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Contents

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Notifications Concerning Treaties

WIPO Convention

Accession

NAMIBIA

The Government of Namibia deposited, on September 23, 1991, its instrument of accession to the Convention Establishing the World Intellectual Property Organization, signed at Stockholm on July 14, 1967, and amended on October 2, 1979.

Namibia will belong to Class C for the purpose of establishing its contribution towards the budget of the WIPO Conference.

The said Convention, as amended on October 2, 1979, will enter into force, with respect to Namibia, on December 23, 1991.

WIPO Notification No. 153, of September 23, 1991.

WIPO Meetings

Paris Union

First Part of the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as Far as Patents Are Concerned

(The Hague, June 3 to 21, 1991)

NOTE*

Background to the First Part of the Diplomatic Conference

In June 1983, the Director General of the World Intellectual Property Organization (WIPO) proposed to the Governing Bodies of WIPO (and, in particular, the Assembly of the Paris Union) that a study be undertaken on the legal effects of public disclosure of an invention by its inventor prior to filing an application. The proposal was adopted and the question was considered in May 1984 at a meeting of the WIPO Committee of Experts on the Grace Period for Public Disclosure of an Invention Before Filing an Application.

Following that initial meeting of the Committee of Experts, it became clear that the question of a grace period could not be dealt with alone. Accordingly, the scope of inquiry of the Committee of Experts was expanded in subsequent meetings, and the name of the Committee of Experts was changed to "Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions." That name was retained throughout the preparatory work for the proposed Treaty Supplementing the Paris Convention as Far as Patents are Concerned (Patent Law Treaty) during the seven years between 1984 and 1991.[1]

In October 1989, the Assembly of the Paris Union decided that, after further preparations during the years 1989 and 1990, a diplomatic conference for the adoption of the Patent Law Treaty should be convened in the second quarter of 1991. These further preparations included a Consultative Meeting of Developing Countries on the Harmonization of Patent Laws, which was held in June 1990. In September 1990, the Paris Union Executive Committee fixed the dates for the Diplomatic Conference as June 3 to 28, 1991.

A preparatory meeting for the Diplomatic Conference was convened in two parts in June and October/November 1990 and took decisions concerning the substantive documents to be submitted to the Diplomatic Conference, the States and organizations to be invited, as well as the draft Rules of Procedure and the draft Agenda of the Diplomatic Conference.

While, as indicated, the dates for the Diplomatic Conference were originally fixed as June 3 to 28, 1991, those dates were reconsidered at an extraordinary session of the Paris Union Assembly in April 1991. That extraordinary session was convened by the Director General following the receipt of written requests from a number of States members of the Paris Union and by virtue of the authority conferred on him by the Assembly of the Paris Union to convene an extraordinary session if he deemed it necessary.

At that extraordinary session, the Paris Union Assembly adopted the following decision:

> "1. The Assembly of the Paris Union, meeting at the request of some members of the Paris Union in extraordinary session in Geneva on April 29 and 30, 1991, decides that the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as far as Patents are Concerned will be in two parts.
> 2. The first part of the Diplomatic Conference will be held in The Hague from June 3 to 21, 1991. It will discuss articles of the basic proposal.
> 3. The date of the second part of the Diplomatic Conference may be recommended by the Diplomatic Conference in its first part and will be considered by the September 1991 ordinary session of the Assembly of the Paris Union...."

When the Assembly adopted the above decision, it was understood that the no final decision on the

* Prepared by the International Bureau.

[1] For a more complete description of the history of the preparations of the Patent Law Treaty, see document PLT/DC/5 of the same title, reproduced in *Industrial Property*, 1991, pp. 168 to 175.

draft Treaty or any of its provisions would be made in the first part of the Diplomatic Conference.

In accordance with the decision of the Paris Union Assembly, and at the invitation of the Government of the Netherlands, the first part of the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as Far as Patents are Concerned was convened and organized by WIPO at the Netherlands Congress Centre in The Hague, from June 3 to 21, 1991.

Participants in the First Part of the Diplomatic Conference

The following 93 States members of the Paris Union and/or WIPO were represented at the Diplomatic Conference: Algeria, Argentina, Australia, Austria, Bangladesh, Belgium, Benin, Brazil, Bulgaria, Burkina Faso, Burundi, Cameroon, Canada, Central African Republic, Chad, Chile, China, Congo, Costa Rica, Côte d'Ivoire, Cuba, Czechoslovakia, Democratic People's Republic of Korea, Denmark, Dominican Republic, Egypt, Finland, France, Gabon, Germany, Ghana, Greece, Guinea, Guinea-Bissau, Haiti, Hungary, India, Indonesia, Iran (Islamic Republic of), Ireland, Israel, Italy, Japan, Jordan, Kenya, Lebanon, Lesotho, Libya, Luxembourg, Malawi, Malaysia, Mali, Malta, Mauritania, Mexico, Mongolia, Morocco, Netherlands, New Zealand, Niger, Nigeria, Norway, Peru, Philippines, Poland, Portugal, Republic of Korea, Romania, Rwanda, Senegal, Soviet Union, Spain, Sri Lanka, Sudan, Swaziland, Sweden, Switzerland, Syria, Thailand, Togo, Tunisia, Turkey, Uganda, United Kingdom, United Republic of Tanzania, United States of America, Uruguay, Venezuela, Viet Nam, Yugoslavia, Zaire, Zambia, Zimbabwe. The delegates from the foregoing States are identified in the list of participants following this Note.

Six intergovernmental organizations and 33 non-governmental organizations were represented. The names of those organizations and their representatives appear in the list of participants reproduced at the end of this Note.

Officers of the Diplomatic Conference

The Diplomatic Conference unanimously elected Mr. Max Engels (Netherlands) as President of the Conference. In accordance with Rule 12 of the Rules of Procedure, there were two Main Committees, Main Committee I and Main Committee II. The Chairman of Main Committee I was Mr. Jean-Louis Comte (Switzerland), and the Chairman of Main Committee II was Mr. Antonio Trombetta (Argentina). The Chairman of the Credentials Committee was Mr. Salah Kamel (Egypt) and the Chairman of the Drafting Committee was Mr. Michael K. Kirk (United States of America). The full list of officers of the Conference appears at the end of this Note.

The Secretariat of the Diplomatic Conference was provided by the staff of WIPO, which was assisted by additional staff placed at the disposal of the Conference by the Government of the Netherlands.

Proceedings at the First Part of the Diplomatic Conference

The Diplomatic Conference was opened by Her Excellency Mrs. Y.M.C.T. van Rooy, Minister for Foreign Trade (Economic Affairs). Opening speeches were also given by Mr. A.J.E. Havermans, Burgomaster of The Hague and Dr. A. Bogsch, Director General of WIPO.

At the first part of the Diplomatic Conference, the 39 Articles of the draft Patent Law Treaty and the 13 Rules of the draft Regulations under the draft Treaty (document PLT/DC/3),[2] as well as 62 proposals for amendment submitted by delegations, were considered.[3]

Main Committee I considered the following Articles contained in the basic proposal: Article 1 (Establishment of a Union), Article 2 (Definitions), Article 3 (Disclosure and Description), Article 4 (Claims), Article 5 (Unity of Invention), Article 6 (Identification and Mention of Inventor; Declaration Concerning the Entitlement of the Applicant), Article 7 (Belated Claiming of Priority), Article 8 (Filing Date), Article 9 (Right to a Patent), Article 11 (Conditions of Patentability), Article 12 (Disclosures Not Affecting Patentability (Grace Period)), Article 13 (Prior Art Effect of Certain Applications), Article 14 (Amendment or Correction of Application), Article 15 (Publication of Application), Article 16 (Time Limits for Search and Substantive Examination), Article 17 (Changes in Patents), Article 18 (Administrative Revocation), Article 20 (Prior User), Article 21 (Extent of Protection and Interpretation of Claims) and Article 23 (Enforcement of Rights).

Main Committee I also considered the following Rules contained in the basic proposal: Rule 1 (Definitions (*ad* Article 2)), Rule 2 (Contents and Order of Description (*ad* Article 3(2))), Rule 3 (Manner of Claiming (*ad* Article 4(5))), Rule 4 (Details Concerning the Requirement of Unity of Invention (*ad* Article 5(1))), Rule 5 (Divisional Applications

[2] Document PLT/DC/3 was reproduced in *Industrial Property*, 1991, pp. 118 to 138, and is hereinafter referred to as the "basic proposal." Also see "Notes on the Basic Proposal for the Treaty and Regulations" (document PLT/DC/4), reproduced in *Industrial Property*, 1991, pp. 139 to 152.

[3] Document PLT/DC/INF/3 lists all of the proposals for amendment of provisions of the basic proposal submitted at the first part of the Diplomatic Conference.

(*ad* Article 5(1))), Rule 6 (Manner of Identification and Mention of Inventor (*ad* Article 6)), Rule 7 (Details Concerning the Filing Date Requirements (*ad* Article 8)), Rule 8 (Announcement in the Gazette of the Publication of an Application (*ad* Article 15(1))), Rule 9 (Announcement in the Gazette of the Publication of a Change in a Patent (*ad* Article 17(5))) and Rule 10 (Announcement in the Gazette of the Grant of a Patent (*ad* Article 18(1)(b))).

Main Committee II considered, in addition to the Preamble, the following Articles contained in the basic proposal: Article 10 (Fields of Technology), Article 19 (Rights Conferred by the Patent), Article 22 (Term of Patents), Article 24 (Reversal of Burden of Proof), Article 25 (Obligations of the Right Holder), Article 26 (Remedial Measures Under National Legislation), Article 27 (Assembly), Article 28 (International Bureau), Article 29 (Regulations), Article 30 (Settlement of Disputes), Article 31 (Revision of the Treaty), Article 32 (Protocols), Article 33 (Becoming Party to the Treaty), Article 34 (Effective Date of Ratifications and Accessions), Article 35 (Reservations), Article 36 (Special Notifications), Article 37 (Denunciation of the Treaty), Article 38 (Languages of the Treaty; Signature) and Article 39 (Depositary).

Main Committee II also considered the following Rules contained in the basic proposal: Rule 11 (Absence of Quorum in the Assembly (*ad* Article 27)), Rule 12 (Requirement of Unanimity for Amending Certain Rules (*ad* Article 29(3))) and Rule 13 (Settlement of Disputes (*ad* Article 30)).

LIST OF PARTICIPANTS

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Studies

The WIPO Harmonization Treaty and the Grace Period

H. BARDEHLE*

I. The Current Status of the WIPO Harmonization Treaty[1]

The project of the World Intellectual Property Organization (WIPO) to establish a treaty for the harmonization of formal and substantive patent law within the framework of the Paris Convention led to a decision by the Paris Union Executive Committee, in September 1990, following careful preparation in eight one or two-week meetings of a Committee of Experts, to hold a Diplomatic Conference in The Hague in June 1991 to conduct the final negotiations on the basic proposal (the final draft of the Treaty) that had been prepared by WIPO as a result of the preparatory work and to sign the text of the Treaty. The whole project was then called into question by the fact that the United States of America was unable to accept relinquishment of its first-to-invent principle and to adopt the first-to-file principle in its place. In view of that basic problem, consideration was given to postponing the Diplomatic Conference that had already been scheduled and prepared. In a hastily convened, extraordinary Assembly of the Paris Union held on April 29 and 30, 1991, it was nevertheless decided that the Diplomatic Conference would be held in two parts, that is to say, a first part from June 3 to 21, 1991, and a second part once there was the prospect of reaching a compromise on the diverging positions of the Paris Union member States. Additionally, the negotiations in GATT also play a part and a positive outcome to the Uruguay Round would exert considerable influence on the wording of the Harmonization Treaty. It is therefore not possible to say at present when the second part of the Diplomatic Conference will take place. Even if the Uruguay Round does not lead to a positive outcome, it is hoped that WIPO will not drop the idea of harmonization and, with the agreement of the Paris Union Assembly, will hold the second part of the Diplomatic Conference even in the absence of results in GATT. This could happen within the next two years. In addition to the first-to-file in lieu of first-to-invent problem (Article 9) that concerns solely the United States of America, there also exist basic misconceptions as to the function of an international grace period (Article 12), the point of departure for the harmonization project, which still constitute the basic obstacle on the path towards conclusion of the Treaty. An outright battle has broken out on the subject of the grace period that is quite beyond all those who have or, at least, had experience of a grace period. It is my conviction that the violent rejection of a grace period, particularly on the part of numerous European countries, springs from a profound misunderstanding which I hope to clear up to some extent in my explanations below.

II. The Grace Period in the First-to-File and First-to-Invent Systems

In first-to-file countries that offer their applicants a grace period (Australia, Canada, Japan, Soviet Union)[2] or which had to relinquish it (Germany), it is not understood as an invitation to thoughtless prior disclosure of the subject matter of one's own subsequent application, but as a safety net in the event of unavoidable or unintentional disclosure. There are absolutely no objections in those countries to maintaining the grace period, or reintroducing it wherever possible, as a period of time preceding the priority date and which also has effect with respect to subsequent priority applications (contrary to former German law). In the United States of America, as a first-to-invent country, the grace period applicable there is understood in a different way since it forms a harmonious integral part of the first-to-invent system. The basic difference in the comprehension of the grace period in first-to-file countries and that in the first-to-invent country

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[1] WIPO document PLT/DC/3 of December 21, 1990, and comments by Pagenberg in *AIPLA Quarterly*, Vol. 19, 1991, pp. 1 to 23.

[2] WIPO document HL/CE/I/2, Annex I.

United States of America is that, in the first-to-file countries, the state of the art created by an applicant during the grace period maintains that characteristic, although with the exception that it is not taken into account for the subsequent application by the applicant (or his successor in title). However, this state of the art remains accessible to the community at large just as any other prior art. Anyone making use of the prior art must simply check whether a valid third-party title exists that has been applied for in parallel. All acts performed by the person utilizing this prior art are and remain lawful if they have been carried out prior to the filing date of the relevant title. The understanding of the state of the art in first-to-file countries permits no other interpretation, and particularly not a priority effect deriving from publication, constituting the generation of a right with respect to third parties. The grace period forming part of the first-to-invent system in the United States of America, on the other hand, has a quite different basis. With the creation of the invention (conception date), the inventor already enjoys a priority right with respect to inventions made subsequently, which is not affected by disclosure by the inventor. The grace period applying in the United States of America is simply an administrative provision since, in the event of disclosure by the inventor, he must file his patent application within one year of such disclosure.

In practice, this has the consequence under the first-to-file system that any third party has freely available access to the state of the art created by the inventor during the grace period and on that basis may claim a right of prior use if the necessary acts have been performed, that is to say, prior utilization before the day on which the relevant application is filed, whereas, in the first-to-invent system, the only question that may arise is whether the prior user or the subsequent applicant is to be considered the first inventor. In the first-to-invent system, therefore, the legal institution of the right of prior use does not exist since it would run counter to the system.

III. The Position in the United States of America

In the negotiations within the Committee of Experts (see Chapter I, above) on the WIPO Harmonization Treaty, the delegates from interested circles in the United States of America were shocked to learn of this possibility for the generation of the right of prior use. They considered it a "derivation" in the sense of a dishonest appropriation of the inventor's intellectual property, which was altogether understandable if viewed on the basis of the first-to-invent system.

One could acknowledge those misgivings that prevail in the United States of America as regards this "derivation" and look for a compromise in order to make it more difficult for a right of prior use to arise during the grace period. However, as explained below, that would raise considerable problems. It is not possible to assume any dishonesty on the part of the prior user since all he does in that situation is to use the state of the art. If intellectual theft is involved, on the other hand, then it cannot be a matter of the state of the art since the state of the art is available to society in general. That means that it cannot be stolen. A "derivation" in the meaning given above could only be prevented if a kind of priority right were afforded to prior disclosure by the inventor (under what is called a first-to-publish system) with the result that the grace period that would precede the Paris Convention term of priority under the Harmonization Treaty would be extended by such grace period (by at least the period of time between prior disclosure and filing of a corresponding application). That, however, is strictly rejected by the opponents of the grace period, in my view quite justifiably. The purpose of the grace period, whose practical significance will be described in greater detail in Chapter IV, is not to extend the term of priority. Apart from which, if a kind of priority were afforded to the inventor's prior disclosure there would immediately arise the problem of the unequivocal scope of the relevant prior disclosure, which would also concern public prior use or oral disclosure. The difficulty in determining the technical scope of disclosure of some such prior communication, which does not exist under the Paris Convention priority right based on the priority document issued by the office of first filing, would lead to considerable legal uncertainty, particularly where the original scope of disclosure would have to be determined in a dispute a long time after the filing date. Even if the proposed right of prior use in connection with the grace period is unwelcome in the first-to-file system, such a right must nevertheless be accepted as a necessary element in view of the fact that a priority right derives exclusively from the filing date in the first-to-file system. Nevertheless, this does not mean that the grace period would be devalued to such an extent as not to be still urgently desirable.

The risk that a right of prior use will arise during the grace period is exaggerated by its opponents. In my practical experience with the grace period, not a single case of such kind has ever come to my notice. Indeed, the right of prior use is a rare exception. Theoretically the grace period facilitates the generation of a right of prior use. However, the fact that no particular problems obviously arise in practice probably derives from the fact that a considerable amount of effort is nevertheless needed, if knowledge is gained of disclosure by a competitor, to examine the invention that is possibly contained therein as to its practical usability and then make at least serious

preparations for putting production in hand. The right of prior use applicable in Germany and the practically identical right of prior use in the WIPO Harmonization Treaty (Article 20) demand more than simple projects for possible implementation. Finally, in order to qualify for a right of prior use it will be necessary as a rule to have made preparations over some months and to have produced design drawings, meaning that the period of time between the prior disclosure of an invention and the subsequent filing of a patent application, that is limited by the grace period, will normally be exceeded. The right of prior use has therefore not proved a means of undermining exploitation of the grace period in practice.

IV. Purpose and Function of the Grace Period[3]

The grace period in a first-to-file system, as it also existed in Germany prior to the entry into force of the Strasbourg Convention on the Unification of Certain Points of Substantive Law on Patents for Invention,[4] serves primarily as a kind of safety net in order to catch *unavoidable or unintentional prior disclosure on the part of the inventor* and thereby remove its destructive effect on the patent applied for by the inventor during the grace period. An example is the invention of the sailboard which could only be tested in the open if the invention was to be fully developed. Such cases arise with great frequency in industry. Current examples concern agricultural appliances and machines for manufacturing goods, for example, shoes and chemical products. Such appliances and machines can only be tested openly or in manufacturing plants. Secrecy is not as a rule to be guaranteed in such plants. The wish for secrecy, however understandable, is almost always refused by the plants concerned due to the question of liability. In addition, the concept of absolute novelty introduced by the Strasbourg Convention, and the fact that oral disclosure destroys novelty, has brought a further stumbling block for those applicants who *have to make early reference in business negotiations to new products and new processes* to avoid losing orders through which the activities of their own undertaking and of its work force would be secured.

Taking the facts set out above, particularly in Chapter II, it is shown that the view that a grace period in a first-to-file system leads inventors to disclose their inventions in writing as soon as possible after they are completed is unfounded. This (erroneous) view has led to the fear that an inventor, by means of the earliest possible prior disclosure, could place his competitors in a waiting situation that is extended by the grace period, which would, without the grace period, be a maximum of 18 months, namely, for the period of secrecy of a patent application. This point of view assumes an absurd behavior on the part of inventors and applicants of a kind which has never occurred, at least during the time the grace period applied in the Federal Republic of Germany, and therefore is not to be feared since no sensible inventor or applicant would entertain the risk, through unnecessarily premature disclosure of his invention, of inciting his competitors to begin as quickly as possible with further technical development and to create for themselves a right of prior use by making corresponding preparations. Thus, the rule that a patent should be filed as quickly as possible after the creation of an invention, that applies under the first-to-file system, loses none of its meaning if a grace period exists.

When an invention is nevertheless disclosed, the competitor thereby obtains at an early stage information for which he would otherwise have had to wait a long time since without such prior disclosure he would not have become aware of the invention until the corresponding patent application was published. Does this mean that the situation of a competitor who is aware of the prior disclosure is worse than that of another competitor who, for some reason or other, has not seen the prior disclosure and does not become aware of the invention until the corresponding application is published? There is a considerable difference in the level of information between the two competitors in that the one already possesses information on the invention, for example, 21 months (three months utilization of the grace period plus the 18-month publication term) before publication of the application, whereas the other competitor is taken by complete surprise when the application is published. *The opponents of the grace period, for whom disclosure of an invention prior to filing of an application is a thorn in the side, cannot seriously pretend that the lack of information ("information deficit") in the event of not having been informed at an early stage is more felicitous than the additional information ("information surplus") enjoyed by the person with access to early knowledge.*

It is my conviction that the refusal of the grace period in the Scandinavian countries, as also in Belgium, France, Italy and to some extent in Austria as well, that is basically derived from the waiting considerations described above, has no practical foundation. As far as I am aware, in those countries the opposition stems only from those firms that are

[3] See also Bossung, GRUR Int., 1978, p. 381; von Pechmann, GRUR, 1980, p. 436; Bardehle, GRUR, 1981, p. 687 and *Industrial Property*, 1982, p. 279; Pagenberg, GRUR, 1981, p. 690; Loth, *Schriftenreihe für gewerblichen Rechtsschutz*, Vol. 73; M. Koktvedgaard and L. Østerborg, "A Novelty Grace Period for Patent Applications," Study for the Commission of the European Communities, 1984.

[4] *Blatt für Patent-, Muster- und Zeichenwesen*, 1964, p. 372; *Industrial Property*, 1964, p. 13.

not subject to the problem of the unavoidable prior disclosure described above since in their technical branch it is possible to test their own products within their own closed facilities. These firms, that do not need the grace period, but which is also of no disadvantage to them, have so far succeeded with their considerable influence in depriving particularly medium-sized firms of the grace period that is so important for them. In addition, there also exists an underlying fear that introduction of the grace period would lead to a reduction in the number of applications to be filed since it is possible that during the period of grace certain of the inventions would prove to be technically or commercially insufficient and that would therefore lead to a corresponding reduction in the work load of the office concerned. This absurd fear would in fact not only be limited to patent attorneys. Patent departments in industry also have an interest in proving their capabilities through a corresponding number of patent filings.

V. The Situation of Scientists[5]

Scientists constitute an exception since their own professional prestige demands that they should publish their scientific findings as rapidly as possible. This is an undeniable fact and the problem cannot be solved by simply giving good advice since for the majority of scientists their own specific rules apply and those have also to be recognized by society at large. That means that scientists will continue to rush into print and that has led in many cases of fundamental ideas that inventions contained in the scientist's findings having been deprived of patentability by the action of the inventors themselves. Well-known cases of genetic engineering have indeed led to corresponding patents in the United States of America as a result of the grace period, but have been refused patent protection outside the United States of America.[6] In view of the frequently enormous investments that have to be devoted to creating such inventions, the present situation is untenable since the lack of protection deprives the institutes involved of the possibility of financing their investments through the price of patented products. That is a topic that hardly needs to be discussed, even amongst economists.

It would almost certainly be possible, if the grace period were to apply, to incite scientists to file patent applications as rapidly as possible in every case, independently of their own publications. Why should scientists wait for filing a patent application and possibly make complete use of a grace period? This would simply open them to the danger of someone else obtaining a right of prior use. In any event, the situation of scientists would also be considerably improved if they were able to avail themselves of a grace period when compared with the present situation in which they frequently destroy the novelty of their inventions due to their own early publications.

VI. Bringing Together Prior Disclosure and Published Patent Applications

In the discussions on the grace period under the first-to-file system, Japan previously asked that a provision be included in the WIPO Harmonization Treaty under which the filing of an application would include a "declaration" of any disclosures made during the grace period. The filing of such a "declaration" is hardly feasible in all those cases in which disclosures have taken place due to test runs outside the firm's premises or due to commercial negotiations and which are not necessarily known to the inventor and therefore equally not known to the patent attorney drafting the application nor to the patent department of an industrial firm. It is simply impossible to disseminate knowledge of such processes, whose patent law impact is mostly not at all obvious to those involved, within a firm in such a way that should an application be filed they could also be fully taken into consideration. An incomplete "declaration" is therefore unavoidable in such cases and therefore a sanction, particularly loss of the right to claim the grace period, would not be compatible with practice.

Acceptance of a "declaration" for which there exists a model in the Japanese Patent Law, would thus introduce a pitfall into the concept of the grace period. In this form, the "declaration" is unacceptable. During the first part of the Diplomatic Conference (see Chapter I, above), no further proposal for such a "declaration" was submitted. This does not mean that it may not arise again, however. That could make it necessary to consider a compromise with respect to such a "declaration."

On closer consideration of the arguments of the opponents of the grace period it transpires that a major part is played by prior disclosure in specialized periodicals. Such prior disclosure generally originates from the inventor himself. Assuming that to be the case, in the event of a subsequent patent application it can be determined, by questioning the inventor, whether there was prior disclosure, which could then be recorded in a "declaration" based on best knowledge. It should therefore be considered, as a compromise, whether the "declaration" could be restricted to prior disclosure by the inventor himself, thereby taking the wind out of the sails of the opponents of the grace period in Europe in this respect.

[5] "The Significance of the Novelty Grace Period for Non-Industrial Research in the Countries of the European Economic Community," Commission of the European Communities, Report EUR 11271 EN.

[6] Wade, *Science*, November 9, 1979, Vol 206, p. 664.

The opponents of the grace period further argue that it is not possible to see from a prior disclosure whether it has a relation with a published application and whether the grace period has been claimed. That can be countered since such a need may only arise if the corresponding application has been published, since only then does possible destruction of novelty by the disclosure become relevant. Furthermore, utilization of the state-of-the-art teaching given in disclosures is always attended by the risk that immediately prior to issue of a publication a corresponding patent application may have been filed meaning that, in view of the usual early publication of applications after 18 months, any interested person would have to wait 18 months and would have to monitor the relevant published applications during that period in order to determine whether they included a corresponding application that had to be taken into consideration. If no such application is discovered and if the interested person had immediately after the disclosure made appropriate preparations for subsequent fabrication, he would then have a right of prior use with respect to a subsequently-filed application for which the grace period had been claimed for the disclosure involved, that is to say, would not be hindered by the corresponding title of protection. However, if that person waits and subsequently determines that there is a corresponding application, he could obtain clarity by asking the applicant whether he is claiming the grace period for his application in respect of the relevant prior disclosure. Such a request, however, would seem unwelcome to the opponents of the grace period since they are unwilling to uncover their faces, and thereby their interest in the subject matter concerned, for reasons of commercial policy.

In order to take this factor into account, it would be simple to give the patent offices the task of communicating a request by an interested party, with regard to possible claiming of the grace period in connection with a prior disclosure and a subsequent patent application, by means of an anonymous form to the applicant who would then be required to make a corresponding declaration. Such a procedure cannot be deemed, for example, to constitute unjustified secrecy as to the person submitting the request with regard to the applicant, since in the case of requests for inspection of files no information is usually disclosed to the applicant with respect to the person making the request. It is altogether acceptable for an applicant claiming the grace period to disclose his position to the patent office in the event of an interest in clarifying the legal situation, which would then be further communicated to the person putting the question, as in the case of inspection of files.

VII. Conclusion

The aim of the above considerations is to prove that the need for information with regard to the claiming of the grace period in connection with prior disclosure of the state of the art can be quite easily satisfied. A provisional legal uncertainty does not exist in practice any longer than the usual 18-month period prior to publication of any patent application since, if the interested party concerned is not able to ascertain any relevant application 18 months after public disclosure of an invention immediately followed by his own preparations for production, he would be covered by his right of prior use as shown under Chapter II. Interested parties indeed have an advantage, in the event of prior disclosure by the inventor, of having received early warning in good time of the invention made by a competitor. However, the opponents of the grace period are unwilling to admit it. Surprisingly, they consider this prior disclosure an evil and would apparently be happy if there were no such early warning.

The argument advanced by the opponents of the grace period that they are kept in uncertainty not only for the 18 months up to publication of an application, but, where the grace period is claimed, for a further correspondingly extended period of time, does not therefore hold good. If an undertaking is basically interested in the patenting policy of its competitors, readily manageable means of clarifying the legal situation can be provided, that is to say, an anonymous request to the applicant, to be communicated via the patent office, as to whether he claims the grace period or not for a published patent application with respect to a specific prior disclosure.

Either the opponents will continue to try to prevent the grace period, to the disadvantage particularly of medium-sized industrial firms which urgently need the grace period for the reasons given above, or they will acknowledge that they would have no problem in living with an appropriately-designed grace period. The latter would decisively facilitate the grand overall aim of WIPO to achieve worldwide harmonization of patent law.

The Protection of Biotechnological Inventions Within the Framework of the European Patent Organisation and, More Particularly, in France

E. GUTMANN*

Preliminary Remarks: The Remaining Uncertainties in Respect of the Breadth of Patentability Exclusions in Europe

"Biotechnology," within the usual meaning of the term, generally relates to techniques applicable to the transformation of living matter, to the means which these techniques rely upon, and finally to the resulting products themselves, often "living matter."

Some inventions which belong to the field of biotechnology are still excluded from patentability in most European States, pursuant to national legislation[1] or to Article 53 of the European Patent Convention (EPC) in those States which ratified the Convention. The provisions of Article 53 EPC are set forth hereinafter:

> *"Exceptions to patentability*
>
> European patents shall not be granted in respect of:
>
> (a) inventions the publication or exploitation of which would be contrary to 'ordre public' or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all of the Contracting States;
>
> (b) plant or animal varieties or essentially biological processes for the production of plants or animals; this provision does not apply to microbiological processes or the products thereof."

These exclusions from patentability have sometimes been specifically justified in the past on the ground that the possibilities of transforming living matter were restricted and also fortuitous or contingent.

However, biotechnology has evolved considerably, particularly within the last 20 years. Owing to a better knowledge of the internal structure of living organisms, especially of their genetic material, man has progressively mastered processes which nature itself sometimes brings into play, on a more limited scale, in order to exchange genetic materials among distinct organisms.

Modern biotechnology tends to substitute predetermined and reproducible modifications of the genetic patrimony–one also refers to it under the word "genome"–of the organisms concerned, for the fortuitous or contingent operations which formed the matrix of classical microbiological techniques (mostly selection and induced mutations which sometimes entailed the creation of new characteristics or "phenotypes" which most often escaped analysis). These predetermined and reproducible modifications imply, for instance, an artificial transfer to these organisms of a genetic material normally foreign thereto under conditions which enable them to acquire the new phenotype.

In the field of plants, one observes an explosion in the concept of species. Henceforth, genetic engineering would allow the same genetic material to be incorporated in the genomes of plants fully unrelated to one another, yet conferring artificially upon all a new common trait, for instance, resistance to a determined category of herbicides or insects. The plant species or "transgenic plants" so obtained are then characterized by the presence in their respective genomes of such common genetic material and, where appropriate, of the "genotype" which can then be correlated with the common trait or "phenotype."

Results of a similar nature have already been obtained in animals. For instance, the same genotype capable of inducing the synthesis of a growth hormone characteristic of a specific animal species has been incorporated successfully in the genomes of different animal species!

Should then the exclusions from patentability which affect different categories of inventions involving living matter, more especially those having the characteristics specifically referred to in the first part of paragraph (b) of Article 53 of the EPC, be withheld? Should not doubts regarding the patentability of neighboring inventions, particularly those not explicitly addressed by Article 53(b) be removed, where the relevant provisions would be interpreted restrictively, particularly where Article 53(a) would not be enforceable against them?

These questions are all the more acute as henceforth the processes used for obtaining technical results will often be reproducible and liable of being described, whereby the obstacle of their impossible description, often referred to in the past to prevent patenting such inventions, can then be overcome. It may be noted that the possible patentability of microbiological processes and products obtained thereby, including living microorganisms, became part of the customs, then of the law, when obstacles of the same nature were overcome due to the

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[1] See, for instance, Section 7 of the French Patent Law (Law No. 68-1 of January 2, 1968, modified by Law No. 78-742 of July 13, 1978); see *Industrial Property Laws and Treaties*, FRANCE – Text 2-001.

deposits of such microorganisms with recognized depositary institutions. The conditions governing these deposits and the subsequent availability of these microorganisms to the public have become subject to various treaties, conventions and laws.[2]

Other categories of inventions which bring into play living matter and which would escape the patentability-excluding provisions of Article 53 of the EPC or of similar provisions in the national laws of some European States have been the subject of in-depth studies.[3] However, the border between biotechnological inventions which bear on higher organisms, including plants and animals, which are excluded from patentability and those which are not is not yet clearly drawn.

Problems of a legal nature add up to the technical complexity of this subject; these legal problems relate to the coexistence of the patent systems with distinct protection systems for plant varieties which are subject to specific terms (novelty, stability and homogeneity) within the meaning of the International Convention for the Protection of New Varieties of Plants, adopted on December 2, 1961,[4] and often designated as the "UPOV Convention."[5]

The member States of UPOV abided by their duty to implement the provisions of this international convention in the event that they should adopt a protection system for plant varieties distinct from their patent systems, had they not yet earlier done so, at the national level. Reference will yet be made herein to a long-standing difficulty that arose from the prohibition, which the Contracting States of the EPC, also signatories of the UPOV Convention, adhered to, against the cumulative use of the two protection systems: plant varieties could not be protected both by a patent and a breeder's right.[6]

The competent international organizations understood very soon the significance of the technical and legal issues which were at stake, with a view towards rapidly removing uncertainties in the breadth of the technical fields likely to be either protected or excluded from protection by patents. For that purpose, the in-depth studies undertaken by the Committee of Experts on Biotechnological Inventions and Industrial Property, set up in 1983 by the World Intellectual Property Organization (WIPO), led to proposals for the protection of biotechnological inventions.[7] It was suggested that the States could, if appropriate, adopt them either in the form of legislative or regulatory provisions or as rules of interpretation of patentability-excluding provisions still in existence in their own laws.

Work has also been undertaken along the same lines by the Commission of the European Communities. This work resulted, among other proposals, in one entitled "Proposal for Council Regulations related to the legal protection of biotechnological inventions."[8]

These different proposals concurred in the wish that any new legislation should expressly provide that a product shall not be excluded from patent protection or regarded as unpatentable for the mere reason that it constitutes or includes living matter.

WIPO and UPOV were also to coordinate their thoughts in respect of possible future interactions of patent laws on the one hand, and of the protection systems of breeders' rights on the other.[9] This joint work contributed undoubtedly to the more rapid adoption, in Geneva in March 1991, of a new revised Act of the UPOV Convention.

One important innovation provided by that revised Convention removes the bar against double protection of plant varieties under the two legal systems (patents and plant breeders' rights). But the revised Convention is not yet in force. Reference must also be made to another proposal for a guideline originating from the Commission of the European Communities, specifically for the protection of plant varieties. This proposal maintains the principle of the bar against cumulative protection of a plant variety both by a patent and a breeder's right.[10]

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[2] See particularly the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure of April 28, 1977, which entered into force on August 19, 1980, *Industrial Property Laws and Treaties*, MULTILATERAL TREATIES – Text 2-004, and Rules 28 and 28a of the EPC relative to the requirements of European patent applications relating to microorganisms.

[3] See, for instance, the reports of Reid. G. Adler, "Can Patents Coexist with Breeders' Rights? Developments in US and International Biotechnology Law," IIC, Vol. 17, No. 2, 1986; Bernard M. Roth, "Current Problems in the Protection of Inventions in the Field of Plant Biotechnology–A position paper," IIC, Vol. No. 1, 1987; Joseph Straus, "AIPPI and the Protection of Inventions in Plants–Past Developments, Future Perspectives," IIC, Vol. No. 5, 1989; Joseph Straus, *"Ethische, rechtliche und wirtschaftliche Probleme des Patent- und Sortenschutzes für die biotechnologische Tierzüchtung und Tierproduktion"*; GRUR Int., No. 12, December 1990, p. 913.

[4] This Convention was revised in Geneva, on November 10, 1972, October 23, 1978, and recently on March 19, 1991.

[5] "UPOV" is the abbreviation of the corresponding French designation *Union internationale pour la protection des obtentions végétales* (International Union for the Protection of New Varieties of Plants) which was created by that Convention.

[6] The text of Article 2(1) of the UPOV Convention, as revised on October 23, 1978, and relative to the "forms of protection," was formulated as follows:

"Each member State of the Union may recognize the right of the breeder provided for in this Convention by the grant either of a special title of protection or of a patent. Nevertheless, a member State of the Union whose national law admits of protection under both these forms may provide only one of them for one and the same botanical genus or species."

[7] See, particularly, WIPO document BioT/CE/IV/3 of June 24, 1988, entitled "Revised Suggested Solutions Concerning Industrial Property Protection of Biotechnological Inventions."

[8] Of October 21, 1988; COM (88) 496 final/SYN 159.

[9] See, particularly, the report of the Committee of Experts on the Interface between Patent Protection and Plant Breeders' Rights of February 12, 1990, document WIPO/UPOV/CE/I/4.

[10] See Proposal for a Council Regulation (EEC) on Community plant variety rights, *Official Journal of the European Communities*, No. C 244/1, September 28, 1990.

Last but not least, Article 53(b) of the EPC is still in force. Needless to say, the border between biotechnological inventions excluded from patentability and inventions that are not has not yet been definitively drawn.

Thus, the EPO orientations in this matter, particularly the case law of its Boards of Appeal in this still uncertain legal space, may play a significant role, even influence the eventual evolution of patent rights in the field of biotechnology.

Patentability Problems Within the Framework of the European Patent Convention

Microorganisms

The possible patentability of new microorganisms has been held to be acceptable by the EPO as from the date the EPC entered into force, in the light of the second part of the sentence of paragraph (b) of Article 53 of the EPC. That second part provides that the exceptions to patentability do not apply to "microbiological processes or the products thereof." Hence, a microorganism produced by a microbiological process could be patented. A Notice of the President of the EPO, dated December 12, 1981,[11] concerning amendments to the "Guidelines for examination in the European Patent Office," pointed out that the concept of "microorganism" was to be understood as extending also to genetic "tool" elements, for instance, plasmids and viruses.

It should be noted that all examining divisions of the EPO consider that any cell cultures in a non-differentiated state, including those obtained from plants or animals, must be treated as microorganisms.

Microbiological Processes

This term is interpreted very broadly by the EPO. The Notice of the President of the EPO previously cited provides the following general definition:

> "The term 'micro-biological process' is to be interpreted as covering not only industrial processes using micro-organisms but also processes for producing new micro-organisms, e.g., by genetic engineering."

Patents for microorganisms, cell cultures (for instance, hybridomas[12]) and microbiological processes for producing them are currently granted by the EPO, whenever the inventions concerned, as disclosed and claimed, satisfy the usual patentability criteria.

The EPO pays great attention to the sufficiency of the disclosure of a process which should enable a "person skilled in the art" to reproduce the invention. This reproducibility requirement is, of course, as important in relation to a microorganism if it itself consists of the claimed subject matter. However, according to the Notice of the President of the EPO already cited, the disclosure of a process for the production of that microorganism is not necessary if it has been deposited as provided by the requirements of Rule 28 of the EPC. In effect:

> "repeatability is assured by the possibility of taking samples (Rule 28(3) EPC), and there is thus no need to indicate another process for the production of the micro-organism."

According to an opinion of one of the EPO Boards of Appeal in the so-called *Alpha-interferons/BIOGEN* decision 14,[13] such a deposit can be considered as a:

> "starting point and can be interpreted as a basis of an implied product-by-process definition for the end-product in question since the latter can be reliably obtained by commonly known steps of isolation or be used *in situ* operatively for cloning, etc."

It is worth noting that the Federal Court of Justice *[Bundesgerichtshof]* of the Federal Republic of Germany reached substantially the same conclusions in the national framework, in the so-called *Tollwutvirus* case.[14]

Plants

The Boards of Appeal of the EPO expressed very early a deliberately restrictive position with respect to the patentability exceptions defined in Article 53(b) EPC with respect to new plants. One of the reasons relied upon by a first Board of Appeal in the so-called *Propagating Materials/CIBA-GEIGY* case,[15] repeated in several subsequent decisions, is worth citing in its entirety:

> "2. No general exclusion of inventions in the sphere of animate nature can be inferred from the European Patent Convention (cf. Article 52(1) in conjunction with Article 53(b) after the semi-colon, and Rules 28 and 28a EPC). However, Article 53(b) EPC before the semi-colon prohibits the granting of patents for certain biological inventions. This provision, which needs to be examined more closely in the present case, says that patents shall not be granted in respect of plant varieties or essentially biological processes for the production of plants. The skilled person understands the term 'plant varieties' to mean a multiplicity of plants which are largely the same in their characteristics and remain the same within specific tolerances after every propagation or every propagation cycle. This definition is reflected in the International Convention for the Protection of New Varieties of Plants of 2 December 1961, which is intended to give the breeder of a new plant variety a protective right (Article 1(1))

[11] *Official Journal of the EPO* (OJ EPO), 1/1982, p. 19.

[12] A hybridoma is a hybrid cell resulting from the cell fusion of a lymphocyte of which it retains the capacity of permanently producing the "monoclonal" antibody normally produced for a short duration by this lymphocyte, on the one hand, and of a tumorigenic, particularly myeloma cell from which it acquired the capability of being grown *in vitro*, in an appropriate medium, on the other hand.

[13] OJ EPO 8/1990, pp. 335.

[14] *Tollwutvirus* (rabies virus) case, published in OJ EPO 9/1987, pp. 429.

[15] OJ EPO 3/1984, pp. 112.

> extending both to the reproductive or vegetative propagating material and also to the whole plant (Article 5(1)). Plant varieties in this sense are all cultivated varieties, clones, lines, strains and hybrids which can be grown in such a way that they are clearly distinguishable from other varieties, sufficiently homogeneous, and stable in their essential characteristics (Article 2(2) in conjunction with Article 6(1)(a), (c) and (d)). The legislator did not wish to afford patent protection under the European Patent Convention to plant varieties of this kind, whether in the form of propagating material or of the plant itself."

and the Board of Appeal further stated:

> "4. The very wording of Article 53(b) EPC before the semi-colon precludes the equation of plants and plant varieties, which would also be at variance with the general sense of the provision. Plant varieties were excluded from European patent protection mainly because several of the signatory States to the European Patent Convention have developed special protection for plant breeding at national and international level...."

The Board of Appeal concluded that claims for a new product consisting of a reproduction material, particularly seeds, which had undergone a chemical treatment in order to protect them against the phytotoxicity of compounds used in agriculture were valid. Further support of patentability was found in the fact that the treatment was applicable to any reproduction material, whether it satisfied the criteria of homogeneity and stability required for plant varieties by the UPOV Convention or not.

Applying the same principles, the same Board of Appeal acknowledged in a subsequent Decision known under the headword *Hybrid plants/LUBRIZOL*,[16] the validity of a claim relating to populations of hybrid seeds and of plants obtained from such seeds on the ground that they did not possess the homogeneity and stability features which would possibly have enabled them to benefit from protection by plant breeders' rights.

What then about plants and seeds, for example, developed from plant cell cultures transformed by a genetic engineering process and including a foreign genetic material integrated into their genome and capable of being expressed in a stable fashion in the form of a new characteristic trait or "phenotype" in such plants, although induced by an initial "artificial micro-reconstruction" of the genome reproduced by subsequent replication cycles?

This question would deserve all the greater consideration as the initially transformed plant cell cultures would be derived from a "plant variety" and as the genetically transformed plant or "transgenic plant" obtained would itself apparently be considered as possessing all the attributes of a "plant variety," except for the "non-natural" character of the newly acquired phenotype.

The decisions discussed above do not provide a clear answer to this question. This will be reverted to hereinafter. Could the answer be linked to the question of the "essentially biological" character of the process for obtaining such genetically transformed plant? It should, however, be underlined that the EPO has already started granting patents including claims to such genetically engineered plants, without specific reference to a process for their production.[17]

Animals

The situation of transgenic animals has not yet been clarified. Faced with a patent application relating to a transgenic animal, an Examining Division of the EPO, in the so-called *Oncomouse/HARVARD* case,[18] rejected the claims to the transformed animal, particularly on the ground that no intellectual property laws existed that permitted some animal varieties to be protected, like plant breeders' rights for plant varieties under the meaning of the UPOV Convention. The Examining Division further based its rejection on variations in the definitions in the three official languages of the EPC, of the animals expressly excluded from patentability: "*races animales*," "animal varieties," and "*Tierarten*." According to the Examining Division, the founders of the European Patent Convention did not intend to exclude from patentability just particular categories of animals, but rather all animals, as evidenced by the more general meaning of the German term *Tierarten*.

The Examining Division also questioned the validity of those claims which could only be treated as "process claims" for the production of transgenic animals. The claims under consideration comprised two steps, namely, a first step that could effectively be considered as a "non-essentially biological" process (insertion by micro-injection of an activated oncogenic sequence–the "Myc" sequence–in the genome of cells of an animal which was still at an embryonic stage) and a distinct second step having a "biological" character (sexual reproduction and selection of the transgenic animal under consideration). For the Examining Division, these two steps yielded two different products, a finding which led the Examining Division to the following observation:

[16] OJ EPO, 3/1990, pp. 71.

[17] See, for instance, claim 21 of European Patent EP 0242236 B1:

> "Plant, non biologically transformed, which possesses, stably integrated in the genome of its cells, a foreign DNA nucleotide sequence encoding a protein having a non-variety-specific enzymatic activity capable of neutralizing or inactivating a glutamine synthetase inhibitor under the control of a promoter recognized by the polymerases of said cells."

It will be noted that the glutamine-synthetase inhibitor whose inactivation or neutralization was sought consisted in fact in a powerful non-selective herbicide. The incorporation of the corresponding genetic sequence into the genomes of the plants concerned–particularly crops–aimed at the destruction of weeds of the cultivated fields treated with such herbicide. Of course the cultivated plant was itself protected against the destroying activity of the herbicide, since it had been given the means which enabled it to inactivate or neutralize the herbicide.

[18] OJ EPO, 11/1989, pp. 451.

"Animals which were genetically manipulated themselves are products of a non-essentially biological process, whereas further generations are the product of sexual reproduction which is exclusively biological; therefore, the latter products do not fall under Article 53(b) second part EPC. The artificial connection of the two steps aims at circumventing the exclusion provision in Article 53(b) first part EPC. This does, however, not dispense with the need to evaluate the biological or non-biological character of each step according to its own merits."

And according to the Examining Division, the second part of Article 53(b), which provided for an exception in support of the patentability of microbiological processes, could not lead to a derogation to the exclusion from patentability provided in the first part against animal varieties. Hence, the process claims had to be rejected on the ground that the final product of the process was manifestly excluded from patentability by the first part of Article 53(b).

Bearing in mind, however, the possibility that such inventions could have beneficial effects for mankind, the Examining Division abstained from deciding the non-patentability of the invention on another ground, i.e., the ground provided by Article 53(a) of the EPC in respect of inventions contrary to public order or morality.

However, the Board of Appeal of the EPO disagreed with the Examining Division in a decision delivered on October 3, 1990.[19] The Board asserted that the legislative history of the Strasbourg Convention of November 27, 1963,[20] on the unification of certain points of substantive law on patents for invention and of the EPC did not support in any way the assumption of the Examining Division, relative to the exclusion from patentability of all animals. The Board ruled out the possibility that the exceptions from patentability of certain categories of animals, rather than of all animals, resulted from a mere error of the drafters of these Conventions. However, because the question of the breadth of the patentability exclusion of certain categories of animals by Article 53(b) of the EPC was deemed essential, the Board stated that it had to be examined by at least two levels of jurisdiction. Hence, the Board resorted to its power under Article 111(1) of the EPC to remand the case to the Examining Division for a renewed examination of the question.

In another respect, the Board also underlined its doubts about the legal correctness of the argument which the Examining Division had raised against the applicant in relation to the "non-essentially biological" character of the claimed process. According to the Board, it was inappropriate to dissociate the "non-essentially biological" process step (transfer of a foreign gene into the genetic patrimony of a cell at the embryonic stage) and the "essentially biological" process step (selection of the animals which carried the gene transferred after sexual production cycles of the claimed process). According to the Board, it was not possible, at least under patent law, to establish a distinction between the products of the two process steps, in relation to the gene transferred.

Thus, it was up to the Examining Division to decide whether the claims, specifically claim 19[21] whose text is recalled below as a footnote, had indeed to be rejected on the ground that they were excluded from patentability, to the extent that they would be deemed to consist of product claims. But according to the Board, such a ground of rejection could only be justified if the claimed transgenic animals were indeed covered by any of the expressions "*Tierart*," "animal variety," or "*race animale*," subject, however, to a correct interpretation of these expressions and

"that Article 53(b) EPC can be applied at all in respect of animals which are genetically manipulated, given that neither the drafters of the Strasbourg Convention nor those of the EPC could envisage this possibility."

The Board particularly reminded the Examining Division that:

"Article 53(b), first half-sentence, EPC is an exception to the general principle of patentability contained in Article 52(1) EPC. The second half-sentence is an exception to this exception, ensuring that the patentability bar does not cover microbiological processes or the products thereof. In other words, the general principle of patentability under Article 52(1) EPC is restored for inventions involving microbiological processes and the products of such processes. Consequently, patents are grantable for animals produced by a microbiological process. The Examining Division must therefore consider, should the case arise, whether the claimed processes constitute microbiological processes within the meaning of Article 53(b) EPC."

To our knowledge, the Examining Division has not yet finally decided the question of the pertinency of the exception of Article 53(b) in respect of an animal obtained by a non-essentially biological step, or even by a microbiological step. Some hypotheses–under the sole responsibility of the author–will be considered in the next section, relative to the patentability of "non-essentially biological processes."

However, prior to reverting to such hypotheses, it should also be recalled that the Board of Appeal also invited the Examining Division to reevaluate the impact on the relevant claims of the patentability

[19] *Onco-mouse/HARVARD* case, OJ EPO 12/1990, pp. 476.

[20] The Strasbourg Convention on the unification of certain points of substantive Law on patents for invention was signed by the European States, members of the Council of Europe, on November 27, 1963. As its title indicates, the countries concerned defined common patentability criteria. The relevant provisions of the EPC were patterned closely along it. Paragraphs (a) and (b) of Article 53 of the EPC are a quasi-identical reproduction of paragraph (a) and (b) of Article 2 of the Strasbourg Convention.

[21] "19. A transgenic non-human mammalian animal whose germ cells and somatic cells contain an activated oncogene sequence as a result of chromosomal incorporation into the animal genome, or into the genome of an ancestor of said animal, said oncogene optionally being further defined according to any one of claims 3 to 10."

Claims 3 to 10 related to alternatives of a process for producing the "transgenic mammal" of claim 19.

exclusion provided by Article 53(a) of the EPC, after a careful weighing of the suffering of animals and the possible risks to the environment caused by the invention, on the one hand, and its usefulness for mankind, on the other.

The Examining Division had, in fact, already expressed an inclination in favor of the usefulness of the invention for mankind. Without anticipating in any detail the final answer, it may be noted that test animals have long been used in pharmacology, that some of the "classical" tests used in pharmacological research, particularly in the field of cancer, may not be less traumatic than the testing procedures which would be applied to the new transgenic animals. This could occur especially where genetic information incorporated into the genome of the transgenic animal could be induced only temporarily, for example, only for the time required for the trials.

The possibility of relying on different legal provisions, for preventing too intense suffering by test animals, has also been contemplated.[22]

Finally, the effective production of such transgenic animals will doubtlessly be subject to appropriate regulation, in order to ensure the safeguarding of the environment. But their prohibition should normally not affect the patentability of the inventions concerned, pursuant to the second part of paragraph (a) of Article 53 of the EPC.

Non-Essentially Biological Processes

The *Onco-mouse/HARVARD* decision of an EPO Board of Appeal already witnessed the required restrictiveness of the interpretation of the patentability exception of Article 53(b) of the EPC, in respect of "essentially biological processes for the production of plants and animals."[23] As set forth in the decision,

> "whether or not a (non-microbiological) process is to be considered as 'essentially biological' within the meaning of Article 53(b) EPC has to be judged on the basis of the essence of the invention taking into account the totality of human intervention and its impact on the result achieved."

In the *Hybrid plant/LUBRIZOL* case (pertaining to the production of a hybrid plant population), the Board had already emphasized:

> "the required fundamental alteration of the character of a known process for the production of plants may lie either in the features of the process, i.e., in its constituent parts, or in the special sequence of the process steps, if a multistep process is claimed."

The second alternative (the particular sequence of process steps) was retained in support of the "non-essentially biological" character of the claimed process for the production of the hybrid plant population:

> "This arrangement of steps is decisive for the invention and permits the desired control of the special result in spite of the fact that at least one of the parents is heterozygous. The facts of the present case under appeal clearly indicate that the claimed processes for the preparation of hybrid plants represent an essential modification of known biological and classical breeders' processes."

In contrast, the first alternative (the specific constituent part), transposed to animals, was relied upon in favor of the non-exclusion from patentability of the process claimed in the *Onco-mouse/HARVARD* case. The constituent element–or the essence of the invention–lay in the incorporation of the oncogenic sequence (Myc) in the animal genome by a genetic engineering technique.

The Examining Division may not go as far as stating that the whole process for the production of animals must be considered as consisting of a "microbiological process," as provided by Article 53(b) of the EPC. Nevertheless, one may reasonably expect that the Examining Division will hold that the process as a whole should qualify as a "non-essentially biological" process in the light of the opinion strongly asserted by the Board that one should not separate the "essentially biological" steps and the "non-essentially biological" or even "microbiological" steps of a process which would comprise all of them, in an evaluation of the patentability thereof.

Potential Patentability of Stable and Homogeneous Populations of Genetically Modified Higher Organisms, Particulary Plants and Animals, Within the Framework of EPO Practice

The case law of the EPO Board of Appeal has consistantly held that a claim which defines a product by its process of manufacture (product-by-process claim), particularly when the product could not be defined otherwise, must be deemed to be a "product claim." Hence, the following statement of the Board in the *Onco-mouse/HARVARD* decision in respect of claim 19, which was at the core of the debate,[24] is consistant with the logic of the case law:

> "a product-by-process claim remains a product claim irrespective of the process it refers to. So a successful claim 19 would result in a product patent, not a process patent. Since, however, Article 53(b) EPC excludes only processes for the production of animals, with which claim 19 is not concerned, this provision per se is no bar to patenting the product."

By comparison, a claim defining a process for the production of a genetically engineered higher

[22] See the publication by J.C. Galloux *"Fabrique-moi un mouton ... Vers la brevetabilité des animaux – chimères en droit français." La Semaine Juridique, Edition Générale*, No. 7, February 14, 1990, No. 3430.

[23] See also paragraph C-IV, 3.4 of the "Guidelines for Examination in the European Patent Office," which already provided that:

> "the question whether a process is 'essentially biological' is one of degree depending on the extent to which there is technical intervention by man in the process; if such intervention plays a significant part in determining or controlling the result it is desired to achieve, the process would not be excluded."

[24] See footnote 21, *supra*.

organism, which would only be treated as a process claim–for instance, because the final product was known–would escape in any case the patentability exclusion provided by the first part of Article 53(b).

Under the hypothesis under which the EPO authorities would finally decide against the patentability of certain categories of higher organisms, one might run into a dilemma, anticipated by the Examining Division: a "product-by-process" claim treated as a "product claim" could be refused on the ground that the "product" would be excluded from patentability by Article 53(b) of the EPC, whereas the same claim could be permissible when treated as a process claim only. The dilemma would result from the fact that the product "directly" obtained by the claimed process would at the same time be patentable within the meaning of Article 64(2)[25] and unpatentable within the meaning of Article 53(b).

It should not be necessary to examine further the possible consequences of this dilemma, which may possibly be set aside by an acknowledgment of the possible patentability of new and inventive transgenic animals by the competent authorities of the EPO. The "signals" transmitted by the Board to the Examining Division seem to favor that orientation.

Beyond doubt, the EPO authorities should be able to provide a more correct interpretation of the words used by Article 53(b) in relation to "categories of animals" (or "*races animales*," "animal varieties," "*Tierarten*") which should indeed be excluded from patentability by the EPC and, consequently, as the Board stated in the *Onco-mouse/HARVARD* decision, to

> "find a solution to the problem of the interpretation of Article 53(b) EPC with regard to the concept of 'animal varieties,' providing a proper balance between the interest of inventors in this field in obtaining reasonable protection for their efforts, and society's interest in excluding certain categories of animals from patent protection."

The determination of the "proper balance" should also lead the competent EPO authorities to confirm the correctness of the practice already developed by the EPO in relation to the grant of patents for transgenic plants produced by genetic engineering processes.

Can a New Border be Drawn Between Plants and Animals Excluded from Patent Protection by Article 53(b) of the EPC and Those Not So Excluded?

As the Boards of Appeal have indicated, one cannot identify with certainty the categories of animals which, in the minds of the founders of the Strasbourg Convention and then of the EPC, could have been considered as not excluded from patentability. However, it is not forbidden to state some hypotheses.

The UPOV Convention had already been signed when the founders of the Strasbourg Convention adopted their own text. Thus, they knew of the definitions of plant varieties which were liable to be protected by breeders' rights within the meaning of the UPOV Convention. One is tempted to suggest that if a need for protection of certain categories of new animals–or of new "animal varieties"–had also arisen at the time, the relevant legislators would also have supplied a definition of such animal varieties which would then have had some similarities with the definition of plant varieties. It might perhaps have been more appropriate, at least for the purpose of legal interpretation of the relevant provisions, to have used equivalent wording in the three official languages of the EPC, e.g., "*variétés animales*," "*Tiersorten*" and "animal varieties," in line with the English text of Article 53(b). One might then also believe that such "new animal varieties" would, by analogy with plant varieties, have been defined as possessing one or more important characteristics enabling them to be distinguished from other known animal varieties. These characteristics should then have been sufficiently stable and homogeneous, bearing in mind the particularities of their sex-mediated production. One will have noted that these hypothetical suggestions of definition–which bear on criteria seemingly pertinent for animal breeders–are approximately patterned along Article 6 of the UPOV Convention, in its revised text of October 23, 1978.

Another preliminary remark ought to be made: it relates to our propensity to classify objects and ideas. It leads us naturally, when examining a provision like Article 53(b), to isolate its constituent elements in order to apprehend their individual respective contents. Few commentators escape the categorization of the inventions excluded from patentability by Article 53(b): (1) plant varieties, (2) animal varieties and (3) essentially biological processes for the production of plants or animals. We have ourselves in the preceding discussion yielded to that disposition.

But then it should also be fitting to investigate the bonds which perhaps united the thus individualized constituents with one another, and to identify the wholeness to which these apparently dispersed elements might have belonged in the mind of the legislators.

If words may have been in intimate symbiosis with objects or concepts at the time they were enunciated or written, it should not necessarily follow that their meanings should subsequently be extended to encompass realities or ideas for which they had not been conceived.

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[25] As a matter of fact, Article 64(2) EPC provides that:

> "If the subject-matter of the European patent is a process, the protection conferred by the patent shall extend to the products directly obtained by such process."

Perhaps it was a chance event, an unhappy one for some persons, a happy one for others, which resulted in the fact that the language, which the EPC borrowed from the Strasbourg Convention, happened to become "literally" applicable to transgenic plants and animals, e.g., produced by genetic engineering techniques. Perhaps it was also a chance event which caused the expression "new characteristics" as such, according to the terminology of the UPOV Convention, to also suit, *a posteriori*, some of the new traits which may possibly be induced by genetic engineering techniques in existing plant varieties when applied thereto.

Perhaps one would not have faced today the same problems, had the legislators used a different, or for us, today, a more accurate terminology. Had the language of the Strasbourg Convention and the subsequent EPC been different, and not literally applicable to genetically engineered plants and animals, one would have reached the conclusion that genetically engineered plants and animals were not excluded from patentability.

The silence noticed by the Boards of Appeal, relative to the legislators' intentions in respect of the relevant provision in the preparatory documents of the preceding Conventions, was perhaps linked to a simple, however essential, fact: "the man skilled in the art" may at the time not even have conceived of the idea that new plant varieties (within the meaning of the first versions of the UPOV Convention) or even new animal varieties would one day be produced by processes other than "essentially biological" ones. The EPO Boards of Appeal focused on it most pertinently.

Indeed, Article 6 of the text of the UPOV Convention, as revised in 1978, makes reference to the "artificial or natural" origin of the initial variation which might have given rise to a new plant variety. But the "artificial" origin consisted most often either in the bringing of distinct varieties in sufficiently close relationship to enable them to give rise to a new being, as a result of their own natural crossing or recombination capabilities, or in an accident provoked yet not controlled by man (for instance, mutation induced by chemicals or radiation).[26] But man did nothing else than bring into play the capability of nature to overcome occasionally the effects of pressures which may be imposed on it from outside and to enable the survival and, sometimes, the propagation of a new being arising as a result of these pressures. The breeder's intervention was then restricted to identifying and selecting the new being. Modifications observed only *a posteriori* in the being so selected were the result of biological internal processes which it had "inherited" in some way from the plants from which it had arisen. In other words, the effects of the intervention of man ("initial accident" and "final screening") were rather insignificant as compared to the purely biological aspects of the process carried out by nature to produce the new being. Hence, the process as a whole, including man's most often uncontrolled intervention, was rightfully qualified as an "essentially biological process."

The assumption may thus be made that a concept of "non-essentially biological processes" outside the scope[27] of "purely biological" processes performed by nature alone and of "essentially biological" processes including man's limited interventions was at the time beyond the reach of the legislators of the Strasbourg Convention, and even those of the European Patent Convention. The whole range of plant varieties and animal varieties (whatever that last expression might have meant) which would still be "invented" by man were not, in their minds, going to be produced otherwise than by essentially biological processes. To assert it in the relevant provisions which aimed at defining new higher organisms,[28] inasmuch as they could be given the status of "new products" within the meaning of patent law, would most likely, in the eyes of the legislators, have amounted to a truism or redundancy.

As a matter of fact, one can understand that the legislators may have been mindful of distinguishing between plants, i.e., plant varieties, which had a creative merit and the others which, as such, were apparently not entitled to any protection system. The specific exclusion from patentability of "plant varieties" may have aimed at reminding, as the EPO Boards of Appeal have noted certainly most pertinently, that they could benefit from distinct protection systems, derived from the UPOV Convention. But having in mind such a hypothesis, one may also surmise that the somewhat parallel exception to patentability of new animal varieties had no aim other than that of not definitively closing a door to any subsequent distinct protection system, also for new animal varieties. The legislator had no reason, in 1963, to negate as a matter of principle the creative merit of such animal "varieties," even in the absence of any protection system.

Thus, if one admits that, at the time, the legislators perceived the possibilities of transformation of

[26] The production of hybrids was indeed an exception worthy of note, also considered as such by the UPOV Convention, to these observations of a general nature.

[27] "Scope: space or opportunity for unhampered motion, activity or thought," according to one of the meanings proposed for that word by *Webster's Seventh New Collegiate Dictionary*, G. C. Merriam Company.

[28] The taking into consideration of the higher organisms only would be superfluous at this stage of this presentation, were it not for the "exception to the exception of patentability" provided by Article 53(b) on behalf of "microbiological processes" and of "products obtained by such processes." Obviously "microbiological processes" consisted exclusively too of "essentially biological" processes, when the Strasbourg Convention was adopted.

the living forms, as based on purely biological processes, to the least "essentially biological processes" to the extent where the first were to be favored by man's restricted interventions, Article 53(b) would bear witness of the extraordinary capability that the legislators had had, to condense in a concise formula all the categories of inventions which man was to further make in relation to living matter, however within the limits of what they could apprehend therefrom and even though some of these inventions were subsequently to become subject to patentability exclusions.

The advent of modern biotechnology opened an entirely new space, far beyond the possibilities of nature itself, whatever the effort which man could make to help it, unless in establishing modifications involving a "man-directed internal micro-reconstruction" of a part of the genetic patrimony of naturally existing organisms. Whatever the culture medium chosen, an *Escherichia coli* culture will never produce spontaneously an insulin having the same amino acid sequence as human insulin. Neither will a plant ever naturally produce a bovine growth hormone. In most cases, such results are subject to man-directed transformations which involve some "micro-chemistry," in order to achieve that two distinct genetic systems (including even synthetic systems) be combined–or genetically recombined–to produce a result which may manifest itself in the rise of a new trait or phenotype in a plant, particularly in an already existing plant variety, or in an animal, even an already existing animal variety.[29]

Can one then really speak of a new plant variety or animal variety only on the ground that its genetic patrimony has been "improved" by a limited transfer of genetic material; and this all the more so as the stable transfer of a foreign gene to the genome of a plant or an animal often involves the introduction of that gene through a vector system which the recipient cells must recognize as if it were their own? Often it is only subject to this condition that the gene can be admitted into the genome of a plant or animal so as to be expressed therein, if appropriate. Can one then really speak of a "new plant variety" or a "new animal variety" when the transformed plant was originally a plant variety or the transformed animal could have been categorized originally within an "animal variety?" Would it not rather consist of the same plant variety or the same animal variety which had been simply provided with additional "means" which conferred on them the capability of exerting one or several additional functions or, on the contrary, of preventing them from exercising such functions?

Finally it may be mentioned that variations induced in a genetic patrimony by genetic engineering techniques are likely to remain for a long time far below those which are observed in nature, in a same plant or animal variety. Genetic differences exist also in male and female species of an animal variety. Has one ever spoken of a "male variety" and a "female variety" within the same animal variety?

One would thus be tempted to conclude that the frequent assumption, that a new plant variety or a new animal variety is created as soon as its genetic patrimony has undergone even a minor change, may sometimes amount to an abuse of language. The imperfections of language as a tool for defining patent rights must sometimes be corrected in order to restore the meanings which words might have had for the legislators at the time they used them. One should not necessarily today add to words meanings which were simply beyond the reach of the legislators of the Strasbourg Convention, especially when the concepts underlying the techniques concerned underwent an evolution which they simply could not have expected.

The legislators of the Strasbourg Convention, even those of the European Patent Convention, could make legislation only with respect to a plant and animal world belonging to a field which they could conceptualize.[30]

By way of concluding remarks on the possible ultimate breadth of the exclusions provided by Article 53(b), we would suggest that a possible border line between animals and plants expressly excluded from patentability and those which would not, should not be drawn, at least for animals, between the whole animal world and the categories of animals specifically referred to by any of the three fluctuating expressions "*Tierarten*," "animal varieties," and "*races animales*." Nor should that border, for plants, be drawn between the whole vegetal world and the categories of plants which are met by the expressions, of fluctuating scope, in the three official languages of the EPC: "*Pflanzensorten*," "plant varieties," and "*variétés végétales*." A justification of the restriction of the exception of Article

[29] Professor François Gros mentionned it in a more concise manner, in his book entitled *L'ingénierie du vivant*, Editions Odile Jacob, Paris, 1990:

> "Henceforth, our techniques no longer satisfy themselves with only deceptive life forms, and more generally with what Nature made available, to come to settlement with it for limiting, accelerating or slowing down its rhythms and mutations. On the contrary, they work on Nature as much, as one may say, as they have Nature work to suit our needs and for our benefit. Nature is only given to man to the extent he does not yet know it. However biotechnologies, these practices for mastering and producing life forms, which result from the achievements of genetic engineering and the advances of molecular biology, seem indeed to announce a new era: the human technique attempts in some way to become relieved of the constraints which burdened it as a result of the action of Nature, in an effort to henceforward impose on it its own law."

[30] It was only in 1972 that a group a American researchers thought of producing *in vitro*, i.e., artificially, hybrid or monomeric molecules formed from chromosomal fragments, for the sake of studying their properties.

53(b) only to those plant varieties which would, where appropriate, benefit from protection under distinct systems derived from the UPOV Convention might well consist of a "legal expedient." Reliance on it should not be necessary.

The drawing of the border line between excluded and not excluded inventions should rather take into account the difference in nature of the processes carried out for obtaining them. Consequently, this border line could coincide with that already more than sketched by the Boards of Appeal in the decisions which have been commented on briefly, between essentially biological processes and essentially non-biological processes for obtaining plants and animals.[31]

Whatever the final interpretation of Article 53(b), one would hope that the equitable solutions, called for by the EPO Board of Appeal in the *Oncomouse/HARVARD* case, will be found rapidly. They cannot result in plant or animal populations being excluded from patentability on the ground that they would be constituted by "homogeneous and stable individuals," let alone "clones."

Upholding the exclusion would drastically reduce the useful areas of protection for inventors in the field of biotechnology. This can immediately be perceived in respect of "transgenic" plants. The plants commercialized by competitors will most often not be plant populations formed from unstable and multiform individuals. Most often the commercialized plants will be plants possessing all the attributes of a plant variety whose phenotypes, including those induced by genetic engineering techniques, should be stable. Efficient protection systems must be made available to inventors of such plants. The last revised Act of the UPOV Convention[32] can provide some protection. But the diversity of the inventions of biotechnology[33] will not always be compatible with the necessity of isolating one variety after another in order to protect them all by plant breeders' rights. In our view, only patents can reasonably accommodate such diversity.

Finally, it should be mentioned that the need for some form of protection is becoming increasingly important, also for new transgenic animals. Doubt cannot be cast on the fact that, to the extent where the requirements of Article 53(a) of the EPC would also be fulfilled, such needs cannot be satisfied at best otherwise than by means of patents.

Protection of Biotechnologies in France

An outline of the situation in France for technological inventions must take into account both European patents which are or will be in force in France and French national patents.

European Patents

Can one seriously anticipate eventual divergences between the interpretation of the breadth of Article 53(b) EPC, then also applicable in France, by the French courts and by the EPO Boards of Appeal? It would be premature to conclude: so far French case law in that field is virtually nil.

But the French courts should be perceptive of the great care taken by the EPO Boards of Appeal in their interpretation of patentability exclusions and their investigation of the intentions of the founders of the Strasbourg Convention and the European legislators. The French courts, like the EPO Boards of Appeal, interpret provisions relative to exceptions to patentability in a restrictive manner.

Finally, despite their recent character and limited number, the decisions delivered by the EPO Boards of Appeal evidence profound thinking. In some ways, the EPO may be considered as one of the "European laboratories" in which practitioners (members of the Boards of Appeal and examiners, on the one hand, applicants and their representatives, on the other hand) exchange their respective views on biotechnological themes and try, in their daily practice, to draw them closer to one another.

These elements foretell convergence between eventual conclusions by the French courts and the case law of the EPO Boards of Appeal, especially when that case law may be set.

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[31] Hence, the proposed reading of Article 53(b) would be as follows:

> "European patents shall not be granted in respect of:
>
> ....
>
> (b) essentially biological processes for the production of plants or animals or the 'products' thereof; this provision does not apply to microbiological processes or the products thereof."

[32] The "modernized" definition of "variety" proposed in Chapter I, Article 1(vi) of the last version of the UPOV Convention is reproduced below:

> "'variety' means a plant grouping within a single botanical taxon of the lowest known rank, which grouping, irrespective of whether the conditions for the grant of a breeder's right are fully met, can be
> - defined by the expression of the characteristics resulting from a given genotype or combination of genotypes,
> - distinguished from any other plant grouping by the expression of at least one of the said characteristics and
> - considered as a unit with regard to its suitability for being propagated unchanged."

[33] See text of E. Gutmann, "The Effects of Technical Development in Biotechnology on the Relevant Intellectual Property Laws" in *WIPO Worldwide Forum on the Impact of Emerging Technologies on the Law of Intellectual Property* (No. 674(E)), Geneva, 1988.

It was there noted that a definition of the plant variety capable of being protected by a plant breeder's right would not, in many cases, suit the definition of an invention in the field of biotechnology, particularly where that invention would bring into play genetic constructs transferable to vegetal groups having a botanical taxon of higher ranking than a "variety" or including several distinct plant species.

French National Patents

The law applicable in France is Law No. 68-1 of January 2, 1968, amended a first time by Law No. 78-742 of July 13, 1978. The additional amendments to the Law since then are without bearing on the questions under study.

One of the essential aims of the first amendments to the French Law was to harmonize its provisions in respect of both patentability and exceptions to patentability with the corresponding provisions of the EPC. Section 7 of the French Law, reproduced hereafter, is of particular significance for biotechnology:

> "The following shall not be patentable:
>
> *(a)* inventions the publication or exploitation of which would be contrary to public order or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation;
>
> *(b)* plant varieties belonging to a genus or species enjoying the protection established by Law No. 70-489 of June 11, 1970, on the Protection of New Plant Varieties;
>
> *(c)* animal varieties or essentially biological processes for the production of plants or animals; this provision does not apply to microbiological processes or the products thereof."

Section 7*(a)* is, but for a territorial adaptation of the language, the same as Article 53(a) of the EPC. However, the group of inventions excluded from patentability by Article 53(b) of the EPC, except for the modifications considered hereinafter, has been broken down differently in Section 7*(b)* and *(c)* of the French Law.

Section 7*(b)* relates only to plant varieties which at their possible filing dates would effectively benefit from the Law of June 11, 1970, which provided for a protection system in France for plant varieties different from patents.

Hence those categories of plant varieties which could not, as a matter of practice, benefit from the provisions of the Law of June 11, 1970, were not specifically excluded from patentability. This suggestion, however, disregards the fact that, in 1970, it was impossible, with certain exceptions, to obtain a valid patent for a plant variety, in view of the impossibility of describing a process for obtaining it.

Finally, the regroupment in Section 7*(c)* of the "animal varieties" and "essentially biological processes for the production of plants or animals" provides to a certain extent support for the previous hypotheses, namely, that the legislator had essentially only had in mind the exclusion as new products of "animal varieties," i.e., of a particular class of animals from the whole animal kingdom, or even of higher differentiated organisms (plants and animals) capable of being obtained by essentially biological processes only.

Without definitely anticipating the conclusions which the French courts will reach eventually, it could follow from the above hypotheses that transgenic plants and animals obtained by non-essentially biological processes would be "patentable" within the meaning of the French national law too.

The position already taken by the National Institute of Industrial Property (Institut National de la Propriété Industrielle (INPI) (French Patent Office)) has thus an even greater significance. INPI has now clearly adopted the theory of the freedom of an inventor of a new plant variety to choose the protection system which would appear to him as the most appropriate.[34]

In practice–if need be subject to an appropriate formulation of the claims–INPI does not implement Section 16 of the French Law which confers on it the power to reject a patent application on the ground that the invention is manifestly devoid of patentability. Such would be the case for "plants and animals produced by essentially biological processes."[35]

Conclusion: Are We Heading Towards the Patentability of Transgenic Higher Organisms?

In most European States, the patent laws contain provisions which recite exceptions to patentability like those of Article 53(b) of the EPC.

But an interpretation of such provisions which would, ultimately, cause plants or animals obtained by "non-essentially biological" processes not to be excluded from patentability appears to be within reach. Only plants, including traditional plant varieties, and animals obtained by "essentially biological" processes would be excluded from patentability.

An interpretation favorable to the inventors of transgenic higher organisms would also considerably reduce the practical impact of the patentability exclusions of Article 53(b) of the EPC and of similar provisions of national laws. That would take place from the points of view of both the inventors and the public: from the point of view of the inventors, because their inventions would also in that particular technical field like in others be protected by patents;

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[34] See document WIPO/UPOV/CE/I/4 of February 12, 1990, paragraph 29:

> "Miss Darmon (National Institute of Industrial Property, France) supported the proposal for the removal of the prohibition on double protection by both patent and plant variety certificate, which would enable the applicant *either* to use one or other of the two types of protection *or* to combine them. The amendment would offer two advantages: (i) it would remove the permanent and awkward obstacles that confronted the applicant in his attempts to draw the line between what was patentable and what was not; (ii) it eliminated all the areas of uncertainty regarding protection that were caused by the definition of the variety written into the draft revision of the UPOV Convention."

[35] The relevant provision with respect to biotechnological inventions, reads as follows:

> "A patent application shall be refused, in whole or in part, if:
>
> ....
>
> (4) it has as its subject matter an invention which is manifestly non-patentable under Section 7."

from the point of view of the public, because occurrences of "double protection" that would result from the simultaneous filings of applications for patents and plant breeders' rights would, in practice, be rather seldom.

As a matter of fact, quite a number of biotechnological inventions applied to plants will be brought to the knowledge of the public through the publication of patent applications filed at earlier dates (within an 18-month term from their filing or priority date) before embodiments in their most complete form, particularly plant varieties having the degree of specificity still required by the legislators of the UPOV Convention as revised on March 19, 1991, will ever have been produced. The specific plant varieties could then still be protected by plant breeders' rights. Protection will, however, normally no longer be available by means of an additional patent application. Although still new, an "invention" restricted to the plant variety concerned will often no longer exhibit the inventive step required in respect of earlier published patent applications, or of course scientific publications or other forms of divulgation of the basic principle brought into play by the invention.

However, this is perhaps already erroneously forecasting future developments of biotechnological inventions in the field of plants and, in parallel, of animals. No doubt they will give rise to some additional surprises!

In contrast, a possible enforcement of the exception to patentability against transgenic "stable" and "homogeneous" plants or animals would lead to what could only be termed a paradox: the possible prohibition imposed on the inventor to restrict the protection applied for to a single plant variety, even though he would have been willing to abstain from applying for simultaneous patent protection of other varieties. In fact, the inventor would be put under the obligation to apply for more protection, because he could not be given less!

These are the many observations which lead us to the conclusion that Article 53(b) will not withstand the test of time, even if it can be caused "to last." The removal of the prohibition of the possible cumulative protection of plant varieties by both plant breeders' rights and patents, as provided in the last revision of the UPOV Convention, is a forerunner in that direction.

News Items

The First Hundred Years of the Madrid Agreement Concerning the International Registration of Marks

ARPAD BOGSCH

Director General of the World Intellectual Property Organization

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PART III

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PART I

THE ORIGINS OF THE MADRID UNION

Trademarks before the Madrid Agreement

Trademarks and service marks are amongst the oldest forms of recorded intellectual property, going back to ancient times. It is not possible to date with any precision the origins of marks. The earliest form of identification mark seems to have been the branding of livestock with some design–a practice which pre-dated literate societies. But marks were certainly used in some form in various periods and societies of Antiquity in Europe and Asia. Pottery in Ancient Greece and Rome, and later, porcelain in China, could bear the maker's name. Also bricks and tiles in Ancient Egypt, Mesopotamia and Rome might bear the maker's name, the factory mark, or the geographical origin of the material. Masonry was marked in various ways–with quarry marks indicating the source of the stone, or with stonecutters' signs for the purpose of either identifying individual masons, or assisting stone workers to claim their wages.

Throughout history, the development of the use of marks for purposes more sophisticated than just identification has been assisted by international trade; the spread of trade further and further away from the centers of production of goods, to the point of exporting them beyond seas and land frontiers, has always been conducive to marks acquiring a certain advertising function, as well as to their more extensive use for the examination of claims made by producers, merchants, retailers, transporters, or customers.

The Middle Ages in Europe were particularly favorable to the growth of the conception of marks, and to their more widespread use. In addition to the use of house marks (representing a family, an inn, a shop or other business), proprietory marks (brands on livestock and merchandise) and appellations of origin (such as in textile industries), there was the establishment of craft and trade guilds, which was a powerful factor in institutionalizing the use of marks: guild members were under an obligation to use production marks, primarily as a means of fixing responsibility for the quality of their products, but also as a means of control where territorial trade barriers existed. One sequel to the multiplicity of marks used by individual guild members was the maintenance of registers of marks–the forerunners of modern trademark registration systems–which developed in Europe through the seventeenth and eighteenth centuries.

The Industrial Revolution of the eighteenth and nineteenth centuries, by transforming methods of

production, transportation and ultimately consumer markets, definitively established the importance of industrial property systems. In the field of marks, the sheer scale of production, dissemination of information, and distribution facilitated by technological progress made producers, retailers and consumers increasingly aware of the need to identify goods. International trade, on a scale hitherto unknown, again reinforced the need for controls, whether for the purpose of protection for producers, or for the purpose of enabling consumers to select the type and quality of goods they required. By the middle of the nineteenth century, there was growing recognition, in the way marks were used, of all the characteristics of modern marks–namely, identification, a guarantee of consistency in the thing provided, and an advertising capacity, in a world of expanding markets.

It is thus no wonder that certain European countries, such as the Netherlands and Switzerland, had a national trademark law years before they made national legislative provision for patents and industrial designs.

The nineteenth century saw perhaps the most momentous growth of internationalism ever known, and in various fields. It was the Congress of Vienna in 1815 which put an end to the era of the Napoleonic Wars, and re-drew the map of Europe. Vienna was also the scene of the emergence of a real political will among nations to create an international instrument governing industrial property.

The increasing movement of commercial, scientific and cultural relations beyond national frontiers, aided by the explosion of technological progress in communications, created the necessity for international measures for the protection of industrial property. Following two international exhibitions held in Paris in 1855 and 1867 by the Government of Napoleon III, the Government of Austria-Hungary organized an international exhibition of inventions in Vienna in 1873; to meet the objections of foreigners unwilling to exhibit because of inadequate legal protection, a special Austrian law was passed granting temporary protection to foreign participants for their inventions, trademarks and industrial designs, and, even more significantly, the Congress of Vienna for Patent Reform was convened in that same year of 1873. At last, it was recognized that the kind of multilateral cooperation increasingly practiced in the political field was equally essential for industrial property; the system of bilateral treaties (there were 69 of them concerning the protection of foreigners' industrial property rights in 1883, in the year of the creation of the first International Union for the Protection of Industrial Property in Paris) which had hitherto been in force was clearly inadequate and outdated. The 1873 Congress passed a resolution urging governments "to bring about an international understanding upon patent protection as soon as possible."

The sequel to the Vienna Congress of 1873 was an International Congress on Industrial Property in Paris in 1878. The major result of that Congress was a decision that one of the governments should be asked to convene an international diplomatic conference "with the task of determining the basis of uniform legislation" in the field of industrial property. About trademarks in particular, the 1878 Congress expressed the wish that the registration of trademarks "should be subject to international provisions by which it would suffice for the owner of a trademark to register once only in a State to ensure the protection of that mark in all the other member States."

It was the French Government which put forward a final draft proposing an international "Union" for the protection of industrial property, and invited a number of other governments to an International Conference in Paris in 1880. That Conference adopted a draft convention, transmitted by the French Government to other interested governments. In March 1883, another Diplomatic Conference was convened in Paris, and on March 20, the Paris Convention for the Protection of Industrial Property was signed by 11 States: Belgium, Brazil, France, Guatemala, Italy, Netherlands, Portugal, Salvador, Serbia, Spain and Switzerland.

The Paris Convention of 1883 was the keystone of subsequent international cooperation also in the field of trademarks. For the first time in the history of intellectual property, it created an international "Union," made up of member States, for the protection of industrial property. It was more than a treaty establishing rights and obligations: the Paris Convention actually established a legal entity in international law, with the legal and administrative organs for the performance of the tasks assigned to the Union.

The provisions of the Paris Convention can be divided into four main categories. First, there are rules of substantive law which guarantee a basic right to *national treatment* in each of the member countries. A second category establishes another basic right–that of the *right of priority*. Thirdly, certain provisions define *common rules* establishing rights and obligations of natural persons and legal entities, or rules requiring or permitting member countries to enact legislation in conformity with those rules. Finally, there are provisions laying down the *administrative framework* for the implementation of the Convention.

The text of that first Act of the Paris Convention of 1883 contains many references to trademarks. This shows the importance of the place held by trademarks in the field of industrial property as a whole in the nineteenth century.

It is worth examining what the original Paris Convention established specifically for trademarks, since this was, as has been stated, the keystone of the subsequent special agreements on the subject.

The two major principles of national treatment and the right of priority were paramount for the future of international registration of trademarks and similar marks or signs. The principle of national treatment accorded to foreigners, in particular, was the crux of the matter. For the first time, an international convention contained provisions enabling member States of an international Union to offer each other similar terms for international registration, on a basis of reciprocity. Articles 2 and 3 established that once valid filing and registration had been effected, certain foreigners were to enjoy in countries of the Union the same advantages as the nationals of those countries. Eligibility for that treatment would be determined by nationality, residence, or the establishment of commercial or industrial entities, in any of the other countries of the Union.

A natural complement to this national treatment was therefore a Union-wide application of a right of priority, as laid down in Article 4. On the basis of a valid application for registration of a trademark in one member country, the same applicant or his successor in title could, within a specified period (in the text of 1883, three months for trademarks, with an additional month for "overseas" or more distant countries), apply for protection in other member countries, and be registered in them as from the original date of filing the application. The applicant could thus enjoy priority status in relation to other applications for the same industrial property title filed after his first application in any member country.

That original text of the Paris Convention also laid down common rules of substantive law concerning trademarks. These fall into two groups. Either they were "self-executing" rights of natural persons or legal entities (that is to say, immediately applicable, without any incorporation in national law), or they were common rules which had to be incorporated into national law. These common rules were naturally subject to certain conditions and exceptions, but by and large they were as follows.

The text of 1883 contained the rule, later modified, of a certain dependence of trademarks. Article 6[1] stated: "Every trade mark duly filed in the country of origin shall be accepted for filing and protected in its original form in the other countries of the Union." Of course this rule was subject (Article 6[4] of the 1883 text) to important exceptions, such as the possible refusal of a trademark for reasons of morality or public order.

Moreover, Article 7 prohibited refusal by any member country to register a mark on the grounds that the nature of the goods to which the trademark applied could not legally be sold in that country. Protection of the right to file, then register, went as far as to override the different individual domestic restrictions as to the type of goods which could be sold in the member countries.

Article 11 of the Paris Convention dealt with a problem which, as we have already seen, was particularly topical in the latter half of the nineteenth century. It granted temporary protection to exhibits of industrial property, including trademarks, shown at official or officially recognized international exhibitions.

An important landmark in these common rules was the provision for sanctions and remedies against infringement. No international instrument could have any real weight, unless it was internationally enforceable, that is to say, unless offenses could be detected, punished and corrected beyond national boundaries. Article 9 laid down that any goods unlawfully bearing a trademark or a trade name might be seized on importation into those States of the Union where such mark or name had a right to protection, and that seizure could be at the request of the public prosecutor or of the interested party in accordance with the national law of each State.

Most important for the infrastructure and the practical implementation of any measures for the international registration of trademarks was Article 12, which required each member country to establish "a special industrial property service and a central office for the communication to the public of patents, industrial designs and trademarks." This was no statement of the obvious in the 1880s, at a time when industrial property matters in various countries suffered neglect in the absence of a separate and distinct national industrial property institution: to relegate those matters to a small unit in one Ministry or another (not always consistently chosen), or, as in some cases, to accept that officials assigned to quite other duties should devote an unspecified amount of time to them, was not a serious way to implement an international instrument. Moreover, paragraph 5 of the Final Protocol specified the need for the industrial property service to publish an official periodical journal: the importance of this recommendation need not be emphasized, for no trademark office could function without a precise visual record of the registered trademarks.

Finally, the Convention, for the very first time in the history of intellectual property, created an international infrastructure to administer the working of the Union of member countries. Article 13 established the "International Bureau of the Union for the Protection of Industrial Property," and placed it "under the high authority of the High Administration of the Swiss Confederation," which was to supervise it. But the International Bureau's functions were to be determined by the member States, and paragraph 6 of the Final Protocol constructed a framework for the international financing of the Bureau, as well as outlining the major obligations of the Bureau, the Swiss Administration and the member States as a whole. The administrative framework is dealt with in greater detail in Part III.

This consideration of the basis created by the Paris Convention of 1883 for international trademark registration ends with a reference to Article 14, and notably also to Article 15. Article 14 expressly made provision for the improvement of "the system of the Union" by subsequent amendments to that Convention. Article 15, moreover, made it clear that the contracting States "reserve the right to make separately between themselves special arrangements for the protection of industrial property, in so far as these arrangements do not contravene the provisions of the present Convention."

The members of the Union clearly understood that the Paris Convention was only a first step, albeit an important one. It was by and large a statement of principle, a set of basic guidelines. The whole system of international trademark protection had to be worked out in detail–its laws, rules, procedures, day-to-day administration, and effective implementation–and various conflicts and contradictions had to be resolved. The blueprint of March 1883 prepared the way for the conferences held in Madrid in 1890 and again in 1891, when the Madrid Agreement Concerning the International Registration of Marks was finally signed.

Before Madrid, there was just an attempt at a serious follow-up in Rome, where the next Conference of the Paris Union was held from April 29 to May 11, 1886. But in the words of Mr. Grimaldi, the Italian Minister for Agriculture, Industry and Commerce, the Rome Conference could not claim "the glory of advancing the system of the [Paris] Union," but at least "demonstrated the attachment of the member States to the gains already made by the Convention of 1883." Apart from Additional Articles and Regulations added to the Paris Convention for the purposes of explanation and more detailed elaboration, the Rome Conference did in fact consider a draft Agreement concerning the international registration of trademarks, as proposed by Switzerland and amended by Italy. But the majority of the delegations, deciding that more time was needed to study the question in depth, voted to postpone consideration of this special Agreement until the next Conference. Madrid was chosen, by acclamation, to host it, and it took place in 1890 and 1891.

The Need for a Special Agreement, and its Culmination in Madrid

The nineteenth century saw an unprecedented pace of industrial development all over the world, not the least product of which was a revolution of transportation, notably in the creation of railway networks. More than ever, trade and commerce crossed national frontiers, not only into traditional markets in neighboring countries, but also much further afield. The trademark increasingly became a vital protection for producers and retailers against counterfeiters, and in a world where demand and consumption grew, it was worthwhile, in terms of profits and the safeguarding of the good name of their products, for these producers and retailers to secure legal recognition and protection of their trademarks beyond the boundaries of the country where they lived or operated commercially.

In the absence of any international system permitting a single registration valid for several countries by an established procedure, the applicant for the registration of a trademark had to ensure that it was correctly registered in accordance with the laws and procedures in force in *each* of the countries where his goods or services were traded. There were essentially two ways of doing this effectively. One was for the owner or his representative to undertake the journeys to the countries concerned; this was clearly too cumbersome and expensive. The alternative was to use the services of trademark agents or agencies as intermediaries, but this, as a Swiss delegate pointed out in the Rome Conference in 1886, was somewhat expensive also.

The delegate of the Netherlands argued that the use of trademark agencies could be avoided by sending the trademark directly to governmental administrations, in accordance with the laws of different States. But the very use by applicants of such agencies showed this argument to presuppose a utopian clarity and procedural efficiency, which an applicant could not in practice expect. Indeed, at the international level, both governments and international meetings generally recognized as much: to give but one example of such governmental recognition, in 1879, the Belgian Government passed a law enabling trademark holders in Belgium to deposit and register their trademarks through Belgian consulates abroad, thus obviating the need to go through agencies abroad. As for action in international meetings, once again, an industrial property Congress in Paris in 1889 passed a resolution declaring the need for "an international trademarks regime, so that a trademark deposited in one country which is a member of an international Union is protected in all the member States, by means of deposit with the International Bureau of that Union."

Why Madrid, why Spain? Some sectors of Spanish opinion were among the most doubtful about the choice made by the Rome Conference in 1886 for the place of the next intemational conference. The newspaper *El País*, in a critical article in the edition of April 7, 1890, opined gloomily, "There are some who expect from this Conference resolutions of importance for Spain and considerable practical results for our industry. We believe, on the contrary, that we will remain as we were. We hope we are wrong." The article ended caustically, "We consider that other countries, which a few years ago had no law on [industrial] privileges, are today more pros-

perous than we are, because, quite unlike us, before legislating on inventions, they managed to set up factories and industries." This was an exaggeratedly critical view, but it raises certain questions.

For it was in many ways remarkable that such an international Conference–the first of its kind in Spain–should be held in Madrid, in the context of European history in the nineteenth century. Spain was among the European countries which had suffered the most tragically from foreign and domestic political crises of that century.

Institutions in Spain were in a period of transition. Alfonso XII, the father of King Alfonso XIII (the latter was a minor under a Regency when the Madrid Conferences were held), was the first Spanish monarch of the century to be able to reign uninterruptedly from the year of his return to Spain, in 1875, until his death in 1885. All the others were at some point forced to leave the throne or abdicated. At the beginning of the century, Charles IV and Ferdinand VII gave place to the Napoleonic conquest and the imposition of the French Emperor's brother as sovereign; Ferdinand VII was subsequently restored to the throne. His daughter, Isabella II, survived the enforced abdication in 1840 of her mother, María Cristina of Naples, as Queen Regent, only to be forced into exile in France herself in 1868. Yet the attempt to create a constitutional monarchy with a new constitution in 1869, and a specially chosen foreign King, Amadeo of Savoy, in 1870, fared no better: Amadeo abdicated in 1873. A Republic set up in 1873 soon collapsed. The restoration of the Bourbon monarchy under Alfonso XII, proclaimed in 1874, lasted until 1931.

If Spanish history shows that the monarchy still had a role to play in political life, the pressures that monarchs were subject to illustrate the importance of other forces, which, in a period of transition, were still to find their rightful place. The Cortes was not yet exactly a Parliament or broadly-based National Assembly: legislation introducing universal suffrage in 1869 did not radically alter electoral management by a system of metropolitan, provincial and local patronage–*Caciquismo* as it was called, using a chain of influence extending from Madrid politicians and provincial governors to *caciques* or powerful local figures.

Individuals gained political power in Madrid by their standing with the Crown, which still appointed ministers. Although these individuals belonged to, or actually formed, "groupings," neither were the latter wholly political parties with established programs and objectives: personal rivalries, tactically realistic alignments, and more strictly political splits within groups made cohesion difficult within political groupings, and often the sole common denominator was fear of revolution and anarchy. In addition, there was the Army, which was a political factor with its own strength.

When the Rome Conference in 1886 settled on Madrid as the place to hold the next international Conference, Spain had enjoyed, for some 11 years, an unprecedented period of political stability, which, however relative, was in stark contrast to the strife of international and civil war, disputed royal successions, and the ambitions of groups and individuals which had ravaged the country for three-quarters of a century.

A major architect of this later Bourbon restoration, Cánovas del Castillo, kept in place, with other politicians, the most stable political structure erected by nineteenth-century liberalism. The new Constitution of 1876 lasted until 1923. The worst evils of faction and attempts by a single group to capture and monopolize Crown favor were averted until the 1890s by a system of *turno pacífico*, or peaceful rotation of power, between different parties. This rotation was for much of the period 1875 to 1896 assured by Cánovas himself as leader of the Liberal-Conservatives, and by Sagasta as leader of the Liberals. Moreover, Queen María Cristina (an Austrian Hapsburg), acting as Regent for her infant son Alfonso, a posthumous child, from 1886 to 1902, showed a personal and political discretion which soon cut short comparisons with her Neapolitan namesake in the same role earlier in the century. Whether or not this political structure could make deep-seated changes in Spain, it created a situation where Spain could actively participate in legal and economic debates such as the international registration of trademarks, and at the foremost international level, as host of the international Conference.

The decision of the Rome Conference in favor of Madrid not only coincided with a politically appropriate period but also with an economic situation which, more than merely propitious, made it necessary for Spanish commerce and industry to advance on an international scale.

Agriculture remained the predominant economic activity in Spain, and was the key to her overall prosperity: it was not only important for internal consumption and certain traditional export markets, but also greatly affected Spain's industrial prosperity, which ultimately depended on the purchasing power of the majority of Spaniards. Cereals, fruits, olive oil, wines (including specialized export wines such as sherry from the South) and brandies, were among the main agricultural products of Spain. As elsewhere, agricultural prosperity was subject to internal crises and price fluctuations in internal and external markets. But the outbreak of phylloxera in French vineyards enabled Spain progressively to gain preeminence in the world wine market for over a decade, through to the 1880s: in 1886, the year when Madrid was chosen by the Rome Conference to host the next international industrial property conference, Spain was still benefiting from this agricultural boom, and did not yet feel the full weight of falling

prices and the spread of phylloxera to Spain.

Spain's industrial development suffered from insufficient Spanish capital, making foreign investment inevitable. An illustration of this was the communications industry, which in the nineteenth century meant railways. The Spanish railway network was largely made possible by French capital. But this very pattern of foreign investment created the situation where the more industrialized Western European nations had a stake in Spain and where Spain in turn needed them. There is no surer way for a nation to be an integral part of international cooperation. Moreover, there was no question that foreign investment, whatever its disadvantages, was indispensable for Spain's industrial development. To give but one example, the coach service established in the restoration of Ferdinand VII (1814-1833) between Madrid and Barcelona took eight days, and was estimated to cost a year's wages for a prosperous artisan. Here again, the 1880s were among the peak years for railway construction.

What an initial absence of phylloxera did for Spanish wine, the discovery of the Bessemer process for steel manufacture could be said to have achieved for Spanish iron ore. The period 1880-1900 saw the apogee of mining industries in Spain, in many cases not so much for domestic use, it must be said, but for export, and with strong foreign investment by the interested countries. Thus Basque iron ore became an essential part of British imports and manufacturing processes, with British financial backing and technical expertise. Also largely financed and operated by the British were copper at the Rio Tinto mine, and pyrites (exploited for sulphur and copper) in the region of Huelva. The Royal Company of the Asturias, originally established with Belgian financing and control, had been exploiting zinc since 1853. Spain was the leading producer in the world of mercury and lead; French companies were particularly active in the latter industry, notably with the creation in 1880 of the Société Minière Métallurgique de Peñarroya.

The major industrial center in Spain was Catalonia. The Catalan industrial economy rested on the textile industry–based on imported cotton, and a growing woollen industry–and on colonial commerce. Although politically the Spanish colonial Empire in the 1880s was reduced to Cuba, Puerto Rico and the Philippines, all of which would be lost by Spain in 1898, right through the 1880s and well into the 1890s Cuba, in particular, remained of great importance as a market for Catalan manufacturers: the major Catalan exports to Cuba were cotton manufactures, shoes and other leather goods, paper and soap.

It is not appropriate here to examine how far Spanish agriculture and industry were developing in the long term in the context of nineteenth century Europe as a whole. Suffice it to say that in a century of exceptional international and civil strife, Spanish Governments from 1875 created the longest period of internal political stability experienced in that century. Also, the second half of the century in particular saw a sustained effort to develop the country both internally and in its international relations. The national legal framework developed considerably. Laws concerning banks, companies, railway and other communications, as well as mining were passed in the 1850s as a basis for progress.

Thus, the conditions existed in Spain for interest in the protection of industrial property at an international level: Spanish interests sought protection abroad, and foreign interests sought protection in Spain. In Spanish registers, along with the majority of trademarks registered by Spanish nationals in the early 1880s, were foreign trademarks registered by nationals and companies of France, the United States of America, Britain, Germany and Switzerland. Here, too, the development of a legal framework is apparent. In 1824, the Royal Conservatory of Arts was founded in Madrid to maintain a register and record of privileges granted to inventors. As early as 1850, a decree regulating trademarks was promulgated, and the Royal Conservatory of Arts began to examine and report on trademarks before entering them in the official registers. These measures were reinforced by a new Patent Law in 1878. In 1890 and 1891, although Spain's leaders may not have had the same optimism as in the previous decade, they still had, in the interests of the country's progress, the sense of purpose which made Madrid the birthplace of an international Union for the international registration of trademarks.

Madrid at the time of the Conference bore the imprint of the architectural and artistic changes introduced by the first Bourbon King of Spain, Philip V, who had reigned from 1700 to 1746. In addition to Spanish talent, he used foreign architects and artists –French, Italian and others–to embellish the city. Under him, two Italian architects, Juvara and Sacchetti, began work on the new Royal Palace in the 1730s. Progressively through the eighteenth century, the elaborately ornate, even florid, Baroque and Rococo styles were displaced by the more austere, massive, but dignified grandeur of Neoclassicism. The reign of Charles III (1759-1788) set the seal on these trends. His arrival from Naples (he succeeded his half-brother, Ferdinand VI, when the latter died without an heir) brought a fresh injection of Italian or Italian-trained architects and artists, such as the Bohemian-born Anton Raphael Mengs, and no less than the Venetian master of interiors, Giambattista Tiepolo.

The reign of Charles III saw the creation or completion of some of the most noble sights of nineteenth century Madrid. Sabatini added to the Royal Palace, and was responsible for other structures in Madrid, such as the Alcalá Gate. Juan de Villanueva,

a friend of the painter of genius, Francisco de Goya, was the architect of the Prado Museum, originally intended to house Charles III's natural history collection and to serve as a temple of science.

The building in which the Madrid Conference was held was also intended to be a temple of learning. The San Fernando Royal Academy of Fine Arts moved to the site which today is No. 13 Calle Alcalá in 1774, to a building which had been designed by Churriguera earlier in the century, in the Baroque style. Its façade was transformed into a more austere and very elegant Neoclassicism by Diego de Villanueva, brother of the architect of the Prado; the building underwent further changes and restorations in the nineteenth and twentieth centuries. It is not inappropriate that an Academy dedicated to becoming the center of instruction and taste in the fine arts, and later in music, of which men of genius (Goya among them) had been members, should be the place where the delegates of 15 countries of the globe were to debate how to protect and foster, on an international scale, the part of human productivity represented by trademarks.

The Conference

"Don Alfonso XIII, by the grace of God, Constitutional King of Spain, and in his name and during his minority Doña María Cristina Queen Regent of the Kingdom..." began the royal pronouncements of the infant King. He was three years old in 1889, the year fixed for the Madrid Conference in Article 14 of the Additional Articles to the Paris Convention agreed upon in Rome. In view of the amount of preparatory work to be done, two royal orders, of July 4 and August 1, 1889, respectively, postponed the Conference, the latter one fixing the date at April 1, 1890.

The Ministry for Development was the one concerned with the Conference, and made the necessary arrangements. The appointment of the four distinguished Spanish delegates had been by a royal order of July 20, 1889. They were, in the order of precedence given, Segismundo Moret y Prendergast, an ex-Minister for External Affairs and for the Interior and a deputy of the Cortes, the Count of San Bernardo, Director General of Agriculture, Industry and Commerce, also a deputy of the Cortes, Enrique Calleja y Madrid, agricultural counsellor, industrial engineer and Head of the Patent Office, and Luis Mariano de Larra, one of Spain's representatives to the Rome Conference, and Director of the "Official Bulletin of Intellectual Property" of the Ministry for Development.

All the countries which were members of the Paris Union at the time of the preliminary organization of the Conference were invited, as was appropriate for a Conference convened to create a Special Union which was to be a direct consequence of, and in conformity with, the provisions of the Paris Convention: the countries which were represented in Madrid were Belgium, Brazil, France, Great Britain, Guatemala, Italy, the Netherlands, Norway, Portugal, Spain, Sweden, Switzerland, Tunisia, and the United States of America. Germany, although not yet a member of the Paris Union, was also represented. The International Bureau, which grouped together the international secretariat of the two Unions of Paris and Berne, was headed by Henri Morel, its *de facto* Secretary General, and assisted by two of his staff, Mr. B. Frey-Godet and Mr. Ernest Röthlisberger, a future Director of that same Bureau; this secretariat was also joined by Mr. Luis Prota, an official in the office of the Spanish Minister for Development.

In fact it was found more convenient to begin the Conference on Wednesday, April 2, 1890, and it continued through until Monday, April 14, 1890, when its ninth and last session was held. This was a technical Conference, which had to debate in depth matters which the Rome Conference of 1886 had left for future conclusion. The documents prepared and distributed by the Spanish Administration and the International Bureau before and during the Conference were mainly on four subjects, namely, a draft agreement concerning the prevention of false indications of source, a draft protocol on the interpretation and application of the Paris Convention, a draft protocol on the definitive establishment of the International Bureau, and, most important for the scope of the present work, a draft agreement concerning the international registration of marks, together with draft Regulations applicable to it.

The preparatory meeting held on the afternoon of April 2 was a rapid preliminary, dispensed with in half an hour. It was provisionally chaired by Spain's second delegate, the Count of San Bernardo, in the absence of Spain's first delegate, Segismundo Moret. The latter was appointed Chairman of the Conference, as was thought fitting for a delegate of the host country. Similarly, the first delegate of Italy, as the host country of the last Conference, was appointed to be Vice-Chairman of the Conference, and in the absence of Commander Puccioni, the Marquis Dalla Valle temporarily took his place. The Secretariat of the Conference was also appointed–Frey-Godet, Luis Prota, and Röthlisberger, as noted above.

Draft rules of procedure for the Conference, prepared by the Spanish Administration and the International Bureau, were adopted without any changes. They stated, notably, that the official language of the Conference was to be French, and that discussion would be based on the proposals made by participating countries and communicated to the delegates by the International Bureau. These proposals were to be examined by one or more

Committees: in each case, the Conference would decide whether or not such examination was to precede a general debate. The Conference was then adjourned until Saturday, April 5, the intervening days being the break for Easter celebrations.

Saturday, April 5 saw the provisional appointment of a Committee to prepare the work of the Conference, comprising the delegates of France, Great Britain and Switzerland. On the following day, the Queen Regent, María Cristina, gave a reception to the delegates. The first plenary session of the Conference was held on the afternoon of Monday, April 7, 1890.

It was, as could be expected from an opening session, an occasion of elegant speeches combined with practical arrangements. It was presided over by the Marquis de la Vega de Armijo, Minister for Foreign Affairs, who was assisted by the Duke of Veragua, Minister for Development. It is worthwhile to reproduce part of the inaugural address of the Marquis de la Vega de Armijo:

> "The universal dissemination of education and technical knowledge make it daily more necessary to complete the work of the Union and to take more energetic steps to fight counterfeiting, one of the worst barriers to industry.
>
> Moreover, good communications, which have turned the whole world into a huge market of products from all nations, make it vital to protect everywhere those worthy interests of the inventor and the industrial artist."

Segismundo Moret of Spain also spoke with eloquence, explaining that his satisfaction was "all the greater because this Conference is being held in the capital of Spain, and this fact will prove to all that, even if we have been through difficult times and violent commotions before being able to enjoy the benefits of a constitutional and parliamentary form of government, we have already reached a degree of progress which enables us to guarantee not only the rights of Spaniards, but also those of foreigners in their economic and industrial relations with Spain." The last of the opening speeches was from Commander Emilio Puccioni, first delegate of Italy, who graciously paid tribute to the host country.

Thereafter, the appointments of the Officers of the Conference made on April 2 were duly confirmed, as was the composition of the Working Committee decided upon in the meeting of April 5. Moret proposed, without opposition, that the Conference should hold its plenary sessions every morning from 10 a.m., and that the Committee should use the afternoons to prepare the next day's work. But with so many substantive and administrative issues to address, it is not surprising that the Conference could not adhere strictly to this optimistic timetable.

It was in the fourth session of the Conference that discussion on the draft Agreement concerning the international registration of marks began, and in the fifth session, held on the afternoon of Thursday, April 10, 1890, more detailed discussion on the draft Agreement concerning the international registration of marks led to the adoption of an agreed text. The Working Committee had had at its disposal the substance of the proposals made at the Rome Conference in 1886–that is to say, the original Swiss proposal, as amended by the Italian Administration. The major contribution of the latter was to change the Swiss proposal of filing by the owners of trademarks duly registered in the country of origin directly with the International Bureau for international registration, into filing of such trademarks with the International Bureau *via the national Administration where they were first filed.* This change was partly necessitated by fears that individual signatory States would lose considerable revenues hitherto accruing to them from the registration of national trademarks abroad, or of foreign trademarks at home. Interestingly, some figures were collected for the year 1888, and submitted to the Conference:

COUNTRY (in French alphabetical order)	REGISTERED TRADEMARKS		
	National	Foreign	Total
Germany	1,247	304	1,551
Austria-Hungary	1,103	117	1,220
United States of America	1,220	166	1,386
France	6,175	361	6,536
Italy	63	117	180
Serbia	5	16	21
Switzerland	391	153	544
Total	10,204	1,234	11,438

The Italian amendment to the original Swiss proposal enabled national Administrations to fix and collect the fees that persons living in, or commercially based on, their territory would have to pay for the preliminary registration. The costs of the international administration of the Agreement had to be worked out in the form of supplementary payments by States to the International Bureau, proportionate to the number of applications for international registrations put forward by each member State; any surplus, after deducting the International Bureau's costs, would be redistributed to the member States.

This supplementary international payment was among the most contentious points of the entire debate. The delegate of the Netherlands strongly put forward the view that countries which were commercially and industrially less developed would compensate for the loss of fees formerly paid directly to them, under the old system, for international registration of applications from abroad (which were of a greater volume than national registrations), by charging prohibitively high fees for the international registration of the small number of marks applied for within those countries.

He therefore stuck out for a compulsory supplementary international fee of 200 Swiss francs. (The equivalent of this sum in US dollars was then roughly 38 dollars.) Other delegates, such as those of Belgium and France, disagreed, and rather considered that one of the fundamental aims of the Agreement–moderate fees–would be defeated by such a high compulsory international fee. The figures of fees hitherto charged by an agent for the registration of a mark for a foreigner had been prepared for the year 1888 and included in the documentation of the Conference, and were as follows:

COUNTRY	FEES[1] (in Swiss francs)	CHARGES[2] (in Swiss francs)
Belgium	10	185
Spain	25 (100 réaux)	212
United States of America	130 ($25)	318
France	15 (14 Fr. francs)	132
Great Britain	31 (£ 1/5/-)	79
Italy	41	265
Netherlands	21 (10 fl.)	238
Portugal	17 (4 milreis)	265
Norway	56 (40 Cr.)	238
Sweden	56 (40 Cr.)	265
Switzerland	20	238

[1] Fees laid down by national law.

[2] Charges of agency per registration including national fees opposite.

The delegate of the Netherlands insisted on maintaining his proposal, and held that the supplementary international fee was not excessive in the light of current conditions and agency fees. The proposal created divisions and abstentions during the vote on draft Article 8–five States for (Guatemala, Netherlands, Norway, Portugal and Sweden), three States against (Belgium, Spain and Switzerland) and six abstentions (Brazil, France, Great Britain, Italy, Tunisia and the United States of America). It was not until the delegate of the Netherlands subsequently proposed to add that the supplementary fee of 200 Swiss francs was a maximum which could be reduced when ratifications were exchanged, that there was unanimous agreement on this point.

The final text of the Madrid Agreement Concerning the International Registration of Marks, in its entirety and after due discussion and amendment, was adopted by nine votes for (Belgium, Guatemala, Italy, Netherlands, Norway, Portugal, Spain, Sweden and Switzerland) and five abstentions (Brazil, France, Great Britain, Tunisia and the United States of America). In the case of Great Britain, the reasons for abstention were not far to seek: at the end of the fourth session, the British delegation had declared openly that Great Britain could not at present adhere to the Agreement, since there was not yet an international classification of trademarks, and had requested that his country's place in the Working Committee, for matters concerning this Agreement only, should temporarily be filled by another country. Belgium was chosen as the temporary replacement on the Committee.

As for the draft Regulations of the Agreement, the Conference assigned to the International Bureau, under the supervision of the Swiss Government, the task of harmonizing them with the newly adopted text of the Agreement. The Swiss delegate, although finding this a heavy responsibility and expressing his preference for the adoption of the Regulations within the sessions of the Conference, accepted the task, and stated that the new draft Regulations would be circulated in good time by the Swiss Government for the approval of the signatory States, before the Diplomatic Conference for the signature of the adopted texts.

For another, this time signatory, Conference was to be held, following which, in accordance with Article 12 of the Agreement, individual States were to ratify the Agreement, and the exchange of ratifications was to take place in Madrid, within a maximum period of six months. The Agreement was to enter into force a month after this exchange, and was to have the same force and duration as the Paris Convention.

The ninth and last session of this Conference, held on the afternoon of Monday, April 14, 1890, was as elegant an occasion as the opening, presided over this time by the Duke of Veragua, Minister for Development. He expressed pride in the role that Madrid had played "in advancing the system of the Union, by consolidating its base in such a way as to satisfy the industrial interests of most of the States represented." Equally eloquent was the last speaker, Commander Puccioni of Italy, Vice-Chairman of the Conference, who, amidst the applause of the delegates, made the following poignant revelation about Veragua: "... I, as an Italian, cannot pronounce [a name] without emotion: Cristóbal Colón [Christopher Colombus], Duke of Veragua, is a direct descendant of the illustrious man from Genoa, who, in the fifteenth century, brought together in common glory two peoples of one race, who still continue to have reasons to remain on a path of the closest possible fraternity."

In his summing up of the achievements of the Conference, Commander Puccioni called the Paris Conference of 1883 the basis of a "Confederation of different States for the reciprocal protection of industrial property rights," the Rome Conference of 1886 a consolidation of that basis, and a preparation for future progress, and the Madrid Conference "a new stone in the structure." He paid tribute to the hosts of the Conference, their country, their Queen Regent (who had received the delegates the evening before) and to their infant Sovereign. But above all, it must

have delighted the Spaniards present to hear him conclude the last official session of the Conference with the words *"Vive l'Espagne"*, words echoed in unison by all those present.

Exactly a year after the technical Conference, a Diplomatic Conference was convened in Madrid, for Tuesday, April 14, 1891. By that time, there were 16 member States of the Paris Union, all of which were invited: Belgium, Brazil, Dominican Republic, France, Great Britain, Guatemala, Italy, Netherlands, Norway, Portugal, Serbia, Spain, Sweden, Switzerland, Tunisia and the United States of America. All except the Dominican Republic and Serbia were represented.

The meetings were once again held at the San Fernando Royal Academy of Fine Arts, lasting the two days of April 14 and 15, 1891, with the first Spanish delegate, Segismundo Moret, presiding. They were intended primarily for the signature by the representatives of contracting States of the texts adopted at the Madrid Conference of 1890. But it will be recalled that a technical point remained to be settled–the amount of the supplementary international fee for international registration of marks. The question was duly raised on April 14, the day on which the Agreement Concerning the International Registration of Marks was signed, and its Regulations, as drawn up and circulated by the International Bureau, were formally declared approved. The French proposal, to reduce the originally proposed international fee of 200 Swiss francs to 100 Swiss francs, was opposed only by Italy and the Netherlands, but they quickly rallied to those voting for it–Belgium, France, Portugal, Spain, Switzerland and Tunisia; this left five abstentions, those of Brazil, Great Britain, Norway, Sweden and the United States of America.

The Madrid Agreement Concerning the International Registration of Marks was signed during this session by the delegates of Belgium, France, Guatemala, Italy, the Netherlands, Portugal, Spain, Switzerland and Tunisia. The Brazilian delegate explained that the absence of his signature should not be interpreted as a rejection, but that it was delayed by the need for a legislative decision in his country.

There remained a draft Final Protocol put forward by the French delegation, to clarify any doubts on the meaning of Article 5 of the Agreement, which laid down the possibility and the modalities for national administrations to deny protection to trademarks communicated to them by the International Bureau. The Protocol explained that the above-mentioned Article 5 did not contradict Article 6 of the Paris Convention and paragraph 4 of the Final Protocol of the Paris Convention, but should rather be read with them, since they were applicable. It will be recalled that Article 6 of the Paris Convention required any trademark, duly filed in the country of origin, to be accepted and protected in its original form in the other countries of the Madrid Union, unless it were refused on the grounds of being contrary to morality or public order. Paragraph 4 of the Final Protocol of the Paris Convention further laid down that such denial of protection could not be solely on the grounds that the signs composing the mark did not comply with the laws of the refusing State with regard to form, that it sufficed that the mark complied, on this point, with the laws of the country of origin, and that it had been validly filed in the country of origin, and finally, that the use of public armorial bearings and decorations might be considered as contrary to public order, in the sense of Article 6 of the Convention. In the second session, held on the afternoon of Wednesday, April 15, 1891, this Final Protocol was signed by the same countries as had signed the Agreement itself.

The maximum six-month period foreseen for the exchange of definitive ratifications in Madrid proved to be too short for the completion of formalities in all the contracting States. The date had to be postponed, first to April 15, 1892, and finally to June 15, 1892, when five of the States, Belgium, France, Spain, Switzerland and Tunisia, were in a position to exchange instruments of ratification at the Ministry of State in Madrid. In the long history of the Agreement, others would follow in joining the Union.

The next chapter examines what this first Agreement of 1891 established and achieved, and how it developed in its application and in subsequent Diplomatic Conferences.

PART II

THE LEGAL DEVELOPMENT OF THE SYSTEM OF INTERNATIONAL TRADEMARK REGISTRATION

The first Diplomatic Conference that discussed detailed plans for a system of international registration of marks was the Rome Conference of 1886 (that revised the Paris Convention concluded in 1883). No agreement was reached on the plans at the Rome Conference and they were submitted, in revised form, to the Madrid Conference of 1891 at which the Madrid Agreement was adopted.

Since its adoption, the Madrid Agreement of 1891 has been revised on six occasions: at Brussels in 1900, at Washington in 1911, at The Hague in 1925, at London in 1934, at Nice in 1957 and at Stockholm in 1967. Throughout those revisions, however, the essence of the system established in 1891 has remained constant. From its inception, the aim of that system has been to provide a legal mechanism whereby protection for a mark originating in one of the contracting countries could be obtained in all of the other contracting countries. The means of achieving that result was and still is the international

registration of the mark following its registration in the national trademark registry of one of the contracting countries, the international registration having the same effect as a national registration in each of the other contracting countries. The effect may be refused–for reasons specified in its national law–by any of those countries, but such refusal only concerns the refusing country.

While the system established by the original Madrid Agreement has remained the same, the various revisions have added more detail, sophistication and clarity to the operation of the legal mechanism. This effect of the revisions can be seen by examining the development of each of the main elements of the present system of international registration under the latest (Stockholm 1967) Act of the Madrid Agreement.

Main Elements of the System of International Registration

The present system of international registration under the Madrid Agreement may be said to be constituted by seven main elements:

(i) the existence of a basic right (a registered mark) in one contracting country–the basic mark–for which protection in the other contracting countries is sought;

(ii) the entitlement on the part of the owner of the basic mark to take advantage of the benefits of the Madrid Agreement for obtaining the protection sought for the same mark in the other contracting countries;

(iii) the filing of an application for the international registration of the basic mark and the subsequent international registration of the same mark;

(iv) the designation of those of the other contracting countries in which protection of the mark is sought through the international registration;

(v) the right on the part of the designated contracting parties to refuse, on certain grounds, to accord protection to the internationally registered mark;

(vi) the dependency of the international registration and of the effects of that registration on the continuing existence of the registration of the basic mark, that is, the registration in its country of origin, throughout a limited initial period (five years);

(vii) the possibility of an unlimited duration, through an initial term and subsequent renewals, of the international registration.

Each of the above-mentioned elements is separately considered in the paragraphs that follow.

Existence of a Basic Right, that is, a National Registration in the Country of Origin

From the time of the first project for a system of international registration of marks, presented by the Delegation of Switzerland at the Rome Conference of 1886, the idea of a unitary system–namely, a system under which one and the same title of protection of a mark would have the same effect and be governed by the same law throughout the whole of the territory of all of the contracting countries–has been eschewed. The explanatory memorandum to the proposals of the Swiss Administration presented at the Rome Conference of 1886 opposed the adoption of a unitary system, this opposition being repeated at the Madrid Conference of 1890 in the following terms:

> "Absolute unification of the system of trademarks, assuring protection throughout the whole territory of the Union to all marks regularly filed in one State of the Union, will perhaps be achieved one day; but the differences that presently exist between internal laws lead one to believe that that moment is still far off. Furthermore, the Swiss Administration does not see the need for such a complete unification of law on this matter: it even fears that marks used solely in the internal commerce of one country should be protected throughout the whole Union, since that would oblige persons seeking to choose a new trademark to consult beforehand the enormous collection of marks used in all the contracting States, in order not to become infringers without knowing it." (*Procès-verbaux de la Conférence de Madrid de 1890 de l'Union pour la protection de la propriété industrielle*, p. 30.)

By rejecting the idea of a unitary system, the framers of the Madrid Agreement were required to develop a system which would preserve the separate national effects of the protection of a mark in each of the contracting countries, while at the same time creating the possibility for those separate national effects to be made available to any mark that originated in one of the contracting countries. Such a result required the starting point for the system of international registration to be a national registration which, through a subsequent international registration, could be given the effect of national registrations in the other contracting countries.

The proposal originally presented by the Swiss Administration at the Rome Conference of 1886 (which preceded by five years the Madrid Conference) envisaged the possibility of a direct filing with the International Bureau by the owner of the national registration. As stated in Part I, above, however, the proposal was amended on the initiative of the Delegation of Italy so as to provide for the international

application to be made through the intermediary of the Office of the country of origin, the purpose of interposing the Administration of the country of origin being to compensate "contracting States for the loss of fees on foreign marks by the right to impose a fee on marks filed for international registration by their nationals." (*Actes de la Conférence internationale de l'Union pour la protection de la propriété industrielle, Rome, 1886*, p. 152.)

Entitlement to Seek International Registration

The Madrid Agreement of 1891 provided for two classes of persons to be entitled to use the system it established for obtaining international registration of their marks. One of the classes comprised the subjects or citizens of any of the contracting countries themselves (Article 1). The other class was rather generously defined and included the subjects or citizens of non-contracting countries who were domiciled or who had industrial or commercial establishments in the territory of one of the States of the *Paris Union* (Article 2).

As it became apparent that fewer countries would become members of the Madrid Union than of the Paris Union, the scope of the latter class of persons entitled to file and obtain international registrations underwent an important limitation at the Brussels Conference of 1900. The Brussels Act provided for entitlement to subjects or citizens of non-contracting countries only if they were domiciled or had real and effective industrial or commercial establishments in the territory of one of the countries members of the *Madrid Union*.

The definition of the range of persons entitled to file for international registration required a practical complement. Since it had been decided that direct filing by the owners of marks with the International Bureau was not to be allowed, it was necessary to specify the identity of the intermediary through which the filing should be made. The Madrid Agreement of 1891 used the notion of the "country of origin." It did not, however, define the notion presumably because that notion was defined in Article 6(2) of the Paris Convention (original text). According to that Article, the country of origin is "the country in which the applicant has his principal establishment." A formal connection was not, however, made between the definition of the term contained in the Paris Convention and the use of the term in the Madrid Agreement of 1891.

Predictably, by the time of the Hague Conference of 1925, problems had surfaced in relation to the identification of the country of origin. In the proposals and explanatory memoranda prepared by the Netherlands Administration and the International Bureau for the Hague Conference, it was noted that "On various occasions we have noticed that enterprises that have establishments in several countries have, and for very different reasons, deposited their international marks while choosing in an arbitrary manner the country through the intermediary of which they make their deposits." (*Actes de la Conférence de La Haye de 1925*, p. 227.)

Not all of the cases of enterprises using different countries of origin were attributed to ignorance of the definition of "country of origin" in Article 6 of the Paris Convention. The same preliminary texts before the Hague Conference noted:

> "... we know of countries where the true country of origin has been deliberately avoided, because the applicant considered that his filings there suffered from longer delays than in another, more efficient country, or because the Administration of the country of the principal establishment imposed for the deposit at Berne a national fee noticeably higher than that of the country where his secondary establishment was located. Finally, marks have been filed, or filed a second time internationally, through the intermediary of another Administration than that of the true country of origin because in the latter the national mark would have run the risk of being refused or annulled." (*Ibid.*)

The text of the Hague Act of 1925 regulated the problem of multiple countries of origin by creating a formal and direct link with the definition of "country of origin" in what had become Article 6 of the Hague Act of the Paris Convention. That definition was in almost identical terms to the provision now contained in Article 1(3) of the Stockholm Act of the Madrid Agreement.

Article 1(3) of the Stockholm Act provides for the so-called "cascade" to determine a sole country of origin. It proceeds on the basis that the country of origin is the country of the Madrid Union where the applicant has a real and effective industrial or commercial establishment. If that criterion cannot be met because there is no such establishment, the country of origin is the country of the Madrid Union where the applicant has his domicile. If that further criterion also cannot be met, the country of origin is the country of the Madrid Union of which the applicant is a national.

The Madrid Agreement of 1891 dealt only with entitlement to benefit from the advantages of the international system of registration at the time of *filing* the international registration. The question of subsequent transfers of a mark which was the subject of the international registration was not treated. This question was taken up at the first revision conference, the Conference of Brussels of 1900. The Brussels Act added extensive provisions on the transfer of marks which were the subject of international registrations, including the rule that no transfer of a

mark registered in the International Register could be effected for the benefit of a person not established in one of the "signatory countries." In the Stockholm Act, the analogous provision is to be found in Article 9*bis*(2), with the more appropriate wording that no transfer of a mark registered in the International Register could be recorded for the benefit "of a person who is not entitled to file an international mark...."

Filing of the Application and Registration

The Madrid Agreement of 1891 did not itself contain provisions concerning the procedure for application for international registration. It merely envisaged the filing of marks at the International Bureau (Article 1) followed by their immediate registration by the International Bureau (Article 3). The details concerning the application procedure were dealt with in the Regulations.

Throughout the various revisions, more of the details concerning the application procedure have been included in the text of the Agreement itself. Thus, for example, it was judged appropriate at the Hague Conference of 1925 to make provision in Article 3 for an indication, in summary form, of the procedure to be followed to obtain an international registration. In particular, it was stated that the Office of the country of origin of a mark had to certify that the particulars appearing in the international application were in accordance with the particulars in the national registration, this provision being considered opportune in order to make "the proprietors of marks more aware of the reason for which they are obliged to pass through the intermediary of the Administration of their country." (*Ibid.*, p. 278.)

Besides the addition of greater detail and sophistication in the provisions setting forth the requirements of the international application, the most significant change to have been adopted to the procedures for international application and international registration was the introduction, in Article 3(2) of the Nice Act of 1957, of the compulsory use of the classification of goods and services established by the Nice Agreement Concerning the International Classification of Goods and Services to which Trademarks are Applied.

The introduction of a system of registration by class, and the use of the International Classification for that purpose, represented a major step forward. An attempt to introduce registration by class had been made with the original proposal formulated by the Delegation of Switzerland at the Rome Conference of the Paris Union of 1886, but had failed. By the time of the Nice Conference of 1957, however, it was clear that:

> "In countries where registration suffices, in the absence of use, to create rights in respect of a mark, the custom spread of effecting deposits which applied not only to products made or sold by the applicant, but also to others which in no way entered into his normal field of activity. Transposed to the international level, that practice, highly prejudicial to the general interest of commerce and industry, became for the Administrations of countries conducting an examination as to prior rights the source of a useless and heavy increase of responsibility, since it required them to examine and, where applicable, to inscribe in their registers, for all the articles for which they were described, marks which, for certain of those articles, would never be used and which, in this respect, not only do not have any real economic interest, but even constitute veritable marks of obstruction." (*Actes de la Conférence de Nice de 1957*, p. 69.)

The adoption of the system of registration by class, with the levying of a supplementary fee for each class above the third, was directed at reducing, if not totally eliminating, those difficulties.

Designation of Contracting Parties in Which Protection is Sought

As originally adopted, the Madrid Agreement of 1891 provided for an international registration to have automatic effect in each of the contracting countries, regardless of whether the owner of the mark had, or had any intention of establishing, commercial operations in each of those countries.

By the time of the London Conference of 1934, certain disadvantages had been perceived in the system of giving automatic effect to the international registration in each contracting country. The Delegation of the Netherlands questioned whether the system should not be reconsidered. It pointed to two disadvantages, in particular, the first affecting national Administrations and the second affecting users. From the point of view of the national Administration, the fact that each international registration automatically had effect in each contracting country meant that the Administration was put to the work of examining and inscribing a number of marks in respect of which the territory of the Administration was of little or no interest to the applicant. Those Administrations which conducted an examination of marks on the grounds of registrability or prior rights, as well as those countries in which only a small part of the total number of international marks were exploited, were particularly disadvantaged. From the point of view of the users, the automatic effect produced by international registration imposed unnecessary burdens by requiring them to oppose the

national effects of marks even in those countries in which the mark's protection was not desired.

In order to overcome those disadvantages, the Delegation of the Netherlands proposed during the London Conference that the applicant should be required to designate the countries in which he wished to claim protection and that the international fee should vary according to the number of countries designated. The proposal was considered, however, to be too radical to be adopted at that Conference, most delegations stating that they needed to consult with their interested circles before being able to subscribe to the proposal. It was decided, nevertheless, that the proposal should be remitted for further study.

In the period following the London Conference of 1934, four draft proposals were developed to revise the system of the automatic effect of the international registration. Each of those four draft proposals was based on the notion of the so-called territorial limitation of international registrations, according to which each international registration would be notified only to Administrations of those contracting countries in which the owner of the mark had declared that he wished to obtain protection. None of the four proposals, however, met with unanimous approval. A further proposal, accordingly, was devised, which was based on the notion of use of the mark. According to that proposal, each contracting country would be free to require, at the end of each period of five years commencing with the date of the international registration, the production of an affidavit establishing that the mark which was the subject of the registration had been utilized in its territory. In default of the production of such an affidavit, the authorities of the country concerned could annul the mark. Once again, however, the project failed to achieve unanimous approval.

In order to break the deadlock that had developed over the question, the Administration of France and the International Bureau reverted, during the preparations of the Nice Conference of 1957, to the principle of territorial limitation as the means of resolving the situation. This time, however, it was proposed to make that principle optional rather than compulsory:

> "Rather than, on the one hand, imposing territorial limitation on Administrations that do not want it, or, on the other hand, prohibiting territorial limitation to those Administrations that were partisan to it, it appeared opportune to leave to each unionist State the faculty of choosing for its territory, if such were its desire, the application of territorial limitation." (*Actes de la Conférence de Nice de 1957*, pp. 68-69.)

The new solution won acceptance at the Nice Conference of 1957. One of the major reasons for its acceptance was a fear that the system of automatic effect had been the cause of denunciation of the Madrid Agreement by several States (there were six such denunciations between 1934, when the Netherlands Delegation first proposed a system of designation, and 1957, when such a system was finally adopted) and might curtail future growth of the Madrid Union.

The new solution gave birth to Articles 3*bis* and 3*ter* of the Nice Act of 1957, which appear in substantially the same form in the corresponding Articles of the Stockholm Act of 1967. Article 3*bis* of the Stockholm Act allows any contracting country to notify the Director General of WIPO that the protection resulting from the international registration will extend to that country only at the express request of the proprietor of the mark. Article 3*ter* deals with the modalities of designating, in respect of a particular mark, a country which has chosen to adopt the principle of territorial limitation. Such a designation must be made either in the international application, that is, at the time at which the application is made (paragraph (1) of Article 3*ter*), or subsequent to the international registration by the presentation, through the intermediary of the Office of the country of origin, of a request on an official form (paragraph (2) of Article 3*ter*). The latter is usually called "later designation."

Refusal of Protection by Designated Contracting Parties

In the original proposal for the establishment of a system of international registration of marks submitted by the Swiss Delegation at the Rome Conference in 1886, the automatic effect given to an international registration was to be absolute. The Trademark Administration of the contracting countries were to have no right to refuse to accord protection. The only means of refusing protection was the invalidation of the protection by a court.

For as long as marks were not examined at the national level for conflicts with prior rights, it made sense not to accord contracting countries any right of refusal: the international scheme would mirror national practice. The idea of subjecting marks to examination for conflicts with prior rights was, however, starting to find some supporters. Sweden and Norway were such supporters. They felt unable to agree to the proposal of the Swiss Delegation, since "according to the recently adopted laws, no trademark could be accepted for legal protection before being submitted to an examination as to prior rights by the competent authority. The adoption of the Agreement proposed would oblige those countries to completely revise their legislation, and to introduce new principles." (*Actes de la Conférence*

internationale de l'Union pour la protection de la propriété industrielle, Rome, 1886, p. 151.)

In consequence of such objections, the proposal put forward at the Madrid Conference of 1890 envisaged that each contracting country would have a period of one year in which to refuse to accord protection to any mark which was the subject of an international registration that had been notified to it by the International Bureau. The proposal was adopted, but the adopted text failed to state explicitly that the limitations imposed by the Paris Convention of 1883 on the right of member countries of the Paris Union to refuse registration for marks which had been duly filed in other member countries (naturally) applied in the context of the Madrid Agreement. In order to eliminate doubt, a Final Protocol to the Madrid Agreement of 1891 was adopted which made the requisite connection by specifying that the right of refusal envisaged in Article 5 of the Madrid Agreement was circumscribed by the pertinent provisions of the Paris Convention (namely, Article 6 of the Paris Convention of 1883 and paragraph 4 of the Final Protocol accompanying it).

At the time of the Brussels Conference of 1900, advantage was taken of the opportunity presented by the revision of the Madrid Agreement to insert the clarification contained in the Final Protocol to the Madrid Agreement of 1891 into the text of the Madrid Agreement itself. A sentence was added to the first paragraph of Article 5 of the Brussels Act of 1900 providing that "any such refusal can only be based on the grounds that would apply by virtue of the Convention of March 20, 1883, in the case of marks deposited for national registration."

Most of the major modifications that have been made to the provisions concerning the right of contracting countries to refuse to accord protection were introduced at the London Conference of 1934. Two questions on the subject were treated at that Conference.

The first concerned the communication by the International Bureau to interested third parties of the grounds on which a particular contracting country may have refused protection to a mark that was the subject of an international registration. In the explanatory memorandum prepared by the United Kingdom Administration and the International Bureau for the Conference, it was observed that the International Bureau was increasingly receiving requests from third parties for the communication of such grounds of refusal. After weighing the arguments for and against making such communications, it was concluded that "industrialists and businessmen certainly had an ... interest in knowing the jurisprudence of the countries to which they wish to export their products and in knowing exactly what type of signs it would be better not to choose in order not to risk seeing protection refused in this or that country." (*Actes de la Conférence de Londres de 1934*, pp. 204-205.) A corresponding provision was, accordingly, adopted as paragraph (4) of Article 5 in the London Act of 1934.

The second question considered at the London Conference of 1934 concerned the fairness of the procedures adopted by national Administrations in respect of the invalidation of marks. The explanatory memorandum of the United Kingdom Administration and the International Bureau remarked that owners of international marks had often complained that the authorities of certain countries had invalidated marks without giving sufficient opportunity to the owners to defend their cases. The argument that the Agreement should not deal with such questions of procedure was dismissed on the basis that "registration, as a whole, constituted one administrative procedure and, if one did not assure that it had a certain security against arbitrary invalidations, it would singularly lose its value." (*Ibid.*, p. 205.) In consequence, paragraph (6) of Article 5 of the London Act of 1934, which is in substantially the same form as the corresponding provision in the Stockholm Act of 1967, was adopted and provided that an international mark could not be invalidated by the competent authorities without the proprietor of the mark having, in good time, been afforded the opportunity of proving his rights.

Dependency

An inevitable consequence of rejecting the notion of a unitary system during the initial preparation of the Madrid Agreement was the creation of a relationship of dependence between the international registration and the basic right or national registration on which the international registration was based. At first, the dependence was complete. Article 6 of the Madrid Agreement of 1891 provided that the protection resulting from the international registration "may not be invoked in favor of a mark that no longer enjoys legal protection in the country of origin." It thus resulted from Article 6 that the international registration had no "existence of its own." (*Procès-verbaux de la Conférence de Madrid de 1890 de l'Union pour la protection de la propriété industrielle*, p. 33.)

The rule of total dependence of the international registration on the national registration on which it was based stayed in place until the Nice Act of 1957. In the proposals and explanatory memorandum prepared by the French Administration and the International Bureau for the Nice Conference, the desirability of such total dependence was questioned. In particular, it was argued that the total dependence of the international registration might not be entirely compatible with Article 6D of what was then the

latest text of the Paris Convention, namely, the London Act of 1934. That provision, whose counterpart is now to be found in Article 6(3) of the Stockholm Act of the Paris Convention, provided, in its relevant part, that "when a trademark has been duly registered in the country of origin and then in one or more of the other countries of the Union, each of these national marks shall be considered, from the date of its registration, as independent of the mark in the country of origin...."

In order to overcome this alleged contradiction, it was proposed to delete the words "it [the protection resulting from registration at the International Bureau] may not be invoked in favor of a mark which no longer enjoys legal protection in the country of origin," which originally appeared in Article 6 of the Madrid Agreement of 1891 and which were to be found in the London Act of 1934. The proposal was, however, considered to be too radical in that it went from a situation of total dependence to one of total independence. In particular, it was considered by the delegations attending the Nice Conference of 1957 that the total independence of the international registration would impair the principal benefit of the Madrid Agreement, namely, a single procedure. The single procedure made possible by the Madrid Agreement meant not only that there was one filing, a uniform duration, one renewal and one set of procedures for the transfer of the registration, but also that there was one procedure for attacking and bringing about the invalidation of an international registration. If the international registration was made totally independent, competitors would be put to the trouble of seeking the invalidation of the mark that was the subject of the registration in each contracting country. Amongst other things, such a result was perceived as likely to create an imbalance in the benefits made available by the Madrid Agreement since, as the Madrid Agreement had the objective of offering traders a relatively cheap means of obtaining the registration of their marks in several countries at a time, it followed "equitably that other businessmen, whose interests could be in conflict with the international registration of a mark and the national registration of which it was the consequence, could also take measures to obtain satisfaction for their interests through the means of one procedure and without great expense." (*Actes de la Conférence de Nice de 1957*, p. 136.)

The concern to preserve the benefits of the single procedure which, in this context, has become known as the possibility of "central attack," resulted in the adoption of the compromise of a dependence limited in time. The international registration would become independent after a period of five years from the date of the international registration. That rule is now to be found in Article 6(2) of the Stockholm Act of 1967.

Duration

From the Madrid Agreement of 1891 until the present time, the initial duration of the international registration has been 20 years. It has also been provided from the outset that the duration of the registration could be extended indefinitely.

The principal changes that have occurred in the international system in relation to duration have concerned renewals. Under the Madrid Agreement of 1891, the renewal procedure was the same as the application procedure, so that the renewal was notified to each of the contracting countries which, in turn, had the possibility of refusing the renewal. In keeping with the notion of limited dependence established at the Nice Conference of 1957, the renewal procedure was revised at the same Conference so as to allow renewal to be effected "simply by the payment of the basic fee and, if necessary, of the supplementary and complementary fees" (Article 7(1) of the Nice Act of 1957). The earlier requirements of a prior renewal in the country of origin and of the presentation of a national certification were eliminated. Renewal could be effected directly with the International Bureau since the international registration would have, by that stage, attained independence, thus obviating the need to pass by the national Administration.

Recent Developments– the Madrid Protocol of 1989

While the success of the Madrid Agreement is undoubted, the testimony of which is the number of approximately 280,000 international registrations that are in force in 1991, the geographical reach of the membership of the Madrid Union has never realized its full potential. The system has remained short of universal. Important markets have remained outside the system and, in a world in which national and regional markets are becoming increasingly integrated into one global market, attention has naturally turned to ways in which a truly universal international registration system for marks might be achieved.

The first attempt at establishing such a universal system in the relatively recent past was the Trademark Registration Treaty (TRT), which was adopted by the Vienna Diplomatic Conference on June 12, 1973. The attempt thus chose the strategic route of a completely new treaty, one which was outside the Madrid system, but which, at the same time, seeks to incorporate some of the advantageous features of the Madrid system.

Under the TRT, the international application does not need to be based on a mark that has already been registered at the national level. Thus, the interna-

tional registration is independent in all of the countries in which it has effect from the commencement of the international registration. Like the Madrid Agreement, however, the effect of the international registration under the TRT in each of the designated States is the same as a national filing in that State. Similarly, each designated State has the right to refuse the effects of the international registration within a specified period of time.

While the TRT entered into force in 1980, the number of States that are party to it has not increased beyond the five whose accessions brought about the entry into force of the treaty. Thus, as an attempt to achieve a truly universal system of international registration of marks, the TRT did not succeed.

As it became clear that the TRT was not going to win widespread acceptance, the strategy shifted away from a completely new treaty, like the TRT, to the possibility of revising those features of the Madrid Agreement which seemed to be the cause of resistance on the part of non-contracting States to joining in the international system established by the Madrid Agreement. The difficulty with such an approach, however, was that the parties to the Madrid Agreement were satisfied with it in its present form and were not keen to risk a revision which might prejudice the benefits of the efficient functioning of the system that it created.

After lengthy discussions in committees of governmental experts convened in the years 1986 to 1989 by the International Bureau, the idea of a treaty in parallel to the Madrid Agreement was conceived. Pursuant to that idea, a protocol would be concluded which would be based on the Madrid Agreement, but with the modifications considered necessary to attract certain non-members of the Madrid Union to the Madrid system. In order to benefit from the cooperation with those non-contracting countries that would become party to the new protocol, existing contracting parties to the Madrid Agreement could also become party to the protocol. At the same time, they would remain party to the Madrid Agreement which would continue to function on its present terms. For ease of administration and to provide a common forum for deliberations and decision-making, those countries which became party to the new protocol would also become members of the Special Union created by the Madrid Agreement.

The newly-conceived idea was born–like the original Madrid Agreement of 1891–in Madrid, on June 28, 1989, when what is called "the Madrid Protocol" was adopted. The features of the Madrid Agreement which were widely perceived as constituting impediments to the enlargement of the membership of the Madrid Union and which were modified in the Madrid Protocol were fourfold.

The first modification related to the basic right on which an international registration has to be based. Whereas the Madrid Agreement requires the international application to be based on a national *registration*, the Madrid Protocol allows it to be based on a national *application*, as well as a national registration. The modification was introduced for the benefit of those countries whose Offices examine applications *ex officio* both on absolute grounds and as to conflict with earlier rights. In such cases, the processing of an application typically requires more than six months, so that it would be very difficult to file an application for international registration based on a national registration within the six-month priority period established by the Paris Convention.

The second modification was also introduced for the benefit of those countries in which the national Office carries out a full *ex officio* examination. In those cases, the time limit for refusing the effect of an international registration under the Madrid Agreement (one year) was perceived to be too short. To deal with that difficulty, the Madrid Protocol allows 18 months for refusals and an even longer period in the case of oppositions.

The third modification related to the fee structure of the Madrid Agreement. For those countries conducting a full *ex officio* examination of an application, the capacity to receive a fee as a result of a designation which was equivalent to the national fee was considered necessary in order to maintain the resources required for the examination system. The Madrid Protocol, accordingly, provides that the national Office of a designated country may, if it so desires, receive the full amount of the fee, or a substantial proportion thereof, that it would charge for a national registration.

The final feature concemed the system of central attack resulting from the relative dependence of the international registration on the national registration on which it is based. In circumstances where the reasons for cancellation were valid only in the country of the national registration forming the basis of the international registration, the effects of relative dependence (namely, the loss of effect of the international registration in all the designated countries) were considered to be unjust. To deal with this difficulty, the Madrid Protocol allows the transformation of a failed international registration into a national application in each designated country, such national applications having the filing or, where applicable, priority date of the international registration.

In addition to the above-mentioned modifications, the Madrid Protocol also establishes the possibility of a link between the Madrid system and regional trademark systems of which the future Community trademark is expected to be a notable example.

The Madrid Protocol was signed by 28 States, including several States that are not party to the Madrid Agreement. It had not yet been ratified by any State or intergovernmental organization at the time of the one hundredth anniversary of the Madrid

Agreement. Signs for the future of the Madrid Protocol and its coexistence with the Madrid Agreement are hopeful. But that future now remains to be made over the next 100 years of the Madrid Agreement.

PART III

THE DEVELOPMENT OF THE ADMINISTRATION OF THE MADRID UNION

Membership

The membership of the Madrid Union developed in an interesting way: naturally, amongst the most important periods of membership was the beginning, from 1892, when ratifications were exchanged for the first time, until 1896. But there was also a significant number of new memberships (nine) between the adoption of the Washington Act in 1911 and the end of 1925, possibly partially indicating a delayed reaction after the First World War. More predictably, the third particularly fruitful period of membership came after the adoption of the Stockholm Act in 1967, through the 1970s and 1980s; this was a consequence of the creation of the World Intellectual Property Organization, henceforth administrator of the Madrid system, and its ever growing influence in international cooperation in the field of intellectual property.

The following States ratified or acceded to the various Acts of the Madrid Agreement in the last 100 years:

Original 1891 texts: Belgium, Brazil (ceased to be a member in 1934), France, Italy, Netherlands, Portugal, Spain, Switzerland, Tunisia (9).

Brussels Act, 1900: *New members*: Austria, Cuba (ceased to be a member in 1932, but rejoined in 1989), Hungary, Mexico (ceased to be a member in 1943). *Others*: Belgium, Brazil, France, Italy, Netherlands, Portugal, Spain, Switzerland, Tunisia (total of 13).

Washington Act, 1911: *New members*: Czechoslovakia, Danzig (Free City of), Germany, Latvia (ceased to be a member in 1926), Luxembourg, Morocco, Romania, Serbia-Croatia-Slovenia, Turkey (ceased to be a member in 1956). *Others*: Austria, Cuba, France, Hungary, Italy, Mexico, Netherlands, Portugal, Spain, Switzerland, Tunisia, (total of 20).

The Hague Act, 1925: *New members*: Liechtenstein, Slovakia, Tangier. *Others*: Austria, Belgium, Brazil, Czechoslovakia, France, Germany, Hungary, Italy, Mexico, Morocco, Netherlands, Portugal, Romania, Spain, Switzerland, Tunisia, Turkey, Yugoslavia (total of 21).

London Act, 1934: *New members*: Egypt, Monaco, San Marino, Viet Nam. *Others*: Austria, Belgium, Czechoslovakia, France, Germany, Hungary, Italy, Liechtenstein, Luxembourg, Morocco, Netherlands, Portugal, Romania, Spain, Switzerland, Tangier, Tunisia, Yugoslavia (total of 22).

Nice Act, 1957: *New member:* German Democratic Republic (ceased to be a member in 1990). *Others*: Austria, Belgium, Czechoslovakia, Egypt, France, Germany (Federal Republic of), Hungary, Italy, Liechtenstein, Luxembourg, Monaco, Morocco, Netherlands, Portugal, Romania, San Marino, Spain, Switzerland, Tunisia (ceased to be a member in 1988), Yugoslavia (total of 21).

Stockholm Act, 1967: *New members*: Algeria, Bulgaria, China, Democratic People's Republic of Korea, Mongolia, Poland, Soviet Union, Sudan. *Others*: Austria, Belgium, Cuba, Czechoslovakia, Egypt, France, German Democratic Republic (ceased to be a member in 1990), Germany (Federal Republic of), Hungary, Italy, Liechtenstein, Luxembourg, Monaco, Morocco, Netherlands, Portugal, Romania, San Marino, Spain, Switzerland, Viet Nam, Yugoslavia (total of 30 members having ratified or acceded to the Stockholm Act). Total membership: 29 States, after the unification of the two parts of Germany.

Madrid Union Membership

The following list shows the present members of the Madrid Union in the order of the years in which they became members:

1892 Belgium, France, Spain, Switzerland
1893 Netherlands, Portugal
1894 Italy
1905 Cuba
1909 Austria, Hungary
1917 Morocco
1919 Czechoslovakia
1920 Romania
1922 Germany
1924 Luxembourg
1928 Yugoslavia
1930 Liechtenstein
1949 Viet Nam
1952 Egypt
1956 Monaco
1960 San Marino
1972 Algeria
1976 Soviet Union
1980 Democratic People's Republic of Korea
1984 Sudan
1985 Bulgaria, Mongolia
1989 China
1991 Poland

Use of the Madrid System

The facilities offered by the Madrid Agreement began to function on January 1, 1893. The tables and data on pages 408 and 409 indicate the numbers of international registrations and renewals from the

Registrations*

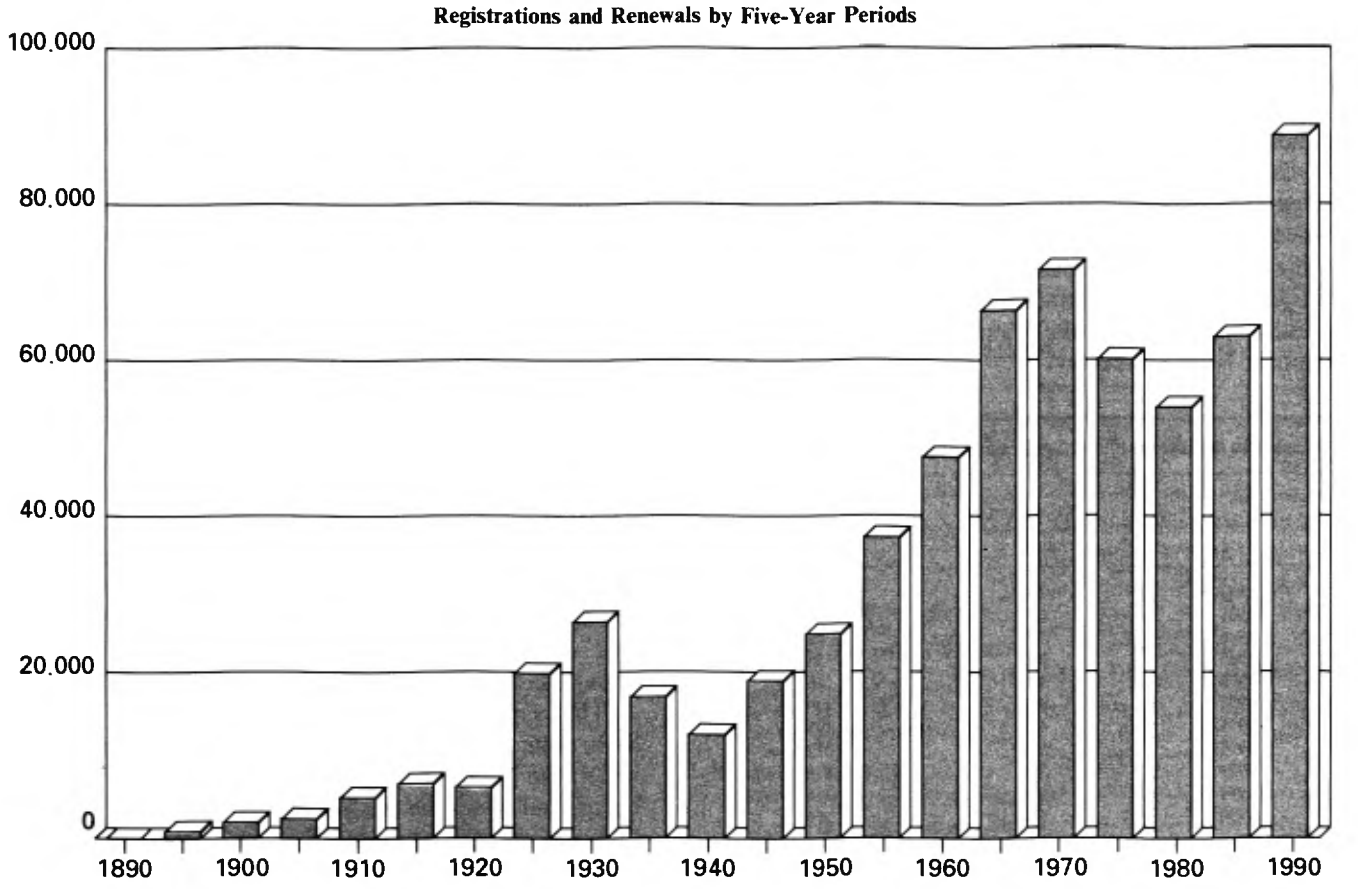
Year	Registrations	Year	Registrations	Year	Registrations
1893	76	**1918**	987	**1943**	5,612
1894	231	**1919**	1,575	**1944**	4,502
1895	229	**1920**	2,284	**1945**	3,682
1896	304	**1921**	2,562	**1946**	4,560
1897	409	**1922**	2,653	**1947**	4,616
Cumulative total	1,249		29,014		133,967
1898	451	**1923**	5,258	**1948**	5,981
1899	323	**1924**	5,487	**1949**	4,801
1900	368	**1925**	5,387	**1950**	6,309
1901	369	**1926**	4,888	**1951**	7,569
1902	435	**1927**	5,255	**1952**	7,552
Cumulative total	3,195		55,289		166,179
1903	577	**1928**	5,976	**1953**	7,572
1904	547	**1929**	5,917	**1954**	8,069
1905	691	**1930**	5,760	**1955**	7,955
1906	749	**1931**	4,482	**1956**	7,909
1907	789	**1932**	3,946	**1957**	8,501
Cumulative total	6,548		81,370		206,185
1908	908	**1933**	3,550	**1958**	9,873
1909	1,302	**1934**	3,453	**1959**	11,296
1910	1,409	**1935**	2,822	**1960**	11,662
1911	1,517	**1936**	3,204	**1961**	12,079
1912	1,553	**1937**	2,905	**1962**	12,872
Cumulative total	13,237		97,304		263,967
1913	1,934	**1938**	2,800	**1963**	14,193
1914	1,394	**1939**	2,476	**1964**	14,423
1915	658	**1940**	1,951	**1965**	14,596
1916	850	**1941**	2,913		307,179
1917	880	**1942**	3,551		
Cumulative total	18,953		110,995		

* Until December 14, 1966, renewals were in the form of new registrations.

Registrations and Renewals from 1966

Year	Registrations	Renewals	Total Registrations and Renewals
1966	24,258*	1**	24,259
1967	9,598	689	10,287
1968	11,024	1,713	12,737
1969	11,435	1,554	12,989
1970	10,731	2,328	13,059
Cumulative total			380,510
1971	9,583	3,204	12,787
1972	10,781	3,431	14,212
1973	8,942	3,112	12,054
1974	8,858	3,468	12,326
1975	7,203	3,190	10,393
Cumulative total			442,282
1976	7,393	3,002	10,395
1977	7,544	3,006	10,550
1978	7,307	3,724	11,031
1979	7,359	3,913	11,272
1980	8,028	4,310	12,338
Cumulative total			497,868
1981	8,269	4,249	12,518
1982	8,096	4,464	12,560
1983	8,047	4,882	12,929
1984	8,246	4,799	13,045
1985	8,961	4,735	13,696
Cumulative total			562,616
1986	9,167	8,242	17,409
1987	10,186	3,611	13,797
1988	13,016	4,538	17,554
1989	14,896	4,592	19,488
1990	17,157	4,854	22,011
Cumulative total			652,875

* Until December 14, 1966, renewals were in the form of new registrations. ** From December 15 to 31, 1966.



beginning until the end of 1990. It should be noted that until December 14, 1966, renewals of previous registrations were in the form of new registrations.

The Finances of the Madrid Union

Sources of the Union's Income

Registration and Renewal Fees. The main source of the Madrid Union's income is the registration and renewal fees paid by the users of the international registration system.

The first of the major fees, and the only one to subsist in the same form from the very beginnings to the present day, is the basic fee for the registration or renewal of a single mark. It was established as the sole fee in 1891, as has been stated in Part I, at a flat rate of 100 Swiss francs. The Brussels Act of the Madrid Agreement, which came into force in 1902, made provision for a system of advantageous multiple deposits, whereby the same depositor could internationally register, simultaneously with a first mark (still at 100 Swiss francs), any additional marks at half price.

These fees remained unchanged until June 1, 1928, when the revision of the Madrid Agreement undertaken at The Hague in 1925 came into force. The basic fee for registration or renewal of a single mark then rose to 150 Swiss francs, and the cost of simultaneous additional registrations or renewals rose to 100 Swiss francs. The Hague Act also introduced an optional system of payment of the above-mentioned registration fees in two installments, each covering a 10-year period: the first installment was a payment of 100 Swiss francs for a single mark, and 75 Swiss francs per additional simultaneous registration, and the second installment 75 Swiss francs for the single mark, and 50 Swiss francs per additional simultaneous registration.

These fees, as revised at The Hague, remained stable until the entry into force, on December 15, 1966, of the Nice Act of the Madrid Agreement. In 1966, the basic fee for the registration or renewal of a single mark rose to 200 Swiss francs, and the fee for registration of any additional simultaneously registered or renewed mark rose to 150 Swiss francs. The two installments for registration per 10-year period also rose: the first installment became 125 Swiss francs for a single mark and 100 Swiss francs for any additional simultaneous one, and the second installment 100 Swiss francs for the single mark, and 75 Swiss francs for any additional simultaneously registered mark. It was the last occurrence of the lower rate for multiple deposits that was discontinued in the Stockholm Act.

The increases of 1966 marked the end of an era of stable fees for long periods. Rising costs, notably

caused by the phenomenon of worldwide inflation, necessitated more frequent increases in the fees, especially through the 1970s. The basic fee for a registration, for example, was raised some eight times after 1966, the last time as from April 1, 1990. It is at present 720 Swiss francs for a single payment; in installments, the first payment is 470 Swiss francs, and the second 600 Swiss francs. A table tracing the evolution of the amounts of the basic fee for the registration of a single mark or, at a certain period, for the first mark of a multiple deposit, is shown below.

Changes in the International Application Fee for a Single Trademark

	Amounts in Swiss francs	Approximate Equivalents in US dollars
1893	100	19
1928	150	28
1966	200	46
1968	250	58
1970	300	69
1973	400	129
1975	480	192
1976	530	212
1977	580	241
1984	670	291
1990	720	514

The income from the above-mentioned basic fees has always been credited to the Madrid Union's account for use by the International Bureau in running international registration services under the Madrid Agreement. The income from these basic fees in the 1988-89 biennium amounted to 24,043,730 Swiss francs.

Complementary and Supplementary Fees. In contrast to the basic fee, income from the Union's two other major types of fees–complementary and supplementary fees–are not part of the International Bureau's budget, but are distributed to member States of the Union. It is worthwhile first to outline the origin and evolution of complementary and supplementary fees.

Both of them originated in the Nice revision of the Madrid Agreement (1957), which came into force in 1966. The complementary fee arose from Articles 3*bis* and 3*ter* of the Agreement, whereby a member State could specify a "territorial limitation," namely, that it would extend protection to an international registration only at the express request of the proprietor of the mark. Article 8(2)*(c)* of the Nice Agreement laid down a complementary fee of 25 Swiss francs per country, for any request by an applicant for "territorial extension" of protection to a country which had opted for the territorial limitation referred to above.

The supplementary fee arose from the introduction of the compulsory application of a new "International Classification of Goods and Services to which Trademarks are Applied," as established by the Nice Agreement. Applicants for international registration were now required to indicate the goods or services in respect of which protection of a mark was claimed, using the above-mentioned International Classification as far as possible.

Evolution of Complementary and Supplementary Fees

	Complementary Fees (in Swiss francs)	Approximate Equivalents in US dollars	Supplementary Fees (in Swiss francs)	Approximate Equivalents in US dollars
1966	25	5.80	25	5.80
1973	40	13	40	13
1975	48	19	48	19
1976	53	21	53	21
1977	58	24	58	24
1984	68	29	68	29
1989	80	50	68	42.50
1990	80	57	80	57

The supplementary fee was a surcharge of 25 Swiss francs for each class over and above three into which the goods or services to which a mark was to be applied would be placed.

Since their inception, for most of the time these fees have both been of an identical amount; they, too, rose most perceptibly in the 1970s. For example, in 1973 they were both at the unitary rate of 40 Swiss francs, in 1975 at 48 Swiss francs, in 1976 at 53 Swiss francs, in 1977 at 58 Swiss francs, and in 1984 at 68 Swiss francs. In 1989, the supplementary fee was 68 Swiss francs, and the complementary fee at 80 Swiss francs, but by April 1, 1990, the date of the last change, both types of fees were again set at the same amount of 80 Swiss francs. A table tracing the evolution of the amounts of complementary and supplementary fees is shown above.

The income from complementary and supplementary fees is not part of the International Bureau's income. It is set aside for distribution to member States. The basis for their distribution established at Nice was something new: it was determined by taking into account the number of applications for international protection originating in the member State during each year. This factor was additionally weighted in favor of countries practicing preliminary examination, by multiplying it with a coefficient, which was fixed at three in the 1966 Regulations. There followed differentiation between member States practicing prior examination in varying degrees, in the Regulations which came into force on October 1, 1970: for countries examining only absolute causes of nullity, the coefficient would be two, for countries also examining anticipation following opposition by third parties, it would be three, and for countries also examining anticipation *ex officio*, it would be four. From 1974, a coefficient of four was

also applied to countries carrying out anticipation searches *ex officio* with an indication of the most significant anticipations.

The complementary fees collected in 1990 amounted to 17,651,840 Swiss francs. The supplementary fees collected in 1990 amounted to 877,084 Swiss francs. The following table gives details of their distribution to member countries.

Distribution of Supplementary and Complementary Fees for 1990 (in Swiss francs)

(States in French Alphabetical Order)

	Supplementary Fees	Complementary Fees	Total
Algeria	8,236.48	168,022.24	176,258.72
Germany (Federal Republic of)*	48,578.65	897,819.99	946,398.64
German Democratic Republic*	49,418.83	1,366,469.74	1,415,888.57
Germany**	9,437.24	187,501.56	196,938.80
Austria	39,619.55	736,099.89	775,719.44
Benelux	91,138.48	1,673,868.13	1,765,006.61
Bulgaria	19,495.20	489,691.59	509,186.79
China	12,043.—	227,397.73	239,440.73
Cuba	6,389.21	120,626.01	127,015.22
Egypt	25,131.73	477,295.65	502,427.38
Spain	81,859.18	1,561,471.36	1,643,330.54
France	39,846.49	728,599.83	768,446.32
Hungary	48,367.34	1,063,967.21	1,112,334.55
Italy	42,687.75	790,110.76	832,798.51
Liechtenstein	11,454.07	211,538.22	222,992.29
Morocco	8,930.27	166,589.93	175,520.20
Monaco	19,434.87	362,971.78	382,406.65
Mongolia	8,193.40	152,917.94	161,111.34
Portugal	69,735.72	1,356,469.65	1,426,205.37
Democratic People's Republic of Korea	12,232.63	246,668.72	258,901.35
Romania	32,560.90	694,693.30	727,254.20
San Marino	5,310.47	100,026.88	105,337.35
Sudan	9,813.69	196,147.47	205,961.16
Switzerland	40,748.58	750,475.01	791,223.59
Czechoslovakia	46,724.03	1,024,696.05	1,071,420.08
Soviet Union	29,458.27	640,109.51	669,567.78
Viet Nam	11,255.86	243,231.20	254,487.06
Yugoslavia	48,982.11	1,016,362.65	1,065,344.76
	877,084.—	17,651,840.—	18,528,924.—

* Until October 2, 1990.
** As from October 3, 1990.

Other Fees. Various other fees have been a source of income for the Madrid Union. Amongst the first of them to be introduced, at the very beginning of this century, were fees for provision by the International Bureau of extracts from the International Register of Marks.

The Hague Act of the Madrid Agreement, which came into force in 1928, introduced new fees, most of which remain in their essence until today, particularly for changes made to existing entries in the International Register of Marks: these covered matters such as transfers, changes of name and domicile, correction of a depositor's mistakes, limitations of products after initial registration, or renunciations of protection after initial registration for one or more than one country.

The recent numerical and financial significance of these operations concerning the provision of extracts from the International Register, and the recording of changes in it, are apparent in the table given below.

Recordal of Changes in the International Register 1988-89

	Nos. in 1988	Nos. in 1989	Total 1988-89	Income (in Swiss francs)
Territorial extensions after first registration	2,490	2,069	4,559	
Transfers	4,713	5,669	10,382	
Partial assignment	196	190	386	
Cancellations (for all countries, products and services)	1,235	1,140	2,375	
Renunciations of protection for some countries	304	331	635	2,535,995
Limitations in the list of products and services	573	789	1,362	
Change of name and or address of owner	4,886	4,280	9,166	
Miscellaneous changes (e.g., regarding agent, corrections, etc.)	4,497	5,912	10,409	
Totals:	18,894	20,380	39,274	
Other Services				
Extracts from the International Register	5,648	5,727	11,375	630,936

Surcharges. The system of surcharges, first introduced in the Nice Act of the Madrid Agreement, also brings a certain income to the Madrid Union. At present, surcharges cover the use of a period of grace for late payment of second installments for initial registration and late payment of renewal of registrations (the surcharge is 50% of the sums first due), the requirement by the mark owner of a figurative element or word mark in a special form of writing, except for those published in color (the unitary surcharge is 60 Swiss francs), marks published in color (the unitary surcharge is 400 Swiss francs), and certain services provided by the International Bureau in the field of classification of goods and services: the latter services are called for when the International Bureau has to group an applicant's goods and services into classes in accordance with the International Classification in the case of the applicant's failure to do so (the unitary surcharge is 60 Swiss francs), there being an additional surcharge of 4 Swiss francs for each word printed over and above 20 in the publication of the classification in classes, and another surcharge of 4 Swiss francs per word in the case of the International Bureau having to correct more than 19 words of incorrect classification by the applicant. The amount

of income from these surcharges, for the 1988-89 biennium, was 1,055,728 Swiss francs.

Income from Publications. The remaining significant source of income (albeit a long way behind fees and charges) of the Madrid Union is from the Union's publications, and this very largely from the advertising within, and the sale of, *Les Marques internationales.* In the 1988-89 biennium, some 44,280 copies of *Les Marques internationales* were printed, and they brought to the Union an income of 883,652 Swiss francs in that same period. All the Union's publications in that biennium brought an income of 1,077,316 Swiss francs.

Establishment of Fees

Over 88% of the Madrid Union's budgetary income of 31,893,346 Swiss francs in the 1988-89 biennium came from the fees the International Bureau was empowered to charge, and this well reflects their financial significance throughout the history of the Madrid Union.

The major items of the Union's income, the fees and charges mentioned above, were at first fixed in the Diplomatic Conferences which established, then revised, the Madrid Agreement. This meant that fees could only be increased at the next revision of the Madrid Agreement, or alternatively between Diplomatic Conferences by the International Bureau's correspondence with all the member States, seeking their acceptance of any increases proposed.

The Nice Act for the first time modified that procedure, when it came into force in 1966. Article 10(4) of the Nice Act enabled the Director of the International Bureau to make proposals to an administrative organ of the Madrid Union, then the Committee of Directors of the National Industrial Property Offices of the Madrid Union; that Committee was empowered to approve the Director's proposals, and to confer on him, with the unanimous consent of the countries represented, the authority to raise fees and charges in both the Agreement and its Regulations.

The process of delegating the authority to modify fees was continued and improved in the Stockholm Act of the Madrid Agreement, which, moreover, differentiated, in the procedures established, between the major and other fees of the Madrid Union. In accordance with Article 12, the new administrative organ created by the Stockholm Act, the Assembly of the Madrid Union, was to fix the major fees related to international registration and renewal (registration fees, and supplementary and complementary fees, under Article 8) on the Director General's proposal, whilst other fees and charges were to be fixed by the Director General and reported to the Assembly.

It was the Nice revision that removed the need for a Diplomatic Conference, or alternatively for extraordinary correspondence procedures, in order to make changes in the Union's finances. The Committee of Directors of the National Industrial Property Offices of the Madrid Union, as established in the Nice Act, could be convened by the Director of the International Bureau or at the request of five member States, but in any case had to meet at least every five years.

The Assembly, as established at Stockholm, was initially required to hold its ordinary sessions every three years, but in 1979, the periodicity of the ordinary sessions of the administrative organs of the Madrid Union was established as every two years.

Expenditure of the Union

The Madrid Union's major single items of budgetary expenditure are staff costs and the printing costs of its publications. In the 1988-89 biennium, the staff costs were 14,476,150 Swiss francs, and the printing costs 2,845,301 Swiss francs. The other items of budgetary expenditure (for example, conferences, communications, expenditure on buildings and materials) in the same biennium came to 7,395,117 Swiss francs. The total budgetary expenditure for the last biennium was therefore 24,716,568 Swiss francs.

Surplus after Comparison of Income and Expenditure

Surpluses of income over expenditure are in part distributed to member States. The 1988-89 biennium showed a surplus of 7,176,778.07 Swiss francs. The percentage of the surplus for distribution to member States, which is at present fixed at 40% of it, came to 2,870,712 Swiss francs for the last biennium; this sum, halved, came to 1,435,356 Swiss francs for each of the years 1988 and 1989. The remaining 60% of the Union's surplus income was paid into the Union's Reserve Fund.

The Reserve Fund

The creation of reserves out of a part of the annual surplus of the Union's income was institutionalized in 1963; the interest earned by sums in the Reserve Fund was, and continues to be, credited to that Fund. Its purpose is to provide a general safeguard and guarantee for the continuing solvency of the Madrid Union. At the end of 1989, the Union's Reserve Fund stood at 21,345,148.53 Swiss francs. The resources of this Reserve Fund in turn contributed, by transfer of its funds, to the establishment of a Working Capital Fund.

THE WORKING CAPITAL FUND

The creation of this Fund was provided for in the Stockholm Act of the Madrid Agreement, and the Working Capital Fund was established in 1979. Its purpose is to provide greater day-to-day liquidity, to cover running expenses of the Madrid Union during the year for which funds are assured and expected but not immediately available. At the end of 1989, it stood at 2,000,000 Swiss francs.

THE ACCOUNTS OF THE MADRID UNION

Full financial statements, showing the accounts of the Madrid Union, have always been submitted to the Union's member States for information and approval. In the earlier history of the Union, since the International Bureau and the activities of its Unions were initially placed under the supervision of the "High Administration of the Swiss Confederation," the Swiss Administration had the responsibility for auditing the Madrid Union's accounts, and submitting its findings to member States. The International Bureau, from the very beginnings of the Registrations Service in 1893, prepared annual "Management Reports" covering the Madrid Union, under the supervision of the Swiss Administration, for presentation to the member States, and these reports reflected the results of the Swiss Government's auditing of the accounts.

When the World Intellectual Property Organization, established at the Stockholm Diplomatic Conference, came into being in 1970, initiating a new administrative structure, the Government of the Swiss Confederation continued to audit the Madrid Union's accounts, not automatically as before, but by designation of the appropriate Governing Bodies–the WIPO General Assembly and the Madrid Union Assembly, which now have vested in them the authority to appoint the auditors of the Union's accounts. Following WIPO's entry into the United Nations system in 1974, and the subsequent adoption of a biennial budgeting cycle in 1979, WIPO's Management Reports also became biennial, as from the 1982-83 biennium. Once the accounts of the Union are audited, they are reflected in the "Financial Management Report" and sent for information to the member States. The auditor's report is also sent to them and is presented to the Governing Bodies for their information and approval at their ordinary sessions.

THE MADRID UNION'S BUDGET

The budgeting procedures of the Madrid Union –that is to say, the process in which its finances are estimated and planned for in advance–are of more recent date. For many years, the Madrid Union functioned without forward planning, by simply spending its income as necessary, and as we have seen above, by accounting for income, expenditure and any remainder at the end of each year. The creation of a reserve (first established in 1951, and the forerunner of the Reserve Fund established in 1963) from surplus revenues, to meet ongoing needs and possible deficits, was the only financial safety mechanism in the period before budgetary planning.

The establishment of the World Intellectual Property Organization, at the Stockholm Diplomatic Conference, meant that the Madrid Union became one of the Unions administered by WIPO as from 1970, and was to plan its finances in the framework of a global triennial budget. Annual draft budgets were drawn up by the International Bureau and submitted to the WIPO Coordination Committee for approval, whilst the triennial budget of the Union was adopted by the Assembly of the Madrid Union in its corresponding triennial ordinary sessions. This budget cycle was reviewed and modified following the entry of WIPO (in 1974) into the United Nations system, within which medium-term planning and biennial budget cycles were generally practiced. In their third ordinary sessions in 1979, the Assembly and Committee of Directors of the Madrid Union approved the abolition of yearly programs and budgets within triennial cycles, substituting biennial programs and budget cycles; the periodicity of the ordinary sessions of the administrative organs of the Madrid Union therefore also became biennial.

The budgeting process now begins with the International Bureau's estimates and proposals for the coming biennium, taking into account a program of activities for the Madrid Union, and balancing these with the expected income and expenditure of the Union. Projections are made, considering factors such as the numbers of international registrations and renewals, and of actions related to them, and the expected level of inflation; naturally, increases in fees and other charges may be proposed in the light of these projections.

These estimates and proposals are submitted to a Budget Committee, early in the year of the ordinary session of the Governing Bodies. This Committee (a select body of representatives of Member States of WIPO, appointed by the WIPO General Assembly and the Assemblies of the appropriate Unions) adopts a report on the proposed program and budget, which, together with the observations of the Director General of WIPO, are put before the Governing Bodies later in the year, for their final decision and for their adoption of a final program and budget for the coming biennium.

"Les Marques internationales"

The Madrid Union's publication, *Les Marques internationales*, was a statutory obligation laid on the

International Bureau from the very beginning, in Article 3 of the Madrid Act of the Agreement, with details elaborated in the Regulations, and intended to be an integral part of the process of international registration.

Les Marques internationales has always been published only in French, the official language of the Madrid Union, and on a monthly basis. In 1891, it was decided that the forthcoming publication, *Les Marques internationales*, would be a supplement to the journal of the International Bureau–in this case, *La Propriété industrielle*–and was to contain either a reproduction or a written description of every internationally registered mark, together with indications of the date of international registration, the serial number of the mark, the name and address of the applicant, the goods to which the mark applied and the mark's country of origin, as well as its date of registration and its serial number in that country. The International Bureau was also to publish, at the beginning of each year, in respect of each member State and in alphabetical order, the names of the owners of the marks published during the preceding year.

From 1895 onwards, annual tables and the monthly issues also progressively came to show other data, such as transfers, cancellations, changes and corrections affecting marks, as well as tables by categories of products to which marks applied, using a kind of classification system not yet formalized. By 1912, limitations of products to which marks applied were also notified. Very important for future years were the statistical tables published in the January issue of 1907, concerning the registrations, refusals, transfers and cancellations of marks from the very beginning (1893) to the end of 1906; this set a trend which was never discontinued.

The Washington revision in 1911 took due account of the growing volume of the publication: for the first time, *Les Marques internationales* was not referred to in an Act of the Madrid Agreement as an appendage of another publication, but as a periodical journal in its own right. The Washington Act also reinforced the publicity value of *Les Marques internationales*, by stating that publication of international marks within its pages was sufficient in itself for the purposes of disseminating information, and that no other publicity measures could be required of the applicant.

The Diplomatic Conferences held in The Hague (1925) and London (1934), besides tightening up on the precision of the information on the international registrations contained in the periodical (which was to be taken from the international application and the applicant's printing block), began to address the question of free copies to member States: from the outset, in 1893, member States could obtain from the International Bureau, free of charge, as many copies of *Les Marques internationales* as they requested. This became expensive for the International Bureau as the volume of the publication grew steadily (200 pages for the full year of 1911, 679 pages for 1923, and 772 for 1930, as compared with 30 pages for the whole of 1893), and printing and distribution costs also increased.

In the Diplomatic Conference at Nice, in 1957, it was decided (Article 3(5) of the Nice Act) that the appropriate Administrations of member States would receive a number of copies free and at a reduced price, the precise number being in proportion to the number of units determining a country's financial contribution under Article 13(8) of the Paris Convention. In the Regulations applicable when the Nice Act came into force in 1966, this amounted to two free copies and two copies at half price in respect of each unit corresponding to the class of contributions selected in accordance with Article 13(8) of the Paris Convention. The Stockholm revision in 1967 confirmed this system. Monthly figures for 1990 show some 342 free copies, and some 1,258 partially or wholly paid for copies sent to some 44 countries, of which 15 were not member States and 29 were at that time member States. Some 1,820 copies a month were printed in 1990.

In its earliest days in the 1890s, as a supplement appended and in addition to *La Propriété industrielle*, the annual subscription was 5 Swiss francs within Switzerland, and 5.60 Swiss francs for other countries within the Universal Postal Union, whereas the annual subscription for *Les Marques internationales* alone was 3 Swiss francs and 3.60 Swiss francs, respectively; a single issue of *Les Marques internationales* cost 50 centimes.

The current prices are 410 Swiss francs for the annual edition, as well as for the annual edition on microfiches (instituted in 1982), 720 Swiss francs for the combined annual ordinary and microfiches editions, and 51 Swiss francs for a single issue of the ordinary edition.

From 1893 to the present day without interruption, and still progressing in content and volume, is an outstanding history for any publication. From barely three pages in the first issue in February 1893, it has come to 567 pages in the January issue of 1991; from 30 pages for the full year of 1893, the publication contained some 7,816 pages in the year 1990. From 1893 to the end of 1990, over 132,461 pages were printed in *Les Marques internationales*, and it is estimated that by the end of 1991, the total number of pages printed since the very beginning will exceed 140,000.

In the 97 years from 1893 to the end of 1990, there have been some 1,175 issues of *Les Marques internationales*. Those issues have given publicity to and basic information about 652,875 international registrations and renewals of marks, as well as about related actions which affected their status. On January 1, 1991, some 280,000 international registra-

tions and renewals were valid. These figures speak eloquently for the value of *Les Marques internationales.*

The Staff of the International Registration Service

From 1888 to 1892, the Paris Union for the Protection of Industrial Property (set up by the Paris Convention in 1883) and the Berne Union for the Protection of Literary and Artistic Works (set up by the Berne Convention in 1886) were grouped together in Berne, under the "high authority" of the Administration of the Swiss Confederation, to form the "Bureaux internationaux réunis pour la protection de la propriété intellectuelle"–translated as the United International Bureaux for the Protection of Intellectual Property. Interestingly enough, it was the creation of the Madrid Union which proved to be a catalyst in what was called the "definitive organization" of the International Bureau on January 1, 1893, which was also the date of the official beginning of the International Registration Service. At the time there was to be a total of seven staff members.

The "high authority" exercised by the Swiss Government in the administration of the International Bureau continued after the Organization's move to Geneva in 1960, and remained until 1970, when the new administrative structure established at the Stockholm Diplomatic Conference came into force. The total number of staff members in the Organization was 383 on April 1, 1991, of whom the Registration Service (marks only, excluding industrial designs) numbered 31.

A modern staffing structure was already discernible at the end of 1966. In that year, registration activities were first placed in a Registration Services Division concerned uniquely with those activities, under a Head, who supervised Sections dealing with the international registration of marks, as well as with the registration of industrial designs. A management structure of an overall head of Division, who had under him a head of the registrations service or services, has remained. The chart below indicates the persons holding those two positions since the 1960s.

The last important reorganization of the Division was in 1986. By then it was called the Trademark and Industrial Design Registries, with one overall Head. The two distinct sectors within it were the International Trademark Registry and the International Industrial Design Registry. The International Trademark Registry was subdivided into four units: Unit A, called Reception, Preliminary Examination, Secretariat; Unit B, called Data Entry, Control, Validation; Unit C, named Classification and Examination; and Unit D, named Notifications, Advice, Publications, Training, Information. The International Industrial Design Registry formed another Section.

That basic staffing structure of 1986 still remains today, and the marks sector remains a crucial part of an expanding World Intellectual Property Organization. The International Trademark Registry continues to widen its contacts and cooperation with other parts of the Organization. It is linked to the Director General and his Office via a Deputy Director General. A complete list of the staff currently working in the marks sector also appears below.

As we advance into the 1990s, the activities of the Madrid Union continue to reflect the national and international movements and changes that are taking place. The staff of today are the adaptable successors of staff who, since 1893, have provided a unique international service in the field of marks, and there is every sign that they will witness and contribute to the Madrid Union's increasing international importance and future potential.

Heads of the International Bureau and Their Terms of Office		*Division and Section Heads of the International Registration Service with their Nationalities*	
Henri Morel	(1893-1912)		
Robert Comtesse	(1912-1921)		
Ernest Röthlisberger	(1922-1926)		
Fritz Ostertag	(1926-1938)		
Bénigne Mentha	(1938-1953)		
Jacques Secretan	(1953-1963)		
George H.C. Bodenhausen	(1963-1973)	*Division Head:*	L. Egger (Switzerland)
		Section Heads:	E. Margot (Switzerland) R. Walther (Switzerland)
Arpad Bogsch	(1973-)	*Division Heads:*	L. Egger (Switzerland) P. Maugué (France) S. Di Palma (Italy)
		Section Heads:	R. Walther (Switzerland) C. Werkman (Netherlands) P. Maugué (France) I. Vedernikova (Soviet Union) E. Rezounenko (Soviet Union) R. Unterkircher (Austria) J.-P. Hoebreck (Belgium)

STAFF LIST AS OF APRIL 1, 1991

Name	*Title*	*Grade*	*Nationality*	*Sex*
	INTERNATIONAL TRADEMARK AND INDUSTRIAL DESIGN REGISTRIES			
Di Palma, Salvatore	Head	P5	IT	M
Unterkircher, Rudolf	Automation Officer	P3	AT	M
Spagnolo, Henri	Computer-assisted Publications Technician	G5	CH	M
Walt, Patrick	Digital Optical Disc Technician	G4	FR	M
Aziza, Myriam	Secretary I	G4	FR	F
Fort, Madeleine	Secretary I	G4	FR	F
Rosedel, Franciane	Secretary I	G4	FR	F
	INTERNATIONAL TRADEMARK REGISTRY			
Hoebreck, Jean-Paul	Head	P3	BE	M
	UNIT A — RECEPTION, PRELIMINARY EXAMINATION, SECRETARIAT			
Bernard, Christian	Clerk	G4	FR	M
Capelli, Michèle	Clerk	G4	FR	F
Guette, Marie-Thérèse	Clerk	G4	FR	F
	UNIT B — DATA ENTRY, CONTROL, VALIDATION			
Pierre, Marie-Caroline	Senior Data Entry Clerk	G5	FR	F
	UNIT C — CLASSIFICATION AND EXAMINATION			
Corvaro, Pietro	Senior Examiner	G7	CH	M
Stassin, Thérèse	Examiner-Classifier	G7	BE	F
Albanesi, Huguette	Examiner	G6	CH	F
Cartant, Patrick	Examiner	G6	FR	M
Heitz, Gisèle	Examiner	G6	FR	F
Ianna, Rita	Examiner	G6	FR	F
Maisonneuve, Jean-Luc	Examiner	G6	FR	M
Riond, Eliane	Examiner	G6	CH	F
Charron-Chiche, Anny	Examiner	G5	FR	F
Morel, Michel	Examiner	G5	FR	M
Schwab, Caroline	Examiner	G5	CH	F
Maschio, Daniela	Clerk	G4	FR	F
	UNIT D — NOTIFICATIONS, ADVICE, PUBLICATIONS, TRAINING, INFORMATION			
Berthelet, Maryvonne	Administrative Assistant	G6	CH	F
Moelijker, Geertje	Administrative Assistant	G6	NL	F
Baroni, Monique	Clerk	G5	FR	F
Belaich, Nicole	Clerk	G4	FR	F
Brousse, Catherine	Clerk	G4	FR	F
Jordan-Meille, Evelyne	Clerk	G4	FR	F
Kotalawala, Munidasa	Clerk	G4	LK	M

ARGENTINA

National Director of Industrial Property

We have been informed that Mr. Luis Ravizzini has been appointed National Director of Industrial Property.

DEMOCRATIC PEOPLE'S REPUBLIC OF KOREA

Director General, Invention Office

We have been informed that Mr. Ryu Song Kwang has been appointed Director General of the Invention Office.

Calendar of Meetings

WIPO Meetings

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

1991

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.

Other Meetings Concerned with Industrial Property

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