

# Industrial Property

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## Notifications

### WIPO Convention

#### Ratification

#### ICELAND

The Government of Iceland deposited, on June 13, 1986, its instrument of ratification of the Convention Establishing the World Intellectual Property Organization, signed at Stockholm on July 14, 1967.

The said Convention will enter into force, with respect to Iceland, on September 13, 1986.

WIPO Notification No. 135, of June 13, 1986.

### Budapest Treaty

#### Change in Fees under Rule 12.2 of the Regulations under the Budapest Treaty

#### AMERICAN TYPE CULTURE COLLECTION (ATCC)

The following notification addressed to the Director General of WIPO by the Government of the United States of America under Rule 12.2(a) of the Regulations under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure was received on June 24, 1986, and is published by the International Bureau of WIPO pursuant to Rule 12.2(b) of the said Regulations:

The Fee Schedule of the American Type Culture Collection (ATCC) as published in the May 1985 issue of *Industrial Property* is changed as follows in respect of the fees for the furnishing of samples under Rules 11.2 and 11.3 of the said Regulations:

#### *ATCC Cultures (per sample)*

Algae, animal and plant viruses, bacteria, bacteriophages, fungi, plant tissue cultures, plasmids, protozoa, seeds (25 per sample) and yeasts, (except Preceptrol cultures)

– United States non-profit institutions . . . . .	US\$ 0.00
– Foreign non-profit institutions . . . . .	0.00*
– Other United States and foreign institutions . . . . .	4.00

#### *ATCC Preceptrol Cultures*

– All United States and foreign institutions . . . . .	2.00
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#### *ATCC Oncogenes*

– United States non-profit institutions . . . . .	5.00
– Foreign non-profit institutions . . . . .	5.00**
– Other United States and foreign institutions . . . . .	2.00

#### *ATCC Cell Lines*

CCL 1, CCL 10, CCL 23, CCL 34, CCL 61, CCL 75, CCL 81, CCL 92, CCL 163, CCL 171, CCL 240, CRL 1580, CRL 1593, all TIB cells, all HTB cells, HB 1 to HB 7999

– United States non-profit institutions . . . . .	0.00
– Foreign non-profit institutions . . . . .	0.00
– Other United States and foreign institutions . . . . .	4.00

#### *All Other Cell lines*

– United States non-profit institutions . . . . .	5.00
– Foreign non-profit institutions . . . . .	5.00**
– Other United States and foreign institutions . . . . .	2.00

Cell lines ordered in flasks, protozoa ordered in test tubes, and other deposits specially ordered in test tubes carry an additional fee of US \$35.00.

The minimum invoice is US \$45.00. Orders received for lesser amounts will be invoiced at the minimum.

\* Subject to an additional US \$24.00 per culture handling and processing charge.

\*\* Subject to an additional US \$27.00 per culture handling and processing charge.

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

The fees set forth in the said notification of the Government of the United States of America will apply as from the thirtieth day following the date (August 31, 1986) of the publication of the said fees in the present issue of *Industrial Property*, that is, as from September 30, 1986 (see Rule 12.2(c) of the Regulations of the

Budapest Treaty), and will replace the fees published in the May 1985 issue of *Industrial Property*.

Budapest Communication No. 28 (this Communication is the subject of Budapest Notification No. 52, of July 16, 1986).

## WIPO Meetings

### WIPO Permanent Program for Development Cooperation Related to Industrial Property

#### Permanent Committee

Tenth Session  
(Geneva, April 8 to 11, 1986)

#### NOTE\*

The WIPO Permanent Committee for Development Cooperation Related to Industrial Property (hereinafter referred to as "the Permanent Committee") held its tenth session in Geneva from April 8 to 11, 1986.<sup>1</sup> Sixty-seven member States of the Permanent Committee, eight non-member States, five intergovernmental organizations and three international non-governmental organizations were represented. The list of participants follows this Note.

The Permanent Committee has the task of reviewing the WIPO Permanent Program for Development Cooperation Related to Industrial Property. The objectives of that Program are:

- (i) to promote inventive and innovative activity in developing countries with a view to strengthening their technological capacity;
- (ii) to facilitate the acquisition by developing countries, under fair and reasonable terms and conditions, of technology related to industrial property;
- (iii) to promote the development of legislation and institutions in the field of industrial property in developing countries.

The Permanent Committee is therefore the forum where member States—both developing and industrialized countries—meet in order to discuss WIPO programs and plans of particular interest to developing countries in the field of industrial property, and to evaluate what has been and is being done in that area. It submits recommendations to the competent governing bodies of WIPO.

The tenth session was opened by Dr. Arpad Bogsch, Director General of WIPO, who welcomed the eight States (Angola, Bangladesh, Central African Republic, China, Cyprus, Gambia, Nicaragua, Venezuela) that had become members of the Permanent Committee in

the period between the preceding session and the present session, bringing the number of member States of the Permanent Committee to 92.<sup>2</sup>

The Director General further emphasized that the Permanent Committee is the main WIPO organ within which an in-depth discussion can be held on the development cooperation activities of WIPO in the field of industrial property. The WIPO program is approved by the Governing Bodies of WIPO, but those bodies do not have sufficient time available to enter into detail with respect to development cooperation activities. It is for that reason that the Permanent Committee was set up. The Permanent Committee enables the wishes and the views of its member States, both developing countries and industrialized countries, to be heard, particularly as regards the direction to be taken by the development cooperation activities.

The Permanent Committee reviewed activities carried out since its last session under the WIPO Permanent Program for Development Cooperation Related to Industrial Property, as well as plans for future activities.

Due account being taken of the comments and suggestions made by several delegations, the Permanent Committee expressed its satisfaction with the implementation of the Permanent Program by the International Bureau. Numerous delegations emphasized the capital role of cooperation under the Permanent Program in the setting-up or modernization of the industrial property structures of their countries. In particular, the Delegations of Libya, Nigeria and Syria stated that their countries were envisaging a complete recast of their industrial property systems and were relying on receiving advice from the International Bureau. The Delegation of Bolivia, in referring to the assistance received by its country under the Permanent Program, announced that its country intended to accede to certain conventions administered by WIPO.

<sup>2</sup> Algeria, Angola, Argentina, Australia, Austria, Bangladesh, Barbados, Benin, Brazil, Bulgaria, Burkina Faso, Cameroon, Canada, Central African Republic, Chile, China, Colombia, Congo, Costa Rica, Côte d'Ivoire, Cuba, Cyprus, Czechoslovakia, Democratic People's Republic of Korea, Denmark, Egypt, El Salvador, Finland, France, Gabon, Gambia, German Democratic Republic, Germany (Federal Republic of), Ghana, Greece, Guatemala, Guinea, Honduras, Hungary, India, Indonesia, Iraq, Israel, Italy, Japan, Jordan, Kenya, Libya, Malawi, Mauritania, Mauritius, Mexico, Mongolia, Morocco, Netherlands, New Zealand, Nicaragua, Niger, Norway, Pakistan, Panama, Peru, Philippines, Poland, Portugal, Republic of Korea, Romania, Rwanda, Senegal, Somalia, Soviet Union, Spain, Sri Lanka, Sudan, Suriname, Sweden, Switzerland, Togo, Tunisia, Turkey, Uganda, United Arab Emirates, United Kingdom, United Republic of Tanzania, United States of America, Uruguay, Venezuela, Viet Nam, Yemen, Yugoslavia, Zaire, Zambia.

\* Prepared by the International Bureau.

<sup>1</sup> For a note on the preceding session, see *Industrial Property*, 1984, p. 410.

Certain delegations stressed that the industrial property system could not be conceived solely as a system for granting or recording industrial property rights, but that it was mostly a tool to serve the economic development of developing countries in the technical, industrial and commercial fields. Consequently, the Permanent Program should endeavor to contribute to the development of the dynamic aspects of the industrial property system in the developing countries, such as access to technical information, promotion of inventive activity and exploitation of research findings, and licensing with the aim of facilitating the acquisition, by developing countries, of suitable technology and of strengthening their ability to negotiate industrial property licenses. That concept of the part to be played by the industrial property system should also result in greater attention being paid to the production sector and to the establishment of links between the governmental institutions concerned and that sector. A number of delegations also expressed the view that another priority area for development cooperation activities concerned the need to improve the understanding of the complex matters involved in the legal protection of advanced technologies, such as biotechnology, integrated circuits and computer software. Those delegations also said that programs and activities designed in this respect should not be mere corollaries of initiatives taken by developed countries, but should respond to a need for developing countries to examine the implications that the legal protection of advanced technologies might have on their economic development. In this context, they stated that initiatives in respect of these new fields of technology that might be envisaged within WIPO should be pursued taking fully into account that legitimate concern of developing countries.

The Permanent Committee considered that the training activities and those concerned with improved awareness of industrial property and its role remained one of the major priorities of the Permanent Program and that they should aim not only at the establishment or strengthening of institutions related to industrial property (including institutions concerned with the promotion of inventive activities and the dissemination of technical information, institutions concerned with teaching industrial property (universities) and judicial institutions), but also at the effective utilization of industrial property in the developing countries, by all sectors concerned, as a tool for technological development. In approving the orientation of the WIPO training program, numerous delegations stressed the advantages derived from the systematic organization of training courses at the regional and subregional levels and supported the diversification of the training activities, both as regards greater specialization of the training program and its extension to new groups of trainees. In the latter case, strong accent was placed on the training of the judiciary and of university professors, on the training of trainers and on training in the field of

licensing, as well as on patent information and documentation. The need for long-term training programs was also stressed and a number of delegations specifically supported the initiatives taken by the International Bureau to second university professors to provide advice to universities in developing countries.

Numerous delegations reiterated the importance that they attached to development cooperation activities in the field of patent information and documentation as an instrument of access to technological information. A number of delegations mentioned that WIPO activities in that area should, in particular, improve access to patent information by the production sector, and also its exploitation by that sector (through the creation of appropriate institutions and machinery and the training of providers and users of patent information). It was suggested in that respect that WIPO should study possible ways of promoting the use of patent documentation by non-specialized users and should endeavor to obtain preferential conditions for developing countries from major patent information distributors. Certain delegations suggested that, in order to allow the Permanent Committee on Patent Information (PCPI) to carry out its work more effectively, the Permanent Committee for Development Cooperation Related to Industrial Property should identify what were the areas of interest for developing countries in the field of patent information and documentation so as to enable the Working Group on Patent Information for Developing Countries of the PCPI to examine possible solutions in respect of the subjects so identified.

As regards activities for the promotion of inventive and innovative activity in developing countries, the Permanent Committee noted with satisfaction progress reports submitted by the International Bureau on a study on the patent management and licensing operations of research and development institutions in developing countries, and on a study on possible arrangements for the promotion of technological innovation in developing countries, and invited the International Bureau to pursue those studies.

The Permanent Committee agreed that cooperation among developing countries was an important element—some delegations said it was an essential component—in the development cooperation activities of WIPO and would continue to be so. The Permanent Committee expressed its satisfaction with the International Bureau's activities in support of cooperation among developing countries, and recommended that the International Bureau pursue its efforts to increase the use of experts and institutions from developing countries and of the mechanisms of regional cooperation. Apprised by the current Chairman of the Council of the African Regional Industrial Property Organization (ARIPO) of the delicate financial situation that ARIPO was going through due to the economic crisis that was affecting African countries, the Permanent Committee invited the International Bureau to explore all possibilities of mobilizing the necessary funds to deal

with the financial situation of ARIPO, including the possibility of convening a meeting of countries and institutions that might be interested, and able to contribute to the solution to the problem.

Due account being taken of comments and suggestions made by several delegations, the Permanent Committee also noted with satisfaction the plans for future activities under the Permanent Program. In that connection, numerous delegations stressed the importance they attached to the plans of action that had resulted from the cycle of regional planning meetings organized by WIPO in Pattaya (June 1984) for the countries of Asia and the Pacific, Bogota (August 1984) for the countries of Latin America and the Caribbean, Geneva (May 1985) for the Arab countries and Lomé (July-August 1985) for the countries of Africa, as references for implementing and assessing the activities undertaken within the framework of the Permanent Program, and expressed the wish that the necessary funding might be found, particularly under the regional programs of UNDP, to finance the Geneva and Lomé plans of action and to continue the implementation of the ongoing regional projects in the regions of Asia and the Pacific and of Latin America and the Caribbean during the fourth UNDP programming cycle (1987-1991). Numerous delegations further stressed that the International Bureau should continue to enhance the utilization of the regional and subregional programs and projects as instruments of collective promotion of the industrial property system within the developing countries and as factors in the promotion of technical cooperation among developing countries.

In the field of training, a number of delegations indicated their approval of the structuring and planning efforts made by the International Bureau and supported the objectives for the 1990s suggested by the International Bureau, particularly with regard to the identification of regional training centers in developing countries.

Numerous delegations expressed their gratitude to the UNDP and the governments and organizations of the industrialized and developing countries that had cooperated in and contributed to the Permanent Program for the assistance they had received in their countries through the Program, and the Permanent Committee invited all those concerned to continue their efforts to provide the necessary resources for funding the Permanent Program, both as regards the resources within the WIPO budget and those outside the budget, including the resources of UNDP. The Delegations of Australia, Austria, Brazil, Bulgaria, Czechoslovakia, Egypt, France, the German Democratic Republic, Germany (Federal Republic of), India, Japan, the Netherlands, Portugal, the Soviet Union, Spain, Sweden, Switzerland, the United Kingdom, the United States of America and the EPO referred to their cooperation activities under the Permanent Program and expressed their wish to continue and, in some cases, increase their contributions to the Program.

Finally, the Permanent Committee recommended that (i) in future, the report on its sessions be submitted to the WIPO Conference and that examination of the report be expressly mentioned in the draft agenda submitted by the Director General to that Conference; and (ii) the Permanent Committee should devote a part of some of its sessions to examining specific matters affecting the orientation or implementation of the Program; such matters could concern licensing, industrial property protection of new subject matter, patent documentation and information, utilization of human resources and institutions in the developing countries within the framework of the Permanent Program.

## LIST OF PARTICIPANTS\*

### I. States

Algeria<sup>1</sup>: H. Redouane. Argentina<sup>1</sup>: L. Tettamanii. N. Fasano. Australia<sup>1</sup>: I.W. McCay. Austria<sup>1</sup>: H. Marchart. Bangladesh<sup>1</sup>: M. Rahman. Benin<sup>1</sup>: L. Hounzangbe. Bolivia<sup>1</sup>: I. Paz Claros. Brazil<sup>1</sup>: J.M. Vinicius de Souza; M. Nascimento; P. França. Bulgaria<sup>1</sup>: O. Delev. Burkina Faso<sup>1</sup>: A. Seye. Cameroon<sup>1</sup>: J.-O. Tigbo; W. Eyambe. Central African Republic<sup>1</sup>: G. Zekpio. Chile<sup>1</sup>: C. Lynam; E. Ruiz. China<sup>1</sup>: Ge Bo. Colombia<sup>1</sup>: A. Gamboa Alder; L.A. Luna Benitez. Costa Rica<sup>1</sup>: E. Soley Soler; J. Rhenán Segura. Côte d'Ivoire<sup>1</sup>: K.F. Ekra. Cuba<sup>1</sup>: M. Jiménez Aday. Cyprus<sup>1</sup>: C. Yiangou. Czechoslovakia<sup>1</sup>: V. Benisko. Egypt<sup>1</sup>: S.A. Abou Ali; W.Z. Kamil. El Salvador<sup>1</sup>: A. Gonzalez. France<sup>1</sup>: M. Hiance; J.-B. Mozziconacci. Gabon<sup>1</sup>: T. Imboumy. Gambia<sup>1</sup>: M.N. Bitaye. German Democratic Republic<sup>1</sup>: K. Stoecker. Germany (Federal Republic of)<sup>1</sup>: F.P. Goebel; D. Schennen. Ghana<sup>1</sup>: A.M. Abdullah. Guatemala<sup>1</sup>: A. Pallares-Buonafina; N.M. de Contreras-Saravia. Guinea<sup>1</sup>: M. Touré. Honduras<sup>1</sup>: J.M. Maldonado; I. Lopez; R. Castro Nuñez; O. da Costa Gomez. India<sup>1</sup>: S.R. Tayal. Indonesia<sup>1</sup>: N. Wisnomoerti; T. Soetrisno. Italy<sup>1</sup>: M.G. Fortini. Jamaica<sup>1</sup>: K.G.A. Hill; P.A. Robotham. Japan<sup>1</sup>: M. Umeda; Y. Masuda. Libya<sup>1</sup>: M. Sasi. Madagascar<sup>1</sup>: P. Verdoux. Malawi<sup>1</sup>: B.Y.M. Makwinja. Mexico<sup>1</sup>: R. Beltran Guerrero. Morocco<sup>1</sup>: M.S. Benryane. Netherlands<sup>1</sup>: W. Neervoort. Nicaragua<sup>1</sup>: G.A. Vargas; O. Aleman Benavides. Niger<sup>1</sup>: G. Hassane. Nigeria<sup>1</sup>: E.O. Jegede; F.O. Fenuyi; J. Oniwon. Norway<sup>1</sup>: T. Hansen. Pakistan<sup>1</sup>: Z. Akram. Panama<sup>1</sup>: I. Aizpúria Pérez. Peru<sup>1</sup>: J.F. Rubio Correa. Portugal<sup>1</sup>: J. Mota Maia. Republic of Korea<sup>1</sup>: S.M. Cha; J.U. Chae; T.C. Choi. Rwanda<sup>1</sup>: F. Kanyamibwa. Saudi Arabia<sup>1</sup>: J. Abdul Razak; A. Al-Bakri; A. Omair. Senegal<sup>1</sup>: A.M. Dieng; S.C. Konate. Somalia<sup>1</sup>: S.A. Sheikh Mohamed. Soviet Union<sup>1</sup>: A. Alekseev. Spain<sup>1</sup>: R. Vazquez de Parga. Sri Lanka<sup>1</sup>: J. Dhanapala; P. Kariyawasam. Sudan<sup>1</sup>: M. Abdalla. Sweden<sup>1</sup>: U. Jansson; E. Nyrén; L. Claesson. Switzerland<sup>1</sup>: E. Caussignac; J.-M. Souche. Syria<sup>1</sup>: N. Chaalan. Thailand<sup>1</sup>: S. Posayanond; N. Punyakij; K. Phutragool. Trinidad and Tobago<sup>1</sup>: L.E. Williams; H. Robertson. Tunisia<sup>1</sup>: A. Boudhiba; H. Boufares. Turkey<sup>1</sup>: M. Çetin. Uganda<sup>1</sup>: P.L. Nsibirwa. United Kingdom<sup>1</sup>: L. Lewis. United Republic of Tanzania<sup>1</sup>: R.B. Mngulwi; S. Asman. United States of America<sup>1</sup>: G.L. Skillington; P.A. Woodring. Uruguay<sup>1</sup>: R. Gonzalez-Arenas. Venezuela<sup>1</sup>: L.D. Ruiz; O. Garcia Garcia. Viet Nam<sup>1</sup>: Vu Huy Tan. Yugoslavia<sup>1</sup>: B. Pajković; G. Fejić. Zambia<sup>1</sup>: A.R. Zikonda.

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

<sup>1</sup> State member of the WIPO Permanent Committee for Development Cooperation Related to Industrial Property.

## II. United Nations Organizations

United Nations Development Programme (UNDP): E. Bonev.

## III. Other Intergovernmental Organizations

African Intellectual Property Organization (OAPI): G. Meyo M'Emane. European Patent Organization (EPO): A.G. Wells. League of Arab States (LAS): R. Hamadah. Permanent Secretariat of the General Treaty on Central American Economic Integration (SIECA): E. Abplanalp.

## IV. International Non-Governmental Organizations

International Association for the Protection of Industrial Property (AIPPI): G.E. Kirker. International Federation of Inventors' Associations (IFIA): K.E. Sundström. Licensing Executives Society (International) (LES): H.C. Donkers.

## V. Officers

*Chairman:* H. Redouane (Algeria). *Vice-Chairmen:* M. Hiance (France); V. Benisko (Czechoslovakia). *Secretary:* B. Machado (WIPO).

## VI. International Bureau of WIPO

A. Bogsch (*Director General*); M. Porzio (*Deputy Director General*); K. Idris (*Director, Development Cooperation and External Relations Bureau for Arab Countries*); L. Kadigamar (*Director, Development Cooperation and External Relations Bureau for Asia and the Pacific*); E. Pareja (*Director, Development Cooperation and External Relations Bureau for Latin America and the Caribbean*); I. Thiam (*Director, Development Cooperation and External Relations Bureau for Africa*); R. Blumstengel (*Head, Developing Countries Section (Patent Information)*); B. Machado (*Head, Development Cooperation Program Support Unit*); J. Quashie-Idun (*Head, Developing Countries Section (Industrial Property), Industrial Property Division*).

## Paris Union

### I. Committee of Experts on the Protection Against Counterfeiting

First Session  
(Geneva, May 5 to 7, 1986)

#### NOTE\*

The Committee of Experts on the Protection Against Counterfeiting (hereinafter referred to as "the Committee of Experts") held its first session in Geneva from May 5 to 7, 1986.

The following States were represented at the session:

Argentina, Australia, Austria, Bangladesh, Brazil, Cameroon, Canada, Chile, China, Colombia, Cuba, Czechoslovakia, Denmark, Finland, France, Germany (Federal Republic of), Greece, Hungary, India, Ireland, Israel, Italy, Japan, Madagascar, Mexico, Morocco, Netherlands, Norway, Panama, Portugal, Spain, Sweden, Switzerland, Tunisia, United Kingdom, United States of America, Yugoslavia (37). The representatives of four intergovernmental organizations and of 32 non-governmental organizations also attended the session of the Committee of Experts in an observer capacity. The list of participants follows this Note.

Discussions were based on a memorandum by the Director General entitled "Counterfeiting and National Laws; Counterfeiting and the Paris Convention" (documents PAC/CE/I/2 and PAC/CE/I/2 Add., hereinafter referred to as "the Memorandum").

The introduction to the Memorandum explains that, at its eighth session (September/October 1985), the General Assembly of WIPO unanimously approved a draft decision that contained, *inter alia*, an invitation to the Director General "to convene an intergovernmental group of experts to examine, in as many sessions as necessary, within the limits of available resources, the relevant provisions of the Paris Convention in order to determine to what extent such provisions can adequately provide for the efficient protection of industrial property and to recommend appropriate provisions to be incorporated in national industrial property legislation in order to strengthen the protection of industrial property titles." The Memorandum further specifies that the first step in carrying out the terms of reference given by the General Assembly is limited to examining the consideration of measures, existing or desirable, to combat counterfeiting, where the counterfeiting involves the unlawful use of protected trademarks. The Memorandum was intended as an introduction to that first step, other steps being reserved for dealing with those aspects of counterfeiting that do not concern trademarks and with aspects—other than those concerning counterfeiting—of the efficient protection of industrial property rights.

The Memorandum comprises two chapters. Chapter I contains recommendations on appropriate provisions to be incorporated in national industrial property legislation in order to combat acts of counterfeiting effectively and thereby strengthen protection attaching to marks. It also contains model provisions intended to serve as examples to governments and thereby facilitate their task in drafting or amending national legislation with respect to the contents of the provisions which are to combat counterfeiters and counterfeiting. Chapter II consists of an analysis of those provisions of the Paris Convention for the Protection of Industrial Property of March 20, 1883, last revised at Stockholm on July 14, 1967 (hereinafter referred to as "the Paris Convention"), that have a bearing on counterfeiting. It also contains a proposal for the institution of "information meetings."

\* Prepared by the International Bureau.

During the general debate held by the participants at the meeting of the Committee of Experts, the growing threat that counterfeiting represented for the protection of intellectual property and the need to act effectively at both international and national levels against this factor that affects all types of industry were discussed in some detail. The numerous speakers in the general debate emphasized that not only manufacturers and consumers were victims of counterfeiting but also the national economies of the countries as a whole. Although satisfied with the priority that had been given to the counterfeiting of trademarks, they pointed out that copyright, designs, patents and indications of source were also subject to counterfeiting and that WIPO should subsequently deal with those aspects of counterfeiting that did not concern trademarks. The general debate further showed that the initiative taken by WIPO to study the problem of counterfeiting and to seek means of combating it were unanimously approved. In view of the international nature of counterfeiting and its various aspects, a number of delegations held that converging action should be taken within the international community to put a halt to counterfeiting and that the activities undertaken by WIPO in that field should not exclude those of other international organizations required to deal with certain aspects of counterfeiting. Other delegations considered that WIPO was the international organization that possessed overall competence to promote international cooperation for the fight against counterfeiting and that WIPO's in-depth examination of the problem should not be minimized by possible concurrent initiatives taken in other international bodies.

Following the general debate, the participants examined the specific issues dealt with in the Memorandum, that is to say, examination of the relevant provisions of the Paris Convention related to counterfeiting that are analyzed in Chapter II of the Memorandum, examination of the model provisions contained in Chapter I of the Memorandum and examination of the Director General's proposal to institute information meetings, made at the end of Chapter II of the Memorandum.

### Counterfeiting and the Paris Convention

The Paris Convention establishes certain obligations for the countries party to it concerning the prevention and repression of counterfeiting. The Memorandum contains the following comments (paragraphs 22 to 31) in respect of obligations dealing *expressis verbis*, in the Convention, with counterfeit goods illegally bearing protected trademarks:

22. Article 10ter(1) of the Paris Convention provides that "countries [members] of the [Paris] Union undertake to assure to nationals of the other countries of the Union appropriate legal remedies effectively to repress all acts referred to in Articles 9, 10 and 10bis."

23. Article 9 refers to the act of "unlawfully bearing a trademark" by goods. In other words, the unlawful presence of a protected trademark

on goods—that is, "counterfeit goods," in the sense the expression is used in this Memorandum—is an act or situation following from an act which contracting countries have to "effectively repress" through "appropriate legal remedies."

24. *Three kinds of measures.* Among such legal remedies, Article 9 mentions three kinds: (i) seizure (paragraphs (1) to (6)), (ii) prohibition of importation (paragraph (5)) and (iii) other "actions and remedies" (paragraph (6)), i.e., actions and remedies other than seizure and prohibition of importation.

25. *Seizure.* Article 9 differentiates between seizures applicable to domestic goods ("seizure in the country where the unlawful affixation occurred" (paragraph 2)) and seizures applicable to foreign goods (goods to "be seized on importation" and goods "imported" (paragraphs (1) and (2))).

26. As far as the seizure of *domestic* counterfeit goods is concerned, the obligation to effect it is absolute since none of the exceptions, provided for in paragraphs (4), (5) and (6), applies to it.

27. As far as the seizure of *foreign* counterfeit goods is concerned, there is an obligation to seize them (i) "on importation" and (ii) (if, *de facto*, not seized upon importation, then) "inside the country," that is in the country into which the goods were imported. This obligation, however, is not absolute in neither of the two cases.

28. The obligation of seizure upon importation is not absolute since it follows from paragraph (5) that a country's legislation is allowed not to provide for seizure on importation. If it does not provide for seizure on importation, the country must, however, "replace" seizure on importation by "prohibition of importation" or by "seizure inside the country." The Paris Convention, however, admits that even these replacement measures may not exist, and if they do not, then and "until such time as the legislation [of the country] is modified accordingly" (paragraph (6)), the said replacement measures must be replaced "by the actions and remedies available in such cases to nationals under the law of such country" (paragraph (6)). Such actions and remedies are dealt with in paragraph 31, below.

29. The obligation of seizure inside the country of foreign goods is not absolute either since it follows from paragraph (6) that a country's legislation is allowed not to provide such seizure. However, if it does not provide such seizure, it must replace it "by actions and remedies available in such cases to nationals under the law of such country" (paragraph (6)). Such actions and remedies are dealt with in paragraph 31, below.

30. *Prohibition of Importation.* As already stated, one of the measures by which a contracting country may replace seizure on importation is the "prohibition of importation" (paragraph (5)). However, the Paris Convention admits that even this replacement measure may not exist and, if it does not, then and "until such time as the legislation [of the country] is modified accordingly" (paragraph (6)), the said replacement measure must be replaced "by actions and remedies available in such cases to nationals under the law of such country" (paragraph (6)). Such actions and remedies are dealt with in the next paragraph.

31. *Other Actions and Remedies.* What are such "actions and remedies?" They must, according to Article 10ter(1) be "appropriate," "legal" and apt to "effectively repress" the illegal acts. The Paris Convention does not specify the said actions and remedies but this does not mean that they need not exist. They do need to exist. Characteristic actions and remedies are (i) the prohibition (of the continuation) of the sale of the counterfeit goods, (ii) the destruction of the counterfeit goods, (iii) the awarding of damages to be paid by the counterfeiter to the owner of the counterfeit mark and (iv) the punishing of the counterfeiter by fine and/or imprisonment. All those actions and remedies are appropriate, legal and effective. Since it is difficult to imagine many other actions or remedies corresponding to those three criteria, it is believed that a correct interpretation of the Paris Convention is that at least one of, if not all, the four kinds of actions and remedies must be provided for in the legislation of any country party to the Paris Convention. (Naturally, as already indicated, the seizure of domestic counterfeit goods, mentioned in paragraph 26, is also an action or remedy that must be provided for.)

Views within the Committee of Experts were divided on whether the relevant provisions of the Paris Convention could properly ensure effective protection against counterfeiting and also on whether the minimum standards contained in the Paris Convention in the field of counterfeiting were effective enough to bind the national legislator.

It was commented, on the one hand, that those standards were not binding on the national legislator. For example, Article 9 of the Paris Convention (stipulating seizure, prohibition of importation and actions and remedies other than seizure and prohibition of importation in respect of goods unlawfully bearing a trademark) seemed to offer strong protection, but the obligations contained in that Article were largely taken

away by its paragraph (6) which stipulated that where the legislation of a country permitted neither seizure on importation nor prohibition of importation, nor seizure inside the country, then, until such time as the legislation was modified accordingly, these measures were to be replaced by the actions and remedies available in such cases to nationals under the law of the country.

On the other hand, it was remarked that Article 10ter of the Paris Convention required that "the countries of the Union undertake to assure to nationals of the other countries of the Union *appropriate legal remedies effectively to repress...*" the unlawful acts committed by counterfeiters and that there was no escaping the binding effect of that provision. It was therefore fair to say that the Paris Convention did contain effective provisions against counterfeiting.

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### Model Provisions

The Memorandum contains four model provisions intended to serve as examples for national lawmakers wishing to strengthen protection of trademarks against

counterfeiting. The provisions are accompanied by observations. This Note reproduces each model provision ("Article") and the relevant observations, followed by a summary of the main remarks and suggestions made by the participants during the discussions.

#### *"Observations Concerning Article A*

19.1 Counterfeiting is an act which results in the making of counterfeit goods or which deals in counterfeit goods. The act is any of the following: (i) manufacturing, (ii) importation, (iii) offering for sale, rental, lending or free distribution, (iv) sale, rental, lending or free distribution.

19.2 The person who commits the act, and the person, if any, on the order of whom the act is committed, is the counterfeiter.

19.3 Any of the said acts, in itself, is counterfeiting. Naturally, in any given case, not only one but also several of the above-mentioned acts may be committed by the same counterfeiter. One or several of the acts may be committed by one counterfeiter, and one or several of the other acts may be committed by another counterfeiter.

19.4 The model provision does not mention exportation or transiting of the goods but the legislator may wish to consider those acts, too, as acts of counterfeiting.

#### *"Article A* COUNTERFEITING

For the purposes of this Law,

- (i) the manufacturing,
- (ii) the importation,
- (iii) the offering for sale, rental, lending or free distribution,
- (iv) the sale, rental, lending or free distribution,

of goods bearing a trademark that is a slavish or near-slavish imitation of the protected trademark shall be considered an act of counterfeiting *provided* that the goods are of the same kind or of a similar kind in connection with which the trademark is protected and *provided* that the act is committed without the authorization of the owner of the protected trademark."

19.5 "Bearing" a trademark should be understood as a close association of the goods and the trademark. The trademark may be an integral part of the product (e.g., is painted on or is interwoven in the texture), may be affixed to it or on its container, or may be the container itself (e.g., the container's shape being a so-called three-dimensional mark).

19.6 The counterfeit trademark may, but need not, look exactly the same ("slavish imitation") as the protected trademark; it is enough, to be considered as a counterfeit, if it looks very similar to the protected trademark ("near-slavish imitation").

19.7 To be protected, a trademark, in most countries and in most cases, must be registered in the trademark register of the country or in the international register kept by the International Bureau of WIPO in Geneva. However, the Paris Convention requires that well-known trademarks be protected even if not registered. In some countries, for example in the United States of America, even ordinary trademarks (i.e., other than well-known trademarks) are protected without registration; they acquire protection through use.

19.8 If the trademark is registered, the registration identifies the goods for which protection has been asked for by the owner of the registration. If the trademark is not registered, the question for which goods the trademark is protected depends on the circumstances: where the trademark is an unregistered well-known trademark, in most countries, probably, what counts is whether the average consumer considers that the goods originate with the enterprise of the owner of the trademark, whereas in the case of countries in which use, without registration, causes protection, protection probably extends to the goods in connection with which the trademark was and continues to be actually used.

19.9 Counterfeiting exists even if the consumer (potential or actual buyer, payer of a rental fee, borrower, donee) is not confused as to the origin of the goods. As a matter of fact, the consumer may very well know that the goods offered to him are counterfeit. The potential or actual vendor, owner of the rented or lent goods, or donor, may himself call this fact to the consumer's attention. These facts do not deprive the acts of selling, etc., from being acts of counterfeiting."

Differing opinions were expressed on whether the list of acts constituting counterfeiting ought to be limited to those named in the Memorandum or, on the contrary, extended to other acts. Whereas some delegations had doubts on the introduction of a rigid legal definition that might not cover unforeseeable future aspects, other delegations considered that counterfeiting should be covered by a strict legal definition since it constituted a violation of protected industrial property rights. Numerous delegations were in favor of including in the list of acts referred to in Article A the fact of being in possession of counterfeit goods with the intention of placing them on the market, of transit and of the exportation of counterfeit goods.

Some delegations further proposed that the scope of Article A be limited to registered trademarks alone, in order to ease the task of the authorities, particularly the customs authorities, which were expected to act swiftly. In the opinion of other delegations, such a limitation would be inopportune, particularly in view of the obligation to protect well-known marks even if they were not registered. The latter delegations wanted Article A to cover cases of trademarks used without registration also, taking into account the legal tradition of certain countries in which the rights deriving from the trademark were acquired by use. Several delegations objected to the term "near-slavish" in view of the diffi-

culties of interpretation raised by that concept both for the courts and for other authorities. According to those delegations, the concept implied a subjective judgment that could prove difficult for certain authorities. In that respect, it was proposed that there be a requirement that imitation should be such as to mislead the consumer or the general public. Other delegations stated, on the other hand, that the concept of near-slavish imitation should be maintained since to delete it would open the way to even more numerous abuses in view of the skill and imagination demonstrated by counterfeiters. As regards the goods, some delegations had difficulties in interpreting the words "similar kind" since, according to those delegations, they also implied a judgment of value and a subjective assessment. Those delegations felt that they should be limited to products of the same kind.

In view of the difficulties encountered in finding satisfactory concepts, various delegations felt that the definition of counterfeiting should be left to the national legislator.

*"Observations Concerning Article B*

19.10 The expression "Conservatory," only used in the title of this Article, is intended to indicate that the measures are designed to freeze or conserve the situation as it is found at the moment the competent authority orders and applies them.

19.11 *Ad paragraph (1)*. The measures in question must serve one or both of two objectives.

19.12 One of the objectives is to prevent the commission, or the continuation of the commission, of acts of infringement. It goes without saying that the commission, or the continuation of the commission, must be likely to occur. There must be a present danger. Such danger will have to be found in the circumstances. For example, there are goods ready in the workshop and, next or near to those goods, there are trademarks on labels or pieces of cloth, obviously apt to be placed on the goods; or it is known that goods have been charged abroad on airplane or boat scheduled to land in the country; or there are goods in the warehouse of a wholesale firm or in the warehouse or on the floors of a retail outlet, like a shop, department store, videocassette "club" or publicity outfit.

19.13 The other objective that the measures must serve is to secure evidence as to the identity, quantity or location of the goods.

19.14 As to the first objective—prevention—the measure typically consists of an order not to commit a certain act. This is called, in some countries, injunction.

19.15 As to the second objective—securing evidence—the measures may consist of the sealing, by the police, of the premises where the goods are manufactured or kept; the description—in a *procès verbal*, drawn up by a notary public or the police—of what was found, particularly the goods that were found, on certain premises, belonging to or otherwise under the control of certain persons or accessible to such persons; the taking of samples of the goods and keeping them by the police, the notary public or the court; the taking and keeping of some or all of the books.

19.16 The measure may be ordered by "law enforcement authorities," typically a court, a judge responsible for investigation, a public prosecutor, the police or the customs authorities. But if the authority is not a court, either the previous authorization of the court is required or if such previous authorization cannot, reasonably, be received without endangering (because of the delay and/or publicity involved) the effectiveness of the measure, one must obtain, as soon after the measure as possible the *ex post facto* agreement ("the subsequent ratification"). If it is not requested promptly or if it is refused, the measure should be withdrawn by the authority that ordered it.

19.17 *Ad paragraph (2)*. It is essential that the person asking for the measure or measures allege counterfeiting since the measures are justified only if there is, or there is a danger of, counterfeiting and since, if the allegation proves to be wrong, the person that asked for the infringement is responsible for any damage caused (see paragraph (5)). It is going to be the person who has requested the measure and alleged the infringement who will be responsible for any such damages.

19.18 *Ad paragraph (3)*. This requirement has been explained in connection with paragraph (1).

19.19 *Ad paragraph (4)*. The posting of bonds should be required in particular if the potential damage to the person who has to suffer the measure is considerable both in terms of money and reputation.

19.20 *Ad paragraph (5)*. This provision is justified in connection with paragraph (1).

19.21 *Ad paragraph (6)*. The ordering of certain measures, to be effective, must surprise the alleged counterfeiter. Otherwise, he could hide or otherwise conceal the goods or his activities. However, once the measure is taken, the alleged counterfeiter should be heard and, if his defense is convincing, the measure should be withdrawn.

19.22 *Ad paragraph (7)*. This provision allows both *ex officio* cancellation of the measures or their cancellation at the request of the alleged counterfeiter.

*"Article B*

## CONSERVATORY MEASURES

(1) On the request of the owner of the protected mark, law enforcement authorities, with the previous authorization or the subsequent ratification of court authorities, shall take measures which they consider necessary:

(i) in order to prevent the commission or the continuation of the commission of acts of counterfeiting, and/or

(ii) in order to secure evidence as to the identity, quantity and location of the goods.

(2) In either case, it shall be required that the owner allege counterfeiting.

(3) The court authorizing or ratifying the measure, or the law enforcement authority proceeding with the measure without the previous authorization of the court, must find that the acts committed or likely to be committed may reasonably be suspected of constituting acts of counterfeiting.

(4) The law enforcement authority or the court may order the posting of a bond by the party requesting the measure.

(5) If, later, it is found by the court that there was no act of counterfeiting, the person who had asked for the measure shall be liable for the damages caused by the measure.

(6)(a) The court or other law enforcement authority may order the measure even without offering an occasion to the person who may suffer prejudice as a consequence of the measure to be heard before the measure is ordered or applied.

(b) It shall, whenever practicable, and as soon as practicable, offer such an occasion after the ordering and applying of the measure.

(7) The court or the law enforcement authority may cancel the measure if the requirements set forth in paragraphs (2) and (3) are no longer fulfilled.

(8) The measures shall include, in particular, any of the following:

(i) seizure or impounding of the goods,

(ii) sealing of the premises where the goods are manufactured, stored or offered for sale, rental, lending or free distribution,

(iii) impounding the tools which may serve for the manufacturing of the goods,

(iv) ordering that the manufacturing, importation, offering for sale, rental, lending or free distribution, or the sale, rental, lending or free distribution, stop."

19.23 *Ad paragraph (8)*. "Seizure or Impounding" mean the placing of the goods in a physical situation in which no one can have access to them without the authorization of the authority that ordered the impounding."

As regards the conservatory measures that could be ordered by the "law enforcement authorities," various delegations expressed doubts as to the applicability of such a broad provision in respect of competence. Indeed, both the principle of the separation of powers and the risk of arbitrary acts (if powers were entrusted to the offices) militated in favor of giving responsibility for the enforcement of the laws to the judicial authorities alone. On the other hand, the activities of the customs were most useful since they enabled acts of counterfeiting to be discovered rapidly; a separate provision giving competence to the customs would therefore have to be included. One delegation explained that it could be contrary to a country's constitution to apply measures subject to subsequent confirmation by the courts. The conservatory measures set out in Article B should always be ordered by the courts themselves. One delegation felt that it would be difficult for law enforcement authorities to take preventive measures before the committing of the offense. Once the evidence showed that the offense had been committed, then it would be proper to prevent continuation of the acts of counterfeiting by suitable measures.

Under Article B, the main aim of the conservatory measures was to secure evidence as to the identity, quantity and location of the goods. It was proposed that it be laid down that evidence should also be secured in respect of the source and destination of the goods.

*"Observations Concerning Article C*

19.24 By "civil" remedies are meant all remedies other than penal or criminal remedies.

19.25 *Ad paragraph (1)*. The general law on damages will apply. They may typically, consist of compensation for *damnum emergens* (actual damage) or of *lucrum cessans* (profit not realized). In some countries, they may be also in compensation for the harm done to the reputation of the owner of the mark.

19.26 *Ad paragraph (2)*. The question to which an answer is sought is what should happen to the counterfeit goods, once a court finds, in a judgement no longer open for appeal, that the goods are counterfeit. The law may provide for their confiscation and/or forced sale for the benefit of the State or the injured party. But confiscation is not permitted under the constitution of certain countries and, in any case, may result in putting back into circulation the counterfeit goods. Another possible remedy consists of ordering the removal of the trademarks from the goods; but this is not always practicable and, again, will put the goods back into circulation. Destruction is a drastic measure but, because of that, is probably also a deterrent against repetition.

19.27 *Ad paragraph (4)*. Such a measure may be compatible with the legal system of only some countries. In countries that know it, it is usually called an injunction."

With regard to damages, it was mentioned that it was difficult to assess the compensation to be paid to the owner of a mark for the harm done to his reputation. Various suggestions were made in that respect: payment of twice or three times the damages normally paid, payment of the cost of preparing the case and attorneys' fees, payment of damages corresponding to the profits

*"Article C*  
CIVIL REMEDIES

(1) The owner of the protected mark shall be entitled to damages for the prejudice suffered by him as a consequence of acts of counterfeiting.

(2) Where counterfeit goods are in existence, the court shall order their destruction.

(3) Where the court considers that there is a danger that certain tools may, in the future, be used for the continuation of counterfeiting, it may order their destruction.

(4) Where the court considers that there is a danger that the defendant may continue any of the acts of counterfeiting, it shall expressly order that such acts not be committed, specifying the goods and the prohibited acts."

gained by means of the counterfeit goods. On the subject of the destruction of such goods, a remedy that is considered to be the most efficacious and which should be especially provided for in the case of pharmaceutical, chemical or other goods involving a risk to the consumer or the public at large, it was mentioned that the solution consisting in destruction pure and simple, without any exception, could involve certain problems. Account had to be taken of special cases such as that of the innocent trader, for whom destruction could sometimes be far too drastic a remedy. In certain cases, the State could profit by the goods or could donate them to a charity. The destruction of the goods should occur only if there were no other, more appropriate and more useful solutions. It would also be possible to provide, as did certain national laws, for the destruction of the goods solely where it was not possible to erase or remove the trademark in another way without damaging them. With regard to the tools used, they should not be destroyed where they were not designed exclusively for the marking of counterfeit goods.

Other civil remedies were mentioned in addition to those referred to in Article C, such as an obligation to divulge the source of the counterfeit goods, forfeiture of civil and political rights, prohibition on the exercise of business activities or striking off the trade register.

#### *Observations Concerning Article D*

19.28 Criminal law and procedure differ to a considerable extent in the various countries. Consequently, it is even more difficult to propose model provisions for criminal sanctions than for civil remedies and conservatory measures. Each country will follow its own system.

19.29 *Ad paragraph (1).* But what this paragraph still wants to achieve is to suggest to the legislator that all acts of counterfeiting should be offenses.

19.30 The definition of counterfeiting will have to be construed, in each country, according to the general concepts of criminal law applicable in that country. If the offense is a minor one (called, in some systems, a misdemeanor), negligence on behalf of the offender may be sufficient to make him an offender; if the offense is considered as a major one, punished as a "crime," "felony" or "delict," intent or *mens rea* may be a requirement. The question on whose initiative the procedure can be started (private complaint and/or public prosecutor), what the limits of the punishment are, and many other important aspects will be governed by the general penal law of the country concerned.

19.31 *Ad paragraph (2).* This model provision is intended to suggest that *recidivism* should be punished more severely than a first offense. Here, too, the general penal system of the country will be determinative.

19.32 *Ad paragraph (3).* Whether the powers of a criminal court extend to the possibility of applying the measures referred to in Article C(2), (3) and (4) is, again, a question, the answer to which will largely depend on the criminal system of the country."

It was generally acknowledged that, on the one hand, criminal sanctions should only be applied where the counterfeiting was intentional and, on the other, that the penalties should differ depending on whether the act had been committed intentionally or by negligence. The penalties should be sufficiently serious for them to have a dissuasive effect. In that connection, various delegations spoke of the very low fines to be found in some

#### *Article D*

#### CRIMINAL SANCTIONS

(1) Any person who has committed an act of counterfeiting as defined in Article A, shall be punished by a fine of between ... and ... and/or imprisonment for a period of between ... and ....

(2) The punishments specified in paragraph (1) shall be double where the conviction is not the first conviction of the defendant for counterfeiting in the five years that precede the conviction.

(3) Any of the conservatory measures provided for in Article B, may be ordered *ex officio* in the case where the commission of a criminal act is suspected.

(4) The court shall apply the measure referred to in Article C(2), and may apply the measures referred to in Article C(3) and (4), also in a criminal proceeding."

national laws as a result of monetary depreciation. As regards the fixing of the amount of the fine, a number of possibilities were discussed. It was suggested that a fine be stipulated the amount of which would represent a given number of times that of a minimum salary. It was also requested that a solution be studied for laying down fines that were proportional to the volume of the counterfeiter's business.

In respect of the terms of imprisonment, attention was drawn to the fact that courts frequently did not apply such penalties even where they were provided for in national law. In view of the fact that counterfeiting was a serious commercial crime approximating to theft, it was proposed that any person who committed an act of counterfeiting be punished by the penalty applicable to the theft of tangible property.

### Information Meetings

The content of paragraphs 45 to 50 of the Memorandum, devoted to information meetings, was the following:

45. It is proposed that the General Assembly of WIPO decide that at regular intervals—for example, once every two years—a meeting be convened at Geneva by the Director General of WIPO for the purpose of exchanging information, among representatives of the member States of WIPO, on their experience in combating counterfeiting.

46. The information presented could relate both to successes and shortcomings of the measures against counterfeiting and of the implementation of such measures.

47. A report summarizing the discussions that took place in each information meeting would be prepared by the International Bureau of WIPO for approval by the participants and, after approval by them, would be published.

48. It is to be noted that it is not proposed that the information meetings adopt any resolutions, conclusions, recommendations or any other joint statement. Neither is it proposed that the information meetings be empowered to invite States to consult with each other in the case of possible disputes among them or to "settle" disputes, as they may, for example, in the framework of GATT.

49. In other words, information meetings should be what their title indicates and nothing else, that is, meetings in which the representative of any government of a member State—and nobody else—could present information, orally or in writing, and the representatives of the other member States—and nobody else—could make observations, in writing or orally, on such information.

50. Should the Committee of Experts favor the further exploration of the possibilities of instituting such information meetings, the Director General would, if the Committee of Experts so desires, present draft rules of procedure for such information meetings. Such draft rules of procedure could be presented to the next session of the Committee of Experts and would, eventually, be submitted for decision to the General Assembly of WIPO when it meets in ordinary session in 1987."

It was agreed in the Committee of Experts that the idea of having such information meetings was promising and should be further explored. Several delegations expressed their strong support for holding such meetings which would provide a forum to consider the success and shortcomings of the measures against counterfeiting. Such meetings would give an opportunity to

exchange information on the implementation of relevant legislation and administrative measures and, in general, on the experience of member States in combating counterfeiting. The meetings should be held at regular intervals, annually if possible, at least during an initial period of several years. They should cover not only trademark aspects of counterfeiting, but also deal with other aspects of industrial property.

Views were divided on the question whether copyright aspects of counterfeiting should be included as well.

It was suggested that WIPO should, as proposed in the Memorandum, draft rules of procedure for such information meetings for the next session of the Committee of Experts to allow a more detailed evaluation of the tasks to be accomplished by such meetings.

Several other delegations, while supporting the proposal in principle, expressed the view that it was premature to pursue the idea of information meetings at the present time. According to those delegations, before taking any decision in the matter, more information was required as to the kind of information which should be collected and furnished for such meetings; in order to provide a clear picture of what was intended to be achieved by the meetings, the International Bureau should provide a detailed analysis of the information required in the form of a questionnaire; no recommendations on this question should be made for the time being and one should also avoid institutionalizing the procedure before collecting more experience with its implementation; it was also premature to consider draft rules of procedure for information meetings at the next session of the Committee of Experts; there should, in particular, be no parallel activity by the Committee of Experts and in the framework of information meetings.

In this connection, it was clarified that it was not proposed to hold these information meetings already now, but to submit a proposal to the 1987 session of the General Assembly of WIPO for a decision.

Several delegations expressed the view that the International Bureau should submit to the next session of the Committee of Experts a document (either in the form of rules of procedure or of a detailed description of the proposed mechanism) which would allow a more detailed study of the proposal with a view to submitting a recommendation on it to the session of the General Assembly of WIPO in 1987.

### Future Work

The Director General of WIPO informed the Committee that he planned two more sessions of the Committee of Experts before the September 1987 sessions of the Governing Bodies. For the next session, an improved version of the Memorandum presented to the present session would be prepared. The Secretariat

would send a questionnaire to all countries members of the Paris Union and to countries that are not members of the Paris Union, but appear on the list of countries in respect of which a summary of the relevant laws was made in Annex II to the Memorandum. In addition, the Secretariat would send the existing summary of the national law of each country for correction and completion to the government of that country; at the same time, it would ask that the governments supplement the information contained in those summaries—almost exclusively dealing with what can be found in trademark laws—by relevant information contained in other laws (for example, criminal laws, civil and criminal procedure laws, codes of commercial laws) and in more important court decisions. Governments would have several months for replying to the questionnaire and for completing the summary.

The Director General further explained that the recommended provisions would be revised and would contain alternatives. The part on the Paris Convention would also be revised in the light of the discussions. Both the part on the Paris Convention and the part on the recommended provisions would continue to deal essentially with counterfeiting only where trademark rights were violated. The part on the information meetings would not contain any draft rules of procedure, but would merely elaborate on certain ideas expressed in the Memorandum.

In conclusion, the Director General said that whether information meetings of any kind were to be instituted was a question reserved for the Governing Bodies when they met in September 1987.

After the statement by the Director General, the Delegation of Brazil said that in the next Memorandum the International Bureau should present a profound analysis on the extent to which the Paris Convention could adequately provide for appropriate measures for combating counterfeiting, taking into account the information provided by member countries in respect of their national laws. For their part, the Delegations of Argentina, Brazil, Colombia, Cuba and India said that, although they supported the principle of information exchange, it was premature to deal with the question of special meetings; a much more profound analysis of the Paris Convention and of existing national laws should first be completed; in any case, the next sessions of the Committee of Experts could also serve as an occasion to exchange information.

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### II. Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions

Second Session  
Geneva, May 26 to 30, 1986

#### NOTE\*

The Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions (hereinafter referred to as "the Committee of Experts") held its second session in Geneva from May 26 to 30, 1986. The following States were represented at the session: Austria, Belgium, Brazil, Cameroon, Canada, China, Denmark, Finland, France, Germany (Federal Republic of), Hungary, Iceland, Indonesia, Italy, Japan, Madagascar, Netherlands, Nigeria, Norway, Philippines, Poland, Portugal, Republic of Korea, Soviet Union, Spain, Sweden, Switzerland, Tunisia, United Kingdom, United States of America (30). In addition, representatives of one intergovernmental organization and 21 non-governmental organizations participated in an observer capacity. The list of participants follows this Note.

The Committee of Experts considered seven questions: three for the second time and four for the first time.

The three questions that were already considered by the Committee of Experts in its first (July 1985) session<sup>1</sup> concern: (i) the grace period for public disclosure of an invention before filing an application; (ii) the requirements in respect of the granting of a filing date to a patent application; and (iii) the requirements in respect of the naming of the inventor and in respect of evidence to be furnished concerning the entitlement of the applicant. Explanations on the latter two questions (concerning the filing date and the naming of the inventor) were presented to the Committee of Experts in two memoranda prepared by the International Bureau; they are reproduced in full following this Note. The first

question (concerning the grace period), which, prior to the first session of the Committee of Experts, had already been considered by the Committee of Experts on the Grace Period for Public Disclosure of an Invention Before Filing an Application, was the subject of a memorandum prepared by the International Bureau whose text was reprinted *in extenso* in *Industrial Property*, 1984, pp. 314 to 327.

The four questions considered by the Committee of Experts for the first time concern: (i) the requirements in respect of the manner of claiming in patent applications; (ii) the requirements in respect of unity of invention in patent applications; (iii) the extension of patent protection of a process to the products obtained by that process, and proof of infringement of a process patent; and (iv) the prior art effect of previously filed but yet unpublished patent applications.<sup>2</sup>

The Committee of Experts expressed general support for WIPO's efforts in the harmonization of patent laws. Significant progress was made towards reaching an agreement on the solutions proposed by the International Bureau in respect of the seven questions considered by the Committee of Experts.

On the question of a *grace period for public disclosure*, a number of delegations and organizations agreed with the proposed draft treaty provision, according to which there should be a general grace period of six or 12 months for any disclosure by the inventor or someone having obtained the information on the invention from the inventor, regardless of the grounds or methods of such disclosure. Opinions of government delegations were about equally divided as regards the question of whether the general grace period should be a six-month period or a 12-month period, whereas a majority of the organizations favored a 12-month period. Opinions were similarly divided as to the question whether there should be an obligation to notify formally the industrial property office of any prior disclosure: government delegations were about equally divided as regards such a requirement, whereas a majority of the organizations were against such a requirement. It was agreed that third party rights in respect of the continued exploitation of the patented invention which had been started before the filing or priority date should be safeguarded in the future treaty, subject to clarification that such third party rights were limited to persons who had made the invention independently from the person invoking the grace period.

The Committee of Experts also discussed an alternative proposal submitted by the Delegation of Denmark and supported by the Delegations of Finland, Iceland, Norway and Sweden. That proposal recognized a six-month grace period (i) for a disclosure by the inventor or a person acting on his behalf, but only if such disclosure occurred in connection with the testing of the invention, and (ii) for a disclosure of an invention by a

\* Prepared by the International Bureau.

<sup>1</sup> See *Industrial Property*, 1985, p. 267.

<sup>2</sup> It is intended to publish the International Bureau's memoranda on the said questions once their final version has been discussed by the Committee of Experts.

third party, including an industrial property office, but only if the third party was under an obligation to keep the invention secret or if the information had been obtained by an unlawful appropriation, provided that the applicant had done all that could be reasonably required to keep the invention secret. Under the said proposal, the grace period would be allowed only on the condition that the application had been filed as soon as possible after the disclosure. Several participants commented that the purpose of any grace period was to protect inventors, in particular those who did not have sufficient knowledge of patent law and that, in addition to testing, there were other cases which deserved the same treatment. It was suggested that the Delegation of Denmark further elaborate its proposal, taking into account the discussion that took place in the second session of the Committee of Experts and present any revised proposal in time before the next (the third) session of the Committee of Experts, in order to permit proper examination by governments and organizations before the session.

Concerning the *filing date requirements*, the Committee of Experts, in general, found the principles of a solution submitted by the International Bureau (see page 320, below) acceptable. Since the majority of the Committee of Experts, at its first session held in 1985, had already agreed on the basic approach of providing, as a matter of principle, for both obligatory ("minimum") requirements (that is, requirements that must be provided for by every national law) and additional optional ("maximum") requirements (that is, requirements that may be provided for by any national law), the Committee of Experts this time focused on the substance of the proposed requirements.

It was generally agreed that the first among the proposed obligatory minimum requirements, namely that there must be an indication that protection for an invention was sought, would be satisfied by a request for the grant of a patent or another title of protection for an invention, such as an inventor's certificate, utility model or certificate of addition. As to the question whether the obligatory minimum requirement of an identification of the applicant should also include an indication of the applicant's address, it was argued that giving the applicant's address may be necessary in some, but not all, cases and that a solution should be formulated with this possible need in mind. Views were also divided as regards two further proposed obligatory minimum requirements, namely that the application must contain a part which, on its face, appeared to be a description, and a part which, on its face, appeared to be a claim or claims. Several delegations and representatives of organizations stated that what was important was that an application contain a disclosure of the invention in order to be accorded a filing date but that it was not necessary that such disclosure include a claim or claims. In conclusion, it was agreed that a compromise solution might consist of providing that any national law would, on the one hand, be free to require the

presence of a claim or claims in an application as a condition of according a filing date but would, on the other hand, be obliged to require the presence of a description as a condition of according a filing date.

With respect to the question of whether an application in the form of a telex merely identifying another application filed for the same invention in another country should be considered sufficient disclosure for purposes of according a filing date, it was suggested that a possible solution may be for the draft treaty to provide for a possibility of reservation, available to countries already accepting such applications, which would allow such countries to retain such a system but which would not allow other countries to adopt it.

Discussions also focused on the question of whether additional requirements for granting a filing date should not be permitted. One such requirement, which received much attention but with respect to which views were divided, was the possible requirement of the payment of filing fees. The majority of the Committee of Experts thought that there were other more appropriate methods for enforcing the payment of filing fees than by making the payment a condition for granting a filing date, particularly if it was considered that the philosophy behind the granting of a filing date was to accord a filing date as soon as sufficient disclosure of the invention, together with some indispensable elements of identification, were submitted.

As regards the *requirements in respect of the naming of the inventor and in respect of evidence to be furnished concerning the entitlement of the applicant* and the principles of a solution proposed with respect thereto by the International Bureau (whose text is reproduced on page 324, below), it was suggested that the indication of the name of the inventor should be requested to include both his family name and his given name. It was also suggested that it should be required that the inventor's address be indicated. It was furthermore suggested that national laws should be free to require that either the applicant or his representative make the declaration indicating the legal grounds of entitlement to file the application. It was also agreed to study further the question of whether the sanction for non-compliance with the requirements of naming the inventor and the declaration of entitlement should be that the application must be refused or must, instead, be deemed to have been withdrawn.

As regards the *requirements in respect of the manner of claiming in patent applications*, the memorandum prepared by the International Bureau had a relatively liberal approach, in order to facilitate the drafting and reading of claims. It was pointed out that harmonization in this field was of great interest to the users of the patent system. A number of detailed suggestions for the improvement of the proposal of the International Bureau were made.

On the question of the *requirements of unity of invention*, the International Bureau had made a proposal for the harmonization of the presently largely

divergent practices under national laws, in order to facilitate the drafting of patent applications. The usefulness of harmonization in this field was recognized, and several suggestions were made in respect of the International Bureau's proposal. It was generally agreed that the principle, proposed by the International Bureau, according to which a patent application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept, was acceptable. Additional information was requested from governments, particularly on the actual practice of their industrial property offices, since the differences among the various countries seemed to consist in the practical application of the general principle of unity of invention (which appeared to be similar in the various countries). It was stressed that any draft provision on unity of invention should be supplemented by guidelines for its interpretation and application, for consideration with the draft treaty.

As concerns the *extension of patent protection of a process to the product obtained by that process and proof of infringement of a process patent*, the solution proposed by the International Bureau was that the Treaty should require such an extension, as well as the reversal of the burden of proof in the case where the process is for the manufacture of a new product. That solution was in general considered as acceptable.

However, there were differences of opinion on certain details. In connection with the reversal of the burden of proof, views were divided on the questions whether that reversal should apply only where the defendant's product is identical to the one described in the process patent and whether the product had to be new. As regards the question of whether products had to be obtained directly by the patented process in order to be covered by the proposed, extended process patent protection, there was a general view that this should be the rule.

As regards the *prior art effect of previously filed but yet unpublished patent applications*, the Committee of Experts, in general, took a favorable view of the principles of a solution submitted by the International Bureau, according to which the treaty would require that Contracting States consider the whole contents of a patent application, to the extent that they are subsequently published, as prior art from the filing date or the priority date of the application.

As regards the meaning of "whole contents," it was suggested that the prior art effect of previously filed but yet unpublished patent applications should be dated back to the priority date only with respect to subject matter which had also been disclosed in the priority application and that the filing date should be the effective date for prior art purposes for any other subject matter which had not been disclosed in the priority application.

Moreover, it was pointed out that the proposed solution should make it absolutely clear that previously filed but yet unpublished patent applications were

meant to be taken into account as prior art only for purposes of determining novelty and not for purposes for evaluating inventive step.

In addition, it was suggested that the proposed solution should include measures to prevent that a conflict between several patent applications filed by the same applicant cause the applicant to destroy the novelty of his own invention merely by reason of having described his invention in a patent application previously filed by him but not yet published.

In conclusion, the Committee of Experts agreed that the questions discussed deserved a continued effort of harmonization at the international level. In endorsing the continuation of the work of the International Bureau, the Committee of Experts also agreed that other possible topics for inclusion in the draft treaty should be studied, such as exclusion of certain categories of inventions from patent protection, interpretation of patent claims, duration of patents, first-to-file versus first-to-invent principle, manner of description, and rights conferred by the patent. The International Bureau would proceed to revise, in the light of the suggestions made by the Committee of Experts, the proposed provisions in the draft treaty and, on the basis of the principles of solutions and taking into account the discussions by the Committee of Experts, prepare draft provisions on those questions for which draft provisions have not yet been elaborated. The possibility would also be examined of including certain details in implementing regulations, with supporting guidelines to secure a uniform interpretation of the draft treaty and its implementing regulations. The revised text of the draft treaty as well as memoranda on one or several of the new topics to be studied would be submitted to the Committee of Experts at its next session.

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### REQUIREMENTS IN RESPECT OF THE GRANTING OF A FILING DATE TO A PATENT APPLICATION

#### Memorandum by the International Bureau of WIPO

This document contains a revised version of the memorandum (document HL/CE/1/4) submitted to the first session (Geneva, July 1985) of the Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions. It takes into account the comments made during the said session.

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### I. Introduction

1. Patents<sup>1</sup> are granted by the competent authority of each country, or by a competent intergovernmental authority, as a consequence of the filing of applications requesting such grants. Without an application, no patent will be granted. Applications may be filed either with the national or intergovernmental authority that is competent for the grant (hereinafter referred to as "industrial property office") or—under the Patent Cooperation Treaty (PCT)—with a receiving Office under the PCT.

2. The date of filing of an application for a patent is of importance in several respects.

(i) In the countries applying the "first-to-file" system, the date of filing determines the priority between two conflicting applications.

(ii) Under the great majority of national laws and the European Patent Convention, it is the date of filing on which compliance with the patentability requirements of novelty of the invention and of inventive step must exist (under the law of the United States of America, the said patentability requirements must be complied with on the date on which the invention was made; but even under that law, an invention loses its novelty if it is patented or described in a printed publication or disclosed in the country (namely, the United States of America) through public use or sale more than one year (the "grace period") before the date of filing of the application in the United States of America).

(iii) Under the Paris Convention for the Protection of Industrial Property (hereinafter "the Paris Convention"), the date of filing determines the right of priority according to Article 4, and this in two respects, namely, as regards the first filing in a country of the Paris Union and as regards subsequent filings in other countries of the Paris Union, which must be made within 12 months from the first filing.

(iv) In a number of countries, the duration of a patent is counted from the date of filing.

(v) Some countries charge maintenance fees for pending applications at points in time which are calculated from the date of filing.

(vi) Some countries publish pending applications at a point in time which is calculated from the date of filing (or the date of priority under the Paris Convention).

(vii) In some countries, substantive examination of an application depends on a request which must be made within a certain period from the date of filing.

<sup>1</sup> In this memorandum, "patents" means both patents for inventions and inventors' certificates, and "patent applications" means both applications for patents for inventions and applications for inventors' certificates. Whether other titles of protection for an invention, such as registrations of utility models and utility certificates, are to be included, will be studied later.

(viii) In some countries, compulsory licenses may be granted if the patented invention is not worked but, under Article 5A of the Paris Convention, such a compulsory license may not be applied for before the expiration of four years from the date of filing (or three years from the date of grant of the patent, whichever period expires last).

3. Bearing in mind the above-mentioned important legal consequences of the filing date of an application, for both the applicant and third parties, it is highly desirable if not necessary that the filing date be established and notified to the applicant and published so that third parties can take cognizance of it. Under some laws, the establishment of a filing date is merely implicit—that is, it is not separately communicated to the applicant but is indicated in the granted patent, or in the publication of the pending application. But in the absence of a grant or such a publication, the filing date can be found only in the files of the application. In any case, the authority competent for the grant of the patent must make a determination as to the date of filing of the application. For the purposes of this Report, the decision leading to the determination of the filing date is referred to as “granting a filing date,” even if the decision is only an implicit one and is made known to the public only on the occasion of granting the patent or publishing the pending application.

4. In order to illustrate the complexity of the problem dealt with in this Report, the following example may be given: an industrial property office receives on a particular date a signed letter, the essential part of which reads as follows: “I have invented a new type of combustion engine, for which I request a patent”; the industrial property office sends an application form and information on the filing of patent applications to the author of the letter; the inventor returns the form, filled in but without his signature, accompanied by a description of the invention but not by claims; upon a reminder by the industrial property office, he sends a copy of the form as filled in with his signature and a text which can be considered as claims but no copy of the description; later, he submits two drawings showing the combustion engine and amends his claims. The following questions arise: What is the filing date of the application? Is it the date of receipt of the first letter, the date of receipt of the unsigned form with the description, the date of receipt of the copy of the signed form with the text that can be considered as claims? Or the date of receipt of the drawings and the amended claims? Does it matter that the first letter was signed whereas the application form was not signed? And does it matter that the copy of the signed form was not accompanied by a copy of the description? All these questions are of a legal nature; in order to answer them, rules of law must be applied. Those rules—whether contained in express provisions or the result of established practices without express provisions—govern the question of which requirements must be fulfilled on a particular date in order to consider that date as the filing date of the application.

5. The decision to grant a filing date is a task of the industrial property office with which the application was filed. As already said (see paragraph 3, above), such decision may be explicit or implicit. It is not necessary, however, that the said decision be made on the very date on which all the requirements for granting the filing date are complied with. The decision may well be taken at a later stage; it may, once taken by the industrial property office, be corrected by a court in an appeal procedure against a refusal by the industrial property office to grant the requested patent, or in a procedure for invalidation of the granted patent. Thus, it does not matter *when* the decision for granting the filing date is taken (although, in order to advance the further processing of an application, such decision should be taken by the industrial property office as early as possible); what matters is that the decision states that, on a particular date, all the requirements

were fulfilled in order to consider that date as the filing date of the application.

6. It is important to distinguish the decision on granting a filing date from the decision on the compliance with all requirements (which include requirements not relevant for the granting of the filing date) that an application has to comply with to be entitled to the grant of a patent or other title for the protection.

## II. Purpose of the Memorandum

7. The purpose of this memorandum is to examine the existing requirements in respect of granting a filing date and the possibility of finding a uniform solution which could easily be applied by national and regional industrial property offices, and which would have the advantage that applicants do not have to comply with a number of different requirements if they seek protection in several countries. The solution to be proposed for adoption should be the same for the largest number of countries. In this connection, reference is made to the significant achievements in respect of the harmonization of certain provisions of patent law, already obtained as a consequence of the Patent Cooperation Treaty (PCT) (1970) and the European Patent Convention (1973).

## III. Existing Legislative Provisions

### A. Information Used in the Present Memorandum

8. Before any uniform solution is proposed, the existing requirements in respect of granting a filing date must be examined. For this purpose, the following information has been taken into account:

(i) the provisions of the Patent Cooperation Treaty (PCT);

(ii) the provisions of the European Patent Convention (EPC) and of the legislation (laws, regulations, etc.) of those eight countries in which or for which, according to the statistics published by WIPO (IP/STAT/1983/B), more than 10,000 titles of protection for inventions were granted in 1983. Those countries are Canada (20,999), France (25,043), Germany (Federal Republic of) (20,913), Japan (54,701), the Soviet Union (74,200), Switzerland (11,768), the United Kingdom (28,254) and the United States of America (56,862). The figures in parenthesis following the names of all States except the Soviet Union indicate the number of patents granted in 1983; the figure concerning the Soviet Union represents the total number of patents and of inventors' certificates granted in 1983.

9. In general, the present memorandum is based on legislative provisions (treaties, laws, regulations, etc.) and only exceptionally takes into account the interpretation given to the said provisions by courts and industrial property offices or the practice of industrial property offices. The present memorandum only presents a short summary of the said provisions; the summaries have not been verified by the industrial property offices concerned. Moreover, each summary only mentions the requirements that are relevant for the purposes of this memorandum but not those of the—altogether 13 (see paragraph 45, below)—requirements which do not apply.

### B. The Patent Cooperation Treaty (PCT)

10. Under Article 11(1) of the PCT, the receiving Office has to accord as the “international filing date” the date of receipt of the international application if it finds that, in addition to the requirements concerning entitlement of the applicant, in view

of his residence or nationality, to file an international application and in respect of the prescribed language, the international application contains at least the following elements:

- (i) an indication that it is intended as an international application;
- (ii) the designation of at least one Contracting State;
- (iii) the name of the applicant, as prescribed;
- (iv) a part which on the face of it appears to be a description;
- (v) a part which on the face of it appears to be a claim or claims.

11. If all requirements are fulfilled, the receiving Office notifies the applicant of the international filing date (see Rule 20.5 of the PCT Regulations); otherwise, the receiving Office invites the applicant to file the required correction; if the applicant complies with the invitation, the date of receipt of the required correction is accorded as the international filing date (see Article 11(2)(a) and (b) of the PCT and Rule 20.6 of the PCT Regulations); if the applicant does not comply with the invitation, the receiving Office notifies him that his application is not and will not be treated as an international application (see Rule 20.7 of the PCT Regulations). If the international application refers to drawings which, in fact, are not included in that application, and those drawings are not furnished or are furnished after the prescribed time limit (of 30 days), the filing date will be established on the basis of the other elements of the application, and any reference to drawings will be considered non-existent. Where drawings are furnished later, but within 30 days from the filing of the other elements of the application, the date of submission of the drawings will be the filing date of the application (see Article 14(2) of the PCT and Rules 20.2 and 26.6 of the PCT Regulations).

12. As regards the effect of the international filing date, Article 11(3) of the PCT provides that an international application which has been accorded an international filing date has the effect of a regular national application in each designated State as of the international filing date, which date is to be considered to be the actual filing date in each designated State.

### C. European Patent Convention and National Legislation

13. *European Patent Convention.* Under Article 80 of the European Patent Convention (EPC), the date of filing of a European patent application is the date on which documents filed by the applicant contain:

- (i) an indication that a European patent is sought;
- (ii) the designation of at least one Contracting State;
- (iii) information identifying the applicant;
- (iv) a description and one or more claims in one of the prescribed languages even if the description and the claims do not comply with other requirements of the Convention.

If any drawings referred to in the description or the claims are not filed on the date of filing of the application and no steps are taken to correct the deficiency, either the application is related to the date of filing of the drawings or any reference to the drawings in the application is deemed to be deleted, according to the applicant's choice (Article 91(6) EPC).

14. Under Article 14(1) and (2) of the EPC and Rule 6 of the EPC Regulations, in order to obtain a date of filing, a European patent application must, in principle, be filed in one of the official languages of the European Patent Office (EPO), namely, English, French or German; however, applicants that have their residence or principal place of business in a Contracting State of the EPC having a language other than English, French or German as an official language and nationals of that State who are resident abroad may file European patent applications in an official language of that

State, provided that a translation in one of the official languages of the EPO is filed within three months after the filing of the application, but not later than 13 months from the date of priority. If the above requirements are not complied with, the EPO informs the applicant of the deficiencies, inviting him to make the required correction within one month; if the applicant makes the required correction within one month, the EPO informs him of the date of filing (which is the date of receipt of the correction) (see Rule 39 of the EPC Regulations). If no corrections are required, there is an implicit decision of the EPO on the filing date, which latter is subsequently published together with the publication of the application.

15. The EPC has adopted the "first-to-file" system. Thus, the filing date is the date on which the patentability requirements of novelty and inventive step must be fulfilled (unless a Paris Convention priority has been claimed, in which case it is sufficient that the said requirements were fulfilled at the priority date) (see Articles 54(1) and (2), 56 and 89 EPC); moreover, the filing date is relevant for the date of publication of a European patent application (except where a Paris Convention priority has been claimed), for the payment of renewal fees for European patent applications and for the term of European patents (see Articles 63, 86 and 93 EPC).

16. *Canada.* Section 32(1) of the Patent Rules under the Patent Act, 1952, as amended in 1982, stipulates that the filing date of an application is the date when (a) the filing fee has been paid and (b) the following documents relating to the application have been filed:

- (i) a petition executed by the applicant or a patent agent on his behalf;
- (ii) a specification, including claims;
- (iii) any drawing referred to in the specification;
- (iv) an abstract of the disclosure, which abstract may be inserted at the beginning of the specification.

As regards the specification, Section 20 of the Patent Rules prescribes that it must be either wholly in English or wholly in French. From this provision it can be concluded that other languages are not admitted; however, the question whether a filing date can be granted if the specification is in English and the claims in French (or vice versa) does not seem to have been considered. As regards the abstract, a filing date may be granted even if it is missing, provided the industrial property office is satisfied that it would be unjust not to do so (see Section 31(2) of the Patent Rules).

17. If any of the essential requirements are not fulfilled, they will be called for by the industrial property office within the time limit of one to three months. The filing date is granted only when the essential requirements are met.

18. In view of the fact that Canada has adopted the "first-to-invent" principle, the filing date is only indirectly of importance for the determination of the novelty and inventive step of an invention, namely, in that certain disclosures of the invention are non-prejudicial only if made within a certain period before the filing date (see Section 28 of the Patent Act, 1952, as amended in 1972). The filing date of an application filed in Canada, however, is relevant for any subsequent applications in other Paris Union countries, if the priority of the Canadian application is to be claimed.

19. *France.* Under Section 13 of the Patent Law, as last amended and supplemented in 1978, the filing date of a patent application is the date on which the applicant has produced documents containing:

- (i) a statement that an industrial property title is sought;
- (ii) information identifying the applicant;

- (iii) a description and one or more claims, even if the description and the claims do not comply with the other requirements of the Law.

The said documents must be in the French language (see Section 6 of the Decree on Applications for Patents and Utility Certificates and the Grant and Maintenance in Force of Such Titles, as last amended in 1982); however, applications filed by nationals of countries providing an equivalent treatment to French nationals or by natural persons or legal entities to whom an application filed in a foreign country granting equivalent treatment to French nationals or a right of priority under such an application has been assigned may be filed in foreign languages, provided that a French translation is filed within three months from the filing date; the Minister of Foreign Affairs and the Minister responsible for industrial property draw up a list of countries regarded as granting equivalent treatment and determine the national language or that of the national languages in which nationals of those countries may effect filings (see Section 14 of the Decree).

20. According to Section 6 of the above-mentioned Decree, the benefit of the filing date is granted even if the documents referred to in paragraph 19 have formal defects. Where one of those documents is missing, the applicant is invited to complete the patent application within one month. If the applicant complies with this invitation, the filing date is that on which the application was completed, and the applicant is notified accordingly. Otherwise, the application is declared unacceptable.

21. If drawings are filed after the filing date, as defined in the Law, the applicant is informed that the drawings and the references to the drawings in the application are removed unless, within one month, he submits a request for the grant of a patent bearing the date of filing of the drawings. If the drawings have not been filed, the applicant is invited to submit them within one month and the filing date is the date on which the drawings were submitted; otherwise the references to the drawings are removed (see Section 7 of the above-mentioned Decree).

22. Since France applies the "first-to-file" system, the importance of the filing date for the novelty and the inventive step of an invention is essentially the same as under the European Patent Convention. Moreover, the filing date of the application may be relevant for the date of the publication of the application (see Section 17 of the Law), for the payment of annual fees for the maintenance in force of patent applications or patents (see Section 3(1) of the Law) and for the term of protection of a patent (see Section 94(4) of the Decree). Finally, after the expiration of a period of three years from the grant of a patent or of four years from the filing date of the application, a compulsory license for non-working of the patented invention may be applied for (see Section 32 of the Law).

23. *Germany (Federal Republic of)*. Since neither the 1981 Patent Law nor the 1981 Implementing Ordinance set out conditions for assigning a filing date to an application, case law has had to provide a basis and establish the practice followed by the German Patent Office. In addition to the requirement that filing must be in writing and in the German language (see Sections 35 and 126 of the Law), the application must contain, in accordance with the said practice:

- (i) a statement that a patent is sought;
- (ii) information identifying the applicant;
- (iii) disclosure of the invention enabling a person skilled in the art to understand it and to carry it out.

24. As regards late submission of drawings, this does not affect the filing date; however, the later submitted drawings are treated as an alteration of the application and as such,

according to Section 38 of the Patent Law, are admissible only to the extent that they do not broaden the scope of the subject matter of the application.

25. According to the practice of the German Patent Office, the applicant is notified of the granting of the filing date or of any defects requiring correction.

26. Since the Federal Republic of Germany applies the "first-to-file" system, the importance of the filing date for the novelty and the inventive step of an invention is essentially the same as under the European Patent Convention. Moreover, the filing date of the application may be relevant for the date of the publication of the application (see Sections 31(2) and 32(5) of the Patent Law of 1981), for the payment of annual fees for pending applications and patents (see Section 17(1) and (3) of the Patent Law) and for the term of protection (see Section 16(1) of the Patent Law).

27. *Japan*. Although not specifically mentioned in the Law, in practice the applicant must fulfill the following conditions as requirements for the granting of a filing date in respect of his application:

- (i) the kind of title of protection which the applicant seeks must be indicated;
- (ii) the name or appellation of the applicant must be indicated;
- (iii) the applicant or his or her representative (e.g., patent attorney, patent administrator) must have an address in Japan;
- (iv) text matter and drawings must be indelible (for example not erasable such as writing in pencil);
- (v) the documents must be submitted in the Japanese language;
- (vi) the application must contain at least one claim and a description;
- (vii) in case of divisional applications or conversion applications, the time limits for division or conversion must be met;
- (viii) for utility model applications, a drawing or drawings must be submitted, together with the specification, at the time of filing.

28. Upon receipt of the application, the Japanese Patent Office notifies the applicant of the filing date and number of the application; such notification is provisional and becomes definitive if the applicant receives no further notice of non-acceptance or invalidation of the application.

29. Since Japan has adopted the "first-to-file" system, the filing date is important for the determination of the novelty and the inventive step of an invention. Moreover, the filing date is important for the date of the laying open of an application for public inspection (see Section 65*bis*(1) of the Patent Law of 1959, as last amended in 1985) and for the calculation of the term of the patent, which is 15 years from the publication of the patent application but not more than 20 years from the filing date (see Section 67(1) of the Patent Law).

30. *Soviet Union*. In order to be accorded a filing date ("accepted for examination"), an application must comply with the following conditions and be accompanied by the following documents (see Section 44 of the Statute on Discoveries, Inventions and Rationalization Proposals of 1973, as amended in 1978 (hereinafter referred to as "the Statute") and Articles 18, 22, 26, 30 and 31 of the Instructions on Compiling Applications for Invention (EZ-1-74), adopted by the USSR State Committee for Inventions and Discoveries in 1974, as amended until 1981 (hereinafter referred to as "the Instructions (EZ-1-74)")):

- (i) a request for the grant of an inventor's certificate or a patent;

- (ii) a description of the invention together with the claims;
- (iii) drawings, diagrams, reports on trials and other material illustrating the alleged invention, if necessary for the most complete disclosure of the essence and importance of the invention;
- (iv) a certificate attesting the creative participation of each of the joint inventors in the elaboration of the invention, or, in case of foreign applicants, a statement of authorship signed by all authors of the invention;
- (v) an abstract containing a summary of the disclosure as contained in the description of the invention, the claims and other material of the application, including the indication of the field to which the invention pertains and the potential use or uses of the invention;
- (vi) evidence of payment of the application fee (where a patent is requested).

All documents must be signed by the applicant; if the applicant is not the inventor, a legalized certificate of succession in title must be presented and the inventor(s) must be designated (by indicating his or their full name(s), address(es), place(s) of work, nationality); the application must be in the Russian language or accompanied by a Russian translation (Article 22 of the Instructions (EZ-1-74)). Foreign applicants must submit applications through the USSR Chamber of Commerce and must present a legalized power of attorney, authorizing the USSR Chamber of Commerce to act on their behalf.

31. Section 47 of the Statute provides for the grant of the date on which an application was received by the USSR State Committee for Inventions and Discoveries as its filing date, if the preliminary examination (to be carried out within 15 days from the date on which the application was actually received by the USSR State Committee for Inventions and Discoveries) concludes that the application is accepted for examination; the applicant is given a certificate to this effect. If the USSR State Committee for Inventions and Discoveries finds that an application may not be rejected on the grounds provided for in Articles 30 and 31 of the Instructions (EZ-1-74), but if still other corrections or amendments have to be made, the State Committee informs the applicant of the deficiencies, inviting him to correct and amend his application within two months from receiving such invitation, in order to preserve as the filing date for his application the date on which it was originally received by the USSR State Committee for Inventions and Discoveries. Otherwise, the application is deemed not to have been filed (see Section 47 of the Statute and Article 32 of the Instructions (EZ-1-74)).

32. In the Soviet Union the "first-to-file" system has been adopted. Thus, the filing date is the date on which the patentability requirement of novelty must be fulfilled (unless a Paris Convention priority has been claimed, in which case it is sufficient for the said requirement to have been fulfilled at the priority date (see Sections 21, 50, 52 and 53 of the Statute); moreover, the filing date is relevant for the term of protection (see Sections 26 and 31 of the Statute), for the payment of renewal fees (see Decree No. 416 of the Council of Ministers of the USSR of June 3, 1976), for the term within which the State scientific and technical examination has to be completed and the term within which the applicant has to be informed of the decision as to the grant or refusal of an inventor's certificate or a patent (see Section 48 of the Statute).

33. *Switzerland.* Under Section 56(1) of the Federal Law on Patents for Inventions and in accordance with Section 46(1) of the Ordinance on Patents for Inventions of 1977 (Patent Ordinance), a filing date is assigned to a patent application:

- (a) if it is filed in an official language; and

(b) if it contains:

- (i) a request for the grant of a patent;
- (ii) a description of the invention;
- (iii) one or more claims;
- (iv) the drawings to which the description or claims refer;
- (v) indications whereby the applicant may be identified.

Moreover, the request must bear a valid signature; in the absence of a signature, the date of submission of an unsigned request is recognized on condition that, at the request of the industrial property office, the defect is remedied within 14 days (see Section 3(2) of the Patent Ordinance).

34. According to Section 46(3) of the Patent Ordinance, if the requirements mentioned in paragraph 33 are not met, the industrial property office regards the application as not having been filed. It returns the documents filed to the applicant, if he is identified, or gives him the opportunity of meeting the conditions still required for the assignment of the filing date. As regards missing drawings, the applicant will be invited to supply them or to request, for the purpose of ensuring the maintenance of the filing date, that the reference to the drawings concerned be regarded as not having been made (see Section 46(4) of the Patent Ordinance). Once the filing date has been established (after corrections or not), the office issues a certificate of filing to the applicant (see Section 46(5) of the Patent Ordinance).

35. Since Switzerland applies the "first-to-file" system, the importance of the filing date for the novelty and the inventive step of an invention is essentially the same as under the European Patent Convention; moreover, the filing date is relevant for the calculation of the term of the patent (see Section 14(1) of the Federal Law on Patents for Inventions of 1954, as revised in 1976) and for the payment of the annual fees for keeping the patent in force (see Section 42(1) of the Federal Law). Finally, after a period of three years from the date of grant of a patent, but not earlier than four years after the filing of the application, a compulsory license for non-working of the patented invention may be applied for (see Section 37(1) of the Federal Law).

36. *United Kingdom.* Under Section 15(1) of the Patents Act 1977, the date of filing an application for a patent is taken to be the earliest date on which the following conditions are satisfied in relation to the application:

- (i) the documents filed at the Patent Office contain an indication that a patent is sought in pursuance of the application;
- (ii) those documents identify the applicant or applicants for the patent;
- (iii) those documents contain a description of the invention for which a patent is sought (whether or not the description complies with the other provisions of the Act and with any relevant rules);
- (iv) the applicant pays the filing fee.

An application filed in a language other than English will be accorded a filing date but it will not, except in very rare circumstances, be allowed to proceed unless it is accompanied at the time of filing by a verified translation into English (Rule 113(1) of the Patents Rules, 1982).

37. Where drawings mentioned in the application are filed after the filing date, the applicant will be given a period of one month to elect that the application be redated to the date on which the drawings were filed; if he does not so elect, the drawings and any reference to them will be treated as omitted. In the case where drawings referred to in the application were not filed, the applicant will be invited to file them within one month; if he does not do so, the reference to the drawings will

be treated as omitted. (Section 15(2) and (3) of the Patents Act 1977 and Rule 23 of the Patents Rules, 1982).

38. Once the filing date has been accorded (after corrections or not), it is communicated to the applicant, according to the administrative practice of the Office.

39. Since the United Kingdom applies the "first-to-file" system, the importance of the filing date for the novelty and the inventive step of an invention is essentially the same as under the European Patent Convention. Moreover, the filing date of the application may be relevant for the date of the publication of the application (see Section 16 of the Patents Act and Rule 27 of the Patents Rules), for the payment of patent renewal fees (see Rule 39 of the Patents Rules) and for the term of the patent (see Section 25(1) of the Patents Act).

40. *United States of America.* Title 37 of the Code of Federal Regulations (Patents, Trademarks and Copyright) (37 CFR), as revised in 1984, sets out, in Section 1.53, the minimum conditions to be met by an application for a patent so that a filing date may be accorded to it, by providing that the filing date is the date on which the following are filed with the Patent and Trademark Office on behalf of the actual inventor or inventors:

- (i) a specification containing a description and at least one claim;
- (ii) any drawings where these are necessary to understand the invention for which a patent is sought.

An application may be filed in a language other than English (see 37 CFR 1.52(d)).

41. The decision on the granting of a filing date is notified by the industrial property office to the applicant (see 37 CFR 1.54(b)). In this respect, Section 503 of the Manual of Patent Examining Procedure (Original Fifth Edition, 1983) contains the following additional instruction: "An application is entitled to a filing date as of the date of the identification of all of the inventors and receipt of the specification, including claims, and any required drawing. However, the filing receipt will not be mailed until the oath or declaration and basic filing fee have also been received. The oath or declaration and filing fee may be filed later than the remaining application papers, but if so, they must be accompanied by the required surcharge. If the oath or declaration, and/or filing fee, and appropriate surcharge are not timely filed, the application will be abandoned and no filing receipt will be mailed. Otherwise, the filing receipt will be mailed upon the timely receipt of the oath or declaration, and/or filing fee and surcharge."

42. As regards the legal importance of the filing date under the patent law of the United States of America, taking into account the "first-to-invent" system adopted by it, there is the provision, contained in Section 102(b) of Title 35 of the United States Code (Patents), according to which no patent may be granted if the invention was patented or described in a printed publication in the United States of America or abroad or in public use or on sale in the United States of America more than one year prior to the date of application. Moreover, the filing date is important for the prior art effect of patent applications according to Section 102(e) of Title 35. In addition, the filing date of an application filed in the United States of America is relevant for any subsequent applications in other Paris Union countries, if the priority of the application filed in the United States of America is to be claimed.

#### *D. Comparative Analysis*

43. When comparing the requirements for granting a filing date, referred to in the preceding chapter, it is obvious that a distinction must be drawn between the PCT, on the one hand,

and the European Patent Convention and the national legislation of the countries covered by the present memorandum, on the other. The PCT sets an international standard for the determination of the filing date, in particular because of its objective of establishing the same filing date in respect of an international application, with effect in all designated countries. In contrast, the European Patent Convention and national legislation only deal with the determination of a filing date in relation to their own specific procedure (although the filing date has an international aspect, in view of the priority right under Article 4 of the Paris Convention). Therefore, as a general observation, it can be stated that the provisions of the PCT and the Regulations thereunder, as regards the conditions and procedure for granting a filing date, the communication of that date to the applicant as well as its publication, are by far more elaborate than the provisions of any of the national legislations covered by the present memorandum; even countries which typically provide for a filing date, the communication of that date to the applicant as well as its publication, are by far more elaborate than the provisions of any of the national legislations covered by the present memorandum; even countries which typically provide for a rather complete regulation of the conditions and procedures concerning the grant of patents, such as Germany (Federal Republic of) and Japan, have scarce provisions as regards the granting of a filing date. On the other hand, the PCT does not regulate all the legal consequences of the granting of an international filing date, since the specific purpose of the PCT is to cover the application procedure and the preparation of reports relevant for the grant of a patent or other title for the protection of an invention but not to regulate the conditions and effects of that grant; indeed, in respect of the legal consequences of the international filing date, the PCT refers to the national laws of the designated States.

44. In the preceding chapter, not only the requirements for granting a filing date, but also the procedure for the granting of that date (including an invitation to make required corrections and the making of such corrections), the communication of the decision on the filing date to the applicant and the publication of such a decision, as well as the legal consequences of the filing date, have been covered. However, the scope of the present memorandum is limited to the question of the requirements of the filing date. In addition, it covers the procedure for correcting defects, in particular the invitation to be issued by an industrial property office to the applicant, notifying him of the defects to be corrected and the time limit for correction. As regards the procedure for the granting of the filing date and the communication of the decision on the filing date to the applicant as well as its publication, it is not proposed, for the time being, to enter into an effort of harmonization, since these aspects form part of the broader subject of communications between an applicant and the industrial property office, which should be considered as a whole and not in parts singled out for specific purposes. The same applies to the question of the legal consequences of the filing date: harmonization here would, in practice, mean that the basic features of all patent laws (in particular, as regards the "first-to-file" system and the "first-to-invent" system) would have to be harmonized—a task which, for the time being, does not appear to have much chance of being completed without delays and difficulties. Therefore, the following comparison only deals with the requirements of granting a filing date. Moreover, it does not deal with the question whether a filing date is established on the basis of the actual receipt of the application by an industrial property office or on the basis of a mailing certificate where the date of mailing is considered as the date of filing; this question is not relevant for the present memorandum but may deserve examination in a separate study.

45. For the purposes of comparison, each of the several requirements for granting a filing date which are provided for

in the PCT, in the European Patent Convention and in the national legislation of either all or some of the countries covered by the present memorandum has to be considered separately. The *first* of those requirements concerns the entitlement of the applicant, in view of his residence or nationality, to file an application. The *second* requirement concerns the language in which the application is filed. The *third* requirement relates to the petition, that is, the statement that a patent (or another title of protection for an invention) is requested; under the PCT, (see Rule 4.2 of the PCT Regulations), the petition is to the effect that the international application be processed according to the Patent Cooperation Treaty. The *fourth* requirement is relevant only for the PCT and the European Patent Convention; it concerns the designation of at least one Contracting State (either of the PCT or of the EPC); such a designation is not required under a national procedure, since it is clear that, if a patent is applied for, that patent is to be granted only for the country in question; thus, it is not further considered here. The *fifth* requirement concerns the identification of the applicant. The *sixth* requirement concerns the submission of a text which can be considered as a description of the invention, or which at least, on the face of it, appears to be a description. The *seventh* requirement concerns the submission of a text which can be considered as claims, or which at least, on the face of it, appears to be a claim or claims. The *eighth* requirement concerns the submission of drawings as a condition for granting a filing date. The *ninth* requirement concerns the submission of an abstract as a condition for granting a filing date. The *tenth* requirement concerns the naming of the inventor, where the applicant is not the inventor, or the naming of co-inventor(s) and the furnishing of relevant evidence. The *eleventh* requirement concerns representation by an agent. The *twelfth* requirement concerns the signature of the applicant or his agent under the request. The *thirteenth* requirement concerns the payment of the prescribed fee(s).

46. *Entitlement to file.* Only the PCT provides for this requirement.

47. *Language.* With the exception of the United States of America, the requirement of filing in the prescribed language(s) is considered as a condition for granting a filing date by the countries covered by the present memorandum and by the PCT. Under the national laws of Denmark, France, Hungary and the Netherlands, filing of patent applications in certain foreign languages is admitted, with the proviso that a translation had to be submitted shortly after filing. As regards the European Patent Office, reference is made to paragraph 14, above.

48. *Petition.* This is the applicant's request that his application be treated as a request for the grant of a patent or another title of protection provided for in the applicable national law or regional convention. Under the PCT, the EPC and practically all national laws covered in this memorandum, with the exception of that of the United States of America, the petition—which may be an express or an implied one—is considered as an essential condition for the granting of a filing date by the industrial property office.

49. *Identification of the applicant.* Rule 20.4(b) of the PCT Regulations stipulates that, for according an international filing date, it is sufficient to indicate the name of the applicant in a way which allows his identity to be established even if the name is misspelled, the given names are not fully indicated or, in the case of legal entities, the indication of the name is abbreviated or incomplete. Although the EPC and the majority of national laws covered in this memorandum appear to apply the same requirements as the PCT in respect of information identifying the applicant, it should nevertheless be noted that in Canada there does not seem to exist a specific

provision on this matter and that, on the other hand, under the Japanese law the applicant must communicate, in addition to the name, an address for service in Japan, such requirement, however, being considered to be complied with where the address of the agent is indicated. As regards the situation in Canada, although the requirement to state the name of the applicant is not explicitly mentioned in the relevant provisions, it is to be presumed that the name has to be given in "the petition executed by the applicant."

50. *A part which on the face of it appears to be a description.* Under the PCT (Article 11(1)(iii)(d)), it is sufficient for the granting of the international filing date that the application contain a part which, on the face of it, appears to be a description. The requirements laid down by the EPC and by the French and United Kingdom laws are the same, although formulated differently. They require a description to be furnished even if it does not comply with the other requirements of the Convention or of the law. The other countries covered by this memorandum simply require the provision of a description or a disclosure of the invention without specifying, however, that it is sufficient for this part of the application to appear on the face of it to be a description. Since the examination in connection with the granting of a filing date is an administrative examination carried out by administrative staff not in a position to evaluate the technical content of the patent application, it can be assumed that no country, in practice, would stipulate requirements for the purposes of this examination that go beyond those laid down by the PCT, since, in fact, the said requirement only serves as a basis for establishing the filing date but not as a basis for granting a patent.

51. *A part which on the face of it appears to be a claim or claims.* This requirement for the setting of a filing date is subject to the same observations, *mutatis mutandis*, as those expressed in the preceding paragraph in respect of the description, with the exception of Germany (Federal Republic of) and the United Kingdom, where the presentation of claims is not required as a condition for obtaining a filing date.

52. *Drawings.* Under the laws and regulations of Canada, France, the Soviet Union, Switzerland and the United States of America, drawings are required in order to establish a filing date, if they are referred to in the description or are necessary to understand the invention for which a patent is requested. Under the PCT, submission of drawings is not a condition for obtaining a filing date, but in case of late submission of drawings the date of such submission is the filing date (see above, paragraph 11). An approach similar to that provided for under the PCT with respect to late submission of drawings is followed in Germany (Federal Republic of), in the United Kingdom and in the United States of America.

53. With respect to utility model applications, under the law of Japan the presentation of drawings constitutes a condition for granting a filing date. However, in respect of utility model applications filed under the PCT, it is possible to file drawings only when entering the national phase if the international application did not contain drawings at the time of filing.

54. *Abstract.* An abstract is required for granting a filing date by the laws of Canada ("a notice of disclosure") and the Soviet Union.

55. *Naming of the Inventor and Evidence.* Except for the law of the Soviet Union, the identification of the inventor by an applicant who is not the inventor is not a requirement for granting a filing date.

56. *Representation.* Under the law of the Soviet Union, it is a requirement for granting a filing date to an application filed

by a foreign applicant that he be represented by the USSR Chamber of Commerce. In Japan the indication of an address for service in Japan is required (see paragraph 27(iii) above).

57. *Signature.* In the Soviet Union, the signature of the application by the applicant constitutes a condition for the granting of a filing date. In the other countries covered by this memorandum, the signature of the application is not relevant for granting a filing date.

58. *Fees.* Payment of the filing fee is required for the granting of a filing date by the laws of Canada, of the Soviet Union (in respect of an application for a patent) and of the United Kingdom. In other countries and under the PCT and the EPC, this requirement does not exist.

#### IV. Arguments in Favor of a Uniform Solution

59. The diversity of requirements provided for under the European Patent Convention and the legislation of the countries covered by this memorandum constitutes a serious difficulty for the users of the patent system, since it is necessary that they take into account widely different and complex requirements in respect of obtaining the grant of a filing date (unless they use the PCT, by which they can avoid such diversity). The requirements for granting a filing date vary from one country to another, and lack of knowledge and failure to comply with them may lead to the granting of a filing date which is later than the date of the actual filing, because the filing date is the date when any relevant defect has been corrected. Between the time of a filing with a defect preventing the grant of a filing date and the correction of the defect, the priority period under Article 4 of the Paris Convention may have expired, making a priority claim impossible. Moreover, during that interval, the relevant invention may be usurped or disclosed, not only in the country in which the filing was made, but also in other countries of the Paris Union in which, if a filing date had been granted in the first country, the applicant could have invoked the priority established in that country.

60. It is quite common for inventors to wish to obtain protection for the fruit of their research as rapidly as possible and, because of the pressure of time, to submit applications for titles of protection for which a filing date cannot be granted since the requirements of the country in which protection is sought have not all been complied with. It must be admitted, in defense of applicants, that it is not always easy to obtain detailed information on those conditions, particularly where they are not laid down in the national law or in the implementing regulations. Indeed, sometimes such conditions are mentioned in internal instructions or are simply established by practice in the office, which does not make it easier for applicants to obtain the necessary information. An internationally accepted uniform solution in respect of the requirements for granting a filing date would greatly facilitate the situation inventors have to face when they seek protection for their inventions in more than one country.

#### V. Desirability of Action at the International Level

61. It seems evident that it is desirable to take measures to find a uniform solution to the problem under examination in as many treaties and national laws as possible. Such action must take place at the international level. It could take the form either of an international treaty or of a recommendation adopted by a competent body, such as the Assembly of the Paris Union for the Protection of Industrial Property. While a recommendation might have the advantage that it can be adopted relatively easily, it has the disadvantage that it

probably would not create sufficient momentum for changing national laws and industrial property office practices. The adoption of treaty provisions would be much more adequate. Such provisions should be included in the envisaged treaty dealing also with other aspects of the harmonization of laws for the protection of inventions.

62. A certain degree of harmonization has already been achieved for a number of requirements. Thus, when comparing the filing date requirements stipulated by the PCT and those adopted by the countries considered, it can be noted, summarily, that:

(i) several countries covered in this memorandum require that the application be filed in the prescribed language or one of the prescribed languages;

(ii) the EPC and most of the countries covered in this memorandum require—either expressly or implicitly—a petition;

(iii) the EPC and all the countries covered in this memorandum require that the applicant should be identified;

(iv) the EPC and all the countries covered in this memorandum require a written or documentary disclosure of the alleged invention by the submission of a text which can be considered as a description;

(v) the EPC and several of the countries covered in this memorandum require that the application should contain at least one claim.

63. The provision to be included in the envisaged treaty would oblige the Contracting States to provide for certain minimum requirements in respect of granting a filing date to an application. The said requirements would be fixed so as to ensure a certain degree of uniformity in national legislations and could be the following:

(i) an express or implicit indication that the granting of a patent is sought;

(ii) an identification of the applicant;

(iii) a part which, on the face of it, appears to be a description;

(iv) a part which, on the face of it, appears to be a claim or claims;

(v) in the case of an international or regional application with possible effect in several States, the designation of at least one such State.

64. The treaty could contain a further provision allowing each Contracting State to provide in its national law certain precisely defined additional requirements in respect of granting a filing date. It would be understood that the said additional requirements, together with what is prescribed as a minimum, would constitute the "maximum" of the requirements which could be imposed by a Contracting State. The said requirements would be applicable also for granting a filing date to divisional or conversion applications.

65. The main advantage of such a solution would be that industrial property offices in all Contracting States would apply certain specific minimum requirements to be complied with for granting a filing date, which is important because the filing date constitutes the basis for international priority under Article 4 of the Paris Convention. Moreover, applicants would be aware of the requirements constituting the maximum which could be provided for under the national law of any Contracting State. The said maximum would consist of the minimum requirements and the precisely defined additional requirements. Compliance with all maximum requirements would give to applicants the certainty of obtaining a filing date in all Contracting States.

66. Under the said treaty, the additional requirements which could be provided for by a Contracting State for the

purposes of granting a filing date to an application and which, together with the minimum requirements referred to in paragraph 65, would constitute the maximum which could be required, would be the following:

(i) that the applicant does not lack, for reasons of residence or nationality, the right to file the application;<sup>2</sup>

(ii) that the application is filed in the prescribed language or in one of the prescribed languages.

67. The maximum solution set out here comes close to the requirements set by the PCT. If a Contracting State wishes to apply any of the maximum requirements referred to in paragraph 66, it should notify the Director General of WIPO accordingly.

68. It could be examined whether the maximum requirements should include the condition of payment of the filing fee as laid down in the laws of Canada, the Soviet Union and the United Kingdom. It should be noted, however, that the other countries included in this survey, following the solutions adopted in the PCT and the EPC, have relinquished the condition of payment of a filing fee in connection with granting a filing date. Therefore, it is suggested not to include the said condition.

69. As regards the furnishing of an abstract (required by the laws of Canada and the Soviet Union), the maximum solution does not include those requirements because an abstract does not seem to be necessary where a description is supplied.

70. Moreover, the maximum solution does not include the requirement of identification of the inventor as provided for in the law of the Soviet Union. This requirement appears to be too burdensome and unnecessary for granting a filing date. Reference is also made to the harmonization proposals contained in document HL/CE/II/2 Supp. 2 (entitled "Requirements in Respect of the Naming of the Inventor and in Respect of Evidence to be Furnished Concerning the Entitlement of the Applicant; Arguments in Favor of a Uniform Solution").

71. The maximum solution does not include the requirement of signature provided for in the law of the Soviet Union. In view of the widespread use of telex communications and future developments towards automatic filing procedures, the requirement of signature as a condition for granting a filing date would be an obstacle to modernization and would constitute a particular burden for applicants, which should not be sanctioned by an international treaty.

72. The treaty should provide for an obligation by industrial property offices to notify the applicant of any defect, and for a minimum time limit for correction of defects, with the effect that the date of receipt of the correction becomes the filing date. It is proposed to fix a minimum time limit of one month.

73. The treaty could include a provision on drawings referred to in the application but in fact not included, to the effect that the industrial property office may be obliged to notify the applicant of this defect, with the consequence that either the applicant corrects the defect within the fixed time limit of at least one month, in which case the filing date becomes the date on which the office received the missing drawing(s), or the references to the said drawings are considered as nonexistent.

<sup>2</sup> It is to be noted that, in applying this requirement, the Contracting States will have to respect the principle of national treatment with regard to applicants covered by Articles 2 and 3 of the Paris Convention.

## VI. Principles of a Solution

74. The principles of a solution to be embodied in an international treaty could be drafted as follows:

"(1) For the purposes of granting a filing date to an application, any national law shall require that the application contain at least the following elements:

(i) an express or implicit indication that protection for an invention is sought;

(ii) an identification of the applicant, which shall consist of an indication of his name;

(iii) a part which, on the face of it, appears to be a description;

(iv) a part which, on the face of it, appears to be a claim or claims;

(v) in the case of an international or regional application with possible effect in several States, the designation of at least one such State.

"(2)(a) For the purposes of granting a filing date to an application, any national law shall be free to require, in addition to the requirements laid down in paragraph (1),

(i) that the applicant does not lack, for reasons of residence or nationality, the right to file the application;

(ii) that the application be filed in a certain language or in one of certain languages.

(b) At the time of becoming party to this Treaty, any Contracting State whose national law contains one or both the requirements referred to in subparagraph (a) shall notify the Director General accordingly. Any change in the national law shall be promptly notified in the same manner.

"(3) No requirements in respect of granting a filing date that are additional to or different from those set forth in paragraphs (1) and (2)(a) shall be allowed.

"(4)(a) If the industrial property office finds that the application did not, at the time of receipt, fulfill the requirements for granting a filing date under the applicable national law, it shall invite the applicant to file the required correction within a time limit fixed by the industrial property office, which shall be at least one month.

(b) If the applicant complies with the invitation, the industrial property office shall grant as the filing date the date of receipt of the required correction.

"(5) Any national law shall be free to provide that, if the application refers to drawings which, in fact, are not included in the application, the industrial property office shall notify the applicant accordingly and that, if the applicant furnishes the drawings within the time limit fixed by the industrial property office, which shall be at least one month, the filing date shall be the date on which the drawings are received by the industrial property office and that, otherwise, any reference to the said drawings shall be considered as nonexistent."

\* \* \*

### REQUIREMENTS IN RESPECT OF THE NAMING OF THE INVENTOR AND IN RESPECT OF EVIDENCE TO BE FURNISHED CONCERNING THE ENTITLEMENT OF THE APPLICANT

#### Memorandum by the International Bureau of WIPO

This document contains a revised version of the memorandum (document HL/CE/I/3) submitted to the first session (Geneva, July 1985) of the Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions. It takes into account the comments made during the said session.

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## I. Introduction

1. Under most national laws, the applicant for a patent<sup>1</sup> has to indicate who is the (natural) person who made the invention, in other words, the applicant has to name the inventor.

2. The naming of the inventor usually is required even where the inventor himself is the applicant. However, it may be possible that an application is filed not by the inventor but by another person (or entity). For example, rights concerning an invention may be assigned by the inventor to another person or entity or transferred by succession. Moreover, under the laws of some countries, such rights may, from the outset, vest in a person or entity other than the inventor, for example, in the person having commissioned the invention or in the inventor's employer. In such situations and under such laws, the application is filed by a person or entity other than the inventor, that is, a person who or an entity which owns the rights in the invention, and that person or entity may be obliged—under the said laws—to declare that he or it (although not being the inventor) is entitled to file the application.

3. The present memorandum deals with the requirement of naming the inventor established under international treaties and national laws, and with possibly required evidence in support of the entitlement of the applicant to file the application and to obtain the title of protection where the applicant is not the inventor. It is to be noted that similar considerations as the ones outlined in this memorandum apply to the cases where the applicant is one of several joint inventors. In the latter case, each of the joint inventors, in the absence of an agreement to the contrary, is deemed to have equal undivided rights in the invention and should, therefore, benefit from any provision governing the naming of the inventor.

4. The said requirements are important since:

- according to Article 4*ter* of the Paris Convention for the Protection of Industrial Property, an inventor has the right to be mentioned as such in the patent; such a mention presupposes that the industrial property office, before granting the patent, be informed of the identity of the inventor;

\* This Annex is not reproduced here (*Editor's note*).

<sup>1</sup> In this memorandum, "patent" means both a patent for invention and an inventor's certificate, and "patent application" means both an application for a patent for invention and an application for an inventor's certificate. Whether other titles of protection for an invention, such as registrations of utility models and utility certificates, are to be included, will be studied later.

- any granting of a patent to a party not legally entitled requires correction by complex and costly administrative or judicial procedures for the annulment of the patent granted or its transfer to the party entitled to the patent;
- any granting of a patent to a party not legally entitled constitutes an abuse of the system of protection of inventions and may cause a loss of confidence in the system by its users.

5. It is to be noted that, even if industrial property offices do not examine the question whether the applicant is entitled to file the application, the requirement that the applicant must name the inventor, and must possibly also indicate the grounds for his entitlement, has the effect that applicants who are not entitled are deterred from filing applications.

## II. Purpose of the Memorandum

6. The purpose of this memorandum is to examine the existing requirements in respect of naming of the inventor and evidence to be furnished concerning the entitlement of the applicant and the possibility of finding a uniform solution which could easily be applied by national and regional industrial property offices, and which would have the advantage that applicants do not have to comply with a number of different requirements if they seek protection in several countries. The solution to be proposed for adoption should be the same for the largest number of countries. In this connection, reference is made to the significant achievements in respect of the harmonization of certain provisions of patent law already obtained as a consequence of the Patent Cooperation Treaty (PCT) (1970) and the European Patent Convention (1973).

## III. Existing Legislative Provisions

## A. Information Used in the Present Report

7. Before any uniform solution is proposed, the existing requirements in respect of the naming of the inventor and evidence to be furnished concerning the entitlement of the applicant must be examined. For this purpose, the following information has been taken into account:

(i) the provisions of the Patent Cooperation Treaty (PCT);

(ii) the provisions of the European Patent Convention and of the legislation (laws, regulations, etc.) of those eight countries in which or for which, according to the statistics published by WIPO (IP/STAT/1983/B), more than 10,000 titles of protection for inventions were granted in 1983. Those countries are Canada (20,999), France (25,043), Germany (Federal Republic of) (20,913), Japan (54,701), the Soviet Union (74,200), Switzerland (11,768), the United Kingdom (28,254) and the United States of America (56,862). The figures in parenthesis following the names of the States other than the Soviet Union indicate the number of patents granted in 1983; the figure concerning the Soviet Union represents the total number of patents and of inventors' certificates granted in 1983.

8. In general, the present memorandum is based on legislative provisions (treaties, laws, regulations, etc.) and only exceptionally takes into account the interpretation given to the said provisions by courts and industrial property offices or the practice of industrial property offices. The present memorandum only presents a short summary of the said provisions; the summaries have not been verified by the industrial property offices concerned.

### B. The Patent Cooperation Treaty (PCT)

9. Article 4(1)(v) of the PCT, in conjunction with PCT Rules 4.1(a)(v) and 4.6, provides that the request part of an international application filed under the PCT must contain the name and other prescribed data concerning the inventor where the national law of at least one of the designated States requires that these indications be furnished at the time of filing a national application. In all other cases, the said indications may be furnished at a later date in separate notices addressed to each designated Office. Article 27(2)(ii) of the PCT provides that the national law may require that the applicant furnish documents constituting proof of allegations or statements made in the international application. Rule 51*bis*.1(a)(i) to (iv) of the PCT Regulations further provides that the documents referred to in Article 27(2)(ii), which the applicant may be required to furnish under the national law applicable by the designated Office, include, in particular, (i) any document relating to the identity of the inventor, (ii) any document relating to any transfer or assignment of the right to the application, (iii) any document containing an oath or declaration by the inventor alleging his inventorship, and (iv) any document containing a declaration by the applicant designating the inventor or alleging the right to the application. According to Rule 51*bis*.2, the applicant must have an opportunity to comply with a requirement referred to in Rule 51*bis*.1 once the international application has entered the national phase.

### C. European Patent Convention and National Legislation

10. *European Patent Convention.* Article 81 of the European Patent Convention (EPC) provides that the applicant, in the European patent application, has to provide the designation of the inventor, and Article 91(5) establishes that the time limit to file such designation is 16 months from the date of filing of the European patent application or, if priority is claimed, from the date of priority. Where a designation is not filed, or where the designation was filed but does not meet the prescribed requirements, the applicant is informed that the European patent application will be deemed to be withdrawn if the deficiency is not remedied within the 16-months period prescribed in Article 91(5) EPC or within a minimum period of two months as from notification of this communication, whichever period is longer. If the applicant is not the inventor or is not the sole inventor, the designation must contain a statement indicating the origin of the right to the European patent. Rule 17 of the EPC Regulations further provides that, if the applicant is not the inventor or is not the sole inventor, the designation must be filed in a separate document; the designation must state the family name, given names and full address of the inventor, and the statement referred to in Article 81 must bear the signature of the applicant or his representative.

11. *Canada.* Rule 33(g) of the Patent Rules under the Patent Act, 1952, as amended in 1972, provides that evidence that the applicant of the patent application is a "legal representative" of the inventor must be filed together with the patent application. Section 2 of the Patent Act specifies that "legal representative" includes "heirs, executors, administrators, guardians, curators, tutors, assignees and all other persons claiming through or under applicants for patents and patentees of inventions." This provision, therefore, deals with two different cases: an application by and in the name of the inventor, and an application by an assignee.

12. *France.* Rule 8(c) of Decree No. 79-822 of September 29, 1977, provides that the request for the grant of a patent must contain the designation of the inventor(s). If the applicant is not the inventor, the designation must be made in a separate document containing the name, given names and

residence of the inventor and the signature of the applicant or his representative. Where this requirement is not fulfilled, the applicant is invited to put his application in order within 16 months from the filing date or, where a priority is claimed, from the priority date. In respect of divisional applications, Rule 27(3) provides that the period during which the designation of the inventor can be made is not less than two months from the date of the invitation by the Patent Office to put the application in order. The date of expiration of this period is mentioned in the invitation. Section 4 of Law No. 68-1 of January 2, 1968, as amended to 1984, provides that the inventor may object to be mentioned.

13. *Germany (Federal Republic of).* Section 37 of the Patent Law of 1980 provides that the applicant must file, within 15 months from the filing date or the priority date, a declaration naming the inventor. If the applicant is not the inventor, he shall state in the declaration how he acquired the right to the patent. The Law expressly states that the Patent Office does not examine the correctness of those indications. Section 63(1) further provides that, upon request by the inventor, the mention of the inventor shall be omitted. The said request may be withdrawn at any time; in such a case, the relevant mention shall be effected thereafter. Renunciation by the inventor of the right to be mentioned shall have no legal effect.

14. *Japan.* Section 36(1)(iv) of Law No. 121 of 1959, as last amended in 1985, provides that the patent application must state the name and the domicile or residence of the inventor.

15. *Soviet Union.* Section 40 of the Statute on Discoveries, Inventions and Rationalization Proposals of 1973, as amended in 1978, and Sections 11, 17 and 26 of the Instructions on Compiling Applications for Inventions (EZ-1-74), provide that the application for an inventor's certificate or a patent must state the name of the inventor(s) and, if filed by the inventor's successor in title, must be accompanied by a document certifying the succession to the rights.

16. *Switzerland.* Section 5(1) of the Federal Law on Patents for Inventions of 1954, as amended in 1976, provides that the applicant must designate in writing the name of the inventor. Section 6 provides that the mention of the inventor is not to be made if the inventor renounces to his right to be mentioned. Any declaration made beforehand by the inventor renouncing his right to be mentioned, is without legal effect. Rule 34(1)(a) and (c) of the Ordinance on Patents for Inventions of 1977 provides that the patent application must be accompanied by a separate statement containing the name and the address of the inventor and, if the applicant is not the inventor or is not the only inventor, by a declaration stating the manner in which the applicant acquired the right to the grant of the patent. Rule 21(3)(a) requires that the said indications must be furnished, at the latest, 16 months after the filing date or, where applicable, the priority date. Rule 34(2) further provides that these particulars must be certified by the signature of the patent applicant.

17. *United Kingdom.* Section 13(2) of the Patents Act 1977 and Rule 15 of the Patents Rules 1978, as last amended in 1982, provide that, if the applicant is not the inventor, he must file a statement identifying the inventor(s) and indicating the derivation of his right to be granted the patent. The Patent Office sends a copy of the statement to the inventor(s). The statement must be filed within 16 months after the filing date or, where applicable, the priority date. Such time limit is extendable by one month.

18. *United States of America.* Section 115 of Title 35, Patents, of the United States Code provides that the inventor must be the applicant of the patent application and must file an

oath in which he states that he believes himself to be the original and first inventor of the invention claimed in the application. Section 118 specifies that, whenever an inventor refuses to execute an application for a patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent *on behalf of and as agent for* the inventor on proof of the pertinent facts and showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage (for example, where the inventor died or is unavailable).

19. The Annex to the present document contains the forms to be used under the provisions of the international conventions and national laws referred to in the preceding paragraphs.

#### D. Comparative Analysis

20. When comparing the requirements referred to in the preceding chapter, it is obvious that the provisions of the PCT do not have the same scope as the provisions of the European Patent Convention and the national laws referred to. The PCT itself does not require a declaration of the kind considered here but only takes into account provisions existing in the applicable law of countries which may be designated in the application. For the purposes of establishing a uniform solution, therefore, the provisions of the PCT are not to be considered as such. It is, however, to be noted that the diversity of requirements under the national laws—if they remain applicable without any change—causes problems to applicants under the PCT because sooner or later they may have to comply with different requirements of designated Offices.

21. A second general remark concerns the law of the United States of America. Since, under that law, an application may be filed only by the inventor (or his "agent"), the problem of a declaration by the applicant who is not the inventor does not arise, except in the rare case referred to at the end of paragraph 18, above.

22. For the purposes of comparison, a distinction is made between five questions:

(i) The first question is *whether* the applicant must name the inventor(s); in this connection, the present memorandum does not deal with the way in which the identification has to be made.

(ii) The second question is *whether* the inventor may renounce his right to be named or to be mentioned in any publication of his invention.

(iii) The third question is *when*—where the inventor must be named—such identification is to be made, namely, whether it has to be made at the time of filing the application or whether it may be made at a later stage, and, if so, at what point in time, i.e., within what time limit.

(iv) The fourth question is *whether any additional information* (additional, that is, to the naming of the inventor) is to be furnished, in particular as regards the facts justifying the entitlement of the applicant.

(v) The fifth question is *whether any evidence* is to be furnished with respect to the applicant's entitlement (for example, furnishing a document signed by him or by the inventor(s)) and, if so, what such evidence is.

23. *Naming of the Inventor.* The first question is whether it is at all required to name the inventor(s). Such a requirement presupposes that the applicant for a title of protection for an invention is not necessarily the inventor. The laws of most countries and the European Patent Convention provide that

the inventor must be named, either at the time of filing the application or later.

24. *Renunciation by the Inventor of his Right to be Named or to be Mentioned.* The laws of France, Germany (Federal Republic of) and Switzerland provide that the inventor may renounce his right to be mentioned. The laws of Germany (Federal Republic of) and Switzerland further specify that any undertaking by the inventor to renounce the right to be mentioned shall be without legal effect.

25. *Naming of the Inventor at the Time of Filing the Application or Later in a Separate Document.* The laws of Japan and the Soviet Union provide that the inventor(s) must be named *in the application*. The practice of the Japanese Patent Office provides, however, that the naming of the inventor can be corrected after filing the patent application. The same appears to be the case in the Soviet Union. The laws of France, Germany (Federal Republic of), Switzerland and the United Kingdom, as well as the European Patent Convention, permit a later naming of the inventor—which is then necessarily in a separate document. Such document must be submitted within 15 months (Federal Republic of Germany) or 16 months (France, Switzerland, United Kingdom, EPC) from the filing date or, where a priority is claimed, from the priority date.

26. *Statement Concerning the Entitlement to File the Application.* Under the law of Canada, the applicant must file, together with the application, evidence that he is the "legal representative" of the inventor. The definition of "legal representative," contained in the law, includes any assignee. The laws of Germany (Federal Republic of), Switzerland and the United Kingdom provide that, when the applicant is not the inventor, the application must be accompanied or followed by a *statement, a declaration or a document* indicating the manner in which the applicant acquired the right to the grant of the patent. Whether such a statement, declaration or document is examined by the patent office is another question. Typically, it is not. It is still valuable since it remains in the files of the patent application. Under the present practice of the Japanese Patent Office, the furnishing of evidence of the entitlement to file a patent application is not required; however, in certain specific cases, the Patent Office may ask that such evidence be furnished.

27. *Evidence.* The law of the Soviet Union requires that, where the applicant for a patent is not the inventor, a deed of transfer of the rights in the invention, from the inventor to the applicant, with the signature of the inventor, must be furnished.

#### IV. Arguments in Favor of a Uniform Solution

28. The diversity of requirements and procedures provided for under national legislation and the European Patent Convention in respect of the naming of the inventor and in respect of evidence to be furnished concerning the entitlement of the applicant constitutes a serious difficulty for the users of the patent system when they wish to apply for patents in several countries since they have to take into account and comply with widely different and complex requirements.

#### V. Desirability of Action at the International Level

29. It seems evident that it is desirable to take measures to find a uniform solution to the problem under examination in as many treaties and national laws as possible. Such action must take place at the international level. It could take the form either of an international treaty or of a recommendation

adopted by a competent body, such as the Assembly of the Paris Union for the Protection of Industrial Property. While a recommendation might have the advantage that it can be adopted relatively easily, it has the disadvantage that it probably would not create sufficient momentum for changing national laws and industrial property office practices. The adoption of treaty provisions would be much more adequate. Such provisions should be included in the envisaged treaty dealing also with other aspects of the harmonization of laws for the protection of inventions.

30. Taking into consideration the existing requirements of the national laws covered by this memorandum and of the European Patent Convention, it appears that harmonization could be achieved by establishing the uniform requirement that an applicant *must name the inventor* and, in the case of an invention made by several inventors, each of the joint inventors, by giving his (their) name(s) and address(es). This obligation should also apply in the case where the applicant is the inventor or one of the joint inventors. It is inherent in such a rule that it is not excluded that a person other than the inventor may be the applicant.

31. It could also be provided that each State party to the treaty would be free to require that the applicant must, in addition to the naming of the inventor, *indicate the legal grounds* that entitle him to file an application (for example, the fact that he is the employer of the inventor and that the invention is a service invention, or the fact that the inventor assigned the right to apply to him). (Such rule would establish an obligation only for the applicant; it would not impose an obligation on the industrial property office to examine the well-foundedness of such an indication.)

32. If the inventor has the right to be named as such, he should also have the right to remain anonymous if he so wishes. In order to avoid that this principle could lead to abuses, it could be established that the inventor's wish not to be named should be expressly set down in a special written declaration. This rule could be completed by a provision to the effect that any undertaking by the inventor to make such declaration is without legal effect.

33. A particular question relates to the requirement, contained in some laws, that the naming of the inventor and the possibly required declaration concerning the facts justifying the entitlement of the applicant, must be made *within a certain time limit*. Generally, failure to comply with such a time limit does not entail automatic sanctions; usually, if the time limit is not met, the industrial property office sends a reminder with a further time limit, and only if the further time limit is also not met may the application be refused. Moreover, the said time limits are modified for PCT applications in that compliance with the requirements to which the time limits apply can be enforced only after the processing of an international application has started in the designated Office (see Article 27(2) of the PCT), that is, not before the expiration of 20 months from the priority date unless the applicant requests an earlier start of the processing in the designated Office (see Article 23 of the PCT), or, when the extended time limits under Chapter II of the PCT apply, not before the expiration of 30 months from the priority date. On the other hand, some countries (e.g., the Soviet Union) seem to treat the naming of the inventor as a condition for granting a filing date: the question thus arises whether the more liberal rule of permitting a certain time limit could not be generally adopted.

34. Under any of the above solutions, *evidence* of the entitlement (for example, the furnishing of a document giving evidence of an assignment from the inventor to the applicant) could not be required. To permit such a requirement or even to

make it mandatory would necessitate changes in a great number of national laws. This does not seem to be justified since the question of entitlement typically is not decided by an industrial property office in the granting procedure but, in case of litigation, by the courts.

## VI. Principles of a Solution

35. The principles of a solution to be embodied in an international treaty could be drafted as follows:

"(1) Any applicant for a patent shall name the inventor or inventors, either in the application or in a separate document, by mentioning the name and, to the extent necessary for purposes of identification, the address of the inventor or, where the invention was made by several inventors, of the several inventors. Where the applicant is the inventor, he shall state this fact in the application or in a separate document.

"(2) The inventor or any of the co-inventors shall be free to renounce to be mentioned in the published application or patent by addressing to the industrial property office with which the application was filed a written declaration to this effect. Any promise or undertaking by the inventor or any of the co-inventors made to any person to the effect that he will make the declaration of renunciation shall be without legal effect.

"(3)(a) Any national law shall be free to require that the applicant make a declaration indicating the legal grounds of his entitlement to file the application.

(b) At the time of becoming party to this Treaty, any Contracting State whose national law contains the requirement referred to in subparagraph (a) shall notify the Director General accordingly. Any change in the national law shall be promptly notified in the same manner.

"(4) The applicant shall comply with the requirements provided for under paragraph (1) and, where applicable, paragraph (3)(a), either:

(i) within a general time limit, fixed by the applicable national law, of at least three months after the filing date of the application but not exceeding 16 months after the filing date of the application or, where priority is claimed, the priority date, provided that the industrial property office with which the application was filed sends a reminder to the applicant at least two months before the expiration of the said time limit, or,

(ii) where the applicable national law does not fix a general time limit as provided in item (i), above, within a specific time limit fixed in a written invitation by the industrial property office with which the application was filed, asking for compliance with the requirements provided for under paragraph (1) and, where applicable, paragraph (3)(a), provided that the said time limit does not expire before three months after the filing date of the application or later than 16 months after the filing date of the application or, where priority is claimed, the priority date, and that the invitation is sent at least two months before the expiration of the time limit.

"(5) Non-compliance by the applicant with the requirements provided for under paragraphs (1) and (3)(a), within either the general time limit under paragraph (4)(i) or the specific time limit under paragraph (4)(ii), shall entail the refusal of the application.

"(6) No requirements concerning the naming of the inventor that are additional to or different from those set forth in the preceding paragraphs shall be allowed.

"(7) Paragraphs (1) to (6) shall not affect any provisions concerning assignment or transfer of the right to file after the filing of an application."

## Plant Varieties

### The International Union for the Protection of New Varieties of Plants (UPOV) in 1985

#### State of the Union

At the end of 1985, the Union comprised the following 17 member States: Belgium, Denmark, France, Germany (Federal Republic of), Hungary, Ireland, Israel, Italy, Japan, Netherlands, New Zealand, South Africa, Spain, Sweden, Switzerland, United Kingdom, United States of America.

On December 31, 1985, all member States—except Belgium, Germany (Federal Republic of), Italy and Spain—were bound by the most recent Act of the International Convention for the Protection of New Varieties of Plants, namely, the Revised Act of October 23, 1978.<sup>1</sup>

#### Sessions

During 1985, the various bodies of UPOV met as described below. Unless otherwise specified, the sessions took place in Geneva.

The *Council* held its nineteenth ordinary session on October 17 and 18, 1985. The session was attended by the representatives of the member States and by observers from seven non-member States, namely, Argentina, Chile, Finland, Greece, Morocco, Norway and Poland. The Food and Agriculture Organization of the United Nations (FAO) and the Commission of the European Communities (CEC) were also represented by observers.

The *Council* (i) approved the report of the Secretary-General on the activities of the Union in 1984 and the first nine months of 1985, the report on his management and the financial situation of the Union in 1984, and the accounts of the Union for 1984, (ii) established the program and budget of the Union for the biennium 1986-87, (iii) noted the medium-term plan for 1988-91, and (iv) approved the reports on the progress made by the various committees and technical working parties of the Council, including their plans for future work.

<sup>1</sup> It should be noted that since January 1, 1986, the Federal Republic of Germany and Italy have deposited their instruments of ratification of the Revised Act of October 23, 1978, and have become bound by that Act with effect from April 12, 1986, and May 28, 1986, respectively.

The *Consultative Committee* held its thirty-first session on March 29, 1985, and its thirty-second session on October 14 and 18, 1985. The thirty-first session was devoted mainly to (i) further consideration of the arrangements made for the celebration in Paris, in 1986, of the 25th anniversary of the adoption of the UPOV Convention, (ii) the establishment of guidelines for the 1986-87 program and budget and the 1986-91 medium-term plan, and (iii) the arrangements for the second Meeting with International Organizations, held on October 15 and 16, 1985. The thirty-second session was devoted mainly to the preparation of the nineteenth ordinary session of the Council and to an exchange of views concerning future cooperation between UPOV and the World Intellectual Property Organization (WIPO) regarding biotechnology and patents.

The *Administrative and Legal Committee*, the body in which questions of the practical application of the UPOV Convention and future developments of an administrative or legal nature are discussed, held its fifteenth session on March 27 and 28, 1985, and its sixteenth session on November 14 and 15, 1985.

At both sessions, the Committee noted the latest developments regarding amendments to national plant variety protection legislation, changes in the fees payable by applicants, the extension of lists of species eligible for protection and the enlargement of the network of bilateral agreements for cooperation in the testing of varieties.

Furthermore, at its fifteenth session, the Committee considered a number of questions in preparation for the second Meeting with International Organizations, held in October 1985, and subsequently, at its sixteenth session, it examined the views expressed by the international non-governmental organizations at that meeting. The subjects discussed at the Meeting with International Organizations were (i) minimum distances between varieties, (ii) international cooperation, (iii) application of the UPOV Convention to botanical genera and species, (iv) appropriate protection of the results of biotechnological developments by industrial patents and/or plant breeders' rights, and (v) scope of protection.

As far as the question of *minimum distances between varieties* is concerned, the Committee noted that organizations generally accepted its earlier view, based on discussions in the Technical Committee, that decisions could only be taken on a species-by-species basis. It also noted the proposal by one participant at the meeting that decisions on whether to grant protection should be

based on a weighing of similarities and differences and not just, as at present, on the establishment of a clear difference for at least one important characteristic, since use of the latter criterion facilitated the activities of both infringers and plagiarists. The Committee decided that the Office of the Union should prepare a document for its future consideration, presenting the legal and scientific facts that provide the basis on which decisions on minimum distances are currently taken in the UPOV member States.

As far as *international cooperation* between the plant variety protection offices in the examination of varieties is concerned, the Committee noted that, whilst breeders of certain crops were still somewhat reluctant to accept the idea of centralized examination, recognition of the value to breeders of the continued development of the network of bilateral agreements was in general increasing. The Committee also noted that the recently formalized practice of taking over examination reports, with no centralization, placed a heavy burden on offices since they had to maintain their examination facilities and, in particular, their reference collections at a time when, as a consequence of the new practice, income from fees for examinations was decreasing. The Committee concluded that it might not always be possible in the long term to satisfy those breeders who wished to be able to choose the country in which their varieties were to be examined.

As far as the question of the *application of the UPOV Convention to botanical genera and species* is concerned, the Committee noted that the organizations were generally strongly in favor of the widest possible application of the Convention, and that they welcomed the draft recommendations prepared by it with a view to stimulating harmonization of the national lists of species eligible for protection. The Committee decided to submit the draft recommendations, as amended following consideration of comments made by the organizations, to the Council for adoption at its next ordinary session. The Committee also decided, in that connection, to ask the organizations to indicate the species which they wished each member State to add to its list of protected species and to give an order of priority for each species concerned.

The Committee, in connection with the work of its Biotechnology Subgroup, sought the views of the organizations on the important question of the *appropriate protection of the results of biotechnological developments by industrial patents and/or plant breeders' rights*. It became apparent from the detailed discussion on that subject that organizations were still in the process of formulating their positions. Nevertheless, the views expressed as to the best way to provide appropriate protection will be of great assistance to the Biotechnology Subgroup in its efforts to identify overlaps and conflicts between patent and plant breeders' rights laws, and to UPOV in its participation in the general debate on biotechnology and intellectual property protection systems.

The Committee noted the request of the organizations that UPOV and its member States should review the *scope of protection* provided for in the Convention and in national laws. It decided that it would consider that request at its next (seventeenth) session.

In view of the strong objections voiced by some organizations about the recently adopted *UPOV Recommendations on Variety Denominations*, the Committee decided to convene a meeting of experts from UPOV and the interested organizations, early in 1986, at which those objections could be considered in detail.

The *Technical Committee*, the body in which questions of the practical application of the UPOV Convention and future developments of a technical nature are discussed, held its twenty-first session on November 12 and 13, 1985, at which it adopted, on the basis of preparatory work carried out by the Technical Working Parties, 14 new or revised Test Guidelines, namely, for Avocado, for Cotton, for Groundnut, for Kiwifruit, for Lagerstroemia, for Ling, Scotch Heather, for Olive, for Quince, for Red Clover, for Rice, for Streptocarpus, for Vine, for White Clover, and for Willow.

The Committee received reports on the progress of the work of the five Technical Working Parties, gave guidance on a number of questions raised by them and instructed them on the major aspects of their future work.

The five Technical Working Parties all met once: the *Technical Working Party on Automation and Computer Programs* in Wageningen (Netherlands) from May 8 to 10, 1985; the *Technical Working Party for Agricultural Crops* in Hanover (Federal Republic of Germany) from June 5 to 7, 1985; the *Technical Working Party for Fruit Crops* from June 19 to 21, 1985, and the *Technical Working Party for Ornamental Plants and Forest Trees* from June 25 to 27, 1985, both in Aarslev (Denmark); the *Technical Working Party for Vegetables* in Cambridge (United Kingdom) from July 9 to 12, 1985.

#### Contacts with States and Organizations

Of the various contacts the Office of the Union had during 1985, the following deserve special mention: in May, the Vice Secretary-General gave a lecture on UPOV at the International Spanish/Latin American Course on Seed Technology, organized by the Spanish Ministry of Agriculture, Fisheries and Food and held in Madrid; in December, the Vice Secretary-General visited the competent authorities of Argentina in Buenos Aires, at their invitation, for discussions on their legislation on plant variety protection and to give a lecture on "International Regulation of Property in Cultivars - A World View; Biotechnology and Its Implications for Property in Cultivars" at a workshop

on the "Regulation of Property in Cultivars and Technology Transfer," organized by the National Institute of Industrial Technology (INTI), in cooperation with the National Institute of Agricultural Technology (INTA).

UPOV was represented: (i) at two meetings held at FAO headquarters in Rome, the first, in March, being a meeting of the Commission on Plant Genetic Resources and the second, in November, being a meeting of Commission II of the twenty-third session of the Conference of FAO; (ii) at the eleventh Pan-American Seeds Seminar (PSS), held in November in Cali, Colombia.

UPOV was also represented: (i) at two meetings of the International Association of Horticultural Producers (AIPH), the first, in January in Berlin (West), being a meeting of the AIPH Committee for the Protection of Plant Breeders' Rights and the second, in August in Helsingborg, Sweden, being the thirty-seventh AIPH Congress; (ii) at the annual Congresses of the International Federation of the Seed Trade (FIS) and of the International Association of Plant Breeders for the Protection of Plant Varieties (ASSINSEL), both held in June in Killarney, Ireland.

In October 1985, the second Meeting with International Organizations was held at the headquarters of UPOV in Geneva. Information on the subjects discussed at that meeting is given in the earlier description of the work of the Administrative and Legal Committee. The following non-governmental organizations were represented: Association of Plant Breeders of the European Economic Community (COMASSO),

International Association for the Protection of Industrial Property (AIPPI), AIPH, ASSINSEL, International Community of Breeders of Asexually Reproduced Ornamental and Fruit Tree Varieties (CIOPORA), FIS, International Chamber of Commerce (ICC). A record of the Meeting is reproduced in document IOM/II/8. Immediately after the Meeting, there was also a brief discussion on the UPOV Recommendations on Variety Denominations, adopted by the Council in October 1984, at its eighteenth ordinary session.

### Publications

In 1985, the Office of the Union published seven issues of *Plant Variety Protection—Gazette and Newsletter of the International Union for the Protection of New Varieties of Plants*; the *Records of the 1984 Symposium on "Industrial Patents and Plant Breeders' Rights—Their Proper Fields and Possibilities for Their Demarcation,"* in English, French, German and Spanish (UPOV publications 342(E), (F), (G) and (S), respectively); 14 *Guidelines for the Conduct of Tests for Distinctness, Homogeneity and Stability*; and a supplement to the *Collection of the Texts of the UPOV Convention and Other Important Documents Established by UPOV* (UPOV publications 644(E), (F) and (G), respectively). It also made the final arrangements for the publication of the *Collection of Plant Variety Protection Laws and Treaties* (UPOV publication 651(E)).

## General Studies

### **The Patentability of Therapeutic Uses of Known Substances under the European Patent Convention**

A. HÜNI\*





















# Calendar of Meetings

## WIPO Meetings

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

### 1986

- September 1 to 5 (Geneva) — Permanent Committee on Patent Information (PCPI) and PCT Committee for Technical Cooperation (PCT/CTC)
- September 8 to 10 (Geneva) — WIPO Patent and Trademark Information Fair
- September 8 to 12 (Geneva) — Governing Bodies (WIPO Coordination Committee, Executive Committees of the Paris and Berne Unions, Assembly of the Berne Union)
- October 13 to 17 (Geneva) — Permanent Committee on Patent Information (PCPI): Working Group on General Information
- November 11 to 14 (Geneva) — Committee of Experts on the International Registration of Marks
- November 24 to December 5 (Geneva) — Permanent Committee on Patent Information (PCPI): Working Group on Search Information
- December 8 to 12 (Geneva) — Permanent Committee on Patent Information (PCPI): Working Groups on Special Questions and on Planning

## UPOV Meetings

### 1986

- September 16 to 19 (Wädenswil) — Technical Working Party for Fruit Crops, and Subgroup
- November 18 and 19 (Geneva) — Administrative and Legal Committee
- November 20 and 21 (Geneva) — Technical Committee
- December 1 (Paris) — Consultative Committee
- December 2 and 3 (Paris) — Council

## Other Meetings Concerned with Industrial Property

### 1986

- September 13 to 17 (Lucerne) — International League for Competition Law: XXIXth Congress
- September 23 to 26 (Strasbourg) — Center for the International Study of Industrial Property: Seminar on Licensing and the Transfer of Technology (second module: Strategy and Procedures for the Transfer of Technology)
- September 23 to 27 (Washington, D.C.) — Inter-American Association of Industrial Property: IXth Congress
- October 22 to 24 (Mainz) — Pharmaceutical Trade Marks Group: 33rd Conference
- December 1 to 5 (Munich) — European Patent Organisation: Administrative Council

