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Monthly Review of the
World Intellectual Property Organization (WIPO)

Contents

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International Unions

Nice Agreement (Classification/Marks)

Ratification of the Geneva Act (1977)

NORWAY

The Government of Norway deposited on April 6, 1981, its instrument of ratification of the Geneva Act of May 13, 1977, of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957, as revised at Stockholm on July 14, 1967.

The Geneva Act (1977) of the said Agreement will enter into force, with respect to Norway, on July 7, 1981.

Nice Notification No. 50, of April 7, 1981.

Patent Cooperation Treaty (PCT)

Withdrawal by France of its Declaration Concerning Chapter II

The Government of France, by notification addressed to the Director General of WIPO and received on March 12, 1981, withdrew the declaration contained in its instrument of ratification of the Patent Cooperation Treaty (PCT) done at Washington on June 19, 1970, to the effect that France is not bound by the provisions of Chapter II of the said Treaty (see PCT Notification No. 15, of December 1, 1977, published in *Industrial Property*, 1978, p. 18).

The withdrawal of the said declaration will take effect on June 12, 1981.

PCT Notification No. 35, of March 19, 1981.

Activities of Other Organizations

International Association for the Protection of Industrial Property

XXXIst Congress

(Buenos Aires, November 16 to 22, 1980)

Introduction

The International Association for the Protection of Industrial Property (IAPIP) held its XXXIst Congress in Buenos Aires (Argentina) from November 16 to 22, 1980. Mr. Federico J.L. Zorraquin acted as President of the Congress, which was opened by the Minister for Justice of Argentina, Mr. Alberto Rodríguez Varela. The work of the Congress was followed by almost 900 delegates. Nineteen governments, as well as several intergovernmental organizations and international non-governmental organizations, sent representatives.

The World Intellectual Property Organization (WIPO) was represented by its Director General, Dr. A. Bogsch, and by Dr. K. Pfanner, Deputy Director General.

At the Opening Ceremony the Director General of WIPO delivered an address, which is reproduced below.

The Congress dealt in plenary sessions with the following questions: the protection of collective and certification marks; the value of industrial property for technical development and economic progress in developing countries, both in the field of patents and in the field of trademarks; the revision of the Paris Convention for the Protection of Industrial Property; the interpretation of patent claims; and the reorganization of IAPIP. Several workshops were organized which

dealt with licensing in Latin America, parallel imports, assessment of damages for patent infringements, employees' inventions, and prior disclosure and prior use of the invention by the inventor. In addition, the Executive Committee of IAPIP and the Council of Presidents of IAPIP held several sessions.

The work of the Congress culminated with the ratification, by the Executive Committee of IAPIP, of a certain number of resolutions which are also reproduced below.

Address by the Director General of WIPO

Excellencies, Ladies and Gentlemen,

The World Intellectual Property Organization is pleased to be present at the XXXIst Congress of the International Association for the Protection of Industrial Property, and I am honored hy the opportunity given to me to speak on behalf of the World Intellectual Property Organization at this opening ceremony.

The World Intellectual Property Organization and IAPIP have many common concerns and these common concerns are based on the same wish. Both our Organization and your Association wish that industrial property be respected. And both our Organization and your Association work for the fulfillment of this wish on a glohal level.

What do the last two and a half years, that is, the period which has elapsed since I addressed your last Congress in Munich in May 1978, show in respect of this common goal of ours, this goal of maintaining and improving international relations?

During these two and a half years, the Patent Cooperation Treaty, concluded in Washington in 1970, has become operational, and the Trademark Registration Treaty, concluded in Vienna in 1973, has entered into force. During the same period, the Budapest Treaty of 1977 on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure entered into force, too.

The Patent Cooperation Treaty, PCT, is now hinding upon 30 States. The number of patents granted each year in those 30 States represents approximately 58% of all the patents granted each year in all the States of the world. These statistics show that the potential for the use of the PCT is already very great. If a few more States accede, particularly if Belgium, Canada and Italy accede—which I ardently hope—such potential will considerably further increase. The number of cases in which the PCT is actually used is, however, still small compared to the number of cases in which the PCT could be used. The present rate of filing is approximately 3,600 international applications per year, corresponding to some 25,000 national or regional applications since the average number of designations per international application is approximately seven. But growth in numbers is constant and, as the hesitation to try anything that is new will gradually he replaced by confidence, the numbers should become much higher. The World Intellectual Property Organization will continue to do its best to familiarize patent attorneys and agents, whether exercising their profession independently or doing so as permanent counsels of industrial firms, with the use and usefulness of the PCT.

The TRT and the Budapest Treaty entered into force only three months ago. More countries will have to accede to them and more time will have to elapse before these two Treaties can be of real usefulness in practice. But they are on the way to becoming additional instruments that will facilitate protection of industrial property on a worldwide level.

I am deeply convinced that, in the field of patents, the PCT and the Budapest Treaty, and, in the field of trademarks, the Madrid Agreement and the TRT, will, in a decade or so, prove to be indispensable. The number of independent States each having their own national procedures for granting patents and registering trademarks is now so high—approaching 150—that applying separately for protection in each, in time, is a practical impossihility because of the high cost, the variety of provisions to be observed, the variety of the languages to be used and the variety of currencies in which the fees have to be paid. Before this century is over, it will generally be recognized that international protection of industrial property would have hroken down in practice had these four treaties not come to the rescue of such protection.

I am, however, not satisfied that all has been done that is needed for making the obtaining of worldwide protection for one's inventions and trademarks a practical reality. We have created the institutional framework, thanks to the four treaties I have just mentioned. But a lot of non-treaty work has yet to be done. I shall mention only one such non-treaty project since I consider it particularly important. It concerns the examination of patent applications.

It is a worldwide phenomenon that practically no country wishes anymore to have a so-called registration system for patents. It is no use telling governments that even very highly industrialized countries have a registration system. The general desire is to have a system in which patent applications are suhjected to an examination as to worldwide novelty and the other recognized criteria of patentahility. But such a system, as you all know, in order not to exist only on paper—as it does in some countries—requires tremendous documentation and a large and specialized staff. Most countries just cannot afford either. So, what is the solution? For international applications, there is the PCT. But for others, particularly for applications originating in, and limited to, a given country, what is the solution? I think that the solution lies in international assistance and cooperation in search and examination. I hope that the next years will, with your advice, see developments in the direction of such assistance and cooperation.

So far, I have spoken ahout international cooperation on a worldwide basis. Let me now say a few words ahout an event concerning regional cooperation, an event which occurred since your last Congress and which concerns Latin America.

The event is the conclusion of a cooperation agreement between the World Intellectual Property Organization and the Board of the Cartagena Agreement. The said cooperation agreement was signed just a year ago in November 1979. Essentially, it provides for technical cooperation between the World Intellectual Property Organization and the five countries of the Andean Group, namely, Bolivia, Colombia, Ecuador, Peru and Venezuela. The first objective of such technical cooperation is the modernization of the patent and trademark offices of the five countries.

The importance of this cooperation agreement lies in the fact that it concerns five countries, five very important countries of Latin America for which official international cooperation, outside the Andean region itself, in the field of industrial property, was almost nonexistent. None of the five countries belongs to the Paris Union, but the process of their gradual interest in international relations in our field has started. Colombia and Peru have become members of WIPO a few months ago. All five of them participate in our Latin American Data Service in the fields of patents and trademarks. More and more delegations, coming from several of these countries, participate in our meetings. Consequently, it is to be hoped that ties between the five countries of the Andean Group and the rest of the world will gradually be strengthened in the field of industrial property.

The next and last topic I shall say a few words about is the revision of the Paris Convention for the Protection of Industrial Property.

This question is of paramount importance for the future of the protection, on the international level, of industrial property.

Your Association has been very active in the preparation of the revision that is going on now, and the matter is the subject of at least two most interesting and penetrating documents that your *Rapporteur général*, Paul Mathély, has prepared for this Congress.

In my view, no discussion should lose sight of what is at stake.

What is at stake is the worldwide protection of industrial property.

I put emphasis, in this statement, on the word "worldwide." In other words, on the protection of industrial property between the developed capitalist countries and the developed Socialist countries and between the developed countries and the so-called developing countries. I say "so-called" since several of them—Argentina is one of them—are, industrially, as highly developed as most of the so-called developed countries and, for such developing countries, international industrial property relations are particularly important.

So, as I have just said, the stake is the worldwide protection of industrial property. At stake is that the developing countries remain party, and those which are not yet party, become party—to the Paris Convention.

As you can see, the objective is important and its achievement is worth some concessions which, if the Paris Convention were destined only for the so-called industrialized countries, would prohahly not be necessary.

But the revision, as proposed, would not only mean concessions by the industrialized countries but would also represent a real advance in the direction of a better and stronger international legal protection, which is of advantage also to the highly industrialized countries with important interests to be protected abroad.

This is true at least in two fields.

One is the field of geographical denominations used as trademarks.

The other one is the proposal, contained in the basic proposals that the Diplomatic Conference on the Revision of the Paris Convention will examine next year, to define what a patent is and to state *expressis verbis* the obligation that inventions must be protected by patents or also hy patents. Such an obligation seemed to be so natural up to the 1960s that nobody thought that it was necessary to mention it in the Paris Convention. But the appearance of inventors' certificates on the international scene made the said obligation less self-evident. Other new kinds of titles—for example, the Mexican invention certificate and the *Wirtschaftspatent* of the German Democratic Republic—also point to the necessity of a clear statement in the text of the Paris Convention itself on what a patent is and that true patents must be available in every contracting State, at least for foreigners.

As I said, all this used to be self-evident. However, now there is reason to believe that all this is no longer self-evident and even more reason to believe that the said so-called self-evident ohligation will be put into more and more douht in the future.

This is why I strongly recommend that the revised text of the Paris Convention expressly state what a patent is and that it expressly state that patents must be availahle for the protection of inventions.

The insertion of such provisions would, in themselves, justify a revision of the Paris Convention and should be a goal for those favoring an unambiguous future for the protection of inventions in foreign countries.

Your Excellencies, Ladies and Gentlemen,

Although we are now in the ceremony which formally opens this Congress, several of the subsidiary bodies of the Congress have already started their work and have been meeting for several days. And some participants arrived today or in the last few days in Buenos Aires and have had contact with the Argentinian organizers of the Congress. It is, therefore, not too early to say, even at this stage of the Congress, that our Argentinian hosts have already proven their capacity for solving, hrilliantly solving, the many problems that the organization of such a large international meeting poses. Nor is it too early to say that our Argentinian hosts are, in every respect, as hospitable and generous as they are reputed to be.

May I therefore express, also in the name of the other guests, my admiration—our admiration—to our Argentinian hosts and in particular to Jorge O'Farrell,

President of the Argentinian Group, and his wife, Gloria O'Farrell. We admire and respect them and all the other Argentinians who have helped to organize this Congress for what they have done and what they are doing, since they ensure the full success of this Congress. The courtesy, warmth and elegance of their hospitality will be long remembered hy all of us.

Resolutions Adopted

QUESTION 45

Valne of Industrial Property for Technical Development and Economic Progress in Developing Conntries

The Role of Trademarks, Trade Names and Geographical Indications

I. *Bearing in mind,* that the question of the significance of trademark protection in developing countries has been recognized with increasing attention hy these countries and the different international organizations, and

in view of the existing tendencies in certain countries to alter the traditional principles of trademark protection,

the IAPIP,

after a first examination of the question *affirms* the following principles:

1. Trademark protection is of great economic importance not only for industrialized countries but also for developing countries. By insuring protection to its proprietor, the trademark insures at the same time fair trade and the protection of consumers.

2. The interest of the consumer requires that the trademark:

(a) identifies the commercial origin of the products and services in an unequivocal manner;

(b) and consequently guarantees to the consumer a constant quality of goods and services;

(c) protects the consumer against any imitation which is susceptible to deceive him.

3. Trademark protection has an equally economic importance for international trade. The trademark is especially for developing countries an indispensable instrument for introducing national products into the world market and thereby creating new outlets.

4. Furthermore, the trademark may he of assistance in the transfer of technology and commercial know-how to developing countries. For instance, the licensor is obliged to transfer on a permanent basis to the trademark licensee his technical experience and know-how in order to assure that the trademark is only used for products and services having the required quality.

II. The IAPIP

decides to further study the question as to the role of trademarks as well as of commercial designations and geographical indications.

The Role of Patents and Know-How in the Transfer of Technology and in Stimulating Indigenous Technology

The IAPIP

1. *takes note* of the various plans to regulate the transfer of technology from developed to developing countries which have been presented by a number of organizations of the United Nations and hy several nations, and

resolves to carry out thorough studies of these plans;

2. in applying its resolution on the erosion of the patent system, *decides* to devise an appropriate strategy to counterhalance any measures within such plans which directly or indirectly would erode the patent system as such;

3. *favours* also the adoption by developing countries of systems of protection of industrial property which encourage the transfer of technology.

QUESTION 60

Interpretation of Patent Claims

The IAPIP considers that:

1. The scope of protection provided by a patent for an invention is determined hy the claims. However, the description and the drawings serve to interpret the claims.

2. The interpretation of the claims comprises:

- understanding the invention;
- understanding the wording of the claims and, if necessary, defining the technical meaning of the terms employed and clarifying any amhiguities;
- understanding the claims which, if necessary, shall be interpreted in the light of the general knowledge of the man skilled in the art at the date to which the claims are entitled and of the examination file of the patent, if any.

3. The claims so interpreted shall serve as the basis for consideration equally of infringement and validity.

4. The claims so interpreted shall protect the patentee against any use of the invention provided that the

claimed essential features of the invention have been taken either by way of identical means or hy way of substitute means. The essential features of tbe invention are those which are sufficient and necessary for realization of the invention.

Substitute means for a feature or a combination of features in a claim shall be taken to include that which functions with respect to the invention as claimed in substantially the same manner and produces substantially the same results, provided that no statement hy the applicant in tbe specification or the examination file of the patent, if any, excludes the substitute means from protection.

5. Subject to the stipulations of paragrapb 4 above:

— a claim to a combination shall not provide independent protection for separate features of the combination, and
— a claim expressly referring to another claim shall not provide protection for the features it contains independently of the features of the claim to which it refers.
However, this does not prevent the application of the doctrines of imperfect use, of indirect or contrihutory infringement, or of active inducement of infringement.

6. The use of a protected invention together with an additional feature shall come within the scope of the claims provided that the additional feature does not suhstantially change the form and function of the claimed essential features of the invention.

QUESTION 67

Revision of the Paris Convention

I. On Article 5A

1. *Obligation to Work Patents ((1) (a))*

The IAPIP

recognizes the right of States to impose through national law the ohligation to work patented inventions. The IAPIP, however, emphasizes tbat sucb ohligations must not come into being until the grant of the patent.

2. *Compulsory Licenses (6)*

The IAPIP

re-affirms its resolution adopted in Montreux in 1976, Munich in 1978 and Toronto in 1979 that a compulsory license should never be exclusive in nature.

3. *Sanctions under Article 5A*

Tbe IAPIP

urges that the text of Article 5A make it clear that the sanctions provided therein are applicable only to cases of simple failure to work or insufficient working. The IAPIP affirms that failure to work or insufficient working is not of itself abuse of the patent right.

4. *Special Provisions for Developing Countries ((8) (a) & (b))*

The IAPIP

re-affirms the Resolution adopted in Toronto in 1979.

The IAPIP favours further study of the sanction of temporary suspension of the patent right (French proposal), but suhject to the condition of the expiration of a period of time after the grant of the first compulsory license.

5. The IAPIP

believes that consideration sbould be given to the introduction into the Paris Convention of provisions specifically designed to benefit developing countries, provided that such provisions entail no weakening of the basic principles of the Paris Convention. The IAPIP favours continuing study of constructive proposals for such provisions.

II. On Inventors' Certificates

Tbe IAPIP

re-affirms its Resolution of Toronto in 1979.

QUESTION 72

Protection of Collective and Certification Marks

The IAPIP

approves tbe general lines of the Summary Report and the Report presented hy its Committee to the Congress of Buenos Aires;

takes account of the ohservations made in the dehate; and

refers the question back to the Executive Committee for adopting, in its definitive form, a doctrine of the IAPIP on the estahlishment of a system for the protection of collective and certification marks.

QUESTION 75

Prior Disclosure and Prior Use of the Invention by the Inventor

The IAPIP

1. *(a) is concerned* that an inventor may publicly disclose his invention before filing a patent application, thereby depriving himself of the ability to ohtain valid patent protection;

(b) recognizes that Article 11 of the Paris Convention provides very limited protection for a disclosure made by an inventor at certain international exhibitions;

(c) considers that it is in the public interest that the inventor should be given greater protection from the consequence of a prior disclosure by himself; and

(d) therefore *considers* it desirable that where a public disclosure of an invention originates from an inventor, such public disclosure shall not be taken into consideration in assessing the patentability of the invention, if the first patent application is filed by the inventor or his successor within a certain period beginning from the disclosure;

and *declares in favour* of the principle of introducing such a period of grace under terms and conditions to be determined;

2. *refers the question back* to the Executive Committee for further consideration.

General Studies

Completion of the Patent Law Reform in the Federal Republic of Germany

A. SCHÄFERS* and U.C. HALLMANN**

News Items

IRAQ

President, Central Organization for Standardization and Quality Control

We have been informed that Dr. M.H. Hnoosh has been appointed President of the Central Organization for Standardization and Quality Control.

Calendar

WIPO Meetings

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

1981

June 15 to 26 (Geneva) — Permanent Committee for Patent Information (PCPI) — Working Group on Search Information

June 29 to July 1 (Bogotá) — Committee of Experts on Means of Implementation of Model Provisions for National Laws on Intellectual Property Aspects of the Protection of Expressions of Folklore in the Latin-American and Caribbean States (convened jointly with Unesco)

June 29 to July 3 (Geneva) — International Patent Cooperation (PCT) Union — Assembly (Extraordinary Session)

September 7 to 10 (Geneva) — Permanent Committee for Patent Information (PCPI) — Working Group on Patent Information for Developing Countries

September 10 to 18 (Geneva) — Permanent Committee for Patent Information (PCPI) — Working Group on Planning

September 24 and 25 (Nairobi) — Treaty on the Protection of the Olympic Symbol — Diplomatic Conference

September 28 to October 24 (Nairobi) — Revision of the Paris Convention — Diplomatic Conference

October 19 to 23 (Kingston) — Regional Seminar on Copyright for English-Speaking Caribbean States (convened jointly with Unesco)

November 9 to 13 (Geneva) — Permanent Committee for Patent Information (PCPI) and PCT Committee for Technical Cooperation

November 11 to 13 (Geneva) — Rome Convention — Intergovernmental Committee (convened jointly with ILO and Unesco)

November 16 to 24 (Geneva) — Governing Bodies (WIPO General Assembly, Conference and Coordination Committee, Assemblies of the Paris, Madrid, Hague, Nice, Lisbon, Locarno, IPC, PCT, TRT, Budapest and Berne Unions; Conferences of Representatives of the Paris, Hague, Nice and Berne Unions; Executive Committees of the Paris and Berne Unions; Committee of Directors of the Madrid Union; Council of the Lisbon Union)

November 26 to 28 (New Delhi)—Regional Seminar on Copyright for Asian and Pacific States (convened jointly with Unesco)

November 30 to December 7 (New Delhi) — Berne Union — Executive Committee — Extraordinary Session (sitting together, for the discussion of certain items, with the Intergovernmental Committee of the Universal Copyright Convention)

December 7 to 11 (Geneva) — International Patent Classification (IPC) — Committee of Experts

UPOV Meetings

1981

June 23 to 25 (Edinburgh) — Technical Working Party for Agricultural Crops

September 8 to 10 (Wädenswil) — Technical Working Party for Vegetables

September 22 to 25 (Wageningen) — Technical Working Party for Fruit Crops

October 6 to 8 (Antibes) — Technical Working Party for Ornamental Plants

October 12 to 14 (Geneva) — Administrative and Legal Committee

October 14 to 16 (Geneva) — Technical Committee

November 9 (Geneva) — Consultative Committee

November 10 (Geneva) — 1981 Symposium

November 10 to 12 (Geneva) — Council

Meetings of Other International Organizations Concerned with Industrial Property

1981

European Communities: September 7 (Brussels) — Community Patent Interim Committee

European Patent Organisation: June 1 to 5, November 30 to December 4 (Munich) — Administrative Council

Inter-American Association of Industrial Property: October 18 to 21 (Acapulco) — Congress

International Federation of Patent Agents: October 5 to 9 (Edinburgh) — Congress

International League Against Unfair Competition: June 1 to 3 (Amsterdam) — Working Session *(Journées d'Etudes)*