

Industrial Property

Published monthly
Annual subscription:
Sw.fr. 140.-
Each monthly issue:
Sw.fr. 14.-

24th Year - No. 6
June 1985

Monthly Review of the
World Intellectual Property Organization

Contents

NOTIFICATIONS	
Madrid Agreement (Marks). Accession: Bulgaria	190
Vienna Agreement (Classification of Figurative Elements of Marks)	
I. Accession: Tunisia	190
II. Entry into Force	190
WIPO MEETINGS	
Madrid Union (Marks). Assembly and Committee of Directors	191
PLANT VARIETIES	
The International Union for the Protection of New Varieties of Plants (UPOV) in 1984	192
SPECIAL STUDIES	
The Patent Cooperation Treaty (PCT): Using it More Through Knowing it Better	195
European Patents via the Euro-PCT Route (L. Gruszow)	196
The PCT Route from the Point of View of a German Applicant (R. Raue)	209
Accessing the United States via PCT (W.S. Thompson)	214
The Present Situation of the PCT System in Japan and its Prospects for the Future (M. Tsuji) .	218
CALENDAR OF MEETINGS	229

INDUSTRIAL PROPERTY LAWS AND TREATIES

Editor's Note

BELGIUM

Patent Law (of March 28, 1984)

Text 2-004

© WIPO 1985

Any reproduction of official notes or reports, articles and translations of laws or agreements published in this review is authorized only with the prior consent of WIPO.

ISSN 0019-8625

Notifications

Madrid Agreement (Marks)

Accession

BULGARIA

The Government of Bulgaria deposited, on April 25, 1985, its instrument of accession to the Madrid Agreement Concerning the International Registration of Marks of April 14, 1891, revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Nice on June 15, 1957, and at Stockholm on July 14, 1967.

The said instrument of accession contains the following declarations:

"1. Pursuant to Article 3*bis*(1) of the said Agreement (Stockholm Act), the People's Republic of Bulgaria declares that the protection resulting from the international registration shall extend to the People's Republic of Bulgaria only at the express request of the proprietor of the mark.

"2. Protection will be accorded in the People's Republic of Bulgaria after a compulsory examination of marks by the industrial property institution responsible for patents for invention.

"3. The People's Republic of Bulgaria considers that the provisions of Article 14(1) of the Madrid Agreement are incompatible with the Declaration of the General Assembly of the United Nations on the granting of independence to colonial countries and peoples, adopted by resolution 1514(XV) of December 14, 1960, which proclaims the necessity of bringing to a speedy and unconditional end colonialism in all its forms and manifestations." (Translation)

Bulgaria has not heretofore been a member of the Union for the International Registration of Marks ("Madrid Union"), founded by the Madrid Agreement.

The Madrid Agreement, as revised, will enter into force, with respect to Bulgaria, on August 1, 1985. On that date, Bulgaria will become a member of the Madrid Union.

Madrid (Marks) Notification No. 36, of May 1, 1985.

Vienna Agreement (Classification of Figurative Elements of Marks)

I. Accession

TUNISIA

The Government of Tunisia deposited, on May 9, 1985, its instrument of accession to the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks, done at Vienna on June 12, 1973.

The date of entry into force of the said Vienna Agreement is the subject of a separate notification (Vienna (Classification) Notification No. 7, below).

Vienna (Classification) Notification No. 6, of May 21, 1985.

II. Entry into Force

The Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks, done at Vienna on June 12, 1973, will enter into force on

August 9, 1985,

that is, three months after the deposit by five States of their instruments of ratification or accession.

In this connection, it is recalled that instruments of ratification of the Vienna Agreement were deposited:

- on June 11, 1975, by France;
- on December 23, 1976, by the Netherlands;
- on June 5, 1980, by Sweden;
- on September 16, 1983, by Luxembourg;

and that an instrument of accession to the said Agreement was deposited, on May 9, 1985, by Tunisia.

Consequently, in accordance with the provisions of Article 13(1) of the Vienna Agreement, the said Agreement will enter into force on August 9, 1985, with respect to the five States referred to above.

Vienna (Classification) Notification No. 7, of May 21, 1985.

WIPO Meetings

Madrid Union (Marks)

Assembly and Committee of Directors

Fourteenth Session (9th Extraordinary)
(Geneva, March 25, 1985)

NOTE*

The Assembly and the Committee of Directors of the Madrid Union for the International Registration of Marks (hereinafter referred to as "the Assembly and the Committee of Directors") met in extraordinary session in Geneva on March 25, 1985.¹ The list of participants follows this Note.

Two items were on the agenda: the computerization of data concerning marks registered in the past in the International Register; and the provision of the data published in the review *Les Marques internationales* on a machine-readable medium.

In respect of the first item, the Assembly and the Committee of Directors decided that:

- (a) the International Bureau would, by its own means, progressively enter into computer memory all published and unpublished data relating to international registrations that were the subject of a renewal or a change as each applicant requested the renewal or the recording of the change;
- (b) the International Bureau would report on the implementation of the operation described under (a), above, at the ordinary session of the Assembly and the Committee of Directors in 1987 or, if the experience gained by that time seemed insufficient, not later than at an extraordinary session of the Assembly and Committee of Directors in 1988;
- (c) at the session to which the International Bureau would submit its report, the Assembly and the Committee of Directors would decide whether the operation described under (a) should continue, or whether, within a period of about 12 months, data concerning all marks in force and not yet entered on that date should be entered at once; if the latter solution were to be adopted, the International Bureau would propose that the

carrying out of the data entry operation be put to tender in the member States of the Madrid Union.

With regard to the second item—the provision, for national offices, of the data published in the review *Les Marques internationales* on a machine-readable medium—the Assembly and the Committee of Directors decided that the matter would be included in the agenda of their ordinary session from September 23 to October 1, 1985, and invited the Director General to draw up a detailed report on all the technical, financial and legal aspects of the question, which would serve as a basis for discussion.

LIST OF PARTICIPANTS*

I. Member States

Algeria: D. Hadj-Sadok. Austria: O. Leberl. Belgium: L. Wuyts. Czechoslovakia: J. Prošek. Democratic People's Republic of Korea: Chang Si Zik; Kwon Ho Jun. France: I. Savignon. German Democratic Republic: K.-D. Peters. Germany (Federal Republic of): E. Merz; E. Schneider. Hungary: G. Pusztai. Italy: S. Paparo. Morocco: H. Abbar. Netherlands: H.R. Furstner. Romania: I. Marinescu. Soviet Union: L.E. Komarov; A. Grigoryev; I. Vedernikova. Spain: J.M. Angulo Rivas. Switzerland: R. Kämpf; J. Weber. Viet Nam: Nguyen Duc Than; Vu Huy Tan. Yugoslavia: M. Jovanovic.

Madrid Union Committee of Directors

Portugal: R.A. Costa de Moraes Serrão. Tunisia: A. Ben Gaïd; A. Koubaa.

II. Observers

Benelux Trademarks Office (BBM): P. Rome; J. Prohn.

III. Officers

Chairman: O. Leberl (Austria). Secretary: P. Mangué (WIPO).

IV. International Bureau of WIPO

A. Bogsch (Director General); L.E. Kostikov (Deputy Director General); P. Mangué (Head, Trademark and Industrial Designs Registration Division); D. Bouchez (Head, Computerization Section); E. Rezounenko (Head, Trademark and Appellations of Origin Registration Section, Trademark and Industrial Designs Registration Division).

* Prepared by the International Bureau.

¹ For a Note on the preceding session, see *Industrial Property*, 1984, p. 115.

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

Plant Varieties

The International Union for the Protection of New Varieties of Plants (UPOV) in 1984

State of the Union

In 1984, Israel and the Netherlands became bound by the Revised Act of October 23, 1978, of the International Convention for the Protection of New Varieties of Plants. There are now 13 States bound by the said 1978 Act.

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

The four member States which are not yet bound by the 1978 Act are Belgium, Germany (Federal Republic of), Italy and Spain.

Sessions

During 1984, the various bodies of UPOV met as described below. Unless otherwise specified, the sessions took place in Geneva.

The *Council* held its eighteenth ordinary session from October 17 to 19, 1984. The session was attended by the representatives of the member States and by observers from four non-member States, namely, Austria, Norway, Peru and Poland. The Food and Agriculture Organization of the United Nations (FAO) and the Commission of the European Communities (CEC) were also represented by observers.

One day of the session was devoted, for the fifth year running, to a symposium. It was attended by some 130 participants, representing governments, intergovernmental organizations and international non-governmental organizations. Its subject was "Industrial Patents and Plant Breeders' Rights—Their Proper Fields and Possibilities for Their Demarcation." The titles of the lectures given were "The Nature of Patents of Invention and Their Application in the Case of Living Matter," "The Nature of Plant Breeders' Rights (Plant Variety Protection Law) and Their Demarcation from Patentable Inventions," "Developments in Biotechnology—Dream or Reality" and "The Legal Protection of Achievements of Biotechnology as Seen by a Japanese Lawyer." Records of the proceedings of

the Symposium are reproduced in a special UPOV publication (No. 342), in English, French, German and Spanish.

The *Council*, at its eighteenth ordinary session, (i) approved the report of the Secretary-General on the activities of the Union in 1983 and the first nine months of 1984, the report on his management and the financial situation of the Union in 1983, and the accounts of the Union for 1983, (ii) decided that, from 1986, the Union would have biennial (instead of annual) budgets and would have medium-term plans covering four years, (iii) established the program and budget of the Union for 1985, (iv) approved the reports on the progress made by the various committees and technical working parties of the Council, including their plans for future work, (v) approved the establishment of a Biotechnology Subgroup under the Administrative and Legal Committee to examine the implications of developments in biotechnology for the production and legal protection of new varieties of plants, (vi) adopted three UPOV models and the recommendations on variety denominations.

The *Consultative Committee* held its twenty-ninth session on April 6, 1984, and its thirtieth session on October 16 and 19, 1984. The first was devoted mainly to an exchange of views on the "International Undertaking on Plant Genetic Resources" adopted by FAO in November 1983, and on the arrangements made for the celebration in Paris, in 1986, of the twenty-fifth anniversary of the signing of the UPOV Convention. The second was devoted mainly to the preparation of the eighteenth ordinary session of the Council.

The *Administrative and Legal Committee*, the body in which questions of the practical application of the UPOV Convention and future developments of an administrative or legal nature are discussed, held its thirteenth session on April 4 and 5, 1984, and its fourteenth session on November 8 and 9, 1984.

In both sessions, the Committee noted the latest developments regarding amendments to national plant variety protection legislation either introduced or planned by member States, particularly in relation to ratification of or accession to the 1978 Act of the UPOV Convention.

Furthermore, the Committee examined the results of the first Meeting with International Organizations, held in November 1983, at which a number of intergovernmental and international non-governmental organiza-

tions gave their views on (i) minimum distances between varieties, (ii) international cooperation and (iii) UPOV recommendations on variety denominations.

As far as the question of *minimum distances between varieties* is concerned, the Committee, on the basis of discussions in the Technical Committee, concluded that decisions regarding the extent of the difference that had to exist between a new variety and any other variety if the new variety was to qualify for a grant of plant variety protection could only be taken on a species-by-species basis.

As far as *international cooperation* between the plant variety protection offices in the examination of varieties is concerned, the Committee was of the opinion that the current practice of concluding bilateral agreements for such cooperation on the basis of a UPOV model agreement was the only realistic solution. It noted that the replacement of the network of bilateral agreements by a multilateral agreement would be difficult under the present circumstances. It felt, however, that the introduction of a system for the centralized filing of applications should be envisaged as soon as possible. Furthermore, the Committee recommended certain amendments to the UPOV models for two application forms and to the UPOV Model Agreement (now called "Administrative" Agreement) for International Cooperation in the Testing of Varieties. (The new versions of these models were subsequently adopted by the Council at its eighteenth ordinary session.) The main innovation included in the new Model Administrative Agreement is that the authority of a Contracting State will in general now take over the results of an examination performed by the authority of another Contracting State even if both authorities have suitable testing facilities of their own for the species in question.

As far as the question of *variety denominations* is concerned, the Committee examined the request made by certain international organizations that the application of the 1973 Guidelines for Variety Denominations, which were in some respects outdated, should be discontinued, without their being replaced by an updated legal instrument of a similar character. The Committee could not share the view of those organizations and underlined once more the need for appropriate guidance for the uniform interpretation and application of the provisions of Article 13 of the UPOV Convention, which would be of assistance not only to the authorities of member States in their task of deciding on the suitability of variety denominations but also to breeders having to select and propose denominations for their varieties. It therefore suggested that the 1973 Guidelines for Variety Denominations should be replaced by recommendations (rather than guidelines) which should, however, take into account as far as possible the suggestions made by the international organizations. (Subsequently, the Council, at its eighteenth ordinary session, adopted the UPOV Recommendations on Variety Denominations.)

The Committee noted that pilot projects for the centralized examination of proposed variety denominations have been started. The projects are being carried out by the Plant Varieties Office of the Federal Republic of Germany, in Hanover, for *Elatior Begonia* and by the Plant Variety Rights Office of the United Kingdom, in Cambridge, for *Chrysanthemum*. Once the projects are operational, each of those Offices will make a complete examination for the other participating offices of the acceptability of variety denominations filed with those offices.

The Committee gave detailed consideration to the possibilities for harmonizing the lists of species of which varieties are eligible for protection in the various member States of the Union. It eventually decided to continue studying that question in 1985, with a view to developing a suitable recommendation for adoption by the Council.

Finally, the Committee decided on the composition of the Biotechnology Subgroup set up by the Council. The task of the Subgroup will be to make a comparative study of plant variety protection and patent systems in Europe, Japan and the United States of America. Once that study is completed, the Subgroup will consider the possibility of developing suitable recommendations regarding the most appropriate form of protection for the results of biotechnological developments relating to plant varieties. The Subgroup held its first session on November 9, 1984, and decided on the organization of its rather complex work.

The *Technical Committee*, the body in which questions of the practical application of the UPOV Convention and future developments of a technical nature are discussed, held its twentieth session on November 6 and 7, 1984, in which it adopted, on the basis of preparatory work carried out by the Technical Working Parties, 10 new or revised Test Guidelines, namely, for Broad Bean and Field Bean, for Cocksfoot, for Crown of Thorns, for Curly Kale, for Freesia, for Meadow Fescue and Tall Fescue, for Persimmon, for Strawberry, for Swede, for Timothy.

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

The five Technical Working Parties all met once: the *Technical Working Party on Automation and Computer Programs* in La Minière (France) from May 15 to 17, 1984; the *Technical Working Party for Vegetables* in Bet Dagan (Israel) from June 11 to 15, 1984; the *Technical Working Party for Agricultural Crops* in Lund (Sweden) from June 27 to 29, 1984; the *Technical Working Party for Ornamental Plants and Forest Trees* in Hanover (Federal Republic of Germany) from August 7 to 9, 1984; and the *Technical Working Party for Fruit Crops* in Valencia (Spain) from October 9 to 11, 1984.

Contacts with States and Organizations

As in previous years, UPOV had numerous contacts in 1984 with representatives of States—in particular of non-member States showing an interest in the work of the Union and in the possibilities of their becoming members—and with various intergovernmental and international non-governmental organizations. Many of the contacts were related to the important question of the legal protection of the results of biotechnological research. In particular, UPOV was represented at a meeting of governmental experts concerning biotechnology, convened by the Commission of the European Communities (Brussels, October 1984), at the first session of the WIPO Committee of Experts on Biotechnological Inventions and Industrial Property (Geneva, November 1984) and at a seminar on "Patent and/or Plant Variety Protection for Plant Varieties Developed by Genetic Engineering," organized by the Max Planck Institute for Foreign and International Patent, Copyright and Competition Law (Munich, December 1984).

Publications

In 1984, the Office of the Union published four issues of *Plant Variety Protection—Gazette and Newsletter of the International Union for the Protection of New Varieties of Plants*; the *Records of the 1983 Symposium on "Nomenclature,"* in English, French, German and Spanish (UPOV publications 341 (E), (F), (G) and (S), respectively); 10 *Guidelines for the Conduct of Tests for Distinctness, Homogeneity and Stability*; and regular supplements to the *Collection of the Texts of the UPOV Convention and Other Important Documents Established by UPOV* (UPOV publications 644 (E), (F) and (G), respectively), including, in particular, the following revised models: (i) *Model Administrative Agreement for International Cooperation in the Testing of Varieties*; (ii) *UPOV Model Form for an Application for Plant Breeders' Rights*; (iii) *UPOV Model Form for an Application for a Variety Denomination*; and the *UPOV Recommendations on Variety Denominations* (UPOV publication INF/10).

Special Studies

The Patent Cooperation Treaty (PCT): Using it More Through Knowing it Better

Studies by L. Gruszow, R. Raue, W.S. Thompson
and M. Tsuji

INTRODUCTION

The Patent Cooperation Treaty (PCT), which was signed in Washington on June 19, 1970, and entered into force on January 24, 1978, became operational on June 1, 1978; that date was also the one on which the first international application was filed. In the ensuing seven years, almost 30,000 filings have been made under the PCT, which at present comprises 39 Contracting States.

In the course of this initial period, confrontation with practical experience revealed a need to make amendments to the Treaty and above all to the Regulations under it. With the adoption in February 1984 of the latest changes, and the entry into force of most of them on January 1, 1985,¹ this phase of internal consolidation is now complete.

There still is progress to be made, however. More countries are expected to join the PCT Union, which will make it possible to broaden further the geographical scope of the Treaty. That scope is already quite considerable if one considers that, out of every 10 patent applications filed throughout the world, about nine are filed in PCT Contracting States. Another, perhaps more important, objective is the withdrawal of the reservations made by certain member States: while the United States of America is at present actively preparing to withdraw the reservation that it made regarding Chapter II of the PCT, on international preliminary examination, and while the other States still bound by comparable reservations may be expected to follow suit,² it is still necessary that two further reservations, which are significant for their adverse effect on the attractiveness of the PCT, be withdrawn, namely, that made by Japan under Article 64(2) and that made by the United States of America under Article 64(4). It is of course premature to say whether and, if so, when those reservations will in fact be withdrawn, but they are events earnestly hoped for.

We should not, however, ignore the efforts that have been made by member States to improve their national legislation to the advantage of the PCT: the United States of America and Japan, to mention those two countries once again, have both recently adopted amendments to their domestic legislation that will benefit PCT users, and similar action has been taken or is at present being taken in other Contracting States.

The time has come for applicants to take a new look at the possibilities offered by the PCT. It has come for a number of reasons: as

¹ See *Industrial Property*, 1984, p. 115, and 1985, p. 145.

² Those States are Denmark, Liechtenstein, Norway, the Republic of Korea and Switzerland.

mentioned above, the PCT system has just undergone amendments that significantly improve its operation and increase its advantages. Moreover, the recent entry of Italy into the PCT Union marks the complete, factual realization of the harmony that already existed between the text of the PCT and that of the European Patent Convention: the combination of the two systems, which has been possible from the outset, is more attractive than ever, as *L. Gruszow* shows in her study on the "Euro-PCT route." And yet it would be wrong to think that the PCT's appeal is only now beginning: in economic terms, its advantages have already attracted important applicants, and others should follow in the future. *R. Raue's* study provides some very interesting material with which to evaluate this prospect. Also, *M. Tsuji* shows convincingly that in Japan the PCT should be used much more than it has been up to now—and his wide personal experience with the PCT leaves little doubt as to the accuracy of his views, which may to a large extent be applied also to other countries. Finally, *W.S. Thompson* makes a welcome contribution for the benefit of persons wishing to use the PCT to secure patents in the United States of America: the invaluable advice that he gives will make it possible to derive the greatest possible advantage from the present status of the PCT in his country.

In publishing these four studies, the International Bureau of WIPO wishes to give the reader the opportunity to acquire a more thorough knowledge of the PCT, and thereby to make him an enthusiastic user of it. In this way the PCT will be able to continue developing towards the eventual realization of the considerable, yet still largely unexploited potential that it offers to all those who wish to secure worldwide protection for their inventions.

European Patents via the Euro-PCT Route

L. GRUSZOW*

**The PCT Route from the Point of View
of a German Applicant**

R. RAUE*

Accessing the United States via PCT

W.S. THOMPSON*

**The Present Situation of the PCT System
in Japan and its Prospects
for the Future**

M. TSUJI*

Calendar of Meetings

WIPO Meetings

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

1985

- July 8 to 12 (Geneva) — Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions
- September 11 to 13 (Geneva) — Permanent Committee on Patent Information (PCPI); Working Group on Patent Information for Developing Countries
- September 16 to 20 (Geneva) — Permanent Committee on Patent Information (PCPI) and PCT Committee for Technical Cooperation (PCT/CTC)
- September 23 to October 1 (Geneva) — Governing Bodies (WIPO General Assembly, Conference and Coordination Committee; Assemblies of the Paris, Madrid, Hague, Nice, Lisbon, Locarno, IPC, PCT, Budapest, TRT and Berne Unions; Conferences of Representatives of the Paris, Hague, Nice and Berne Unions; Executive Committees of the Paris and Berne Unions; Committee of Directors of the Madrid Union; Council of the Lisbon Union)
- October 7 to 11 (Geneva) — Permanent Committee on Patent Information (PCPI); Working Group on General Information
- October 21 to 25 (Geneva) — Nice Union: Committee of Experts
- November 4 to 30 (Plovdiv) — WIPO/Bulgaria: World Exhibition of Young Inventors and International Seminar on Inventiveness for Development Purposes (November 12 to 15)
- November 18 to 22 (Geneva) — Permanent Committee on Patent Information (PCPI); Working Groups on Special Questions and on Planning
- November 25 to 29 (Paris) — Committee of Governmental Experts on Model Provisions for National Laws on Publishing Contracts for Literary Works (convened jointly with Unesco)
- November 25 to December 6 (Geneva) — Permanent Committee on Patent Information (PCPI); Working Group on Search Information
- November 26 to 29 (Geneva) — Committee of Experts on Intellectual Property in Respect of Integrated Circuits
- December 3 to 6 (Geneva) — Permanent Committee for Development Cooperation Related to Industrial Property
- December 11 to 13 (Geneva) — Committee of Experts on the International Registration of Marks

UPOV Meetings

1985

- July 8 to 12 (Cambridge) — Technical Working Party for Vegetables, and Subgroup
- October 14 (Geneva) — Consultative Committee
- October 15 and 16 (Geneva) — Meeting with International Organizations
- October 17 and 18 (Geneva) — Council
- November 12 and 13 (Geneva) — Technical Committee
- November 14 and 15 (Geneva) — Administrative and Legal Committee

Other Meetings Concerned with Industrial Property

1985

- September 2 to 6 (Budapest) — Hungarian Group of the International Association for the Protection of Industrial Property and the Hungarian Association for the Protection of Industrial Property: Sixth International Conference on "New Technical Tendencies and Industrial Property Protection"
- September 16 to 18 (Geneva) — International Association for the Advancement of Teaching and Research in Intellectual Property: Assembly and Annual Meeting
- September 24 to 27 (Strasbourg) — Center for the International Study of Industrial Property: Seminar on Transfer of Technology (second module: Strategy and Procedures for the Transfer of Technology)

September 27 and 28 (Wiesbaden) — International League for Competition Law (formerly International League Against Unfair Competition): *Journée d'études*

October 10 and 11 (Harrogate) — Pharmaceutical Trade Marks Group: 31st Conference on "Generic Prescribing— 12 Diverse but Authoritative and Informed Viewpoints"

1986

June 1 to 4 (San Diego) — The United States Trademark Association: Annual Meeting

June 8 to 13 (London) — International Association for the Protection of Industrial Property: XXXIII Congress

