

Industrial Property

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Contents

NOTIFICATIONS CONCERNING TREATIES

Locarno Agreement. New Member of the Locarno Union: Federal Republic of Germany . . .	249
Budapest Treaty	
I. Notification of the European Patent Organisation (EPO): Deutsche Sammlung von Mikroorganismen und Zellkulturen GmbH (DSMZ) (Federal Republic of Germany)	249
II. Change of Address: Culture Collection of Algae and Protozoa (CCAP) (United Kingdom)	251
Treaty on Intellectual Property in Respect of Integrated Circuits. Ratification: Egypt	251

WIPO MEETINGS

Paris Union. Committee of Experts on the International Protection of Geographical Indications. First Session (Geneva, May 28 to June 1, 1990)	252
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NEWS ITEMS

Recent Developments in Industrial Property Legislation	274
Zaire	288

CALENDAR OF MEETINGS	289
--------------------------------	-----

INDUSTRIAL PROPERTY LAWS AND TREATIES (INSERT)

Editor's Note

UNITED KINGDOM

Patents Act 1977 (as last amended by the Copyright, Designs and Patents Act 1988) (Sections 1 to 60) (<i>This text replaces the one previously published under the same code number</i>)	Text 2-001
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WIPO 1990

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Notifications Concerning Treaties

Locarno Agreement

New Member of the Locarno Union

FEDERAL REPUBLIC OF GERMANY

The Government of the Federal Republic of Germany deposited, on July 25, 1990, its instrument of ratification of the Locarno Agreement Establishing an International Classification for Industrial Designs, signed at Locarno on October 8, 1968, as amended on October 2, 1979.

The said instrument was accompanied by the following declaration:

"the said Agreement shall also apply to Berlin (West) with effect from the date on which it enters into force for the Federal Republic of Germany."

The said Agreement will enter into force, with respect to the Federal Republic of Germany, on October 25, 1990.

Locarno Notification No. 24, of July 25, 1990.

Budapest Treaty

I. Notification of the European Patent Organisation (EPO)

DEUTSCHE SAMMLUNG VON MIKROORGANISMEN
UND ZELLKULTUREN GmbH (DSM)

(Federal Republic of Germany)

The following notification from the European Patent Organisation (EPO), dated July 4, 1990, was received on July 9, 1990, by the Director General of WIPO under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure:

1. Pursuant to Rule 3.3 of the Regulations under the Budapest Treaty, I have the honor to

notify you that the assurances given by the European Patent Organisation in its communications of July 23, 1981, and March 8, 1988, to the effect that the Deutsche Sammlung von Mikroorganismen und Zellkulturen GmbH (DSM), in its capacity as international depositary authority, complies and will continue to comply with the requirements specified in Article 6(2) of the Treaty, are extended with certain limitations, to the following kinds of microorganisms:

- plant viruses
- plant cell cultures.

Annex I reproduces the entirety of the kinds of microorganisms now accepted by the authority.

2. With reference to Rule 12 of the Budapest Treaty, I have the honor to inform you that DSM will charge the fees shown in Annex II hereto in respect of the kinds of microorganisms added to the list of kinds of microorganisms previously accepted.

3. Finally, I am informing you in Annex III of the requirements DSM wishes to apply under Rule 6.3 of the Budapest Treaty to the kinds of microorganisms added to the list of kinds of microorganisms previously accepted. For the sake of clarity, Annex III reproduces all the requirements of the authority under Rule 6.3.

Annex I

Kinds of Microorganisms Accepted for Deposit by the Depositary Authority

The following are accepted for deposit:

1. bacteria, including actinomycetes,
2. fungi, including yeasts,
3. bacteriophages,
4. plasmids
 - (a) in a host,
 - (b) as an isolated DNA preparation,
5. plant viruses,
6. plant cell cultures.

Re points 1, 2, 3 and 4:

The DSM accepts for deposit only those bacteria, fungi, bacteriophages and plasmids which, pursuant to DIN 58 956 Part 1 (supplementary sheet 1), belong to hazard group I or II.

Re points 1, 2, 3, 4, 5 and 6:

It must be possible to process genetically manipulated strains or isolated DNA and also genetically manipulated plant viruses and plant cell cultures in accordance with Laboratory Safety Measures L1 or L2 contained in "*Richtlinien zum Schutz vor Gefahren durch in-vitro neukombinierte Nukleinsäuren*" (5th revised version, German Federal Ministry for Research and Technology, May 1986, Bundesanzeiger Verlagsgesellschaft mbH, Cologne) (Guidelines on protection against hazards resulting from in vitro recombinant nucleic acids).

Re point 5:

Plant viruses which cannot multiply through mechanical infection of plants cannot be accepted for deposit.

Re point 6:

Plant cell cultures can only be deposited in the form of callus or suspension cultures with non-differentiated growth. The material for deposit must be free from contamination by foreign organisms.

For all deposits:

Notwithstanding the restrictions mentioned above, the DSM reserves the right to refuse to accept for deposit material which in its view represents an unacceptable hazard.

In all instances, it must be possible to preserve the deposited material by lyophilization or storage in liquid nitrogen or by some other method of long-term preservation without significant change.

Annex II

Fee Schedule (Rule 12.1 of the Budapest Treaty)

A. The fees relating to bacteria, fungi, bacteriophages and plasmids are set out in *Industrial Property*, 1990, p. 71.

B. The fees relating to plant viruses are the same as those for the organisms specified in A, above.

C. The fees for the deposit of plant cell cultures are as follows:

	DEM
1(a) storage according to Rule 12.1(a)(i) of the Budapest Treaty	2,500
(b) conversion of a deposit made outside the Budapest Treaty into a deposit according to the Budapest Treaty	2,500
(c) prolongation of the duration of the storage over the one provided by Rule 9 of the Budapest Treaty, per year	80

2. issuance of viability statement under Rule 12.1(a)(iii) of the Budapest Treaty	
(a) where a viability test is also requested	200
(b) on the basis of the last viability test	40
3. furnishing of a sample under Rule 12.1(a)(iv) of the Budapest Treaty (plus current freight costs)	200
4. communication of information under Rule 7.6 of the Budapest Treaty	40
5. attestation referred to in Rule 8.2 of the Budapest Treaty	40

As a general rule, the fees under 1, 2, 4 and 5, above, are subject to VAT, currently at the rate of 7%. Where samples are furnished, VAT is payable only by requesting parties in the Federal Republic of Germany.

Annex III

Requirements under Rule 6.3 of the Budapest Treaty

1*(a) Bacteria and fungi should, where possible, be deposited in the form of two active cultures.

(b) Plasmids as isolated DNA preparations should be in a minimum quantity of 2 x 20 µg.

(c) Bacteriophages should be deposited in minimum quantities of 2 x 5 ml having a minimal titre of 1 x 10⁹ pro ml.

(d) Plant viruses should be deposited in the form of dried or frozen material along with the host's seeds, unless the host is generally available. 100 µl of serum suitable for immunoelectron microscopy should also be deposited for the purity and identity test.

When hybridomes for antibody testing of plants are deposited, the antigen (not pathogen) necessary for the specificity test should be deposited at the same time.

(e) In the case of plant cell cultures, active cultures in the form of a callus (four petri dishes) or suspension (four culture vessels) or frozen cultures (18 cryoampoules) should be deposited.

2.** The deposit must be accompanied by the appropriate form duly completed (Form DSM-BP/1: Original Deposit; DSM-BP/2: New Deposit; or DSM-BP/3: New Deposit with Another Inter-

* Points 1(a), (b) and (c) do not differ from the last Communication in *Industrial Property*, 1989, p. 315.

** See *Industrial Property*, 1988, p. 139.

national Depositary Authority) in English or German. Depositors can obtain these from the DSM (separate forms are to be used for bacteria and fungi, bacteriophages, isolated plasmids, plant viruses and plant cell cultures).

3.** The fee for storage mentioned in Rule 12.1(a)(i) of the Budapest Treaty must be paid.

[End of text of the notification of the European Patent Organisation]

The list of kinds of microorganisms specified in Annex I of the notification of the EPO and the amendments to the requirements provided for by Rule 6.3 of the Regulations under the Budapest Treaty, which are set forth in Annex III of the said notification, will take effect as from September 30, 1990, the date of publication of the said notification in the present issue of *Industrial Property*. The said list of kinds of microorganisms and the said requirements will replace the list of kinds of microorganisms and the requirements published in the April 1988 issue of *Industrial Property*.

The fees set forth in Annex II of the said notification will apply as from the thirtieth day following the date of publication (September 30, 1990) of the said fees in the present issue of *Industrial Property*, that is, as from October 30, 1990 (see Rule 12.2(c) of the Regulations under the Budapest Treaty).

Budapest Notification No. 63 (this notification is the subject of Budapest Notification No. 90, of July 27, 1990).

II. Change of Address

CULTURE COLLECTION OF ALGAE AND PROTOZOA (CCAP)

(United Kingdom)

The Government of the United Kingdom has informed the Director General of WIPO by a notification dated August 10, 1990, which was received on August 14, 1990, that the addresses of both sections of the Culture Collection of Algae and Protozoa (CCAP), an international depositary authority under the Budapest Treaty, are as follows:

CCAP at Windermere (all protozoa and freshwater algae)

CCAP

Institute of Freshwater Ecology

The Windermere Laboratory

Far Sawrey

Ambleside, Cumbria LA22 0LP

United Kingdom

Telephone: (09662) 2468/9

Facsimile: (09662) 6914

Telex: 94070416 WIND G

E-Mail: WL_CCAP @ UK.AC.NWL.VA

CCAP at Oban, Scotland (marine algae)

CCAP

Dunstaffnage Marine Laboratory

P.O. Box 3

Oban, Argyll PA34 4AD

Scotland

United Kingdom

Telephone: (0631) 62244

Facsimile: (0631) 65518

Telex: 776216 MARLAB G

E-Mail: S_CCAP @ UK.AC.NSM.VA

Budapest Notification No. 64 (this notification is the subject of Budapest Notification No. 91, of August 22, 1990).

Treaty on Intellectual Property in Respect of Integrated Circuits

Ratification

EGYPT

The Government of Egypt deposited, on July 26, 1990, its instrument of ratification of the Treaty on Intellectual Property in Respect of Integrated Circuits, adopted at Washington on May 26, 1989.

The date of entry into force of the said Treaty will be notified when the required number of ratifications, acceptances, approvals, or accessions is reached in accordance with Article 16(1) of the said Treaty.

IPIC Notification No. 2, of July 26, 1990.

WIPO Meetings

Paris Union

Committee of Experts on the International Protection of Geographical Indications

First Session
(Geneva, May 28 to June 1, 1990)

NOTE*

Introduction

The Committee of Experts on the International Protection of Geographical Indications (hereinafter referred to as "the Committee of Experts") held its first session in Geneva from May 28 to June 1, 1990.

The following States members of the Paris Union were represented at the session: Algeria, Australia, Canada, China, Czechoslovakia, Denmark, France, Germany (Federal Republic of), Greece, Ireland, Italy, Japan, Libya, Mexico, Morocco, Netherlands, Portugal, Republic of Korea, Romania, Soviet Union, Spain, Switzerland, Tunisia, Turkey, United Kingdom (25).

Representatives of the General Agreement on Tariffs and Trade (GATT), the Commission of the European Communities (CEC) and of the International Office of Vine and Wine (IWO) participated in the session in an observer capacity. Representatives of the following non-governmental organizations participated in the session in an observer capacity: Centre for International Industrial Property Studies (CEIPI), European Communities Trade Mark Practitioners' Association (ECTA), International Association for the Protection of Industrial Property (AIPPI), International Federation of Industrial Property Attorneys (FICPI), International League for Competition Law (LIDC), Max Planck Institute for Foreign and International Patent, Copyright and Competition Law (MPI) and the United States Trademark Association (USTA).

The Committee of Experts considered the following questions:

1. Need for a New Treaty;

2. Possible Contents of a New Treaty
 - A. Subject Matter of Protection
 - B. Conditions of Protection
 - C. Contents of Protection
 - (a) Scope of Prohibited Use
 - (b) Scope of Protected Goods
 - (c) Grounds for Refusing Protection
 - (d) Prior Users' Rights;
 - D. Enforcement Mechanisms;
 - E. Dispute Settlement;
 - F. International Registration System.

The discussions of the first session of the Committee of Experts were based on the memorandum prepared by the International Bureau, entitled "The Need for a New Treaty and Its Possible Contents" (document GEO/CE/I/2). The document consisted of three substantive parts: *Part II* containing a historical background describing existing multilateral treaties for the protection of appellations of origin and indications of source and past efforts within the framework of WIPO towards adopting new treaty provisions; *Part III* considering the question of whether the existing treaties should be revised or whether a new multilateral treaty should be concluded, the reply to this question being that a new treaty should be concluded; and *Part IV* outlining the possible contents of such a treaty, for discussion by the Committee of Experts, so that the International Bureau could receive guidance for its future work in preparing a draft of a new treaty.

Parts II and III of document GEO/CE/I/2 read as follows:

"II. Historical Background

A. Basic Concepts and Terminology

For purposes of the discussions of the Committee of Experts, it is important to establish

* Prepared by the International Bureau.

agreement on the basic concepts and terminology to be used. In this regard, it is to be recalled that appellations of origin and indications of source are objects of industrial property, as stated in Article 1 of the Paris Convention for the Protection of Industrial Property. Compared with other objects of industrial property, such as patents, industrial designs and trademarks, appellations of origin and indications of source present a particular feature, namely a relationship with an existing factual situation, since they refer to the particular geographical origin of a product. Thus, each appellation of origin and indication of source, so to say, necessarily 'belongs' to a country (the country where the geographical area to which the indication refers is located), even if its goodwill and reputation may have been developed through the efforts of certain individuals or entities, whereas patents, industrial designs and trademarks belong to natural persons or legal entities. Moreover, while inventions, industrial designs and—at least, to some extent—trademarks are the result of creative work, appellations of origin and indications of source are the result of practices in trade and—to some extent—regulatory activities of governments.

In this document, 'indication of source' means any expression or sign used to indicate that a product originates in a country, a region or a specific place. 'Appellation of origin' means the geographical name of a country, region or specific place which serves to designate a product originating therein the characteristic qualities of which are due exclusively or essentially to the geographical environment, including natural or human factors, or both natural and human factors (this definition corresponds to Article 2 of the Lisbon Agreement). The main difference between the two concepts consists of the fact that appellations of origin only apply to products which have *characteristic qualities* that are due to conditions existing in the geographical area referred to by the appellation of origin, whereas indications of source apply to *any* products originating in the geographical area to which the indication refers. Appellations of origin are a special kind of indication of source. In other words, all appellations of origin are indications of source, but not all indications of source are appellations of origin.

In addition to the traditional expressions 'appellation of origin' and 'indications of source'—or rather replacing these traditional expressions—this document uses the term 'geographical indication.' That term is not new. It has already been used in the framework of the revision of the Paris Convention for the Protection of Industrial Property of 1883, as last revised in 1967 (hereinafter referred to as the 'Paris Convention'), when the inclusion of a new Article

10^{quater} in that Convention was discussed (see paragraphs 47 to 49, below). The term 'geographical indication' has the same coverage as the expression 'indication of source.' The term 'geographical indication' seems to be preferable to the expression 'indication of source' because the latter expression frequently is understood to imply a lower level of protection, in comparison with the strong protection of appellations of origin. The use of the term 'geographical indication' is intended to underline that both appellations of origin and indications of source are covered and that the protection to be established is not limited to the protection which at present exists with respect to indications of source.

'Protection' of a geographical indication means that it is prohibited to use the indication for goods not originating in the geographical area to which the geographical indication refers, or as a generic name of a product or as a trademark.

Patents for inventions, industrial design rights and trademark rights are independent in each country so that, for example, an invention may be patented in a country even if it has not been patented in its country of origin, e.g., in the country of residence of the inventor. The situation is different in the case of geographical indications; their protection in countries other than their country of origin depends on their protection in the country of origin (i.e., the country where the geographical area to which the indication refers is located). In other words, if a geographical indication is not protected in the country of origin, normally it is not protected in other countries.

However, the fact that a geographical indication is protected in the country of origin does not automatically mean that protection exists also in other countries. Under existing laws, protection in other countries may be limited to cases where a likelihood of misleading consumers exists. Problems may arise where a geographical indication which is protected in the country of origin is not understood as such in a country other than the country of origin. For example, due to developments in the past and the particular success of certain products, a geographical indication may have become the generic name of a product in certain countries. Therefore, the question arises whether in international relations rules exist or should be established that ensure international protection of a geographical indication even where such indication has become or later becomes the 'name' of the product in other countries. This is one of the main questions of the international protection of geographical indications, a question which has been partly answered in some of the existing treaties and which certainly will have to be answered in any revision of existing treaties or in a new treaty.

B. Existing Multilateral Treaties for the Protection of Geographical Indications

Three multilateral treaties contain provisions for the protection of geographical indications: the Paris Convention, the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods of 1891, as last revised in 1967 (hereinafter referred to as the 'Madrid Agreement'), and the Lisbon Agreement.

(a) The Paris Convention

Several provisions of the Paris Convention deal specifically with indications of source or appellations of origin: Article 1(2) contains a reference to 'indications of source' and 'appellations of origin' in the list of objects of industrial property; Article 10 deals with the protection of indications of source; Article 9 deals with sanctions where the rights in an appellation of origin are not respected; and Article 10*ter* reinforces the provisions of Articles 9 and 10.

Article 1(2) provides that the protection of industrial property has as its object, among others, 'indications of source' or 'appellations of origin.' The obligation to protect indications of source is specifically provided for in Article 10, but there are no special provisions in the Paris Convention for the protection of appellations of origin. Nevertheless, Articles 9, 10 and 10*ter* are applicable to appellations of origin since each appellation of origin by definition constitutes an indication of source (see paragraph 5, above).

Article 10(1) is the basic provision of the Paris Convention on indications of source. It provides that the sanctions prescribed by Article 9 in respect of goods unlawfully bearing a trademark or trade name apply to any use of a 'false indication of the source' of a product. This means that no indication of source may be used that refers to a geographical area from which the products in question do not originate. For the provision to be applicable, there is no need for the false indication to appear on the product, since any direct or indirect use, for example in advertising, is sanctionable. However, Article 10(1) does not apply to indications which, without being false, may mislead the public, or at least the public of a certain country (for example, where certain geographical areas in different countries have the same name but only one of those areas is internationally known for particular products, the use of that name in connection with products originating from another area may be misleading).

As regards the sanctions in the case of the use of a false indication of source, Article 9 establishes the principle that seizure upon importation

must be provided for, or at least prohibition of importation or seizure inside the country but, if those sanctions do not exist in a particular country, the actions and remedies available in such cases are to be applied.

Article 9(3) and Article 10(2) determine who may request seizure on importation or the imposition of other sanctions: the public prosecutor, any other competent authority, any interested party. Article 10(2) defines what is meant by 'interested party,' stipulating that 'any producer, manufacturer, or merchant, whether a natural person or a legal entity, engaged in the production or manufacture of or trade in such goods and established either in the locality falsely indicated as the source, or in the region where such locality is situated, or in the country falsely indicated, or in the country where the false indication of source is used, shall in any case be deemed an interested party.'

Article 10*bis* concerns the protection against unfair competition and as such provides a basis for protection against the use of confusing, false or misleading geographical indications. Article 10*bis* obliges countries of the Paris Union to assure effective protection against unfair competition, sets a general definition of what constitutes an act of unfair competition and contains a non-exhaustive list of three types of acts which, in particular, must be prohibited.

Article 10*ter* is also relevant inasmuch as it obliges countries of the Union to provide, on the one hand, appropriate legal remedies and to permit, on the other, federations and associations representing interested industrialists, producers or traders to take action, under certain conditions, with a view to the repression of false indications of source.

The main advantage of the protection afforded by the Paris Convention to indications of source lies in the extent of the territorial area covered by the Paris Union, which on March 1, 1990, comprised 100 member States. On the other hand, the question of indications which, in countries other than the country of origin, are generic names of a product in other countries is not dealt with in the Paris Convention, so that member States of the Paris Union seem to be entirely free in that respect. Finally, sanctions, although specifically mentioned in the Paris Convention, are not in all cases mandatory and apply only to false but not to misleading indications of source.

(b) The Madrid Agreement

The Madrid Agreement is a special agreement within the framework of the Paris Union. The Agreement aims at the repression not only of false but also of deceptive indications of source.

Article 1(1) of the Madrid Agreement provides that any product bearing a false or deceptive indication by which one of the States party to the Madrid Agreement or a place situated therein is directly or indirectly indicated as being the country or place of origin must be seized on importation into any of the States party to the Madrid Agreement.

The other paragraphs of Articles 1 and 2 specify the cases and the manner in which seizure or similar measures may be requested and carried out. There is no express provision to the effect that private individuals may request seizure directly. Thus, member States are free to provide that such persons have to apply through the public prosecutor or any other competent authority.

Article 3 authorizes a vendor to indicate his name or address on goods coming from a country other than that in which the sale takes place, but obliges him, if he does so, to have his name or address accompanied by an exact indication in clear characters of the country or place of manufacture or production, or by some other indication sufficient to avoid any error as to the true source of the wares.

Article 3bis obliges the States party to the Madrid Agreement to prohibit the use, in connection with the sale or display or offering for sale of any goods, of all indications capable of deceiving the public as to the source of the goods.

Article 4 provides that the courts of each country have to decide what appellations, on account of their generic character, do not fall within the provisions of the Madrid Agreement. Only regional appellations concerning the source of products of the vine are excluded from the reservation inherent in the provision. The reservation substantially limits the scope of the Madrid Agreement, in spite of the important exception constituted by the case of regional appellations concerning the source of products of the vine, for which protection is absolute. Yet the expression 'regional appellations concerning the source of products of the vine' is somewhat ambiguous and has given rise to divergent interpretations.

The territorial scope of the Madrid Agreement is considerably smaller than that of the Paris Convention, as only 31¹ countries are bound by it. In addition, the Agreement has certain limitations some of which are similar to those existing in the Paris Convention. In particular, the repression of

false or deceptive indications used in translation or qualified by terms such as 'kind' or 'type' is not provided for. Furthermore, apart from regional appellations concerning the source of products of the vine, indications of source are not protected against the risk of becoming generic names. Finally, the sanctions provided for are limited. However, the protection conferred by the Madrid Agreement goes further than that conferred by the Paris Convention in two respects: the repression of deceptive indications of source (even if they are not false) is provided for, and regional appellations concerning the source of products of the vine are protected against the risk of becoming generic names.

(c) The Lisbon Agreement

Sixteen countries² are party to the Lisbon Agreement. The limited geographical scope of the Lisbon Agreement is due to particular characteristics of the substantive provisions of the Agreement.

Article 2(1) contains a definition according to which appellation of origin means 'the geographical name of a country, region, or locality which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors.' It follows that only names conforming to the definition may be protected by virtue of the Lisbon Agreement. Simple indications of source (which can be used for products whose characteristics do not result from the geographical environment) are excluded from its purview. This limitation has prevented the accession of countries which do not know the concept of appellation of origin.

The first element of the definition is that the appellation must be the geographical name of a country, region or locality. The second element of the definition is that the appellation of origin must serve to designate a product originating in the country, region or locality referred to. The third element of the definition is that there must be a qualitative link between the product and the geographical area: the 'quality and characteristics' must be due exclusively or essentially to the geographical environment; if the qualitative link is insufficient, that is, if the characteristic qualities are not due essentially, but only to a small extent, to the geographical environment, the name is not an appellation of origin but merely an indication of source or even a generic name; as for the geographical environment, it includes natural

¹ Algeria, Brazil, Bulgaria, Cuba, Czechoslovakia, Dominican Republic, Egypt, France, German Democratic Republic, Germany (Federal Republic of), Hungary, Ireland, Israel, Italy, Japan, Lebanon, Liechtenstein, Monaco, Morocco, New Zealand, Poland, Portugal, San Marino, Spain, Sri Lanka, Sweden, Switzerland, Syria, Tunisia, Turkey, United Kingdom.

² Algeria, Bulgaria, Burkina Faso, Congo, Cuba, Czechoslovakia, France, Gabon, Haiti, Hungary, Israel, Italy, Mexico, Portugal, Togo, Tunisia.

factors, such as soil or climate, and human factors, such as the special professional traditions of the producers established in the geographical area concerned.

Even if interpreted broadly, the definition of appellation of origin in Article 2(1) has a serious drawback for countries whose denominations typically do not apply to agricultural products or products of handicraft but to products of industry. The difficulty arises from the fact that Article 2(1) requires the existence of a qualitative link between the geographical environment and the product, even though the presence of purely human factors would be considered sufficient. This link, which may have existed at the start of the manufacture of an industrial product, may subsequently have been stretched to the point that its existence is difficult to prove. Moreover, traditions in manufacture and skilled staff can be shifted from one geographical area to another, in particular in view of the increasing mobility of human resources in all parts of the world.

Article 1(2) provides that the countries party to the Lisbon Agreement undertake to protect on their territories, in accordance with the terms of the Agreement, the appellations of origin of products of the other countries party to the Lisbon Agreement, recognized and protected *as such* in the country of origin and registered at the International Bureau of WIPO. Therefore, in order to be protected under the Lisbon Agreement, the appellation of origin must fulfill two conditions. The first condition is that the appellation of origin must be recognized and protected as such in the country of origin (the latter being defined in Article 2(2)). This condition means that it is not sufficient for the country in question to protect its appellations in a general way. Each appellation still has to benefit from distinct and express protection, deriving from a specific official act (a legislative or administrative provision, or a judicial decision, or a registration). Such an official act is required because the specific elements of the object of protection (the geographical area, the lawful users of the appellation of origin, the nature of the product) must be determined. Those elements must be indicated in the application for international registration in accordance with Rule 1 of the Regulations under the Lisbon Agreement.

This first condition (recognition and protection as appellation of origin in the country of origin) is one of the main obstacles to the territorial extension of the Lisbon Agreement. In a number of countries, it is only in a few exceptional cases that specific official acts granting distinct and express protection to an appellation of origin exist. While this fact alone does not prevent those countries from acceding to the Lisbon Agreement,

for such reason they nevertheless cannot apply for international registration of all the appellations which they might wish to have protected, even if the appellations correspond to the definition in Article 2(1). This, obviously, diminishes the practical value of accession to the Lisbon Agreement.

The second condition laid down by Article 1(2) is that the appellation of origin must be registered with the International Bureau of WIPO. Articles 5 and 7 of the Agreement itself and the Regulations set forth the procedure for international registration.

Article 2(2) defines the country of origin as being 'the country whose name, or the country in which is situated the region or locality whose name, constitutes the appellation of origin which has given the product its reputation.'

Article 5(1) and the corresponding provisions of the Regulations issued under the Lisbon Agreement define the procedure for international registration. International registration must be applied for by the competent Office of the country of origin, and therefore may not be requested by interested parties. The national Office, however, does not apply in its own name for international registration, but in that of 'any natural persons or legal entities, public or private, having a right to use [*titulaires du droit d'user*]' the appellation, according to the applicable national legislation. The International Bureau of WIPO has no competence to examine the application with respect to substance; it may only make an examination as to form. Under Article 5(2) of the Lisbon Agreement, the International Bureau notifies the registration without delay to the Offices of the countries party to the Lisbon Agreement and publishes it in its periodical *Les Appellations d'origine* (Rule 7 of the Regulations). Up to March 1990, 726 appellations of origin have been so registered under the Lisbon Agreement. This means that, since the Agreement entered into force in 1966, an average of 30 registrations per year (or more than two registrations per month) were effected so far.

In accordance with Article 5(3) to (5), the Office of any State party to the Lisbon Agreement may, within a period of one year from the receipt of the notification of registration, declare that it cannot ensure the protection of a given appellation. Apart from the time limit mentioned, the right of refusal is subject to only one condition: the grounds for refusal must be indicated. The grounds which may be so indicated are not restricted by the Lisbon Agreement; this in fact gives each country the discretionary power to protect or refuse to protect a registered appellation of origin.

In all countries not having made a declaration of refusal, the registered appellation enjoys

protection. However, if third parties have been using the appellation in a given country prior to the notification of the registration, the Office of that country may, under *Article 5(6)* of the Lisbon Agreement, grant them a maximum of two years in which to terminate such use.

The protection conferred by international registration is unlimited in time. *Article 6* provides that an appellation which has been granted protection cannot be deemed to have become generic, as long as it is protected as an appellation of origin in the country of origin. *Article 7* provides that the registration need not be renewed and is subject to payment of a single fee. An international registration ceases to have effect only in two cases: either the registered appellation has become a generic name in the country of origin, or the international registration has been cancelled by the International Bureau at the request of the Office of the country of origin.

The content of the protection afforded to an appellation of origin registered under the Lisbon Agreement, according to *Article 3* of the Agreement, is very extensive. Any usurpation or imitation of the appellation is prohibited, even if the true origin of the product is indicated or if the appellation is used in translated form or qualified by terms such as 'kind,' 'type,' 'make,' 'imitation,' or the like.

With regard to the enforcement of the protection of an appellation of origin registered under the Lisbon Agreement, *Article 8* refers to national legislation. It specifies that the right to take action belongs to the competent Office and the public prosecutor, on the one hand, and to any interested party, whether a natural person or a legal entity, whether public or private, on the other. In addition to any sanctions applicable pursuant to the Paris Convention and the Madrid Agreement (*Article 4*), all the sanctions provided for in national legislation, whether civil (injunctions restraining or prohibiting unlawful acts, actions for damages, etc.), penal or administrative, are to be applied. However, the Lisbon Agreement does not establish a standard with respect to the sanctions to be provided for by the States party to it.

The main advantages of the Lisbon Agreement are that the use of corrective or qualifying terms in connection with an internationally registered appellation of origin does not make its use licit (*Article 3*) and that it prevents an internationally registered appellation of origin from becoming a generic name as long as it has not become a generic name in the country of origin (*Article 6*).

The main shortcomings of the Lisbon Agreement seem to be as follows: the definition of appellation of origin is too narrow (*Article 2(1)*); the requirement of prior recognition and protection under a special official act in the country of

origin does not take into account any system of protection by general legislative provisions for the repression of deceptive practices (*Article 1(2)*); the mandatory indication of the owners of the right to use the appellation in whose name the international registration must be applied for is difficult to reconcile with a system of protection by general legislative provisions for the repression of deceptive practices (*Article 5(1)*); the absence of any definition of what constitutes valid grounds for refusal weakens the protection conferred by international registration, in particular since negotiations between interested countries can only be initiated after refusal (*Article 5(3) to (5)*). In addition, the Lisbon Agreement does not provide for the application of the law of the country of origin, except for the determination whether an appellation has become a generic name (*Article 6*); as a result, the question of usurpation or imitation in a specific case is to be decided in accordance with the law of the country in which protection is sought, a situation that is unlikely to ensure that products embody all the characteristic qualities required.

C. Work Undertaken Within the Framework of WIPO Towards the Adoption of New Treaty Provisions

(a) Preparation in 1974 and 1975 of a New Multilateral Treaty on the Protection of Geographical Indications

In 1974, WIPO started work on the preparation of a new multilateral treaty for the protection of appellations of origin and indications of source. After a first session of a Committee of Experts in 1974, the International Bureau of WIPO prepared a draft treaty which was submitted to the second session of the Committee in 1975. The proposed text was entitled 'Draft Treaty on the Protection of Geographical Indications' (hereinafter referred to as the 'WIPO draft Treaty'). The expression 'geographical indications' was used in order to cover both indications of source and appellations of origin. (The draft Treaty and the report adopted by the Committee of Experts are contained in WIPO documents TAO/II/2 and 6, respectively.)

The first chapter of the WIPO draft Treaty contained a provision according to which the use of denominations, expressions or signs which constitute or directly or indirectly contain false or deceptive geographical indications as to the source of products or services must be prohibited.

The second chapter provided for a system of international registration in respect of any geographical indication which fulfills the following conditions: (i) the geographical indication consists of the official or usual name of a

State (the 'filing State') or of the name of a major circumscription of a State or of a denomination which serves to indicate the source of a product; (ii) the indication is declared by the filing State to be a reference to itself as the State of origin; (iii) the indication is used in the course of trade in relation to products originating in the State, and the said State certifies such use.

The WIPO draft Treaty intended to establish a new definition of geographical indication for the purposes of a system of international registration. The new definition was broader than the definition of appellation of origin under the Lisbon Agreement. In most other respects, the system of the WIPO draft Treaty was similar to the Lisbon Agreement. In particular, the procedure for international registration included the possibility of objections and provided for protection unlimited in time once the international registration had become effective. However, unlike the Lisbon Agreement, the grounds for objection were limited to one of the following: (i) the subject of the application for international registration consists neither of the official or usual name of the filing State or of that of a major circumscription of that State, nor of a denomination which serves to indicate the source of a product; (ii) the denomination in question does not refer to the filing State as the State of origin; (iii) in the filing State, the denomination in question is used in the course of trade in relation to products originating in any State; (iv) in the objecting State the denomination in question is regarded as a generic term by the general public and is used as such in the course of trade; (v) certain requirements concerning the application have not been fulfilled. Although unlimited in time, continued protection would depend on the payment of maintenance fees. In addition, the WIPO draft Treaty contained a chapter on sanctions, the right to bring action and the settlement of disputes through diplomatic channels.

When preparations for the revision of the Paris Convention started in the late 1970s, and those preparations also dealt with the possible revision of those provisions of the Paris Convention that deal with geographical indications, work on the WIPO draft Treaty was interrupted.

(b) Revision of the Paris Convention

As indicated, during the time the WIPO draft Treaty on geographical indications was being prepared, the process of revision of the Paris Convention was initiated. This process has not yet been completed.

In the course of the discussions on the revision of the Paris Convention, the Working Group on Conflict Between an Appellation of Origin and a

Trademark prepared a proposal to include in the Paris Convention a new article on the protection of appellations of origin and indications of source. Under the Rules of Procedure of the Diplomatic Conference on the Revision of the Paris Convention, the said proposal became a basic proposal for the revision of the Paris Convention (see document PR/DC/4). In the proposal, the terminology used in the WIPO draft Treaty was adopted; thus the term 'geographical indication' was used. The purpose of this new article of the Paris Convention, which provisionally is numbered Article 10*quater*, is intended to be two-fold. First, the article should ensure a more extensive protection of appellations of origin and indications of source against their *use as trademarks*. Second, a special provision in favor of developing countries should be included, which would allow such countries to reserve a certain number of potential geographical indications for the future so that, even if they were not yet used as geographical indications, they could not be used as trademarks.

The draft Article 10*quater* establishes in its paragraph (1) the principle that a geographical indication which directly or indirectly suggests a country of the Paris Union or a region or locality in that country with respect to goods not originating in that country may not be used or registered as a trademark, if the use of the indication for the goods in question is of a nature as to mislead the public as to the country of origin. Paragraph (2) extends the application of paragraph (1) to geographical indications which, although literally true, falsely represent to the public that the goods originate in a particular country. Paragraph (3) contains an additional provision in respect of geographical indications which have acquired a reputation in relation to goods originating in a country, region or locality, provided that such reputation is generally known in the country where protection is sought by persons engaged in the production of goods of the same kind or in trade in such goods. This additional provision establishes a reinforced protection for certain generally known geographical indications without the requirement of misleading use. Paragraph (4) allows the continuation of use which had been begun in good faith. Paragraph (5) requires that all factual circumstances must be considered when applying the preceding provisions. Paragraph (6) reserves the possibility of bilateral or multilateral negotiations between member countries of the Paris Union. Finally, paragraph (7) provides that each developing country may notify the International Bureau of up to 200 geographical names denominating the country itself or a region or a locality on its territory, with the consequence that the International

Bureau would notify all Paris Union member States and that these States would be obliged to prohibit the registration or use of trademarks containing or consisting of the notified names. The effect of the notification would last for 20 years. During this period, any developing country having made a notification would have the possibility of making known and protecting the geographical indication as referring to a geographical area in its territory from which certain goods originate so that subsequently the general provisions on protection of geographical indications would apply.

Draft Article 10*quater* has been discussed in the four sessions of the Diplomatic Conference as well as in some of the subsequent consultative meetings. Although, initially, the group of industrialized market economy countries was divided in respect of the protection of geographical indications which have acquired a certain reputation, in 1984, those countries agreed on a proposal (see document PR/DC/51) for a new Article 10*quater*, which can be summarized as follows: paragraphs (1) and (2) are similar to paragraphs (1) and (2) of Article 10*quater*, as contained in the basic proposals for the revision of the Paris Convention described in paragraphs 48 and 49, above, subject to some minor changes; paragraph (3) deals with the special case of any 'geographical indication generally known in a country to consumers of given products or of similar products as designating the origin of such products manufactured or produced in another country of the Union,' and provides that the protection would not, as in the basic proposal, be directed against the use as a trademark but against a development of such an indication to a designation of generic character for the said product or similar products; paragraph (4) contains an amended version of the special provisions in favor of developing countries; in contrast to the basic proposal, the number of geographical indications which can be reserved is up to 10, and they can only be reserved if the goods for which the name is or will be used have been indicated; paragraphs (5) to (7) contain slightly amended versions of the provisions of the basic proposal in respect of acquired rights, the consideration of all factual circumstances and the possibilities of concluding bilateral and multilateral agreements. The said proposal has not yet been discussed in the sessions of the Diplomatic Conference itself.

It should also be mentioned that in 1982 the competent Main Committee of the Diplomatic Conference on the Revision of the Paris Convention adopted an amendment to Article 6*ter* of the Paris Convention. That Article, in its present text, contains a prohibition on using as trademarks state emblems, official marks or emblems of

intergovernmental organizations (see document PR/DC/INF/38Rev.). The amendment concerns the inclusion of the official names of States in the list of emblems, etc., which may not be used as trademarks. This is of importance for protection of geographical indications since it means that at least official names of States would always have to be excluded from use as trademarks.

As regards the prospects for the adoption of the aforementioned proposals regarding geographical indications in the course of the revision of the Paris Convention, all that can be said at present is that the process of the revision of the Paris Convention has not yet been concluded. The question of international protection of geographical indications is only one of a number of questions which are being considered by the Diplomatic Conference.

III. Need for a New Treaty

As the preceding explanations show, the existing multilateral treaties, such as the Paris Convention, the Madrid Agreement and the Lisbon Agreement, and the efforts within the framework of WIPO towards the adoption of new treaty provisions, have not ensured a satisfactory worldwide protection of geographical indications.

The Lisbon Agreement has been accepted by only 16 States. It is clear that a number of States are not in a position to accede to the Lisbon Agreement presumably and mainly because that Agreement is limited to appellations of origin, with a specific definition of that concept that is unlikely to be accepted worldwide.

The Madrid Agreement has found a broader acceptance (31 States). However, there are only 10 States which joined the Agreement during the last 40 years, and, during the last 10 years, no State has joined that Agreement. A number of States seem to be unable to accept some of the features of the Agreement.

The relevant provisions of the Paris Convention are widely accepted but only ensure limited protection.

As regards the revision of the Paris Convention, so far this work has not come to a conclusion. As already noted, the outcome of the Diplomatic Conference on the Revision of the Paris Convention is still unsettled. The protection of geographical indications is only one of a number of questions under consideration in the revision process, some of which are controversial, and it is unlikely that this question could be settled without reaching agreement on the other questions as well. Moreover, the Paris Convention can only be expected to ensure certain basic conditions of protection but not specific rules covering all

aspects of the international protection of geographical indications, which are also greatly needed.

The work commenced about 15 years ago within the ambit of WIPO to prepare a new Treaty on the international protection of geographical indications shows the desirability and feasibility of finding a solution in this respect since several countries expressed support or at least an interest in a new draft Treaty. Such interest appears to persist and even to have grown.³

As already mentioned, it would seem that under the existing multilateral agreements the concept and scope of protection of geographical indications do not cover all existing systems, the international registration system established under the Lisbon Agreement is not adapted to a number of legal systems, the rights conferred by registration and the sanctions and remedies generally afforded lack mechanisms of enforcement, and insufficient attention is given to dispute settlement procedures. There seem to be various reasons for the relatively small number of States that have adhered to the existing special agreements. Therefore, this has resulted in an incomplete and ineffective protection of geographical indications at the international level.

There are several strong arguments that can be made in support of the need for concluding a *new Treaty* on the international protection of geographical indications.

(i) Given the integration of the world economy and the sophistication of contemporary telecommunications, it is important to achieve widespread agreement on the international standards concerning geographical indications.

(ii) It is therefore desirable that a large majority of Paris Union member States adhere to a treaty on the international protection of geographical indications, so that such a treaty can have a truly widespread, if not global, application. The 99-year experience with the Madrid Agreement and the 32-year experience with the Lisbon Agreement indicate that this objective cannot be achieved by a revision of the Madrid Agreement and/or the Lisbon Agreement. The desirable modifications of each of those Agreements concern basic concepts, such as the introduction of a system of international registration in the

case of the Madrid Agreement or the definition of appellation of origin in the case of the Lisbon Agreement, so that a revision would change the essential characteristics of those Agreements and would be tantamount to the introduction of a new treaty.

(iii) There is a need to depart from the concepts of appellation of origin and indication of source by introducing a new notion, namely 'geographical indication,' a notion that would allow all existing national systems of protection to be covered.

(iv) There is a need to establish a new international registration system which is more widely acceptable than the system of the Lisbon Agreement. It is believed that a system which would not require a specific form of protection in the country of origin as a condition for international registration would be so acceptable.

(v) There is a need, in particular, that such an international registration system provide for effective protection of geographical indications against degeneration into a generic term, and that it ensure effective enforcement of protection.

Furthermore, if a new Treaty is negotiated within the framework of the Paris Convention, all the presently 100 Paris Union member States (and not only countries party to the Madrid Agreement or the Lisbon Agreement) would be able to participate fully in the negotiations and the diplomatic conference that would have the task of adopting the new Treaty and would be entitled to become party thereto.

A new Treaty would also provide an opportunity to introduce dispute-settlement provisions. Subject to the application of a possible new Treaty on the Settlement of Intellectual Property Disputes Between States (see documents SD/CE/I/2 and 3), a dispute settlement body, composed of experts elected for a fixed-term and with broad powers for interpreting and applying the Treaty and resolving differences between contracting parties, is considered to be a necessary element for achieving an effective system for the protection of geographical indications at the international level. It would ensure both the continuity and the flexibility needed in the application and interpretation of the Treaty to different situations and allow it to evolve with new needs and problems as they arise. Naturally, if, in the meantime, a general WIPO settlement-of-disputes Treaty is adopted, the mechanism offered by that Treaty would, or would also, be at the disposal of States having a dispute concerning the application or interpretation of the new Treaty."

After hearing general statements from a number of delegations and representatives of intergovernmental and non-governmental organizations, many of

³ WIPO, in cooperation with the Government of France, organized, in 1988, a symposium in Bordeaux and, in 1989, a symposium in Santenay (Bourgogne). In both of those meetings, the question of the international protection of geographical indications was considered. Relevant publications can be obtained from the International Bureau (*Symposium on Appellations of Origin and Indications of Source* (Bordeaux, 1988), WIPO publication No. 669(E), *Symposium on the International Protection of Geographical Indications* (Santenay, 1989), WIPO publication No. 676(E)).

which emphasized the need for a new Treaty, the Committee of Experts discussed the possible contents of a new Treaty, on the basis of *Part IV* of document GEO/CE/I/2.

Possible Contents of a New Treaty

The corresponding text of GEO/CE/I/2 reads as follows:

"IV. Possible Contents of a New Treaty

On the assumption that a new Treaty on the international protection of geographical indications is considered desirable, and for purposes of preparing a draft of such a Treaty, the following questions and explanations thereof regarding the possible contents of the said Treaty are submitted for consideration to the Committee of Experts.

Three basic questions would appear to require examination at this stage in order to define the possible scope and contents of a new Treaty:

- (i) What should be the subject matter of protection? (see Section A, below)
- (ii) What should be the general principles of protection, including the conditions of protection, its contents, and the mechanisms for its enforcement and for settling disputes arising under the new Treaty? (see Sections B to E, below)
- (iii) Should there be a system of international registration and, if so, what should it consist of? (see Section F, below)"

Subject Matter of Protection

The corresponding text of document GEO/CE/I/2 reads as follows:

"A. Subject Matter of Protection

The new Treaty would have to define the subject matter of protection. Four approaches are possible.

The *first* possible approach is that the new Treaty would only refer to the protection of indications of source, as defined in paragraph 5, above, along the lines of the Madrid Agreement. Although this would implicitly cover appellations of origin because they are a special kind of indication of source (see paragraph 5, above), the use of the term 'indication of source' could be misleading and create the impression that the specific concerns of the protection of appellations of origin have not been taken into account.

A *second* possible approach is that the new Treaty deal with the protection of appellations of origin, as defined in paragraph 5, above, along

the lines of the Lisbon Agreement, that is, that it cover only names that serve to designate a product whose quality and characteristics are due exclusively or essentially to the geographical environment from where the goods originate. However, such a restrictive approach is likely to run into the same problems as those already encountered by the Lisbon Agreement.

A *third* possible approach would be that the new Treaty deal with both indications of source and appellations of origin but as two distinct objects of protection and possibly through different means of protection (e.g., protecting indications of source without registration through prohibition of the use of false or deceptive indications and protecting appellations of origin through registration not only against misleading practices but also against their use as generic terms or trademarks or with additional terms such as 'kind,' 'type,' etc. (see paragraph 77, below)). On the one hand, such an approach would be similar to the system of protection which already exists in the States party to the Lisbon Agreement and might, therefore, be acceptable to those countries. On the other hand, many other countries outside the Lisbon Agreement do not always make a distinction between the general concept of 'indication of source' and the qualified case thereof of 'appellation of origin' as do countries party to the Lisbon Agreement. Therefore, this third approach would probably lead to a combined repetition of the Madrid Agreement and the Lisbon Agreement, which, even if the texts were improved, would not result in the desired increase in the number of Contracting Parties.

A *fourth* approach would be to depart from the restrictive concepts of the past and for the new Treaty to use a more general term, namely, 'geographical indication.' Such a notion would avoid, at the international level, the use of the two concepts of indication of source and appellation of origin and the somewhat artificial and difficult-to-distinguish differences between the two partly overlapping notions (since appellations of origin are indications of source). The concept of geographical indication is not restricted by the limitation that applies to the concept of appellation of origin, that is, that the indication must serve to designate a product whose characteristic qualities are due to the geographical environment from where the product originates. The concept of geographical indication is more adaptable to different legal systems. It could encompass protection established in the form of collective marks or certification marks, which are not an uncommon means of protecting geographical indications in many countries with an Anglo-Saxon legal tradition. It is recalled that 'protection' of geographical indications is used here to mean that

it is prohibited to use the indication for products not originating in the geographical area to which the indication refers, or as a generic name of a product or as a trademark in connection with products (see paragraph 7, above). Furthermore, the concept of geographical indication could also apply in those countries that are not party to the Lisbon Agreement and where recent developments towards strengthening protection have not resulted in adopting the concept of appellation of origin as defined in the Lisbon Agreement. The situation in the United States of America can be cited here as an example. In the United States of America, the term 'appellation of origin' is used in regulations adopted in 1978 concerning appellations of origin for wines. Those appellations, however, only specify names of geographical areas but do not imply quality standards associated with the factors to be found or used in particular areas. Government control aims at preventing consumer deception by prohibiting false or misleading terms, without attempting to authenticate quality and production methods.⁴ Thus the expression 'appellation of origin' has, in the United States of America, a meaning that is different from the meaning that the same expression has in countries which follow the terminology established under the Lisbon Agreement, namely, that an appellation of origin serves to designate a product whose quality and characteristics are due exclusively or essentially to the geographical environment from which the goods originate. However, the concept of appellation of origin as used in the United States of America could be covered by the concept of geographical indication.

Question 1: Should the subject matter of protection of the new Treaty consist of the traditional concepts of indication of source and appellation of origin, or should it consist of the concept of geographical indication?

If the concept of 'geographical indication' is adopted as the subject matter of protection under the new Treaty, the question then arises whether the new Treaty should also define what constitutes a protectable 'geographical indication' for purposes of the Treaty.

The term 'geographical indication' is composed of two words, 'geographical' and 'indication.'

'Geographical,' in this context, is generally understood to mean that the indication refers to a geographical area. For purposes of a treaty for the international protection of geographical indications, this reference should be precise and specific. The geographical indication should refer to an identifiable place or region, with precise boundaries, so as to leave no doubt as to the geographical origin of the goods in connection with which the indication is or may be used.

The word 'indication,' in this context, is generally agreed to mean the 'name' of, or a denomination referring to, a geographical area (e.g., 'St. Emilion'). The question arises whether other signs or expressions which refer to a specific geographical area should also be encompassed by the term 'geographical indication' and be protectable under the new Treaty, such as signs (e.g., a national flower), expressions (e.g., 'Tequila'), unofficial names of States, in the form of a noun or an adjective (e.g., 'Holland' or 'Dutch' as referring to the Netherlands), symbols (e.g., the Empire State building as referring to New York City) and other indirect indications which in themselves do not specifically refer, but are nonetheless understood or known to refer, to a particular geographical area.

Question 2: Should the new Treaty define what constitutes a protectable 'geographical indication' for purposes of the Treaty? If so,

Question 3: Should a protectable 'geographical indication' be defined as the name of, or a denomination referring to, a precise geographical area, or also as a sign, expression, unofficial name of a State, symbol or other indirect indication which refers, or is understood or known to refer, to a precise geographical area, and which thus serves to indicate the geographical origin of the goods in connection with which the indication is used?"

The portion of the report of the Committee of Experts (contained in document GEO/CE/I/3) concerning the discussion of this part of document GEO/CE/I/2, in particular *Questions 1, 2 and 3*, reads as follows:

Question 1:

"There seemed to be general agreement that the subject matter of protection of the new Treaty should consist of the concept of 'geographical indication.'

Several delegations pointed out that the new concept of 'geographical indication' embraced the traditional concepts of 'indication of source' and 'appellation of origin' established under the

⁴ See Lecture No. 3 at the *Symposium on the International Protection of Geographical Indications* at Santenay (France, November 9, 1989), entitled 'The Protection of Geographical Indications in the United States of America' by Mr. S. Higgins, Director of the Bureau of Alcohol, Tobacco and Firearms, United States of America (document WIPO/AO/SAN/3, pp. 3 and 4, WIPO publication No. 676(E), pp. 31).

Madrid Agreement and the Lisbon Agreement and that the concept of 'geographical indication' promised sufficient flexibility and breadth so as to be able to encompass the greatest number of legal systems.

In reply to a question raised by one delegation, the Chairman clarified that, since the concept of 'geographical indication' would encompass the traditional concepts of 'indication of source' and 'appellation of origin,' such concepts need not disappear at the national, regional or bilateral levels. However, the concept of 'geographical indication' could go further and also encompass other notions such as, for example, certification marks composed of the name of a geographical area and used for goods originating therefrom.

Another delegation noted that the question concerning the subject matter of protection was not as important as the question of the nature and contents of the protection to be conferred by the new Treaty and that the former question could not be examined independently of the latter question."

Questions 2 and 3:

"There was general agreement that the new Treaty should define what constitutes a protectable 'geographical indication' for the purposes of the Treaty. There was also no major objection to the definition suggested in Question 3, except for the following observations and suggestions.

One delegation questioned the appropriateness of the term '*precise*' geographical area in the context of an international treaty and noted that such term should not limit the notion only to political boundaries.

A number of delegations expressed the view that a geographical indication could serve to indicate the geographical origin of goods as well as of services.

Some delegations also made reference to the system which exists among various countries on the bilateral level, that is, of negotiating and exchanging lists of protected geographical indications, a system which, in their view, could be transposed to the multilateral level.

The Representative of the Commission of the European Communities reported on the position taken by the services of the Commission of the European Communities to introduce an additional element in the definition suggested in Question 3, to the effect that, in order for a geographical indication to be 'protectable,' some kind of link must exist between the geographical area to which the indication refers and the goods which originate from that area. According to the services of the Commission of the European Communities,

protectable geographical indications should be those which 'designate a product as originating from a country, region, or locality where a given quality, reputation or other characteristic of the product is attributable to its geographical origin, including natural and human factors.' It was explained that this 'quality link' was broader than the restrictive definition of 'appellation of origin' under the Lisbon Agreement. Whereas Article 2 of the Lisbon Agreement speaks of (i) 'quality and characteristics' which are due, (ii) 'exclusively or essentially' to the geographical environment, under the definition proposed by the services of the Commission of the European Communities, the link need not consist of a given quality but may consist of a given 'reputation or other characteristic' and such characteristic need not be 'exclusively or essentially' attributable to its geographical origin.

A number of delegations expressed their support for the position taken by the services of the Commission of the European Communities. It was added that geographical denominations should not be protectable under the new Treaty merely because the geographical area to which it refers exists somewhere on a map.

A number of other delegations disagreed with the position taken by the services of the Commission of the European Communities. They noted that, although with many geographical indications some quality or reputation link existed between the geographical area and the goods originating therefrom, this was not always the case, and, even if it were, this fact would be difficult to determine and prove through objective means. Incorporating this 'link' into the definition of protectable geographical indication was, therefore, inappropriate at the international level. It risked opening the door to a restrictive interpretation.

The delegations of several developing countries further pointed out that such a quality link requirement would unnecessarily limit protectable geographical indications, in particular to the detriment of developing countries whose geographical indications frequently had not yet developed such a reputation or other characteristic so that a link between the geographical area and the goods originating therefrom could be established and protection invoked under the new Treaty. Such a restrictive approach would discourage adherence to the new Treaty especially by developing countries.

In the light of these divergent opinions, it was finally agreed that the qualifying words suggested by the services of the Commission of the European Communities be included in the draft Treaty to be prepared by the International Bureau, but in square brackets, leaving this question for further consideration and discussion at the next meeting of the Committee of Experts."

Need of Protection in Country of Origin

The corresponding text of document GEO/CE/I/2 reads as follows:

“B. Need of Protection in Country of Origin

It would seem essential that the Contracting Party to which the geographical indication refers, or where the geographical area is located (i.e., the ‘Contracting Party of origin’), protect the geographical indication in its territory against use of the indication in connection with goods which do not originate from that area. It would seem self-evident that a geographical indication should not benefit from protection under the new Treaty if the geographical indication is not protected, or at some time loses protection, in the territory of the Contracting Party of origin, for example, because it is considered and used there, or at some time comes to be used there, as a generic term for the goods for which it is used and is no longer understood to indicate their specific geographical origin. The protection in the territory of the Contracting Party of origin may result from special legislation, order or regulation concerning the indication in question or from the application of general legislation or general principles, such as the legislation or principles on the protection against unfair competition. Alternatively, the protection in the territory of the Contracting Party of origin may result from registration of the geographical indication as a collective mark or certification mark (a commonly used form of protection, for example, in the United States of America and the United Kingdom).

Question 4: Should the new Treaty require, as a condition of protection under the Treaty, that the geographical indication be protected in the territory of the Contracting Party where the geographical area is located (i.e., Contracting Party of origin), against use of the indication in connection with goods which do not originate in the area to which the indication refers?”

The portion of the report of the Committee of Experts concerning the discussion of this part of document GEO/CE/I/2, in particular *Question 4*, reads as follows:

Question 4:

“The great majority of delegations and organizations agreed that, as a condition of protection under the new Treaty, the geographical indication must be protected in the territory of the Contracting Party of origin, against its use in connection with goods which do not originate in the area to which the indication refers.

A number of delegations explained that it would be illogical for the new Treaty to allow a Contracting Party to invoke protection of a geographical indication which it did not protect in its own territory. Several delegations pointed out that this did not mean, however, that the geographical indication had to be protected ‘as such’ by the Contracting Party of origin, as required under Article 1 of the Lisbon Agreement (for example, under special legislation or on the basis of a national registration system); it would be sufficient if the geographical indication benefited from some protection in the territory of the Contracting Party of origin, be it under general legislation or general principles of law (for example, on the repression of unfair competition or consumer protection) or resulting from registration as a collective mark or a certification mark. What was considered essential was that some minimum protection be available in the territory of the Contracting Party of origin as a condition for invoking protection under the new Treaty in other Contracting Parties.

The Delegation of Japan expressed reservations about such a requirement, as, in its country, geographical indications were not protected under special legislation, and it wondered how, under such circumstances, actual protection in the territory of the Contracting Party of origin could be established in order to invoke protection under the new Treaty.

The Delegation of the Federal Republic of Germany objected to making protection in the territory of the Contracting Party of origin a condition of protection under the new Treaty. It considered that the situation in the territory of the Contracting Party of protection could be just as important and relevant (e.g., the likelihood of a geographical indication misleading consumers) as the situation in the territory of the Contracting Party of origin. It also stated that it had similar reservations to those expressed by the Delegation of Japan regarding this question.”

Contents of Protection

The corresponding text of document GEO/CE/I/2 reads as follows:

“C. Contents of Protection

The new Treaty would have to set down the obligations which the Contracting Parties to the Treaty agree to undertake. As a minimum, a treaty dealing with the international protection of geographical indications would have to establish that each Contracting Party undertakes to protect geographical indications, as defined in the Treaty

and meeting any conditions for protection required by the Treaty, which refer to an area in another Contracting Party, against their use in connection with goods that do not originate from that area.

Question 5: Should the new Treaty provide that each Contracting Party must protect geographical indications, as defined in the Treaty, which refer to an area in another Contracting Party, and which meet the conditions of protection required by the Treaty, against their use in connection with goods that do not originate from the said area?

The new Treaty could, of course, go further in defining the scope of protection. It could define the scope of prohibited use and the scope of protected goods. It could also be considered whether the new Treaty should set any limits on the scope of protection, in particular, whether it should recognize any grounds on which a Contracting Party may refuse to protect any given geographical indication and whether the new Treaty should recognize any prior users' rights.

(a) Scope of Prohibited Use

As regards the scope of prohibited use, in addition to the basic obligation to prohibit use of the geographical indication in connection with goods that do not originate from the geographical area to which the indication refers, it may be appropriate to include an obligation to prohibit use of the geographical indication as a mark (and its registration as a mark) and use of the geographical indication as a generic term, even where the goods in respect of which those kinds of uses are made originate from the geographical area to which the indication refers. In such a case, the use and registration of the geographical indication as a mark is not compatible with the function of the geographical indication and the possibility that any enterprise in the said area may continue to use it as a geographical indication, which would not be available if one of them could obtain an exclusive right in the indication. The use of the geographical indication as a generic term is likely to result in the dilution of the geographical indication and to contribute to its degeneration into a generic term. Finally, the prohibition of the use of the geographical indication with additional terms such as 'kind,' 'type,' 'make,' 'imitation,' or the like (see Article 3 of the Lisbon Agreement) should also be considered.

Question 6: Should the scope of prohibited use under the new Treaty extend only to prohibited use of the protected geographical indication as a geographical indication or also to its use as a

mark or a generic term and its use with additional terms such as 'kind,' 'type,' 'make,' 'imitation,' or the like?

(b) Scope of Protected Goods

As regards the scope of protected goods, it is clear that the new Treaty should prohibit the use of a geographical indication in connection with goods not originating from the geographical area to which the indication refers, when such goods are the same as those for which the indication is protected in the territory of the Contracting Party of origin. The question still arises whether the protection should extend to other goods.

In this connection, as a general rule, protection could cover the same goods for which a geographical indication is protected in the territory of the Contracting Party of origin and to similar goods, without any need to show that a prohibited use of the indication in connection with such goods would be likely to confuse consumers or dilute the indication.

Question 7: What should be the scope of protected goods under the new Treaty? In particular, should protection be limited to the same goods with respect to which the geographical indication is protected in the territory of the Contracting Party of origin, or should it also cover similar goods, provided that protection in the Contracting Party of origin covers similar goods?

(c) Grounds for Refusing Protection

It is to be recalled here that, if the new Treaty establishes as a condition of protection that a geographical indication must be protected in the territory of the Contracting Party of origin (see paragraph 74, above), then, logically, any other Contracting Party could refuse to protect any geographical indication that is not thus protected or which, at some time, loses such protection by the Contracting Party of origin.

A more difficult question arises when a geographical indication, which is protected by the Contracting Party of origin, is used and considered as a generic term in the territory of another Contracting Party (i.e., other than the Contracting Party of origin). Should that other Contracting Party be allowed to refuse protection on those grounds?

A generic term, in the context of the protection of geographical indications, is usually understood as a term which, although it may in fact refer to a geographical area, has, through use, come to be understood as a term referring to a particular kind of goods. Two situations of this kind, in particular, are likely to arise. The first is that of the

geographical indication which is protected by the Contracting Party of origin but which degenerates into a generic term in the territory of another Contracting Party after the latter accedes to the Treaty. The other situation is that of the geographical indication which, although protected by the Contracting Party of origin, was already considered a generic term in the territory of the other Contracting Party at the time of the latter's accession to the Treaty.

As regards the first case described, it would seem clear that geographical indications which are protected by the Contracting Party of origin and which are not considered a generic term by the other Contracting Party at the time of the latter's accession to the Treaty should not be allowed later to be considered and used as a generic term in the territory of such other Contracting Party.

The second case mentioned is more difficult to resolve. The fact that the geographical indication is already considered a generic term by the other Contracting Party (i.e., other than the Contracting Party of origin) at the time of its accession to the Treaty could be considered as an obstacle to redressing the situation and to reestablishing use of the geographical indication in its proper sense because traders and consumers have become accustomed to its use as a generic term. Nevertheless, one could consider solving such problems through negotiations between the Contracting Parties concerned. A possible result of such negotiations could be, for example, that the use as a generic term is to be discontinued after a certain period of time (for example, 10 or 20 years).

Question 8: Should the new Treaty allow a Contracting Party to refuse protection of a geographical indication on the ground that the indication came to be considered and used as a generic term in the territory of the Contracting Party where protection is sought? Should a distinction be made between the case where the indication was already considered and used as a generic term in the territory of the Contracting Party where protection is sought before the latter's accession to the Treaty and the case where such a situation arose after the latter's accession to the Treaty? Should the Treaty encourage settlement of those questions through negotiations between the Contracting Parties concerned?

(d) Prior Users' Rights

A related question concerns the situation where a certain geographical indication which is protected by the Contracting Party of origin has already been used by a specific person or persons, as a mark or otherwise (for example, as

a generic term), in the territory of another Contracting Party before the latter's accession to the Treaty. The problem then arises whether the new Treaty should permit such a Contracting Party to allow such person or persons to continue using the indication, and, if so, under what conditions and for how long (that is, indefinitely or for a fixed period of time). Three basic approaches are possible. *One* approach is that, if a person or persons can prove that they have thus been continuously using an indication in the territory of another Contracting Party (i.e., other than the Contracting Party of origin), the new Treaty could allow such person or persons (and only such person or persons) to continue such use indefinitely. A *second* approach would be for the Treaty not to recognize at all any such prior users' rights. A *third* approach would be for the Treaty to allow such person or persons to continue using the indication but only if continuous use had already existed for a significant period of time (for example, at least 25 years) and, in that case, to allow such person or persons to continue using the indication only for a fixed period of time (for example, 25 years). This last approach would represent a compromise between the two other approaches of unlimited recognition of prior users' rights and no recognition at all, but would still impart a certain weight to the protection afforded under the new Treaty.

Question 9: Should the new Treaty recognize prior users' rights acquired through continuous use of a geographical indication, as a mark or otherwise (for example, a generic term), when such use occurred in the territory of the Contracting Party where protection is sought before the latter's accession to the Treaty?

Question 10: If so, should such prior users' rights be recognized indefinitely, regardless of the length of time during which the continuous use on the basis of which the right is claimed took place, or should such prior users' rights be recognized only for a fixed period of time (for example, 25 years) and only if the use on the basis of which the right is claimed took place for at least a specified period of time (for example, 25 years)?"

The portion of the report of the Committee of Experts concerning the discussion of this part of document GEO/CE/I/2, in particular *Questions 5 to 10*, reads as follows:

Question 5:

"The majority of the delegations that took the floor replied to the question in the affirmative, namely, that the Treaty should place each

Contracting Party under the obligation to protect geographical indications as defined in the Treaty itself, subject to whatever exceptions might be provided for, which are the subject of the next questions.

Concerning this question, one delegation stated that the answer depended on several other elements. If—as the Delegation advocated—a broad definition of the term ‘geographical indication’ were adopted, there would be situations where an ‘absolute’ protection might not be justified and additional requirements would have to be met, such as misleading or deception or other aspects of unfair competition. The answer also depended on the possibility of easily ascertaining the existence of protected indications and the solutions found for the other questions.”

Question 6:

“The majority of the delegations and of the representatives of observer organizations that took the floor declared themselves in favor of extending the prohibition on the use of geographical indications to use as a mark or a generic term, even accompanied by a delocalizing term, subject to the rights of prior users (which are the subject of a later question).

One delegation wished to point out, on the other hand, that a geographical indication could be used in combination with a mark provided that the owner of that mark was entitled to use the geographical indication in connection with the product to which the mark applied.

Certain delegations were of the opinion that the prohibition on the use of a geographical indication should be extended to cases other than those provided for by the International Bureau, and in particular to industrial designs. However, one delegation warned in this connection that care should be taken not to extend the instances of prohibition too much, as that could in certain cases be at variance with the interests of creators.

The representative of an international organization was of the opinion that geographical indications should be protected against any use which constitutes an act of unfair competition and any use which is susceptible to mislead the public. He considered that a list of examples of such acts should be included in the new Treaty. In addition to the examples given in Question 6, he suggested including three further acts in such a list: (a) protection against the use of a geographical indication in translation; (b) protection against any usurpation, imitation or evocation of the geographical indication, even where the true origin of the product is indicated; and (c) protection against the use of any means in the designation or presentation of the product likely to

suggest a link between the product and any geographical area which is not the true place of origin.

Another delegation considered that the use of a geographical indication in translation should also be prohibited. The same delegation indicated moreover that the prohibition on the use of the geographical indication as a mark should even extend to any use that was of the same nature as use as a mark.

It was also pointed out that the prohibition on use should likewise cover terms similar to the geographical indication, indeed anything that suggested a geographical indication.

Two delegations were of the opinion that it was difficult to answer the question in either the affirmative or the negative, and that one should at the outset prohibit all deceptive or fraudulent indications, or any appropriation of the reputation attaching to a geographical indication. In that connection it was pointed out that the use of expressions such as ‘kind,’ ‘type,’ etc., should be allowed as long as it was not liable to mislead the public.”

Question 7:

“The majority of the delegations and of the representatives of observer organizations that took the floor spoke in favor of extending protection to similar goods, in the interest of both producers and consumers. Divergent views were, however, expressed on the question whether that extension of protection to similar goods should be made subject to the condition that the protection also cover similar goods in the Contracting Party of origin.

Some delegations pointed out in that connection that one could not claim protection broader than that which existed in the country of origin, whereas other delegations contended that the situation in the country of origin was irrelevant, and that account should mainly be taken of the situation in the country in which protection was sought.

One delegation moreover pointed out that, in the case of famous geographical indications, no account should be taken of the identicalness or similarity of the goods, and that the indication should be protected regardless of the goods concerned. The same delegation said that account should be taken not only of the similarity of the goods but also of the similarity to other signs of the sign constituting the geographical indication.

Two delegations expressed the view that the use of a geographical indication should be prohibited only if it were liable to mislead the public or if it were fraudulent, but they were not supported by any other delegation, the prevailing opinion

being that protection should be absolute, subject to exceptions expressly stated in the Treaty.”

Question 8:

“It was generally agreed that the Treaty should allow a Contracting Party to contest a geographical indication on the ground of its having become generic in the territory of that Contracting Party prior to the latter’s accession to the Treaty.

The term ‘refusal’ was not however considered appropriate by a number of delegations because it implies a definitive situation. They maintained, in effect, that, in the event of dispute, the parties involved should first enter into negotiations, for example, with a view to agreeing on the time limits by which an end could be put to the unlawful use of the geographical indication.

Other delegations were of the opinion that, if indeed there was to be negotiation between the parties concerned, the eventual decision should nevertheless be taken by the country in which protection was claimed, which in any event had to be allowed to refuse a geographical indication.

Several delegations moreover asked for it to be mandatory to state the grounds for refusal, while some considered that the Treaty should in addition contain a list of possible grounds for refusal, provide for a refusal procedure and set the time limit by which a refusal could be pronounced. One delegation and the representatives of a number of non-governmental organizations further expressed the wish that private persons, and most especially the owners of prior marks, be given the opportunity of contesting a geographical indication.

Opinions were divided on whether it was the country of origin or the country in which protection was sought that should be considered competent to determine whether the indication had become generic. It was pointed out in that connection that the criteria governing the assessment of generic character were different from country to country, and that it might be appropriate for the Treaty to attempt to harmonize legislation on that point, for instance, by specifying a minimum period for a term to be regarded as having become generic, or a precise definition of the generic character of a geographical indication.

Two delegations for their part expressed the view that a geographical indication could become generic even after its registration under the Treaty.

As for the last part of Question 8, it was generally agreed that the notification of any refusal should give rise to the opening of negotiations between the Contracting Parties concerned, and that the Treaty should provide for machinery

for the settlement of disputes where the parties concerned were unable to come to terms.”

Questions 9 and 10:

“Some delegations criticized the expression ‘rights acquired,’ as the users of a geographical indication could not, according to them, be regarded as having acquired a ‘right’ in that indication. One delegation pointed out in that connection that, among the elements which should be taken into consideration to determine if there could be an ‘acquired right,’ was the element of whether there had been *continuous, uncontested* use of the geographical indication. In any case, the delegation considered that this question still merited reflection in connection with the problems raised in paragraphs 89, below.

Another delegation proposed using the expression ‘rights acquired in good faith.’ The principle of that proposal was supported by another delegation, which however mentioned that it preferred the use of the words ‘rights legitimately acquired.’ The latter expression was itself criticized by certain delegations, which were of the opinion that a third party could not have legitimately acquired rights in a term that constituted a geographical indication.

The majority of the delegations shared the view that the Treaty should in one way or another preserve the rights of the users of a term identical or similar to a geographical indication where that use had gone on for a sufficiently long time prior to the date on which the geographical indication qualified for protection under the Treaty, and provided that the rights of those users had been acquired in accordance with legislation and with the general principles of law.

Certain delegations nevertheless thought that the rights in question could only be preserved for a finite period, which should be far shorter than the 25 years proposed by the International Bureau: a period in the region of 10 years seemed ample. There was one delegation that wanted the Treaty not to provide for any set period, but rather to leave the parties concerned to set a period themselves in the course of their negotiations.

Several other delegations and representatives of non-governmental organizations considered on the other hand that the rights of prior users, especially those of the owners of registered marks or other industrial property titles, should be given absolute protection, and that no prohibition on use could be contemplated regarding them, even if it were subject to a time condition. It was emphasized in that connection that there should be no provision for expropriation measures such as those found in the Lisbon Agreement.

One delegation considered for its part that a distinction should be made between the case in which the term constituting the geographical indication had been, in the territory of a Contracting Party, the subject of prior use as a registered mark acquired in good faith and the case in which it had been used because it had become generic. The delegation explained that, in the first case, it could be envisaged that the owner of the previously registered mark could continue to use that mark indefinitely according to the legislation governing marks. On the other hand, where the prior use was made by virtue of the term being generic, that use could only continue for a limited period, of 10 years or so, at the end of which the term concerned could, without reservation, be regarded as a protected geographical indication. In general, the question of prior users' rights merited more in-depth reflection."

Enforcement Mechanisms

The corresponding text of document GEO/CE/I/2 reads as follows:

"D. Enforcement Mechanisms

If the new Treaty is to ensure not only effective protection but also effective enforcement and go beyond existing multilateral treaties concerning the international protection of geographical indications, it should also deal with enforcement mechanisms.

In this regard, the new Treaty could establish at least what minimum remedies Contracting Parties must undertake to provide for purposes of enforcing the provisions of the Treaty and the protection afforded thereunder. Such minimum remedies could consist of: (i) an injunction to prevent and to stop prohibited acts under the Treaty; (ii) damages to compensate for losses incurred by reason of the commission of prohibited acts under the Treaty; (iii) refusal and invalidation of registration as a mark of protected geographical indications; (iv) seizure, upon importation or in the territory of the Contracting Party, by court order or by administrative decision (e.g., seizure by customs authority), of the goods bearing a geographical indication which does not refer to the geographical area from which the goods originate; and (v) penal sanctions.

The question of remedies raises the related question of who should be entitled to invoke the enforcement of such remedies. There are various possibilities: (i) a competent authority of a Contracting Party, either only *ex officio* or only upon request of an 'interested party,' or both; or (ii) also any 'interested party' directly. Such

'interested party' could be defined as a natural person or a legal entity, public or private, which has a right to or an interest in the use of a geographical indication (e.g., producers or producer associations, owners of collective marks or certification marks, or consumer organizations).

Question 11: *Should the new Treaty provide for minimum remedies, and, if so, what should such remedies consist of:*

- (i) *an injunction to prevent and to stop prohibited acts under the Treaty?*
- (ii) *damages to compensate for losses incurred by reason of such acts?*
- (iii) *refusal and invalidation of registration as a mark of protected geographical indications?*
- (iv) *seizure, upon importation or in the territory of the Contracting Party, by court order or administrative decision, of goods bearing the geographical indication which does not refer to the geographical area from which the goods originate?*
- (v) *penal sanctions?*

Question 12: *Who should be entitled to invoke the remedies ensured under the new Treaty:*

- (i) *a competent authority of a Contracting Party, ex officio?*
- (ii) *a competent authority of a Contracting Party, upon request of an interested party?*
- (iii) *any interested party?*

Question 13: *For the purposes of the new Treaty, should the term 'interested party' include any natural person or a legal entity, public or private, which has a right to or an interest in the use of a geographical indication (e.g., producers or producer associations, owners of collective marks or certification marks, or consumer organizations)?"*

The portion of the report of the Committee of Experts concerning the discussion of this part of document GEO/CE/I/2, in particular *Questions 11, 12 and 13*, reads as follows:

Questions 11, 12 and 13:

"It was generally agreed that the new Treaty should provide for minimum remedies.

As to the form that those remedies should take, all the measures specified in items (i) to (v) of Question 11 were considered acceptable subject to the following reservations.

With regard to item (i), it was said that the injunction should be granted even where the act had not been committed negligently or intentionally.

With regard to item (ii), it was said that it should not be possible to seek damages unless an act had been committed negligently or intentionally.

As for item (iii), the International Bureau was asked to ascertain its compatibility with the Paris Convention. One delegation moreover wished to have the refusal relate not only to registration as a mark of protected geographical indications, but also to the registration of a complex mark incorporating a geographical indication. Another delegation considered that a distinction should be made between marks submitted for registration after the entry into force of the Treaty and marks already registered on its entry into force, as the latter could not be refused.

On the subject of item (v), one delegation expressed the view that sanctions other than penal sanctions could be provided for, while another delegation felt that penal sanctions should not be mandatory.

On Questions 12 and 13, all the delegations that took the floor agreed that any interested party should be entitled to take action. Several delegations said furthermore that the term 'interested party' should be interpreted in the broadest way, and that it should encompass governments, competent national authorities, producers' associations and consumers' associations, although the latter should not be entitled to seek damages. One delegation wished to point out in addition that the legitimate user of the geographical indication should be able to assert his rights in any country in which an offense was committed."

Dispute Settlement

The corresponding text of document GEO/CE/I/2 reads as follows:

"E. Dispute Settlement

If the new Treaty is to ensure effective protection and enforcement, and if it is to afford continuity, flexibility and expertise in the application and interpretation of its provisions, the most effective way of doing so would be by setting up a special dispute-settlement mechanism. The examination of such a dispute-settlement mechanism must, of course, follow closely the work being concurrently carried out within the ambit of the WIPO Committee of Experts on the Settlement of Intellectual Property Disputes Between States, which held its first session, in Geneva, from February 19 to 23, 1990 (the memorandum prepared by the International Bureau for that meeting and the report of the meeting are contained in documents SD/CE/I/2 and 3, respec-

tively). In any case, a dispute-settlement mechanism will have to regulate, among others, the following questions: What kind of disputes may be submitted and by whom to a dispute-settlement body? What kind of decision can be made by such body (order, recommendation, etc)? What are the sanctions for non-compliance with the body's decision? Who bears the cost of the procedures?

Question 14: *Should the new Treaty provide for a dispute-settlement mechanism, and, if so, what principles should it rest upon?"*

The portion of the report of the Committee of Experts concerning the discussion of this part of document GEO/CE/I/2, in particular Question 14, reads as follows:

Question 14:

"The Chairman noted that this question had already been dealt with in connection with the discussions on Question 18, and that there was therefore no reason to discuss in greater depth the machinery for the settlement of disputes within the framework of the present session of the Committee of Experts."

International Registration System

The corresponding text of document GEO/CE/I/2 reads as follows:

"F. International Registration System

A system of international registration of geographical indications with WIPO already exists in respect of appellations of origin under the Lisbon Agreement. The modernization of that system and the enlargement of the participation in it could, however, be envisaged. Before any such modernization is undertaken, a number of preliminary questions need to be examined. The most fundamental of those questions concern the nature and purpose of the international registration system:

Question 15: *What should be the legal consequences of international registration? In particular,*

- (i) *Should international registration be an essential precondition or sine qua non of obtaining international protection and for the enforcement of that protection?*
- (ii) *Should international registration have the effect that the protection of a registered indication cannot be contested, unless an objection is made within a given time limit (for*

example, one year from the date of international registration) and unless the registered geographical indication is no longer protected in the Contracting Party of origin?

- (iii) Should, alternatively, international registration only provide the start of proof of entitlement to protection by constituting *prima facie* evidence of the existence of international protection?
- (iv) Should international registration be regarded as neither giving rise to entitlement to protection nor providing *prima facie* evidence of the existence of protection but as constituting a mere source of information of what each Contracting Party protects within its territory, it being understood that proof of entitlement to protection would depend entirely on the application of the principles established by the new Treaty without reference to registration?

Once the essential nature and purpose of the international registration system is clarified, the following further questions would require examination:

Question 16: *What should be the role of the International Bureau in any system of international registration?*

Question 17: *Who should be allowed to file applications for registration?*

Question 18: *Should a procedure be provided for an objection to be made by a Contracting Party to the registration of a geographical indication by another Contracting Party? In particular,*

- (i) *Should provision be made for the objection procedure to take place before or after registration?*
- (ii) *What should be the effect of an objection, that is, should an objection have the effect of non-recognition of entitlement to protection in the objecting Contracting Party or should it give rise to some form of bilateral consultations or require a decision by an entity other than either of the Contracting Parties in question?*
- (iii) *If it is envisaged that objections should be dealt with and decided by an entity other than the interested Contracting Parties, should that procedure be the same as any procedure that may be established for the settlement of disputes concerning the interpretation and the application of the Treaty?*

Question 19: *What should be the duration of the validity of an international registration?"*

The portion of the report of the Committee of Experts concerning the discussion of this part of document GEO/CE/I/2, in particular *Questions 15 to 19*, reads as follows:

Question 15(i):

"There was general agreement concerning the importance of this question for the international protection of geographical indications. A number of delegations emphasized that an international registration system was the best solution to provide for legal security and transparency not only for Contracting Parties to the Treaty but also for users of geographical indications and their competitors as well as for consumers.

Other delegations, however, stated that they were not convinced of the necessity of a new registration system. Some of those other delegations were opposed to the registration system because they had expressed the opinion that there was no need at all for a new Treaty. Still some others were of the opinion that a registration system was not needed because it would be sufficient to revise the Madrid Agreement, which established a system of protection of geographical indications without any registration. Some delegations believed that, although there might be an advantage in having a system of notifications or, at the international level, of geographical indications the protection of which was requested; such notifications or communications could be effected by the transmittal of lists and, where divergencies existed between Contracting Parties on the justification of the inclusion of certain geographical indications in those lists, bilateral negotiations could take place on the basis of those lists.

It was pointed out that, if there was to be an international system of notification or communication of protected geographical indications, this was not a viable alternative to a registration system. The method of exchanging lists and negotiating on their contents was workable in the context of *bilateral* negotiations but could not be used for a *multilateral* system because simultaneous negotiations between a number of Contracting Parties on the contents of the lists presented by them would create uncertainty about those contents if an agreement had been reached between two Contracting Parties on the removal of certain geographical indications from those lists, which removal, however, had not been considered in negotiations with other Contracting Parties. Thus, only a system of international registration with the possibility of objection or refusal would be appropriate for a multilateral treaty. This view was shared by a number of delegations and observers. It was in particular underlined that only the system of international registration with

publication of the contents of the register and of any objections or refusal would provide for the required transparency, which was an important precondition for international trade in goods marketed with geographical indications.

One delegation suggested that a register would not be necessary for the names of countries and certain political subdivisions in countries such as 'cantons,' since those names could be protected automatically. It was, however, pointed out that the implementation of this suggestion would encounter practical difficulties with respect to the definition of which kind of political subdivisions would automatically be covered by the Treaty without the need for registration.

One delegation expressed the view that, if a registration system was to be established, that system should not have an exclusive character in the sense that only registered geographical indications would enjoy protection under the Treaty; the Treaty should also cover the protection of geographical indications that were not internationally registered and should establish conditions for their protection. It was agreed that, in any case, the Treaty would not establish a maximum of protection but rather a minimum, leaving freedom to Contracting Parties to provide for more extensive protection of geographical indications than the protection which was mandatory under the Treaty.

In conclusion, it was recommended that the International Bureau should prepare a study in which the advantages and disadvantages of a registration system would be evaluated, in comparison with alternative systems such as the presentation of lists of geographical indications."

Question 15(ii) to (iv):

"The majority of the delegations expressed the view that, if an international registration system was adopted, a registration should not have solely the effect of constituting a mere source of information or *prima facie* evidence of the existence of protection but rather have the effect of establishing a certain kind of protection under the Treaty, notwithstanding the possibility of the Treaty providing for some kind of protection also for unregistered geographical indications.

On the assumption that the international registration of a geographical indication would have certain legal effects, it was agreed that there should be the possibility for each Contracting Party to refuse the effect of the international registration or to file objections thereto. In this connection, it was suggested that private parties should also have the right to submit objections to the effect of international registration. As regards the time limit within which objections could be

raised against the effect of an international registration, opinions were divided: according to one opinion, the time limit should be the same as in the Lisbon Agreement, namely, one year; according to another opinion, the time limit should be longer, for example, up to five years; one delegation suggested that there should be no time limit whatsoever for raising objections against the effect of an international registration."

Question 16:

"There was general agreement that the International Bureau of WIPO should be in charge of the administration of the system of international registration."

Question 17:

"The majority of the delegations expressed the view that only the competent authorities of Contracting Parties should be entitled to file applications for international registrations. Some delegations suggested that, in addition to the competent authority of each Contracting Party, interested enterprises or groups of enterprises or associations should also be admitted to file applications for international registration. On the other hand, it was pointed out that, if applications could be filed only by the competent authority of each Contracting Party, there would be some kind of guarantee in respect of the requirement of protection of the geographical indication in the territory of the requesting Contracting Party. It was, therefore, suggested that, in principle, only Contracting Parties would be entitled to file applications for international registration, subject to the possibility of an option for each Contracting Party in respect of the filing of applications by private enterprises or associations."

Question 18:

"The majority of the delegations expressed the view that the Treaty should provide for a set of procedures to settle disputes between Contracting States concerning the interpretation and the application of the Treaty. Under those procedures, first of all, an attempt should be made to find a compromise solution in the framework of negotiations between the Contracting Parties involved in the dispute. Secondly, the matter could be submitted to a 'committee of wise men' [*comité des sages*], which should be competent to make recommendations for the settlement of the dispute. Thirdly, where the Contracting Parties felt that they could not implement the recommendations of the aforementioned committee, the matter could be submitted to an independent arbitration board or a similar institution having competence to decide on the dispute.

One delegation referred to the experience gained on the basis of negotiations on bilateral treaties. According to that delegation, bilateral negotiations had the advantage that compromise solutions on a *quid pro quo* basis could be more easily agreed, thus avoiding the problems connected with the establishment of a committee, an arbitration board, etc.”

Question 19:

“It was generally agreed that the question should be discussed in detail at a later stage. Some delegations, however, suggested that no unlimited protection should be envisaged, in order to provide an opportunity to ascertain whether the conditions for the registration were still valid or if circumstances had changed in the meantime.”

In conclusion of the discussions, the Chairman stated that a number of delegations had expressed the wish for the preparation of a new treaty, whereas others had expressed some reservations; in particular, reservations had been expressed with respect to the question of whether the new treaty should provide for a registration system or for the establishment of lists of protected indications by Contracting Parties. Summarizing the opinions expressed in the Committee of Experts, he stated that it was desirable that, for the next session of the Committee of Experts, a preliminary draft of a treaty should be prepared by the International Bureau, providing for alternatives in all those cases where the Committee of Experts so far had not yet reached agreement.

The Director General declared that it was planned that the next session of the Committee of Experts would take place in 1991 and that the International Bureau would prepare for that session a preliminary draft of a treaty with alternatives, as stated by the Chairman.

LIST OF PARTICIPANTS**

I. Member States

Algeria: H. Yahia-Cherif. **Australia:** J.F. Hannoush. **Canada:** P. Lemyre; J.S. Gero. **China:** Dong Baolin; Zheng Hongjun. **Czechoslovakia:** P. Vrba; L. Kavinkova.

Denmark: T. Jakobsen. **France:** J.-C. Combaldieu; D. Filhol; M.-H. Bienaymé; G. Legendre; B. Vidaud; D. Hascher; H. Ladsous. **Germany (Federal Republic of):** A. von Mühlendahl; F.W. Michel; M.G. Coerper; B. Maeder-Metcalf. **Greece:** A. Cambitsis; D. Hadjimichalis. **Ireland:** H.A. Hayden; F. O'Grada. **Italy:** M.G. Fortini; P. Iannantuono; I. Nicotra; L. Sordelli; G. Sfara. **Japan:** K. Yamaura; S. Takakura. **Libya:** S. Shaheen. **Mexico:** A. Arriazola. **Morocco:** A. Bendaoud. **Netherlands:** W. Neervoort; I.W. van der Eyk. **Portugal:** J. Mota Maia; R.A. Costa de Morais Serrão; A.Q. Ferreira. **Republic of Korea:** J.K. Kim; W.T. Kim. **Romania:** E.-R. Udrea; L. Georgescu. **Soviet Union:** A.N. Grigoryev. **Spain:** M. Hidalgo Llamas; M.T. Yeste; J.M. González de Linares. **Switzerland:** A. Stebler. **Tunisia:** H. Tebourbi. **Turkey:** A. Algan. **United Kingdom:** A. Sugden; M. Todd.

II. Intergovernmental Organizations

Commission of the European Communities (CEC): E.C. Nooteboom; C. Fernández Mariscal. **General Agreement on Tariffs and Trade (GATT):** M. Geuze. **International Office of Vine and Wine (IWO):** R. Tinlot.

III. Non-Governmental Organizations

Centre for International Industrial Property Studies (CEIPI): P. Nuss. **European Communities Trade Mark Practitioners' Association (ECTA):** F. Gevers. **International Association for the Protection of Industrial Property (AIPPI):** M.W. Metz. **International Federation of Industrial Property Attorneys (FICPI):** Y.J.-J. Plasseraud. **International League for Competition Law (LIDC):** J. Guyet. **Max Planck Institute for Foreign and International Patent, Copyright and Competition Law (MPI):** R. Knaak. **The United States Trademark Association (USTA):** P. Weiss.

IV. Officers

Chairman: J.-C. Combaldieu (France). **Vice-Chairmen:** A.N. Grigoryev (Soviet Union); A. Sugden (United Kingdom). **Secretary:** L. Baeumer (WIPO).

V. International Bureau of WIPO

A. Bogsch (*Director General*); A. Schäfers (*Deputy Director General*); L. Baeumer (*Director, Industrial Property Division*); A. Ilardi (*Senior Legal Officer, Industrial Property Law Section, Industrial Property Division*); P. Maugué (*Senior Counsellor, Industrial Property (Special Projects) Division*); O. Espinosa (*Senior Legal Officer, Industrial Property Law Section*); H. Lom (*Senior Legal Officer, Developing Countries (Industrial Property) Section, Industrial Property Division*); W. Starein (*Senior Program Officer, Developing Countries (Industrial Property) Section*); B. Ibos (*Legal Officer, Industrial Property (Special Projects) Division*).

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

New Items

RECENT DEVELOPMENTS IN INDUSTRIAL PROPERTY LEGISLATION*

I. National Legislation

Argentina. The Resolution of the National Director of Industrial Property entitled *Basic Rules for the Examination of Patent Applications* (No. 42 of October 20, 1988) entered into force on January 1, 1989. For a commentary on that Resolution, see the study by E. Aracama Zorraquín entitled "Recent Developments in Industrial Property in Argentina," *Industrial Property*, 1990, pp. 40 *et seq.*

Australia. The *Patents Act 1952*, as last amended by Act No. 10 of 1988, was further amended by the Industry, Technology and Commerce Legislation Amendment Act 1989 (No. 91 of 1989).

Part 5 of the amending Act, which entered into force on August 1, 1989, enables the delegation of powers by the Commissioner of Patents to an appropriate level of responsibility within the Patent Office. Part 6 of the amending Act, which entered into force on June 27, 1989, repeals unproclaimed amendments to the Patents Act 1952 relating to the preparation and lodgment of abstracts of patent specifications.

The Patents Act 1952, as last amended by Act No. 91 of 1989, was further amended by the Patents Amendment Act 1989 (No. 96 of 1989), which entered into force on December 15, 1989.

Section 6 has been amended to provide for definitions of the expressions "marketing approval certificate," "pharmaceutical substance" and "therapeutic use" (all in relation to inventions concerning pharmaceutical substances for human use).

Section 75 (amended) provides for an extension of the term of a patent of addition. A patent of addition will remain in force for as long as the patent for the main invention remains in force. A patent of addition may, however, be granted an extension of

term even though the term of the patent for the main invention is not extended.

Part IX (Extension of Certain Patents) entirely replaces the previous Part IX (Extension of Patents) and provides for an extension of term of a patent relating to a pharmaceutical substance for human use (Section 90), the lapsing of the application for extension in certain circumstances (Section 91), the issuing of a marketing approval certificate (Section 92), the advertisement of the application for extension (Section 93), opposition to the grant of an extension (Section 94), the determination of the application for extension (Section 95), a limitation on infringement proceedings (Section 96), actions in respect of acts done where a patent expires before the extension is granted (Section 96A), appeals (Section 96B), and delegation of powers and functions (Section 96C).

Section 160 (amended) provides that an extension of time (not exceeding three months) may be granted to take an action under Part IX where that action was not taken due to error.

Part III of the amending Act is entitled "Application and Transitional Provisions."

The Patents Act 1952, as last amended by Act No. 96 of 1989, was further amended by the Industry, Technology and Commerce Legislation Amendment Act (No. 2) 1989 (No. 10 of 1990), which was assented to on January 17, 1990. Part 5 of the amending Act, which was taken to have come into force on December 15, 1989, corrects a minor error in the Patents Act 1952 introduced by Act No. 96 of 1989.

The *Trade Marks Act 1955* (Text 3-001, IP 7-8/1988 and 3/1990), as last amended by Acts Nos. 23 of 1987 and 91 of 1989, and the *Designs Act 1906*, as last amended by Act No. 23 of 1987, were amended by Part 5 of the Industry, Technology and Commerce Legislation Amendment Act 1989 (No. 91 of 1989), which enables the delegation of powers by the Registrars of Trade Marks and Designs to an appropriate level of responsibility within the Trade Marks and the Designs Offices. Those provisions entered into force on August 1, 1989.

The *Patents Regulations* (Amendment) (Statutory Rules 1989, No. 93), which vary the fees payable under the Patents Act 1952, entered into force on July 1, 1989.

* This study presents an overview of developments in national, international and regional industrial property legislation on the basis of information received by the International Bureau of WIPO from the competent industrial property administrations in 1989 and the first half of 1990.

The texts published in *Industrial Property Laws and Treaties* (see the Cumulative Index of legislative texts inserted in the January 1990 issue of *Industrial Property*) are followed, in brackets, by the number of the text, the month (in Arabic figures) and the year of publication in *Industrial Property* (IP). The tables of member States of the treaties administered by WIPO (together with the dates of entry into force of the various acts) are also given in the January 1990 issue of *Industrial Property*.

The Patents Regulations (Amendment) (Statutory Rules 1989, No. 311), which update and consolidate the list of Convention countries under Section 140, and those countries whose laws confer corresponding rights under Section 123, of the Patents Act 1952, entered into force on November 17, 1989. The amended Regulations also specify those treaties under which a patent application is deemed to have been made in a Convention country.

The Patents Regulations (Amendment) (Statutory Rules 1989, No. 390), which contain implementing regulations for the new extension of patent term provisions, entered into force on December 21, 1989.

The *Patent Attorneys Regulations* (Amendment) (Statutory Rules 1989, No. 25), which vary requirements concerning the qualifications of persons who practice as patent attorneys, entered into force on May 1, 1989.

The Patent Attorneys Regulations (Amendment) (Statutory Rules 1989, No. 92), which vary the fees payable with respect to the registration of patent attorneys, entered into force on July 1, 1989.

The *Trade Marks Regulations* (Amendment) (Statutory Rules 1989, No. 94), which vary the fees payable under the Trade Marks Act 1955, entered into force on July 1, 1989.

The Trade Marks (Norfolk Island) Regulations (Statutory Rules 1989, No. 208), which modify the provisions of the Trade Marks Act 1955 relating to importation of goods infringing Australian trademarks, in their application to Norfolk Island, entered into force on August 7, 1989.

The Trade Marks Regulations (amendment) (Statutory Rules 1989, No. 312), which update and consolidate the list of Convention countries under Section 108 of the Trade Marks Act 1955, entered into force on November 17, 1989. The amended Regulations also specify those treaties under which a trademark application is deemed to have been made in a Convention country.

The *Designs Regulations* (Amendment) (Statutory Rules 1989, No. 95), which vary the fees payable under the Designs Act 1906, entered into force on July 1, 1989.

The Designs Regulations (Amendment) (Statutory Rules 1989, No. 313) which update and consolidate the list of Convention countries under Section 48 of the Designs Act 1906, entered into force on November 17, 1989. The amended Regulations also specify those treaties under which a design application is deemed to have been made in a Convention country.

The *Circuit Layouts Act 1989* (No. 28 of 1989), assented to on May 22, 1989, has not yet entered into force except for the provisions of Sections 1 and 2 (short title and commencement) (on May 22, 1989). Registration of circuit layouts is not required for their protection.

Belgium. The *Law on the Legal Protection of Topographies of Semiconductor Products* of January 10, 1990, entered into force on February 5, 1990 (Text 1-003, IP 6/1990). This text is the national text adopted to implement Directive 87/54/EEC of the Council of the European Communities of December 16, 1986, on the Legal Protection of Topographies of Semiconductor Products (MULTILATERAL TREATIES – Text 2-011, IP 6/1987). Registration of topographies is not required for their protection.

Brazil. The new *Constitution of the Federative Republic of Brazil* (of October 5, 1988) entered into force on October 5, 1988 (*Extracts*, Text 1-001, IP 6/1989). For a commentary of the pertinent points of that text, see "Developments in Industrial Property Legislation in 1988" (hereafter referred to as "Developments 1988"), *Industrial Property*, 1989, pp. 200 *et seq.*

Canada. The *Act to Amend the Patent Act* and to provide for certain matters in relation thereto, assented to on November 19, 1987 (hereinafter referred to as the "amending Act"), entered into force on various dates and on October 1, 1989 (for almost all amendments relating to the general patent procedures for granting and enforcing patent rights) and on December 7, 1987 (for amendments dealing with market protection for patents relating to medicines).

One of the most important changes is that of the adoption of a first-to-file system (as opposed to the first-to-invent system which was in force previously).

The new system is based on the concept of absolute novelty, with any publication of the invention earlier than the filing date or the priority date, if any, being a potential bar to the grant of a patent.

The term of a patent has been extended from 17 years from the date of issue of a patent to 20 years from the filing date and annual maintenance fees are payable on patents issued and applications filed on or after October 1, 1989. Patents granted after October 1, 1989, based on applications filed before that date are also subject to maintenance fees as of their issue date, for a period of 17 years. All patents that have been issued after October 1, 1989, are subject to reexamination at the request of the owner of the patent or a third party during the whole period of validity of the patent.

Another innovation introduced by the amending Act relates to provisions on inventions pertaining to medicines aimed at increasing the market protection given to patents relating to medicines. Those provisions include restrictions placed on the use of compulsory licenses on patents relating to medicines, granted under the Patent Act. The restrictions take the form of periods of exclusivity that prevent a compulsory licensee from (a) importing a patented

medicine into Canada, for sale in Canada, for a period of 10 years from the date of the notice of compliance (NOC) issued to the patentee under the Food and Drug Regulations, and (b) manufacturing a patented medicine in Canada, for sale in Canada, for a period of seven years from the NOC date. A patentee may apply to the Commissioner of Patents to have a medicine declared to be an invention that has been invented and developed in Canada and, if such a declaration is made, the patentee is entitled to increased patent protection by way of further restrictions placed on any compulsory licensee.

The amending Act also establishes a Patented Medicine Prices Review Board which requires the owner of a patent for an invention pertaining to a medicine to provide the Board with information on the price at which the medicine is sold and the costs of making and marketing it, and such additional information as the Board may require. If the Board decides that a medicine is excessively priced it may order that the above-mentioned restrictions on compulsory licensees will cease to apply to that particular medicine and/or to another of the patentee's patented medicines, or direct the patentee to cause the price at which the medicine is sold to be reduced.

The *Patent Rules* governing the general patent provisions contained in the amending Act came into effect on October 1, 1989.

Canada became a member of the Patent Cooperation Treaty (PCT) as from January 2, 1990, and Canada's Patent Cooperation Treaty Regulations came into effect on that date.

Chile. The new *Law on Industrial Property* authorizing the President of the Republic to issue by decree a new consolidated, coordinated and systematized text on industrial property, including the revision and amendment of the provisions *inter alia* of the Decree-Law on Industrial Property (No. 958 of June 8, 1931), was adopted on February 12, 1990, and entered into force on February 24, 1990.

China. The *Implementing Regulations under the Trademark Law* (amended and approved by the State Council on January 3, 1988, and Promulgated by the State Administration for Industry and Commerce on January 13, 1988) entered into force on January 13, 1988 (Text 3-002, IP 3/1990). For a commentary on that text, see "Developments 1988" and the study by Ren Zhonglin entitled "Current Developments in China's Trademark Operations," *Industrial Property*, 1990, pp. 73 *et seq.*

The *Law on Technology Contracts* (adopted by the Twenty-First Session of the Standing Committee of the Sixth National People's Congress on June 23, 1987), entered into force on November 1, 1987 (Text 6-001, IP 12/1989).

China became party to the Madrid Agreement, of April 14, 1891, Concerning the International Registration of Marks, as from October 4, 1989.

Czechoslovakia. The *Trademark Law* (No. 174 of November 8, 1988) and the *Decree of the Office for Inventions and Discoveries on the Procedure Relating to Trademarks* (No. 187 of November 8, 1988) both entered into force on January 1, 1989 (Texts 3-001 and 3-002, IP 10/1989). For a commentary on those texts, see the study by M. Vilímská entitled "The Legal Protection of Trademarks in Czechoslovakia," *Industrial Property*, 1989, pp. 378 *et seq.*, and "Developments 1988."

Denmark. Act No. 854 of December 23, 1987, to amend the *Patents Act*, the *Designs Act*, the *Trademarks Act* and the *Collective Marks Act*, which introduced provisions on the extension of the competence of the Board of Appeals in patent matters to trademark and industrial design matters, entered into force on January 1, 1988.

The *Patents Act* was further amended by Act No. 368 of June 7, 1989, which introduced a new Part XA entitled "European Patents" (Sections 75 to 90), in order to permit the ratification of the European Patent Convention. Those provisions entered into force on January 1, 1990.

The *Secret Patents Act* (Text 2-002, IP 6/1980) was amended by Act No. 369 of June 7, 1989, which entered into force on January 1, 1990. The amendments concern European patent applications and patents.

The *Order Concerning Patents for Inventions of Pharmaceutical Products* (No. 450 of September 16, 1983), entered into force on December 1, 1983, and the *Executive Order Concerning Patents for Inventions of Foodstuffs and Patents for Processes for the Manufacture of Foodstuffs* (No. 511 of August 23, 1988), entered into force on January 1, 1989 (Texts 2-003 and 2-004, IP 7-8/1989).

Denmark became a member of the European Patent Organisation as from January 1, 1990, and party to the European Convention on the Unification of Certain Points of Substantive Law on Patents for Invention (1963) as from December 30, 1989.

Finland. The *Decree Concerning the Grant of Patents for Foodstuffs and Pharmaceuticals* (No. 932 of December 4, 1987), entered into force on January 1, 1988 (Text 2-003, IP 7-8/1989).

Law No. 656 of December 29, 1967, Concerning the Right to Employees' Inventions was amended by Law No. 526 of June 10, 1988, which entered into force on October 1, 1988. The burden of proof as to the patentability of employees' inventions has been shifted: it now states that if an employer claims a right in an invention made by an employee—thus limiting the employee's right to apply for or to

obtain a patent—the invention is deemed patentable unless the employer can show plausible grounds to prevent the grant of a patent (e.g., by proving that the invention is not patentable). The Law also provides that an action relating to the remuneration must be brought within 10 years from the date on which the employer has informed the employee that he will claim a right in the invention (instead of five years from the date on which the employer indicated his intention to claim a right in the invention, or within one year from the grant of the patent).

Decree No. 527 of June 10, 1988, Concerning the Right to Employees' Inventions entered into force on October 1, 1988.

France. The *Decree on the Protection of Topographies of Semiconductor Products* (No. 89-816 of November 2, 1989) entered into force on November 9, 1989 (Text 1-003, IP 3/1990). For the text of the Law No. 87-890 of November 4, 1987, on the Protection of Topographies of Semiconductor Products, etc., see Text 1-002, IP 3/1990.

The *Law of May 6, 1919, Concerning the Protection of Appellations of Origin* was amended and completed by Law No. 90-558 of July 2, 1990, concerning controlled appellations of origin of primary or transformed agricultural or alimentary products. The Law of 1990 extends the protection conferred by controlled appellations of origin to agricultural and alimentary products.

German Democratic Republic. The new *Statute of the Patent Office* of the German Democratic Republic was adopted by a Decision of the Council of Ministers of February 13, 1990.

The *Patent Law* (of October 27, 1983) (Text 2-001, IP 7-8/1984) was amended by the Law amending and completing the Patent Law and the Trademark Law of June 29, 1990, which entered into force on July 1, 1990. New Section 4 of the Patent Law provides that the right to the invention and to the grant of a patent belong to the inventors or their successors in title and that inventors have the right to be mentioned in the patent specification. Section 5 is amended as follows: inventions are considered to be technical solutions that are characterized by novelty and industrial applicability and that are based on inventive activity (subsection (1), second sentence); a technical solution is considered to be based on inventive activity if it is not obvious to a person skilled in the art with regard to the state of the art (subsection (5)); the following are not regarded as inventions: "methods for treatment of the human or animal body by surgery or therapy and diagnostic methods—this exclusion does not apply to products, in particular substances or compositions, to be used in any of these methods; plant and animal varieties as well as essentially biological processes for the production of plants or animals, except microbiolog-

ical processes and products obtained by such processes" (subsection (6)). A new subsection (7) is added to Section 5: "Furthermore, the following shall not be regarded as inventions: discoveries, scientific theories and mathematical methods; aesthetic creations; schemes, rules and methods for performing mental acts, playing games or doing business, as well as computer programs; the presentation of information. This provision shall apply only to the extent to which protection is sought for the above-mentioned subject matter or activities as such." Section 6 concerning the exclusions from patent protection is worded as follows: "Patents shall not be granted for technical solutions the use of which would be contrary to public order or morality." Section 8 no longer provides for economic patents but only for exclusive patents; the legal protection of inventions is established by the grant of exclusive patents and, if an invention is a State secret, the patent shall be kept secret. Section 9 lays down provisions governing employees' inventions. The duration of a patent is 20 years beginning on the day following the day on which the patent application was received at the Patent Office (Section 15(2)). Disputes on the remuneration of inventors may be submitted to the competent courts of first instance after an appeal has been filed with the Conciliation Board of the Patent Office (Section 28).

The *Law on Distinctive Signs for Goods* (of November 30, 1984) (Text 3-001, IP 11/1985) was also amended by the above-mentioned Law of June 29, 1990, mainly by the deletion of Sections 1 to 6 (purview of the Law, principles and mandatory marking of goods).

The above-mentioned Law of 1990 provides, in its transitional provisions, that applications for economic patents and secret patents filed before its entry into force shall, on request submitted within six months from the entry into force, be converted into exclusive patents; a person who is enjoying the right of use and has already used or made the necessary preparations to use an invention protected by an economic patent is entitled to continue to use the invention in the case of a conversion if he asserts the right to joint use against the patent owner or the Patent Office within six months from the announcement of the conversion; the patent owner has the right to an appropriate license fee; the previous law shall continue to apply to economic patents granted before its entry into force and not converted, to the extent that everyone shall have the right of use and shall be obliged to inform the applicant of the scope of use not later than at the beginning of the use; the applicant is entitled to claim an appropriate consideration from any person using the invention examined as to all requirements for protection.

Germany (Federal Republic of). The *Law for the Reinforcement of the Protection of Intellectual*

Property and for Combating Product Piracy of March 7, 1990, entered into force on July 1, 1990.

The *Trademark Law* (Text 3-001, IP 12/1979 and 10/1981, further amended in 1985 and 1986) was amended by the above-mentioned Law of 1990 that introduced provisions allowing an injured person to demand the destruction of illegally marked articles (Section 25a), to demand, from a person who has, in the course of trade, illegally marked articles or put such articles on the market or stocked them, information on the source of such articles and to claim compensation for damages and restitution of the illegal gain (Sections 25b and 25c). New Section 25d enumerates the acts of illegally marking goods or their packaging which are punished by imprisonment for up to five years or by a fine; the incriminated articles may be seized and the sentence may be published. New Section 26 provides a penalty of imprisonment for up to two years or a fine for any person who falsely applies, in the course of trade, indications as to the source, characteristics or value of goods that are likely to cause error, or for any person who puts such goods on the market, and the removal or destruction of the incriminated goods. New Section 28 provides for seizure of such goods at the border, by the customs authorities, at the request of the legitimate owner, whether those goods are due for importation or exportation, where the violation of the law is obvious and against security deposited by the legitimate owner of the right. This provision applies in the course of trade with the other Member States of the European Communities only to the extent that controls are carried out by the customs authorities. The Law of 1990 implements the Council of the European Communities Regulation (EEC) No. 3842/86 of December 1, 1986, Laying Down Measures to Prohibit the Release for Free Circulation of Counterfeit Goods (MULTILATERAL TREATIES – Text 3-003, IP 7-8/1987).

The *Law Concerning Copyright in Industrial Designs* (Text 4-001, IP 6/1988) was also amended by the above-mentioned Law of 1990 by the introduction, *inter alia*, of a new Section 14 providing for imprisonment for up to three years or a fine applicable to any person who, without the consent of the owner of the right, makes a copy of a design with the intent to distribute it or who distributes such a copy; the imprisonment penalty is increased to up to five years where such acts are accomplished in the course of trade; the provisions on destruction of infringing material, demand for information, publication of the sentence and measures taken by the customs authorities—which are similar to those introduced into the Trademark Law—are those which were introduced into the Copyright Law and are applicable *mutatis mutandis* to industrial designs.

The *Patent Law* (Text 2-002, IP 5/1981 and 5/1988) was also amended by the above-mentioned Law of 1990 by the introduction of provisions

allowing the injured person to demand the destruction of incriminated articles (Section 140a) and to demand from any person who uses his patented invention illegally to supply information on the source of the articles used (Section 140b). Under new Section 142, the penalty of imprisonment is increased from up to one year to up to three years and, where the acts were done in the course of trade, the penalty is imprisonment for up to five years or a fine. The provisions on seizure of infringing material, publication of the sentence and measures taken by the customs authorities are similar to those introduced into the Trademark Law.

The *Utility Model Law* (Text 2-003, IP 7-8/1987) was also amended by the above-mentioned Law of 1990. New Section 1(1) defines the object which may be protected as a utility model: an invention that is new, involves an inventive step and is industrially applicable. New Section 2 provides that inventions the publication or exploitation of which would be contrary to public order or morality, plant or animal varieties and processes may not be protected as utility models. Section 4(1) provides that a utility model application may be filed for one invention only. Section 12a provides that the scope of protection of a utility model is determined by the terms of the claims, but that the description and drawings are to be used to interpret the claims. The duration of a utility model, which is originally three years, may be extended by the payment of a fee for another three-year period and may then be extended by the payment of successive fees for periods of two years each, for a maximum of 10 years. New Sections 24a, 24b and 25 contain provisions on the destruction of infringing material, the right to demand information, increased penalties, seizure of goods and publication of the sentence similar to those introduced into the Trademark and Patent Laws. New Section 25a contains provisions on measures taken by the customs authorities similar to those introduced into the Trademark Law.

The *Law on the Protection of the Topographies of Microelectronic Semiconductor Products* (Text 1-004, IP 1/1988) was also amended by the above-mentioned Law of 1990 by the application, *mutatis mutandis*, to semiconductor products of the new provisions introduced into the Utility Model Law on the destruction of infringing material, demand for information and measures applied by the customs authorities; the criminal sanctions are likewise increased and the penalty for acts done in the course of trade is imprisonment for up to five years or a fine; the provisions of the Utility Model Law on seizure and publication of the sentence are likewise applicable.

The above-mentioned Law of 1990 furthermore amended the Copyright Law, the Law on the Protection of Plant Varieties, the Law on Unfair Competition, the Law on the Organization of the Courts, the

Ordinance on Penal Proceedings and the Law on the Fees of the Patent Office and the Patent Court.

The *Order Concerning the German Patent Office* (of September 5, 1968, as last amended by the Order of June 24, 1988), entered into force on July 1, 1988 (Text 1-003, IP 7-8/1989).

Greece. The *Law on Technology Transfer, Inventions and Technical Innovation* (Law No. 1733 of May 7, 1987) entered into force on September 22, 1987, except for the provisions of its Parts II, III, IV and Section 25(1) and (2) of Part VI, which entered into force on January 1, 1988 (Text 1-001, IP 4/1990). For a commentary on that text, see "Developments 1988" and the study by C. Margellou entitled "The New Greek Legislation on Technology Transfer, Inventions and Technical Innovations," *Industrial Property*, 1990, pp. 83 *et seq.*

Guinea became a member of the African Intellectual Property Organization (OAPI) on January 13, 1990.

Hungary. The *Decree on the Remuneration of Employee's Inventions and Other Matters Related to Inventions* (No. 77 MT of July 10, 1989) and the *Decree Concerning Innovations* (No. 78 MT of July 10, 1989) both entered into force on January 1, 1990.

Indonesia. The *Patent Law* is scheduled to enter into force on August 1, 1991. Under its provisions, patents are granted for a maximum of 16 years (14 years at the outset and one renewal for two years) and utility models for five years. For the purposes of prior art, the novelty of an invention is destroyed by a written disclosure in Indonesia or abroad or by a disclosure by other means in Indonesia only. Food-stuffs, drinks, new plant and animal varieties, diagnostic methods, therapeutic and surgical treatment, as well as scientific and mathematical methods, are excluded from patent protection. The grant of a patent may be postponed for a period of five years in the public interest or for the execution of a development program. Importation of patented products or of products obtained by a patented process is not considered use of an invention, nor is it considered as an infringement, except in certain cases designated by the Government. Applications claiming a priority right under the Paris Convention must be filed within 12 months from the first application in a Paris Union member State. The details of all applications are published within six months from their filing date; opposition may be made within the following six months. Publication of certain inventions may be dispensed with in the national interest. A request for examination must be filed within three months from the application. In order to be valid, the transfer of patents and license contracts must be

recorded in the patent register. License contracts must not contain terms prejudicial to the national economy. A compulsory license may be requested if the patent has not been worked for three years in the country (importation is not considered as working). A patent lapses if it has not been used for four years. The patent owner whose right has been infringed may request an injunction, damages and the remittance to him of the manufactured products or of their equivalent in money. In such a case, the innocent infringer is entitled to compensation. Only applications filed under the 1953 Decrees during the 10 years (i.e., since August 1, 1981) preceding the entry into force of the Patent Law may be filed again under the new Law.

Ireland. The *European Communities (Protection of Topographies of Semiconductor Products) Regulations, 1988* (S.I. No. 101 of 1988) entered into force on May 13, 1988. The *European Communities (Protection of Topographies of Semiconductor Products) (Amendment) Regulations, 1988* (S.I. No. 208 of 1988) entered into force on August 18, 1988, and shall stand revoked on November 7, 1990 (Texts 1-001 and 1-002, IP 5/1990). These texts are the national texts adopted to implement Directive 87/54/EEC of the Council of the European Communities (MULTILATERAL TREATIES - Text 2-011, IP 6/1987). Registration is not required for the protection of topographies.

Italy. The *Provisions on the Legal Protection of Topographies of Semiconductor Products* (Law No. 70 of February 21, 1989) entered into force on March 18, 1989 (Text 1-009, IP 2/1990); their application is, however, conditional on the entry into force of their implementing regulations. The Law is the national text adopted to implement Directive 87/54/EEC of the Council of the European Communities (MULTILATERAL TREATIES - Text 2-011, IP 6/1987) and provides for the registration of topographies for their protection.

Japan became party to the Nice Agreement, of June 15, 1957, Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, as from February 20, 1990.

Lesotho. The *Industrial Property Order, 1989* (Order No. 5 of 1989) entered into force on May 22, 1989 (Text 1-001, IP 5/1990). It was drafted on the basis of the ARIPO Model Law. Its main provisions are as follows:

Part II (Sections 3 to 16) relates to patents. The following are excluded from patent protection: "(a) discoveries, scientific theories and mathematical methods; (b) plant and animal varieties or essentially biological processes for the production of plants or

animals, other than microbiological processes and the products of such processes; (c) schemes, rules or methods for doing business, performing purely mental acts or playing games; (d) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practiced on the human or animal body. This provision shall not apply to products for use in any of those methods.” (Section 4).

An invention is new if it is not anticipated by prior art which consists of everything disclosed to the public prior to the filing or priority date of the application: (a) anywhere in the world, by publication in tangible form; or (b) in Lesotho, by oral disclosure, by use or in any other way (Section 5(1) to (3)); for the purposes of prior art, disclosure of the invention to the public is not taken into consideration if it occurred within six months preceding the filing or priority date of the application, and if it was by reason or in consequence of acts committed by the applicant or his predecessor in title or of an abuse committed by a third party with regard to the applicant or his predecessor in title (Section 5(4)).

The right to a patent may be assigned, or transferred by succession (Section 6(4)).

Section 6 contains provisions relating to inventions made in execution of a commission or an employment contract.

The inventor has the right to be named as such in the patent (Section 6(10)).

The right of priority under the Paris Convention is provided for by Section 9.

Exploitation of a patented invention by the Government is provided for in cases where the public interest, in particular, national security, nutrition, health or the development of another vital sector of the national economy requires it (Section 13(5)).

A patent expires 15 years after the date of the application for the patent, with an extension of that period for a period of five years on payment of a fee and on proof that the invention is sufficiently worked or of circumstances justifying failure to work the patent sufficiently (importation is not such a circumstance) (Section 14); if the patented invention is not worked or is insufficiently worked in Lesotho, the Registrar may grant a non-voluntary license at the request of any person who proves his ability to work the patented invention in Lesotho made after the expiration of a period of four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period expires last, unless the owner of the patent proves circumstances which justify the non-working or insufficient working (importation does not constitute such a circumstance) (Section 15(1) and (2)).

Part III (Sections 17 to 19) deals with utility model certificates. The provisions of Part II apply, *mutatis mutandis*, with a number of exceptions to

utility model certificates (Section 17). In order to qualify for a utility model certificate, an invention must be new and industrially applicable (Section 18(1)); a utility model certificate expires, without any possibility of renewal, at the end of the seventh year after the date of the filing of the application (Section 18(4)).

Part IV deals with the protection of industrial designs. An industrial design is new if it has not been disclosed to the public prior to the filing or priority date of the application: (a) anywhere in the world by publication in tangible form; or (b) in Lesotho, by description or by use or in any other way (Section 20).

Section 21(5) to (9) lays down the provisions governing industrial designs made on commission or by employees which are similar to those governing patents; Section 21(10) provides for the naming of the creator.

Part V (Sections 26 to 33) deals with trademarks, collective marks and trade names. Marks incapable of distinguishing the goods or services of an enterprise from those of other enterprises, marks contrary to public order or morality or misleading marks are not registrable (Section 26); an examination as to substance and opposition proceedings (on notice given by any interested person within the prescribed period) are provided for in Section 28. The exclusive right of the trademark owner extends to the use of a sign similar to the registered mark and to the use in relation to goods or services similar to those for which the mark has been registered, where confusion may arise in the public, but not to acts in respect of articles put on the market in the country by the registered owner or with his consent (Section 29(2) and (3)).

The duration of the registration of a mark is 10 years from the filing date of the application, renewable, upon request, for consecutive periods of 10 years (Section 29(4), (5) and (6)).

With some exceptions, the provisions relating to trademarks are applicable *mutatis mutandis* to collective marks (Section 31(1)); the collective mark must be designated as such in the application and the application must be accompanied by a copy of the conditions governing the use of the collective mark (Section 31(2)); the owner of the collective mark must notify to the Registrar all changes made in the conditions (Section 31(3)).

License contracts concerning marks (registrations and applications) must provide for effective control by the licensor of the quality of the goods or services of the licensee in connection with which the mark is used; the license contract is not valid if it does not provide for such control or if such control is not effectively carried out (Section 32(1)); applications for collective marks and registered collective marks may not be subject to license contracts (Section 32(2)).

Names or designations used as trade names and which, by reason of their nature or the use to which they may be put, are contrary to public order or morality or which are liable to deceive trade circles or the public as to the nature of the enterprise identified by that name may not be used as trade names (Section 33(1)); however, trade names are protected even prior to or without registration against any unlawful act committed by third parties (Section 33(2)).

Part VI deals with acts of unfair competition which are defined as any acts of competition contrary to honest practices in industrial or commercial matters, in particular: (a) all acts of such nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor; (b) false allegations in the course of trade of such nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor; (c) indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity of the goods (Section 34).

Where the applicant's ordinary residence or principal place of business is outside Lesotho, he must be represented by an agent (Section 35).

The *Industrial Property Regulations, 1989* (Legal Notice No. 85) entered into force on January 15, 1990 (Text 1-002, IP 5/1990).

Luxembourg. The *Law of December 29, 1988, on the Legal Protection of Topographies of Semiconductor Products*, entered into force on November 7, 1987 (Text 1-001, IP 7-8/1989). This text is the national text adopted to implement Directive 87/54/EEC of the Council of the European Communities (MULTILATERAL TREATIES - Text 2-011, IP 6/1987) and provides for the registration of topographies for their protection.

Madagascar. The entry into force of *Ordinance No. 89-019 Instituting an Industrial Property Protection System* in Madagascar (of July 31, 1989), published in the Official Journal of the Democratic Republic of Madagascar on August 14, 1989, is scheduled to take place on January 1, 1991.

The Ordinance provides for the protection of inventions (by patents and inventors' certificates), of marks for products and services and of collective marks, of industrial designs, of commercial names and protection against acts of unfair competition.

Mali. The *Law on the Protection of Industrial Property* (No. 87-18/AN-RM of March 9, 1987) (Text 1-001, IP 1/1990) entered into force, as regards applications filed in Mali before September 30, 1984, on July 28, 1988; as from that date, the

OAPI (Bangui) Agreement is applicable; the *Decree Implementing the Law* (No. 130 PG-RM of May 18, 1987) entered into force on May 18, 1987 (Text 1-002, IP 1/1990).

Nepal. The *Patents, Designs and Trademarks Act, 2022 (1965)*, as amended by the Patents, Designs and Trademarks (First Amendment) Act, 2044 (1987), entered into force on October 18, 1987 (Text 1-001, IP 3/1990).

It was mainly amended by the introduction of service marks (Section 2); the publication and availability for inspection of registered patents, and the possibility to object to such patents within 35 days from the date of inspection (Section 7A). The patent term has been extended to a maximum of 21 years (seven years from the date of registration under Section 8, and two further terms of seven years each under Section 23B) and the duration of design registrations has been fixed at a maximum of 15 years (five years from the date of registration under Section 14A, and two further terms of five years each under Section 23B).

Section 18A allows the Government to classify goods and services for the purposes of the registration of marks; separate applications must be filed for marks relating to goods or services belonging to separate classes (Section 18A); the use of unregistered marks as registered marks is prohibited (Section 18B); the registration of a mark may be canceled where the registered mark has not been used within one year from registration (Section 18C); the registration may be renewed without limitation (seven years from registration under Section 18D, with any number of additional terms of seven years under Section 23B).

The penalties for the violation of industrial property rights have been increased.

The owner may allow another person to use his registered design or mark; the Department of Industries may grant the corresponding permission on joint application by the owner and the other person and, in doing so, the Department transfers the ownership of the design or mark to the person allowed to use it (Section 21D).

Registration abroad of industrial property titles not registered in Nepal is prohibited (Section 23A).

Oman. The new *Trademark Law*, promulgated in October 1987, provides for the registration of marks for products or for services; the international classification of marks is applicable, although alcoholic products (class 33) are excluded; separate applications must be filed for products or services in separate classes; the registration of a mark is valid for a period of 10 years, indefinitely renewable, on request, for periods of 10 years each.

The *Implementing Regulations under the Trademark Law* were published in the Official Gazette by

decision of the Minister for Trade and Industry of November 24, 1988, and entered into force on December 15, 1988. Applications for the registration of trademarks have been accepted in Oman since January 1, 1989.

Peru. *Supreme Decree No. 048-84-ITI/IND* (of October 31, 1984), introducing the protection of utility models by registration, entered into force on November 5, 1984 (Text 2-001, IP 3/1990).

Portugal. *The Law of June 30, 1989, on the Legal Protection of Topographies of Semiconductor Products* (No. 16/89 of June 30, 1989) was published in 1990 in *Industrial Property* (Text 1-002, IP 3/1990). This text is the national text adopted to implement Directive 87/54/EEC of the Council of the European Communities (MULTILATERAL TREATIES – Text 2-011, IP 6/1987) and provides for the deposit of topographies for their protection; it also provides for compulsory licenses for the State in cases where a vital national interest is involved.

Republic of Korea. *The Patent Law* (No. 950 of December 31, 1961, as wholly amended by Law No. 4207 of January 13, 1990) entered into force on September 1, 1990.

The reservation relating to Chapter II of the PCT (International Preliminary Examining Authority) has been withdrawn. New Section 201 provides for the international preliminary examination system under Chapter II of the PCT.

Patent protection has been extended to food products *per se* and to asexually reproducible plant varieties (Sections 31 and 32).

New Section 43 requires an abstract to be joined to the patent application.

Sections 41 and 66(4) of the new Law provide for restrictions on the filing of patent applications for inventions necessary for the national defense in foreign countries and secrecy of such inventions.

The duration of patents is 15 years from the date of publication of the application if the application was published, or from the date of registration of the establishment of the right, if the application was not published, but not exceeding 20 years from the filing date of the application (new Section 88); it may be extended by a maximum of five years in cases where the invention could not be worked for over two years because permission to do so could not be obtained earlier (Section 89).

The Government is authorized to use or expropriate a patented invention which is necessary for purposes of national defense (Section 106). Non-exclusive licenses may be requested in cases of non-working or insufficient working of a patented invention or where necessary in the public interest (Section 107).

Section 98, which provided for a statute of limitation of five years after the date of registration of the patent right for bringing a trial for invalidation on the ground that the invention had been described or could easily have been made by a person having ordinary skill in the art prior to the patent application, has been deleted.

The Trademark Law (No. 71 of November 28, 1949, as wholly amended by Law No. 4210 of January 13, 1990) entered into force on September 1, 1990.

It provides for free assignment or change of ownership of a trademark application or registered mark without having to transfer the related business (Section 12); the provision providing for automatic expiration of a mark upon the cessation of the related business has been repealed; the former requirements governing the transfer of a registered mark have been loosened by permitting the owner to assign his mark separately on a product classification unit basis (Section 12); the provision requiring the applicant for registration of a mark or the owner of a registered mark to give public notice of his proposed assignment or transfer of the mark no later than 30 days before the transfer has been repealed; the period of non-use of a mark for purposes of bringing a cancellation trial has been extended from one year to three years (Sections 76 and 42(2)(ii)); the ground for instituting a cancellation trial founded on the owner's lack of action to stop unauthorized use of his mark has been deleted; the burden of proof (that the owner has not worked the mark during the relevant period) on the plaintiff in a cancellation trial founded on the non-use of a registered mark has been shifted to the owner of the mark and it is now for the latter to prove that he actually used the mark (Section 66(4)); partial invalidation or cancellation of a mark registered for several classes is now possible for those classes of articles which are found defective; in accordance with Article 6ter of the Paris Convention, official signs and hallmarks indicating control and warranty adopted by Paris Union member States have been added to the list of non-registrable subject matter (Section 7(1)(i)); a pledge may now also be established on an application for trademark registration or a registered mark.

The Utility Model Law (No. 952 of December 31, 1961, as wholly amended by Law No. 4209 of January 13, 1990) entered into force on September 1, 1990. The amendments reflect those introduced into the Patent Law. The term of a utility model is 10 years from the date of publication of the application therefor if published, or from the date of registration of the establishment of the utility model right if not published; its term may, however, not exceed 15 years from the filing date of the utility model application (Section 22(1)).

The Designs Law (No. 951 of December 31, 1961, as wholly amended by Law No. 4208 of

January 13, 1990) entered into force on September 1, 1990. The amendments reflect those introduced into the Patent Law.

Saudi Arabia. The *Patents Act* (approved by the Council of Ministers Decision No. 56 of 19/4/1409 of the *Hegira* on November 28, 1988, and promulgated by Royal Decree No. M/38 of 10/6/1409 of the *Hegira*) entered into force on May 18, 1989 (Text 2-001, IP 9/1989). For a commentary on that text, see "Developments 1988."

Soviet Union. Decree No. 6(15) of the USSR State Committee for Inventions and Discoveries of June 11, 1987, concerning additions to the *Statute on Trademarks*, added to it a new Chapter VI entitled "Procedures for the Filing of Applications for the Registration of Trademarks and for the Use of Trademarks by Nationals Engaging in Individual Economic Activity" (Text 3-001, IP 9/1986 and 5/1990). This new Chapter extends the possibility of filing trademark applications and owning trademark registrations to individuals. The Decree entered into force on June 11, 1987.

Spain. The *Trademark Law* (Law No. 32/1988, of November 10, 1988) entered into force on May 13, 1989 (Text 3-001, IP 6/1989). For a commentary on that text, see "Developments 1988."

The *Trademark Regulations* (Royal Decree No. 645/1990 of May 18, 1990) entered into force on May 26, 1990.

Switzerland. The Commission of the European Communities has decided that the legal protection currently applicable in Switzerland under Section 5 of the Federal Law on Unfair Competition of December 19, 1986 (Text 5-001, IP 9/1988) fulfills the requirements of Article 1(2) of the Decision of the Council dated May 31, 1988, by which Member States of the European Communities are obliged to extend the legal protection granted to the topographies of semiconductor products to natural persons of Swiss nationality or whose residence is in Switzerland. This also applies to companies and other legal persons that have an actual industrial or commercial establishment in Switzerland to the extent that reciprocity exists.

United Kingdom. The *Patents Act 1977*, as last amended by the Copyright, Designs and Patents Act 1988, will appear in 1990 in several issues of *Industrial Property* (Text 2-001, IP 9, 10 and 11/1990).

Part III of the Copyright, Designs and Patents Act 1988 (Design Right) entered into force on August 1, 1989 (Text 4-001, IP 9/1989).

The *Design Right (Semiconductor Topographies) Regulations 1989*, of June 29, 1989, which entered into force on August 1, 1989, revoked and replaced the Semiconductor Products (Protection of Topog-

raphy) Regulations 1987 (No. 1497 of August 20, 1987) and were themselves amended on May 2, 1990, by the Design Right (Semiconductor Topographies) (Amendment) Regulations 1990, which entered into force on May 31, 1990 (Text 1-001, IP 11/1989). Except where the context otherwise requires, the new Regulations must be construed as one with Part III (Design Right) of the Copyright, Designs and Patents Act 1988 (see commentary in "Developments 1988." According to the new Regulations, the right in a semiconductor topography is a special category of design right; it therefore sets out the provisions of Part III of the Copyright, Designs and Patents Act 1988 that should be read differently when applying to a semiconductor topography right.

The *Registered Designs Act 1949* (as last amended by the Copyright, Designs and Patents Act 1988) appeared in *Industrial Property* in 1989 (Text 4-002, IP 10/1989).

The Copyright, Designs and Patents Act 1988 introduced four new Sections (58A, 58B, 58C and 58D) into the *Trade Marks Act 1938* (Text 3-001, IP 3/1987 and 4/1990). They entered into force on August 1, 1989. The fraudulent application or use of a trademark that is identical to or nearly resembles a registered mark to goods or material used or intended to be used for labeling, packaging or advertising goods, or to sell, etc., goods or material bearing such a mark is an offense where done by a person not entitled to use the mark, if the person acts with a view to gain or intent to cause loss to another and intends that the goods in question should be accepted as connected in the course of trade with a person entitled to use the mark; for such an offense, the court may order that the infringing material be delivered up but the court shall not make such an order if it appears to the court unlikely that any order as to the disposal of infringing goods or material will be made under Section 58C. Persons having an interest in the goods or material are informed of, and have a right to take part in, the proceedings (Section 58C). The local weights and measures authority has certain powers for the enforcement of Section 58A in relation to the Trade Descriptions Act 1968 (Section 58D).

The Copyright, Designs and Patents Act 1988 (Part V (Patent Agents and Trade Mark Agents) and Part VI (Patents)) appeared in *Industrial Property* in 1990 (Text 2-003, IP 6/1990). Part V has not yet entered into force; Part VI entered into force on August 1, 1989, with the exception of Sections 293, 294 and 295, insofar as it relates to paragraphs 1 to 11 and 17 to 30 of Schedule 5.

Viet Nam. The *Decree on the Protection of Industrial Property Rights* (promulgated by Order No. 13 LCT/HDNN 8 of February 11, 1989) entered into force on February 11, 1989 (Text 1-001, IP 11/1989).

Its principal provisions are as follows: industrial property rights consist of the ownership of inventions, utility solutions, industrial designs and trademarks and of the right to use appellations of origin (Section 1); foreigners may enjoy industrial property rights in Viet Nam in accordance with the provisions of the international treaties to which Viet Nam is a party or on the basis of the principle of reciprocity (Section 3).

Trademarks are registered for goods or services (Section 4(4)).

The owner of a title of protection may be an organization or a natural person to whom a title of protection is granted or the ownership right of an object of industrial property is transferred (Section 8(1)).

"Service inventions," "service utility solutions" and "service industrial designs" are dealt with in Section 8(3)).

The owner of a title of protection granted for an invention, a utility solution, an industrial design or a trademark is entitled to possess the protected object, to use it exclusively and to transfer the ownership right of or the right to use the protected object to another organization or person (Section 9(1)); the owner of a title of protection granted for an appellation of origin is entitled to use the appellation of origin but not to transfer that right (Section 9(2)); in a case of infringement of his right, the owner of a title of protection may institute proceedings with the court (Section 9(3)). The transfer of the ownership right or of the right to use a protected object must be by a written contract registered with the National Office on Inventions according to the provisions on transfer of technology (Section 10).

The following acts constitute use of an invention, utility solution or industrial design: manufacturing, using, importing, advertising and putting into circulation the product in which the protected invention, utility solution or industrial design is embodied, as well as the process in which an invention or utility solution is protected (Section 11(1)); the following acts constitute use of a trademark or of an appellation of origin: placing the trademark or appellation of origin on a product or its packaging or on documents or vouchers to mark the product or to indicate the origin of the product or advertising the trademark or appellation of origin (Section 11(2)).

Infringement of the rights of the owner of a title of protection is committed by performing acts which the owner is exclusively entitled to perform and acts considered as use of the protected object without the owner's agreement and the use of a sign or name similar to a protected trademark in such a way as to be likely to mislead the consumers and damage the interests of the owner (Section 12(1)).

Section 15 reserves the right of an organization or person who or which, before the priority date of the application for a title of protection, has used or made

serious preparations to use the invention, utility solution or industrial design, to continue to use the said object, however, without extending that use or increasing its volume; such right may not be transferred.

The author of an invention, utility solution or industrial design has the right to be named as such in the title of protection and other scientific and technical documents; the author of a service invention, a service utility solution or a service industrial design has the obligation to inform his organization or unit of his creative results and has the right to receive a remuneration and bring proceedings for infringement of his right (Section 17).

The right to file an application for protection belongs, in the case of an invention, a utility solution or an industrial design, to the author or his successor in title (Section 18(1)); in the case of a service invention, service utility solution or service industrial design, that right belongs to the organization or unit which employs the author, and, if it has not filed such an application within two months from the notification of his creation made by the author, the author has the right to file the application himself (Section 18(2)). The right to file an application for an invention, utility solution or industrial design made in the course of a scientific-technological research and development contract belongs, unless otherwise provided for in the contract, to the employing party (Section 18(3)).

The right to file an application for the registration of a trademark belongs to organizations or persons lawfully engaged in manufacturing or commercial activities (Section 18(5)). The right to file an application for the protection of an appellation of origin belongs to an organization or person engaged in lawful manufacturing or commercial activities in the locality presenting the distinctive factors (Section 18(6)); the right to file an application for an invention, utility solution or an industrial design may be transferred in writing (Section 18(7)).

The date of priority of an application is the date of receipt of the application by the National Office on Inventions or determined according to the international treaties to which Viet Nam is a party; the priority under such an international treaty must be claimed in the application and must be proved (Section 19).

Applications may be filed through industrial property agents and foreign applicants must do so (Section 20(2)).

The term of a patent is 15 years from the date of priority (Section 23(2)(a)), that of a patent for a utility solution is six years from the priority date (Section 23(2)(b)), that of an industrial design certificate is five years from the priority date (Section 23(2)(c)) and that of a certificate of registration of a trademark is 10 years from the priority date (Section 23(2)(d)). The duration of a certificate of registration

of an appellation of origin is not limited in time (Section 23(2)(e)). At the request of the owner, the term of an industrial design certificate may be extended twice for periods of five years each and that of a trademark registration certificate indefinitely for periods of 10 years each (Section 23(3)).

A trademark registration lapses where the owner of the certificate has not used or transferred the right to use the mark within five years from the date of registration (Section 24(1)(d)).

Inventions or utility solutions relating to the defense and security of the State are secret; their author or the owner of the title of protection for such an invention or utility solution and any person concerned with the making, filing or examining of the application for protection or using or transferring the ownership right or the right to use the secret invention or utility solution is obliged to keep the object secret (Section 26).

Objects of industrial property protection may be the subject of applications for protection abroad after an application for protection has been filed in Viet Nam, unless international treaties to which Viet Nam is a party otherwise provide (Section 27).

The People's Court of a province or town directly under the Central Government and of a corresponding administrative unit is the competent court in the first instance to deal with appeals and disputes in accordance with civil proceedings; where one or both parties are foreigners, the competent court is the People's Court of Hanoi or the People's Court of Ho Chi Minh City upon request of the plaintiff (Section 29).

Disputes concerning contracts of transfer of the ownership right or the right to use an object of industrial property are settled under the provisions relating to proceedings in civil or economic contracts; disputes in which one or both parties are foreigners are settled by the arbitration or other authority selected by both parties (Section 30).

See also the study by Nguyen Van Vien entitled "Promulgation of the Decree on the Protection of Industrial Property Rights in Viet Nam—From Stimulation to Ownership," *Industrial Property*, 1989, pp. 388 *et seq.*

Yugoslavia. The Law of January 17, 1990, amending and completing the *Law on the Protection of Inventions, Technical Improvements and Distinctive Signs* (of June 9, 1981) entered into force on January 27, 1990, and the Law of April 11, 1990, further amending the 1981 Law entered into force on April 21, 1990; both 1990 Laws became applicable as from July 27, 1990 (Text 1-001, IP 7-8/1990).

The novelties introduced into the 1981 Law are as follows.

The Law is now applicable not only to organizations of associated labor but also to enterprises.

The worker-creator has the right to be informed of the procedure for recognition of the right by which his creation is protected (Section 12a).

The Office is entrusted with further tasks, in particular in the field of documentation and vocational training at regional centers (Section 18a).

Section 20 as amended excludes the following from the definition of inventions under the Law: "Discoveries, scientific theories, mathematical formulae, computer programs and any other rules, plans, methods and guidelines for intellectual activity;" and Section 23 as amended excludes the following from patent protection: "(2) the invention of a surgical or diagnostic procedure or a procedure for treatment, directly applicable to human beings or animals," this provision not being applicable to "the invention of a procedure for the application of a substance for diagnostic or curative purposes," and (3) "plant varieties and animal breeds."

An appellation of origin may henceforth also be protected in favor of a foreign person under an international convention (Section 41, third paragraph (new)).

The right of the holder of a patent or design is qualified as "exclusive" (Section 44 amended).

The protection conferred by a patent granted in respect of a process extends to any products directly obtained by the process (Section 45 amended).

The term of a patent is 20 years from the date of submission of the patent application, that of a design is 10 years from the date of submission of the application and that of a mark is 10 years from the date of submission of the application; the latter being extendible for an unlimited number of times; the duration of protection of an appellation of origin is not limited; a patent of addition which has become a basic patent may not last longer than the original basic patent would have lasted; it expires when the basic patent expires.

Section 52, which provided for the obligation of serious and effective exploitation of the protected invention, shape, picture or drawing in the country, has been repealed.

Title IV, which was entitled "Self-Managing Regulation of the Right to Use Inventions Created in Associated Labor," has been repealed.

Henceforth, a patent application may also cover several inventions, provided that they are closely related in such a way as to make up a single inventive concept, and a design application may cover several designs applicable to products belonging to a single class under the International Classification for Industrial Designs (Section 71 amended).

Section 73 provides that a patent application may not be modified after its submission by broadening the subject matter in respect of which protection is applied for; the same provision applies *mutatis mutandis* to applications for the registration of designs or marks.

New Section 76a provides that, in case of a dispute concerning an infringement of the rights arising out of the application, the applicant may request the Office to give priority to the procedure pertaining to his application on supplying evidence establishing that he has requested the publication of his application together with a complete examination of the requirements for the grant of a patent and that he has instituted legal proceedings for the infringement of the rights arising out of the application.

Section 77a provides that inventions relating to the application of substances for the treatment of humans or animals shall not be patentable until December 31, 1992. Sections 77b and 77c give implementing details of this provision.

The applicant must give a detailed account in the description of the invention of at least one way of putting into practice the invention for which protection is requested (the indication of the best mode of putting the invention into practice was previously required) (Section 78, third paragraph, amended).

The provision on compulsory examination of the deposited shape, picture or drawing as to novelty, which was provided for in Section 84, second paragraph, has been repealed.

New Section 84a provides for the possibility of converting a patent application into a design application, and vice versa.

The new third paragraph of Section 92 provides for the printing of a separate patent document for each protected invention.

The third paragraph of Section 93, which provided that at the expiration of a period of 18 months from the filing date of an application or from the date of the claimed priority right any person was allowed to inspect the application, has been repealed.

New Section 98a provides that, within three months from the date of publication of a decision to grant a patent, any person may file an opposition claiming that the requirements for the recognition of the patent have not been satisfied (definition of inventions (Section 20), exclusions from patent protection (Section 23) and provisions concerning the formal requirements for filing an application (Section 78)).

New Section 98b provides that the opponent may withdraw his opposition in the course of the procedure and that the latter shall be terminated unless the applicant requests the procedure to be carried through or if the Office continues it *ex officio*. In its decision on the opposition, the Office decides, if necessary, whether to amend or cancel the disputed decision on the grant of the patent.

Section 112 was amended in order to increase, from three to five years from the date of registration of the mark or from the date on which the mark was last used, the time limit within which any interested person may request that a decision be taken to terminate the said mark.

Section 117 as amended defines the infringement of rights arising out of an invention, a design or a mark and the unauthorized use of a protected appellation of origin and makes the author of the infringement liable to pay damages under the general principles governing compensation for damage. Its new third paragraph establishes the presumption according to which, in the absence of any evidence to the contrary, if the infringement has been committed against an invention in respect of which protection has been applied for or granted, concerning a process for the production of a new substance, any substance having the same composition is deemed to have been manufactured using the protected process; the burden of proof is in such cases on the persons producing the said substance.

Section 119 authorizes not only the holder of a patent (as previously) but also the applicant for a patent to institute an action for infringement of rights. The applicant must submit a request for the complete examination of the requirements for the grant of the patent; if he has not submitted it, he may do so within the time limit prescribed by the court; if he has not submitted it within that time limit, the applicant shall forfeit his right to legal protection in the dispute.

The inventor or author may ask to be named in the application and all relevant documents (Section 127, first paragraph (new)).

The provision requiring an organization of associated labor to use its own registered mark together with the mark of another that it is entitled to use has been repealed (old Section 134).

Under Section 144, an "official license" may be granted for the use of a patented invention in the production and marketing of goods manufactured according to the protected invention.

New Section 149a requires that an organization of associated labor or enterprise whose employee has made an invention notify him of the contents of the patent application it proposes to file and supply him with other information in this respect. Where the organization of associated labor or enterprise intends to withdraw a patent application, it must notify the inventor accordingly and enable him to continue the procedure initiated by the application.

New Section 153a provides for the payment of a royalty to the author of an industrial creation also in cases where the industrial property title is protected and used abroad in the name of an organization of associated labor or enterprise.

Section 169, second paragraph (new), provides that the procedure applicable to disputes relating to the recognition of the authorship is also applicable *mutatis mutandis* to disputes relating to the recognition of the authorship of a technical improvement.

A new Title XI entitled "Representation" (Section 172a) provides that natural and legal persons in charge of representation in the procedure for the

protection of inventions and distinctive signs must be registered in the register of representatives kept by the Office, according to the conditions laid down by the Federal Executive Council.

The amounts of the fines for the violation of the Law (Sections 173, 174 and 175) have been increased.

Zaire. *Ordinance No. 89-173 of August 7, 1989, Providing for the Application of Law No. 82-001 of January 23, 1982, Governing Industrial Property* (Text 1-001, IP 4/1983) entered into force on August 7, 1989.

II. International Treaties

WIPO. The *Treaty on Intellectual Property in Respect of Integrated Circuits*, done at Washington, D.C., on May 26, 1989 (MULTILATERAL TREATIES – Text 1-011, IP 6/1989), was signed by the following eight States : China, Egypt, Ghana, Guatemala, India, Liberia, Yugoslavia, Zambia. The instrument of ratification of the Government of Egypt was deposited on May 26, 1990. See also the Note on the Diplomatic Conference for the Conclusion of a Treaty on the Protection of Intellectual Property in Respect of Integrated Circuits (Washington, D.C., May 8 to 26, 1989), *Industrial Property*, 1989, pp. 216 *et seq.*

The *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks* (as signed at Madrid on June 28, 1989) (MULTILATERAL TREATIES – Text 3-007, IP 7-8/1989) was signed by the following 28 States : Austria, Belgium, Democratic Republic of Korea, Denmark, Egypt, Finland, France, German Democratic Republic, Germany (Federal Republic of), Greece, Hungary, Ireland, Italy, Liechtenstein, Luxembourg, Monaco, Mongolia, Morocco, Netherlands, Portugal, Romania, Senegal, Soviet Union, Spain, Sweden, Switzerland, United Kingdom, Yugoslavia. See also the Note on the Diplomatic Conference for the Conclusion of a Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid, June 12 to 28, 1989), *Industrial Property*, 1989, pp. 253 *et seq.*

III. Regional Treaties

ARIPO. The *Agreement on the Creation of an African Regional Industrial Property Organization (ARIPO)* (as adopted by the Diplomatic Conference for the adoption of an Agreement on the Creation of an Industrial Property Organization for English-Speaking Africa at Lusaka (Zambia) on December 9, 1976), the *Protocol on Patents and Industrial Designs Within the Framework of ARIPO* (adopted on December 10, 1982, at Harare (Zimbabwe)) and the *Regulations for Implementing the Protocol on Patents and Industrial Designs Within the Frame-*

work of ARIPO (text entered into force on April 25, 1984), as amended by the Administrative Council of ARIPO on December 12, 1986, were published in *Industrial Property* in 1989 (MULTILATERAL TREATIES – Texts 1-002, 1-008 and 1-010, IP 12/1989).

Benelux. The *Executive Rules under the Uniform Benelux Law on Marks* and the *Administrative Regulations under the Uniform Benelux Law on Marks* both entered into force on July 1, 1989 (MULTILATERAL TREATIES – Texts 3-008 and 3-009, IP 2/1990)

These texts incorporate, *inter alia*, provisions on anticipation searches, the presentation of a certified copy of the documents proving the priority right, references to the Classification under the Vienna Agreement of June 12, 1973, Establishing an International Classification of the Figurative Elements of Marks, on the possibility of communicating documents to the Benelux Bureau or national offices by telegraph, telex or other similar means of communication, the request for urgent execution of the anticipation search, and provisions relating to time limits and to cases of disruptions in normal postal distribution.

The *Benelux Designs Convention* (of October 25, 1966) and the *Uniform Benelux Designs Law* were reprinted in *Industrial Property* in 1990 (MULTILATERAL TREATIES – Text 4-003, IP 2/1990).

The *Executive Rules under the Uniform Benelux Designs Law* and the *Administrative Regulations under the Uniform Benelux Designs Law* (MULTILATERAL TREATIES – Texts 4-004 and 4-005, IP 2/1990) both entered into force on July 1, 1989.

These texts introduce, *inter alia*, new provisions on the description of the characteristic elements of the new appearance of products, on the presentation of a certified copy of documents establishing the priority right, the possibility to request the postponement of publication of the registration, the same provisions as for marks with respect to communications to the Benelux Bureau or national offices and with respect to time limits and cases of disruptions in normal postal distribution.

European Communities. The *First Council Directive of December 21, 1988, to Approximate the Laws of the Member States Relating to Trade Marks* (89/104/EEC) appeared in *Industrial Property* in 1989 (MULTILATERAL TREATIES – Text 3-006, IP 6/1989). For a commentary of that text, see "Developments 1988."

European Patent Organisation. Denmark became party to the European Patent Convention as from January 1, 1990.

OAPI. Guinea became a member of OAPI as from January 13, 1990.

ZAIRE
Director,
Directorate of Industrial Property

We have been informed that Professor Mbuyu Kabango has been appointed Director of the Directorate of Industrial Property.

Calendar of Meetings

WIPO Meetings

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

1990

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|-------------------------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| September 24 to October 2 (Geneva) | Governing Bodies of WIPO and the Unions Administered by WIPO (Twenty-First Series of Meetings)

Some of the Governing Bodies will meet in ordinary session, others in extraordinary session.
<i>Invitations:</i> As members or observers (depending on the body), States members of WIPO or the Unions and, as observers, other States and certain organizations. |
| October 15 to 26 (Geneva) | Committee of Experts Set Up Under the Nice Agreement (Sixteenth Session)

The Committee will complete the fifth revision of the classification established under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks.
<i>Invitations:</i> States members of the Nice Union and, as observers, States members of the Paris Union not members of the Nice Union and certain organizations. |
| October 22 to 26 (Geneva) | Committee of Experts on the Settlement of Intellectual Property Disputes Between States (Second Session)

The Committee will examine principles for a possible multilateral treaty.
<i>Invitations:</i> States members of the Paris Union, the Berne Union or WIPO or party to the Nairobi Treaty and, as observers, certain organizations. |
| October 29 to November 9 (Geneva) | Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions (Eighth Session; Second Part)

The Committee will continue to examine a draft treaty supplementing the Paris Convention as far as patents are concerned (patent law treaty).
<i>Invitations:</i> States members of the Paris Union and, as observers, States members of WIPO not members of the Paris Union and certain organizations. |
| November 7 to 9 (Geneva) | Preparatory Meeting for the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as Far as Patents Are Concerned (Second Part)

The Meeting will complete the preparation of the organization of the diplomatic conference (June 1991).
<i>Invitations:</i> States members of the Paris Union, EPO and OAPI. |
| November 26 to 30 (Geneva) | Working Group on the Application of the Madrid Protocol of 1989 (Second Session)

The working group will continue to study Regulations for the implementation of the Madrid Protocol of 1989.
<i>Invitations:</i> States members of the Madrid Union, States having signed or acceded to the Protocol, the European Communities and, as observers, other States members of the Paris Union expressing their interest in participating in the Working Group in such capacity and certain non-governmental organizations. |
| December 10 to 14 (Geneva) | PCT Committee for Administrative and Legal Matters (Fourth Session)

The Committee will continue the work started during its third session (July 2 to 6 and September 17 to 21, 1990).
<i>Invitations:</i> States members of the PCT Union and, as observers, States members of the Paris Union not members of the PCT Union and certain organizations. |

1991**January 28 to 30 (Geneva)****Information Meeting(s) on the Revision of the Paris Convention**

An information meeting of developing countries members of the Paris Union and China and, if it is so desired, information meetings of any other group of countries members of the Paris Union will take place for an exchange of views on the new proposals which will have been prepared by the Director General of WIPO for amending the articles of the Paris Convention for the Protection of Industrial Property which are under consideration for revision.

Invitations: See the preceding paragraph.

January 31 and February 1 (Geneva)**Assembly of the Paris Union (Fifteenth Session)**

The Assembly will fix the further procedural steps concerning the revision of the Paris Convention and will take cognizance of the aforementioned proposals of the Director General of WIPO. It will also decide the composition of a preparatory meeting which will take place in the first half of 1991.

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

June 3 to 28 (The Hague)**Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as Far as Patents Are Concerned**

This diplomatic conference will negotiate and adopt a treaty supplementing the Paris Convention as far as patents are concerned (patent law treaty).

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

September 23 to October 2 (Geneva)**Governing Bodies of WIPO and the Unions Administered by WIPO (Twenty-Second Series of Meetings)**

All the Governing Bodies of WIPO and the Unions administered by WIPO meet in ordinary sessions every two years in odd-numbered years. In the sessions in 1991, the Governing Bodies will, *inter alia*, review and evaluate activities undertaken since July 1990, and consider and adopt the draft program and budget for the 1992-93 biennium.

Invitations: States members of WIPO or the Unions and, as observers, other States members of the United Nations and certain organizations.

**November 18 to December 6
(dates and place to be confirmed)****Diplomatic Conference on the Revision of the Paris Convention for the Protection of Industrial Property (Fifth Session)**

The Diplomatic Conference is to negotiate and adopt a new Act of the Paris Convention.

Invitations: States members of the Paris Union and, without the right to vote, States members of WIPO or the United Nations not members of the Paris Union as well as, as observers, certain organizations.

UPOV Meetings

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

1990**October 10 and 11 (Geneva)****Fifth Meeting with International Organizations**

The meeting is to enable international non-governmental organizations to express views on questions concerning the revision of the UPOV Convention.

Invitations: Member States of UPOV and certain international non-governmental organizations.

October 12, 15 and 16 (Geneva)**Administrative and Legal Committee (Twenty-Eighth Session)**

The Committee will continue the preparations for the Diplomatic Conference for the Revision of the UPOV Convention.

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

October 17 (Geneva)**Consultative Committee (Forty-Second Session)**

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

Invitations: Member States of UPOV.

October 18 and 19 (Geneva)

Council (Twenty-Fourth Ordinary Session)

The Council will examine the reports on the activities of UPOV in 1989 and the first part of 1990 and approve documents for the Diplomatic Conference for the Revision of the UPOV Convention.

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

1991

March 4 to 19
(dates and place to be confirmed)

Diplomatic Conference for the Revision of the UPOV Convention

Invitations: Member States of UPOV and, without the right to vote, States members of the United Nations not members of UPOV as well as, as observers, certain organizations.

Other Meetings Concerned with Industrial Property

1990

September 30 to October 5 (Barcelona)

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

1991

September 15 to 20 (Lucerne)

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

September 30 to October 4 (Harrogate)

International Federation of Industrial Property Attorneys (FICPI): Congress

