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Contents

NOTIFICATIONS CONCERNING TREATIES

Budapest Treaty

- I. Change of Name: Commonwealth Agricultural Bureau (CAB), International Mycological Institute (United Kingdom) 51
- II. Change in Fees under Rule 12.2 of the Regulations under the Budapest Treaty: Fermentation Research Institute (FRI) (Japan) 51

WIPO MEETINGS

- Developments in 1988 Concerning the Draft Treaty on the Protection of Intellectual Property in Respect of Integrated Circuits 52
- Paris Union. Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions. Fifth Session, Second Part (Geneva, December 12 to 16, 1988) 53

STUDIES

- Selection and Protection of Marks, by Y. Plasseraud 70

BOOKS AND ARTICLES

- Book Reviews 79

NEWS ITEMS

- Austria, Israel, Mexico, Peru, Poland 80

- CALENDAR OF MEETINGS 81

INDUSTRIAL PROPERTY LAWS AND TREATIES (INSERT)

Editor's Note

UNITED STATES OF AMERICA

United States Code, Title 35—Patents (as last amended by Public Law 100-703 of November 19, 1988) (*This text replaces the one previously published under the same code number*) Text 2-001

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Notifications Concerning Treaties

Budapest Treaty

I. Change of Name

COMMONWEALTH AGRICULTURAL
BUREAU (CAB),
INTERNATIONAL MYCOLOGICAL INSTITUTE
(United Kingdom)

(formerly known as the "Culture Collection
of the Commonwealth Mycological Institute")

The Government of the United Kingdom has informed the Director General of WIPO by a communication of January 23, 1989, that the assurances furnished in its communication of January 21, 1983, concerning the Culture Collection of the Commonwealth Mycological Institute, an international depositary authority under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, continue to apply to the said international depositary authority under its new name: Commonwealth Agricultural Bureau (CAB), International Mycological Institute. The address of the said international depositary authority is unchanged, that is:

Ferry Lane
Kew, Surrey TW9 3AF
United Kingdom.

Budapest Communication No. 49 (this Communication is the subject of Budapest Notification No. 75, of January 30, 1989).

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

FERMENTATION RESEARCH INSTITUTE (FRI)
(Japan)

The following communication addressed to the Director General of WIPO by the Government of Japan under Rule 12.2 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 February 2, 1989, and is published by the International Bureau of WIPO pursuant to Article 7(2)(a) and Rule 13.2(b) of the said Treaty and Regulations:

1. In accordance with Rule 12.2(a) of the Regulations under the Budapest Treaty, the fee schedule of the FRI published in the September 1987 issue of *Industrial Property* will be modified as follows:

	Yen
(a) Storage:	
— original deposit	190,000
— new deposit	14,000
(b) Attestation referred to in Rule 8.2	1,700
(c) Issuance of a viability statement:	
— if the depositor, when requesting the issuance of a viability statement, also requests a viability test	10,000
— other cases	1,700
(d) Furnishing of a sample	10,000*
(e) Communication of information under Rule 7.6	1,700

* When furnishing a sample to a foreign institution:

- additional 37,000 yen per one package as cost of a special container, is payable for animal cell cultures;
- additional 800 yen per package as cost of a special container, is payable for other microorganisms.

Fees are expressed net of Value Added Tax according to Japanese provisions currently in force.

[End of text of the communication of the
Government of Japan]

The fees set forth in the said communication will apply as from the thirtieth day following the date (February 28, 1989) of publication of the said fees in the present issue of *Industrial Property*, that is, as from March 30, 1989 (see Rule 12.2(c) of the Regulations under the Budapest Treaty), and will replace the fees which were published in the September 1987 issue of *Industrial Property*.

Budapest Communication No. 50 (this Communication is the subject of Budapest Notification No. 76, of February 13, 1989).

WIPO Meetings

Developments in 1988 Concerning the Draft Treaty on the Protection of Intellectual Property in Respect of Integrated Circuits

NOTE*

Following consideration of a draft Treaty on the Protection of Intellectual Property in Respect of Integrated Circuits (hereinafter referred to as "the draft Treaty") in three sessions of a Committee of Experts, held, respectively, in November 1985, June 1986 and April 1987,¹ the General Assembly of WIPO and the Assembly of the Paris Union decided, on September 30, 1987, on a future program of work in relation to the draft Treaty.

Pursuant to that decision, the International Bureau held consultations with experts from developing countries in January 1988 prior to, and for the purpose of assisting in, the preparation of seven studies and analyses dealing with legal matters concerning intellectual property in respect of integrated circuits. Following the consultations, the International Bureau prepared the seven studies and analyses, bearing the following titles (documents IPIC/S/1 to 7):

- Sui Generis* Approach;
- Definition;
- Object of the Protection: Conditions of Protection;
- National Treatment;
- Scope of Protection;
- Formalities;
- Duration of Protection.

The seven studies and analyses were distributed for comments to the States members of WIPO or the Paris Union, the English text in February 1988, and the French and Spanish texts in March 1988.

Following the distribution of the seven studies and analyses, a Consultative Meeting of Experts from Developing Countries on Integrated Circuits was convened in Geneva from May 24 to 27, 1988, to review and evaluate the comments received from governments on the seven studies and analyses.

The Consultative Meeting, mentioned in the previous paragraph, was followed by a Review Meeting on the Progress of the Preparatory Work for the Diplomatic Conference for the Conclusion of a Treaty on the

Protection of Intellectual Property in Respect of Integrated Circuits, which was held in Geneva from May 30 to June 1, 1988. Forty-five States, as well as the Commission of the European Communities, were represented at the Review Meeting.

At the conclusion of the Review Meeting, a decision was adopted that, amongst other things, requested the International Bureau to prepare, for the fourth session of the Committee of Experts:

"(1) one or several documents dealing with the six points identified by the May 24 to 27, 1988, Consultative Meeting of Experts from Developing Countries on Integrated Circuits and further made explicit by the Spokesman of the Group of 77 during the May 31 session;

(2) a document containing a revised version of the draft Treaty presented to the third session of the Committee of Experts, taking into account the discussions of that session, subsequent developments in the field and comments received from governments (documents IPIC/CM/1 and addenda). The new version should contain alternative provisions related to the issues mentioned in paragraph (1) and comprehensive explanatory notes with particular reference to the new provisions. The draft should contain a provision to the effect that the form of protection that any contracting party wishes to adopt in its legislation is left to that party, provided that the national legislation is consistent with the future treaty."

The fourth session of the Committee of Experts on Intellectual Property in Respect of Integrated Circuits was held in Geneva from November 7 to 22, 1988. Sixty-one States were represented at that session. In addition, representatives of five intergovernmental organizations and 12 non-governmental organizations participated in an observer capacity.

The discussions of the fourth session of the Committee of Experts were based on the following documents: "Draft Treaty with Explanatory Notes," presented by the Director General of WIPO (document IPIC/CE/IV/2), hereinafter referred to as "the draft Treaty"), "The Six Points Identified by the May 24 to 27, 1988, Consultative Meeting of Experts from Developing Countries," prepared by the International Bureau (document IPIC/CE/IV/3), and "Draft Codicil

* Prepared by the International Bureau.

¹ For notes on the first, second and third sessions of the Committee of Experts, see *Industrial Property*, 1986, p. 110; 1986, p. 373; and 1987, p. 282.

to the Berne Convention for the Protection of Integrated Circuit Designs," presented by India (document IPIC/CE/IV/5), as well as documents containing proposed amendments to the draft Treaty (documents IPIC/CE/IV/4, 6, 7, 8, 9, 10, 11, 12, 13 and 14) presented by delegations during the fourth session in connection with various articles of the draft Treaty. Copies of these documents, together with the other documents mentioned in this Note, are available from the International Bureau of WIPO.

Simultaneously with the fourth session of the Committee of Experts, a Preparatory Meeting for the Diplomatic Conference for the Conclusion of a Treaty on the Protection of Intellectual Property in Respect of Integrated Circuits was held in Geneva from November 14 to 22, 1988. Sixty States were represented at the Preparatory Meeting. Four intergovernmental organizations also participated in an observer capacity.

The discussions of the Preparatory Meeting were based on a Memorandum of the Director General of WIPO entitled "Preparations for the Diplomatic Conference" (document IPIC/PM/2). The following matters were discussed at the Preparatory Meeting:

- Substantive documents to be submitted to the Diplomatic Conference;

- States and Organizations to be invited to the Diplomatic Conference;
- Date and venue of the Diplomatic Conference;
- Draft Rules of Procedure of the Diplomatic Conference;
- Wording of the invitations to the Diplomatic Conference; and
- Draft Agenda of the Diplomatic Conference.

It was decided by the Preparatory Meeting that the Diplomatic Conference for the conclusion of a treaty would be held from May 8 to 26, 1989, in Washington, D.C.

The invitations for the Diplomatic Conference were issued in December 1988, together with the following two documents in the English, Arabic, French, Russian and Spanish languages:

- Draft Agenda of the Diplomatic Conference (document IPIC/DC/1);
- Draft Rules of Procedure of the Diplomatic Conference (document IPIC/DC/2).

A revised version of the draft Treaty has been prepared by the International Bureau for consideration by the Diplomatic Conference and was published in January 1989.

Paris Union

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

Fifth Session, Second Part
(Geneva, December 12 to 16, 1988)

NOTE*

Introduction

Following the decision taken during the first part of the fifth session,¹ held in Geneva from June 13 to 17, 1988, to adjourn the session, the second part of the fifth session² of 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") was held in Geneva from December 12 to 16, 1988.

The following States members of the Paris Union for the Protection of Industrial Property were represented: Argentina, Australia, Belgium, Brazil, Bulgaria, Cameroon, Canada, Czechoslovakia, Denmark, Egypt,

Finland, France, German Democratic Republic, Germany (Federal Republic of), Ghana, Greece, Hungary, Ireland, Italy, Japan, Mexico, Netherlands, Norway, Philippines, Poland, Republic of Korea, Soviet Union, Spain, Sweden, Switzerland, Tunisia, Turkey, United Kingdom, United States of America, Uruguay (35). The following State member of WIPO was represented in an observer capacity: Panama. Representatives of three intergovernmental organizations and 25 non-governmental organizations also participated, in an observer capacity. The list of participants follows this Note.

In addition to the Preamble and the Introductory Provisions contained in Article 1 ("Establishment of a Union") and Article 2 ("Definitions"), the Committee of Experts considered in detail the following seven questions:

- (i) requirements for granting a filing date;
- (ii) the naming of the inventor and declaration concerning the entitlement of the applicant;
- (iii) manner of description;
- (iv) manner of claiming;

* Prepared by the International Bureau.

¹ For the Note on the first part of the fifth session, see *Industrial Property*, 1988, p. 358.

² For Notes on the first, second, third and fourth sessions, see *Industrial Property*, 1985, p. 267; 1986, p. 309; 1987, p. 204; and 1988, p. 179.

- (v) unity of invention;
- (vi) grace period; and
- (vii) prior art effect of applications.

Memoranda prepared by the International Bureau were reproduced in full in *Industrial Property*, on the first question, 1986, pp. 312 to 320, on the second question, 1986, pp. 320 to 324, on the third question, 1987, pp. 209 to 216, on the fourth question, 1987, pp. 255 to 264, on the fifth question, 1987, pp. 264 to 270, on the sixth question, 1984, pp. 314 to 327, and, on the seventh question, 1987, pp. 270 to 276.

Certain general observations were also made during the second part of the fifth session concerning questions which had been discussed at the first part of the fifth session.

The discussions were based on the document drawn up by the International Bureau of WIPO and entitled "Draft Treaty on the Harmonization of Certain Provisions in Laws for the Protection of Inventions; Draft Regulations" (document HL/CE/V/2, hereinafter referred to as the "draft Treaty and draft Regulations"), as well as a proposal by the Delegation of the United States of America entitled "Draft Article and Draft Rule on Unity of Invention" (document HL/CE/V/5) and a proposal by the Delegation of Japan entitled "Draft Articles 302, 307 and 308" (document HL/CE/V/6). The relevant portions of these documents are quoted hereafter together with the corresponding parts of the report of the second part of the fifth session of the Committee of Experts (document HL/CE/V/7).

Provisions of the Draft Treaty and the Draft Regulations Not Discussed at the First Part of the Fifth Session

Preamble

The Preamble of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

*"The Contracting States,
desiring to strengthen cooperation between States
in respect of the protection of inventions,
considering that such protection is facilitated by a
harmonization of provisions in laws for the protection
of inventions,
have concluded the present Treaty, which consti-
tutes a special agreement within the meaning of
Article 19 of the Paris Convention for the Protection of
Industrial Property."*

The portion of the report of the Committee of Experts concerning the discussion of the Preamble reads as follows:

"The Delegation of Brazil, recalling statements which it had made, on its own behalf and on behalf of the Group of Latin American countries, in previous sessions of the Committee of Experts, stated that it

considered that the Preamble should reflect the view that harmonization ought to take into account differences in the levels of development and the special features of protection accorded in various countries. To this end, it suggested that a further provision be added after paragraph 2 of the Preamble to the following effect: '*taking into account differences in the levels of development of the Contracting States.*'"

The Delegation of the United States of America stated that it considered the suggestion of the Delegation of Brazil to be an interesting but premature one. It considered that, until the content of the draft Treaty had been determined and all its provisions known, it could not be decided to include a provision such as that suggested by the Delegation of Brazil in the Preamble.

The Delegation of Denmark stated that the Preamble should place more emphasis on the need for harmonization. In particular, it suggested that the Preamble make explicit mention of the need for harmonization to bridge the differences in levels of development, rather than to emphasize such differences.

One delegation suggested that the term 'Contracting States' should be replaced by 'Contracting Parties.'"

Article 1: Establishment of a Union

Article 1 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

"(1) The States party to this Treaty (hereinafter called 'the Contracting States') constitute a Union for the harmonization of certain provisions in laws for the protection of inventions. The Union shall be known as the International Union for the Harmonization of Certain Provisions in Laws for the Protection of Inventions."

"(2) No provisions of this Treaty shall be interpreted as diminishing the rights that any national or resident of any country party to the Paris Convention for the Protection of Industrial Property has under that Convention."

The report of the Committee of Experts records that there were no observations on this Article.

Article 2: Definitions

Article 2 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

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

(i) references to an 'application' shall be construed as references to an application for a patent

for invention or to an application for an inventor's certificate;

(ii) references to a 'patent,' in this Article and in Articles 101, 105, 201, 202, 203, 301, 304, 306 and 308, shall be construed as references to a patent for invention as well as references to an inventor's certificate; furthermore, references to a 'patent' shall be construed as references to a national patent or to a regional patent, a 'national patent' meaning a patent granted by a national authority and a 'regional patent' meaning a patent granted by a national or an intergovernmental authority having the power to grant patents effective in more than one State;

(iii) 'industrial property office' means the government authority of a Contracting State entrusted with the granting of patents; references to an 'industrial property office' shall be construed as referring also to any intergovernmental authority which several States have entrusted with the task of granting regional patents, provided that at least one of those States is a Contracting State;

(iv) references to 'national law' shall be construed as references to any legal provisions governing the granting of patents and the effects of patents;

(v) 'Paris Convention' means the Paris Convention for the Protection of Industrial Property, signed at Paris on March 20, 1883, and last revised on July 14, 1967, and as amended on October 2, 1979;

(vi) 'priority date,' for the purposes of computing time limits, means the filing date of the application (whether foreign or domestic) whose priority is claimed or, where the priorities of two or more applications are claimed, the filing date of the earliest-filed of those applications;

(vii) 'Union' means the International Union for the Harmonization of Certain Provisions in Laws for the Protection of Inventions;

(viii) 'Assembly' means the Assembly of the Union;

(ix) 'Organization' means the World Intellectual Property Organization;

(x) 'International Bureau' means the International Bureau of the Organization;

(xi) 'Director General' means the Director General of the Organization."

The report of the Committee of Experts records that there were no observations on this Article.

Article 101 and Rule 101: Requirements for Granting a Filing Date

Article 101 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

"(1) For the purposes of granting a filing date, an application shall contain the following elements:

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

(ii) an identification of the applicant, as prescribed in the Regulations;

(iii) a part which, on the face of it, appears to be a description of the invention for which a patent is applied for; however, any national law may provide that, [Alternative A: where an application claims the priority of an earlier application] [Alternative B: where a previous application has been filed] for the same invention, the said part may be replaced by a reference to the description contained in the said [earlier] [previous] application, provided that the said part is furnished within two months after the filing date and provided that the application is filed by the applicant of the [earlier] [previous] application or his successor in title.

(2)(a) Subject to subparagraph (b), 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 filing fee be paid;]

[(ii) that the application contain a part which, on the face of it, appears to be a claim or claims;]

(iii) that the application, if not filed in a certain language or in one of certain languages, be accompanied by a translation in that language or in one of those languages;

(iv) that, if the application refers to drawings, such drawings be included in the application.

(b) Where the national law of a Contracting State contains, at the time that State becomes party to this Treaty, any of the requirements referred to in subparagraph (a), the Contracting State shall be free to repeal any such requirement at any time thereafter. Any requirement referred to in subparagraph (a)(i) to (iii) not provided for in the national law of a Contracting State at the time that State becomes party to this Treaty shall not thereafter be introduced in the national law of the said State, and any requirement referred to in subparagraph (a)(i) to (iii) which, at the time a State becomes party to this Treaty, was provided for in the national law of that State but which was thereafter repealed, shall not be reintroduced in the national law of the said State, except where such introduction or reintroduction is required in order to align the national law of the said State with a treaty to which the said State becomes party.

(c) At the time of becoming party to this Treaty, any Contracting State whose national law contains any of the requirements referred to in subparagraph (a) shall notify the Director General accordingly. The repeal of any such requirement in the national law shall be promptly notified in the same manner. The provisions of this subparagraph shall not apply to any

such requirement contained in a treaty providing for the grant of regional patents.

(3) No requirements in respect of granting a filing date that are additional to or different from those set forth in the preceding paragraphs shall be allowed, with the exception of the requirement, in any treaty providing for the grant of regional patents, that an application for a regional patent contain the designation of at least one State party to that treaty."

Rule 101 of the draft Regulations as submitted by the International Bureau to the Committee of Experts read as follows:

"(1) The applicant shall be identified by his name. For such purposes, it shall be sufficient if the identity of the applicant can be established.

(2)(a) If the requirements of Article 101 are not complied with, the industrial property office shall promptly invite the applicant, provided that such invitation is possible, to comply with the said requirements within a time limit fixed in the invitation, which shall be at least one month from the date of the invitation.

(b) The compliance with any invitation concerning the requirements of Article 101(2)(a)(i) to (iii) may be subject to the payment of a surcharge.

(c) If the applicant complies with the invitation referred to in paragraph (a) within the time limit fixed in the invitation, the filing date shall be:

- (i) the date of receipt of the required correction, where the invitation related to a requirement of Article 101(1);*
- (ii) the date on which the requirements of Article 101(1) were complied with, where the invitation related to a requirement of Article 101(2)(a)(i), (ii) or (iii);*
- (iii) the date of receipt of the missing drawings, where the invitation related to the requirement of Article 101(2)(a)(iv); if the missing drawings are not received by the industrial property office within the time limit fixed in the invitation, any reference to them in the application shall be considered non-existent."*

The portion of the report of the Committee of Experts concerning the discussion of Article 101 and Rule 101 reads as follows:

"The texts appearing in the draft Treaty and the draft Regulations were generally supported, subject to the following comments.

Article 101(1)(ii) and Rule 101(1). Differing opinions were expressed on whether to retain the present text of this provision, with the cross-reference to the Regulations (and, in that case, whether or not Rule 101(1) should be expanded to

refer to other requirements for identifying the applicant, such as mention of address and nationality), or whether Rule 101(1) should be incorporated into Article 101(1)(ii), leaving more flexibility as to how the applicant should be identified. After extensive discussion of the Article and subsequently of the Rule, several delegations and representatives expressed their support for the proposal initially made by the Delegation of Switzerland to eliminate Rule 101(1) and for Article 101(1)(ii) merely to provide that an application shall contain indications necessary and sufficient to identify the applicant.

Article 101(1)(iii). Among those delegations and representatives who spoke, an overwhelming majority supported Alternative B, and none expressed opposition thereto. The Delegation of the Soviet Union declared that it preferred eliminating both Alternatives.

As for the contents of Alternative B, several suggestions were made. In particular, a number of delegations wished to reintroduce, in the Treaty or the Regulations, the requirement of submission of a certified copy of the earlier application and to transfer the two-month time limit for submitting the description from the Treaty to the Regulations.

The Delegation of the United States of America proposed that, for the sake of balance and to achieve harmonization, Alternative B be made a mandatory element of Article 101(1)(iii). This position was expressly supported by the Delegations of Canada, Denmark, Finland, Norway and Sweden and by the representatives of APAA, AIPLA, BDI, FICPI, IFIA, PTIC and UNICE and was expressly opposed by the Delegations of Germany (Federal Republic of), the Netherlands and the United Kingdom. The Chairman noted that the present text of Article 101(1)(iii) constituted a compromise solution responding to the differences of opinion expressed on this question at previous sessions of the Committee of Experts.

Rule 101(2)(c)(i). As regards the consequences of non-compliance with the mandatory requirements under Article 101(1), the Delegation of the United States of America proposed that only item (iii) under Article 101(1), i.e., the requirement of a description, be covered by Rule 101(2)(c)(i) and that items (i) and (ii) under Article 101(1), i.e., the requirements of a request for the grant of a patent and the identification of the applicant, be shifted to Rule 101(2)(c)(ii); in other words, only the failure to file a description, and its subsequent correction, would result in according as the filing date the date of receipt of the required correction; failure to file a request or to identify the applicant, and its subsequent correction, would be treated in the same way as an optional requirement so that, once corrected, the date on which the description had been filed would be retained as the filing date of the application. Opinions seemed

divided on this proposal. The Chairman, therefore, suggested that both approaches, the present text of Rule 101(2)(c) and the proposal by the Delegation of the United States of America, appear as two alternatives in the next version of the draft Treaty to be prepared by the International Bureau.

Article 101(2)(a) and Rule 101(2)(c). Varied and frequently opposing opinions were expressed with respect to the four optional requirements contained in Article 101(2)(a) and the consequences of non-compliance therewith under Rule 101(2)(c)(ii). The present text is presented as a compromise solution, on the condition that non-compliance with such requirements would be able to be corrected under the Regulations without losing the initial filing date.

As regards the optional requirements of filing fees and claims under Article 101(2)(a)(i) and (ii), the majority seemed to support these two items, provided, for many delegations, that the present text of Rule 101(2)(c)(ii) be retained as concerned those requirements, although several delegations considered that Rule 101(2)(c)(i) should apply to the requirements of Article 101(2)(a)(i).

As regards the optional requirement of a translation under Article 101(2)(a)(iii), many supported this item, also on the condition, for several delegations, that the present text of Rule 101(2)(c)(ii) be retained as concerned such requirement; other delegations considered that Rule 101(2)(c)(i) should apply to the requirements of Article 101(2)(a)(iii); yet others preferred a stricter provision, as it appeared in the previous version of the draft Treaty, permitting the requirement that the application itself, without any allowance for a translation, be filed in a certain language (document HL/CE/IV/2, Article 101(2)(a)(ii)) (see also Note g. on Article 101 in document HL/CE/V//2). It was also suggested that consideration be given to including provision for the correction of errors in a translation.

As regards the optional requirement of drawings under Article 101(2)(a)(iv), some delegations supported the present text. Other delegations proposed that, for purposes of according a filing date, a distinction be made between drawings which are necessary and those which are not necessary for the understanding of the invention (which, it was conceded, would require a technical evaluation), the reasoning being that the late filing of drawings which were not necessary for the understanding of the invention did not add new matter to the disclosure and, therefore, should not affect the filing date of the application; only drawings necessary for the understanding of the invention should be covered by Article 101(2)(a)(iv) and Rule 101(2)(c)(iii).

A few delegations asked if a new item could not be added to Article 101(2)(a), allowing the appointment of a local representative in the case of foreign applicants as an additional optional requirement. In response, it was explained that Article 101 dealt only

with requirements for granting a filing date, which, in the interest of applicants, should be kept to a minimum; Article 101 did not deal with formal requirements for the processing of applications, which meant that any national law remained free to require foreign applicants to appoint a local representative and, in the absence thereof, provide for the refusal of the application.

Article 101(2)(b). There seemed to be general acceptance of this provision and of the suggestion made by one delegation that the last line read, '... to which the said State *is or becomes* party' (emphasis added).

Article 101(2)(c). No observations were made on this provision.

Article 101(3). Notwithstanding the fact that a few reservations were expressed, this provision seemed to receive general acceptance. It was suggested that the Notes on Article 101 clarify the fact that divisional applications could be subject to special rules and were not covered by Article 101.

Rule 101(2)(a). The majority of delegations and representatives seemed satisfied with this provision, although a few reservations were expressed with respect to the term 'promptly' and the proviso, 'that such invitation is possible.'

Rule 101(2)(b). There seemed to be general agreement among the delegations concerning the question of a surcharge. It was suggested that a possible maximum percentage for such surcharge could be indicated."

Article 102: Naming of Inventor; Declaration Concerning the Entitlement of the Applicant

Article 102 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

"(1)(a) The applicant for a patent shall name the inventor or the co-inventors, as the case may be, either in the patent application or in a separate document.

(b) The identification of the inventor or the co-inventors may be rectified at any time by addressing the relevant rectification to the industrial property office. The rectification shall be signed by the applicant or his representative.

(2)(a) The inventor or each co-inventor shall be free to renounce the right to be mentioned in the published patent application or patent by addressing to the industrial property office with which the patent application was filed a written declaration to that effect.

(b) Any promise or undertaking by the inventor or a co-inventor made to any person to the effect that he

will make a declaration of renunciation shall be without legal effect.

(3)(a) Any Contracting State shall be free to maintain, in its national law, a requirement existing at the time of becoming party to this Treaty, obliging the applicant or his representative to make a declaration indicating the legal grounds of the applicant's entitlement to file the patent 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. The repeal of such requirement in the national law shall be promptly notified in the same manner. The provisions of this subparagraph shall not apply to any such requirement contained in a treaty providing for the grant of regional patents.

(4)(a) Where the applicant does not comply with the requirements provided for under paragraph (1)(a) and, where applicable, paragraph (3)(a), at the time of filing the patent application, the industrial property office with which the patent application was filed shall invite the applicant to comply with the said requirements within a reasonable time limit fixed in the invitation.

(b) Non-compliance by the applicant with the requirements provided for under paragraph (1)(a) and, where applicable, paragraph (3)(a) within the time limit fixed in the invitation referred to in subparagraph (a), shall entail the refusal of the patent application or be deemed withdrawal of the patent application.

(5) 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.

(6) Paragraphs (1) to (5) shall not affect any provisions in any national law concerning assignment or transfer of the right to the patent after the filing of a patent application."

The portion of the report of the Committee of Experts concerning the discussion of Article 102 reads as follows:

"General. Several delegations suggested that Article 102 should contain only broad principles, such as the requirement that the inventor be named, and that details concerning the implementation of the broad principles should be set out in a corresponding Rule.

Article 102(1). The majority of delegations considered that Article 102(1)(a) should require the applicant to supply the full name and address of the inventor, in order to facilitate communications with the inventor.

Several delegations considered that it should be made clear that a Contracting State would be free to

require that the name of the inventor be supplied in the script of a particular language.

With respect to Article 102(1)(b), a number of delegations considered that the terms and conditions for rectification of the identification of the inventor should be left to national law. On this basis, a majority of delegations favored, in particular, the deletion of the last sentence of Article 102(1)(b).

Several delegations suggested that, if the last sentence of Article 102(1)(b) were retained, the consent of the originally named inventor should be required for a rectification. One delegation also pointed out that, in this sentence, the term 'signed' should be understood as including 'sealed' in accordance with Rule 2.3 of the Regulations under the Patent Cooperation Treaty.

One delegation considered it should be made clear that a Contracting State would be free to require the payment of a fee for rectification.

It was suggested by one delegation that, in the second line of Article 102(1)(b), the words 'at any time' should be replaced by 'before the grant of the patent.'

It was also suggested that the word 'applicant' be added in Article 102(1)(b) to accommodate national laws which required the applicant to be the inventor.

Article 102(2). The Delegation of Canada, as well as a number of representatives, stressed the importance of the public interest in always having available the identity of the inventor, and considered that Article 102(2) should accordingly be deleted. Such availability would facilitate the search of patent documentation by reference to inventors, and the lack of the right, on the part of an inventor, to renounce being named would ensure that employees could not be unreasonably requested by employers to forgo their right to be mentioned.

A number of other delegations opposed the deletion of Article 102(2) and supported the right of the inventor to renounce being identified. It was suggested that Article 102(2)(a) should be restricted to the principle and that the last part of the provision starting with the words 'by addressing to the industrial property office...' could be deleted.

Several delegations considered that the consequences of the promise or undertaking mentioned in Article 102(2)(b) should be that such promise or undertaking would be without legal effect only in the procedure before the industrial property office, and not without general legal effect in the civil law. One delegation expressed itself in favor of the deletion of Article 102(2)(b).

The Delegation of the Soviet Union sought clarification on the right of an inventor to renounce being identified where the applicant is the inventor.

Article 102(4). Several delegations suggested that the words 'fixed in the invitation' in Article 102(4)(a)

and (b) should be deleted, since the time limit might be fixed in the national law rather than by the Patent Office.

Some delegations considered that the sanctions provided for in Article 102(4)(b) were too severe, and that sanctions should be decided by the national law. In this respect, it was suggested that the words 'shall entail' be replaced by 'may entail.'

Article 102(5). With one exception, the principle contained in Article 102(5) was considered desirable since it would limit, in the interests of harmonization, the requirements concerning the naming of the inventor.

Clarification was sought by a number of delegations on what constituted 'requirements concerning the naming of the inventor.' The Delegations of Sweden and Norway stated that, if a requirement that an applicant who was not the inventor furnish an assignment of the invention from the inventor were not to be considered as a 'requirement concerning the naming of the inventor,' the general reservations which they had expressed in previous sessions of the Committee of Experts in respect of Article 102 would need to be reconsidered. The International Bureau stated that the requirement of an assignment from the inventor could be considered as relating to the right to file a patent application, rather than a formal requirement concerning the naming of the inventor, and that this question would be studied for the future version of the draft Treaty.

Article 102(6). It was suggested by one delegation that the words 'after the filing of a patent application' be deleted."

Article 103 and Rule 103: Manner of Description

Article 103 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

"An application shall contain a description. The description shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art."

Rule 103 of the draft Regulations as submitted by the International Bureau to the Committee of Experts read as follows:

"(1)(a) Any description drafted in accordance with the provisions of paragraph (2) shall be accepted as satisfying the requirements in respect of the manner of description.

(b) Any national law may provide for requirements in respect of the manner of description which do not contain all the requirements provided for in paragraph (2).

(2) The description shall first state the title of the invention and shall:

- (i) specify the technical field to which the invention relates;*
- (ii) indicate the prior art which, as far as known to the applicant, can be regarded as useful for the understanding, searching and examination of the invention, and, preferably, cite the documents reflecting such art;*
- (iii) disclose the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state the advantageous effects, if any, of the invention with reference to the prior art;*
- (iv) briefly describe the figures in the drawings, if any;*
- (v) set forth at least the best mode contemplated by the applicant for carrying out the invention claimed; this shall be done in terms of examples, where appropriate, and with reference to the drawings, if any; where the national law of a Contracting State does not require the description of the best mode but is satisfied with the description of any mode (whether it is the best contemplated or not), failure to describe the best mode contemplated shall have no effect in that State;*
- (vi) indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is capable of exploitation in industry; the term 'industry' is to be understood in its broadest sense as in the Paris Convention.*

(3) The description shall be presented in the manner and order specified in paragraph (2), unless, because of the nature of the invention, a different manner or a different order would afford a better understanding and a more economic presentation.

(4) Where any requirement prescribed in Article 103 or in this Rule is not complied with, the applicant shall be given an opportunity to amend the application."

The portion of the report of the Committee of Experts concerning the discussion of Article 103 and Rule 103 reads as follows:

"The existing text of Article 103 was approved by most delegations.

The Delegation of Ghana suggested modifying Article 103 by adding the word 'full' before 'description' in the first sentence, and by adding the words 'without undue experimentation' at the end of the Article.

The Representatives of EPO and PTIC expressed the view that the example given in Note d. on Article 103 was not a correct standard on which to decide

whether the invention was disclosed sufficiently clearly, and suggested the deletion, from the third last sentence, of the words 'to have had access to everything in the 'prior art,' in particular, the documents cited in the search reports, and.' The Delegation of the United Kingdom expressed its preference for the existing text of Note d. on Article 103. In response to a request, the International Bureau stated that it would examine the possibility of adding to Note d. on Article 103 a statement drawing attention to different national practices and understandings of the prior art.

Rule 103(2). One delegation suggested that after the expression 'technical field' in item (i) the words 'or fields' should be inserted.

The Delegation of the United States of America and the Representatives of AIPLA and NYPTC suggested replacing the words 'prior art' in items (ii) and (iii) by the words 'background art.'

The Delegations of the United Kingdom, Switzerland, Germany (Federal Republic of), the Netherlands, France and Ghana, and the Representatives of UNICE, EPI, CNIPA, CIPA, FICPI, JPA, CEIPI and APAA, opposed a requirement of the disclosure of the best mode in item (v), on the basis that the requirement would add complications for applicants and also add risk because of the danger that a patent would be invalidated if anything had been left out, as well as burden industrial property offices with additional volumes of paper. It was also doubted whether a 'best mode,' as set out at the time of filing an application, would still be of practical value for third parties wishing to work the invention after the expiry of the patent and without the intermediary information available to or developed by the patent owner during the pendency of the patent.

The delegations and representatives mentioned in the previous paragraph expressed a preference for the corresponding previous text of item (v) contained on page 65 of document HL/CE/IV/2. Alternatively, if it was desired to maintain the possibility of requiring disclosure of the best mode, the text could permit this requirement as an option.

The Delegations of Canada and the United States of America, and the Representatives of AIPLA, NYPTC and PTIC, supported the 'best mode' requirement and the existing text of item (v), emphasizing that a patent represented a contract between an inventor and the State. In return for the disclosure of the invention to the public, the inventor received the right to exclude others from the use of the invention for the period of the validity of the patent. The disclosure of the invention should therefore include a full description of the best mode for carrying out the invention known to the inventor at the time of the filing of the application. It was also noted that items (i) to (vi) of paragraph (2) represented maximum requirements, and that under Rule 103(1)(b) any Contracting State would be free not to

provide for all requirements in respect of the manner of description provided for in paragraph (2).

It was concluded that item (v) of Rule 103(2) should be placed in square brackets.

Rule 103(3). Several delegations suggested substituting the word 'or' for the word 'and' in the third line of paragraph (3).

Rule 103(4). Several delegations suggested deleting the reference to Article 103 in paragraph (4), which it was considered should be limited to amendments of formal deficiencies only.

A number of delegations expressed concern that paragraph (4) might be understood as enabling applicants to supply additional information which might constitute 'new matter.' It was pointed out that amendments would be permitted only if they conformed to the widely accepted rule that matter going beyond the original disclosure could not be introduced."

Article 104 and Rule 104: Manner of Claiming

Article 104 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

"An application shall contain one or more claims. The claim or claims shall define the matter for which protection is sought. The claim or claims shall be clear and concise, and shall be supported by the description."

Rule 104 of the draft Regulations as submitted by the International Bureau to the Committee of Experts read as follows:

"(1)(a) Any claim or claims drafted in accordance with the provisions of paragraphs (2) to (5) shall be accepted as satisfying the requirements in respect of the manner of claiming.

(b) Any national law may provide for requirements in respect of the manner of claiming which do not contain all the requirements provided for in paragraphs (2) to (5).

(2) If there are several claims, they shall be numbered consecutively in arabic numerals.

(3)(a) The definition of the matter for which protection is sought shall be in terms of the technical features of the invention.

(b) A claim may either be written in two parts containing:

- (i) a statement indicating [at least] those technical features of the invention which are necessary for the definition of the claimed subject matter but which, in combination, [are] [appear to be] part of the prior art;*
- (ii) a characterizing portion—preceded by the words 'characterized in that,' 'characterized by,' 'wherein the improvement comprises,'*

or any other words to the same effect—stating concisely the technical features which, in combination with the features stated under (i), it is desired to protect;

or be written as a single part containing a recitation of a combination of several elements or steps, or a single element or step, which distinctly sets forth the subject matter regarded as being the invention.

(4)(a) *Claims shall not, except where absolutely necessary, rely, in respect of the technical features of the invention, on references to the description or drawings, particularly not on such references as: 'as described in part ... of the description,' or 'as illustrated in figure ... of the drawings.'*

(b) *The claims shall not contain drawings or graphs but may contain chemical or mathematical formulae and/or, if desirable, tables.*

(c) *Where the application contains drawings, the technical features mentioned in the claims may, if the intelligibility of the claim can thereby be increased, be followed by reference signs relating to those features and placed between parentheses.*

(5)(a) *Any claim which includes all the features of one or more other claims of the same category shall be referred to hereinafter as 'dependent claim' or 'multiple dependent claim' depending on whether it refers to one or more other claims. It shall contain, if possible at the beginning, a reference to the other claim or claims and shall then state the additional features claimed.*

(b) *Dependent claims or multiple dependent claims may depend on dependent claims or multiple dependent claims. Multiple dependent claims may refer in the alternative or in the cumulative to the claims on which they depend.*

(c) *All dependent claims referring to a single other claim, and all multiple dependent claims referring to several other claims, shall be grouped together in the most practical way possible.*

(6) *Where any requirement prescribed in Article 104 or in this Rule is not complied with, the applicant shall be given an opportunity to amend the application."*

The portion of the report of the Committee of Experts concerning the discussion of Article 104 and Rule 104 reads as follows:

"There were no observations on Article 104, which the Committee of Experts approved in its present form.

Rule 104(1)(a). It was agreed that the words 'Article 104 and' should be added after the words 'the provisions of' in the first line.

Rule 104(3)(a). It was noted that the term 'technical features' should be understood in the broad sense indicated in Note d. on Rule 104, namely, that

technical features may be explained in functional, mathematical or structural terms.

Rule 104(3)(b). A number of delegations and representatives considered that the drafting of Rule 104(3)(b) should be presented in such a way as to make it clear that the applicant would have a free choice to adopt either a single-part claim or a two-part claim. In this respect, it was suggested that the existing provision should be divided into two subparagraphs, one dealing with single-part claims, and the other dealing with two-part claims.

A number of delegations and representatives suggested that it should be explicitly stated that, in two-part claims, the technical features preceding the characterizing portion should not be considered as forming part of the prior art for the mere reason that those technical features appeared in the preamble before the characterizing portion.

It was agreed that the words 'at least' appearing in square brackets in item (i) of Rule 104(3)(b) should be deleted in order to emphasize that claims should be concise and should contain only necessary matter.

The majority of delegations preferred the alternative 'appeared to be' to 'are' in item (i) of Rule 104(3)(b) on the basis that the words 'appeared to be' made it clearer that the part of the claim preceding the characterizing portion did not constitute an admission that the technical features described in this part of the claim constituted part of the prior art. In this regard, several delegations and representatives considered that the words 'may be' would represent a further improvement on the words 'appeared to be.'

One delegation suggested that the words 'containing a recitation of a combination of several elements or steps, or a single element or step' be deleted from the last part of Rule 104(3)(b).

Rule 104(5). One delegation asked that consideration be given to defining, in paragraph (5)(a), the meaning of the term 'the same category' which appeared in the second line.

The Delegations of the United States of America and Canada considered that paragraph (5)(b) should allow a Contracting State the freedom not to accept multiple dependent claims that depend on other multiple dependent claims. These delegations also expressed a preference for not permitting multiple dependent claims to refer in the cumulative to the claims on which they depend.

A number of delegations supported the text of paragraph (5)(b) in its present form, emphasizing that the use of multiple dependent claims which depend on other multiple dependent claims has the effect of reducing the number of claims and delimiting precisely the scope of the protection claimed.

It was requested that the Notes on paragraph (5)(b) include an explanation that the word 'cumulative' was intended to refer to the sum of the claims

on which a multiple dependent claim might depend.

Rule 104(6). The question of the extent to which paragraph (6) would give an applicant the right to amend the description in consequence of an amendment to the claims was discussed. It was agreed that, in accordance with the widely accepted rule, no amendment should be permitted which enlarged the scope of the original disclosure. It was noted, however, that, as stated in Note c. on page 26 of document HL/CE/V/2, matter which was contained only in an original claim, and not in the description, nevertheless constituted part of the original disclosure. On this basis, amendment to the description should be permitted in consequence of an amendment to a claim, provided that the amendment to the claim did not go beyond the original disclosure in the claims or description.

It was agreed that the International Bureau should examine the way in which the right to amend applications should be dealt with in the draft Treaty. One delegation suggested that an additional Article might be needed which dealt expressly with amendments, while a number of other delegations considered that the question of amendments ought to be left to national law.

It was noted that paragraph (6) would not be applicable to national systems in which a substantive examination of patent applications was not conducted."

Article 105 and Rule 105: Unity of Invention

Proposal by the Delegation of the United States of America.

The Delegation of the United States of America presented a proposal for a draft Article and draft Rule on Unity of Invention which had been jointly developed by the Japanese Patent Office, the European Patent Office and the United States Patent and Trademark Office, and which it proposed be included in the draft Treaty and draft Regulations in place of the text of Article 105 and Rule 105 as submitted by the International Bureau to the Committee of Experts. The draft Article and draft Rule proposed by the Delegation of the United States of America are set out, together with explanatory notes, in document HL/CE/V/5. The text of the draft Article and draft Rule, as appearing in that document, read as follows:

"Article

Unity of Invention

(1) A patent application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

(2) Where a group of inventions is claimed, the link in paragraph (1) must be a technical interrelationship

expressed in the claims in terms of the same or corresponding special technical features. The expression 'special technical features' means those technical features which define the contribution which each invention makes over the prior art.

(3) The determination whether a plurality of inventions are so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

(4) Failure to comply with the requirement of unity of invention shall not be a ground for invalidation or revocation of a patent.

Rule Regarding Procedures Relating to Requirement of Unity of Invention

(1) The applicant has the right to file one or more divisional applications, in particular in order to meet an objection of lack of unity of invention with regard to the parent application.

(2) A divisional application may be filed at any time up to at least the time when the parent application is in order for a grant or, where applicable, for publication for pre-grant opposition.

(3) The priority documents, if already filed in the parent application, need not be filed again in the divisional application.

(4) If there is a lack of unity of invention in an application, the invention, or group of inventions within the meaning of paragraphs (1) and (2) of the Article, first mentioned in the claims will be the elected invention for purposes of search and examination."

The portion of the report of the Committee of Experts concerning the discussions of the draft Article and draft Rule proposed by the Delegation of the United States of America reads as follows:

"The Delegation of the United States of America introduced its proposal for a draft Article and draft Rule on Unity of Invention (document HL/CE/V/5) to replace existing Article 105 and Rule 105 in the draft Treaty and draft Regulations. It stated that the proposal had been jointly developed by the Japanese Patent Office, the European Patent Office and the United States Patent and Trademark Office, and represented the result of extensive work undertaken by those three Offices. The Delegation drew particular attention to paragraph (2) of the draft Article. This paragraph, which required a group of inventions to be linked through a technical interrelationship expressed in the claims in terms of the same or corresponding special technical features, contained a conceptual principle through which it was sought to explain the application of unity of invention in all situations and for all categories of inventions.

It was agreed that more time was needed in which to study the proposal, and that detailed consideration of the proposal should be postponed until the next session of the Committee of Experts.

It was also agreed, following a proposal by the Delegation of the Soviet Union, that delegations

should be able to send written comments on the proposal to the International Bureau before February 15, 1989, and that these comments should be distributed by the International Bureau before the next session of the Committee of Experts."

The text of Article 105 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

"(1) An application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (requirement of unity of invention)."

(2) Failure to comply with the requirement of unity of invention shall not be a ground for invalidation or revocation of a patent."

The text of Rule 105 of the draft Regulations as submitted by the International Bureau to the Committee of Experts read as follows:

"(1) The requirement of unity of invention shall be deemed to be complied with where the following combinations of claims of different categories are included in the same application:

(i) the combination of an independent claim for a given product with:

(a) an independent claim for a process for, or also for, the manufacture of the said product (combination A + B);

(b) an independent claim for a use of the said product (combination A + C);

(c) an independent claim for a process for, or also for, the manufacture of the said product, and an independent claim for a use of the said product (combination A + B + C);

(d) an independent claim for a process for, or also for, the manufacture of the said product, and an independent claim for a means for, or also for, carrying out the said process (combination A + B + D);

(e) an independent claim for a process for, or also for, the manufacture of the said product, an independent claim for a means for, or also for, carrying out the said process, and an independent claim for a use of the said product (combination A + B + D + C);

(ii) the combination of an independent claim for a given process with an independent claim for a means for, or also for, carrying out the said process (combination B + D).

(2) The order in which the claims appear in any of the combinations referred to in paragraph (1) may be different from the order used in that paragraph.

(3) The inclusion in the same application of independent claims of different categories in combinations other than the combinations referred to in para-

graph (1), or of claims of the same category, or of dependent claims and of multiple dependent claims (even where the features of a dependent claim or of a multiple dependent claim constitute in themselves an invention), shall be allowed to the extent that the requirement of unity of invention is complied with."

The portion of the report of the Committee of Experts concerning the discussion of Article 105 and Rule 105 of the draft Treaty and the draft Regulations, as submitted by the International Bureau to the Committee of Experts, reads as follows:

"It was suggested by one delegation and one representative that the words 'so linked as to form a single general inventive concept' in paragraph (1) of Article 105 should be replaced by the words 'linked by a single general inventive concept.'"

Further discussion of Article 105 and Rule 105 was postponed until the next session of the Committee of Experts when these provisions would be considered in conjunction with the proposal of the United States of America (document HL/CE/V/5)."

Article 201: Grace Period

Article 201 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

"(1) A patent shall not be refused or held invalid under any national law by virtue of the fact that a disclosure was made which may affect the patentability of the invention that is the subject of an application for that patent or of that patent, provided that the said disclosure was made:

(i) by the inventor, or

(ii) by a third party, other than an industrial property office, based on information obtained from, or in consequence of acts performed by, the inventor, or

(iii) by an industrial property office in the form of an official publication, pursuant to an application filed without the consent of the inventor and based on information obtained from, or in consequence of acts performed by, the inventor,

and provided that the said disclosure occurred not more than 12 months before the date on which the application for that patent was filed by the inventor or, where priority is claimed, before the priority date.

(2) For the purposes of paragraph (1), 'inventor' also means a co-inventor or the co-inventors as well as any natural person or legal entity other than the inventor who or which is entitled to the grant of a patent for the invention at the date of the application, such as his successor in title or an employer automatically entitled to the invention, and 'third party'

means any natural person or legal entity other than the inventor as defined in this paragraph.

(3) For the purposes of paragraph (1), 'disclosure' means making available to the public by written or oral means, or by use or in any other way.

(4) For the purposes of paragraph (1), the applicant or the owner of the patent shall have the burden of proof in respect of the conditions stated in that paragraph."

The portion of the report of the Committee of Experts concerning the discussion of Article 201 reads as follows:

"It became clear from the discussions that a general consensus had developed as to the principle itself of a grace period (although for some delegations it was acceptable only in a package deal).

Article 201(1) and (2). Several proposals were made in order to refine and clarify various concepts and terms in these provisions. In light thereof, the following revised text was submitted by the Delegation of the United Kingdom, and approved by the Committee of Experts:

"(1) A patent shall not be refused or held invalid by virtue of the fact that information has been disclosed which may affect the patentability of the invention that is the subject of an application for that patent or of that patent, provided that the information was disclosed:

- (i) by the inventor, or
- (ii) where the information was obtained directly or indirectly from the inventor, by a third party, or an industrial property office either erroneously or pursuant to an application filed without the consent of the inventor,

and provided that the disclosure of the said information occurred not more than 12 months before the date on which the application for that patent was filed by the inventor or, where priority is claimed, not more than 12 months before the priority date.

(2) For the purposes of paragraph (1), 'inventor' also means a co-inventor or the co-inventors as well as any natural person or legal entity other than the inventor who or which is entitled to the grant of a patent for the invention at the date of the application, such as his successor in title or an employer automatically entitled to the invention, and 'third party' means any natural person or legal entity other than the inventor as defined in this paragraph, including an industrial property office not acting in pursuance of an application."

As regards the question of the length of the grace period, among the delegations and representatives who spoke, a majority favored a 12-month grace period (Canada, Denmark, Germany (Federal Republic of), Ireland, Soviet Union, Switzerland, United Kingdom, United States of America, AIPLA, AIPPI, FICPI, IFIA, JPAA, LES, NYPTCLA, PTIC, UEPIP); a certain number preferred a six-month grace period (Belgium, Republic of Korea, Japan, Netherlands, Poland, EPI, CNIPA, CIPA, JPA).

Article 201(3). The substance of this provision was accepted, subject to minor drafting changes now required as a result of the revision of paragraphs (1) and (2).

Article 201(4). Except for the reservations expressed by the Delegation of Denmark and the Representative of the CEC, those who spoke supported this provision, it being understood that it dealt with the question of the burden of proof if the novelty of the invention or its non-obviousness was contested on the basis of information the disclosure of which benefited from the period of grace and not of when and how the grace period was to be claimed by the applicant, which was left to national law."

Article 202: Prior Art Effect of Applications

Article 201 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

"(1) *The whole contents of an application as filed in, or with effect for, a Contracting State shall, for the sole purpose of determining the novelty, but not the inventive step, of an invention claimed in another application filed in, or with effect for, that State, be considered under the national law applicable in the said State as prior art from the date on which the former application was filed or, where priority is claimed, from the priority date for matter contained in both the former application and the application on which the priority claim is based, to the extent that the former application or the patent granted thereon is published subsequently.*

(2) *For the purposes of paragraph (1), 'published' means any first act of making available to the public by reason of an official act, including any making available of the application to the public for purposes of public inspection without reproduction of the application, whether such act occurs prior to or by reason of the grant of a patent on the application.*

(3) *For the purposes of paragraph (1), 'whole contents' of an application consists of the description and any drawings, as well as the claims, but not the abstract.*

(4) *Paragraph (1) shall not apply to applications which were withdrawn prior to their publication but which were nevertheless published.*

(5) *As regards international applications filed under the Patent Cooperation Treaty, any national law may prescribe that paragraph (1) shall apply only if the acts referred to in Article 22 or, where applicable, Article 39(1) of that Treaty have been performed.*

[(6) *Each Contracting State shall be free not to apply paragraph (1) when the applicant of the former application [, or the inventor referred to in the former application,] and the applicant of the application*

under examination [, or the inventor referred to in the latter application,] is one and the same person, provided that not more than one patent shall be granted for the same invention.]"

The portion of the report of the Committee of Experts concerning the discussion of Article 202 reads as follows:

"Article 202(1). There was general agreement as to the substance of this provision; several proposals and suggestions were made as to the need for certain clarifications of a drafting nature. The Representative of AIPLA suggested that the International Bureau study the effective scope of novelty in Japan and in Member States of the European Patent Convention and recommend a definition of novelty that would produce uniform results in all countries.

Article 202(2) to (5). There were no observations on these provisions.

Article 202(6). Differing and frequently opposing views were expressed with respect to this provision. A majority supported, or at least did not oppose, retaining the provision; some delegations and representatives considered an internal priority provision more desirable or a useful addition to the existing provision. Some expressed the desire that the rule contained in paragraph (6) remain optional; others proposed that it be made mandatory. A majority supported deleting the brackets around the references to the 'inventor,' and many emphasized the desirability of the proviso against double-patenting. Some delegations preferred the deletion of the paragraph.

The Chairman suggested that, in light of the variety of opinions expressed, paragraph (6) remain in brackets in the next version of the draft Treaty in order to permit further re-thinking and discussion of the provision and that the International Bureau examine the possibility of introducing a provision on internal priority."

Additional Proposals and Ideas

During the second part of the fifth session, the Delegation of Japan proposed the addition of new paragraphs to Articles 302, 307 and 308 of the draft Treaty (document HL/CE/V/6). The text of the proposed new paragraphs, as presented by the Delegation of Japan, read as follows:

"Article 302: Rights Conferred by a Patent and Opposition and/or Re-examination

(1)-(4) [The provisions concerning the rights conferred by a patent now under consideration (see WIPO draft 302(1)(4))]

(5)(a) A Contracting State shall provide any person with an opportunity to file pre-issue and/or post-issue

opposition to the competent authorities with respect to any allowed application or issued patent.

(b) A Contracting State shall be free not to permit opposition on the ground of failure to fulfill any requirement irrelevant to the validity of a patent.

(6) Any Contracting State shall provide an applicant or a patentee and an opponent with a fair opportunity to make an argument.

Article 307: Publication of Applications and Provisional Protection

(1) Any pending application shall be published, at latest, promptly after the expiration of 18 months from its filing date or, where priority is claimed, the priority date or, in the case of divisional, continuation or continuation-in-part application, from the earliest filing date of that application, unless the application contains expressions or drawings which, in the opinion of the competent authority, is contrary to morality or public order.

(2) [The provisions concerning the provisional patent right now under consideration (see WIPO draft Article 307(1)(2))].

Article 308: Prior Users' Rights and Correction of Issued Patent

(1) [The provisions concerning the prior users' rights now under consideration (see WIPO draft Article 308)].

(2) A Contracting State shall provide a patentee with an opportunity to correct the issued patent.

(3) Such correction shall not enlarge the scope of the claim or claims."

The portion of the report of the Committee of Experts concerning the discussion of the proposals of the Delegation of Japan reads as follows:

"The Delegation of Japan introduced its proposal for the addition of new paragraphs to Articles 302, 307 and 308 (document HL/CE/V/6):

(a) In respect of the proposed additional paragraphs to Article 302, the Delegation stated that the intention of the new paragraphs was to ensure, to the maximum extent possible, that patents were granted only on valid grounds by requiring Contracting States to provide a system of opposition and/or re-examination in conditions providing applicants or patentees, and opponents, with a fair opportunity to be heard. The absence of such a system would increase defective patents which might not only bring about undue profits of the patent owner but restrict the availability of technology which otherwise any person could enjoy and, as a result, impede the development of industry. The Delegation clarified that the words 'any requirement irrelevant to the validity of a patent' in draft Article 302(5)(b) of its proposal were intended to refer to any requirements other than the substantive grounds of patentability.

(b) With regard to the proposed new paragraphs of Article 307, the Delegation stated that the intention of the paragraphs was to maximize the availability of the technological information contained in patent documentation, thereby

avoiding duplication in research and development and stimulating further research and development.

(c) Concerning the proposed new paragraphs of Article 308, the Delegation stated that the intention of the paragraphs was to provide a patent owner with the opportunity to make corrections to an issued patent which did not go beyond the scope of the accepted claim or claims.

The Delegation of the United States of America, while reserving its position on the substance of the proposal of the Delegation of Japan, endorsed the referral of the proposal to the International Bureau for further examination and for consideration by the Committee of Experts at its next session. In addition, the Delegation of the United States of America stated that it wished to present two further ideas for referral to the International Bureau for examination and consideration by the Committee of Experts at its next session:

(a) The first idea related to one of the matters dealt with in the proposal of the Delegation of Japan, namely, opposition proceedings. In this respect, the Delegation of the United States of America wished to propose that a provision be introduced which would ensure that opposition proceedings (essentially, proceedings contesting the validity of claims) could be instituted only after the grant of a patent. Such a provision would avoid the situation, which occurred too frequently, in which a patent term had expired or had been substantially reduced before opposition proceedings, instituted prior to grant, were concluded, thus denying the patent owner the proper enjoyment of his right.

(b) Secondly, the Delegation of the United States of America said that it was necessary to prevent that the effective term of protection may be shortened, as it frequently is in deferred examination systems, because search and examination were not completed for a very long time. The Delegation drew attention to the large amount of published patent applications, which might mature into rights affecting competitors, citing, as an example, 2,511,000 published patent and utility model applications in the Japanese language, which placed an immense burden of surveillance on those doing business in Japan. The Delegation proposed that a provision should be introduced which would require searches to be completed not later than 18 months after the filing date of an application for a patent, and which would require that substantive examination be commenced within 36 months after the filing date of an application for a patent.

On a question of the Director General, the Delegation said that the proposal would mean that both the application and the search report would have to be published within 18 months of the filing date.

The majority of delegations, while reserving their position on the proposals and ideas of the Delegation

of Japan and of the United States of America, endorsed the referral of those proposals and ideas to the International Bureau for further study since they were likely to result in a better and faster flow of technological information, in introducing more transparency into patent systems, and in contributing to a better balance between the interests of patent applicants and owners, competitors and the public.

The Delegation of Brazil expressed its support in principle for the proposals of the Delegation of Japan, emphasizing, among other things, the usefulness and even necessity of proposals like that relating to Article 307 on the dissemination of technological information, or that, attached provisionally to Article 302, permitting a form of 'public inspection' of patent applications.

Several delegations expressed the view that, with the addition of the new proposals and ideas of the Delegations of Japan and the United States of America, the list of subjects to be treated in the draft Treaty and the draft Regulations should be closed.

The Delegation of Belgium opposed further consideration of the proposals of the Delegation of Japan and the ideas presented by the Delegation of the United States of America on the basis of the difficulties which those proposals and ideas would raise for countries not having systems of search and examination or opposition.

The Delegation of the Netherlands opposed further consideration of the ideas presented by the Delegation of the United States of America on the basis that the ideas would introduce substantial practical difficulties for countries having systems of deferred examination and that, consequently, it was doubtful that the ideas would find acceptance.

The Committee of Experts agreed to ask the International Bureau to cover, in the next draft of the Treaty, the proposals and ideas of the Delegations of Japan and the United States of America. It was understood that the International Bureau would express the ideas in these proposals in a style consistent with the other provisions of the draft Treaty and that it would also take into account the fact that several national systems did not provide for search, examination or opposition."

Provisions of the Draft Treaty and the Draft Regulations Previously Discussed at the First Part of the Fifth Session

At the conclusion of the discussions set out above, the Chairman invited new observations concerning those Articles and Rules of the draft Treaty and the draft Regulations which had been discussed at the first part of the fifth session, held in Geneva from June 13 to 17, 1988.

The portion of the report concerning these observations reads as follows:

*"Article 203: Exclusions from Patent Protection"*³

The Delegation of the United Kingdom drew attention to the use of the word 'invention' in paragraph (1) of Article 203 and to the fact that, as indicated in Note b. on Article 203, no definition of 'invention' was contained in the draft Treaty or the draft Regulations. The Delegation expressed the view that agreement on a general definition of what constituted an invention would constitute a major step of harmonization.

It was agreed that the International Bureau should prepare draft definitions of 'invention' and 'patentable invention' for consideration at the next session of the Committee of Experts for inclusion in the draft Treaty.

The Delegation of Brazil reaffirmed the opposition which it had expressed at the first part of the fifth session concerning Article 203 of the draft Treaty. It considered that the process of harmonization should represent an attempt at making homogeneous differing provisions in national laws dealing with essentially procedural matters, whereas the question of exclusions from patent protection constituted a matter on which widely divergent approaches of substance were adopted by various countries. The Delegation recalled, in this respect, that legitimate recourse to exclusions in the pharmaceutical sector had provoked, on the part of one large country, illegal unilateral retaliatory measures of an economic nature against its country, as well as threats of the application of the same sanctions against another Latin America country. Such matters were matters that affected vital national interests and the economic policy of governments and, consequently, the sovereignty of the States should not be touched by obligations that a Treaty would place upon them. The Delegation emphasized that certain provisions in the draft Treaty could be considered as reflecting national industrial strategies, citing, as an example, the proposal of the Delegation of Japan on early publication of patent applications (document HL/CE/V/6). The Delegation drew attention to the use of exclusions from patent protection by developing countries as part of the strategy for national industrial development, and stated that this strategy should likewise find expression in the draft Treaty, taking also into account studies made by other bodies such as UNCTAD. The Delegation also asked how it would be possible for the International Bureau to prepare a new draft of Article 203, given the widely divergent positions which had been

expressed in respect of it at the first part of the fifth session.

The Delegation of Argentina also re-affirmed its opposition to the inclusion of Article 203 in the draft Treaty. It stated that, in view of the different positions and the doubts and reserves which had been expressed in respect of Article 203 at the first part of the fifth session, and in view of the lack of agreement on certain questions concerning not only biotechnological inventions which had been expressed at the fourth session of the Committee of Experts on Biotechnological Inventions and Industrial Property, held from October 24 to 28, 1988, but also plant variety protection which had been expressed within the Union for the Protection of New Varieties of Plants (UPOV), it did not consider that agreement was possible on an Article dealing with exclusions. The Delegation also emphasized the particular difficulty associated with exclusions relating to pharmaceutical processes and products, emphasizing the importance of the pharmaceutical sector in its own country, and the firmness with which its Delegation would insist on an exclusion from patent protection in respect of this sector.

In response to the observations made by the Delegations of Brazil and Argentina, the Director General stated that the lack of agreement which existed with respect to Article 203 would be reflected in the new draft to be prepared by the International Bureau by way of alternatives, ranging from an alternative allowing no exclusions to an alternative which would exclude Article 203 from the draft Treaty and intermediary solutions such as time limits for the introduction of any new obligations or the possibility of excluding them through reservation. In response to a further question of the Delegation of Argentina, the Director General stated that the same kind of proposals would be made also in respect of Articles 302, 303 and 305.

*Article 303: Extension of Process Patent Protection to Products; Reversal of Burden of Proof*⁴

The Delegations of Argentina and Brazil reaffirmed their opposition to the inclusion of Article 303 in the draft Treaty, stating that this Article caused the greatest difficulties for developing countries. These Delegations also confirmed the reservations which they had expressed during the first part of the fifth session on Articles 302, 304 and 305, as well as Rule 304. They also stated that it would be desirable for further study to be carried out, in consultation with bodies such as UNCTAD and UNIDO, on the impact on developing countries of Articles 203, 303, 304 and 305. The Delegations

³ The text of Article 203 of the draft Treaty and the discussions concerning this Article during the first part of the fifth session of the Committee of Experts are set out in the Note on the first part of the fifth session in *Industrial Property*, 1988, pp. 380 to 382.

⁴ The text of Article 303 of the draft Treaty and the discussions concerning this Article during the first part of the fifth session of the Committee of Experts are set out in the Note on the first part of the fifth session in *Industrial Property*, 1988, pp. 365 to 368.

emphasized that the standards of the most technologically sophisticated countries should not be considered to be the only valid criteria or norms for international standards. In addition, the Delegation of Argentina drew attention to the particular impact which Article 303 would have on its pharmaceutical industry, and to the intermediate level of development which its country enjoyed and wished to augment.

Article 308: Prior Users' Rights⁵

The Delegation of Belgium emphasized the importance which it attached to the establishment of a link between the provisions of Article 201 and those of Article 308.

General

The Delegation of the United States of America stated that it was in the best interests of all countries to conclude as rapidly and as completely as possible the work on the draft Treaty. It emphasized that all of the Articles in Chapters II and III served a useful purpose in stimulating the benefits of technology on a worldwide basis. It also stressed that the present exercise was directed at the conclusion of a Special Agreement under the Paris Convention for the Protection of Industrial Property, rather than an agreement for the non-protection of industrial property, so that it was inappropriate to discuss the possibility of reservations on the part of Contracting States to the provisions of the Treaty. All delegations came to the negotiations with the knowledge that adherence to the proposed Treaty would involve some change in national legislation, so that such changes should be the subject of negotiations rather than the expression of a desire to make a reservation.

The Representative of ALIFAR stated that, in respect of the Articles in Chapter III, the rights of patent users must be taken into account in addition to those of consumers and inventors. She stated that the antinomy between the patent system and other economic policy objectives explained and justified the special provisions which had always pertained in some countries in respect of pharmaceuticals. The Representative expressed the hope that the harmonization exercise would take into account differing levels of development, and the consensus in Latin American countries, including both governments and enterprises, against the inclusion of patent protection for pharmaceuticals. She also stated that unilateral measures designed to provoke changes in the application of patent protection to pharmaceuticals affected the credibility of multilateral institu-

tions, and that provisions ought not to be introduced into a multilateral treaty until pending bilateral discussions or disputes in respect of the same subject matter had been resolved."

Future Work

The portion of the report reflecting the discussions of the Committee of Experts concerning future work in relation to the draft Treaty and the draft Regulations reads as follows:

"The Committee of Experts agreed that the future work in respect of the draft Treaty and the draft Regulations should proceed as follows:

(a) The sixth session of the Committee of Experts would be convened in Geneva, from April 24 to 28, 1989, and would consider Articles 105, 301, 304, 306, 307, 308 and 309, together with the corresponding Rules, on the basis of drafts prepared by the International Bureau, as well as draft provisions corresponding to the proposals of the Delegation of Japan (document HL/CE/V/6) and the ideas presented by the Delegations of the United States of America and the United Kingdom.

(b) The seventh session of the Committee of Experts would be convened in Geneva for a period of two weeks in October or November 1989.

(c) It was agreed (subject to the reservations noted) that the further work of the Committee of Experts should be limited to the questions considered in this and the previous meetings of the Committee of Experts and that no new questions should be added to those questions.

(d) The question of the convening of a Diplomatic Conference for the conclusion of the Treaty, and of the date of that Diplomatic Conference, would be submitted to the next ordinary sessions of the Governing Bodies of WIPO and the Paris Union to be held from September 25 to October 4, 1989."

LIST OF PARTICIPANTS**

I. States

Argentina: A.G. Trombetta. **Australia:** M.P.F. Smith. **Belgium:** D. Vanderghenst. **Brazil:** P. de Almeida; A.R. Holanda Cavalcanti. **Bulgaria:** M. Popov. **Cameroon:** I. Meutcheye. **Canada:** J.H.A. Gariépy; J. Gero; A.M. Troicuk. **Czechoslovakia:** A. Vokálek; M. Hujerová. **Denmark:** L. Østerborg; S.C. Pedersen; N. Ravn. **Egypt:** N. Gabr. **Finland:** E. Häkli; E.-L. Vilkkonen; E. Nourlahti-Solarmo. **France:** M. Guerrini; J. Divoy. **German Democratic Republic:** S. Schröter. **Germany (Federal Republic of):** I. Koch; D. Schennen; H. Bardehle; W. Niedlich. **Ghana:** M. Abdullah. **Greece:** A. Cambitsis. **Hungary:** I. Iványi; Z. Szabó; M. Sümeghy.

⁵ The text of Article 308 of the draft Treaty and the discussions concerning this Article during the first part of the fifth session of the Committee of Experts are set out in the Note on the first part of the fifth session in *Industrial Property*, 1988, pp. 376 to 379.

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

Ireland: B. O'Farrell. **Italy:** M.G. Fortini. **Japan:** T. Yoshida; Y. Muranaga; S. Takakura. **Mexico:** A. Fuchs. **Netherlands:** W. Neervoort. **Norway:** P.T. Lossius; E. Liljegren. **Philippines:** A. Catubig. **Poland:** G. Lachowicz. **Republic of Korea:** T.-C. Choi. **Soviet Union:** G. Gourianov; A. Kortchaguine. **Spain:** A.-C. Ortega Lechuga. **Switzerland:** J.-L. Compte; P. Messerli; F.A. Jenny. **Tunisia:** H. Tebourbi. **Turkey:** A. Algan. **United States of America:** D.J. Quigg; M.K. Kirk; L.J. Schroeder; R.F. Burnett; T. McMahon; D.J. Harmer; D.R. Patterson. **United Kingdom:** A. Sugden; P. Hayward. **Uruguay:** I. Rodriguez.

II. Observer States

Panama: M. Saavedra Polo.

III. Intergovernmental Organizations

General Agreement on Tariffs and Trade (GATT): A. Subramanian. **Commission of the European Communities (CEC):** S. Keegan; L.M. Ferrao. **European Patent Office (EPO):** U. Schatz; A.G. Remond; R. Teschemacher; G. Metaxas-Maranghidis

IV. Non-Governmental Organizations

American Bar Association (ABA): L.B. Mackey. **American Intellectual Property Law Association (AIPLA):** J.A. De Grandi. **Arab Society for the Protection of Industrial Property (ASPIP):** H. Bourguiba, Jr. **Asian Patent Attorneys Association (APAA):** I. Shamoto; K. Leslie; N. Ogawa. **Bundesverband der Deutschen Industrie e.V. (BDI):** H.-J. Schulze-Steinen. **Centre for International Industrial Property Studies (CEIPI):** B. de Passemar. **Chartered Institute of Patent Agents (CIPA):** R.C. Petersen. **Committee of National Institutes of Patent Agents (CNIPA):** R.C. Petersen. **Federal Chamber of Patent Attorneys (FCPA):** G. Schmitt-Nilson. **International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP):** W. Fryer. **International Association for the Protection of**

Industrial Property (AIPPI): M. Santarelli. **International Chamber of Commerce (ICC):** J. Buraas. **International Federation of Industrial Property Attorneys (FICPI):** J. Beier; G. Schmitt-Nilson. **International Federation of Inventors' Associations (IFIA):** C.P. Feldmann; P.J.H. Berna. **International Federation of Pharmaceutical Manufacturers Associations (IFPMA):** H.-J. Schulze-Steinen. **Institute of Professional Representatives Before the European Patent Office (EPI):** R.C. Petersen. **Japan Patent Association (JPA):** M. Takada. **Latin American Association of Pharmaceutical Industries (ALIFAR):** M.N. Levis; M. Jimenez. **Licensing Executives Society (International)(LES):** C. Osterrieth. **Max Planck Institute for Foreign and International Patent, Copyright and Competition Law (MPI):** J. Pagenberg. **New York Patent, Trademark and Copyright Law Association, Inc. (NYPTCLA):** P.H. Heller; M.N. Meller. **Patent Attorneys Association of Japan (JPAA):** M. Yanagida. **Patent and Trademark Institute of Canada (PTIC):** R.E. Mitchell. **Union of Industrial and Employers' Confederation of Europe (UNICE):** R.S. Crespi; H. Goldrian. **Union of European Practitioners in Industrial Property (UEPIP):** J. Beier.

V. Officers

Chairman: J.-L. Compte (Switzerland). **Vice Chairmen:** M. Abdullah (Ghana); G. Gourianov (Soviet Union). **Secretary:** L. Baeumer (WIPO).

VI. International Bureau of WIPO

A. Bogsch (*Director General*); **A. Schäfers** (*Deputy Director General*); **L. Baeumer** (*Director, Industrial Property Division*); **F. Gurry** (*Head, Industrial Property Law Section, Industrial Property Division*); **J. Quashie-Idun** (*Head, Developing Countries Section, Industrial Property Division*); **H. Lom** (*Senior Legal Officer, Industrial Property Law Section*); **B. Ibos** (*Legal Officer, Industrial Property (Special Projects) Division*); **S. Zotine** (*Legal Officer, Industrial Property (Special Projects) Division*); **T. Niinomi** (*Associate Officer, Industrial Property Law Section*).

Studies

Selection and Protection of Marks

Y. PLASSERAUD*

Books and Articles

Book Reviews

Handbuch Erfindertätigkeit, by J. Hemmerling, K. Henkel *et al.* Edited by the Office for Inventions and Patents of the German Democratic Republic, Verlag Die Wirtschaft, Berlin 1988. — 336 pages.

The book under review is a manual on inventive activities prepared by a team of authors from the Office for Inventions and Patents of the German Democratic Republic, under the leadership of its President, Professor J. Hemmerling. It describes the general political principles which guide the authorities of the German Democratic Republic when promoting inventive activities in socialist enterprises and research institutions and stresses, in particular, the outstanding importance technological progress has for the development of society. Particular emphasis is placed on the necessity of obtaining protection for the results of inventive activities, not only in the German Democratic Republic itself but also in other socialist countries and in non-socialist countries in view of competition on the markets.

The manual explains the intellectual and psychological attitudes and motivations which create a favorable environment for inventiveness in individual persons and induce such persons to be constantly on the alert for creative solutions to newly arising technical problems. It outlines the basic elements authorities and enterprises should take into account when setting targets for such solutions to be found by researchers and inventors and when preparing the implementation and exploitation of inventive achievements.

In this context, the manual underlines the outstanding role the systematic use of patent information and documentation has to play in the definition of targets and the general range of solutions that meet the criteria of patentability, in order to keep track of the most advanced technology on a worldwide scale. The manual indicates the various sources for patent information and documentation, explains the appropriate procedures for state of the art searches and gives a detailed description of the services offered by the Office for Inventions and Patents.

A special section of the manual deals with the legal framework for the protection of inventions, based on the legislation of the German Democratic Republic on inventions and other related instruments, and describes the procedures for the obtaining and defending of patent protection, the functions of the Office for Inventions and Patents in this respect, possibilities of appeal and judicial review and the role of the offices of patent attorneys and collegia of lawyers.

Another section covers the international aspects of protection for inventions, the internal procedures for the filing of patent applications abroad and for the granting of licenses on the basis of protective titles. The text refers to the relevant provisions of the Paris Convention for the Protection of Industrial Property, of international treaties

concluded with other socialist countries and of the European Patent Convention as an instrument for the marketing of protected products and processes in member countries of the European Patent Organisation. It also gives an outline of the system established by the Patent Cooperation Treaty and mentions that the German Democratic Republic is not yet a Contracting State to the PCT.

The manual concludes with detailed information on incentives and stimulants for inventive activities available for enterprises and research institutions, the functions and tasks of the bureaux for protection rights (*Büros für Schutzrechte*) and the continuous evaluation of technological and economic achievements reached by means of protected inventions and the promotion of inventive activities.

The book gives valuable and comprehensive information about the general structure of the protection for inventions and the promotion of inventive activities under the conditions of a social system with a centrally planned economy.

AS

License, Assign, But Don't Endanger Your Trade Mark, European Communities Trade Mark Practitioners' Association, London, 1988. — 101 pages.

This work, the fourth to be published by the European Communities Trade Mark Practitioners Association (ECTA), contains a series of reports submitted to the Annual Conference of the Association held in Copenhagen in 1987.

The various reports deal with the complex matter of the assignment and licensing of marks as reflected in the laws of various European countries (Benelux countries, France, Germany (Federal Republic of), Greece, Spain, United Kingdom) and in the draft for the proposed European Community trade mark. The work of specialists, who are at the same time practitioners, these reports contain a concisely expressed sum of information that will be of the greatest help to all those involved in managing trademarks at an international level. The second part of the work contains the text of the statements made by various speakers during a round table devoted to the problem of assignment and licensing.

ECTA has previously published three works likely to interest trademark practitioners: *Distinctiveness Requirements for Trade-marks*, *Opposition on the Basis of Non-Registered Rights*, *Use to Maintain Rights in EC Countries*.

PM

New Items

AUSTRIA

President, Austrian Patent Office

We have been informed that Dr. Joseph Fichte has been appointed President of the Austrian Patent Office.

ISRAEL

Commissioner of Patents, Designs and Trade Marks

We have been informed that Mr. Michael Ophir has been appointed Commissioner of Patents, Designs and Trade Marks.

MEXICO

Director General of Technological Development

We have been informed that Dr. Roberto Villarreal Gonda has been appointed Director General of Technological Development.

PERU

Director of Industrial Property

We have been informed that Dr. Luis Alberto López Sousa has been appointed Director of Industrial Property.

POLAND

President, Patent Office of the Polish People's Republic

We have been informed that Dr. ing. Wiesław Kotarba has been appointed President of the Patent Office of the Polish People's Republic.

Calendar of Meetings

WIPO Meetings

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

1989

February 20 to March 3 (Geneva)

Committee of Experts on Model Provisions for Legislation in the Field of Copyright (First Session)

The Committee will consider proposed standards in the field of literary and artistic works for the purposes of national legislation on the basis of the Berne Convention for the Protection of Literary and Artistic Works.

Invitations: States members of the Berne Union or WIPO and, as observers, certain organizations.

April 3 to 7 (Geneva)

WIPO Permanent Committee for Development Cooperation Related to Copyright and Neighboring Rights (Eighth Session)

The Committee will review and evaluate the activities undertaken under the WIPO Permanent Program for Development Cooperation Related to Copyright and Neighboring Rights since the Committee's last session (March 1987) and make recommendations on the future orientation of the said Program.

Invitations: States members of the Committee and, as observers, States members of the United Nations not members of the Committee and certain organizations.

April 10 to 21 (Geneva)

Diplomatic Conference for the Conclusion of a Treaty on the International Registration of Audiovisual Works

The Diplomatic Conference will negotiate and should adopt a Treaty on the international registration of audiovisual works and Regulations under that Treaty.

Invitations: States members of WIPO and, as observers, States members of the United Nations not members of WIPO and certain organizations.

April 24 to 28 (Geneva)

Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions (Sixth Session)

The Committee will continue to examine a draft treaty on the harmonization of certain provisions in laws for the protection of inventions.

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

May 8 to 26 (Washington)

Diplomatic Conference for the Conclusion of a Treaty on the Protection of Intellectual Property in Respect of Integrated Circuits

The Diplomatic Conference will negotiate and should adopt a Treaty on the protection of layout-designs of integrated circuits.

Invitations: States members of WIPO or the Paris or Berne Unions and, as observers, States members of the United Nations not members of WIPO or the Paris or Berne Unions and certain organizations.

May 29 to June 2 (Geneva)

WIPO Permanent Committee for Development Cooperation Related to Industrial Property (Thirteenth Session)

The Committee will review and evaluate the activities undertaken under the WIPO Permanent Program for Development Cooperation Related to Industrial Property since the Committee's last session (May 1988) and make recommendations on the future orientation of the said Program.

Invitations: States members of the Committee and, as observers, States members of the United Nations not members of the Committee and certain organizations.

June 12 to 28 (Madrid)

Diplomatic Conference for the Conclusion of a Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

The Diplomatic Conference will negotiate and should adopt a Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

Invitations: States members of the Madrid Union, Denmark, Greece, Ireland, the United Kingdom and, as observers, the other States members of the Paris Union as well as certain organizations.

- June 26 to July 3 (Paris)** **Berne Union for the Protection of Literary and Artistic Works: Executive Committee (Extraordinary Session)** (sitting together, for the discussion of certain items, with the Intergovernmental Committee of the Universal Copyright Convention)
- The Committee will mainly review the activities undertaken and the meetings held since the Committee's last session (June 1987) as far as substantive issues of copyright protection are concerned.
- Invitations:* States members of the Executive Committee of the Berne Union and, as observers, other States party to the Berne Convention and certain organizations.
- July 5 to 7 (Geneva)** **Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations: Intergovernmental Committee (Ordinary Session)** (convened jointly with ILO and Unesco)
- The Committee will review the status of the international protection of neighboring rights under the Rome Convention.
- Invitations:* States members of the Intergovernmental Committee and, as observers, other States members of the United Nations and certain organizations.
- September 25 to October 4 (Geneva)** **Governing Bodies of WIPO and the Unions Administered by WIPO (Twentieth Series of Meetings)**
- All the Governing Bodies of WIPO and the Unions administered by WIPO meet in ordinary sessions every two years in odd-numbered years.
- In the sessions in 1989, the Governing Bodies will, *inter alia*, review and evaluate activities undertaken since July 1988, and consider and adopt the draft program and budget for the 1990-91 biennium.
- Invitations:* States members of WIPO and the Unions and, as observers, other States members of the United Nations and certain organizations.
- September 26 (Geneva)** **Permanent Committee on Industrial Property Information (PCIPI) (Second Session)**
- The Committee will discuss its main activities and plans for the future.
- Invitations:* States and organizations members of the Committee and, as observers, certain other States and organizations.
- October 9 to 13 (Moscow)** **International Forum on the Role of Industrial Property in Economic Cooperation Arrangements** (organized jointly with the State Committee for Inventions and Discoveries of the Soviet Union)
- The Forum will deal with questions of industrial property in joint ventures (among capitalist and socialist countries) and other cooperative economic arrangements (among capitalist and socialist countries), particularly in the field of the transfer of high technology, trade in goods bearing trademarks and franchizing of services.
- Invitations:* The Forum will be open to the public. Participants, other than representatives of governments, will be requested to pay a registration fee.
- November 1 and 2 (Beijing)** **Worldwide Symposium on the International Patent System in the 21st Century** (organized jointly with the Chinese Patent Office)
- The Symposium will be conducted in three half-day sessions, each dealing with one of the following three topics: internationalization of the patent system; computerization of the patent system; patent documentation, search and examination.
- Invitations:* States members of WIPO, certain intergovernmental organizations and non-governmental organizations having observer status in WIPO.
- November 6 to 10 (Geneva)** **Committee of Experts on Model Provisions for Legislation in the Field of Copyright (Second Session)**
- The Committee will continue to consider proposed standards in the field of literary and artistic works for the purposes of national legislation on the basis of the Berne Convention for the Protection of Literary and Artistic Works.
- Invitations:* States members of the Berne Union or WIPO and, as observers, certain organizations.
- November 13 to 24 (Geneva)** **Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions (Seventh Session)**
- The Committee will continue to examine a draft treaty on the harmonization of certain provisions in laws for the protection of inventions.
- Invitations:* States members of the Paris Union and, as observers, States members of WIPO not members of the Paris Union and certain organizations.

UPOV Meetings

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

1989

April 14 (Geneva)

Consultative Committee (Thirty-ninth Session)

The Committee will mainly discuss the outcome of the twenty-fourth session (April 10 to 13) of the Administrative and Legal Committee and prepare the meeting with international organizations.

Invitations: Member States of UPOV.

October 16 (Geneva)

Consultative Committee (Fortieth Session)

The Committee will prepare the twenty-third ordinary session of the Council.

Invitations: Member States of UPOV.

October 17 and 18 (Geneva)

Council (Twenty-third Ordinary Session)

The Council will examine the program and budget for the 1990-91 biennium, the reports on the activities of UPOV in 1988 and the first part of 1989.

Invitations: Member States of UPOV and, as observers, certain non-member States and intergovernmental organizations.

Other Meetings Concerned with Industrial Property

1989

June 4 to 10 (Amsterdam)

International Association for the Protection of Industrial Property (AIPPI): Congress

July 10 to 12 (Geneva)

International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP): Annual Meeting

December 5 to 9 (Munich)

European Patent Organisation (EPO): Administrative Council

