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Editor's Note

AUSTRALIA

Patents Act 1990 (No. 83 of 1990, amended by the Industry, Technology and Commerce Legislation Amendment Act 1991 (No. 66 of 1991)) (*Replacement sheets*) .. Text 2-001

FINLAND

Patent Law (No. 550 of December 15, 1967, as last amended by Law No. 387 of May 10, 1985) (*This text replaces the one previously published under the same code number*) Text 2-001

(Continued overleaf)

WIPO 1991

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FRANCE

Law No. 90-1052 of November 26, 1990, Relating to Industrial Property (as amended by Law No. 91-7 of January 4, 1991, Relating to Trademarks and Service Marks) (*Extracts Concerning Persons Qualified with Respect to Industrial Property*) Text 1-004

Law No. 77-683 of June 30, 1977, on the Application of the Convention on the Grant of European Patents, done at Munich on October 5, 1973 (as amended and completed by Law No. 90-1052 of November 26, 1990, Concerning Industrial Property) (*This text replaces the one previously published under the same code number*) Text 2-003

Notifications Concerning Treaties

Paris Convention

Withdrawal of Declaration Concerning Article 28(1) of the Stockholm Act (1967)

CZECHOSLOVAKIA

The Government of Czechoslovakia has notified, in its notification received on June 11, 1991, the withdrawal of the declaration which, in 1970, it made concerning Article 28(1) of the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Stockholm on July 14, 1967.

Paris Notification No. 127, of June 14, 1991.

Budapest Treaty

Withdrawal of Assurances under Article 8(2)

IN VITRO INTERNATIONAL, INC. (IVI)
(United States of America)

The Director General of WIPO was informed by the following communication received on July 2, 1991, dated June 25, 1991, from the Government of the United States of America of the withdrawal of its declaration of assurances made under Article 7 of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure with respect to In Vitro International, Inc. (IVI), an international depository authority under that Treaty.

The Patent and Trademark Office has been informed by In Vitro International, Inc. (IVI), of

Linthicum, Maryland, in a letter dated May 24, 1991, that it can no longer continue to perform its functions as an international depository authority under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure. I am hereby notifying you that the United States withdraws its declaration of assurances made on behalf of IVI on September 9, 1983.

All deposits stored with IVI under the Budapest Treaty were transferred on June 20, 1991, to a substitute authority, which is the American Type Culture Collection (ATCC) of Rockville, Maryland. All mail or other communications addressed to IVI regarding those deposits, including all files and other relevant information, have also been transferred to ATCC. IVI has been requested to notify all depositors affected by the discontinuance of the performance of its functions and the transfers effected. We will monitor this notification and will encourage IVI fully to comply with its responsibilities.

In addition, we are in the process of informing all those who made deposits of biological samples with IVI, including patent owners and patent applicants, of IVI's discontinuance as an international depository authority and of the transfer of their deposits to ATCC. We are also publishing notices of the determination in the *Official Gazette* and the *Federal Register*.

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

Pursuant to Article 8(2)(b) of the Budapest Treaty and of Rule 4.2(c) of the Regulations under that Treaty, the status of In Vitro International, Inc. (IVI) as an international depository authority under the Budapest Treaty will terminate three months from the date of the said communication, that is, on September 25, 1991.

Budapest Communication No. 71 (this communication is the subject of Budapest Notification No. 99, of July 15, 1991).

WIPO Meetings

Madrid Union

Working Group on the Application of the Madrid Protocol of 1989

Third Session
(Madrid, May 21 to 27, 1991)

NOTE*

Introduction

The Working Group on the Application of the Madrid Protocol of 1989 (hereinafter referred to as "the Working Group") held its third session in Madrid from May 21 to 27, 1991.¹

The following States members of the Working Group were represented: Algeria, Austria, Belgium, Bulgaria, China, Cuba, Czechoslovakia, Democratic People's Republic of Korea, Denmark, Egypt, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Luxembourg, Monaco, Mongolia, Morocco, Netherlands, Poland, Portugal, Romania, Senegal, Soviet Union, Spain, Sudan, Sweden, Switzerland, United Kingdom, Viet Nam, Yugoslavia (34). In addition, the European Communities (EC), also a member of the Working Group, were also represented.

The following States, with observer status, were represented: Norway, Republic of Korea, United States of America (3). A representative of one inter-governmental organization and representatives of 18 non-governmental organizations also participated in an observer capacity. The list of participants follows this Note.

This session coincided with the centenary of the Madrid Agreement Concerning the International Registration of Marks, which was celebrated by an *Acto Solemne*, honored by their Majesties the King and the Queen of Spain.

In the present Note, all references to the Agreement are to the Madrid Agreement Concerning the International Registration of Marks (1967), and all references to the Protocol are to the Madrid Protocol (1989) relating to that Agreement, whereas all references to the draft Regulations or Rules are to the *draft* Regulations or Rules contained in document GT/PM/III/2, and all references to the *present* Regulations are to the Regulations under the Agreement (as in force since April 1, 1990).

Discussions on the Provisions of the Draft Regulations

In view of the fact that the Working Group had examined, at its second session in November 1990, a previous draft of Rules 1 to 13, it was agreed to start discussions with draft Rule 14.

Draft Rule 14: Time Limit for Refusal in Case of Oppositions After 18 Months

Draft Rule 14 of the draft Regulations as submitted by the International Bureau read as follows:

"(1) [Notification] Where a declaration has been made by a Contracting Party pursuant to Article 5(2)(b) and (c), first sentence, of the Protocol, the Office of such Contracting Party shall, where applicable, notify the International Bureau of the number, and the name of the holder, of the international registration in respect of which oppositions may be filed after the expiry of the 18-month time limit referred to in Article 5(2)(b) of the Protocol and, once known, of the date on which the opposition period ends.

* Prepared by the International Bureau.

¹ For the Note on the second session, see *Industrial Property*, 1991, p. 193.

(2) [Transmittal of Copies of Notifications] *The International Bureau shall transmit a copy of the notification received under paragraph (1) to the Office of origin and, at the same time, to the holder of the international registration concerned.*"

The portion of the report of the Working Group concerning the discussion of Rule 14 reads as follows:

"This Rule was approved as proposed."

Draft Rule 15: Notification and Recordal of Refusals

Draft Rule 15 of the draft Regulations as submitted by the International Bureau read as follows:

"(1) [Refusals] (a) The notification of refusal shall be signed and shall contain or indicate

- (i) the Office pronouncing the refusal,*
- (ii) the number of the international registration,*
- (iii) the name and address of the holder of the international registration,*
- (iv) the grounds on which the refusal is based and the corresponding essential provisions of the law,**
- (v) where the grounds on which the refusal is based refer to a prior mark with which the mark that is the subject of the international registration appears to be in conflict, the filing date, the priority date (if any), the registration date (if available), the name and address of the owner, and a reproduction, of that prior mark,*
- (vi) where the refusal is based on an opposition on a ground other than conflict with a prior mark, the name and address of the opponent,*
- (vii) if the refusal does not affect all the goods and services, those which are affected by the refusal,*

(viii) whether or not the refusal may be subject to review or appeal and, if so, the time limit for any request for review of, or appeal against, the refusal and the authority to which such request for review or appeal shall lie, with the indication, where applicable, that the request for review or the appeal has to be filed through the intermediary of a representative whose

* In practice, refusals are communicated by the Office concerned on a special form on which are printed all the provisions in the law applicable to that Office which could constitute a ground of refusal (the pertinent provisions being translated, where necessary, into the applicable working language). The ground or grounds applicable in a particular case are designated on the notification with a reference to the corresponding provision of the law that is reproduced on the form.

address is within the territory of the Contracting Party whose Office has pronounced the refusal,

(ix) the date on which the refusal was pronounced.

(b) The International Bureau shall record the refusal in the International Register, with an indication of the date on which the notification of refusal was sent to the International Bureau.

(2) [Confirmations or Withdrawals of Refusals] *(a) Where the notification of refusal under paragraph (1)(a) indicates that the refusal may be subject to review or appeal, the Office concerned shall promptly notify the International Bureau,*

(i) where the applicable time limit has expired without a request for review or an appeal having been lodged, of that fact,

(ii) where a request for review or an appeal has been lodged, of that fact and, once a decision is made in respect of the review or appeal, of the decision made.

(b) The International Bureau shall record the relevant facts and data in the International Register.

(3) [Transmittal of Copies of Notifications] *The International Bureau shall transmit copies of notifications received under paragraphs (1)(a) and (2)(a) to the Office of origin and, at the same time, to the holder."*

The portion of the report of the Working Group concerning the discussion of Rule 15 reads as follows:

"Paragraph (1)(a)(i) to (iv). These items were approved as proposed, subject to the addition, in the first line, after the word 'refusal,' of the following words: 'under Article 5(1) of the Agreement, under Article 5(1) of the Protocol or under both.'

Paragraph (1)(a)(v). This item was approved as proposed, with the understanding that the next draft should require that the notification include also the list of the goods and services for which the prior mark is registered (such list may be given in the language in which it is in the register in which the prior mark is registered). It was suggested that the International Bureau should examine whether, if the prior mark is internationally registered, such list could be omitted (since it can be easily found in the International Register) and whether the refusing Office should or could, among the goods or services appearing in the list, specify those which were relevant to the conflict.

Paragraph (1)(a)(vi) and (vii). These items were approved as proposed.

Paragraph (1)(a)(viii). After a discussion on the opportunity of providing for the obligation to

indicate the address of the authority to which the request for review or appeal lies, this item was approved as proposed, it being understood that the notification of refusal may contain the indication of such address at the option of the Office communicating the refusal.

Paragraph (1)(a)(ix). This item was approved as proposed.

Paragraph (1)(b). This paragraph was approved as proposed.

Paragraph (2)(a), first four lines. These lines were approved as proposed, subject to the replacement of the word 'promptly' by 'as soon as possible.'

Paragraph (2)(a)(i). This item was approved as proposed.

Paragraph (2)(a)(ii). It was decided that this item should make it clear that not only a decision rendered in respect of a review or appeal lodged by the holder, but also a decision rendered in respect of a review or appeal lodged by an opponent (because his opposition has been rejected) should be notified to the International Bureau.

Paragraph (2)(b). This paragraph was approved as proposed.

Paragraph (3). This paragraph was approved as proposed, subject to the understanding that the International Bureau would not send the copies of notifications to the Office of origin if that Office informed the International Bureau that it did not wish to receive such copies."

Draft Rule 16: Irregular Refusals

Draft Rule 16 of the draft Regulations as submitted by the International Bureau read as follows:

"(1) [International Registration Governed Exclusively by the Agreement] (a) In the case of an international registration governed exclusively by the Agreement, the notification of refusal shall not be regarded as such by the International Bureau

(i) if it is sent to the International Bureau after the expiration of one year from the date on which the notification of the designation of the Contracting Party concerned was sent by the International Bureau to the Office of that Contracting Party. In the case of notifications of refusal sent by post, the date of dispatch shall be determined by the postmark. If the postmark is illegible or missing, the International Bureau shall treat such notification as if it had been sent 20 days before the date of its receipt by the International Bureau,

(ii) if it does not identify the Office which pronounced the refusal,

(iii) if it is not signed on behalf of the said Office,

(iv) if it does not indicate the number of the international registration concerned,

(v) if it does not indicate any grounds for refusal,

(vi) where the notification of refusal indicates that a request for review or an appeal is possible, if it does not indicate the applicable time limit for lodging such a request or appeal.

(b) Where subparagraph (a) applies, the International Bureau shall nevertheless transmit a copy of the notification to the holder, shall inform, at the same time, the holder and the Office that sent the notification that the notification of refusal is not regarded as such by the International Bureau, and shall indicate the reasons therefor.

(c) If the notification of refusal does not contain

(i) where applicable, the details of a prior mark with which the mark that is the subject of the international application appears to be in conflict (Rule 15(1)(a)(v)),

(ii) where applicable, the name and address of the opponent (Rule 15(1)(a)(vi)),

(iii) where the refusal indicates that not all the goods and services are affected, the indication of those goods and services that are affected by the refusal (Rule 15(1)(a)(vii)),

(iv) where applicable, the indication of the authority to which a request for review or an appeal lies or the indication that the request for review or the appeal has to be filed through the intermediary of a representative whose address is within the territory of the Contracting Party whose Office has pronounced the refusal (Rule 15(1)(a)(viii)),

(v) the indication of the date on which the refusal was pronounced (Rule 15(1)(a)(ix)),

the International Bureau shall invite the Office which pronounced the refusal to rectify its notification within three months from the invitation. If the notification is not so rectified, it shall not be regarded as a notification of refusal by the International Bureau.

(2) [International Registration Governed Exclusively by the Protocol] Paragraph (1) shall also apply in the case of an international registration governed exclusively by the Protocol, it being understood that the time limit referred to in paragraph (1)(a)(i) shall be the time limit applicable under Article 5(2)(a), (b) or (c) of the Protocol.

(3) [International Registration Governed by Both the Agreement and the Protocol] Paragraph (1) shall equally apply in the case of an interna-

tional registration governed by both the Agreement and the Protocol, it being understood that, in respect of a designated Contracting Party bound by the Protocol but not by the Agreement, the time limit referred to in paragraph (1)(a)(i) shall be the time limit applicable under Article 5(2)(a), (b) or (c) of the Protocol."

The portion of the report of the Working Group concerning the discussion of Rule 16 reads as follows:

"Paragraph (1)(a). This paragraph was approved, subject to the modifications referred to in paragraphs below.

Paragraph (1)(a)(i). It was agreed that this item should make it clear that the date of the sending, by the International Bureau, of the notification of the designation and the date of recordal, by the International Bureau, of the designation, must be the same.

Paragraph (1)(a)(iv) and (vi). It was agreed that these items should be transferred to paragraph (1)(c).

Paragraph (1)(b). This paragraph was approved as proposed.

Paragraph (1)(c). This paragraph was approved, subject to the following two modifications: before item (i), a new item should be inserted, namely, 'the number of the international registration'; in item (iv), the words appearing after the word 'lies' (second line) should be deleted. Furthermore, it was decided that the International Bureau should consider adding a sentence at the end of this paragraph providing that, if the notification is so rectified, it shall be regarded as if it had been made on the date on which the imperfect notification was made, provided that the holder has a reasonable time limit for requesting a review or appeal.

Paragraphs (2) and (3). These paragraphs were approved as proposed."

Draft Rule 17: Notifications Concerning Ceasing of Effect of Basic Application or Basic Registration

Draft Rule 17 of the draft Regulations as submitted by the International Bureau read as follows:

"(1) [International Registration Governed Exclusively by the Agreement or by Both the Agreement and the Protocol] Where, in respect of an international registration governed exclusively by the Agreement, Article 6(3) of the Agreement applies or where, in respect of an international registration governed by both the Agreement and the Protocol, Article 6(3) of the Agreement and Article 6(3) of the Protocol apply, the Office of

origin shall notify the International Bureau accordingly and shall indicate

(i) the number of the international registration,

(ii) the name and address of the holder of the international registration,

(iii) the facts affecting the basic registration and the effective date of those facts,

(iv) where the said facts affect the international registration only in part, the said part.

(2) [International Registration Governed Exclusively by the Protocol] Paragraph (1) shall also apply where, in the case of an international registration governed exclusively by the Protocol, Article 6(3) of the Protocol applies, except that, if the international registration concerned is based on a basic application which has not become the subject of a registration in the country of origin, the facts that must be notified under paragraph (1)(iii) shall be those affecting the basic application.

(3) [Rectification of Notification] If the notification referred to in paragraph (1) or paragraph (2) does not comply with the requirements of whichever of those paragraphs applies, the International Bureau shall invite the Office of origin to rectify the notification within three months.

(4) [Recordal and Transmittal of the Notification] The International Bureau shall, provided that the notification referred to in paragraph (1) or paragraph (2) requests cancellation of the international registration and complies with the requirements of whichever of those paragraphs applies, cancel, to the extent applicable, the international registration in the International Register, and shall transmit a copy of the notification to the Offices concerned."

The portion of the report of the Working Group concerning the discussion of Rule 17 reads as follows:

"Paragraph (1). This paragraph was approved as proposed, subject to the possibility of referring, in items (iii) and (iv), not only to 'facts' but also to 'decisions.'

Paragraphs (2), (3) and (4). These paragraphs were approved as proposed."

Draft Rule 18: Notification and Recordal of Invalidation

Draft Rule 18 of the draft Regulations as submitted by the International Bureau read as follows:

"(1) [Contents of the Notification of Invalidation] Where Article 5(6) of the Agreement or

Article 5(6) of the Protocol applies and the invalidation is no longer subject to appeal, the Office of the Contracting Party whose competent authority has pronounced the invalidation shall notify the International Bureau accordingly. The notification shall contain or indicate

- (i) the authority which pronounced the invalidation,
- (ii) the number of the international registration which is the subject of the invalidation,
- (iii) the name and address of the holder of the international registration which is the subject of the invalidation,
- (iv) if the invalidation does not affect all the goods and services, those in respect of which the invalidation has been pronounced,
- (v) the grounds on which the invalidation is based; where the grounds refer to a prior mark with which the mark that is the subject of the international registration is in conflict, also the filing date, the priority date (if any), the registration date (if available), the name and address of the owner, and a reproduction, of that prior mark,
- (vi) the date on which the invalidation was pronounced.

(2) [Recordal of the Invalidation] *The International Bureau shall record the invalidation in the International Register, together with the data contained in the notification of invalidation.*

The portion of the report of the Working Group concerning the discussion of Rule 18 reads as follows:

“It was decided that a new item be added in paragraph (1) requiring that the notification indicate that the invalidation is no longer subject to appeal. It was also decided to delete item (v) in paragraph (1). Otherwise, the Rule was approved as proposed.”

Draft Rule 19: Recordal of Decisions Restricting the Rights of the Holder

Draft Rule 19 of the draft Regulations as submitted by the International Bureau read as follows:

(1) [Notification of Decision] (a) *Where a judicial or administrative decision that is no longer subject to appeal has the effect of restricting, because of bankruptcy or similar reasons, the holder's rights in respect of an international registration in the territory of a Contracting Party, the Office of that Contracting Party may notify the International Bureau of this fact. The notification shall indicate*

- (i) the authority which made the decision,
 - (ii) the number of the international registration concerned,
 - (iii) the name and address of the holder of the international registration concerned.
- (b) *The notification shall be accompanied by*
- (i) a copy of the decision,
 - (ii) a summary of the decision, in the applicable working language, prepared by the Office transmitting the notification.

(2) [Recordal] *The International Bureau shall record the decision in the International Register, together with*

- (i) an indication of the authority which made the decision,
- (ii) the summary of the decision prepared by the Office transmitting the notification.”

The portion of the report of the Working Group concerning the discussion of Rule 19 reads as follows:

“It was decided that this Rule should consist of only the following: ‘Where a judicial or administrative decision that is no longer subject to appeal has the effect of restricting the holder's right of disposal of an international registration in the territory of a Contracting Party and the Office of that Contracting Party informs the International Bureau accordingly, the International Bureau shall record that information in the International Register.’”

Draft Rule 20: Designation Subsequent to the International Registration

Draft Rule 20 of the draft Regulations as submitted by the International Bureau read as follows:

(1) [Official Form] *A designation made subsequently to the international registration shall be presented on an official form to the International Bureau by the holder or by the Office of origin. It shall be signed by the holder, even where it is presented by the Office of origin, and shall indicate the date on which it was so signed.*

- (2) [Contents] (a) *The designation referred to in paragraph (1) shall indicate*
- (i) the number of the international registration concerned,
 - (ii) the name and address of the holder of the international registration,
 - (iii) the designated Contracting Party, with an indication of the goods and services covered by the international registration that are also covered by the designation,

(iv) the amount of the fees paid, the method of payment and the identification of the party effecting the payment.

(b) Where the designation concerns a Contracting Party that has made a notification under Rule 6(1), it shall contain a declaration of bona fide intent to use the mark in the territory of that Contracting Party, signed by the holder and not by a representative. Such declaration may be annexed to the designation.

(c) Where the designation concerns a Contracting Party that has made a notification under Rule 6(2), it shall contain a translation, into the language of the international application, of any word that constitutes or is contained in the mark and that has a meaning in a language other than English or French, unless already furnished under Rule 8(4)(xiii) or (6)(vi).

(3) [Designation of a Contracting Party Previously Designated] Where the holder designates a Contracting Party which has been previously designated without subsequent cancellation of the previous designation, the International Bureau shall notify the holder that it shall process the designation only once the previous designation has been cancelled. The designation shall be considered to have been received by the International Bureau on the date of cancellation of the previous designation.

(4) [Applicable Provisions] Rules 9, 13 and 14 to 19 shall apply mutatis mutandis."

The portion of the report of the Working Group concerning the discussion of Rule 20 reads as follows:

"Paragraph (1), first sentence. This sentence was provisionally approved, subject to the examination, by the International Bureau, of the following questions: Should it be possible to file a subsequent designation through the Office of origin even if the effects of the basic application or the basic registration no longer exist after the expiration of the five-year period provided for in Article 6(3) of the Agreement and Article 6(3) of the Protocol? Should the Office of origin have any role in respect of subsequent designations?

Paragraph (1), second sentence. After a detailed discussion of the question relevant also in respect of Rule 8(2) concerning the signature of the subsequent designation, the Director General said that the next draft would provide that the signature of the holder or his representative would not be required where the designation is signed by the Office of origin, provided that where a declaration of intent to use is attached to the designation that declaration would have to be signed by the holder (not by the Office and not by a representative).

Paragraph (2)(a). This paragraph was approved as proposed.

Paragraph (2)(b). Since this paragraph refers to Rule 6(1), the said Rule was also considered, as well as Rule 8(6)(v), which corresponds to Rule 20(2)(b).

The Delegation of the European Communities voiced doubts at the idea of a Contracting Party being able to require, at the time of filing of the international application, a declaration of *bona fide* intention to use the mark, as laid down in Rule 6(1). The Delegation was inclined to think that such a requirement would act as an obstacle to the international protection of marks and would be incompatible with the system laid down in the Protocol, which made no provision for the possibility of declarations to such effect. The Delegation, however, stated that it would not oppose discussions of this general problem within the Working Group and would listen with interest to any arguments that might be put forward by other delegations.

Some delegations, including delegations of Member States of the European Communities, expressed doubts as to the compatibility of Rules 6(1), 8(6)(v) and 20(2)(b) with the Protocol. In their opinion, such provisions should not be included in the Regulations but should have been included in the Protocol itself. Furthermore, they expressed the view that, if Rules 6(1), 8(6)(v) and 20(2)(b) were adopted as proposed, it should be made clear that they could apply only to Contracting Parties that at present provided for the requirement of a declaration of intent to use.

Other delegations, including delegations of Member States of the European Communities, expressed the view that the adoption of the Rules referred to was desirable and within the competence of the Madrid Union Assembly and that their application should not be restricted to the currently existing law in the Contracting Parties to the Agreement and the Protocol.

The Delegation of the United States of America explained that the requirement of a declaration, to be signed by the applicant, of his *bona fide* intention to use the mark in commerce had been introduced as a fundamental change in the 1988 revision of the trademark law of the United States of America. Following that revision, applicants now had a choice between filing an application invoking actual use of the mark and filing an application invoking an intention to use; for the latter case, the declaration of intention to use was a filing date requirement; if the International Bureau would not check the fulfillment of this requirement under the Protocol and transmit applications and subsequent designations to the United States Patent and Trademark Office without the declaration of intention to use, that

Office would have to refuse the effect of an international registration or subsequent designation, and if the applicant or holder would then comply with the requirement, his filing date would be a later date, and he would have to pay again the designation fee.

The representatives of trademark owners and trademark agents underlined their strong interest in being able to use the Protocol for obtaining protection in the United States of America. The formality of filing, under the Protocol, a declaration of *bona fide* intent to use (when the United States of America is designated), which had to be complied with in any case under the law of the United States of America, would constitute a minor burden, which by far would be outweighed by the advantage of being able to use the Protocol with respect to the United States of America.

It was agreed that the International Bureau would supply, together with the next draft of the Regulations, information on the relevant provisions of the law of the United States of America (including, in particular, the question of whether the signature of the applicant could be replaced by the signature of a representative). The next draft would provide that the declaration of intent to use must be an annex (a separate document) to the application or subsequent designation, that is, the declaration could not be part of the application or designation form. The International Bureau should also study whether such an annex could allege actual, rather than merely intended, use in the United States of America.

Paragraph (2)(c). This paragraph, as well as Rules 6(2) and 8(6)(vi), were withdrawn by the Director General. He said, and it was noted, that, in the next draft, Rule 8(4)(xiii) would read as follows: 'where the mark consists of or contains a word that may be translated into English or French, and the applicant wishes to give a translation of that word into the language of the international application, such a translation.'

Paragraph (3). It was noted that this paragraph was withdrawn by the Director General.

Paragraph (4). It was agreed that this paragraph would be examined in connection with the examination of Rules 9 and 13."

Draft Rule 21: Request for Recordal of a Change

Draft Rule 21 of the draft Regulations as submitted by the International Bureau read as follows:

"(1) [Presentation of the Request] A request for the recordal of a change concerning an international registration, such as a change in the ownership of the international registration in

respect of all or some of the goods and services or all or some of the Contracting Parties, cancellation of the international registration in respect of all or some of the goods and services or all or some of the Contracting Parties, or changes in the name or address of the holder or representative, shall be presented on an official form to the International Bureau by the holder or by an interested Office.

(2) [Contents of the Request] The request for the recordal of a change shall, in addition to the requested change, indicate

(i) the number of the international registration concerned,

(ii) the name and address of the holder of the international registration,

(iii) the amount of the fees paid, the method of payment and the identification of the party effecting the payment."

The portion of the report of the Working Group concerning the discussion of Rule 21 reads as follows:

"Paragraph (1). It was decided that the International Bureau should prepare a revised draft which would, in respect of the question whether the recordal of a change may or must be requested by the holder or by the interested Office, differentiate between the situations which are governed by the Agreement, the Protocol or both, including the possibility of the International Bureau refusing the recordal of the change where the recordal is requested by the holder (rather than the interested Office) and the situation is governed by the Agreement.

Paragraph (2). This paragraph was approved as proposed."

Draft Rule 22: Irregularities in Requests for Recordal of Changes

Draft Rule 22 of the draft Regulations as submitted by the International Bureau read as follows:

"(1) [Irregular Request] If the request for the recordal of a change does not comply with the applicable requirements, the International Bureau shall notify that fact to the party (holder or Office) that presented the request.

(2) [Time Allowed to Remedy Irregularity] If the irregularity is not remedied within three months from the date of the notification of the irregularity by the International Bureau, the request shall be considered abandoned and any fees already paid shall be reimbursed."

The portion of the report of the Working Group concerning the discussion of Rule 22 reads as follows:

“This Rule was approved as proposed. The Delegation of Germany reserved its position on the three-month period in Rule 22(2).”

Draft Rule 23: Recordal and Notification of Changes

Draft Rule 23 of the draft Regulations as submitted by the International Bureau read as follows:

“(1) [Recordal and Notification of a Change] *The International Bureau shall, provided that the request for the recordal of a change is in order, promptly record the change in the International Register and shall notify accordingly and at the same time the holder and the Office concerned.*

(2) [Recordal of Partial Change in Ownership] *Where the change consists of a transfer of the international registration in respect of some only of the goods and services or some only of the Contracting Parties, the change shall be recorded under the international registration of the transferor. In addition, the transferred part shall be recorded as a separate international registration of the transferee; that registration shall bear the same number as the international registration of the transferor, together with a capital letter.*

(3) [Recordal of Merger of International Registrations] *Where the same person becomes the holder of both international registrations referred to in paragraph (2), the two registrations shall be merged on the request of the said person and paragraph (1) and Rules 21 and 22 shall apply mutatis mutandis.”*

The portion of the report of the Working Group concerning the discussion of Rule 23 reads as follows:

“*Paragraph (1)*. This paragraph was approved as proposed, subject to the replacement of the word ‘Office,’ appearing in the fourth line, by the word ‘Offices’ and the introduction of a provision regarding the date on which the recordal becomes effective as contained in Rule 22(1) of the present Regulations.

Paragraph (2). This paragraph was approved, subject to a reexamination of the terminology used, taking into account the drafting of Rule 22(2) of the present Regulations and the relevant provisions of the Agreement and the Protocol. In any case, the word ‘*mais*’ in the eighth line of the French version is to be deleted.

Paragraph (3). This paragraph was approved as proposed.”

Draft Rule 24: Corrections in the International Register

Draft Rule 24 of the draft Regulations as submitted by the International Bureau read as follows:

“(1) [Correction] *Where the International Bureau, acting ex officio or at the request of the holder or of an interested Office, considers that there is an error concerning an international registration in the International Register, it shall modify the Register accordingly.*

(2) [Notification] *The International Bureau shall notify the holder and, at the same time, the Offices concerned of the correction.*

(3) [Refusal of Effects of Correction] *The Office of any Contracting Party concerned may refuse, as far as it is concerned, the effects of a correction notified to it by the International Bureau. Article 5 of the Agreement or Article 5 of the Protocol shall apply mutatis mutandis, it being understood that the date of notification of the correction to the Offices concerned shall be the date from which is counted the time limit for pronouncing a refusal.*

[(4) [Preservation of Rights of Third Parties] *Any correction made in the International Register concerning an international registration shall not affect the rights of any third party who has relied in good faith on that registration before the said correction was effected.]”*

The portion of the report of the Working Group concerning the discussion of Rule 24 reads as follows:

“*Paragraphs (1) and (2)*. These paragraphs were approved as proposed.

Paragraph (3). This paragraph was approved as proposed, subject to examination by the International Bureau of the question whether, instead of simply referring to Article 5 of the Agreement and Article 5 of the Protocol, it would not be preferable to repeat those Articles in this paragraph.

Paragraph (4). This paragraph was deleted.”

Draft Rule 25: Unofficial Notice of Expiration

Draft Rule 25 of the draft Regulations as submitted by the International Bureau read as follows:

“The unofficial notice of expiration according to Article 7(4) of the Agreement and Article 7(3) of the Protocol shall include an indication of the designated Contracting Parties at the date of the notice. Where, at the said date, the international registration shows that a refusal or an invalidation is recorded in respect of a designated Contracting Party, this fact shall be indicated in the said notice.”

The portion of the report of the Working Group concerning the discussion of Rule 25 reads as follows:

“This Rule was approved, subject to the insertion of the relevant contents of Article 7(4) of the Agreement and Article 7(4) of the Protocol into the text of the Rule and to the clarification that the second sentence also applied to the case of a partial refusal or a partial invalidation.”

Draft Rule 26: Fees Concerning Renewal

Draft Rule 26 of the draft Regulations as submitted by the International Bureau read as follows:

“(1) [International Registration Governed Exclusively by the Agreement] In the case of an international registration governed exclusively by the Agreement, the fees required for renewal are the basic fee, the complementary fee and, where applicable, the supplementary fee and the surcharge, specified in item 5 of the Schedule of Fees.

(2) [International Registration Governed Exclusively by the Protocol] In the case of an international registration governed exclusively by the Protocol, the fees required for renewal are, subject to paragraph (4), the basic fee, the complementary fee and, where applicable, the supplementary fee and the surcharge, specified in item 6 of the Schedule of Fees.

(3) [International Registration Governed by Both the Agreement and the Protocol] In the case of an international registration governed by both the Agreement and the Protocol, the fees required for renewal shall be paid for 10 years; subject to paragraph (4), those fees are the basic fee, the complementary fee and, where applicable, the supplementary fee and the surcharge, specified in item 7 of the Schedule of Fees.

(4) [Individual Fee] In respect of a Contracting Party having made a declaration under Article 8(7)(a) of the Protocol and for which renewal is made under paragraph (2) or (3), the complementary fee shall be replaced by

the individual fee specified in items 6.4 and 7.4 of the Schedule of Fees, except where such Contracting Party is a State party to both the Agreement and the Protocol and the Office of origin is the Office of a State bound by both the Agreement and the Protocol. Where only Contracting Parties which have made a declaration under Article 8(7)(a) of the Protocol are concerned by the renewal, no supplementary fee shall be payable.

(5) [Surcharge] Where the period of grace of six months provided for in Article 7(5) of the Agreement or in Article 7(4) of the Protocol is made use of, the surcharge specified in items 5.4, 6.5 or 7.5, as the case may be, of the Schedule of Fees shall be payable.

(6) [Time Limit for Payment] The fees referred to in paragraphs (1) to (4) shall be paid, at the latest, on the date on which the renewal of the international registration is due, except where the surcharge referred to in paragraph (5) is payable, in which case both the surcharge and the required fees shall be paid within six months from the date on which the renewal of the international registration was due.

(7) [Insufficient Fee] (a) If the amount of the fee received is less than the amount required, the International Bureau shall promptly notify at the same time both the holder and the representative, if any, accordingly.

(b) If the amount of the fee received is, at the expiration of the time limit under paragraph (6), less than the amount required, the International Bureau shall not record the renewal and shall reimburse the amount received to the party having paid it.

(8) [Renewal for Less Than All the Designated Contracting Parties] The fact that the renewal is not effected in respect of all the Contracting Parties covered by the international registration at the time of the renewal shall not be considered to constitute a change for the purposes of Article 7(2) of the Agreement or Article 7(2) of the Protocol.”

The portion of the report of the Working Group concerning the discussion of Rule 26 reads as follows:

“Paragraphs (1) to (5). These paragraphs were adopted as proposed, subject to a possible transfer of Rule 26 to another part of the Regulations and to the addition of a similar Rule dealing with the fees to be paid for each of the three kinds of international applications.

Paragraph (6). This paragraph was adopted as proposed, on the understanding that a time limit

should be provided for, before which the fees required for renewal could not be validly paid. It should be examined whether such time limit should be one year (as provided for in present Rule 25(2)), or, for example, six months.

Paragraphs (7) and (8). These paragraphs were approved as proposed.”

Draft Rule 27: Recordal of the Renewal, Notification and Certificate

Draft Rule 27 of the draft Regulations as submitted by the International Bureau read as follows:

“(1) [Effective Date of the Renewal] *Renewal shall be recorded in the International Register with the date on which renewal was due, even if renewal is effected within the period of grace referred to in Article 7(5) of the Agreement and in Article 7(4) of the Protocol.*

(2) [Contracting Parties Not Covered by the Renewal] *Where the renewal is not effected for any Contracting Party that was covered by the international registration at the time of the renewal, the indication of that Contracting Party shall be cancelled in the International Register.*

(3) [Notification and Certificate] *The International Bureau shall notify the Contracting Parties concerned of the renewal and shall send a certificate to the holder.”*

The portion of the report of the Working Group concerning the discussion of Rule 27 reads as follows:

“This Rule was approved as proposed.”

Draft Rule 28: Gazette

Draft Rule 28 of the draft Regulations as submitted by the International Bureau read as follows:

“(1) [Information Concerning International Registrations] *The International Bureau shall publish in the Gazette relevant data recorded since the last preceding issue of the Gazette in the International Register concerning international registrations, notifications under Rule 14(1), refusals (without the grounds for refusal, however), renewals (together with information on the status of any refusal or invalidation), designations subsequent to the international registration, changes, cancellations, corrections, invalidations and summaries of judicial or administrative decisions under Rule 19. Where color is claimed and the reproduction of the mark is in black and*

white in the basic application or the basic registration, the Gazette shall contain reproductions of the mark both in black and white and in color. The Gazette shall also publish the numbers of international registrations which have not been renewed.

(2) [Information Concerning Particular Requirements and Certain Declarations of Contracting Parties, and Other General Information] *The International Bureau shall publish in each issue of the Gazette*

(i) *any notifications made under Rule 6,*
(ii) *any declarations made under Article 5(2)(b) and (c), first sentence, of the Protocol,*
(iii) *a list of the days on which the International Bureau is not open to the public during the current and the following calendar year and such a list for each Office from which a communication under Rule 4(4) has been received.*

(3) [Yearly Index] *In respect of every year, the International Bureau shall publish an index indicating, in alphabetical order, the names of the holders of the international registrations concerning which one or more entries was published in that year in the Gazette. The name of the holder shall be accompanied by the number of the international registration, the page number of the Gazette issue in which the entry affecting the international registration was published and the indication of the nature of the entry (registration, renewal, refusal, invalidation, cancellation, change).*

(4) [Number of Copies for Offices of Contracting Parties] *The International Bureau shall send each Office copies of the Gazette in its paper, microfiche or CD-ROM (Compact Disc Read Only Memory) form. The number of copies in whatever form to which each Office is entitled free of charge or at half of the subscription price depends on the number of the contribution class units of its country under the Paris Convention for the Protection of Industrial Property: if the number of the contribution class units is less than one, the number of free copies shall be one; if it is one or more than one, it shall be two for each unit. The number of copies available for half price shall be the same as the number of copies free of charge. Any Contracting Organization shall be considered to belong to contribution Class I (one) under the Paris Convention for the Protection of Industrial Property.”*

The portion of the report of the Working Group concerning the discussion of Rule 28 reads as follows:

“Paragraph (1). This paragraph was approved as proposed, subject to the reservations made by

some delegations, which were of the opinion that the publication of the mark, both in black and white and in color, in the case mentioned in the penultimate sentence, could cause confusion.

The Director General said that in the entry of the Gazette announcing a change concerning a given international registration the class or classes of the International Classification referred to in that registration would also be indicated.

Paragraph (2). This paragraph was adopted as proposed.

Paragraph (3). This paragraph was adopted as proposed.

Paragraph (4). The International Bureau was requested to propose new criteria for the fixing of the number of copies of the Gazette to be furnished free of charge to the Offices of the Contracting Parties, such as the number of designations received under the Agreement and the Protocol during the preceding year.”

Draft Rule 29: Electronic Data Base

Draft Rule 29 of the draft Regulations as submitted by the International Bureau read as follows:

“(1) [Maintenance of Electronic Data Base] *The International Bureau shall maintain an electronic data base.*

(2) [Data Recorded in the International Register] *All the data recorded in the International Register shall be entered in the electronic data base.*

(3) [Data Concerning Pending International Applications and Subsequent Designations] *If an international application or a designation under Rule 20 is not recorded in the International Register within three working days following the receipt by the International Bureau of the international application or the designation under Rule 20, the International Bureau shall enter, under a provisional number, in the electronic data base, notwithstanding any irregularities that may exist in the international application or designation as received, all the data contained in the international application or designation.*

(4) [Public Access to Electronic Data Base] *The electronic data base shall be made accessible to the public, against payment of the prescribed fee, by on-line access and through other appropriate means determined by the International Bureau. Data entered under paragraph (3) shall be accompanied by a warning to the effect that the International Bureau has not yet made a decision on the international application or the request for recording of the designation.”*

The portion of the report of the Working Group concerning the discussion of Rule 29 reads as follows:

“*Paragraph (1).* This paragraph was approved. One delegation suggested that the adjective ‘electronic’ was superfluous.

Paragraphs (2) and (3). These paragraphs were approved as proposed.

Paragraph (4). This paragraph was approved, subject to the addition of a provision according to which the Offices of Contracting Parties would not have to pay a fee to the International Bureau for accessing the latter’s data base (the cost of telecommunication being, however, at the charge of the said Offices).”

Draft Rule 30: Payment of Fees

Draft Rule 30 of the draft Regulations as submitted by the International Bureau read as follows:

“(1) [Modalities of Payment] *The fees indicated in the Schedule of Fees may be paid*

(i) *by debit to a current account with the International Bureau,*

(ii) *by payment into the Swiss postal cheque account or to any of the specified bank accounts of the International Bureau,*

(iii) *by a banker’s cheque,*

(iv) *by payment in cash at the International Bureau.*

(2) [Indications Accompanying the Payment] *At the time of the payment of a fee, an indication must be given,*

(i) *before international registration, of the name of the applicant, the mark concerned and the purpose of the payment,*

(ii) *after international registration, of the name of the holder, the number of the international registration concerned and the purpose of the payment,*

(iii) *in the case of any renewal which relates to less than all the Contracting Parties that were covered by the international registration at the time of the renewal, of the Contracting Parties to which the renewal should extend.*

(3) [Date of Payment] (a) *Subject to subparagraph (b), any fee shall be considered to have been paid on the date on which the International Bureau receives the required amount.*

(b) *Where the required amount is available in an account opened with the International Bureau, the fee shall be considered to have been paid,*

(i) *in case the owner of the account has given a general authorization to the International*

Bureau to debit his account whenever action by the International Bureau in respect of an international application or an international registration concerning the said owner is to be effected, at the time such action is requested or becomes due,

(ii) in case the owner of the account has not given a general authorization according to item (i), on the day on which the International Bureau receives the owner's specific instruction to debit the fee required for the action requested.

(4) [Change in the Amount of the Fees] (a) Where the amount of the fees payable in respect of the filing of an international application is changed between, on the one hand, the date of the receipt, by the Office of origin, of the request to file an international application and, on the other hand, the international registration date, the fee that was valid at the first date shall be applicable.

(b) Where the amount of the fees payable in respect of the renewal of an international registration is changed between the date of payment and the due date of the renewal, the fee that was valid at the date of payment shall be applicable, provided that that date is not earlier by more than one month than the due date.

(c) Where the amount of any fee other than the fees referred to in paragraphs (a) and (b) is changed, the amount valid at the date on which the fee was received by the International Bureau shall be applicable."

The portion of the report of the Working Group concerning the discussion of Rule 30 reads as follows:

"Paragraphs (1) and (2). These paragraphs were approved as proposed.

Paragraph (3). This paragraph was approved, subject to the replacement of subparagraph (b) by the following text: 'Where the required amount is available in an account opened with the International Bureau, the fee shall be considered to have been paid on the day on which the International Bureau receives the holder's instruction to debit the fee required for the action requested.'

Paragraph (4). This paragraph was approved, it being understood that the time limit provided for in subparagraph (b) had to be harmonized with the time limit to be included in Rule 26(6) (see paragraph 59, above)."

Draft Rule 31: Currency of Payments

Draft Rule 31 of the draft Regulations as submitted by the International Bureau read as follows:

"(1) [Obligation to Use Swiss Currency] All payments due under these Regulations shall be made in Swiss currency.

(2) [Establishment of the Amount of Individual Fees in Swiss Currency] (a) Where a Contracting Party makes a declaration under Article 8(7)(a) of the Protocol that it wants to receive an individual fee, the amount of the individual fee shall be indicated in the currency in which are fixed the fees payable to the Office of the said Contracting Party.

(b) Where the fee is indicated in the declaration in a currency other than Swiss currency, the Director General shall, after consultation with the Office of the Contracting Party concerned, establish the amount of the individual fee in Swiss currency on the basis of the official exchange rate of the United Nations.

(c) Where, for more than 30 consecutive days, the official exchange rate of the United Nations between Swiss currency and the other currency in which the amount of an individual fee has been indicated by a Contracting Party is higher or lower by at least 5% than the last exchange rate applied to establish the amount of the individual fee in Swiss currency, the Office of that Contracting Party may ask the Director General to establish a new amount of the individual fee in Swiss currency according to the official exchange rate of the United Nations prevailing on the day preceding the day on which the request is made. The Director General shall proceed accordingly. The new amount shall become applicable as from a date which shall be fixed by the Director General, provided that such date is between one and two months after the date of the publication of the said amount in the Gazette.

(d) Where, for more than 30 consecutive days, the official exchange rate of the United Nations between Swiss currency and the other currency in which the amount of an individual fee has been indicated by a Contracting Party is higher or lower by at least 10% than the last exchange rate applied to establish the amount of the individual fee in Swiss currency, the Director General shall, after consultation with the Office of that Contracting Party, establish a new amount of the individual fee in Swiss currency according to the official exchange rate of the United Nations prevailing on the day preceding the day on which the consultation is initiated by the Director General. The new amount shall become applicable as from a date which shall be fixed by the Director General, provided that such date is between one and two months after the date of the publication of the said amount in the Gazette."

The portion of the report of the Working Group concerning the discussion of Rule 31 reads as follows:

“This Rule was approved, subject to including, at the beginning of paragraph (2)(c), the words ‘Subject to subparagraph (d),’.”

Draft Rule 32: Exemption from Fees

Draft Rule 32 of the draft Regulations as submitted by the International Bureau read as follows:

“Recordal of the following shall be exempt from fees:

(i) the total cancellation of the international registration,

(ii) the renunciation of protection in respect of a Contracting Party,

(iii) the limitation of the list of goods and services in respect of a Contracting Party if effected in the international application itself,

(iv) the limitation of the list of goods and services requested by an Office in accordance with Article 6(4), first sentence, of the Agreement or Article 6(4), first sentence, of the Protocol,

(v) the existence of a judicial proceeding or of a final judgment affecting the basic application or the basic registration,

(vi) a final refusal or a notification under Rule 15(2),

(vii) the invalidation of an international registration,

(viii) a decision, notified under Rule 19, restricting the holder's rights in respect of an international registration,

(ix) a correction in the International Register.”

The portion of the report of the Working Group concerning the discussion of Rule 32 reads as follows:

“It was decided to request the International Bureau to furnish information on the yearly amounts collected by it on account of the different fees; in the light of such information, it might be decided that certain services should be free of charge, or that the equivalent of the amounts of the corresponding fees be covered by a corresponding increase of the basic fees since the reduction of the number of the different kinds of fees was desirable, the more so as the monitoring of small fees may cost more than the value of those fees. In any case, the recordal of a representative, when appointed in the international application, in a later designation, in a request for recording a transfer or in connection with a

renewal, as well as the recordal of the cancellation of an appointment, should be free of charge.”

Draft Rules 33 to 36, Annex; Rules 1 to 13

The portion of the report of the Working Group concerning draft Rules 33 to 36, Annex and Rules 1 to 13 reads as follows:

“Due to lack of time, these Rules and the Annex were not considered in this session of the Working Group. However, a number of observations were made in respect of those texts, which will be considered by the International Bureau when it prepares the next draft of the Regulations, to be considered by the Working Group at its fourth session, scheduled to take place in Geneva from November 11 to 18, 1991.”

LIST OF PARTICIPANTS**

I. Members

Algeria: A. Hasnadi; F. Bouzid. **Austria:** O. Rafeiner; G. Mayer-Dolliner. **Belgium:** W.J.S. Peeters. **Bulgaria:** T. Petkova. **China:** Liu Peizhi; Wu Qun. **Cuba:** M. Azcuy Quesada. **Czechoslovakia:** L. Jakl; V. Zamrzla; J. Marešová. **Democratic People's Republic of Korea:** Hyon Chun Hwa; Hwang Myong Hi. **Denmark:** J.E. Carstad; B. Kromann. **Egypt:** A.G.M. Fouad. **Finland:** S.-L. Lahtinen. **France:** J.-C. Combaldieu; B. Vidaud; C. Girard. **Germany:** A. von Mühlendahl; E. Schäfer; M. Bühring. **Greece:** P. Geroulakos. **Hungary:** I. Iványi; G. Vékás; L. Tattay. **Ireland:** S. Fitzpatrick; H.A. Hayden. **Italy:** M.G. Del Gallo Rossoni; P. Iannantuono; I. Nicotra; S. Paparo. **Luxembourg:** F. Schlessler; E.L. Simon. **Monaco:** J.-P. Campana; J. L'Herbon de Lussats. **Mongolia:** D. Zolboot. **Morocco:** H. Abbar. **Netherlands:** H.R. Furstner; D. Verschure. **Poland:** W. Kotarba; B. Rokicki. **Portugal:** J. Mota Maia; R.A. Costa de Morais Serrão; M.J. Pinto Coelho; J.M. Freire de Sousa. **Romania:** A.C. Strenc; D. Pitzu; C. Moraru. **Senegal:** D. Sagna. **Soviet Union:** E.G. Koutakova. **Spain:** J. Delicado Montero-Ríos; A. Casado Cerviño; C. Muñoz Caparrós; M.T. Yeste; T. de las Heras Lorenzo; J.L. Barbero Checa. **Sudan:** A.R. Elkhalfifa. **Sweden:** K. Sundström. **Switzerland:** J.-D. Pasche. **United Kingdom:** P. Hartnack; M. Todd; M. Knight. **Viet Nam:** Phuong Doan. **Yugoslavia:** T. Lisavac. **European Communities (EC):** O. Montalto; E. Nooteboom; H.W. Kunhardt.

II. Observer States

Norway: E.S. Helgesen. **Republic of Korea:** L. Seong Tae; R. Tae Keun. **United States of America:** J.M. Samuels; R.G. Bowie; L. Beresford.

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

III. Intergovernmental Organization

Benelux Trademark Office (BBM): L. van Bauwel.

IV. Non-Governmental Organizations

Benelux Association of Trademark and Design Agents (BMM): F. Gevers. *Chambre des spécialistes en marques et modèles*, France (CSMM): E. Glorian. Chartered Institute of Patent Agents, United Kingdom (CIPA): A.C. Serjeant. Committee of National Institutes of Patent Agents (CNIPA): A. Hansmann. European Association of Industries of Branded Products (AIM): G.F. Kunze. European Communities Trade Mark Practitioners' Association (ECTA): F. Gevers. Federal Chamber of Patent Attorneys, Germany (FCPA): A. Hansmann. Federation of German Industry (BDI): D. Füllkrug. French Association of Practitioners in Trademark and Design Law, France (APRAM): R. Baudin. Institute of Trade Mark Agents, United Kingdom (ITMA): J.A. Slater. International Association for the Protection of Industrial Property (AIPPI): M.W. Metz; D.H. Tatham. International Chamber of Commerce (ICC): A.L. de Sampaio. International Federation of Industrial Property Attorneys (FICPI): A.L. de Sampaio; A. Hansmann. The United States

Trademark Association (USTA): Y. Chicoine. Trade Marks, Patents and Designs Federation, United Kingdom (TMPDF): D.H. Tatham. Union des fabricants pour la protection internationale de la propriété industrielle et artistique, France (UNIFAB): M. Deroulers. Union of European Practitioners in Industrial Property (UEPIP): R. Wiclander. Union of Industrial and Employers' Confederations of Europe (UNICE): D.H. Tatham; G. Kunze.

V. Bureau

Chairman: J. Mota Maia (Portugal). *Vice-Chairmen:* I. Iványi (Hungary); S.-L. Lahtinen (Finland). *Secretary:* P. Maugué (WIPO).

VI. International Bureau of WIPO

A. Bogsch (*Director General*); L. Baeumer (*Director, Industrial Property Division*); G. Ledakis (*Legal Counsel, Director, General Administrative Services*); P. Maugué (*Senior Counsellor, Industrial Property (Special Projects) Section, Industrial Property Division*); S. Di Palma (*Head, International Trademark and Industrial Design Registries*); C. Claa (*Head, Meetings and Documents Service*).

Studies

The New Canadian Legislation on Patents

J.H.A. GARIEPY*

Introduction

On November 19, 1987, the Canadian Parliament approved "An Act to amend the Patent Act and to provide for certain matters in relation thereto," hereinafter referred to as the Amending Act. This Act, as the title indicates, merely amends a number of sections of the previous Patent Act, but does not replace the Act in total.

The first patent for that part of the North American continent that is now Canada was granted in June 1791 by a specific Ordinance enacted by the Governor General and the Legislative Council. The first legislation to provide statutory protection for inventions was passed in 1824. In that year, the Province of Lower Canada, which geographically corresponds for the most part to the present Province of Quebec, enacted legislation that provided for the grant of patents. Following passage of the Patent Act in Lower Canada, other provinces brought in similar legislation that established statutory authority for the granting of patents. For example, the Province of Upper Canada, which corresponds to what is now the Province of Ontario, enacted a law similar to that in Lower Canada in 1826.

The formation of Canada in 1867, that united four provinces into what was then called the Dominion of Canada, gave the authority to grant patents to the federal parliament, which shortly thereafter passed Canada's first Patent Act in 1869. Since then, the federal Patent Act has undergone more than 30 revisions, including some important changes such as the extension of patent protection to non-residents in 1872, and amendments in 1923 designed to comply with the obligations under the Paris Convention for the Protection of Industrial Property, the same year in which Canada joined the Convention.

Apart from some minor amendments, the general patent provisions of the federal Patent Act that were in existence prior to November 19, 1987, had not been substantially changed since the last complete revision of the Patent Act in 1935. Arguably, none of the above individual amendments since 1869, a period of more than 120 years, have changed the general patent provisions as significantly or as extensively as those brought about by the 1987 Amending Act.

The Amending Act has made substantial changes to Canada's patent system in two primary areas, namely, the general patent provisions that govern the obtaining and enforcing of patents in Canada, and the provisions that relate to the protection afforded to patents in the pharmaceutical field. This study will primarily address the detailed legislative changes that have been made to the general patent provisions. The new Regulations that have been approved in order to implement the Patent Cooperation Treaty (PCT) in Canada will also be described, since the Amending Act conferred regulatory powers on the Governor in Council to carry into effect the terms of the Treaty. The study will only briefly refer to the extensive amendments that were included in the Amending Act in order to improve the market protection for patented pharmaceuticals in Canada.

Purpose

The widespread changes to the general provisions of the Patent Act were based on a policy that was designed to enhance the technology transfer process in Canada by making the technical information contained in patents available to industry and research organizations in a more expeditious fashion. This policy has resulted in the adoption of a patent system that provides for the early publication of patent applications and a series of other amendments that were needed in order to shape Canada's patent system to better serve the needs of the business community, and particularly the technology needs of the small and medium-sized businesses.

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For the texts of the Patent Act, the Patent Rules and the Patent Cooperation Treaty Regulations, see *Industrial Property Laws and Treaties*, CANADA – Texts 2-001, 2-002 and 2-003, respectively.

At the same time, these amendments have brought Canadian patent law into closer harmony with the patent laws of most other industrialized countries. The new provisions have reduced a number of differences that existed between Canadian law and that of most of its trading partners. As a consequence, the patent system is more friendly to both Canadian innovators and industrialists who seek patent protection in Canada and abroad, and to foreign patent owners who seek protection and investment and transfer of technology opportunities in Canada.

Implementation

Most of the provisions in the Amending Act, approved by Parliament on November 19, 1987, did not come into effect on that date. A few sections of the Act, namely those that did not require the drafting of implementing Regulations, did in fact become law immediately upon parliamentary approval. The remaining sections were designed to come into force on days to be fixed by proclamation, and were brought into effect in step-wise fashion, starting on December 7, 1987, with those provisions of the Amending Act that created the Patented Medicine Prices Review Board.

The coming into force of the general patent provisions was deferred pending the drafting and approval of the Regulations required to implement the changes. Draft Regulations for the general patent provisions were made available for public comment in the summer of 1988, and following approval of the Regulations in the late summer of 1989, the new general patent provisions in the Amending Act and the Regulations relating thereto came into effect simultaneously on October 1, 1989.

Amendments to the General Patent Provisions

A brief description of each of the main amendments to the Patent Act that deal with the general provisions relating to the obtaining and enforcing of patents in Canada follows. The descriptions are grouped according to the date on which they came into effect.

In force on November 19, 1987

The important changes that came into effect immediately upon parliamentary approval on November 19, 1987, are set out below.

First, Section 12 of the Patent Act, which provides the authority for the Governor in Council to make Regulations to implement the provisions of the Act, was amended and took effect immediately upon approval of the Amending Act. This Section main-

tained the regulatory powers previously found in the Act, but also added one important subsection which authorized the implementation of the Patent Cooperation Treaty (PCT) in Canada by means of Regulation.

Second, the previous Act required that all patent claims directed to substances intended for foods or medicines that are prepared or produced by a chemical process must be drafted in a process-dependent form. This provision has been repealed. As a result, patents may now be granted that contain claims for foods or medicines *per se*, and the claims need not be restricted to the method or process of manufacture. Moreover, patent applicants who filed their application before November 19, 1987, i.e., under the previous Act, have been permitted to insert claims directed towards the food or medicine *per se*.

One exception to the above deletion remains, however, with respect to claims directed to naturally occurring substances intended for food or medicine and prepared or produced by, or significantly derived from, a microbiological process. Inventions directed towards these substances must still be claimed in process-dependent form. This provision is only an interim measure and is scheduled to expire on November 19, 1991. After that date, no restrictions will exist on the claiming of foods and medicines in Canada.

Third, under Section 2 of the Act, a definition of the phrase "priority date" was introduced. The definition was included to clearly set out its meaning, particularly in view of the added importance of priority dates under the new first-to-file system.

Finally, several procedures contained in the previous Act were deleted and not replaced. The requirement to mark patented articles was repealed since no evidence could be found that it had been effectively used in the market place. The offenses and penalties for non-compliance with the marking procedure were consequently also removed from the Act. In addition, the provisions dealing with a system of caveats were deleted. This procedure allowed intending applicants who had not yet perfected their invention to file a caveat and thereby obtain both a date of invention, and a notice in the event that an application for the same invention was filed by another person. These provisions were originally designed for a first-to-invent system and would not be in keeping with the new first-to-file regime.

In force on October 1, 1989

The major changes to the general provisions of the Patent Act came into effect on October 1, 1989. These amendments introduced a series of new procedures that applicants and patentees must follow, and dramatically changed Canada's patent system as well as the operations of the Patent Office.

The previous Patent Act contained a number of basic concepts, some of which had been in place in Canada since Confederation, such as patent applications could not be opened to the public during their pendency, patents were granted on the basis of a first-to-invent principle, all applications were automatically examined, and the term of a patent was fixed at 17 years and began on the date of issue. All of these provisions have been deleted by the Amending Act and a new patent system has been introduced which calls for the laying open of the contents of patent applications to the public, the granting of patents on the basis of a first-to-file system, a deferred examination system, and a 20-year patent term that starts on the filing date and continues only for as long as the patent maintenance fees are paid.

Ten new major amendments contained in the Amending Act, which came into effect on October 1, 1989, are described below.

1. First-to-File

Canada has operated under a first-to-invent patent system since the first federal Patent Act was passed in 1869. Under the first-to-invent system, whenever the situation arose that two or more inventors requested a patent for the same invention, the Commissioner of Patents determined which of the inventors first made the invention, and granted the patent to that inventor.

The Amending Act has replaced the first-to-invent system with a first-to-file system, which prevails in almost every country in the world. Thus, as between two applicants who both request a patent for the same invention, the patent will, under the new provisions, be granted to that applicant who was the first to file a patent application. In the rare event that two applications describing the same invention are filed on the same day, the present Patent Act indicates that each application shall be examined and a patent granted without regard to the existence of the other application.

Under the previous Patent Act applications were placed in conflict when two or more applicants requested a patent for the same invention. The Act set out the specific steps that the Commissioner of Patents must follow in order to determine which of the two or more inventors should be granted a patent. Apart from the provisions in the Amending Act that are effective during the transition from the previous to the present Act, the statutory provisions that defined the conflict procedure have been deleted.

The first-to-invent system continues to apply to all those applications that were filed under the previous Act, i.e., prior to October 1, 1989. In addition, it will continue to be used to determine the right to a patent in those instances where an application filed before October 1, 1989, under the previous Act, requests a patent for the same invention claimed in an application

filed on or after October 1, 1989, under the present Act. The possibility of this occurring will of course diminish as the number of applications filed under the previous Act and still pending before the Office is reduced over the next several years.

2. Novelty

Novelty of an invention is, in addition to inventive ingenuity and utility, one of the three fundamental requirements for obtaining a patent. The Amending Act significantly changes Canadian practice in this regard by eliminating the previous two-year grace period that applied to any printed publication. All applications filed after October 1, 1989, will be subjected to an absolute novelty standard and a patent may only be obtained if the invention was not disclosed in a manner that makes the invention available to the public before the earlier of the Canadian filing date or the priority date. A patent application will therefore become a citable reference from the date when it is made available to the public against all later applications claiming the same invention.

Adoption of a first-to-file system together with the absolute novelty provisions means that the priority date of an application, arising from the Paris Convention for the Protection of Industrial Property or from bilateral agreements that contain priority rights, becomes far more important than under the previous regime. Under the previous Patent Act, the Canadian filing date was the most important date and the priority date was rarely of practical significance. Also, priority could, under the previous Act, be requested at any time during the pendency of the application. The new provisions, however, require that priority be claimed within six months of the Canadian filing date in order to benefit from the advantages under the Paris Convention or other agreements.

An exception to the absolute novelty provisions has been adopted with respect to the applicant's own public disclosure of the invention. Public disclosure of the invention for a one-year period prior to the Canadian filing date, by the applicant or by another person who derived knowledge of the invention either directly or indirectly from the applicant, will not prevent the applicant from obtaining a patent. As a result, an inventor can publish or publicly use the invention before the filing date as long as a patent application is filed in Canada within one year of the disclosure. It should be noted that the critical date specified by this provision is the Canadian filing date and not the priority date of the application.

The former provision under which public use or sale of the invention would only prevent the granting of a patent if the use or sale occurred in Canada, sometimes referred to as local or domestic use or sale, has been deleted.

It should also be noted that the provisions under the previous Act which required an applicant, who had previously filed an application abroad, to file the corresponding Canadian application describing the same invention within a specific time, have been maintained. If a foreign patent has issued, the corresponding Canadian application must be filed within one year of the first foreign filing, or before the issue date of the patent.

3. *Laying Open of Patent Applications*

The previous Act stipulated that the contents of an application were not to be made public until the patent was granted. This created a situation, that has been in existence since 1903, where Canadians could not examine the technical information contained in applications filed in the Canadian Patent Office until the issue date of the patent. In recent times, patents have not been granted, on average, until some three or more years after the Canadian filing date or almost four years after the priority date. In order to ensure access to this information at an earlier date, a procedure for laying open the contents of patent applications to the public, before the patent has issued, has been adopted. This procedure puts Canada in line with almost all other industrialized countries.

Consequently, all patent applications filed after October 1, 1989, are laid open to public inspection 18 months after the Canadian filing date or, in the case of applications claiming convention priority, 18 months after the priority date. Since more than 90% of applications filed with the Patent Office emanate from abroad, most applications are made public shortly after the Canadian filing date. Copies of laid open applications, as they existed at the time of filing, can be purchased by the public from Micromedia Ltd., a private sector company that sells patent documents to the public. It is also possible for the public to inspect all the documents attached to the file of a laid-open patent application, including any amendments that have been made after the filing date.

An applicant can, however, prevent publication of an application by formally withdrawing the application before it has been opened. Unlike the situation under the previous Act, however, all applications that become abandoned under the new provisions will be opened to public inspection, even if the abandonment occurs before the 18-month laid open period has elapsed.

4. *Term of Patent*

The fixed statutory term of a patent, namely 17 years from the day the patent was granted, had been unchanged in Canada since 1935. In order to ensure that undue delays during the granting procedure do not tend to extend the term of protection, and at the

same time to encourage applicants to diligently prosecute their applications, the patent term under the new Act starts on the Canadian filing date. In keeping with international practice, the term is 20 years. Given that it generally takes, on average, some three or more years for an application to mature to a patent in Canada, it is not expected that the new term will significantly alter the effective term of a patent.

The 20-year term applies to all patents that mature from applications filed after October 1, 1989. With respect to those patents that issue from applications which were filed prior to October 1, 1989, the term will continue to be 17 years from the date of issue.

5. *Infringement*

Since the public becomes aware of the technological information contained in the patent application before the exclusive rights are in fact granted, compensation for infringement as of the laying open date has been introduced. A third party who infringes the claims of a patent application subsequent to the laying open date is liable to the patentee as of that date. The legislation states that reasonable compensation is payable to the patentee for infringing acts carried out between the date that an application is opened to public inspection and the date that the patent is issued. Infringing actions that take place subsequent to the grant of a patent continue, however, to be subject to payment of all damages sustained by the patentee after the grant.

6. *Acquired Rights*

Under the previous Act, a person who had purchased, constructed or acquired an invention before a patent thereon was granted, had the right to continue to use the invention after the patent was granted without being liable to the patentee. Adoption of an early publication procedure has resulted in an amendment to this section of the Act whereby only acquisitions that occur prior to the laying open date of an invention are governed by this provision.

7. *Deferred Examination*

The previous Act required that all applications filed with the Patent Office be examined. The new legislation repealed the requirement to examine all applications and introduced a system of deferred examination, whereby applicants must specifically request examination of their applications. Adoption of a deferred examination procedure avoids the examination of applications in which interest has waned, provides more time and flexibility for applicants to decide the commercial value of an inven-

tion, and allows examination efforts to be concentrated on those technologies judged to be of commercial value. Under the new provisions, applicants have a prescribed time fixed by the Patent Rules at seven years from the Canadian filing date, in which to request examination. The request must be accompanied by an examination fee, and the application will become abandoned on failure to make the request within the seven-year period.

Examination of a particular application can also be requested by someone other than the applicant, in which case reasons for the request must be provided. In addition, examination of a particular application can also be initiated by the Commissioner of Patents.

8. Reexamination

A regime for the reexamination of the claims of a patent, by a Board appointed by the Commissioner of Patents, has been established in order to allow a relatively inexpensive and prompt procedure for an administrative reconsideration of the validity of a claim. The reexamination request will only be considered by the Board if it raises a substantial new question of patentability based on prior art.

Subject to appeal to the Federal Court of Canada, the Reexamination Board has the authority to cancel any claim, confirm any claim or approve an amended claim as long as it does not enlarge the scope of the patent. Any person may request reexamination of a patent at any time during the term of a patent and all patents issued after October 1, 1989, are subject to reexamination.

9. Maintenance Fees

Fees to maintain a patent application in effect and to maintain the rights accorded by a patent are standard features among the patent systems of industrialized countries. The introduction of maintenance fees brings Canadian practice into harmony with international practice and will reduce the number of patents that are in force in Canada and will shift a greater portion of the cost of running the patent system in Canada to inventions that are commercially valuable.

Maintenance fees are payable on an annual basis as follows:

- for all patents issued after October 1, 1989, on the basis of applications filed after that date, the fees are calculated from the Canadian filing date of the application and must be paid for each one-year period between the first and nineteenth anniversaries of the filing date;
- for all applications filed after October 1, 1989, the fees are calculated from the Canadian filing date of the application and must be paid for each one-year period between the first and nineteenth anniversaries of the filing date;

- for all patents issued after October 1, 1989, on the basis of applications filed before that date, fees must be paid only to maintain the patent and are calculated from the issue date of the patent for each one-year period between the first and sixteenth anniversaries of the issue date.

If the maintenance fee on an application or patent is not paid by the due date, applicants and patentees are given a further six-month period in which to submit the fee, together with an additional or late payment fee.

10. Second Application for the Same Invention

A new provision had been introduced whereby, under certain specific conditions, an applicant can substitute a second Canadian application for one already on file in the Patent Office, and still retain the filing date of the first application. This procedure, sometimes referred to as internal or domestic priority, allows an applicant to redraft the application in order to provide an improved description of the invention.

For purposes of the Patent Act, a second application will be considered to have the filing date of the first application, if at the time the second application is filed, the first application is still in good standing, i.e., it has not been abandoned, withdrawn or refused. In addition, the first application must not have been opened to the public and must not have served as a basis for claiming a right of priority in any other country. Finally, the second application must be filed within 12 months of filing the first application. Most important, however, the second application must describe the same invention as the first application.

If the above conditions are met, the second application will, for the purposes of the Patent Act, be accorded the filing date of the first application, and the first application shall be deemed to have been withdrawn on the day immediately after the filing of the second application.

Membership in the Patent Cooperation Treaty

The Patent Cooperation Treaty (PCT), including Chapter II of the Treaty, came into effect in Canada on January 2, 1990. The Treaty was implemented by Regulation under the authority provided by Section 12 of the Patent Act, as referred to earlier.

International applications filed with the Canadian receiving Office can be in either the English or French language. The European Patent Office (EPO) acts as both the International Searching Authority and International Preliminary Examining Authority

for Canadian nationals or residents who file under the Treaty.

A PCT applicant who wishes to obtain a Canadian patent, must provide the following items upon entry of the application into the national phase: (i) payment of the national patent fee; (ii) in the case where the international application has been published by the International Bureau in a language other than English or French, a translation of the application into either English or French; and (iii) depending on the time period that has expired since the international filing date, payment of the first patent application maintenance fee.

The above requirements must be met within 30 months of the priority date in the case where Canada is elected before the expiration of the nineteenth month after the priority date, and within 20 months after the priority date in all other cases where Canada is designated. Failure to comply with the above requirements, within the prescribed time limits, will cause the application to be abandoned. In the event of abandonment for these reasons, the application can be reinstated by satisfying the Commissioner of Patents, within two months of the date of abandonment, that the failure to comply with the requirements was not reasonably avoidable. If the application is not reinstated within the specified time, it will be deemed to be withdrawn.

At the national entry stage, the application must also contain, if not already provided or if applicable, the following information: (i) the name and address of the inventor; (ii) in the case where the inventor is not the applicant, evidence that the applicant is the legal representative of the inventor; (iii) the appointment of an associate patent agent; and (iv) the nomination of a representative for service with a local address. Failure to supply this information, within the prescribed time limits, will cause the application to be considered incomplete, and will result in the issuance of a completion request by the Commissioner of Patents. Applicants have three months to comply with the request and failure to do so will result in abandonment of the application.

Publication by the International Bureau of an international application which designates Canada, gives rise to certain rights under the Canadian Patent Cooperation Treaty Regulations. For infringement and acquired rights purposes, under Sections 55 and 56, respectively, of the Patent Act, the above international application, if published in the English or French language, is deemed on the date of publication to be open to public inspection at the Canadian Patent Office.

Transitional Measures

The Amending Act contains a series of provisions necessary to deal with the transition from the

previous to the new Patent Act. Specific transitional provisions have already been described with respect to the first inventor determination between applications filed under the previous Patent Act and those filed under the new Act, and those that apply with respect to maintenance fees. Apart from these, the general approach defined by the Amending Act is that applications filed and patents granted under the previous Patent Act continue to be governed by that Act. On the other hand, applications filed under the new Patent Act and patents granted under that Act, as of October 1, 1989, are governed by that Act.

Market Protection for Pharmaceutical Patents

The Amending Act, in addition to changing the general patent provisions, also includes an extensive series of changes that establishes a new balance between domestic and international patent rights, industrial benefits, Canada's provincial health care systems and consumer interests. These provisions are not concerned with the manner of obtaining a patent and also do not specifically amend the current sections of the Act that deal with the procedure for obtaining a compulsory license for patented pharmaceuticals.

Primarily, the amendments provide for an increased period of market protection for patented medicines, and for the establishment of the Patented Medicine Prices Review Board (PMPRB). While the Patent Act provisions that govern the granting of compulsory licenses for patented medicines are retained, the Amending Act establishes a new concept which prohibits a licensee from exercising the rights given under the license for a period of time. The new legislation assures patentees a period of exclusivity during which the exploitation of the compulsory licenses for patented medicines is delayed for up to 10 years after a drug has been approved for sale by the department of Health and Welfare Canada.

The Patented Medicine Prices Review Board has been established as an independent, quasi-judicial body, and is mandated to review patented medicine prices to ensure that they are not excessive, and to report on the research and development-to-sales ratio of individual patentees and of the pharmaceutical industry as a whole.

Conclusion

The above changes are part of an overall Government approach to modernize Canada's intellectual property legislation. In addition to the above Amending Act, other recent legislative initiatives include the 1988 revision of the Copyright Act, and approval by Parliament in June 1989 of legislation for the protection of integrated circuit topographies.

Recent Developments in Australian Patent Law

P.A. SMITH*

Introduction

There has been an increasing awareness internationally that a nation's future prosperity depends upon its ability to innovate, take advantage of technological change and develop export markets in skill-intensive goods and services. Australia in recent years has come to realize that to develop more internationally competitive industries it must exploit research results, and that it requires a strong capability for innovation, including application within both industry and the public research agencies. This capability must be linked to research and development focused on areas with the greatest potential for national effect.

One of the issues which Australia has been grappling with in recent years is to improve industry competitiveness and performance by encouraging industry and researchers jointly to make more effective use of research and development. The productivity of Australia's efforts is determined by the effectiveness of the innovation system as a whole. The various policy options thus need to be viewed in this context.

Innovation requires many skills and brings together human, financial and other resources in the development of long-term plans. It requires a culture which provides progressive change and is willing to take risks. It also requires an economic environment in which the individual and institutional rewards are commensurate with the risks being taken.

The patent system is one policy option which is considered in Australia when ways are sought to enhance the country's long-term economic prosperity through technological innovation, and the patent legislation is regarded as an instrument of national economic policy aimed at the stimulation of indigenous industrial innovation.

The Australian Government, therefore, in 1990 introduced into the Parliament a completely revamped Patent Bill 1990 which had two main thrusts. First, it implemented a number of policy changes flowing from an expert report reviewing the Australian patent system from an economic perspective. Second, it sought to bring the language and structure of the legislation down to earth so that non-

lawyers might have a better chance of understanding it, at least in general terms.

Background

In October 1979, the Government asked the Industrial Property Advisory Committee (IPAC) to review the Australian patent system from a predominantly economic perspective. The broad thrust of that review was to study, from the viewpoint of the Australian national interest, whether there are ways in which it may be made to do so more effectively.

The Industrial Property Advisory Committee is a standing committee which has the responsibility for continuously reviewing industrial property laws, policy and practices to facilitate their maximum contribution to productivity improvement and innovation in Australian industry. The Committee can both initiate or respond to requests for review of policy aspects of industrial property matters as they affect Australia.

IPAC concluded its review of the patent system in 1984 and its report entitled "Patents, Innovation and Competition in Australia" was published in August of that year.

In its report, IPAC recommended that Australia should continue to operate a patent system and to participate in the international patent system. It made this recommendation despite views that generally the history and characteristics of the Australian economy, singularly and in combination, with heavy emphasis on protection, foreign investment and technology importation, did not provide encouragement for the view that there would be substantial benefits attributable to the operation of the patent system.

IPAC indicated that the policy approach it adopted to review and change was one which sought to optimize the net benefits arising from the operation of the patent system in the national interest to the extent possible consistent with international conventions and treaties having regard to the particular circumstances of the Australian economy. The Committee's aim was to seek to modify the Australian patent legislation, adjusting the length, strength and breadth of patent rights so as to maximize the social benefits and to minimize the social costs to Australians. In doing this, IPAC emphasized that it needed to be recognized that the patent system is a blunt instrument of industrial policy and cannot easily be fine-tuned to take account of particular cases.

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One of the IPAC's recommendations was

"that the patents legislation be reviewed and completely re-drafted to streamline procedures, particularly with a view to eliminating unnecessary steps and procedures, avoiding special categories, and establishing appropriate sanctions for non-compliance."

The Government accepted this recommendation and announced that the Commissioner of Patents would invite the Law Council of Australia and the Institute of Patent Attorneys of Australia to participate in a Working Party to review the legislation particularly with a view to relegating procedural matters to the Regulations.

Reforms Considered

The Patents Act 1990¹ was, as indicated above, the vehicle for implementing the major recommendations contained in IPAC's report. These recommendations may be grouped under a number of categories as follows:

- exploitation of patent rights;
- length and breadth of rights;
- fostering national interests; and
- efficient operation and administration.

Exploitation of Patent Rights

Under the category of exploitation of patent rights, IPAC considered two policy areas which involve equity considerations. The first of these is the interface between patents and competition law. Here the Committee examined how competition law should operate in relation to the patent system, looking particularly to possible safeguards against anti-competitive use of patent rights. It concluded that there was no reason why competition laws proscribing conduct which has substantially anti-competitive effects should not have full application in relation to anti-competitive conduct which involves patents, as it does in relation to other rivalrous conduct. Consequently, the Committee recommended the removal of certain exemptions of patent-related conduct from the Trade Practices Act 1974 and of certain proscriptions from the Patents Act 1952. It further recommended that the application of certain other provisions of the Trade Practices Act in the patents area be subject to the lessening of a competition test rather than as *per se* rules.

These recommendations were not accepted by the Government. In taking this action, the Government recognized that the law should desirably enable an appropriate balance to be struck, in general and in any particular case in seeking both to avoid anti-

competitive conduct and by granting exclusive patent rights to promote innovation. While there may well be some oddities in the way the Trade Practices Act and the Patents Act interrelate, the Government was not satisfied that a case had been sufficiently established for the particular policy changes recommended. It also believed the distinction made between non patent-related and patent-related conduct in proposing to apply, respectively, the present *per se* rules and a broader lessening of a competition test would lead to the result that the Trade Practices Act would contain two separate policies relating to the same kind of conduct depending on whether it was patent-related or not.

The second policy area considered in this category is the vexed question of the appropriate policy approach to be taken in respect of local manufacture or working, on the one hand, and importation on the other, and the related issues of compulsory licensing and forfeiture for "patent misuse."

Since 1903, the Australian patent legislation has contained provisions for the granting of compulsory licenses where patentees fail to satisfy "the reasonable requirements of the public." The legislation provides first for the granting of one or more compulsory licenses where a patentee fails to satisfy the reasonable requirements of the public in Australia, and for the subsequent forfeiture of a patent if, two years after the granting of a compulsory license, the reasonable requirements of the public are still not satisfied. Thus the possibility exists of a compulsory license being obtainable where the patentee is not working or permitting the working of the patented invention in Australia.

The Committee's view was, firstly, that local working should not be viewed as an absolute economic goal, in its own right. It felt there was a wide range of circumstances in which local working would be inefficient and unsuitable. In particular, it felt there were many situations in which Australia's economic needs would be better fulfilled by importation of patented goods rather than by fostering and protection of inappropriate local working with its attendant direct and indirect costs to both the community and Government. The Committee concluded that compulsory licensing and forfeiture in Australia should have the purpose of providing a mechanism by which a patentee can be prevented from misusing a patent to preclude local working which would be economically desirable in circumstances where, but for the patent, it could and would occur. This assumes, among other things, the existence of conditions necessary for the efficient production or provision of goods or services which will be competitive.

Secondly, the Committee felt it was fundamental from an economic viewpoint that Australian patents should not be capable of being used to maintain excessive prices by excluding imports. This applies

¹ See *Industrial Property Laws and Treaties, AUSTRALIA* - Text 2-001.

both to patentees who treat Australia as an export market and who wish to eliminate other imports in order then to charge excessively for their own products, and also to patentees who are local producers wishing to eliminate imports in order that their locally produced products may then be sold at excessive prices.

The main thrust of the compulsory licensing and forfeiture provisions of the existing legislation will be continued with the inclusion in the Patents Act 1990 of a definition of "working" which makes clear that importation is envisaged as constituting "working." Additionally, the Government has indicated that it expects that the courts will take account of economic issues when considering a petition for a compulsory license, including where the prospective licensee wishes to exercise the license by importation.

Length and Breadth of Rights

The overall effects of the patent system appear to be subtle, largely unexplored and imperfectly understood, and in this situation reform should be approached with considerable caution. This is particularly relevant when considering the fundamental issues of appropriate term of a patent, and patentable subject matter.

The consideration of the question of appropriate length of term of a patent was probably the most sensitive issue before the Committee.

Under the provisions of the Patents Act 1952, a standard patent in Australia has a term of 16 years from the date of filing of a complete specification, subject to the payment of annual renewal fees. An extension of term for up to five years and in exceptional cases 10 years may be obtained when the patentee is found after extensive enquiry in the courts to have been inadequately remunerated.

Statistical evidence supplied to the Committee by the Australian Patent Office revealed that the majority of patents did not run their full term. Evidence showed that less than 20% of patents run their full term in Australia, with about 50% ceasing by the end of the tenth year.

The Committee also had before it details of patent terms in other countries as well as submissions supporting a term of 20 years, or increased availability of extensions of the term. Such submissions were variously based on arguments relating to international conformity, to the development time needed to bring certain inventions to commercial reality, and to regulatory delays applying in such areas as pharmaceutical chemicals.

A majority of the Committee recommended that:

- (i) the present standard patent term of 16 years from the date of filing of the complete speci-

fication not be altered, either generally or in the case of particular industries; and

- (ii) the procedures for granting of extension of the term of a standard patent be eliminated *in toto*.

In this regard, the majority of the Committee felt that no case had been made out for a longer term. The Committee was of the view that no empirical evidence had been adduced which supported the idea that to increase the standard patent term beyond 16 years would produce significant added social gains, and the theoretical evidence, such as it was, derived from economic literature, pointed to a shorter rather than longer term. Similarly, the international trend towards a 20-year term is only among certain OECD countries mostly having economies with which Australia's economy has little in common at the present time.

The Government whilst agreeing in principle with these recommendations did indicate that it was sympathetic to the circumstances of the pharmaceutical chemical industry which was required to obtain approval from federal health authorities before they could commence marketing of their products. The delays necessarily incurred in obtaining such approval erode the effective patent lives of these products by periods of up to several years.

Legislation has now been introduced which, whilst not changing the 16-year term of a standard patent, abolishes extension of that term except in the case of pharmaceutical substances for human use which are the subject of federal Government approval for marketing in Australia. These arrangements allow the holder of a pharmaceutical patent, which is subject for the first time to importation and general marketing approval by federal health authorities, to apply to the Commissioner of Patents for an extension of term of four years, rather than having to go through the courts under the previous provisions. During the final two years of an extension, a competing company will be allowed to gear up to be in a position to enter the market immediately on expiry of the extended patent term without being subject to action for infringement of the patent concerned. This means, for example, that manufacturers of "generic" pharmaceutical products would be allowed a two-year period for "spring-boarding" before a patent term extension expired to seek marketing approval and to prepare for entry into the market at the end of the four-year extension period.

The issue of breadth, or scope of patentable subject matter, is one which has given rise to much debate throughout the history of the patent system. There has never been a definition of patentable subject matter in the Australian patent legislation, and that legislation has simply required that an application should be in respect of any manner of new manufacture within the subject of letters patent and

grant of privilege within Section 6 of the Statute of Monopolies.

This has been interpreted in Australia as requiring a determination of the question,

"Is a claim fit subject matter for the grant of letters patent within the context provided by Section 6 of the Statute of Monopolies?"

The great advantage of this approach is that it allows the law to adapt readily to the demands of rapidly developing technology thus enabling advances in scientific knowledge to be accommodated within the ambit of patent protection. At the same time the decision gives clear warning that not every "invention" will be patentable.

IPAC was of the view that in principle it would be possible to legislate about what may be patentable for the purpose of seeking to implement selective economic policy objectives, according to Australia's perceived needs and circumstances. In particular, this could be done for the purpose of encouraging or discouraging innovation, or stimulating or precluding patenting, either in certain industries or technologies, or in relation to particular descriptions of products or processes. Surgical and medical techniques for human therapy, and mixtures of foods and medicines are regarded in many countries as being unpatentable on public interest grounds.

Conversely the Committee asked itself, reflecting positive, pro-competitive aspects of the patent system, whether the concept of manner of manufacture should be broadened specifically to include so-called emerging technologies, particularly those which are software-based either in the narrow computing sense or in a more general sense which might include accounting, investment and other systems of doing business.

After due consideration, the Committee concluded that attempting to fine-tune the patent system in this way would be unlikely to prove beneficial for the purpose of implementing economic policies in the way postulated. The Committee believed there are other measures available to Government of a more flexible and immediate nature, such as tariffs, taxation incentives, and other forms of specific selective encouragement or discouragement, that could be used depending on the economic requirements. Compared to these measures, changes to the criteria for patentability, and more particularly the subject matter for which patents can and cannot be obtained, would likely prove to be a very slow, blunt and inefficient instrument for influencing the economic direction of particular industries or fields of technological development in Australia.

Against this background, IPAC recommended that the existing law in Australia regarding patentable subject matter should be unchanged. The Government agreed with that recommendation.

When, however, the Patents Bill 1990 was introduced into the Parliament, concerns were expressed

in a number of quarters on the issue of the patentability of human life forms. Whilst it had been consistently stated that no patent for a human being would be granted under the patent legislation, this was not sufficient to satisfy those concerns. The objections to the patenting of human life forms were based mainly on moral, ethical and/or environmental grounds and were premised on a belief that there would be a disincentive to research and development in this area if patents were not available for any resulting inventions. The counter argument suggests that this would not be the case. Research and development would continue, with enterprises, instead of having the results of commercially viable research being published, using, where possible, trade secret protection.

As a consequence of the debate which ensued, amendments to the legislation were agreed, which had the effect of codifying the existing policy and which additionally ensured that biological processes for the generation of human beings would also not be patentable inventions.

Fostering National Interests

Australia grants both standard patents, which have a 16-year term, and petty patents, which have a six-year term. Since 1979, when petty patents were introduced into Australia, the requirements regarding novelty and inventiveness have been the same for both standard and petty patents, and were based essentially on local publication as distinct from prior publication anywhere. This led to a certain amount of criticism, and attention was drawn to the two-tiered system operating in Germany and Japan.

IPAC examined in some detail proposals suggesting that Australia should adopt a two-tier system, and reached the conclusion that Australia would be advantaged if higher levels of invention generally compatible with international standards were to be required to support a standard patent. On the other hand, in the innovation process, most of the essential work is not at the level of a major breakthrough or a significant inventive advance, but rather at the level of refining, improving or adapting existing technology. In this process, there are made, in Australia, many inventions which may not be of such an inventive height as to satisfy high international standards, but which are nevertheless significant and new in the commercialization of an innovation in Australia. The Committee believed that this level of invention and innovation was of importance and should not be excluded from protection altogether by the raising of the level of invention required to support a standard patent. It therefore felt that petty patents should remain available for these inventions.

In considering what should be the level of inventiveness required for the grant of a standard patent,

IPAC considered the three most common options, namely:

- novelty and non-obviousness determined against a *prior art base* comprising things made public by any means or used in Australia before the priority date—local or domestic standard of novelty;
- novelty and non-obviousness determined against a *prior art base* which includes anything made public by any means or used anywhere in the world before the priority date—absolute standard of novelty; or
- novelty and non-obviousness determined against a *prior art base* which includes disclosures in recorded form publicly available anywhere in the world, or openly made oral disclosures or use in Australia before the priority date—universal or qualified universal standard of novelty.

IPAC recommended that Australia adopt the so-called universal or qualified universal standard of novelty for standard patents and the Patents Act 1990 reflects that recommendation. The reasoning behind this is that where information exists in a recorded form, it should usually be relatively simple to establish whether it was publicly available prior to a particular date. On the other hand, where there has only been prior oral disclosure, or prior use, unaccompanied by any record, different considerations apply. Proof of what was disclosed or used will depend much upon the testimony of witnesses and their credibility. If the facts relied upon occurred outside Australia, the problems of proof and related costs would be increased.

The Patents Act 1990 has also included provisions which require that novelty and non-obviousness for petty patents be determined against a *prior art base* which is the same as that for standard patents, except that only those disclosures in recorded form which are publicly available in Australia may be considered.

Related to the issue of novelty is the question of “prior claiming,” as known in the legislation of a number of British Commonwealth countries, and particularly in relation to the United Kingdom patent legislation prior to 1977. The Committee came to the conclusion that the “prior claiming” approach has proved to be unsatisfactory in practice and was too narrow in scope. It was attracted to the relatively simple “whole contents” approach adopted in other countries, under which any disclosure contained in an earlier specification that has not lapsed or been withdrawn may be relied upon as an anticipation for determining novelty, but not obviousness. This has been reflected in the Patents Act 1990.

Under this category, the issue of a “grace period” which renders certain disclosures of the invention by, or emanating from, the inventor, not prejudicial to

the grant of a patent, was considered by IPAC. Limited provisions are available under the Patents Act 1952, and the Committee was aware of the more generous provisions in the laws of other countries, notably the United States of America and Canada, and the work being carried out in the World Intellectual Property Organization (WIPO) in the context of the patent harmonization negotiations.

The Committee concluded that there may be certain advantages to Australian applicants if a general grace period were allowed in respect of any disclosures emanating from the inventor, but the Committee considered that it was unwise for Australia to legislate unilaterally to provide any extension of the existing grace period. The Committee reasoned that to do so would lead local inventors to rely on the grace period in Australia with possible consequent destruction of rights in those foreign countries which do not provide a grace period in corresponding circumstances. The Committee’s view was that the problem must be approached internationally and that Australia should await the outcome of WIPO’s work on this issue.

The Committee indicated that the system for establishment of a priority date for an invention by the filing of a patent application accompanied by a “provisional specification,” as presently available in Australia, goes some way to meeting the grace period problem since, if a provisional specification is filed, disclosures can be made without loss of rights. This, together with the belief that the provisional specification procedure is of value in providing a less complex and cheaper first step in the patenting process, led to the recommendation that the provisional specification procedure be retained in Australia. The Patents Act 1990 reflects that recommendation by providing for the filing of a provisional application which must be followed within 12 months by a complete application claiming priority from the provisional application, if the applicant wishes to obtain protection for the invention.

Efficient Operation and Administration

The measures included in this category have the aim of eliminating or minimizing unnecessary costs. This involves seeking to improve the certainty, simplicity and expedition of procedures for applicants, patentees and third parties. A further aim is to prescribe administrative procedures which ought to be as efficient as possible so that patents are simple to obtain, to enforce and to challenge.

One of the administrative procedures studied in this regard was that related to the examination of a patent application. Australia has a system of examination of standard patent applications upon request. Examination is not automatic but must be requested by the applicant or a third party within five years from filing, or earlier upon a direction by the

Commissioner of Patents. Examination on request offers an advantage to an applicant needing additional time to further assess the commercial prospects of the invention before incurring expense on prosecution of the application. Competitors who may face prolonged uncertainty as to whether a patent will finally be granted have the advantage that they are entitled to require examination after the application has become open to public inspection.

The Committee concluded that from the viewpoint of administration of the system, examination on request, as distinct from automatic examination of all applications, eliminated unnecessary and wasteful resources spent in examination of applications which the applicants or third parties had no interest in pursuing further.

The examination process in Australia includes the carrying out of a search to determine the newness of the invention subject of an application. This differs from the practice in some other patent offices, notably the United Kingdom and the European Patent Office, where a prior art search is carried out before the publication of the application, and the examination is performed at a later time.

The Committee recognized that advantages accrue to both the applicant and third parties as a result of the earlier availability of search results at the time of publication of the application, particularly in view of the increasingly sophisticated facilities for gaining access to international patent data bases.

Nevertheless, the Committee concluded that the separation of search and examination did not lead to the most efficient use of the Patent Office resources. Their reasoning was that the assessment of novelty and non-obviousness during examination required an examiner to be intimately familiar with the search. With the aid of modern searching tools, direct access to search material by examiners and with less need for specific expertise in searching, this was becoming much easier. The Committee also felt, after studying material from the United Kingdom Patent Office and the European Patent Office, that the separation of search and examination had not achieved any significant reduction in the work loads of those Offices nor had it produced any significant efficiencies.

Consequently the Patents Act 1990 contains provisions which continue the system of examination upon request, which has been practiced successfully in Australia over the last 20 years, as well as the practice of carrying out the search and examination of an application at the same time.

A related issue is that of notification of search results in respect of an invention or of corresponding patent applications in other countries. The Committee was of the view that, to avoid duplication of searches and to encourage stronger patents, it was appropriate to impose some requirement on applicants to notify previous search results.

The Patents Act 1990 thus includes provisions which permit the Commissioner of Patents to direct an applicant to provide the results of specified searches carried out in specified foreign patent offices or other organizations in respect of corresponding applications.

Related to the examination process is whether or not an examiner should report on whether an invention involves an inventive step, that is, whether or not it is obvious. This has not previously been required during examination in Australia. The Committee recommended, and the Patents Act 1990 now provides, that both novelty and non-obviousness be matters for report by the examiner during examination of a standard patent application.

The complexity and expense of challenging the grant, or validity, of a patent has been the cause of much criticism of the operation of the patent system. Allegations are frequently made that a weak patent may be allowed to continue unchallenged because no prospective challenger is willing to undertake the risk of infringement and revocation proceedings.

It is in the interest of applicants and patentees, their competitors and the public generally, that objections to grant or validity be dealt with as expeditiously, expertly and consistently as is possible, without unduly sacrificing either fairness or the effective application of the relevant criteria.

The Patents Act 1990 faces this problem by permitting the continuance of pre-grant opposition proceedings and by the introduction of an *ex-parte* reexamination procedure.

The arguments for and against pre-grant opposition are many and varied. The rationale usually advanced for pre-grant opposition is that it is in the interests of both the prospective patentee and the public that a patent, once granted, should be as strong as possible. Supporters of a pre-grant opposition system argue that such a system, including a hearing in the Patent Office, is an inexpensive and effective adjunct to examination and search in ensuring that weak patents are not granted.

On the other hand, it is argued that a common purpose for which opposition now seems to be used is as a means for a competitor to delay the grant of a patent. This delay can be of significance since infringement proceedings cannot be pursued until after grant, although the patentee can then sue for infringements dating back to the publication date of the application.

The cost implications of lengthy opposition proceedings may also be very serious for a small inventor who has limited resources and who may be faced at the same time with the need for an expensive advertising or marketing promotion to create consumer awareness of a new product. Any significant delay reduces the opportunity for an inventor to gain real benefit from a patent and is potentially inhibiting of innovation.

The Government, after balancing the various views, decided that pre-grant opposition does provide a relatively inexpensive mechanism for resolving third party disputes as to validity. The Patents Act 1990 therefore provides for such proceedings to continue but the procedures are now more stringent in order to expedite the determination of oppositions.

On the issue of reexamination, this is essentially a form of administrative revocation system. IPAC considered there was sufficient merit in the system to warrant its implementation, subject to certain conditions, to ensure that it did not create more problems than it solved, or involve more costs than it saves.

In this regard, the Committee concluded that matters permitted to be raised in reexamination should be restricted to documentary or other recorded matter affecting novelty and non-obviousness of the invention, the procedure should be *ex parte*, not involving the notifier as a party, and at the Commissioner's discretion.

The Patents Act 1990 thus provides for a reexamination procedure for both standard and petty patents. The procedure is to be available where the grant of a patent is opposed, or where a patent has been granted. The Commissioner of Patents will be empowered to order reexamination within a limited period during opposition proceedings. Reexamination is also to be available, on the direction of a court, where the validity of a granted patent is disputed in any proceedings before the courts. The Commissioner will not be permitted to commence or continue a reexamination where relevant court proceedings relating to a patent are pending or have commenced.

On the issue of enforcement of rights, a patentee may encounter serious difficulty in enforcing his patent where it is prone to infringement by an eventual consumer who is supplied by an unauthorized person with the means to infringe—the contributing infringement issue. This is a problem particularly in respect of process patents, where there is potential for hundreds of unsuspecting consumers infringing such a process patent by purchasing a product and following the instructions for the use of that product.

IPAC was of the view that it was unreasonable and wasteful of resources for a patentee to be required to sue all of the direct infringers with so unsatisfactory a result in each case, when the supplier is, in a real sense, far more responsible for the commission of the infringing acts. The Committee believed that it would be more effective, realistic and just for the patentee to be able to take action against the supplier or middleman who facilitates the commission of the infringing act by the ultimate consumer.

The Patents Act 1990 therefore provides that, in general, the supply of goods whose only use would infringe a patent, or which are accompanied by a positive inducement for the ultimate consumer to

perform actions which would innocently or knowingly infringe a patent, should itself be an infringement of the patent. These provisions will result in the supplier of a product being liable for infringement, where use by the person to whom the product is supplied would be an infringement, if the use is:

- the only reasonable use of the product, having regard to its nature or design;
- any use of a non-staple commercial product to which the supplier had reason to believe that the receiver would put it; or
- use in accordance with any instructions, inducement or advertisement given or published by the supplier.

A further matter considered in respect of enforcement of rights was that of infringement by importation.

Under the existing law, a patent is infringed by importation of the patented article or, in the case of a patented process, of the product of that process. The Government has decided that the principle of infringement by importation will continue to be part of Australian law.

The rights possessed by a patentee include the exclusive right, during the term of the patent, to prevent others from exploiting the invention. The term "exploit" is defined in the Patents Act 1990 as including:

"(a) where the invention is a product—make, hire, sell or otherwise dispose of the product, offer to make, sell, hire or otherwise dispose of it, use or import it, or keep it for the purpose of doing any of those things; or

(b) where the invention is a method or process—use the method or process or do any act mentioned in paragraph (a) in respect of a product resulting from such use."

While this definition makes it clear that certain acts are capable of being held to infringe a patentee's rights, it does not mean that a person who performs one of those acts will always be held to infringe. The provision is not intended to modify the operation of the law on infringement so far as it relates to subsequent dealings with a patented product after its first sale. This applies particularly where a patented product is resold or where it is imported after being purchased abroad. It is intended that the question whether such a resale or importation constitutes an infringement in a particular case will continue to be determined as it is now, having regard to any actual or implied licenses in the first sale and their effect in Australia, and to what is often referred to as the doctrine of "exhaustion of rights" so far as it applies under Australian law.

New Legislation

The Patents Act 1990 commenced on April 30, 1991. The legislation has now been drafted in such a

form that procedural matters may be found in the Regulations, restricting principle and policy issues to prescription in the Act itself. This will ensure that procedures can be more easily amended when neces-

sary by the relatively simple mechanism of amendment of Regulations rather than the more difficult and time-consuming method of amendment via introduction of a new Bill into the Parliament.

New Items

JAPAN

*Commissioner,
Japanese Patent Office*

We have been informed that Mr. Wataru Fukazawa has been appointed Commissioner of the Japanese Patent Office.

Calendar of Meetings

WIPO Meetings

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

1991

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.

**October 17 and 18
(Wiesbaden, Germany)**

Symposium on the International Protection of Geographical Indications (organized by WIPO in cooperation with the Government of the Federal Republic of Germany)

The Symposium will deal with the protection of geographical indications (appellations of origin and other indications of source), at the national and multilateral level.

Invitations: States members of WIPO and certain organizations. The Symposium will be open to the public (against payment of a registration fee).

November 4 to 8 (Geneva)

Committee of Experts on a Possible Protocol to the Berne Convention (First Session)

The Committee will examine whether the preparation of a protocol to the Berne Convention for the Protection of Literary and Artistic Works should start, and—if so—with what content.

Invitations: States members of the Berne Union and, as observers, States members of WIPO not members of the Berne Union and certain organizations.

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.

UPOV Meetings

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

1991

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

September 15 to 19 (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

October 21 and 22 (New York)

International League of Competition Law (LIDC): Study Days

1992

March 16 to 20 (Innsbruck-Igls)

International Federation of Industrial Property Attorneys (FICPI): Executive Committee

October 7 to 10 (Amsterdam)

International League of Competition Law (LIDC): Congress

