making or using for exclusively experimental, academic or scientific research purposes;

(iv) where the act consists of the preparation for individual cases, in a pharmacy or by a medical doctor, of a medicine in accordance with a medical prescription or acts concerning the medicine so prepared.

(b) The provisions of paragraphs (1) and (2) shall not be interpreted as affecting the freedom that Contracting States have under the Paris Convention for the Protection of Industrial Property, to allow, under certain circumstances, the performance of acts without the authorization of the owner of the patent.

(c) Persons performing the acts referred to in paragraph (3)(a)(ii), (iii) and (iv) shall not be considered to be parties entitled to exploit the invention within the meaning of subparagraph (a).

Article 20 Prior User

(1) [Right of Prior User]

Alternative A

Any Contracting Party may provide that, notwithstanding Article 19,

Alternative B

Notwithstanding Article 19,

a patent shall have no effect against any person (hereinafter referred to as "the prior user") who, in good faith, for the purposes of his enterprise or business, before the filing date or, where priority is claimed, the priority date of the application on which the patent is granted, and within the territory where the patent produces its effect, was using the invention or was making effective and serious preparations for such use; any such person shall have the right, for the purposes of his enterprise or business, to continue such use or to use the invention as envisaged in such preparations.

(2) [Successor-in-Title of the Prior User] The right of the prior user may only be transferred or devolve together with his enterprise or business, or with that part of his enterprise or business in which the use or preparations for use have been made.

Article 21 Extent of Protection and Interpretation of Claims

(1) [Determination of the Extent of Protection] (a) The extent of protection conferred by the patent shall be determined by the claims, which are to be interpreted in the light of the description and drawings.

(b) For the purposes of subparagraph (a), the claims shall be so interpreted as to combine fair protection for the owner of the patent with a reasonable degree of certainty for third parties. In particular, the claims shall not be interpreted as being confined to their strict literal wording. Neither shall the claims be considered as mere guidelines allowing that the protection conferred by the patent extends to what, from a consideration of the description and drawings by a person skilled in the art, the owner has contemplated, but has not claimed.

(2) [Equivalents] (a) Notwithstanding paragraph (1)(b), a claim shall be considered to cover not only all the elements as expressed in the claim but also equivalents.

(b) An element ("the equivalent element") shall generally be considered as being equivalent to an element as expressed in a claim if, at the time of any

alleged infringement, either of the following conditions is fulfilled in regard to the invention as claimed:

(i) the equivalent element performs substantially the same function in substantially the same way and produces substantially the same result as the element as expressed in the claim, or

(ii) it is obvious to a person skilled in the art that the same result as that achieved by means of the element as expressed in the claim can be achieved by means of the equivalent element.

(c) Any Contracting Party shall be free to determine whether an element is equivalent to an element as expressed in a claim by reference to only the condition referred to in subparagraph (b)(i) or to only the condition referred to in subparagraph (b)(ii), provided that, at the time of depositing its instrument of ratification of or accession to this Treaty, it so notifies the Director General.

(3) [Prior Statements] In determining the extent of protection, due account shall be taken of any statement limiting the scope of the claims made by the applicant or the owner of the patent during procedures concerning the grant or the validity of the patent.

(4) [Examples] If the patent contains examples of the embodiment of the invention or examples of the functions or results of the invention, the claims shall not be interpreted as limited to those examples; in particular, the mere fact that a product or process includes additional features not found in the examples disclosed in the patent, lacks features found in such examples or does not achieve every objective or possess every advantage cited or inherent in such examples shall not remove the product or process from the extent of protection conferred by the claims.

(5) [Abstract] The abstract of a patent shall not be taken into account for the purpose of determining the protection conferred by the patent.

Article 22 Term of Patents

Alternative A

Note: No article on the term of patents.

Alternative B

(1) [Minimum Duration of Protection] The term of a patent shall be at least 20 years.

(2) [Starting Date of Term] (a) The starting date of the term of a patent shall be the filing date of the application on which the patent is granted, whether or not the application claims the priority of another application.

(b) Notwithstanding subparagraph (a), where an application (“the subsequent application”) invokes one or more earlier applications without claiming the priority of any of those earlier applications, the starting date of the term of the patent granted on the subsequent application shall be the filing date of the earliest-filed application invoked in the subsequent application.

Article 23 Enforcement of Rights

(1) [Enforcement Based on Patents] The owner of the patent shall have at least the right

(i) to obtain an injunction to restrain the performance or the likely performance, by any person without his authorization, of any of the acts referred to in Article 19(1), (2) and (4);

(ii) to obtain damages, adequate under the circumstances, from any person who, without his authorization, performed any of the acts referred to in Article 19(1), (2) and (4), where the said person was or should have been aware of the patent.

(2) [Enforcement Based on Published Applications] (a) The applicant shall at least have the right to obtain reasonable compensation from any person who, without his authorization, performed any of the acts referred to in Article 19(1), (2) and (4) in relation to any invention, claimed in the published application, as if a patent had been granted for that invention, provided that the said person, at the time of the performance of the act, had

(i) actual knowledge that the invention that he was using was the subject matter of a published application, or

(ii) received written notice that the invention that he was using was the subject matter of a published application, such application being identified in the said notice by its serial number.

(b) Any Contracting Party may provide that, with respect to the compensation referred to in subparagraph (a), an action may not be initiated or a decision may not be made until after the grant of a patent on the published application, provided that, if an action may be initiated only after the grant of the patent, the owner of the patent shall have reasonable time to initiate such action.

(c) For the purposes of subparagraphs (a) and (b), the extent of the protection shall be determined by the claims as appearing in the published application. However, if the claims are amended after the initial publication of the application, the extent of the protection shall be determined by the amended claims in respect of the period following their publication. Furthermore, if the claims of the patent as granted or as changed after its grant have a narrower scope than the claims in the application, the extent

of the protection shall be determined by the claims with the narrower scope.

Article 24 Reversal of Burden of Proof

Alternative A

Note: No article on the reversal of the burden of proof.

Alternative B

(1) [Conditions for the Reversal of the Burden of Proof] (a) For the purposes of proceedings, other than criminal proceedings, in respect of the violation of the rights of the owner of the patent referred to in Article 19(2), where the subject matter of the patent is a process for obtaining a product, the burden of establishing that a product was not made by the process shall be on the alleged infringer if either of the following conditions is fulfilled:

(i) the product is new, or

(ii) a substantial likelihood exists that the product was made by the process and the owner of the patent has been unable through reasonable efforts to determine the process actually used.

(b) Any Contracting Party shall be free to provide that the burden of proof indicated in subparagraph (a) shall be on the alleged infringer only if the condition referred to in subparagraph (a)(i) is fulfilled or only if the condition referred to in subparagraph (a)(ii) is fulfilled, provided that, at the time of depositing its instrument of ratification or accession to this Treaty, it so notifies the Director General.

(2) [Manufacturing and Business Secrets] In requiring the production of evidence, the authority before which the proceedings referred to in paragraph (1) take place shall take into account the legitimate interests of the alleged infringer in not disclosing his manufacturing and business secrets.

Article 25 Obligations of the Right Holder

Alternative A

Note: No article on obligations of the right holder.

Alternative B

(1) The owner of a patent shall have at least the following obligations in addition to any other provided for in this Treaty:

(i) to disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art; the descrip-

tion shall set forth at least one mode for carrying out the invention claimed; this shall be done in terms of examples, where appropriate, and with reference to the drawings, if any; however, any Contracting Party may provide that the description set forth the best mode for carrying out the invention known to the inventor at the filing date or, where priority is claimed, priority date of the application;

(ii) to provide such information and supporting documents in his possession as is requested by the competent Office concerning corresponding foreign applications and grants;

(iii) to work the patented invention in the territory of the Contracting State for which it is granted within the time limits as provided by national law;

(iv) to pay, or cause to be paid, such fees as prescribed by national law in relation to the application and the maintenance of the patent granted on it;

(v) in respect of license contracts and contracts assigning patents, to refrain from engaging in abusive, restrictive or anticompetitive practices adversely affecting the transfer of technology.

(2) The applicant or holder of a patent shall comply with any other obligations established in the national law of the State in which the patent was granted in connection with the acquisition and the exercise of the rights conferred by the patent and with the exploitation of the patented invention.

Article 26 Remedial Measures Under National Legislation

Alternative A

Note: No article on remedial measures under national legislation.

Alternative B

(1) Any Contracting State is free to provide appropriate measures to ensure compliance with the obligations referred to in the Article entitled "Obligations of the Right Holder," and for measures to remedy non-compliance with such obligations, including the grant of non-voluntary licenses and the revocation or forfeiture of the patent.

(2) A non-voluntary license under paragraph (1) shall be refused if the owner of the patent proves, to the satisfaction of the national authorities competent to grant non-voluntary licenses, that there are circumstances which justify the non-working or insufficient working of the patented invention.

(3) Any Contracting State is free to provide, at any time, on grounds of public interest, national security, nutrition, health, or the development of other vital sectors of national economy, for the grant

of non-voluntary licenses or for the exploitation of the patented invention by the government of that country or by third persons authorized by it.

Article 27 Assembly

(1) [*Composition*] (a) The Union shall have an Assembly consisting of the Contracting Parties.

(b) Each Contracting Party shall be represented by one delegate, who may be assisted by alternate delegates, advisors and experts.

(c) The Union shall not bear the expenses of the participation of any delegation in any session of the Assembly.

(2) [*Tasks*] (a) The Assembly shall:

(i) deal with all matters concerning the maintenance and development of the Union and the implementation of this Treaty;

(ii) modify, where it considers it desirable, any time limit provided for in Articles 3 to 26 of this Treaty and make any consequential amendments necessitated by any such modification; the adoption of any such modification shall require unanimous consent;

(iii) adopt, where it considers it desirable, guidelines for the implementation of provisions of this Treaty or the Regulations under this Treaty;

(iv) exercise such rights and perform such tasks as are specifically conferred upon it or assigned to it under this Treaty;

(v) give directions to the Director General concerning the preparations for any conference referred to in Article 31 or Article 32 and decide the convocation of any such conference;

(vi) review and approve the reports and activities of the Director General concerning the Union, and give him all necessary instructions concerning matters within the competence of the Union;

(vii) establish such committees and working groups as it deems appropriate to achieve the objectives of the Union;

(viii) determine which States and intergovernmental organizations, other than Contracting Parties, and which non-governmental organizations shall be admitted to its meetings as observers;

(ix) take any other appropriate action designed to further the objectives of the Union and perform such other functions as are appropriate under this Treaty.

(b) With respect to matters which are of interest also to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization.

(3) [*Representation*] A delegate may represent one Contracting Party only.

(4) [Voting] (a) Subject to subparagraph (e), each Contracting Party that is a State shall have one vote and shall vote only in its own name.

(b) Any intergovernmental organization referred to in Article 33(1)(ii) that is a Contracting Party may exercise the right to vote of its member States that are Contracting Parties, [whether] present [or absent] at the time of voting. The intergovernmental organization may not, in a given vote, exercise the right to vote if any of its member States participates in the vote or expressly abstains.

(c) Provided that all its member States that are Contracting Parties have notified the Director General that their right to vote may be exercised by it, any intergovernmental organization referred to in Article 33(1)(iii) that is a Contracting Party may so exercise the right to vote of its member States that are Contracting Parties, [whether] present [or absent] at the time of voting. The intergovernmental organization may not, in a given vote, exercise the right to vote of any of its member States if any of them participates in the vote or expressly abstains.

(d) The right to vote of a State that is a Contracting Party may not, in a given vote, be exercised by more than one intergovernmental organization.

(e) No Contracting Party shall have the right to vote on questions concerning matters in respect of which it has made a declaration under Article 35.

(5) [Quorum] (a) One-half of the Contracting Parties that have the right to vote shall constitute a quorum, provided that, for the purposes of determining whether there is a quorum in respect of any question concerning any matter on which a declaration under Article 35 has been made, any Contracting Party not having the right to vote on that question shall not be counted.

(b) In the absence of the quorum, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the quorum and the required majority are attained through voting by correspondence.

(6) [Majorities] (a) Subject to paragraphs (2)(a)(ii) and (9)(b) of this Article and to Articles 29(2) and (3) and 30(4), the decisions of the Assembly shall require a majority of the votes cast.

(b) Abstentions shall not be considered as votes.

(7) [Sessions] (a) The Assembly shall meet once in every second calendar year in ordinary session upon convocation by the Director General and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization.

(b) The Assembly shall meet in extraordinary session upon convocation by the Director General, either at the request of one-fourth of the Contracting Parties or on the Director General's own initiative.

(8) [Rules of Procedure] The Assembly shall adopt its own rules of procedure.

(9) [Guidelines] (a) In the case of conflict between the guidelines referred to in paragraph (2)(a)(iii) and the provisions of this Treaty or the Regulations, the latter shall prevail.

(b) The adoption by the Assembly of the said guidelines shall require three-fourths of the votes cast.

Article 28 International Bureau

(1) [Tasks] The International Bureau of the Organization shall:

(i) perform the administrative tasks concerning the Union, as well as any tasks specifically assigned to it by the Assembly;

(ii) provide the secretariat of the conferences referred to in Articles 31 and 32, of the Assembly, of the committees and working groups established by the Assembly, and of any other meeting convened by the Director General under the aegis of the Union.

(2) [Director General] The Director General shall be the chief executive of the Union and shall represent the Union.

(3) [Meetings Other than Sessions of the Assembly] The Director General shall convene any committee and working group established by the Assembly and all other meetings dealing with matters of concern to the Union.

(4) [Role of the International Bureau in the Assembly and Other Meetings] (a) The Director General and any staff member designated by him shall participate, without the right to vote, in all meetings of the Assembly, the committees and working groups established by the Assembly, and any other meetings convened by the Director General under the aegis of the Union.

(b) The Director General or a staff member designated by him shall be *ex officio* secretary of the Assembly, and of the committees, working groups and other meetings referred to in subparagraph (a).

(5) [Conferences] (a) The Director General shall, in accordance with the directions of the Assembly, make the preparations for any conference referred to in Article 31 or Article 32.

(b) The Director General may consult with intergovernmental and international and national non-governmental organizations concerning the said preparations.

(c) The Director General and staff members designated by him shall take part, without the right to vote, in the discussions at any conference referred to in subparagraph (a).

(d) The Director General or a staff member designated by him shall be *ex officio* secretary of any conference referred to in subparagraph (a).

Article 29 Regulations

(1) [Content] The Regulations annexed to this Treaty provide rules concerning

(i) matters which this Treaty expressly provides are to be "prescribed";

(ii) any details useful in the implementation of the provisions of this Treaty;

(iii) any administrative requirements, matters or procedures.

(2) [Amending the Regulations] (a) The Assembly may amend the Regulations and shall determine the conditions for the entry into force of each amendment.

(b) Subject to paragraph (3), any amendment of the Regulations shall require three-fourths of the votes cast.

(3) [Requirement of Unanimity] (a) The Regulations may specify rules which may be amended only by unanimous consent.

(b) Exclusion, for the future, of any rule designated as requiring unanimous consent for amendment from such requirement shall require unanimous consent.

(c) Inclusion, for the future, of the requirement of unanimous consent for the amendment of any rule shall require unanimous consent.

(4) [Conflict Between the Treaty and the Regulations] In the case of conflict between the provisions of this Treaty and those of the Regulations, the former shall prevail.

Article 30 Settlement of Disputes

(1) [Consultations] (a) Where any dispute arises concerning the interpretation or implementation of this Treaty, a Contracting Party may bring the matter to the attention of another Contracting Party and request the latter to enter into consultations with it.

(b) The Contracting Party so requested shall provide, within the prescribed time limit, an adequate opportunity for the requested consultations.

(c) The Contracting Parties engaged in consultations shall attempt to reach, within a reasonable period of time, a mutually satisfactory solution of the dispute.

(2) [Other Means of Settlement] If a mutually satisfactory solution is not reached within a reasonable period of time through the consultations referred

to in paragraph (1), the parties to the dispute may agree to resort to other means designed to lead to an amicable settlement of their dispute, such as good offices, conciliation, mediation and arbitration.

(3) [Panel] (a) The Assembly shall adopt rules for the establishment of a body of experts, any candidate having to be presented by a Contracting Party. It shall adopt rules concerning the manner of selecting the members of each panel, each panel having three members, none of which shall, unless the parties to the dispute agree otherwise, be from either party to the dispute. The Assembly shall also adopt rules for the conduct of the panel proceedings, including provisions to safeguard the confidentiality of the proceedings and of any material designated as confidential by any participant in the proceedings. Each panel shall give full opportunity to the parties to the dispute and any other interested Contracting Parties to present to it their views.

(b) If the dispute is not satisfactorily settled through the consultations referred to in paragraph (1), or if the means referred to in paragraph (2) are not resorted to, or do not lead to an amicable settlement within a reasonable period of time, the Director General, at the written request of either of the parties to the dispute, shall appoint members of a panel to examine the matter.

(c) The terms of reference of the panel shall be agreed upon by the parties to the dispute. However, if such agreement is not achieved within the prescribed time limit, the Director General shall set the terms of reference of the panel after having consulted the parties to the dispute and the members of the panel.

(d) If both parties to the dispute so request, the panel shall stop its proceedings.

(e) Unless the parties to the dispute reach an agreement between themselves prior to the panel's concluding its proceedings, the panel shall promptly prepare the draft of a written report containing a statement of the facts of the case and containing recommendations for the resolution of the dispute and provide it to the parties to the dispute for their review. The parties to the dispute shall have a reasonable period of time, the length of which shall be fixed by the panel, to submit any comments on the report to the panel, unless they agree to a longer time in their attempts to reach a mutually satisfactory resolution to their dispute.

(f) The panel shall take into account the comments and shall promptly transmit its final report to the Assembly, which report shall be accompanied by the written comments, if any, of the parties to the dispute.

(4) [Recommendation by the Assembly] The Assembly shall give the report of the panel prompt consideration. The Assembly shall make recommendations to the parties to the dispute, based upon its

interpretation of this Treaty and the report of the panel. Any recommendation by the Assembly shall require consensus among the members of the Assembly other than the parties to the dispute.

Article 31 Revision of the Treaty

This Treaty may be revised by a conference of the Contracting Parties.

Article 32 Protocols

For the purposes of further developing the harmonization of patent law, protocols may be adopted by a conference of the Contracting Parties, provided that the provisions of any such protocol shall not contravene the provisions of this Treaty. Only Contracting Parties may become party to any such protocol.

Article 33 Becoming Party to the Treaty

(1) [*Eligibility*] The following may become party to this Treaty:

(i) any State which is a party to the Paris Convention for the Protection of Industrial Property and in respect of which patents may be obtained either through the State's own Office or through the Office of another Contracting Party;

(ii) any intergovernmental organization which is competent in matters governed by this Treaty and which has established, on such matters, norms that are binding on all its member States, provided that all those States are party to the Paris Convention for the Protection of Industrial Property;

(iii) any intergovernmental organization which maintains an Office granting patents with effect in more than one State, provided that all of its member States are party to the Paris Convention for the Protection of Industrial Property.

(2) [*Signature; Deposit of Instrument*] To become party to this Treaty, the State or the intergovernmental organization shall:

(i) sign this Treaty and deposit an instrument of ratification, or

(ii) deposit an instrument of accession.

(3) [*Condition as to Effect of Instrument*] (a) Any instrument of ratification or accession (hereinafter referred to as "instrument") may be accompanied by a declaration making it a condition to its being considered as deposited that the instrument of one State or one intergovernmental organization, or

the instruments of two States, or the instruments of one State and one intergovernmental organization, specified by name and eligible to become party to this Treaty according to paragraph (1)(i) or (iii), is or are also deposited. The instrument containing such a declaration shall be considered to have been deposited on the day on which the condition indicated in the declaration is fulfilled. However, when the deposit of an instrument specified in the declaration is, itself, accompanied by a declaration of the said kind, that instrument shall be considered as deposited on the day on which the condition specified in the latter declaration is fulfilled.

(b) Any declaration made under paragraph (a) may be withdrawn, in its entirety or in part, at any time. Any such withdrawal shall become effective on the date on which the notification of withdrawal is received by the Director General.

Article 34 Effective Date of Ratifications and Accessions

(1) [*Entry into Force of the Treaty*] This Treaty shall enter into force three months after eight States or intergovernmental organizations have deposited their instruments of ratification or accession.

(2) [*Ratifications and Accessions Subsequent to the Entry into Force of the Treaty*] Any State or intergovernmental organization not covered by paragraph (1) shall become bound by this Treaty three months after the date on which it has deposited its instrument of ratification or accession, unless a later date has been indicated in the instrument. In the latter case, the said State or intergovernmental organization shall become bound by this Treaty on the date thus indicated.

Article 35 Reservations

Alternative A

Note: No article on reservations.

Alternative B

(1) [*Possibility of Making Reservations*] (a) Any instrument of ratification of, or accession to, this Treaty that is deposited not later than the end of the eighth calendar year after the year in which this Treaty has been adopted may be accompanied by a declaration making reservations to this Treaty as provided for in paragraphs (2) to (5).

(b) No reservations to this Treaty other than the reservations allowed under paragraphs (2) to (5) are permitted.

(2) [*Fields of Technology*] (a) Any State or inter-governmental organization may declare that, notwithstanding the provisions of Article 10, patents will not be granted by the competent Office in the fields of technology specified in its declaration, provided that such a declaration may only specify those fields of technology which, at the time of making the declaration, are fields for which that State or intergovernmental organization provides for the exclusion of the grant of patents.

(b) Any declaration made under subparagraph (a) by a developing country or by an intergovernmental organization all the members of which are developing countries shall lose its effect at the end of the fifteenth calendar year after the year in which this Treaty has been adopted. Any declaration made under subparagraph (a) by any other State or intergovernmental organization shall lose its effect at the end of the tenth calendar year after the year in which this Treaty has been adopted.

(3) [*Certain Rights Conferred by Process Patents*] (a) Any State which is a developing country or any intergovernmental organization all the members of which are developing countries and which, at the time of making the declaration, does not provide for the right referred to in Article 19(2)(ii) may declare that it will not apply that provision.

(b) Any declaration made under subparagraph (a) shall lose its effect at the end of the fifteenth calendar year after the year in which the Treaty has been adopted.

(4) [*Term of Patent*] (a) Any State or intergovernmental organization which, at the time of making the declaration, provides for a term of the patent other than that referred to in Article 22 may declare that it will not apply that provision.

(b) Any declaration made under subparagraph (a) by a developing country or by an intergovernmental organization all the members of which are developing countries shall lose its effect at the end of the fifteenth calendar year after the year in which the Treaty has been adopted. Any declaration made under subparagraph (a) by any other State or intergovernmental organization shall lose its effect at the end of the tenth calendar year after the year in which the Treaty has been adopted.

(5) [*Reversal of Burden of Proof*] (a) Any State which is a developing country or any intergovernmental organization all the members of which are developing countries and which, at the time of making the declaration, does not provide for the reversal of the burden of proof referred to in Article 24 may declare that it will not apply that provision.

(b) Any declaration made under subparagraph (a) shall lose its effect at the end of the fifteenth calendar year after the year in which the Treaty has been adopted.

Article 36 Special Notifications

(1) [*States*] (a) Any State in respect of which patents may be obtained only through the Office of another Contracting Party shall notify this fact and shall identify such Contracting Party.

(b) Any change in the fact notified by a State under subparagraph (a) shall be promptly notified by such State.

(2) [*Intergovernmental Organizations Referred to in Article 33(1)(ii)*] (a) Any intergovernmental organization referred to in Article 33(1)(ii) shall notify the list of its member States and, if its norms deal with only some of the matters covered by Articles 3 to 26, shall notify this fact and shall, among the provisions of the said Articles, identify those provisions with which its norms deal. The other provisions of the said Articles shall not bind the intergovernmental organization.

(b) If the norms of any intergovernmental organization referred to in subparagraph (a) later deal with any matter covered by Articles 3 to 26 concerning which the intergovernmental organization has not made a notification under subparagraph (a), the intergovernmental organization shall be bound by the corresponding provisions of this Treaty and shall promptly notify the relevant changes in its norms.

(3) [*Intergovernmental Organizations Referred to in Article 33(1)(iii)*] (a) Any intergovernmental organization referred to in Article 33(1)(iii) shall notify the list of its member States and, if its norms do not deal with any of the matters covered by Articles 19 to 26, shall notify this fact and shall, among the provisions of the said Articles, identify those provisions with which its norms do not deal. The latter provisions shall not bind the intergovernmental organization.

(b) If the norms of any intergovernmental organization referred to in subparagraph (a) later deal with any matter concerning which the intergovernmental organization has made a notification under subparagraph (a), the intergovernmental organization shall be bound by the corresponding provisions of this Treaty and shall promptly notify the relevant changes in its norms.

(4) [*Time of Notification*] (a) Any notification under paragraphs (1)(a), (2)(a) or (3)(a) shall accompany the instrument of ratification or accession.

(b) Any change under paragraphs (1)(b), (2)(b) or (3)(b) shall be notified promptly in a declaration addressed to the Director General.

Article 37 Denunciation of the Treaty

(1) [*Notification*] Any Contracting Party may denounce this Treaty by notification addressed to the Director General.

(2) [Effective Date] Denunciation shall take effect one year from the date on which the Director General has received the notification. It shall not affect the application of this Treaty to any application pending or any patent in force in respect of the denouncing Contracting Party at the time of the expiration of the said one-year period.

Article 38

Languages of the Treaty; Signature

(1) [Original Texts; Official Texts] (a) This Treaty shall be signed in a single original in the English, Arabic, Chinese, French, Russian and

Spanish languages, all texts being equally authentic.

(b) Official texts shall be established by the Director General, after consultation with the interested Governments, in such other languages as the Assembly may designate.

(2) [Time Limit for Signature] This Treaty shall remain open for signature at the headquarters of the Organization for one year after its adoption.

Article 39

Depositary

The Director General shall be the depositary of this Treaty.

DRAFT REGULATIONS UNDER THE TREATY SUPPLEMENTING THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY AS FAR AS PATENTS ARE CONCERNED (PATENT LAW TREATY)

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Rule 1 Definitions (*ad* Article 2)

(1) ["Treaty"; "Article"] (a) In these Regulations, the word "Treaty" means the Treaty Supplementing the Paris Convention for the Protection of

Industrial Property as far as Patents Are Concerned (Patent Law Treaty).

(b) In these Regulations, the word "Article" refers to the specified Article of the Treaty.

(2) [Expressions Defined in the Treaty] The expressions defined in Article 2 for the purposes of

the Treaty shall have the same meaning for the purposes of these Regulations.

(3) [*Means of Publication*] For the purposes of Article 2(viii), an application, a search report, a patent or any change in a patent shall be deemed to be "accessible to the public" if any person so wishing, against payment or free of charge, can

(i) obtain from the Office paper copies of the application, the search report, the patent or the document reflecting the change,

(ii) inspect, at the Office, the application, the search report, the patent or the document reflecting the change and, on request, obtain from the Office paper copies thereof, or

(iii) take cognizance, by means of electronic communication, of the application, the search report, the patent or the change and make, if he so wishes, paper copies thereof.

Rule 2

Contents and Order of Description (ad Article 3(2))

(1) [*Contents of Description*] The description shall, after stating the title of the invention,

(i) specify the technical field or fields to which the invention relates;

(ii) indicate the background art which, as far as known to the applicant, can be regarded as useful for the understanding, searching and examination of the invention, and, preferably, cite the documents reflecting such background art;

(iii) describe the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state the advantageous effects, if any, of the invention with reference to the background art;

(iv) where a deposit of biologically reproducible material is required under Article 3(1)(b), indicate the fact that the deposit has been made and identify at least the name and address of the depositary institution, the date of the deposit and the accession number given to the deposit by that institution, as well as describe, to the extent possible, the nature and the characteristics of such material, relevant to the requirement of disclosure of the invention;

(v) briefly describe the figures in the drawings, if any;

(vi) set forth at least one mode for carrying out the invention claimed; this shall be done in terms of examples, where appropriate, and with reference to the drawings, if any; however, any Contracting Party may provide that the description set forth the best mode for carrying out the invention known to the

inventor at the filing date or, where priority is claimed, priority date of the application;

(vii) indicate explicitly, when it is not otherwise obvious from the description or nature of the invention, the way or ways in which the invention satisfies the requirement of being useful or industrially applicable.

Alternative A

(2) [*Manner and Order of Presentation of Contents*] (a) The contents of the description shall be presented in the order specified in paragraph (1), unless, because of the nature of the invention, a different order would afford a better understanding or a more economical presentation.

(b) Any Contracting Party may accept a description which does not contain the matters specified in paragraph (1)(i), (ii) and (v), or which contains, in lieu of the matter specified in paragraph (1)(iii), a description of the invention in any terms that satisfy the requirement of a disclosure of the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

Alternative B

[*Manner and Order of Presentation of Contents*] The contents of the description shall be presented in the manner and order specified in paragraph (1), unless, because of the nature of the invention, a different manner or a different order would afford a better understanding or a more economical presentation.

(3) [*Nucleotides and Amino Acid Sequences*] Any Contracting Party may, where the application contains disclosure of a nucleotide or amino acid sequence, provide for special requirements concerning the place, mode and format of such disclosure.

Rule 3

Manner of Claiming (ad Article 4(5))

(1) [*Consecutive Numbering*] Where the application contains several claims, they shall be numbered consecutively in arabic numerals.

(2) [*Method of Definition of Invention*] The definition of the matter for which protection is sought shall be in terms of the technical features of the invention.

(3) [*Form of Claim*] Claims shall be written either

(i) in two parts, the first part consisting of a statement indicating those technical features of the

invention which are necessary in connection with the definition of the claimed subject matter and which, in combination, appear to be part of the prior art, the second part (“the characterizing portion”), introduced by the words “characterized in that,” “characterized by,” “wherein the improvement comprises,” or other words to the same effect, consisting of a statement indicating those technical features which, in combination with the features stated in the first part, define the matter for which protection is sought; or

(ii) in a single statement containing a recitation of a combination of several elements or steps, or a single element or step, which defines the matter for which protection is sought.

(4) [References in the Claims to the Description and Drawings] (a) No claim may contain, in respect of the technical features of the invention, a reference to the description or any drawings, for example, such references as: “as described in part ... of the description,” or “as illustrated in figure ... of the drawings,” unless such a reference is necessary for the understanding of the claim or enhances the clarity or the conciseness of the claim.

(b) No claim may contain any drawing or graph. Any claim may contain tables and chemical or mathematical formulas.

(c) Where the application contains a drawing, the mention of any technical feature in a claim may, if the intelligibility of that claim can thereby be enhanced, include a reference sign to that drawing or to the applicable part of that drawing; such a reference sign shall be placed between square brackets or parentheses; it shall not be construed as limiting the claim.

(5) [Dependent and Multiple Dependent Claims] (a) Any claim which includes all the features of another claim of the same category or several other claims of the same category (hereinafter referred to as “dependent claim” and “multiple dependent claim,” respectively) shall, preferably in the beginning, refer to the other claim or the other claims, as the case may be, by indicating the number of the other claim or the numbers of the other claims and shall then state those features claimed that are additional to the features claimed in the other claim or the other claims.

(b) A dependent claim may depend on another dependent claim or on a multiple dependent claim. A multiple dependent claim may depend on a dependent claim or another multiple dependent claim. Multiple dependent claims may refer in the alternative or in the cumulative to the claims on which they depend.

(c) All dependent claims referring back to the same claim, and all multiple dependent claims referring back to the same claims, shall be grouped together in the most practical way possible.

Rule 4 **Details Concerning the Requirement** **of Unity of Invention** **(ad Article 5(1))**

(1) [Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled] Where a group of inventions is claimed, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of those inventions, considered as a whole, makes over the prior art.

(2) [Determination of Unity of Invention Not Affected by Manner of Claiming] The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Rule 5 **Divisional Applications** **(ad Article 5(1))**

(1) [Time Limit] (a) The applicant may file one or more divisional applications at any time up to at least the time when the initial application is in order for grant.

(b) Notwithstanding subparagraph (a), any Contracting Party which establishes a time limit for compliance by the applicant with all requirements for the grant of a patent may provide that no divisional application may be filed during the six months preceding the expiration of that time limit.

(2) [Priority Documents] Priority documents and any translations thereof that are submitted to the Office in respect of the initial application shall be considered as having been submitted also in respect of the divisional application or applications.

Rule 6 **Manner of Identification** **and Mention of Inventor** **(ad Article 6)**

(1) [Manner of Identification and Mention] (a) The identification of the inventor referred to in Article 6(1)(a) shall consist of the indication of the inventor’s name and address.

(b) The mention of the inventor referred to in Article 6(2) shall consist of at least the indication of the inventor’s name.

(2) [*Procedure in Case of Non-Compliance with Requirements*] (a) If the application and the documents accompanying it do not comply with the requirements provided for under Article 6(1)(a) and, where applicable, Article 6(3), the Office shall invite the applicant to comply with the said requirements within a reasonable time limit.

(b) The application may not be rejected for failure to comply with the said requirements where such an invitation has not been extended to the applicant.

(3) [*Corrections*] The applicant may correct, at any time, the identification of the inventor given in accordance with Article 6(1)(a). Any Contracting Party may require the consent of any previously identified inventor before accepting such a correction.

Rule 7 **Details Concerning the** **Filing Date Requirements** **(ad Article 8)**

(1) [*Time Limits*] (a) The time limit referred to in Article 8(2)(a) shall be at least two months from the date on which the elements referred to in Article 8(1) have been received by the Office.

(b) The time limit referred to in Article 8(4) shall be at least two months from the date on which the application containing the reference to the previously filed application has been received by the Office.

(c) The time limit referred to in Article 8(5)(b) shall be at least two months from the date on which the item requiring translation has been received by the Office.

(2) [*Procedure in Case of Non-Compliance with Requirements*] If the application does not, at the time of its receipt by the Office, comply with any of the requirements of Article 8(1) or the applicable requirements, if any, of Article 8(2)(a), Article 8(4) or Article 8(5)(b) that the application must satisfy either on receipt or within the time limit applicable under paragraph (1), the Office shall promptly invite the applicant to comply with such requirement within a time limit fixed in the invitation, which time limit shall be at least one month from the date of the invitation or, where the non-compliance relates to a matter for which a time limit for compliance is established by paragraph (1), the time limit referred to in paragraph (1), whichever expires later. Compliance with the invitation may be subject to the payment of a special fee. Failure to send an invitation shall not alter the said requirements.

(3) [*Filing Date in Case of Correction*] If, within the time limit fixed in the invitation referred to in

paragraph (2), the applicant complies with the invitation and pays the required special fee, if any, the filing date shall be the date on which the elements referred to in Article 8(1) have been received by the Office. Otherwise, the application shall be treated as if it had not been filed.

(4) [*Date of Receipt*] Each Contracting Party shall be free to determine the circumstances in which the receipt of a document by a branch or sub-office of an Office, by a national Office on behalf of an intergovernmental organization having the power to grant regional patents, or by an official postal service, shall be deemed to constitute receipt of the document by the Office concerned.

(5) [*Correction of Translations*] Any translation of the parts of the application, or of the text matter, referred to in Article 8(5)(b) and (c) may be corrected at any time up to the time when the application is in order for grant in order to conform to the wording of those parts or that text matter furnished in a language other than the official language.

Rule 8 **Announcement in the Gazette of the** **Publication of an Application** **(ad Article 15(1))**

The publication of an application shall be announced in the official gazette with an indication of at least the following data:

- (i) the name of the applicant,
- (ii) the title of the invention,
- (iii) the filing date and the serial number of the application,
- (iv) where priority is claimed, the filing date and the serial number of the application the priority of which is claimed and the name of the Office with which that application was filed,
- (v) if available, the symbols of the International Patent Classification.

Rule 9 **Announcement in the Gazette of the** **Publication of a Change in a Patent** **(ad Article 17(5))**

The publication of a change in a patent shall be announced in the official gazette with an indication of at least the following data:

- (i) the name of the owner of the patent,
- (ii) the serial number of the patent,
- (iii) the date of the change,
- (iv) the nature of the change.

Rule 10
Announcement in the Gazette of the
Grant of a Patent
(ad Article 18(1)(b))

The grant of a patent shall be announced in the official gazette with an indication of at least the following data:

- (i) the name of the owner of the patent,
- (ii) the title of the invention,
- (iii) the filing date and the serial number of the application,
- (iv) where priority is claimed, the filing date and the serial number of the application the priority of which is claimed and the name of the Office with which that application was filed,
- (v) the serial number of the patent,
- (vi) if available, the symbols of the International Patent Classification.

Rule 11
Absence of Quorum in the Assembly
(ad Article 27)

In the case provided for in Article 27(5)(b), the International Bureau shall communicate the decisions of the Assembly (other than those concerning the Assembly's own procedure) to the Contracting Parties having the right to vote which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If,

at the expiration of that period, the number of Contracting Parties having thus expressed their vote or abstentions attains the number of Contracting Parties which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

Rule 12
Requirement of Unanimity for
Amending Certain Rules
(ad Article 29(3))

Amendment of Rule 2(1)(vi) or Rule 3(3) of these Regulations shall require that no Contracting Party having the right to vote in the Assembly vote against the proposed amendment.

Rule 13
Settlement of Disputes
(ad Article 30)

(1) [*Time Limit for Consultations*] The time limit referred to in Article 30(1)(b) shall be two months from the date of the request to enter into consultations.

(2) [*Time Limit for Reaching Agreement on the Terms of Reference of the Panel*] The time limit referred to in Article 30(3)(c) shall be three months from the date on which the Director General appointed the members of the panel.

II. Notes on the Basic Proposal for the Treaty and Regulations
(Prepared by the Director General of WIPO)
(PLT/DC/4)

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I. General Explanations on the Notes

0.01 This document contains notes on the Draft Treaty Supplementing the Paris Convention as far as Patents are Concerned (Patent Law Treaty) and the Draft Regulations under that Treaty contained in document PLT/DC/3 (hereinafter referred to as the "Draft Treaty" and the "Draft Regulations," respectively).

0.02 Notes have been prepared only with respect to those provisions of the Draft Treaty and the Draft Regulations which seem to require comments.

0.03 The Draft Treaty and the Draft Regulations contain, in respect of 12 provisions, alternatives: in respect of 11 provisions, they are designated with two letters, namely, "A" and "B" (Preamble; Articles 8(4), 10, 19, 20(1), 22, 24, 25, 26 and 35; Rule 2(2)), and in respect of one provision (Article 19) with three letters, namely, "A," "B," and "C." Draft Rule 29(1)(b) of the Draft Rules of Procedure of the Diplomatic Conference contains the following provision dealing with such alternatives:

"Where, for any given Article, there are two or three alternatives in the basic proposal, consisting of either two or three texts, or one or two texts and an alternative that there should be no such Article, the alternatives shall be designated with the letters A, B and, where applicable, C, and shall have equal status. Discussions shall take place simultaneously on the alternatives and, if voting is necessary and there is no consensus on which alternative should be put to the vote first, each Member Delegation shall be invited to indicate its preference among the two or three alternatives. The alternative supported by more Member Delegations than the other alternative or, where there are three alternatives, any of the other alternatives, shall be put to the vote first."

0.04 The Draft Treaty contains, in respect of six provisions, text which appears in square brackets, namely, in Articles 7(2), 11(2)(c), 13(4)(b), 19(3)(a)(iii) (Alternative B), 27(4)(b) and (c). Draft Rule 29(1)(c) of the Draft Rules of Procedure of the Diplomatic Conference contains the following provision concerning such texts:

“Wherever the basic proposal contains words within square brackets, only the text that is not within square brackets shall be regarded as part of the basic proposal, whereas words within square brackets shall be treated as a proposal for amendment if presented as provided in paragraph (2).”

II. Notes on the Draft Treaty

Note on the Preamble

P.01 Article 19 of the Paris Convention for the Protection of Industrial Property (hereinafter referred to as the “Paris Convention”) reads as follows:

“It is understood that the countries of the Union reserve the right to make separately between themselves special agreements for the protection of industrial property, in so far as these agreements do not contravene the provisions of this Convention.”

Note on Article 1

(Establishment of a Union)

1.01 There are two kinds of unions established by special agreements under the Paris Convention: those which entail financial obligations for the members and those without such obligations. The union to be established by the present Treaty would be of the latter kind.

Note on Article 2

(Definitions)

2.01 It is to be noted that the terms “official language” and “inventor” are not included in Article 2 because each is used for the purposes of one provision of the Treaty only, namely, Articles 8(5) and 12(1), respectively. The terms are defined in Articles 8(5)(d) and 12(2), respectively.

2.02 The terms defined in Article 2 are listed in the order of their first appearance in the Treaty (starting with Article 3).

2.03 *Item (i)* does not attempt to define the constituent elements of an application. Usually, an application would be considered to comprise a request (for the grant of a patent), a description, one or more claims, one or more drawings (where required) and an abstract (see, for example, Article 3(2) of the Patent Cooperation Treaty (PCT)). In the present Treaty, however, this matter is not regulated so that, subject to the requirements of this Treaty (such as, for example, the requirements to accord a filing date when the conditions of Article 8 are satis-

fied or to comply with the stipulations of Article 3 and Rule 2 concerning the description), each Contracting Party would be free to decide what elements constitute an application.

2.04 The terms “application” and “application for a patent” are used in Articles 2(ii) and (ix); 3(1) and (2)(a); 4(1); 5; 6(1), (2) and (3); 7; 8; 9(2); 11(2)(b) and (3); 12(1) and (2); 13; 14; 15; 16(1)(a) and (b) and (2); 17(4); 18(2)(c); 20(1); 22(2) (Alternative B); 23(2); 25(1)(i), (ii) and (iv) (Alternative B); 37(2). They also appear in Rules 1(3); 2(1)(vi) and (3); 3(1) and (4)(c); 5(1) and (2); 6(2); 7(1)(b), (2), (3) and (5); 8; 10.

2.05 *Item (ii)*: The term “priority date” is used in Articles 3(1)(b); 9(2)(ii); 11(2)(b) and (3); 12(1); 13(1)(b); 15(1); 20(1); 25(1)(i); as well as in Rule 2(1)(vi).

2.06 *Item (iii)*: The term “prescribed” is used in Articles 3(2)(b); 4(5); 6(1); 8(2), (4) and (5)(b); 29(1)(i); 30(1)(b) and (3)(c); as well as in Rule 7(2).

2.07 *Item (iv)*: The term “patent” is used in the Treaty to refer only to patents for inventions and to exclude other titles of industrial property that are sometimes referred to in national laws as “patents,” such as patents for designs, patents for utility models, petty patents and plant patents.

2.08 The term “patent” is used in the Preamble, Articles 2(i), (ii), (iv) and (v); 5(2); 6(1)(b) and (2); 8(1)(i) and 8(6)(b); 9; 10(1) and (2) (Alternative A) and 10 (Alternative B); 12(2); 13(1)(a) and (b) and (3); 17; 18(1)(a), (b) and (e) and (2); 19 (Alternatives A and B); 20(1) (Alternatives A and B); 21(1), (3), (4) and (5); 22 (Alternatives A and B); 23; 24(1) (Alternative B); 25(1) and (2) (Alternative B); 26 (Alternative B); 33(1)(i) and (iii); 35(2) and (4)(a); 36(1)(a); 37(2); as well as in Rules 1(1)(a) and (3); 5(1)(b); 7(4); 8; 9; 10.

2.09 *Item (v)*: The term “Office” is used in Articles 2(ii) and (ix); 6(2); 7; 8(1), (2), (3), (4) and (5); 12(1)(ii); 14(1) and (2); 15(1)(a), (2) and (4); 16(1)(a), and (2); 17(1), (2), (3) and (5); 18(1)(a), (d) and (e) and (2); 25(1)(ii); 33(1)(i) and (iii); 35(2) (Alternative B); 36(1); as well as in Rules 1(3)(i) and (ii); 5(2); 6(2); 7(1) to (4); 8(iv); 10(iv).

2.10 *Item (vi)*: The term “person” is used in Articles 9(1); 12(2); 18(1)(a) and (d); 19(4) (Alternative B) and 19(3)(c) (Alternative C); 20(1); 23(1) and (2)(a); 26(3) (Alternative B); as well as in Rule 1(3).

2.11 *Item (vii)*: The term “Director General” is used in Articles 10(3) (Alternative A); 15(1)(b); 18(2)(c);

21(2)(c); 24(1)(b) (Alternative B); 27(2)(a)(v) and (vi), (4)(c) and (7); 28(1)(ii), and (2) to (5); 30(3)(b) and (c); 33(3)(b); 36(4)(b); 37; 38(1)(b); 39; as well as in Rule 13(2).

2.12 *Item (viii)*: The term “published” is used in Articles 13(1)(a) and (2); 15(2) and (4); 16(1); 17(3); 23(2). The definition is to be read in conjunction with Rule 1(3), which indicates the means which must be considered as making an application, search report, a patent or a change in a patent accessible to the public and, therefore, as rendering the application, search report, patent or change “published.”

2.13 *Item (ix)*: The term “substantive examination” is used in Articles 14(2); 16(1)(a) and (2); 18(1)(a).

2.14 *Item (x)*: The term “instrument of ratification” is used in Articles 15(1)(b); 21(2)(c); 24(1)(b) (Alternative B); 33(2)(i) and 3(a); 35(1)(a) (Alternative B); 36(4)(a).

2.15 *Item (xi)*: The term “Assembly” is used in Articles 27; 28(1), (3) to (5); 29(2); 30(3)(a) and (f) and (4); 38(1)(b); as well as in Rules 11; 12.

2.16 *Item (xii)*: The term “Union” is used in Articles 1; 2(xi); 27(1)(a) and (c), (2)(a)(i), (vi), (vii) and (ix) and (b); 28(1)(i) and (ii) and (2) to (4).

2.17 *Item (xiii)*: The term “Organization” is used in Articles 27(2)(b) and (7)(a); 28(1); 38(2).

2.18 *Item (xiv)*: The term “Regulations” is used in Articles 3(3); 18(2)(c); 27(2)(a)(iii) and (9)(a); 29; as well as in Rules 1(1) and (2); 12.

2.19 It is to be noted that Rule 1(3) contains the definition of the term “accessible to the public.”

Note on Article 3 (Disclosure and Description)

3.01 *Paragraph (2)*: It is to be noted that Rule 2 contains further details concerning the contents and the order of the description.

3.02 *Paragraph (3)*: It is understood that the prohibition of additional or different requirements does not prevent a Contracting Party from requiring compliance with certain formal requirements, such as, in the case of paper filings, the use of a special form and the dimensions of text matter and drawings or, in the case of electronic filings, technical standards regarding the input and output of data.

3.03 It is to be noted that Rule 2(3) allows Contracting Parties to provide for special require-

ments in respect of the disclosure of nucleotides or amino acid sequences.

Note on Article 4 (Claims)

4.01 *Paragraph (3)*: The number of claims *per se* cannot be the subject of an objection on the basis of the requirement of conciseness. The requirement of clarity would provide a basis for disallowing any claim that merely paraphrased another claim, since it would not be clear how such a claim differed from the earlier claim.

4.02 Since a trademark does not define a product, a reference in a claim to a trademark would be considered to impair the clarity of the claim and should, save in the exceptional case where such a reference may be unavoidable, be eliminated.

4.03 *Paragraph (5)*: It is to be noted that Rule 3 contains further details concerning the manner of claiming.

4.04 *Paragraph (6)*: As to the scope of the prohibition, see note 3.02, above.

Note on Article 5 (Unity of Invention)

5.01 *Paragraph (1)*: It is to be noted that Rules 4 and 5 contain further details concerning the requirement of unity of invention.

5.02 *Paragraph (2)*: The essential purpose of the requirement of unity of invention is to facilitate the administration and the search of applications. Accordingly, paragraph (2) provides that, while paragraph (1) requires that *applications* must conform to the requirement of unity of invention, if a *patent* happens to be granted on an application that does not comply with that requirement, the failure to comply with the requirement of unity of invention cannot be a ground for the invalidation or revocation of the patent. In other words, and as already stated, since the purpose of the requirement of unity of invention is to facilitate the administration and the search of applications, failure to comply with the requirement can and needs only be redressed at the application stage. At that stage, the sanction for non-compliance is the refusal of the grant of a patent unless the application is restricted through the elimination of certain claimed subject matter. The subject matter so eliminated may then be included in one or more “divisional” applications.

5.03 An objection of lack of unity should only be made when lack of unity seriously disturbs the procedure and, if made, it should be made as soon as possible, that is, normally at the latest at the stage of the first examination based on the prior art. At a later stage of procedure, it should not be raised unless as a consequence of amendment of claims or for other clearly justified reasons.

5.04 Occasionally, in cases of lack of unity of invention, particularly if noted only after assessment of the prior art, the examiner will be able to make a complete search and examination for both or all inventions with negligible additional work, in particular when the inventions are conceptually very close and none of them requires search in separate classification units. It is understood that, in those cases, the search and examination for the additional invention(s) should be completed in respect of the whole application, and no objection of lack of unity of invention should be raised.

*Note on Article 6
(Identification and Mention
of Inventor; Declaration Concerning
the Entitlement of the Applicant)*

6.01 *Paragraphs (1) to (3)*: It is to be noted that Rule 6 contains further details concerning the manner of the identification and mention of the inventor.

6.02 *Paragraph (2)* extends the right of the inventor, established by Article 4^{ter} of the Paris Convention, to be mentioned in the patent to any publication of the Office containing the application. Article 4^{ter} of the Paris Convention reads as follows: "The inventor shall have the right to be mentioned as such in the patent."

6.03 As regards the meaning of "publication," see Article 2(vii) and Rule 1(3).

6.04 *Paragraph (3)* allows a Contracting Party to require the *indication*—as opposed to the production of evidence—of the legal grounds of the applicant's entitlement. Such legal grounds might be, for example, assignment, employment or inheritance. Proof of the correctness of the indicated grounds of entitlement could not be required by the Office *ex officio*.

6.05 *Paragraph (4)*: This paragraph does not affect such general, formal requirements as a requirement to furnish a transliteration of the inventor's name.

*Note on Article 7
(Belated Claiming of Priority)*

7.01 *Paragraph (1)* addresses the situation in which an application which could claim the priority of an earlier application does not, when filed, contain such a claim. The paragraph allows the claiming of priority in a separate declaration filed later than the application. This is permissible since the Paris Convention does not require that the priority claim ("the declaration" containing the priority claim, according to the terminology of Article 4D(1) of that Convention) be contained in the subsequent application itself.

7.02 *Paragraph (2)*: It is to be noted that, if paragraph (2) is adopted, paragraphs (1) and (2) would not be mutually exclusive. Any applicant could invoke both paragraphs, as implied by the words "claims or could have claimed" in the opening of paragraph (2).

7.03 It is understood that an Office could require the payment of a special fee in either of the situations contemplated in paragraphs (1) and (2).

*Note on Article 8
(Filing Date)*

8.01 It is to be noted that certain details concerning the matter of filing date are provided for in Rule 7.

8.02 *Paragraph (1)* applies regardless of the medium (whether paper, electronic impulses or otherwise) in which the elements specified in it are or may be submitted to the Office. The manner of compliance may, however, take into account the particular medium required or allowed by an Office. For example, a Contracting Party whose Office requires or allows electronic filings may require that, in the case of such filings, the applicant identify himself by reference to an identification code which permits entry into the Office system. Such a requirement would be considered to comply with item (ii) of paragraph (1).

8.03 *Paragraph (2)(a)*: The time limit is fixed in Rule 7(1)(a).

8.04 *Paragraph (3)* accords with Article 14(2) of the Patent Cooperation Treaty (PCT).

8.05 *Paragraph (4)*: The time limit is fixed in Rule 7(1)(b).

8.06 *Paragraph (5)(b)*: The time limit is fixed in Rule 7(1)(c).

*Note on Article 9
(Right to a Patent)*

9.01 *Paragraph (1)*: It is understood that the ordinary rules in each Contracting Party applicable to the sale, transfer, devolution or other transmission of property rights, as well as rules on bankruptcy, apply to the right to a patent and are not affected by paragraph (1). Thus, if, in a given case, the inventor (or the employer or the person having commissioned the work of the inventor) has sold his right to a patent for a particular invention, the right to the patent would belong to the successor-in-title of the inventor (or of the employer or of the said person).

9.02 *Paragraph (2)*: The result produced by paragraph (2) (namely, that where there are several inventors who have independently made the same invention, the right to a patent belongs to the one who was the first to file an application) applies regardless of when each of the inventors made the invention.

9.03 The prior art effect of an application in relation to a later application results from Articles 11 (Conditions of Patentability) and 13 (Prior Art Effect of Certain Applications).

9.04 The relationship of two applications filed by the same person with the same Office in respect of the same invention is regulated by the provision on self-collision in Article 13(4).

*Note on Article 10
(Fields of Technology)*

10.01 The Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions (hereinafter referred to as the "Committee of Experts") decided at its June 1990 meeting that this Article should contain two alternatives. Alternative A reproduces a proposal made by 23 developing countries at that meeting (see document HL/CE/VIII/22).

*Note on Article 11
(Conditions of Patentability)*

11.01 *Paragraph (2)(a)*: The second sentence means that a "mosaic" approach to assessing novelty, whereby a plurality of items in the prior art are combined to defeat the novelty of an invention, cannot be used.

11.02 *Paragraph (2)(b)*: It goes without saying that, in this subparagraph, as in all articles of the Draft

Treaty, the term "priority date" means a priority date that is valid.

11.03 *Paragraph (2)(c)*: It is left to general principles of international law to determine what areas of space, land, the sea and the seabed fall within and outside the sovereignty of each State.

*Note on Article 12
(Disclosures Not Affecting Patentability
(Grace Period))*

12.01 *Paragraph (1)*: The disclosure may have been made by any means and in any form: in writing, orally or in some other form (such as display at an exhibition or information via an electronic database).

12.02 *Paragraph (2)*: Persons, other than the inventor, who may have the right to a patent are, for example, the inventor's successor-in-title, his employer, the person commissioning the work that resulted in the invention, or a trustee in bankruptcy.

12.03 *Paragraph (3)*: The phrase "at any time" means that the effects of paragraph (1) can be claimed at any stage of the patent-granting procedure or thereafter, for example, during invalidation proceedings.

*Note on Article 13
(Prior Art Effect of Certain Applications)*

13.01 *Paragraph (1)(a)*: Since the term "application" only means an application for a patent (see Article 2(i)), applications for other titles protecting inventions (for example, utility models) do not have the prior art effect provided for in Article 13. However, where an application for a patent invokes the priority of an earlier application for a utility model, or other title protecting an invention, the prior art effect of the said application for a patent commences (for matter in both the application and the earlier application for a utility model, or other title protecting an invention, which has been invoked) from the priority date (see paragraph(1)(b)).

*Note on Article 14
(Amendment or Correction of Application)*

14.01 *Paragraph (1)*: The "requirements" referred to in this paragraph may result from the Treaty, the applicable national or regional law or both the Treaty and such law.

14.02 The last sentence of paragraph (1) is intended to make it clear that the opportunity to amend or

correct that must be provided under this paragraph arises independently of, and need only be given after, any opportunity to amend or correct, required under Article 8 and its corresponding rule (Rule 7(2)), in respect of elements submitted to obtain a filing date.

14.03 *Paragraph (2)*: Abandoning a claim falls under the notion of amendment of an application.

Note on Article 15
(*Publication of Application*)

15.01 *Paragraph (1)*: It is to be noted that Rule 8 requires that the publication of the application be announced by the competent Office in its official gazette. That Rule reads as follows:

“The publication of an application shall be announced in the official gazette with an indication of at least the following data:

- (i) the name of the applicant,
- (ii) the title of the invention,
- (iii) the filing date and the serial number of the application,
- (iv) where priority is claimed, the filing date and the serial number of the application the priority of which is claimed and the name of the Office with which that application was filed,
- (v) if available, the symbols of the International Patent Classification.”

15.02 The said paragraph does not deal with the determination of the commencement of the 18-month or 24-month time limit in the case of divisional applications, continuation applications, or continuation-in-part applications. Such a determination is left to applicable national or regional law.

15.03 *Paragraph (1)(a)*: As to the term “publish,” see Article 2(viii) and Rule 1(3). In particular, it may be noted that there is no obligation for the Office to distribute pamphlets containing the application, since publication may be effected by allowing inspection of the application and providing paper copies of it on request (Rule 1(3)(ii)) or through an electronic communication which also permits a paper copy to be made (Rule 1(3)(iii)).

15.04 The term “as soon as possible” would permit any unavoidable delays caused as a result of strikes, natural disasters or other cases of *vis major*, but not delays resulting merely from understaffing or inappropriate management arrangements.

15.05 *Paragraph (1)(b)*: Naturally, the reservation referred to in this subparagraph may be withdrawn at any time.

Note on Article 16
(*Time Limits for Search*
and *Substantive Examination*)

16.01 *Paragraph (1)*: As to the term “publish,” see Article 2(viii) and Rule 1(3).

Note on Article 17
(*Changes in Patents*)

17.01 *Paragraph (2)*: While the Treaty does not define “obvious mistakes” or “clerical errors,” they are understood to encompass defects in translations.

17.02 *Paragraph (3)*: The last two words (“as published”) cover each successive text of any patent that has been the subject of changes.

17.03 *Paragraph (5)*: As to the term “publish,” see Article 2(viii) and Rule 1(3).

17.04 It is to be noted that Rule 9 requires that the publication of a change of a patent be announced by the competent Office in its official gazette. That Rule reads as follows:

“The publication of a change in a patent shall be announced in the official gazette with an indication of at least the following data:

- (i) the name of the owner of the patent,
- (ii) the serial number of the patent,
- (iii) the date of the change,
- (iv) the nature of the change.”

Note on Article 18
(*Administrative Revocation*)

18.01 *Paragraph (1)(a)*: The term “document” means any permanent record of information such as, for example, information recorded on paper or information stored in an electronic form.

18.02 *Paragraph (1)(b)*: It is to be noted that Rule 10 requires that the grant of a patent be announced by the competent Office in its official gazette. That Rule reads as follows:

“The grant of a patent shall be announced in the official gazette with an indication of at least the following data:

- (i) the name of the owner of the patent,
- (ii) the title of the invention,
- (iii) the filing date and the serial number of the application,
- (iv) where priority is claimed, the filing date and the serial number of the application the priority of which is claimed and the name of the Office with which that application was filed,

- (v) the serial number of the patent,
- (vi) if available, the symbols of the International Patent Classification.”

18.03 *Paragraph (1)(d)*: The words “departing from the request” signify that an opportunity to present arguments must be accorded on the terms indicated in this provision wherever the decision of the Office does not exactly correspond to the decision requested. Thus, if it is requested that claims A and B be revoked, a proposed decision to revoke only claim B or to revoke claims A, B and C would constitute a “departing from the request” and would require that an opportunity be given to the person making the request to present arguments on the grounds on which the Office intends to depart from the request.

*Note on Article 19
(Rights Conferred by the Patent)*

19.01 The Committee of Experts decided at its October/November 1990 meeting that this Article should contain three alternatives. Alternative C reproduces a proposal made by 23 developing countries at that meeting (see document HL/CE/VIII/22).

19.02 *Paragraph (3)(a)(iii)*: The words in square brackets (“or for the purpose of seeking regulatory approval for marketing”) cover, in particular, acts performed towards the end of a patent term in order to obtain approval of the competent authority for the marketing, following the expiration of the patent term, of a product protected by the patent.

*Note on Article 20
(Prior User)*

20.01 *Paragraph (1)*: The definition of “good faith” is left to applicable national or regional law. In particular, it would be for that law to determine whether a prior use based on information obtained from a non-prejudicial disclosure made during the grace period (that is, a disclosure that does not affect patentability), as opposed to independent invention, constituted a use in good faith.

20.02 The term “territory” is to be interpreted in its broadest sense to cover any and all places and areas where the patent has effect.

*Note on Article 21
(Extent of Protection
and Interpretation of Claims)*

21.01 *Paragraph (2)(b)*: The phrase “at the time of any alleged infringement” may be regarded as

meaning at any time during the occurrence of the alleged infringement or only at the start of the alleged infringement.

*Note on Article 22
(Term of Patents)*

22.01 The Committee of Experts decided at its October/November 1990 meeting that this Article should contain two alternatives. Alternative A corresponds to a proposal made by 23 developing countries at that meeting (see document HL/CE/VIII/22).

22.02 *Alternative B, paragraph (2)(a)*: Where priority is claimed under the Paris Convention, Article 4bis(5) of that Convention applies. Article 4bis(5) reads as follows: “Patents obtained with the benefit of priority shall, in the various countries of the Union, have a duration equal to that which they would have, had they been applied for or granted without the benefit of priority.” The present provision treats applications claiming internal priority in the same manner.

22.03 *Alternative B, paragraph (2)(b)*: This provision covers the term of patents granted on divisional applications, continuation applications and applications for continuation in part. In the case of patents of addition, the term would run from the filing date of the parent application.

*Note on Article 23
(Enforcement of Rights)*

23.01 *Paragraphs (1) and (2)* are presently drafted by reference to Article 19, which sets out the rights conferred by a patent. If Alternative A of Article 19 were adopted, which would leave the rights conferred by the patent to be determined by each Contracting Party, the present Article would have to be re-drafted to refer to those acts recognized by the concerned Contracting Party as constituting an infringement of the rights of the owner of the patent.

23.02 It is understood that national or regional procedural requirements relating to litigation are not affected by this Article.

23.03 Since paragraphs (1) and (2) establish minimum rights (see the words “at least” in the opening clause of each paragraph), any Contracting Party could provide for an exclusive or other licensee to have the right to enforce patent rights or rights arising from published applications.

23.04 *Paragraph (2)*: Where a Contracting Party provides for more measures than those required by

paragraph (2) (by, for example, making available injunctions or damages in respect of rights conferred by published applications), it may naturally continue such additional measures. Such measures as are continued must, because of the principle of national treatment, be available to eligible nationals and residents of other States party to the Paris Convention.

23.05 *Paragraph (2)(a)*: As regards the meaning of "published," see Article 2(viii) and Rule 1(3).

23.06 *Paragraph (2)(b)*: Contracting Parties are free to provide other mechanisms to enhance the enforcement of rights based upon published applications such as, for example, accelerated processing of the application.

23.07 A provision ensuring that the statute of limitations could not commence to run until after the grant of a patent where legal proceedings may not be initiated before the grant of the patent would satisfy the requirement of the proviso that the owner of the patent be accorded a "reasonable" time to initiate such proceedings.

23.08 *Paragraph (2)(c)*: It is understood that the phrase "claims of the patent" refers to the claims appearing in the granted patent on the date of any decision by the court to award compensation.

*Note on Article 24
(Reversal of Burden of Proof)*

24.01 The Committee of Experts decided at its October/November 1990 meeting that this Article should contain two alternatives. Alternative A corresponds to a proposal made by 23 developing countries at that meeting (see document HL/CE/VIII/22).

*Note on Article 25
(Obligations of the Right Holder)*

25.01 The Committee of Experts decided at its October/November 1990 meeting that this Article should contain two alternatives. Alternative B reproduces a proposal made by 23 developing countries at that meeting (see document HL/CE/VIII/31, paragraph 336).

*Note on Article 26
(Remedial Measures Under
National Legislation)*

26.01 The Committee of Experts decided at its October/November 1990 meeting that this Article should contain two alternatives. Alternative B repro-

duces a proposal made by 23 developing countries at that meeting (see document HL/CE/VIII/22).

*Note on Article 27
(Assembly)*

27.01 *Paragraph (1)*: Subparagraph (c) does not preclude the Assembly from requesting financial assistance for the expenses of the participation of all or some delegations from sources outside the Union.

27.02 *Paragraph (4)(b) and (c)*: The words in square brackets ("whether ... or absent") in these subparagraphs are based on a proposal made by the member States of the Organisation africaine de la propriété intellectuelle (OAPI). OAPI has 14 member States.

27.03 *Paragraph (4)(e)*: This subparagraph will have to be omitted if Alternative A (rather than Alternative B) of Article 35 is adopted, that is, if there will be no Article 35.

*Note on Article 28
(International Bureau)*

*Note on Article 29
(Regulations)*

*Note on Article 30
(Settlement of Disputes)*

*Note on Article 31
(Revision of the Treaty)*

*Note on Article 32
(Protocols)*

*Note on Article 33
(Becoming Party to the Treaty)*

33.01 *Paragraph (1)(ii)*: The words "that affect the national laws of the States constituting the said orga-

nization,” which qualified the term “norms” in the proposal made in the last session of the Committee of Experts on which the present provision is based (see document HL/CE/VIII/30), have been omitted. They would seem to be superfluous since any norm in the field of the treaty that is binding on the member States of an intergovernmental organization necessarily affects the national law of those member States.

*Note on Article 34
(Effective Date of Ratifications
and Accessions)*

*Note on Article 35
(Reservations)*

35.01 The Committee of Experts decided at its October/November 1990 meeting that this Article should contain two alternatives. Alternative A corresponds to a proposal made by 23 developing countries at that meeting (see document HL/CE/VII/22).

35.02 *Alternative A*: In relation to the legal effect of the absence of a provision on reservations in a treaty, see Article 19 of the Vienna Convention on the Law of Treaties, which reads as follows:

“A State may, when signing, ratifying, accepting, approving or acceding to a treaty, formulate a reservation unless:

- (a) the reservation is prohibited by the treaty;
- (b) the treaty provides that only specified reservations, which do not include the reservation in question, may be made; or
- (c) in cases not falling under sub-paragraphs (a) and (b), *the reservation is incompatible with the object and purpose of the treaty.*” (Emphasis added)

It would follow from paragraph (c) that the most likely interpretation of the absence of a provision on reservations in this Treaty would be that reservations on any of the substantive provisions would not be permitted at all because the object and purpose of the Treaty is to establish harmonization, within the limits stated in the Treaty, and all the substantive provisions serve that object and purpose.

35.03 *Alternative B, paragraph (2)*: This paragraph is applicable whether Alternative A or Alternative B of Article 10 is adopted.

35.04 *Alternative B, paragraph (3)*: This paragraph is applicable only if Alternative B of Article 19 is adopted.

35.05 *Alternative B, paragraph (4)*: This paragraph is applicable only if Alternative B of Article 22 is adopted.

35.06 *Alternative B, paragraph (5)*: This paragraph is applicable only if Alternative B of Article 24 is adopted.

*Note on Article 36
(Special Notifications)*

*Note on Article 37
(Denunciation of the Treaty)*

*Note on Article 38
(Languages of the Treaty; Signature)*

*Note on Article 39
(Depositary)*

III. Notes on the Draft Regulations

*Note on Rule 1
(Definitions (ad Article 2))*

R1.01 *Paragraph (3)*: Article 2(viii) defines “published” as meaning “made accessible to the public.”

*Note on Rule 2
(Contents and Order of Description
(ad Article 3(2)))*

R2.01 *Paragraph (1)(ii)*: The expression “background art” is used in the corresponding provision of the Regulations under the Patent Cooperation Treaty (PCT) (Rule 5.1(a)(ii)).

R2.02 *Paragraph (1)(iv)*: Article 3(1)(b) reads as follows:

“Where the application refers to biologically reproducible material which cannot be disclosed in the application in such a way as to enable the

invention to be carried out by a person skilled in the art and such material is not available to the public, the application shall be supplemented by a deposit of such material with a depositary institution. Any Contracting Party may require that the deposit shall be made on or before the filing date or, where priority is claimed, the priority date of the application.”

R2.03 *Paragraph (1)(vi)*: As regards amendments of this provision, see Rule 12 which provides that amendment “of Rule 2(1)(vi) ... shall require that no Contracting Party having the right to vote in the Assembly vote against the proposed amendment.”

*Note on Rule 3
(Manner of Claiming (ad Article 4(5)))*

R3.01 *Paragraph (1)* corresponds to Rule 6.1(b) of the Patent Cooperation Treaty (PCT).

R3.02 *Paragraph (2)* corresponds to Rule 6.2(a) of the Patent Cooperation Treaty (PCT).

R3.03 *Paragraph (3)*: As regards amendments of this provision, see Rule 12 which provides that amendment “of Rule 3(3) ... shall require that no Contracting Party having the right to vote in the Assembly vote against the proposed amendment.”

R3.04 *Paragraph (5)(c)* corresponds to Rule 6.4(c) of the Patent Cooperation Treaty (PCT).

*Note on Rule 4
(Details Concerning the Requirement of
Unity of Invention (ad Article 5(1)))*

R4.01 *Paragraph (1)* contains the method for determining whether the requirement of unity of invention is satisfied in respect of a group of inventions claimed in an application. According to that method, unity of invention will exist only when there is a technical relationship among the inventions involving one or more of the same or corresponding “special technical features.” The expression “special technical features” is defined in paragraph (1) as meaning those technical features that define a contribution that each of the inventions, considered as a whole, makes over the prior art.

R4.02 *Independent and Dependent Claims*. Unity of invention has to be considered in the first place only in relation to the independent claims in an application and not the dependent claims. In the context of Rule 4, “dependent” claim means a claim which contains all the features of another claim and is in

the same category of claim as that other claim (the expression “category of claim” referring to the classification of claims according to the subject matter of the invention claimed—for example, product, process, use or apparatus or means, etc.).

R4.03 If the independent claims are patentable and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. Equally, no problem arises in the case of a genus/species situation where the genus claim is patentable. Moreover, no problem arises in the case of a combination/subcombination situation where the subcombination claim is patentable and the combination claim includes all the features of the subcombination.

R4.04 If, however, an independent claim is not patentable, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered. If there is no link remaining, an objection of lack of unity *a posteriori* (that is, arising only after assessment of the prior art) should be raised. Similar considerations apply in the case of a genus/species or combination/subcombination situation.

R4.05 It is intended that the method contained in paragraph (1) for determining whether unity of invention exists should be able to be applied without it being necessary to search the prior art. Where the Office does search the prior art, an initial determination of unity of invention, based on the assumption that the claims are not invalidated by the prior art, might be reconsidered on the basis of the results of the search of the prior art. Where the Office does not search the prior art, unity of invention would be determined on the assumption that the claims are not invalidated by the prior art, unless it is obvious to the person making the determination that the claims are invalidated by the prior art.

R4.06 *Illustrations of Particular Areas*. There are three particular areas of practice where the application of the method for determining unity of invention contained in paragraph (1) of Rule 4 may be illustrated: (i) combinations of different categories of claims; (ii) so-called “Markush practice”; and (iii) the case of intermediate and final products. Principles for the interpretation of the method contained in paragraph (1) in the context of each of those areas are set out below. It is understood that the principles set out below are, in all instances, interpretations of and not exceptions to the requirements of paragraph (1) of Rule 4. Contracting Parties that wish to adopt, in their patent legislation, more detailed provisions on unity of invention than those contained in Article

5 and Rules 4 and 5 could include the substance of the principles of interpretation set out below.

R4.07 In order to secure the greatest possible harmonization of practice, Article 27(2)(a)(iii) empowers the Assembly to adopt guidelines for the implementation of provisions of the Treaty and the Regulations. Under that procedure, the Assembly could adopt, and revise where necessary, the principles of interpretation on the three areas of special concern referred to in the preceding paragraph and set out below. Alternatively, those principles of interpretation could be adopted in the form of an agreed text or statement by the Diplomatic Conference when the Treaty is adopted. The latter method, however, is less flexible, since the text could probably not be later modified in the light of experience in the way that guidelines could be modified by the Assembly.

R4.08 *Combinations of Different Categories of Claims.* The method for determining unity of invention contained in paragraph (1) of Rule 4 should be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same application:

- (i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product, or
- (ii) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process, or
- (iii) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed for carrying out the said process,

it being understood that a process is specially adapted for the manufacture of a product if it inherently results in the product and that an apparatus or means is specifically designed for carrying out a process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art.

R4.09 As indicated in the last part of paragraph R4.08, above, a process should be considered to be specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product. The words "specially adapted" are not intended to imply that the product could not also be manufactured by a different process. They are also not intended to imply that the same kind of process of manufacture could not also be used for the manufacture of other products.

R4.10 As also indicated in the last part of paragraph R4.08 above, an apparatus or means should be considered to be "specifically designed for carrying out" a claimed process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art. Consequently, it would not be sufficient that the apparatus or means is merely capable of being used in carrying out the claimed process. On the other hand, the words "specifically designed" should not imply that the apparatus or means could not be used for carrying out another process, or that the process could not be carried out using an alternative apparatus or means.

R4.11 "*Markush Practice.*" The situation involving the so-called "Markush practice" wherein a single claim defines alternatives (chemical or non-chemical) is also governed by Article 5 and Rule 4. In that special situation, the requirement of a technical inter-relationship and the same or corresponding special technical features as defined in paragraph (1) of Rule 4 should be considered to be met when the alternatives are of a similar nature.

R4.12 When the Markush grouping is for alternatives of chemical compounds, they should be regarded as being of a similar nature where the following criteria are fulfilled:

- (a) all alternatives have a common property or activity, and
- (b)(i) a common structure is present, i.e., a significant structural element is shared by all of the alternatives; or
- (ii) in cases where the common structure cannot be the unifying criterion, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

R4.13 In (b)(i), above, the words "significant structural element is shared by all of the alternatives" refer to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art. The structural element may be a single component or a combination of individual components linked together.

R4.14 In (b)(ii), above, the words "recognized class of chemical compounds" mean that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention. In other words, each member could be substituted one for the other, with the expectation that the same intended result would be achieved.

R4.15 The fact that the alternatives of a Markush grouping can be differently classified should not, taken alone, be considered to be justification for a finding of a lack of unity of invention.

R4.16 When dealing with alternatives, if it can be shown that at least one Markush alternative is not novel, unity should be reconsidered by the examiner. Reconsideration should not necessarily imply that an objection of lack of unity must be raised.

R4.17 *Intermediate and Final Products.* The situation involving intermediate and final products is also governed by Article 5 and Rule 4.

R4.18 The term "intermediate" is intended to mean intermediate or starting products. Such products have the ability to be used to produce patentable final products through a physical or chemical change in which the intermediate loses its identity.

R4.19 Unity of invention should be considered to be present in the context of intermediate and final products where the following two conditions are fulfilled:

(a) the intermediate and final products have the same essential structural element, i.e.,

(i) the basic chemical structures of the intermediate and the final products are the same, or

(ii) the chemical structures of the two products are technically closely interrelated, the intermediate incorporating an essential structural element into the final product, and

(b) the intermediate and final products are technically interrelated, this meaning that the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element.

R4.20 Unity of invention may also be considered to be present between intermediate and final products of which the structures are not known—for example, as between an intermediate having a known structure and a final product the structure of which is not known, or as between an intermediate of unknown structure and a final product of unknown structure. In order to satisfy unity in such cases, there should be sufficient evidence to lead one to conclude that the intermediate and final products are technically closely interrelated as, for example, when the intermediate contains the same essential element as the final product or incorporates an essential element into the final product.

R4.21 It should be possible to accept in a single application different intermediate products used in different processes for the preparation of the final product, provided that they have the same essential structural element.

R4.22 The intermediate and final products should not be separated, in the process leading from one to the other, by an intermediate which is not new.

R4.23 If the same application claims different intermediates for different structural parts of the final product, unity should not be regarded as being present between the intermediates.

R4.24 If the intermediate and final products are families of compounds, each intermediate compound should correspond to a compound claimed in the family of the final products. However, some of the final products may have no corresponding compound in the family of the intermediate products so that the two families need not be absolutely congruent.

R4.25 As long as unity of invention can be recognized applying the above guidelines, the fact that, besides the ability to be used to produce final products, the intermediates also exhibit other possible effects or activities should not affect the decision on unity of invention.

R4.26 *Paragraph (2)* requires that the determination of the existence of unity of invention be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

R4.27 Paragraph (2) is not intended to constitute an encouragement to the use of alternatives within a single claim, but is intended to clarify that the criterion for the determination of unity of invention (namely, the method contained in Rule 4(1)) remains the same regardless of the form of claim used.

R4.28 Paragraph (2) does not prevent an Office from objecting to alternatives being contained within a single claim on the basis of considerations such as clarity, the conciseness of claims or the claims fee system applicable in that Office.

Note on Rule 5

(Divisional Applications (ad Article 5(1)))

R5.01 The right to file divisional applications is established in Article 4G of the Paris Convention, which reads as follows:

"(1) If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.

(2) The applicant may also, on his own initiative, divide a patent application and preserve as

the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the [Paris] Union shall have the right to determine the conditions under which such division shall be authorized.”

*Note on Rule 6
(Manner of Identification and
Mention of Inventor (ad Article 6))*

R6.01 *Paragraph (1)*: The inventor may decide or require that instead of his home address the application should contain an address for service chosen by him.

*Note on Rule 7
(Details Concerning the
Filing Date Requirements (ad Article 8))*

*Note on Rule 8
(Announcement in the Gazette of
the Publication of an Application
(ad Article 15(1)))*

*Note on Rule 9
(Announcement in the Gazette of
the Publication of a Change in a Patent
(ad Article 17(5)))*

*Note on Rule 10
(Announcement in the Gazette of
the Grant of a Patent
(ad Article 18(1)(b)))*

R10.01 The data required in items (i) and (ii) are already required to be published by Article 12 of the Paris Convention which, in its material part, reads as follows:

“(1) Each country of the [Paris] Union undertakes to establish a special industrial property

service and a central office for the communication to the public of patents....

(2) This service shall publish an official periodical journal. It shall publish regularly:

(a) the names of the proprietors of patents granted, with a brief designation of the inventions patented;...”

*Note on Rule 11
(Absence of Quorum in
the Assembly (ad Article 27))*

R11.01 Article 27(5)(b) reads as follows:

“In the absence of the quorum, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the quorum and the required majority are attained through voting by correspondence.”

*Note on Rule 12
(Requirement of Unanimity for
Amending Certain Rules (ad Article 29(3)))*

R12.01 The two Rules identified (Rule 2(1)(vi), concerning the mode of carrying out the invention that must be disclosed, and Rule 3(3), concerning the form of claims) contain provisions of fundamental importance. Therefore, those Rules may not be amended without unanimity.

*Note on Rule 13
(Settlement of Disputes (ad Article 30))*

R13.01 *Paragraph (1)*: Article 30(1)(b) provides that a Contracting Party that is requested to enter into consultations with another Contracting Party “shall provide, within the prescribed time limit, an adequate opportunity for the requested consultations.”

R13.02 *Paragraph (2)*: Article 30(3)(c) provides that the parties to the dispute shall agree upon the terms of reference of the panel but that “if such agreement is not achieved within the prescribed time limit, the Director General shall set the terms of reference of the panel after having consulted the parties to the dispute and the members of the panel.”

Nice Union

Committee of Experts for the International Classification of Goods and Services for the Purposes of the Registration of Marks

Sixteenth Session
(Geneva, October 15 to 19, 1990)

NOTE*

The Committee of Experts set up by Article 3 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks held its sixteenth session in Geneva from October 15 to 19, 1990.¹

The following member countries of the Nice Union were represented: Denmark, Finland, France, Germany, Italy, Japan, Netherlands, Norway, Soviet Union, Sweden, Switzerland, Tunisia, United Kingdom, United States of America (14). China, Kenya and Romania were represented by observers (3). The Benelux Trademark Office and the International Association for the Protection of Industrial Property (AIPPI) were also represented by observers. The list of participants follows this Note.

At the session, the Committee of Experts considered a great number of recommendations by the Preparatory Working Group, made at its last four sessions held from 1987 to 1990, and it adopted the majority of them. The Preparatory Working Group is a body set up in 1974 to prepare the decisions of the Committee of Experts.

The Committee of Experts also considered a number of proposals for the addition of new goods in Class 9 of the Classification submitted directly to it by the International Bureau. The Committee of Experts adopted the majority of those proposals.

With this session (the sixteenth), the Committee of Experts declared the fifth revision period of the Classification closed and expressed its complete satisfaction with the work performed by the Preparatory Working Group.

Finally, the Committee of Experts decided that the changes adopted would enter into force on January 1, 1992. The notification containing those changes will be dispatched to member countries of the Nice Union on July 1, 1991, at the latest. A new (sixth) edition of the Classification will then be published.

* Prepared by the International Bureau.

¹ For the note on the fifteenth session, see *Industrial Property*, 1986, p. 58.

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I. Member States

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Studies

The Future Possibilities of International Protection for Geographical Indications

L. SORDELLI*

The use of geographical names to designate goods is extremely widespread, but one notices, when embarking on the subject, that it is susceptible of a multitude of approaches, and that the relevant legal institutions are themselves very varied. The complexity of the situation is further accentuated by the fact that considerable differences stem from the variety of angles from which national laws consider geographical indications, which have to be looked upon differently in terms of system, substance and conception. Finally, even where the institutional framework used as a reference is governed by essentially comparable principles, comparison is nonetheless difficult owing to the fact that each country organizes this area of law according to its own needs and sets up institutions of its own which are therefore devoid of overall homogeneity (in Italy, for instance, there is no general, statutory regime, and cases are dealt with in a pragmatic fashion). International harmonization of the law of geographical indications is consequently presented with an additional obstacle, namely, the diversity of national legal structures and the different economic interests of a given country in its relations with others. It is true that a geographical name very often denotes the provenance of the goods, which creates tensions regarding the restricted or free use of the name. The legal regime governing geographical indications is bound to be considered from different angles, that of the law on distinctive signs of course, but also that of the law on unfair competition; yet this approach is still inadequate when it comes to determining the areas of involvement of the authorities, the interests at stake, the content of the rights and the limitations that may be imposed on them.

What emerges from the foregoing is that the geographical name has a specific, intrinsic aspect when it is used to designate a product; in that case one speaks of a geographical indication in the general sense, as a word form meaning a distinctive

sign in its own right, a distinctive sign forming part of another sign (a trademark, trade name, or label, for instance) or a distinctive sign having features in common with such a sign.

In the first case, the expression tends to refer to the indicative function, the exact demarcation of which is still blurred, although it is clearly in the field of distinctive signs; in that role it is used to designate indications of source and appellations of origin to the full extent of their meanings and aspects, the understanding of which, as far as industrial property subject matter is concerned, is not questioned inasmuch as it derives from the Paris Convention for the Protection of Industrial Property (Articles 1(2) and 10, in conjunction with Articles 9, 10*bis* and 10*ter*), the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods and the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration.

The fact that geographical indications have been included among distinctive signs immediately prompts a first comment: they are placed alongside trademarks and in opposition to them at the same time, depending on the private or collective interests that are to be given prominence; they are close to trademarks to the extent that they are signs designating specific goods, but remote from them when used in the primary sense of geographical names.

In fact the problem is a well-known one, which the legislation and case law of various countries have solved by adopting a range of variously graduated approaches, dealing with it in different ways and all tending to rule out or substantially limit the existence and registration of trademarks embodying geographical names. They do this in one of the following two ways: (a) by providing for examination of the distinctiveness of the geographical name in question and its acceptance as a trademark to a differentiated or variable extent, or on the contrary by not recognizing the sign's ability to constitute a mark; (b) by providing for examination of the possibly misleading

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intrinsic nature of the geographical name, and for consequent prohibition of either its registration or its use.

From another point of view, due account is taken of the public interest in being able to make everyday use of a geographical name, either to avert the formation of monopolies liable to create positions of undue privilege that would be detrimental to other producers in the area concerned or, where the trademark contains an element that is not purely geographical, to limit the exclusive right to that element and thereby safeguard the freedom to indicate the geographical source of the product (see, for instance, with regard to the first case, Article 3.1(c) and, with regard to the second case, Article 6.1(b) of the European Communities' First Council Directive of December 21, 1988, to Approximate the Laws of the Member States Relating to Trade Marks (89/104/EEC)¹).

A mention should be made, by way of example, of the fairly flexible solution adopted by Italian legal doctrine and case law, according to which a geographical name can become a valid, registered trademark when it has acquired a fanciful meaning that no longer refers to the place of production. According to certain opinions, the same result can be achieved even where, although the headquarters of the business and the production center are located at the place indicated, the geographical name can no longer have any bearing—except perhaps in the eyes of the public—on the characteristics and quality of the product. It follows that any link between a geographical name and the product that it designates is entirely a matter of chance, and one deduces from this that the possibility of having the geographical name registered as a trademark is ruled out only for names of places with which typical products are associated.²

The place-name problem arises also in connection with its definition in relation to a collective mark, in that such a mark has to state and guarantee, as provided for instance in the Italian law,³ the nature, the quality (this being an exception to the rule for an individual mark) and the geographical origin or source of the goods; in this way the interests of the businesspeople of the geographical area to which the name relates (grouped within an organization or association) are catered for, from which it follows that the collective mark has features in common with the geographical indication, above all the kind which, like the appellation of origin,

suggests a certain degree of quality in the product which is characterized by the place and by natural and human factors, as the case may be.

Even in the case of collective, certification or guarantee marks (where legislation provides for them) that incorporate a geographical name, the individual interest of the organization or association of which the various producers are members, and therefore by extension the interest of the producers themselves, in preventing the use of their mark is limited by the interest of any third party who is authorized to use the geographical denomination in accordance with honest practices in industrial or commercial matters (as provided in Article 15.2 of the EEC Directive mentioned above) on the same grounds of social interest as are listed in Article 6.1 of the Directive in connection with individual marks.

The provisions on geographical denominations as elements of trademarks thus incorporate a set of safeguards which are not confined to the examination of the trademark from the point of view of its distinctiveness. Indeed, where either its content or its nature may be misleading, a trademark may not only be denied registration or invalidated if already registered (Article 3.1(g) of the EEC Directive and Section 18(5) of the Italian Trademark Law), but also be the subject of a prohibition on use, as Section 517 of the Italian Criminal Code punishes false indications as to the origin, source or quality of a product.

In any event, as already mentioned, where a geographical trademark is susceptible of registration (as in the eventuality of a place name being used as a fanciful name), its registration in the name of a given person cannot preclude or restrict its use by third parties as a geographical denomination. It follows, *a contrario*, that the trademark system contains a reference, albeit an implied one, to the existence of geographical denominations, and to its separateness from the latter field; the reference is clearer as far as collective marks are concerned, however.

In fact, the references to geographical denominations that are found in the trademark field are intended more to differentiate the two concepts and thereby establish the content, limits and boundaries of trademarks than to define the characteristics peculiar to geographical denominations, to which characteristics we shall be returning below.

A first distinction seems to stem from the foregoing, inasmuch as it is generally taken for granted that distinctiveness is an essential feature of trademarks, even collective trademarks, whereas it is not required for geographical denominations, as their function is to indicate where goods come from.

A set of provisions governing the field of geographical denominations can, however, be based on other legal principles, such as those relating to the prohibition of deception and the repression of

¹ See *Industrial Property Laws and Treaties*, MULTILATERAL TREATIES – Text 3-006.

² Supreme Court of Appeal, October 22, 1982, 546, in *Giurisprudenza Annuale del Diritto Industriale*, 1982, p. 63.

³ Section 2 of Royal Decree No. 929 of June 21, 1942, entitled "Text of the Legislative Provisions on Patents for Business Trademarks," and Section 2570 of the Civil Code.

abuses. This is how the use of false or misleading signs is dealt with. In such cases, recourse is had to another aspect of trademark law, which is also covered by unfair competition legislation, namely, the provision according to which qualifying additions such as "kind," "type," "imitation" and sometimes "taste," etc., are prohibited. This among others is the case that is contemplated when "positive" protection is spoken of, as in connection with Article 3 of the Lisbon Agreement. Such a set of provisions may where appropriate refer to unfair competition law and to acts liable to cause confusion, or to the appropriation of qualities or again, more generally, to acts contrary to honest business practices.⁴

The above acts will in some cases give rise to the imposition of sanctions⁵ provided for in legislation for the repression of acts that are likewise dealt with in multilateral conventions or bilateral treaties, as a means of safeguarding the interests not only of businesses in their relations with each other, but also those of consumers.

The latter remarks lead one to reflect on the conditions that should be met by a general regulatory system on geographical denominations, in order that interests of different character, relating to the public, collective and private sectors, may be provided for. From the point of view of public and collective interests, it is the *principle of truth* that has to be observed if the sign is to be for everyone the expression of the true situation; from the point of view of private interests the principle to be observed is that of *consumer protection*, owing to the implicit link between the name of the place and the product, which in turn justifies the desirability of drawing up a list of protected names; in the last case the principle to be observed is that of the sign *belonging* to a certain geographical area, with the identification of the original beneficiaries of the right (the organization or association—and by extension also the members of that organization or association) which that implies, as a means of responding to economic initiatives and to the expectation of reward for the results of such initiatives.

The borderline between the various principles does not seem entirely exact or strict, however, as the truth condition that has to be met by a place name used as a geographical denomination serves not only the public interest and that of the community as a whole, but also the interest of consumers. The same applies to the principle of safeguarding the trust placed by consumers in the intrinsic geographical meaning of the geographical name, which meaning national legislation protects by providing that the authorities draw up lists of protected names

accompanied by a certain number of provisions (laws, administrative provisions, registration, where appropriate in the form of multilateral or bilateral treaties).

Finally, the safeguarding of the interest that the producers in a given geographical area have in the geographical name of that area being protected (always in relation to its use—indeed, according to some, solely in relation to its use—and by the denial of its use to third parties from outside the place or geographical area that the name designates) involves at the same time not only the principle of belonging but also the principles of truth and trust, and the social requirement of the use of the name concerned, and thus striking of a balance between the interests deserving protection.

The emergence of these interests in the course of the development of production activities, the opening up of markets and the increased circulation of goods outside the frontiers of the various countries has induced legislators to apply different legal techniques which have not been worked out in the same way as far as public law, on the one hand, and private law, on the other, are concerned.

The various systems that have been adopted to solve these complex questions interact with each other in a mutually instructive fashion, as any progress made by one of the systems generates an impulse which had an effect on the others, even when interests are involved that are regarded as deserving protection from a strictly national point of view.

It will be recalled that the text of Articles 9, 10 and 10^{ter} of the Paris Convention, which have to do with the seizure on importation of goods unlawfully bearing a trademark or trade name, does no more than lay down principles, from which the prohibition on the direct or indirect use of false indications as to the origin of a product is derived, whereas the general foundation on which the prohibition relies is to be found in Article 10^{bis}, which deals with the repression of acts of unfair competition. However, in the context of the latter provisions, the definition of geographical denominations takes on a different value depending on the approach to it that a given national system adopts. More explicit provisions on false or deceptive indications and their repression are to be found in the Madrid Agreement mentioned earlier.

Basically, the general trend followed by the provisions enacted in this area is a "negative" one, as it prohibits and punishes certain forms of conduct, yet one can deduce from it a certain number of indications of a positive regulatory system, as we shall see below.

It was not until the 1950s that there was any evidence of positive regulation of geographical indications, defined according to their dual identity of appellations of origin and indications of source, with

⁴ As far as Italy is concerned, see Section 2598 of the Civil Code, the wording of which is considered equivalent to that of Article 10^{bis} of the Paris Convention.

⁵ For Italy, see Section 517 of the Criminal Code.

a distinction made between them which is by no means easy to understand, and indeed is made only in certain countries, and which first found expression, in a more suggested than clear-cut form and a somewhat improvised terminology, in the Convention on the Use of Appellations of Origin and Denominations of Cheeses, signed in Stresa on June 1, 1951 (to which only a small number of countries are party),⁶ and that trend was subsequently confirmed in 1958 by the signature of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration and by the revisions of the Agreement that followed.

The appellation of origin concept (there is still some discussion on the definition of the expression) has a geographical significance which qualifies a product in relation to characteristics of the place of production or origin that are attributable to natural or human factors, in such a way that the appellation of origin takes on a value and bespeaks a certain quality constituting its fundamental element, which even in this respect affords justification for greater protection expressed in the form of exclusive rights accruing to persons allowed to use the appellation concerned to designate specific products possessing particular characteristics. This definition presupposes the following: (a) a system of public authority intervention must be established, by means of legislative and administrative provisions, in the countries within which the places are located; (b) at the international level, the appellation of origin concerned must be protected "as such" in the country of origin (Article 1(2) of the Lisbon Agreement); (c) there must be a system of registration, with the possibility of refusing registration. According to its supporters, the whole system, with both its good features and its less good ones, has to be improved in a positive way, as it is at the same time considered too rigid and restrictive for those countries whose regulatory systems are based on the repression of fraud (WIPO document GEO/CE/I/II, of April 9, 1990, paragraph 41).

The Stresa Convention is inspired by similar principles. The purpose of its Protocols is to grant an exclusive right of protection for the listed appellations of origin of cheeses manufactured or processed according to local, loyal and uninterrupted usages in the particular country or geographical area in which they originate; the cheeses, moreover, have to possess the characteristic qualities laid down by legislative or administrative provisions enacted by the authorities of the country of origin. We need only note the common principle on which the texts of both the Lisbon Agreement and the Stresa Convention are based, without going into the details of their structural differences, that principle being

that the appellation of origin is important as a sign denoting the source in relation to certain specific and essential characteristics of products from a given geographical area, which characteristics determine the particular quality of the product coming from the area in question and itself evoking the geographical name under circumstances provided for in the legislative and other provisions of the country of origin.

This conception of the appellation of origin and its essential qualitative features, being rigidly established in an objective and subjective context, with all the difficulties that are inherent in such a system, have led to the development, above all in legal literature,⁷ of the indication of source concept (on which discussions are also continuing) on the basis of the provisions of the Paris Convention (Articles 1, 2, 9, 10, 10*bis* and 10*ter*) and those of the Madrid Agreement (Articles 3, 3*bis* and 4), with due account also being taken of the contents of bilateral agreements entered into by certain countries in the meantime, although in fact the concept can be more accurately deduced from the Stresa Convention (Article 4). Indications of source are looked upon in the context of the specific provisions governing them and are defined, in conceptual terms, as geographical names referring to the source of a given typical product and to its characteristics in relation to production methods and human factors, even though, legally, the geographical area of production is not actually demarcated and defined (it can even be a very large area, indeed the whole of a country), and there is no rigid qualitative aspect: sometimes all that is required is a vague mention of the qualities of a product, that product being characterized by the reference to the geographical name and by what that name evokes; this is the approach adopted by case law.⁸

This other concept, which is broader than that devised for appellations of origin, retains the reference to an area of production involving natural or human factors (and therefore susceptible of use for both industrial and craft products), and does not rule out any mention of the notoriety of the product by reference to its origins, that being another facet of the same purpose of indicating that the product comes from a particular place; finally, we could point out that both concepts, the appellation of origin and the indication of source, as thus formulated, are

⁷ For Italy, see L. Sordelli "Denominazioni di origine e indicazioni di provenienza" in *Enciclopedia del Diritto*, Milan, vol. XII, 1954, p. 142, and, by the same author, "Denominazione di origine e indicazione di provenienza (diritto nazionale e comunitario)" in *Appendice del Novissimo Digesto Italiano*, Turin, vol. I, 1981, pp. 1050 *et seq.*, and "Denominazioni di origine e indicazioni di provenienza" in *Rivista del Diritto Industriale*, 1982, I, pp. 5 *et seq.*, especially p. 8.

⁸ Quoted by L. Sordelli, *op. cit.*, in *Rivista del Diritto Industriale*, 1982, I, p. 399.

⁶ See *La Propriété industrielle*, 1953, pp. 21 *et seq.*

of the same kind (even though the appellation of origin benefits from stronger protection), and that they can even overlap, as they are adaptable to a single typological grouping in which, by reversing the order, indications of source can be made to include also appellations of origin, thereby making it easier for the former to be assimilated by the various legal institutions, but without ruling out the fact that certain countries with uniform, detailed regulatory provisions may in addition be bound by conventions, agreements or treaties.

There is reason to wonder, therefore, how this diverse range of legal instruments and the concepts used in them can constitute a foundation on which to base a broader international system of provisions capable of accommodating countries with such differentiated systems; this was how a new phase of studies within WIPO began.⁹ The objective of the work of the WIPO Committee of Experts on the International Protection of Geographical Indications is to bring about the adoption of an even more general definition on the basis of the geographical indication notion, which embodies all the elements liable to be relevant in relation to a range of different aspects, and enables some of the obstacles and difficulties encountered by the international conventions and treaties now in force to be overcome. The picture can then be enlarged to include concepts already established in the industrial property field (but which have yet to be linked to the field being studied), such as distinctive signs—more often than not trademarks—appellations of origin, unfair competition, the prohibition of false or deceptive indications of source and indications adopted at a supranational level, including the wealth of provisions adopted by the European Communities in the vine and wine growing context, and the related provisions on the fair use of geographical names denoting the origin of certain foodstuffs or mineral waters in the presentation and labelling of the goods concerned.¹⁰

However, the establishment of such a framework presupposes the solution of a certain number of complex questions.

We shall confine ourselves here to mentioning the substantive principles, in other words the vested interests that have to be reconciled, in order to ascertain some of the minimum conditions that a regulatory system cannot ignore if it is to achieve its aim.

One first essential remark stems from the *truth principle*, which corresponds to the general condi-

tions to be laid down in the interest of all concerned, whether producers, intermediaries or consumers, and regardless of the manner in which the principle is to be implemented.

Another remark, which in my opinion is even more crucial, has to do with the *principle of consumer confidence*, as consumers associate the geographical name given to a product with a certain value, or at the very least with certain characteristics that they expect to find in the product.

The third remark derives from the *principle of belonging*, which we shall interpret here in the broad sense, as further evidence of the fact that the geographical name must not be used in a deceptive manner.

The specific implementation of the above principles prompts the following comments.

The discussion already centers on the matter of the definition of geographical indications. In fact it turns as much as anything on the question whether (as would seem logical) the geographical indication should have a certain qualitative meaning deriving from the confidence inspired by the geographical name in the minds of the public, who accordingly appreciate its value.

The common features and the differences between geographical trademarks and geographical indications lead one to make a distinction between the two concepts: the existence of a geographical trademark, when allowed, would not prevent the geographical indication from being used in the form of a common reference to a place, whereas it would seem that the owner of a pre-existing geographical trademark should not be in any way prejudiced by the subsequent recognition of the geographical indication in another country.

It seems to follow from the application of the truth principle that geographical indications should lend themselves to use that conforms to reality, and in addition that they should be protected against any use that might be construed as an act of unfair competition and be liable to mislead the public, for instance the use of a translation of the geographical indication or of a product designation or a way of presenting the product that might suggest or evoke a place different from the actual place of production.

Another aspect at issue which is of considerable importance at the international level is inherent in the reference to the country of origin of the name, either in connection with the original protection on which its international protection relies (as would seem natural), or in the sense of a value judgment and opinion of the consumer in the place of origin, from which the effectiveness in other countries of the meaning of the source may be determined. Moreover that is an equally valid way of settling the question (although the reply would appear to be negative) whether or not an indication may be considered a generic name when, in the country of

⁹ WIPO Committee of Experts on the International Protection of Geographical Indications, First Session, Geneva, May 28 to June 1, 1990, documents GEO/CE/1/2, entitled "The Need for a New Treaty and its Possible Contents," and GEO/CE/1/3, entitled "Report Adopted by the Committee of Experts."

¹⁰ Some examples are quoted by L. Sordelli, *op. cit.*, in *Rivista del Diritto Industriale*, 1982, I, pp. 19 *et. seq.*

origin, it relates to the value and the renown that the geographical name possesses by implication.

Another problem, which stems from the same references to consumer opinion, is that of the geographical name's gradual transformation into a generic name (or the generalization of the use of a geographical indication). It can happen that such a name subsequently becomes able once again to perform its function by becoming a geographical indication eligible for protection. This *de facto* situation can be settled by referring to customer reactions and to the forming of the opinion that the public has of the name concerned, by attributing a secondary

meaning to it or by reviving it;¹¹ in this case it is a question of determining generic character, which Article 4 of the Madrid Agreement leaves to be interpreted by the national courts, and which does indeed have to be left to the judgment of the court in the country of origin, as it is only in that country that those natural and human factors exist and are formed that are associated with the name which the public notices and to which it attaches value and renown.

¹¹ In this connection, see L. Sordelli, *Marchio e secondary meaning*, Milan, 1979, pp. 303 *et seq.*

Calendar of Meetings

WIPO Meetings

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

1991

March 11 to 15 (Geneva)

PCT Committee for Administrative and Legal Matters (Fourth Session, Second Part)

The Committee will continue to examine proposals for amending the Regulations under the Patent Cooperation Treaty (PCT), in particular in connection with the procedure under Chapter II of the PCT.

Invitations: Members of the Committee (States party to the PCT and the European Patent Office) and, as observers, States members of the Paris Union not members of the PCT Union and certain organizations.]

March 25 to 27
(Stanford University,
Stanford (California))

WIPO Worldwide Symposium on the Intellectual Property Aspects of Artificial Intelligence

The Symposium will examine the various categories of artificial intelligence ("artificial intelligence" is an expression commonly used to designate those kinds of computer systems that display certain capabilities associated with human intelligence, such as perception, understanding, learning, reasoning and problem-solving) and their main fields of application from the viewpoint of their possible intellectual property implications.

Invitations: The Symposium will be open to all. A registration fee of 150 US dollars will be payable. No registration fee will be required for participants designated by governments and invited organizations, or for faculty members and students designated by Stanford University.

April 8 to 11 (Geneva)

Committee of Experts on the Development of the Hague Agreement Concerning the International Deposit of Industrial Designs

The Committee will study possibilities of improving the system of international deposit of industrial designs under the Hague Agreement.

Invitations: States members of the Hague Union and, as observers, States members of the Paris Union not members of the Hague Union and certain organizations.

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.

May 21 to 27 (Madrid)

Working Group on the Application of the Madrid Protocol of 1989 (Third Session)

The Working Group will continue to study Regulations for the implementation of the Madrid Protocol.

Invitations: States members of the Madrid Union, States having signed or acceded to the Protocol, the European Communities and, as observers, other States members of the Paris Union expressing their interest in participating in the Working Group in such capacity and certain non-governmental organizations.

June 3 to 28 (The Hague)

Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as Far as Patents Are Concerned

The 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, the European Patent Organisation and the Organisation africaine de la propriété intellectuelle and, as observers, States members of WIPO not members of the Paris Union and certain organizations.

- June 19 to 21 (Paris)**
- Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations: Intergovernmental Committee (Ordinary Session)** (convened jointly with ILO and Unesco)
- The Committee will review the status of the international protection of neighboring rights under the Rome Convention.
- Invitations:* States members of the Intergovernmental Committee and, as observers, other States members of the United Nations 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.
- July 8 to 12 (Geneva)**
- PCT Assembly (Extraordinary Session)**
- The Assembly will hold an extraordinary session to adopt amendments to the Regulations under the Patent Cooperation Treaty.
- 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.
- September 2 to 6 (Geneva)**
- Committee of Experts on the Settlement of Intellectual Property Disputes Between States (Third Session)**
- The Committee will continue the preparations for a possible multilateral treaty.
- Invitations:* States members of the Paris Union, the Berne Union or WIPO or party to the Nairobi Treaty and, as observers, certain organizations.
- 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 session every two years in odd-numbered years. In the 1991 sessions, 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:* As members or observers (depending on the body), States members of WIPO or the Unions and, as observers, other States members of the United Nations and certain organizations.
- November 11 to 18 (Geneva)**
- Working Group on the Application of the Madrid Protocol of 1989 (Fourth Session)**
- The Working Group will continue to study Regulations for the implementation of the Madrid Protocol.
- Invitations:* States members of the Madrid Union, States having signed or acceded to the Protocol, the European Communities and, as observers, other States members of the Paris Union expressing their interest in participating in the Working Group in such capacity and certain non-governmental organizations.
- December 2 to 5 (Geneva)**
- Committee of Experts on the International Protection of Indications of Source and Appellations of Origin (Second Session)**
- The Committee will examine a preliminary draft of a treaty on the international protection of indications of source and appellations of origin.
- Invitations:* States members of the Paris Union and, as observers, 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.

- March 18 (Geneva)** **Consultative Committee (Forty-Third Session)**
The Committee will consider in particular the policy of UPOV in its relations with developing countries.
Invitations: Member States of UPOV.
- October 21 and 22 (Geneva)** **Administrative and Legal Committee**
Invitations: Member States of UPOV and, as observers, certain non-member States and inter-governmental organizations.
- October 23 (Geneva)** **Consultative Committee (Forty-Fourth Session)**
The Committee will prepare the twenty-fifth ordinary session of the Council.
Invitations: Member States of UPOV.
- October 24 and 25 (Geneva)** **Council (Twenty-Fifth Ordinary Session)**
The Council will examine the reports on the activities of UPOV in 1990 and the first part of 1991 and approve the program and budget for the 1992-93 biennium.
Invitations: Member States of UPOV and, as observers, certain non-member States and inter-governmental organizations.

Other Meetings Concerned with Industrial Property

1991

- May 29 (Paris)** **Compagnie Nationale des Conseils en Brevets d'invention: Conference** (organized within the framework of the celebrations to mark the bicentenary of the French patent) on the theme: "*La propriété industrielle dans le marché unique européen – Brevet et marque communautaires*"
- 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**

