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Contents

| | |
|--|------------|
| NOTIFICATIONS | |
| WIPO Convention. Accession: Sierra Leone | 91 |
| Madrid Agreement (Marks). Corrigendum: Mongolia | 91 |
| Nairobi Treaty. Accessions: Barbados, San Marino, Oman | 91 |
| ACTIVITIES OF THE INTERNATIONAL BUREAU | |
| Detailed Outline of a Proposed New Treaty on the International Registration of Trademarks (Memorandum by the Director General of WIPO) | 92 |
| WIPO MEETINGS | |
| WIPO/Chinese Patent Office. Advanced Patent Course | 110 |
| Paris Union. Committee of Experts on Intellectual Property in Respect of Integrated Circuits | 110 |
| International Patent Classification (IPC) Union. Committee of Experts | 112 |
| WIPO Permanent Committee on Patent Information (PCPI). Working Group on Search Information | 113 |
| GENERAL STUDIES | |
| The Semiconductor Chip Protection Act of 1984: Statutory Framework; Copyright Office Regulations; and Effect on International Protection of Chip Designs (R.S. Laurie) | 115 |
| The 1984 Law Amending the Austrian Patent Law (O. Leberl and N. Marterer) | 126 |
| NEWS FROM INDUSTRIAL PROPERTY OFFICES | |
| Gambia, Mongolia, Saudi Arabia | 134 |
| CALENDAR OF MEETINGS | 135 |
| INDUSTRIAL PROPERTY LAWS AND TREATIES | |
| Editor's Note | |
| AUSTRIA | |
| Patent Law (Federal Law of 1970, as last amended by the Law of May 23, 1984, amending the Patent Law and the Law Introducing Patent Treaties) (second segment) | Text 2-001 |

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Notifications

WIPO Convention

Accession

SIERRA LEONE

The Government of Sierra Leone deposited, on February 18, 1986, its instrument of accession to the Convention Establishing the World Intellectual Property Organization, signed at Stockholm on July 14, 1986.

Sierra Leone will belong to Class C for the purpose of establishing its contribution towards the budget of the WIPO Conference.

The said Convention will enter into force, with respect to Sierra Leone, on May 18, 1986.

WIPO Notification No. 134, of February 18, 1986.

Madrid Agreement (Marks)

Corrigendum

MONGOLIA

The following paragraph is inserted between the third and fourth paragraphs of Madrid (Marks) Notification No. 35, of January 21, 1985:*

The said instrument of accession contains a declaration by the Government of Mongolia that "it avails itself of the right provided for in Article 3bis, according to which the protection resulting from the international registration shall extend to its country only at the express request of the proprietor of the mark." (Translation)

Madrid (Marks) Notification No. 35 (Corrigendum), of February 21, 1986.

Nairobi Treaty

Accessions

BARBADOS

The Government of Barbados deposited, on January 30, 1986, its instrument of accession to the Nairobi Treaty on the Protection of the Olympic Symbol, adopted at Nairobi on September 26, 1981.

The said Treaty will enter into force, with respect to Barbados, on February 28, 1986.

Nairobi Notification No. 33, of February 3, 1986.

SAN MARINO

The Government of San Marino deposited, on February 18, 1986, its instrument of accession to the Nairobi Treaty.

The said Treaty will enter into force, with respect to San Marino, on March 18, 1986.

Nairobi Notification No. 34, of February 18, 1986.

OMAN

The Government of Oman deposited, on February 26, 1986, its instrument of accession to the Nairobi Treaty.

The said Treaty will enter into force with respect to Oman, on March 26, 1986.

Nairobi Notification No. 35, of February 26, 1986.

* Published in *Industrial Property*, February 1985, p. 46.

Activities of the International Bureau

Detailed Outline of a Proposed New Treaty on the International Registration of Trademarks*

Memorandum by the Director General of WIPO

CONTENTS

| | <i>Paragraph</i> |
|---|------------------|
| PART I: THE PRESENT MEMORANDUM | 1 |
| PART II: DESIRABILITY OF A NEW TREATY | 6 |
| PART III: CONTENTS OF A NEW TREATY | 18 |
| <i>1. Application and Registration</i> | |
| A. Meaning of "International Registration" and "International Application" | 22 |
| B. Particulars of the International Application | 24 |
| C. Entitlement to File International Applications and to Own International Registrations | 31 |
| D. Direct or Indirect Filing? | 33 |
| E. Should an International Application Be Required to Be Based on a National (or Regional) Appli- cation? | 36 |
| F. Effects of International Registration | 40 |
| G. No "Central Attack" | 47 |
| H. No Provision on the Use of the Trademark | 50 |
| I. Switchover from National or Madrid Registrations to International Registrations under the New Treaty | 55 |
| J. Co-existence of the New Treaty and the Madrid Agreement | 58 |
| <i>2. Renewal of and Changes in the Registration</i> | |
| K. Later Designations | 63 |
| L. Renewal | 69 |
| M. Changes in the Ownership of the International Registration | 75 |
| N. Change in the Name of the Owner of the Interna- tional Registration | 82 |
| O. Limitation of the List of Goods and Services | 86 |
| P. Switchover from an International Registration to National Registration | 90 |
| Q. Recordings Effected by National or Regional Offices | 92 |
| R. "Cancellation" | 97 |
| <i>3. General Matters</i> | |
| S. Languages | 102 |
| T. Representation | 109 |
| U. Fees | 115 |
| V. Notifications | 131 |
| W. Publication and Notifications by the International Bureau | 134 |
| X. Regulations and other Administrative Matters | 138 |

* This document was submitted to the second session of the Committee of Experts on the International Registration of Marks, which met in Geneva from December 11 to 13, 1985. A note on that session was published in *Industrial Property*, February 1986, p. 56.

| | |
|--|-----|
| PART IV: ADVANTAGES OF THE NEW TREATY | 143 |
| A. The Proposed International System is Cheaper | 145 |
| B. The Proposed International System is Simpler, and, Therefore, More Secure | 154 |
| C. The Proposed International System Facilitates Decisions Whether to Do Business in a Given Country | 156 |
| PART V: ALLEGED DANGERS OF ANY INTERNATIONAL TRADEMARK REGISTRATION SYSTEM | 159 |
| A. "Any International System Makes it More Difficult to Find New Trademarks" | 163 |
| B. "Any International System Increases the Work Load of National Trademark Offices" | 169 |
| C. "Trademark Agents Will Earn Less" | 175 |

Annexes

- Annex I: Terms of Protection and Fees in Selected Countries
- Annex II: Sample Page of the Official Gazette (*Les Marques internationales*) Published by the International Bureau of WIPO under the Madrid Agreement [not reproduced here]

Part I The Present Memorandum

1. The present memorandum (i) continues to advocate the conclusion of a new multilateral treaty of worldwide scope for the international registration of trademarks and (ii) contains the detailed outline or description of the possible main substantive provisions of such a treaty.

2. For the moment, the expression "*New Treaty*" is used. The title or name of the treaty should be decided later. One possibility would be to call it "Trademark Cooperation Treaty." Such a denomination would be similar to the name of the (successful) "Patent Cooperation Treaty" and would avoid the use of the term "registration."

3. Also, for the moment, the expression "international *registration*" is used. Some persons have expressed the view that "registration" was inappropriate since the effect of an international registration is not always quite the same as the word "registration" means in most national trademark laws. International "recordal" would be an alternative (although, in French, it would probably have to become "*enregistrement*" which, in English, can be translated by "registration"). This terminological question, just as that of the title of the New Treaty, should, it is proposed, be discussed later.

4. Furthermore, for the moment, the expression "*trademarks*" is used, and it is used in the sense of meaning, always, both trademarks and service

marks. Should the expression "trademark" be retained, the New Treaty should contain a definition making it clear that "trademark" means also service mark. Another solution would be to use the expression "mark" and define it as comprising both trademark and service mark. It is proposed to deal with this terminological question at a later stage.

5. By "*worldwide*" scope, what is meant is that the treaty should be open for accession to any country party to the Paris Convention for the Protection of Industrial Property (hereinafter referred to as the "the Paris Convention"). The Paris Convention is open to any country of the world and, thus, is worldwide in scope. Making only those countries of the world eligible for becoming party to the New Treaty has the advantage that, as far as substantive rights of protection are concerned, the countries party to the New Treaty would necessarily guarantee the existence of certain such rights, namely, those which are provided for, as minimum rights, in the Paris Convention.

Part II Desirability of a New Treaty

6. The New Treaty would be new as opposed to the existing or "old" treaties of worldwide scope, namely, the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as "the Madrid Agreement") and the Trademark Registration Treaty.

7. The Madrid Agreement has been in existence for 94 years and has been accepted by 28 of the Paris Union's 97 member States. The countries party to the Madrid Agreement are: Algeria, Austria, Belgium, Bulgaria, Czechoslovakia, Democratic People's Republic of Korea, Egypt, France, German Democratic Republic, Germany (Federal Republic of), Hungary, Italy, Liechtenstein, Luxembourg, Monaco, Mongolia, Morocco, Netherlands, Portugal, Romania, San Marino, Soviet Union, Spain, Sudan, Switzerland, Tunisia, Viet Nam, Yugoslavia. As one can see from this list, among the countries absent are the United States of America, Japan, all the Commonwealth countries, all the Nordic countries of Europe and most of the developing countries (particularly those having very high numbers of trademark registrations in Asia and Latin America), including China. It is believed that the low number of the participating countries and the extremely low rate of increase in membership (since its entry into force among five countries in 1892, the Madrid Agreement gained one new adherent every fourth year, which means that if that rate continues—and even if the number of the Paris Union countries (97) does not increase—it will take more than 200 years to have all the (present) countries members of the Paris Union become party to the Madrid Agreement), make it very clear that the Madrid Agreement is not, and is unlikely to become, a multilateral system for the great majority of the countries of the world.

8. Some individuals (not governments) have said that their countries could now be persuaded to accede to the Madrid Agreement. This view does not seem to be very realistic since there is no reason to believe that what has constituted, for 93 years, obstacles to accession should now suddenly disappear.

9. There are several provisions in the Madrid Agreement that are, traditionally, regarded as obstacles to accession to that Agreement: the requirement of previous registration in the country of origin (more difficult and longer to obtain in countries with examination for relative grounds of refusal and/or an opposition procedure, with the risk that it will be obtained only after the expiration of the six-month priority period); the possible risks and inequities of "central attack" (see paragraph 49, below); the relative shortness (12 months) of the time limit for "provisional refusal" (see paragraph 43, below) and the fact that at least some of the national offices receive less fees per trademark if the registration reaches them through the Madrid Agreement than through direct filing for a national trademark registration in the national Trademark Office.

10. The Trademark Registration Treaty came into effect five years ago (in 1980) among the following five

countries: Burkina Faso, Congo, Gabon, the Soviet Union and Togo. No further countries have adhered since. Two trademarks were registered under it during its first year of being in effect. Since then, none. It can be regarded as *de facto* non-existent although, naturally, *de jure* it is in existence. There are no signs, and have been none in the last years, that any country plans to adhere. The reason is, presumably, that the Trademark Registration Treaty—a treaty that was concluded mainly on the initiative of the United States of America and, by most other countries, in the expectation that the United States of America would adhere to it—has not been and probably never will be ratified by that country.

11. Some individuals (not the Government!) in the United States of America have said that the Trademark Registration Treaty may still be ratified by that country. However, there are no signs of such an intent, even less of such an event occurring. The substantive reason for this negative attitude lies probably mainly in the fact that the Trademark Registration Treaty would oblige the United States of America to provide for a moratorium on actual use before registration (see paragraph 51, below), a step that has many strong opponents in the United States of America, the more so as the provision could put foreign trademark owners in an easier position than domestic (i.e., United States) owners, a result resisted on political grounds.

12. One could, of course, propose, at least in theory, that, instead of concluding an entirely new treaty, one should amend the Madrid Agreement or the Trademark Registration Treaty.

13. However, this course is not recommended.

14. It is not recommended because a revision of any existing treaty would have to be decided by, and only by, the countries party to it: in the case of the Madrid Agreement, by the said 28 countries, and, in the case of the Trademark Registration Treaty, by the said five member countries. They would have to decide what amendments are good not only for them but for the *other countries*. This is hardly acceptable from a political point of view. Those countries that are not, but are ready to become, party to any new treaty *must* be among the countries which decide what the new treaty should contain; otherwise, the likelihood that the new treaty will be adhered to by them becomes very thin, to say the least.

15. As far as the Madrid Agreement is concerned, there is also a second reason for not recommending its revision. It is that the governments of, and the private circles in, the countries party to the Madrid Agreement, almost unanimously, very emphatically, and constantly

declare that the Madrid Agreement, as it is today, is fully satisfactory and works "beautifully." So, why spoil it? For them, that is.

16. Besides, anyone who advocates the revision of the Madrid Agreement or the Trademark Registration Treaty, rather than the conclusion of a new treaty, advocates the conclusion of, in fact, a new treaty: a revised treaty is different from the treaty whose revision it is; it must be ratified by a certain number of countries before it goes into existence; it must be ratified by each member country before it binds that country; it creates a regime that is different from the old one. All this is true for a completely new treaty too. The only important difference between a revision and a new treaty consists in the way it is adopted: in the adoption of a new treaty, all interested countries participate on an equal footing, that is, vote in the diplomatic conference adopting it; in the adoption of a revision, no country that is not party to the existing treaty has a say: it is merely offered a text that *other countries* have voted upon and adopted.

17. For these reasons, what is proposed is a new treaty. Any attempt to revise the Madrid Agreement (or, for that matter, the Trademark Registration Treaty) is decidedly and firmly *not* recommended and *not* proposed.

Part III

Contents of the New Treaty

18. The following, detailed outline of the proposed New Treaty is broken down into three chapters.

19. The first chapter, entitled "Application and Registration," deals with the international application and the international registration, including the possible refusal of the effects of the international registration. It not only analyzes what the New Treaty is proposed to contain in these respects but it also mentions a few points that the New Treaty is proposed not to contain, in particular the "dependency on a registration in the country of origin" and the "central attack" features of the Madrid Agreement and the "moratorium on the actual use of the trademark" feature of the Trademark Registration Treaty.

20. The second chapter, entitled "Renewal of and Changes in the Registration," deals with the numerous and important possibilities that an international registration offers to its owners wishing to renew it or wishing to record changes in the registration. Such records would be done "by one stroke" for several countries.

21. The third chapter, entitled "General Matters"—because they are of relevance both before and after the

international registration—deals with the questions of languages, possible representation by agents, fees, notifications and publication.

Chapter I Application and Registration

A. Meaning of "International Registration" and "International Application"

22. It is proposed to call "international registration" the entering of a trademark, with all the relevant particulars, in a register ("the International Register") that would be kept by the International Bureau (that is, the Secretariat) of the World Intellectual Property Organization (WIPO), at its headquarters in Geneva, Switzerland.

23. It is proposed that such registrations be effected on the basis of what is proposed to be called "international applications."

B. Particulars of the International Application

24. It is proposed that an international application contain the usual particulars: a reproduction of the trademark; the list of the goods and/or services for which the registration is applied for (grouped according to the International (Nice) Classification of Goods and Services for the Purposes of the Registration of Marks); the name, the country of the nationality or domicile and the address of the applicant who or which may be a natural person or a legal entity; the name and address of the agent, if the applicant chooses to have one. The furnishing of possible other particulars (for example, claims of color, sound, three dimensions; transliterations and/or translations) would also be regulated.

25. Furthermore, it is proposed that the international application indicate that it is filed under the New Treaty and that it identify the countries party to the New Treaty in which the applicant wishes the international application and registration to have effect. These countries will, hereinafter, be called "designated States." Countries could be designated also later than the filing of the international application (see paragraph 63, below).

26. Any applicant could designate also his own country. This is not possible under the Madrid Agreement.

27. The Trademark Registration Treaty provides also for the possibility of international registration of collective marks. It also provides that the applicant may be an association that is not a legal entity. It is proposed that the New Treaty should not provide for either of those possibilities, since the cases are rare and since the provisions to cover them would inordinately lengthen

and complicate the texts of the New Treaty and the Regulations under it.

28. Any international application could claim the priority of an earlier (national or regional) application, and it could contain a declaration of intent to use or a declaration of actual use for the purposes of designated States where such declarations are necessary or may be useful. The texts of the declarations would be standard. They would be spelled out in the Regulations under the New Treaty.

29. Any international application would be subject to the payment of fees (see paragraphs 115 to 119, below) and would have to be signed.

30. As to languages, see paragraph 102, below.

C. Entitlement to File International Applications and to Own International Registrations

31. It is proposed that to be entitled to file an international application and to (continue to) own an international registration, the applicant (later, the owner of the international registration) be a resident or national of a country party to the New Treaty ("Contracting State"). Both notions would be defined. For example, a legal entity would have to be regarded as a resident of a Contracting State if it has a real and effective commercial establishment in that State; it would not be necessary that that establishment be the legal entity's only, or the main, establishment in the world; it could be one of its establishments, provided it is a commercial establishment which is "real and effective." Where there are several applicants or owners, it would be enough if one of them were eligible.

32. It is believed that nationals or residents of a non-Contracting State be eligible in the following situation and subject to the following condition: when the applicant or owner is a national or resident of a State that is party to a regional trademark registration system (for example, the future (European) Community Trade Mark system), provided that system admits the effect of international registrations made under the New Treaty, an effect that would prevail also in those countries of the regional system that are not party to the New Treaty. For example, let us suppose that the United States of America were party to the New Treaty but (of course) not to the European system and that Ireland were party to the European system but not to the New Treaty: an Irish owner could obtain the effect of a national registration *via* the New Treaty even in the United States of America, and a United States owner could obtain the effect of a European registration *via* the New Treaty also in Ireland.

D. Direct or Indirect Filing?

33. It is proposed that international applications be filable with the International Bureau of WIPO ("direct"

filing) but that any country party to the New Treaty be allowed to allow or require its own nationals or residents to file their international applications with its own national Trademark Office, or with a given regional Trademark Office, which would, then, transmit the international applications to the International Bureau ("indirect filing"). If so *allowed*, an international application could be filed either with the International Bureau or *via* the national or regional Trademark Office; if so *required*, an international application would have to be filed *via* the national or regional Trademark Office.

34. In view of the tradition in the countries party to the Madrid Agreement that applicants must address themselves to their national Offices, the New Treaty could provide that, in those countries, applicants are *required* to file *via* the national Offices. At the same time, the New Treaty could provide for any country party to the Madrid Agreement and the New Treaty to waive such a requirement when it deposits its instrument of ratification of, or accession to, the New Treaty.

35. The date of filing would, in the case of "direct" filing, be the date on which the international application is filed with the International Bureau. In the case of "indirect" filing, the date of filing would be the date of filing with the national or regional Trademark Office.

E. Should International Applications Be Required to Be Based on a National (or Regional) Application?

36. It is proposed that international applications be admitted without the trademark having been first registered in the national trademark register of a country party to the New Treaty or in a regional register, and even without the trademark having first been the object of a national or regional application for registration.

37. The Madrid Agreement allows international applications only in respect of trademarks already registered in the country of origin of the trademark. The time between application and registration in the country of origin may exceed six months from the date of the national (or regional) application, in which case no right of priority may be invoked. It may even last several years, and such a delay would further endanger the possibility of obtaining protection before others ask for the registration of the same trademark. Furthermore, a trademark that is refused in the country of origin may very well be admissible in other countries since grounds of refusal existing in the country of origin (e.g., conflict with an earlier trademark) may very well not exist in other countries (where the body of existing marks may be quite different).

38. Whereas it is strongly recommended not to include in the New Treaty the Madrid Agreement's requirement for a registration in the country of origin, the possible requirement of a home application is conceivable. It seems to be harmless since filing an application is a unilateral act and applications can be filed even in the most unworthy cases. But, at the same time, little, if any, usefulness is seen in such a requirement. It would certainly double the work of the applicant: he would have to file two applications (a national or regional application and the international application) instead of one application (the international application).

39. It should be noted that, later in this memorandum (paragraph 55, below), it is proposed that the owner of a national registration be allowed to switch over to an international registration.

F. Effects of International Registration

40. It is proposed that the New Treaty provide that any trademark that is the subject of an international application and that complies with the requirements concerning eligibility and with the requirements concerning the contents of the international application (including the payment of fees) be internationally registered by the International Bureau of WIPO.

41. In other words, the International Bureau would be allowed to look only at the question whether the formal requirements are fulfilled. There would be an opportunity offered to the applicant to correct any defects (without changing the date of the application to that of the date of the correction if the defect were not a serious one). If, nevertheless, there were a divergence of opinion about whether there is a defect and what its nature is, the International Bureau would notify the international application to each designated State and each of them would decide, for itself, whether the International Bureau erred in assuming that there was a defect. If it finds that that Bureau did err, the international application would, in respect of that State, be treated as if it had been internationally registered.

42. Furthermore, it is proposed that the New Treaty provide that any international registration have the effect in each designated State or regional group of States as if it had been registered in the national or regional register, *provided* that the national or regional Office does not refuse such effect. The refusal would have to be motivated and based on the national law of the country or the regional treaty (which, naturally, must be compatible with the Paris Convention, the more so as, where the international registration is the first registration, it would be regarded, for the purposes of Article 6*quinquies* of the Paris Convention, as the registration in the country of origin). A notice of

possible refusal would have to be issued by the national or regional Office within—say—20 months from the publication of the international registration or, in the case of a later designation, from the publication of the later designation. There would be no time limit for confirming or withdrawing the notice of possible refusal. The notice would have to indicate all the possible grounds for refusal, and the refusal, to be valid, would have to be based on at least one of those grounds. However, when the refusal is made by a court, the refusal would not need to be based on any of the grounds indicated in the notice of possible refusal.

43. The time limit for issuing a notice of possible refusal (called "provisional refusal" in the Madrid Agreement) is 12 months under the Madrid Agreement; it is, in the case of trademarks other than collective marks, 15 months under the Trademark Registration Treaty. It is believed that either period may be found too short by offices with both *ex officio* (*ex parte*) examination and an opposition system. This is why a 20-month period is proposed, although an 18-month period would probably be sufficient, too.

44. The great advantage of a system of notice of possible refusal is that, once the notice is given, the applicant can, with a high degree of probability, predict whether the registration effect will, eventually, be refused and, if no notice is given, the only procedure in which the registration effect can be taken away from him is a court procedure for cancellation.

45. Naturally, any decision of refusal—whatever its grounds—by a national or regional authority could be attacked by the applicant on the same grounds as refusals of national applications are attackable. It is proposed that the New Treaty expressly say so.

46. It is to be noted that, later in this memorandum (see paragraph 55, below), it is proposed that the owner of a national registration be allowed to switch over to an international registration. In that case, the rights acquired under the national registration would continue and the effects of the international registration could not be refused by countries in which the national registrations existed.

G. No "Central Attack"

47. It is proposed that the New Treaty should *not* provide for what is popularly called, in the Madrid registration system, "central attack."

48. Under the Madrid Agreement, if the national registration in the country of origin, basis of the international registration, is cancelled within five

years from the date of the international registration, such registration loses its validity and its effect in each and all of the designated States.

49. "Central attack" is useful when the international application was filed by a person who has obviously no right in any country to the trademark; in such a case, with one stroke (namely, the cancellation of the registration in the country of origin), the lawful owner can get rid of the effect of the international registration in all the designated States. But this sweeping effect of central attack can lead to very unjust results since a ground for refusal or cancellation under the law of the country of origin may very well not be a ground for cancellation in some or all of the designated States. This is the case, for example, when a conflicting, earlier registration exists only in the national trademark register of the country of origin and not in that of each of the designated States.

H. No Provision on the Use of the Trademark

50. It is proposed that the New Treaty should *not* contain any provision concerning the use of the mark. In particular, it should not contain any provision that would require any Contracting State to change its domestic law in respect of the so-called "use requirements."

51. In other words, the New Treaty would leave any country party to it free to provide—within the limits of the Paris Convention—whatever it wishes in its national law concerning the actual use of the mark. The Trademark Registration Treaty provides that no designated State may refuse the national registration effect of an international registration on the grounds that the owner of the registration had not used his mark before the international registration and three years after the date of such registration (so-called "three-year moratorium on the actual use of the mark"). This provision of the Trademark Registration Treaty encountered, and continues to encounter, the disapproval of many United States specialists who do not wish to admit exceptions, particularly not because of a treaty on international registration, to the traditional system of their country according to which a trademark that has not yet been used in commerce should not be eligible for any trademark protection, and, in particular, the fact that such trademark has been registered should not make it eligible for protection.

52. It is hoped that by not including in the New Treaty the provisions of the Trademark Registration Treaty—or provisions similar to those—

on actual use, the New Treaty will satisfy also the said specialists.

53. It is to be noted that silence on this question in the New Treaty would merely mean that the situation in which foreign owners of trademarks find themselves, and will find themselves in the future, in the United States of America in respect of actual use, would not be influenced by the New Treaty. In other words, the present use requirements of the United States law would continue to be applicable unless and until they are changed by statute or court decisions, changes that would be spontaneous in the sense that they would not be a consequence of the United States being—as it is hoped—a party to the New Treaty.

54. As already stated in paragraph 28, above, the New Treaty should, it is believed, provide for the possibility of an applicant or owner of the international registration to file with the International Bureau of WIPO—rather than *separately* with each national or regional Office where that is necessary—declarations of actual use or intent to use when, among the designated States, there are some which, for the purposes of registration and/or renewal, require such declarations. Naturally, it would remain the prerogative of each State to verify the veracity of such declarations; only their form—the words to be used—would be standardized in order to diminish the risk of making mistakes by using the wrong words.

I. Switchover from National or Madrid Registrations to International Registrations under the New Treaty

55. It is proposed that, if the owner of a national trademark registration—however old—wants to replace that registration by an international registration, the New Treaty enable him to do so. Naturally, the New Treaty would expressly provide that the owner's rights acquired under the national registration would continue and would be immune to any possible refusal under the New Treaty.

56. Such a switchover, if effected in respect of several national registrations, would be useful for concentrating in one place—namely, in the international register—the effecting of renewals and the recordal of any assignments or other changes.

57. In a similar fashion, the New Treaty should allow the switchover from an international registration under the Madrid Agreement to an international registration under the New Treaty. Here, too, the New Treaty would expressly provide that the owner's rights acquired under the Madrid registration would continue and would be immune to any possible refusal under the New Treaty.

J. Co-existence of the New Treaty and the Madrid Agreement

58. It is proposed that it be clearly understood that any country party to the Paris Union could be party to the Madrid Agreement and/or the New Treaty.

59. In other words, a country could be party to the Madrid Agreement only, to the New Treaty only, or to both.

60. Consequently, any person who, and any legal entity which, has the right to seek international registration under the Madrid Agreement and the New Treaty (since, for example, he is a national of a country party to both treaties) could freely decide which treaty to use, for which of his trademarks and for which countries that are party to both treaties.

61. For example, if France and Switzerland were party to both treaties, Monaco party to the Madrid Agreement only, and the United States of America party to the New Treaty only, a French applicant could use the Madrid Agreement or the New Treaty for Switzerland, the Madrid Agreement only for Monaco, and the New Treaty only for the United States. If he chose to use, for Switzerland, the Madrid Agreement, he could later switch over to the New Treaty. If Monaco later became a party to the New Treaty, he could switch over to the New Treaty.

62. Once negotiations concerning the New Treaty crystallize some of the basic solutions, the International Bureau will prepare the draft of the form of an international application for the use by applicants who may use both treaties: such single application form would list, with one check box, the countries party to one of the two treaties and, with two check boxes (one for the New Treaty and one for the Madrid Agreement), the countries party to both treaties. The applicant would mark with check marks his choices. Naturally, where international registration is applied for under the Madrid Agreement for at least one country, the single application form would have to be filed with the national Trademark Office of the country of origin and that Office would have to certify the existence of the national registration. The use of the single application form would be a possibility, not an obligation; the applicant could also use two separate application forms: one under the New Treaty, and one under the Madrid Agreement.

Chapter 2

Renewal of and Changes in the Registration

K. Later Designations

63. It is proposed that the New Treaty allow the owner of an international registration to extend the effect of that registration to countries that he did not designate when he filed his international application.

64. Such a possibility of "later designation" would be useful when the owner of the trademark becomes interested in protection in countries in which he was, at the time of filing the international application, not yet interested.

65. Furthermore, the possibility of later designation would be useful also when a country which, at the time of the international application, did not exist or was not a party to the New Treaty, becomes a party to the New Treaty.

66. Finally, the possibility of later designation is useful when the owner of a national registration wants to transform the national registration into an international registration (so-called "switch-over"; see paragraphs 55 to 57, above).

67. The provisions concerning the filing of an international registration and its effects would also apply, *mutatis mutandis*, to later designations, except that where the later designation consists of a switchover from an existing national registration, the later designated country could not refuse the effect of the international registration.

68. The effective date of the later designation would be the date of the filing of the request asking that the later designation be recorded.

L. Renewal

69. It is proposed that the New Treaty provide for the possibility of renewing the effect of the international registration.

70. The initial term of the international registration could be fixed at 10 years and renewals could be provided for additional terms of 10 years each. One could also provide for two possibilities (10 or 20 years), and allow each applicant to choose between the two.

71. Countries which, in their national laws, have other terms would not need to change their laws. The fees to which their national Offices are entitled under the New Treaty (see paragraph 115, below) would, however, be proportionately higher (where, for example, the term, under the national law, is seven years) or lower (if, for example, the term under the national law is 14 or 20 years).

72. Renewal would have to be expressly demanded from the International Bureau of WIPO and would be subject to the payment of fees (see paragraph 128, below).

73. The possibility of renewing the effects of the international registration *in many countries* (that is, in all of the designated States) *by a sole act*

(namely, a demand filed with the International Bureau of WIPO) and by paying the fees in one place (again, the International Bureau of WIPO) would be one of the major advantages offered by the New Treaty to trademark owners: they would not have to monitor different due dates for renewal in different countries and would, as already stated, go through a single formality (the demand) and make one payment. Such a system is practically foolproof and thus creates security in a field which, without an international registration system, is full of pitfalls that may cause the loss of all rights.

74. As to the publication of renewals in a gazette, see paragraphs 134 to 136, below.

M. Changes in the Ownership of the International Registration

75. It is proposed that the New Treaty provide for the possibility of recording in the International Register any change in ownership of the international registration.

76. The change in ownership may be the result of an assignment but it may also be the result of devolution upon death, etc.

77. The change in ownership need not concern all the designated States: there may be no change for some such States, and the identity of the new owners may be different in any of the other designated States.

78. Furthermore, the change in ownership may be limited to only some of the goods or services.

79. The recording of any change in ownership in the International Register would have the same effect as if the recording had been effected in the national trademark registers of the designated States concerned. Such effect could be refused by a designated State on the same grounds, if any, as those on which it could refuse the recording of a change in ownership in its national trademark register. Any designated State could require documentary evidence of the assignment or other cause of the change in ownership.

80. The possibility of recording changes in ownership in the International Register is particularly useful when there is an assignment of rights in a number of countries: once again, all the owner will have to do is to file *one* request (with the International Bureau of WIPO) and pay fees in *one* place (the International Bureau of WIPO) and the recording will have effect in all (frequently, many) the designated States for which the assignment was made.

81. Changes in the person of any agent, and changes in the address of the owner or the agent, would likewise be recordable.

N. Change in the Name of the Owner of the International Registration

82. It is proposed that the New Treaty provide for the possibility of recording in the International Register any change in the name of the owner of the international registration.

83. The procedure and the effects would be similar to those proposed for recording changes in ownership (see paragraphs 75 to 81, above).

84. Corporate entities sometimes change their name, and if they do and if they own many trademark registrations in many countries, the recording of the change in their name is a complicated and costly task.

85. Being able to take care of this task through the filing of *one* request (presented to the International Bureau of WIPO) would be useful because of simplicity, less costs and reduced chances of procedural errors by the owner.

O. Limitation of the List of Goods and Services

86. It is proposed that the New Treaty provide for the possibility to record, in the International Register and on the request of the owner of the international registration, any limitation of the list of goods and/or services, in respect of any designated State. The effect of the international recording would be as if the limitation had been recorded in the national trademark registers of the designated States concerned.

87. Such possibility is sometimes a practical necessity for the owner of the international registration: for example, where he can avoid a lawsuit in a country if he strikes certain goods or services from the list applicable to that country.

88. Furthermore, such possibility is useful when the limitation concerns several designated States since it can be effected through *one* request, filed in *one* place (the International Bureau of WIPO) and with the payment of *one* fee in that same, *one* place.

89. Evidently, the New Treaty would have to allow each designated State to decide whether what the owner calls a limitation is, in fact, not rather an extension (addition) and, in the latter case, to refuse the effect of the recording. In such a case, all that the owner could do is to apply for an additional, new registration as far as the added goods and/or services are concerned.

P. Switchover from an International Registration to National Registrations

90. It is proposed that the New Treaty allow the switchover from an international registration to national registrations in one, several or all the designated States. Naturally, the rights existing under the international registration at the time of the switchover would continue in full under the national registration.

91. Such switchover may be necessary where the rights in a trademark are assigned to a person who is neither a resident nor a national of a country party to the New Treaty and, therefore, such person cannot own international registrations under that Treaty.

Q. Recordings Effected by National or Regional Offices

92. It should be clearly understood that the New Treaty would not require that any national or regional Trademark Office repeat, in its national or regional trademark register, the contents of any international registration that concerns it. The New Treaty would not require either that such contents be published in the national or regional trademark gazette.

93. If a national or regional Trademark Office decides not to duplicate the International Register and the International Trademark Gazette, it will save a lot of work and expense.

94. The public would then need to read the International Trademark Gazette of the International Bureau of WIPO but this seems to be a light burden and even a great advantage, since the reading of that gazette would convey information on the fate of the trademark in many countries (i.e., all the designated States) and not only in one (as the gazette of a national Trademark Office does) or a few (as the gazette of a regional Trademark Office does).

95. On the other hand, the New Treaty should not prohibit the duplication, by any national or regional Trademark Office, of the contents of the International Register and the International Trademark Gazette.

96. Where such a duplicative register exists, it may contain information that is the result of a procedure that took place only before the national or regional Trademark Office. In order to preserve the advantages of a single source of information referred to above, the New Treaty should oblige the national and regional Offices to notify such information to the International Bureau of WIPO, which would record them in the International Register and publish them in the International Trademark Gazette. Failure to notify by the national or regional Office would have the legal consequence that any information recorded in the national or regional

register would not have effect in respect of any foreign third party unless such party was actually aware of the information.

R. Cancellation

97. It is proposed that the New Treaty provide that any designated State may cancel the effect of the international registration in that State on the same grounds as it may, under its national law, cancel the effect of a national registration.

98. The New Treaty should expressly provide that such grounds must be compatible with the Paris Convention (which is only natural since only States party to the Paris Convention could adhere to the New Treaty), that the procedure, including the procedural guarantees (possibilities for appeals, etc.) must be the same as in the case of a cancellation procedure concerning national trademark registrations, and that such procedure must, in any case, include an opportunity for the owner of the international registration to defend his rights before the competent courts or administrative tribunals.

99. The New Treaty should allow the cancellation of the registration effect also on the ground that the applicant was not, or the owner of the international registration is not, entitled to own international registrations.

100. This last case will occur if it is found that, in fact, the owner is not a national of, and has no residence in, a State party to the New Treaty.

101. It is to be noted that the effect of any cancellation would be limited to the designated State whose court or other competent authority pronounces the cancellation. In this respect, the New Treaty would be very different from the Madrid Agreement (see "No Central Attack," paragraphs 47 to 49, above).

*Chapter 3
General Matters*

S. Languages

102. It is proposed that under the New Treaty English and French be the languages that could be used.

103. This would mean that any applicant could file the international application in English or French. Any correspondence between him and the International Bureau of WIPO would be in the language of the international application.

104. However, the publication covering all trademarks in the International Trademark Gazette of the International Bureau of WIPO

would be in both English and French, including in particular the list of goods and services. The translation would be made by the International Bureau.

105. The New Treaty should allow the States party to it to admit, by a collective decision of theirs, the use of other languages. For example, if several Spanish-speaking countries became party to the New Treaty and the number of international applications coming from those countries and the number of cases in which those countries were designated attained a certain level, it would be desirable to admit Spanish.

106. Spanish is used here as an example. Similar considerations would apply to other languages.

107. No designated State whose national language is other than the language of the international application would be allowed to ask for a translation, into its national language, of the contents of the international registration, (except, perhaps, of the list of goods and services), but, of course, any correspondence between the owner of the international registration and the national Trademark Office of the designated State would have to be in the language of that State.

108. In any case, since the publication of the international registration in the International Trademark Gazette of the International Bureau of WIPO would be in English and French, all national Offices could, when examining whether to issue a notice of possible refusal (see paragraph 42, above), have before them the material in both languages.

T. Representation

109. It is proposed that the New Treaty allow any international application to be signed (if accompanied or preceded by a power of attorney) by a representative (trademark agent or other) of the applicant.

110. Furthermore, any applicant or owner of an international application could, if he so desires, be represented before the International Bureau of WIPO by a representative of his choice.

111. The agent would have to be a national of the country of the applicant, that is, the country of which the applicant is a national or a resident. There would be no roster of admitted representatives as there is, for example, in the European Patent Office.

112. Once a representative is appointed and as long as his appointment is not withdrawn in a communication addressed to it, the International Bureau of WIPO would consider any communi-

cation received from him as if it came from the applicant or the owner of the international registration. And any communication sent by the International Bureau of WIPO to the representative would be considered as if it had been sent to the applicant or the owner.

113. As far as representation before authorities of a designated State is concerned, it is proposed that the New Treaty allow any designated State to require representation by a local agent only where the owner of the international registration institutes or defends a proceeding before the national authorities of that State.

114. It is to be noted that notices of possible refusal (see paragraph 42, above) would be sent by the designated State to the International Bureau of WIPO and that it would be that Bureau that would notify the owner of the international registration.

U. Fees

115. It is proposed that the New Treaty lay down the principles concerning fees.

116. The details would be left to the Regulations under the New Treaty (see paragraphs 138 to 141, below).

117. Any applicant would have to pay fees in connection with the filing of an international application.

118. One fee (the "international filing fee") would belong to the International Bureau of WIPO for such services as the handling of the application, the registration, the publication in its Gazette, and the notifications of the designated States. The amount of that fee would vary according to the number of classes into which the goods or services listed in the application belong according to the International (Nice) Classification.

119. Each designated Office would be entitled to a fee (the "designation fee") which, however, would be paid by the applicant to the International Bureau in order to simplify payment. The International Bureau would transfer to each designated State what is due to it.

120. Under the Madrid Agreement, the amount of the designation fee is specified in the Regulations of that Agreement; the applicant pays the same amount for each designation; all designation fees are put aside by the International Bureau and are divided, once a year, among the designated Offices; the share of each Office depends not only on the number of the interna-

tional applications in which it was designated but also on the kind of examination its domestic law provides for (e.g., there is a higher share for those which proceed to an examination of both relative and absolute grounds of refusal than for those which proceed only to an examination of absolute grounds of refusal). If one compares the amount that a designated Office *de facto* receives for each application with the amount that it would receive if the application were a national application, one finds that in some countries the first is higher than the second, whereas in others the reverse is true (see Annex I, Table C). Naturally, as time goes on, a country may pass from the category of those which collect more under the Madrid Agreement than under their national laws into the opposite category because the result depends on four factors, each of them subject to constant change: (i) the amount fixed in the Madrid Regulations, (ii) the amount fixed under the national law, (iii) the exchange rate between the Swiss franc and the currency of the designated State, and (iv) the degree of examination (relative, absolute grounds of refusal, etc.).

121. The Madrid system has the great advantage of making it very simple for the applicant to calculate how much he has to pay: all he has to do is to multiply the designation fee fixed in the Madrid Regulations (which fee is, as already indicated, the same for each country) by the number of designated States.

122. But the system of the Madrid Agreement may, as already indicated above, produce, for a given country, less than what it would collect under its national law. Such a result is and always has been acceptable to those countries (namely, the Madrid Union countries) since the difference is usually a relatively small one and since the simplicity of the system is to the advantage also to their own nationals using the Madrid system abroad. But, naturally, such a view requires thinking in terms of the general interest of trademark owners who are nationals of the country rather than thinking in terms of the financial results of the national Office. To say that the Madrid system, in such countries, creates a privileged position for foreigners is not necessarily true since the processing of designations reaching a national Office under the Madrid Agreement causes less—and if no duplicative publication (see paragraphs 92 and 93, above) is made, much less—work and cost than does the processing of a national application.

123. It seems prudent that the New Treaty should allow each country party to it to choose between a system similar to the one existing

under the Madrid Agreement and a system in which each designated State would be entitled to the same amount as it charges for national applications.

124. Consequently, it is proposed that the designation fee could, for any contracting State that so desires, be the same as its fee is in the case of national applications. Naturally, where the national fees are established for a period that is shorter (e.g., seven years) or longer (e.g., 20 years) than the period under the New Treaty (e.g., 10 years), the amount of the designation fee would be proportionately higher or lower. See Annex I, Tables A and B.

125. Under such a system, the International Bureau and the interested national Office would have to agree, from time to time, on the Swiss franc equivalent of the national fee.

126. Since the calculations of the applicant may be complicated under such a system and mistakes may be made, the New Treaty should provide for a particularly generous (generous, that is, towards the applicant) system of correcting any underpayment: the International Bureau of WIPO should be obliged to invite the applicant to pay any difference (possibly with a handling charge) within, say, one month from the time he is notified, and such late payments should not be allowed to have any adverse effect on the legal status of the international application. Naturally, if the applicant pays more than required, the International Bureau of WIPO should be obliged promptly to reimburse the difference.

127. Trademark owners who expect to use the New Treaty, and trademark agents who represent clients who expect to use the New Treaty, could open a current account with the International Bureau of WIPO, and that Bureau would calculate (or recalculate) the fees and debit, under the control of the owner of the current account, the appropriate amounts on that account.

128. It is proposed that similar solutions be applied under the New Treaty also to the *renewal fees*.

129. In any case, national and regional Trademark Offices would be entitled to payments only in connection with their designation (in the international application or later) and in connection with renewal.

130. In connection with *any other operations*—such as recording of changes in the ownership of the international regulations, changes in the name of the owner of the international registration, limitation of the list of goods and services—fees would be due only to the International Bureau of WIPO.

V. Notifications by National or Regional Offices and by Courts

131. It is proposed that the New Treaty provide that any notice of possible refusal or refusal by a national or regional Trademark Office (see paragraphs 42 to 45, above), or any notice concerning the commencement of any cancellation procedure (see paragraphs 97 to 101, above) by a national or regional Trademark Office or by a court, be notified by that Office or court to the International Bureau of WIPO and that that Bureau—after having made the corresponding annotations in the International Register—notify the same to the owner of the international application.

132. Under such a provision, the appointment of a local agent or the designation of a local address for service could become necessary only *after* the first notification.

133. As already stated (see paragraph 113, above), once the owner of the international registration is involved in a procedure before a national or regional Trademark Office or before a court, he may be required to be represented by a local agent and he would have to use the official language, or one of the official languages, of that Office or that court, as the case may be.

W. Publication and Notifications by the International Bureau

134. It is proposed that the New Treaty provide for the publication, by the International Bureau of WIPO, of a (weekly or monthly) *gazette*, the *International Trademark Gazette*, in which all international registrations and any changes to an international registration (later designations, changes in ownership, etc.) would be published. All the details, including the text of goods and services for which any trademark has been registered, would be so published and various indexes would facilitate the location of the required information. Online information would eventually be made available, too.

135. Renewals would also be published in the *Gazette*. The entry on any renewal would contain all the information valid at the moment of the renewal.

136. The printed publication could look very much like the one used in the *gazette* issued under the Madrid Agreement. A sample page is attached to this document (Annex II).^{*} But whereas in that *gazette* all information is published in French, in the *gazette* under the New Treaty all information would be published in English and French.

137. Naturally, the applicant, or the owner of the registration, would receive a notification addressed to him

by the International Bureau of WIPO as far as any event concerning his application or registration is concerned and would not have to rely on information in the *gazette*. In a similar way, any designated national or regional Office would receive from the International Bureau notifications covering any event in respect of all international applications in which that Office has an interest. Such notifications would be made in English or French, according to the wish of the Office.

X. Regulations and Other Administrative Matters

138. It is proposed that the New Treaty provide that details, including those subject to relatively frequent change (in particular, the amount of fees), be left to Regulations under the New Treaty.

139. The first version of such Regulations—that is, the version that would be applicable from the date the New Treaty comes into effect—would be adopted by the same diplomatic conference that would adopt the New Treaty. This would allow States whose ratifications or accessions would bring into effect the New Treaty to know, when they decide to ratify or accede, what the Regulations contain.

140. The Regulations could be amended later by the States which, at the time the amendment is decided, are party to the New Treaty. Depending on the nature of the provisions of the Regulations to be amended, decisions on amendments would require a simple majority, a qualified (e.g., two-thirds) majority or that no country vote against it (unanimity).

141. For the purposes of amending the Regulations and for supervising the finances of the International Bureau of WIPO as far as operations under the New Treaty are concerned, the States party to the New Treaty would meet, at least once every second year, in what could be called their "Assembly."

142. It is to be noted that all the expenses of the International Bureau of WIPO covering the administration of the New Treaty would have to be covered from the fees that applicants and owners of international registrations would pay to the International Bureau (other than the fees destined for the designated States). The only financial obligation that any State party to the New Treaty would have would consist in constituting a working capital fund (reimbursed, once it is no longer likely to be needed) and could consist in covering any deficits of the International Bureau if deficits became chronic and could not temporarily be covered from the working capital fund. The necessity of asking for deficit-covering contributions is remote the more so as the power to decide on the fees due to the International Bureau belongs exclusively to the countries party to the New Treaty.

^{*} This Annex is not reproduced here (*Editor's note*).

Part IV
Advantages of the New Treaty

143. There are many advantages that the use of the international registration system proposed in this memorandum would carry with it for applicants or owners of registrations over the use of the existing national registration systems (hereinafter sometimes referred to as "the proposed international system" and "the existing national systems," respectively).

144. They are presented hereafter under three headings: "The Proposed International System is Cheaper," "The Proposed International System is Simpler and, Therefore, More Secure," and "The Proposed International System Facilitates Decisions Whether to Do Business in a Given Country."

A. The Proposed International System is Cheaper

145. Should most countries party to the New Treaty decide—and it is likely that they would so decide—to require the payment of the same amounts for their designations under the New Treaty as are the amounts of their application fees for national applications, then the total amount of the *Office fees* payable to obtain registration would necessarily be higher under the proposed international system than under the existing national systems. This would be so because to the total of the amount of the national application fees one would have to add the amount of the international application fee (the fee going to the International Bureau of WIPO).

146. But, naturally, the expenses of an applicant consist not only of office fees but also of what will be called *agents' fees*, that is, the fees payable, under the existing national systems, to the agent in each country for translating (where necessary) the list of goods or services into the language of the country, for filling in the application form prescribed by the national Office, for forwarding the office fee to the national Office, and for filing the application with the national Office.

147. It does not facilitate comprehension that, unfortunately, in English, both office fees and agents' fees are usually referred to by the same word, namely, by the word "fee." It is easier to make the distinction in French, where *office fees* are called "*taxes*," and *agents' fees* are called "*honoraires*."

148. The following table illustrates what is meant. Supposing that the applicant wants protection in 25 countries, that the office fee in each country is an average of US\$100, that the agent's fee in each country is an average of

US\$100, that the fee of the agent who would file the international application would be US\$200 (i.e., double that of a national agent's fee, not because his work would be more than that of a national agent (it would *not* be more) but because his work would involve a higher degree of responsibility) and that the international fee (the fee going to the International Bureau of WIPO) would be US\$300, the expenses would be as follows:

| | <i>In the national systems</i> | <i>In the international system</i> |
|--|--|--|
| | (in US dollars) | |
| National office fees in each country (25 × 100) | 2,500 | 2,500 |
| Agents' fees in each country (25 × 100) | 2,500 | — |
| Agent's fee before the International Bureau | — | 200 |
| International Bureau's office fee | — | 300 |
| Total | 5,000 | 3,000 |

149. Thus, use of the international system would be cheaper by US\$2,000 or by 40%.

150. This percentage would gradually rise to almost 50% as the number of designated States becomes higher. On the other hand, the total amount of the fees payable under the proposed international system would be higher than the total amount of fees payable by using the existing national systems if the number of designated States is less than five. In such (unusual) cases, the incentive for using the proposed international system would have to come from the other advantages (mentioned in paragraphs 154 to 158, below) of the international system.

151. Similar considerations, with approximately similar results, apply also in connection with the payment of *renewal fees*, when the monitoring of the expiration of current national registrations and the payment of national renewal fees is entrusted to local agents.

152. Even higher percentages of savings would occur when the proposed international system was used for the recording of *changes* in the ownership of the international registration, in the name or address of the owner or his representative, or in the list of goods or services. In such cases, there would be a 100% economy of the national fees (since none would be chargeable).

The corresponding calculation, for 25 countries, looks as follows:

| | <i>In the national systems</i> | <i>In the international system</i> |
|--|--|--|
| | (in US dollars) | |
| National office fees in each country (25 × 20) | 500 | — |
| Agents' fees in each country (25 × 60) Agent's fee before the International Bureau | 1,500 | — |
| International Bureau's office fee | — | 100 |
| Total | 2,000 | 200 |

153. Thus, the use of the international system would be cheaper by 90%.

B. The Proposed System is Simpler and, Therefore, More Secure

154. Here are some of the features of the proposed international system which make its use much simpler than the use of the existing national systems:

(i) There is only *one application*. One form is used, not many. It is enough to know the rules of the New Treaty. One can forget about the many and widely different rules of national laws. Filling in the international application form is so simple that it is difficult to make mistakes. If there are, still, mistakes, they would be called *promptly* to the attention of the applicant by the International Bureau of WIPO, and the possibility of correcting them, by one correction with effect for all the designated States, will be offered to him by the said Bureau.

(ii) If there is already a national application and the applicant wants to benefit from the *right of priority* available under the Paris Convention, he does not have to rush, through agents in each of the foreign countries in which he is interested, to each of the national Offices, with national applications. Arriving in time, in such a case, may be extremely difficult, or impossible, since each agent needs instructions from the applicant and needs time to translate, fill in the national forms and file. The filling in of one application form (that is, of the international application form) and filing it in Geneva (probably possible also by telefax)—unless filing is done *via* a national Office—a city having excellent telecommunications systems, is infinitely more easy and requires very much less time. Consequently, the meeting of the time limit of the priority will pose no problems and one can be sure that the priority is correctly claimed, and is going to be effective in all the designated States.

(iii) The payment of the *fees* is much simpler in the proposed international system. All fees would be payable in one place (the International Bureau of WIPO) and in one currency (Swiss francs). The applicant will have at his disposal up-to-date information on the amount and will receive assistance, if he wants to receive it, in calculating the amounts to be paid. If he makes a mistake in calculating, he will promptly be notified of it and given an opportunity to correct it (that is, to pay the difference). All this is true both in respect of the fees payable for applications and for renewals, as well as for any other fees.

(iv) If there is a *change in the ownership of the international registration* (e.g., the rights in the trademark are assigned), the change must be announced only in one place (the International Bureau of WIPO) and the recordal of the change by that Bureau will have effect in *all* the designated States in which the change applies. The same is true for *changes in the name or address of the owner* of the international registration or of his representative. The same is also true where the owner of the international application wishes to *limit the list of goods or services* in respect of some or all of the designated States. Every specialist knows that securing the recordal of any of these types of change in several Offices is an operation which is tedious, wrought with risks and costly.

155. In general, one can say that where there is a way that is *simpler* to achieve the desired results it is not only a more secure way (since the possibilities of errors are reduced) but also a cheaper way. Most of the time, much cheaper. Because the owner of the registration needs not communicate with, give instructions to, or monitor the carrying out of his instructions by, many people in many countries. By one action, he will obtain the desired results in all the countries in which he is interested.

C. The Proposed International System Facilitates Decisions Whether to Do Business in a Given Country

156. In a number of countries, today, a decision to honor or not to honor an application for registration, that is, to register or refuse the registration of a trademark, takes several years. In a number of countries, for several years, an application is followed by nothing but silence on the part of the national Office. The applicant has absolutely no clues whether his trademark will be accepted for registration, and this uncertainty makes it difficult for him to decide whether to do business in the country (manufacture there, license there, import there, etc.) or not.

157. The situation would be quite different under the international system. Any national Office would have to notify a notice of possible refusal within a time limit (e.g., 20 months) that would be fixed in the New Treaty. The notice would have to indicate the possible grounds of refusal. Thus, within a fixed period of time, the owner

of the international registration will know that the registration of his trademark may not stand up and for what possible reasons. He will also know, if he receives no notice of possible refusal within that period, that his registration is safe and can be cancelled only by a court.

158. All this will make it much easier for the owner of the international registration to guess the chances of its standing up and, consequently, whether he is well advised to rely on it in any given country.

Part V Alleged Dangers of any International Trademark Registration System

159. From the viewpoint of the trademark owner, any international registration system, and in particular the international system that the New Treaty would create, would have nothing but advantages. This is generally admitted. Some voices are sometimes heard that, in some special situations, the use of the existing national systems may be more advantageous for the applicant or that in some special situations, using any international system or using the existing national systems is equally good (or bad) for the applicant. It is difficult to imagine such special situations but even if one were to admit that they exist, no harm could result for the applicant since the decision to use or not to use the proposed international system (or, for that matter, the system under the Madrid Agreement) is a free decision, a decision that the applicant and no one else (unless it is the agent of the applicant) makes.

160. It is a basic truth that must be repeated and emphasized: *nobody will be obliged to use the proposed international system*. Every potential applicant is free to use it, if he so wishes. He may decide never to use it, always to use it, or to use it in certain cases.

161. However, alleged dangers of any international system are sometimes voiced from the viewpoint of persons in search of good trademarks to be adopted by them, from the viewpoint of national Offices, and from the viewpoint of trademark agents.

162. Those three alleged dangers constitute the subject matter of the following three sections.

A. "Any International System Makes it More Difficult to Find New Trademarks"

163. The first alleged danger—alleged that is, by some people—is that any international system, including the proposed international system, makes it more difficult to find new signs that one could adopt as trademarks ("clogging of national registers"). The argument runs as

follows: "any international system makes the obtaining of registrations simpler, cheaper and easier; *ergo*, the number of marks registered will be much higher under an international system than under (the more complicated, expensive and difficult) national systems; *ergo*, the number of signs not (yet) registered as trademarks and, therefore, available for adoption as trademarks, will seriously diminish; *ergo*, the choice of new trademarks will become much more restricted than if only the national systems continue."

164. The mistake in this argumentation resides in its second assumption, namely, that the number of marks registered would become much higher. It might become a *little* higher, namely where the simplicity of the system seduces the applicant to seek protection even in countries where his interest is uncertain or marginal. But the number is surely not going to become *much* higher since the designation of each country costs money (under the probably prevailing fee system, the *same* amount of money as under the existing national systems), and the typical applicant only spends money on a country when he wishes protection in that country.

165. It is admitted that it cannot be *proven* that this prediction is correct since one cannot compare the statistical effects of systems that exist (namely, the national systems), and for which statistics exist, with a system (the international system under the proposed New Treaty) that does not yet exist and for which statistics not only are not available but cannot exist.

166. However, the experience with the system of the Madrid Agreement shows that the alleged danger is minimal if not in-existent. That Madrid system shows that applicants are very discriminating. They, *in fact*, usually designate between five and 15 States, with an average of 10, that is, approximately one third of what they *could* designate.

167. Consequently, it seems to be fully justified to negate the allegation according to which the proposed international system would seriously restrict the choice of available signs for adoption as trademarks.

168. It should be noted that the prevention of the "clogging" of national trademark registers can be achieved through a requirement of actual use: the registration of trademarks that have not been used for a certain number of years—for example, five years—should be cancelled. The laws of many countries already contain such provisions.

B. "Any International System Increases the Work Load of National Trademark Offices"

169. Another danger that some persons sometimes allege is that the work load of national (or regional)

Trademark Offices would dramatically increase if international registrations could designate the country or countries that they serve.

170. The supporters of this argument further say that national Trademark Offices are already overworked and understaffed and, if they will have to deal with even more trademarks, their backlog would increase. The same persons also say that where national fees do not cover the costs of the national Office, that is, where every application is subsidized by the government, the amount needed for subsidizing would increase and—and this is particularly shocking—the increase would be due to the applications of *foreigners*, since, evidently, any international system in a country is primarily used by foreigners.

171. There are at least two mistakes in this argumentation.

172. One is the same as the one already referred to in the preceding section (paragraphs 163 to 168, above): it is erroneous to assume that the number of trademarks for which protection is sought in any country will seriously increase on account of the existence of an international system applicable in that country. The reasons why this assumption is considered to be erroneous have been indicated in paragraph 164, above, and they apply here too.

173. The other underlying assumption which is to be examined is that the work of a Trademark Office is necessarily the same under an international application as under a national application. If it is, it is the result of a free decision of the country, namely the decision that its Trademark Office proceed to a repetitive or duplicative registration and a repetitive or duplicative publication. Both are superfluous. Here, too, the example of the Madrid Agreement can be cited. As far as the International Bureau of WIPO knows, none of the 28 States party to the Madrid Agreement proceed to repetitive registrations (that is, recording in their national trademark registers what is already recorded in the International Register under the Madrid Agreement) and repetitive publication (that is, publication in their national trademark gazettes of what is already published in the international gazette issued under the Madrid Agreement). Even countries party to the Madrid Agreement having an opposition system—as for example, the Federal Republic of Germany—do not proceed to such repetitious registrations and publications.

174. But there is at least one field in which every national Office would make great savings thanks to the proposed international system. That is the field of collecting the national fees. The cost of the collection of those fees would be borne by the International Bureau of WIPO. In countries where hard currency, freely conver-

tible, has importance, the fact that those fees would be received in Swiss francs (rather than unconvertible local currencies) by the national Offices will be an added advantage for those Offices in particular, and for the balance of payments of their countries in general.

C. "Trademark Agents Will Earn Less"

175. It is believed that the allegation that trademark agents will earn less if there is an international system has some truth in it. But it is believed that this will not be so for all trademark agents (since the earnings of those who file international applications will increase) and even for those who may be affected, the difference will be small.

176. The difference will be small because the fees earned by a trademark agent from his clients are not only fees that are paid in connection with filing and renewal but also those that are payable when the trademark "is in trouble," that is, for example, when the national Office intends to refuse it, has (as a first instance) refused it, or is subject to opposition by a third party. The fees for defending a trademark in trouble are usually much higher than the fees for the largely routine activities, as are the activities of preparing and filing applications and paying renewal fees. And those, much higher, fees would *not* be affected in any way by the proposed international system since the national registration effect of an international registration is exposed to the same risks as national applications.

* * *

ANNEX I

Terms of Protection and Fees in Selected Countries

A. Term of Basic Registration

20 years: Italy,* Morocco, Spain, Switzerland, United States of America.

15 years: Canada, Tunisia, Venezuela.

10 years: Algeria, Argentina, Austria, Benelux (Belgium, Netherlands, Luxembourg), Brazil, China, Czechoslovakia, Denmark, Egypt, Finland, France, German Democratic Republic, Germany (Federal Republic of), Greece, Hungary, Indonesia, Italy,* Japan,

*In Italy, the owner has the choice between a period of 10 and 20 years.

Monaco, Paraguay, Portugal, Republic of Korea, Romania, Soviet Union, Sweden, Thailand, Uruguay, Viet Nam.

7 years: Australia, India, Ireland, New Zealand, Singapore, United Kingdom.

5 years: Mexico.

B. Term of Renewal

20 years: Italy,* Morocco, Spain, Switzerland, United States of America.

15 years: Canada, Tunisia, Venezuela.

14 years: Australia, India, Ireland, New Zealand, Singapore, United Kingdom.

10 years: Algeria, Argentina, Austria, Benelux (Belgium, Netherlands, Luxembourg), Brazil, China, Czechoslovakia, Denmark, Egypt, Finland, France, German Democratic Republic, Germany (Federal Republic of), Greece, Hungary, Indonesia, Italy,* Japan, Monaco, Paraguay, Portugal, Republic of Korea, Romania, Soviet Union, Sweden, Thailand, Uruguay, Viet Nam.

7 years: India.

5 years: Mexico.

C. Registration and Renewal Fees

This table shows, in countries from which information has been received in April and May 1985, the fees payable for the basic registration (including any separate application fees), and for the renewal, of a trademark with a list of goods or services belonging to three classes. The fees have been adjusted for a 10-year

duration. The exchange rates at mid-May 1985 were used. The "complementary fee for territorial extension" (in this memorandum, called "the designation fee") under the Madrid Agreement (for one country, in three classes) is 68 Swiss francs at registration and for each renewal.

| | Registration (Swiss francs) | Renewal (Swiss francs) |
|------------------------------|--------------------------------|---------------------------|
| United Kingdom | 1714.50 | 416.70 |
| Ireland | 1376.15 | 357.15 |
| Australia | 1124.40 | 400.30 |
| United States of America | 693.00 | 1188.00 |
| Singapore | 637.90 | 170.10 |
| New Zealand | 612.40 | 153.10 |
| Romania | 599.30 | 599.30 |
| Soviet Union | 454.50 | 363.60 |
| Germany, Federal Republic of | 436.00 | 918.90 |
| Finland | 420.40 | 545.10 |
| Algeria | 408.10 | 408.10 |
| Austria | 336.10 | 450.20 |
| Viet Nam | 316.80 | 79.20 |
| France | 265.25 | 348.50 |
| Denmark | 251.90 | 251.90 |
| Benelux | 237.90 | 178.40 |
| Sweden | 235.35 | 323.60 |
| German Democratic Republic | 213.70 | 256.40 |
| Tunisia | 193.65 | 129.00 |
| Canada | 192.30 | 384.70 |
| India | 186.40 | 186.40 |
| Mexico | 175.20 | 141.60 |
| Hungary | 155.20 | 155.20 |
| Japan | 147.85 | 147.85 |
| Venezuela | 142.70 | 6.70 |
| Republic of Korea | 140.70 | 140.70 |
| Switzerland | 140.00 | 140.00 |
| China | 130.90 | 130.90 |
| Italy | 119.60 | 135.20 |
| Czechoslovakia | 105.30 | 105.30 |
| Indonesia | 101.10 | 101.10 |
| Thailand | 96.15 | 96.15 |
| Greece | 74.60 | 46.20 |
| Uruguay | 64.80 | 167.20 |
| Monaco | 63.90 | 63.90 |
| Spain | 63.30 | 63.30 |
| Portugal | 44.55 | 49.70 |
| Brazil | 36.60 | 350.00 |
| Argentina | 27.50 | 27.50 |
| Morocco | 6.10 | 4.10 |
| Paraguay | 2.75 | 2.75 |
| Average of above | 310.85 | 248.40 |

* In Italy, the applicant has the choice between a period of 10 and 20 years.

WIPO Meetings

WIPO/Chinese Patent Office

Advanced Patent Course

(Shanghai, November 11 to December 6, 1985)

NOTE*

An Advanced Patent Course, organized jointly by WIPO and the Chinese Patent Office, was held in Shanghai from November 11 to December 6, 1985. Seventy-two Chinese participants attended the Course; they came from the Chinese Patent Office, Provincial Patent Administrative Bureaus, Patent Agencies, and educational, industrial, scientific and trade institutions. The Course, which was part of a six-month training program for the Chinese participants, was opened by the Mr. Huang Kunyi, Director General of the Chinese Patent Office, and Dr. Arpad Bogisch, Director General of WIPO.

Specialists from France, Germany (Federal Republic of), Japan, Switzerland, the United Kingdom, the United States of America, the European Patent Office, as well as several officials of the International Bureau of WIPO, were invited or designated by WIPO to act as lecturers. The topics covered the contents of a patent application, conditions of patentability, special kinds of inventions, international patent procedures, and licensing.

The specialists had prepared background papers that were translated into Chinese and distributed in advance to the participants. During the Course, each topic was dealt with by three lecturers who engaged in a panel discussion. The panel discussion was followed by a general discussion with the participants, during which numerous questions were clarified.

Paris Union

Committee of Experts on Intellectual Property in Respect of Integrated Circuits

First Session

(Geneva, November 26 to 29, 1985)

NOTE*

The first session of the Committee of Experts on Intellectual Property in Respect of Integrated Circuits (hereinafter referred to as the "Committee of Experts") took place in Geneva, at the headquarters of WIPO, from November 26 to 29, 1985. The following 30 States participated in the session: Argentina, Australia, Austria, Belgium, Brazil, Bulgaria, Canada, China, Denmark, Finland, France, Germany (Federal Republic of), Greece, Hungary, India, Ireland, Israel, Italy, Japan, Morocco, Netherlands, Nigeria, Norway, Pakistan, Republic of Korea, Soviet Union, Sweden, Switzerland, United Kingdom, United States of America. In addition, representatives of three intergovernmental organizations and 14 non-governmental organizations participated in an observer capacity. The list of participants follows this Note.

The Committee of Experts was convened to discuss a Draft Treaty on the Protection of Intellectual Property in Respect of Integrated Circuits, prepared by the International Bureau of WIPO. The aim of the Draft Treaty is to provide a system of international protection for the design or layout of integrated circuits (often referred to as "microchips"). The need for such a system stems from the fact that integrated circuits, the development of which requires great investments in money and manpower, are playing a crucial role in modern technology and are the object of intense international trade and competition. The prevailing view is that the design or layout of integrated circuits is neither an invention eligible for patent protection nor a work eligible for copyright protection, and at least in those countries in which such a view is followed, the existing patent or copyright conventions (i.e., the Paris Convention for the Protection of Industrial Property, the Berne Convention for the Protection of Literary and Artistic Works and the Universal Copyright Convention) do not ensure protection for the design or layout of integrated circuits of foreign origin. The Draft Treaty, if adopted,

* Prepared by the International Bureau of WIPO.

would remedy that situation by obliging the Contracting States to consider unlawful the unauthorized reproduction of the design or layout of integrated circuits, the incorporation of the design or layout of an integrated circuit in a product and the distribution of reproductions of the design or layout of products that incorporate the design or layout.

On the whole, the participants fully endorsed the need for a new multilateral treaty for the protection of the original design or layout of an integrated circuit; they also stressed the importance of such a treaty being based on the principle of national treatment rather than reciprocity. Although proposals for additional clarification and some suggestions for changes were made, much support was given to the Draft Treaty, which was considered to be a solid basis for further consideration.

With respect to the provisions of the Draft Treaty, the participants discussed, *inter alia*, the following:

Definitions. The Draft Treaty does not contain a definition of "integrated circuit" and other technical expressions. The majority of the participants suggested including, either in the text of the Treaty, in an accompanying memorandum or in explanatory notes, definitions of the object of protection and of certain key terms, such as "integrated circuit," "layout-design" and "commercial exploitation." Several delegations made proposals for such definitions, which were discussed by the Committee of Experts. Several other delegations, however, were of the view that definitions were not indispensable, as shown by other important international instruments, including the Paris Convention. It was emphasized that the search for suitable definitions should in no way jeopardize the realization of the Treaty and that all agreed-upon definitions must be sufficiently broad and flexible to ensure that national legislation would not be unduly constrained and that the Treaty would not be surpassed by rapid technological advances.

Conditions of Protection. The Draft Treaty mentions the condition of originality but does not define the notion of originality. The question was discussed whether originality should be an internationally required condition of protection. While most of the participants who spoke on the matter considered that originality should constitute a requirement of protection and that the concept should be referred to in the Treaty, several delegations expressed the view that it would be preferable for the Treaty to remain silent in that regard in order to permit the Contracting States greater flexibility in adopting national systems of protection. As an alternative, the suggestion was made to make protection conditional on either originality or novelty.

It was emphasized that, regardless of the criterion used, the purpose of the Treaty was to establish minimum rights and maximum formalities that could be adopted on an international level in order to prevent

piracy in integrated circuits; the type of system adopted on the national level, therefore, need not be defined in the Treaty, provided that the national system complied with the Treaty's requirements as to minimum rights, minimum duration of protection and maximum formalities.

Minimum Rights Protected. The Draft Treaty enumerates the acts which, if performed for commercial purposes, would, as a minimum, have to be considered unlawful by the Contracting States. Those acts are reproducing or copying the layout (or design) of an integrated circuit, incorporating such layout into a product and distributing products that are reproductions or copies of such layout or that incorporate such layout. The Draft Treaty provides that these acts need not be considered unlawful if they are performed for the purpose of teaching or research, for the purpose of creating another original layout ("reverse engineering") or for the purpose of the distribution of products that have already been put on the market with the consent of the proprietor of the layout. No basic objections were raised to these proposals, although it was suggested that the concepts of "commercial purposes" and "reverse engineering" should be further clarified.

Maximum Formalities. The Draft Treaty permits Contracting States to require that—as a condition of protection—a copy of the layout or design or other identifying material be filed with a national or international public authority and that the proprietor's claim to protection be registered by such authority. Some delegations questioned whether such possibilities should be maintained since the need to comply with such formalities in several countries would be burdensome, particularly to small businesses. It was noted, however, that the United States of America and Japan already had such systems in place.

Minimum Term of Protection. While the Draft Treaty only provides for a minimum duration of 10 years counted either from the date of registration or the date of first commercial exploitation, several delegations suggested that, in addition, the event from which protection must start, for example, the first fixing of the layout, should also be specified. Some delegations found the proposed 10-year minimum too long and proposed that it be reduced to five years to reflect rapid developments in technology, which made new integrated circuits rapidly obsolete.

Additional Proposals. Two delegations indicated their desire that the Treaty provide a system of preferential treatment for developing countries. One delegation introduced a proposal for consultation procedures for the settlement of disputes between Contracting States concerning the implementation of Treaty provisions.

The Committee of Experts noted a statement made by the Director General that he was prepared to consult with a few consultants to clarify some technical issues involved in integrated circuit protection and that the next session of the Committee of Experts would probably take place in mid-1986.

LIST OF PARTICIPANTS**

I. Member States

Argentina: N.S. Fasano. **Australia:** L.G. Honcope. **Austria:** R. Dittrich; G. Mayer-Dolliner. **Belgium:** D. Vanderghyest. **Brazil:** C.I. Zamitti Mammana; C.R. Treiguer. **O.L. Monteiro de Farias;** P.R. França. **Bulgaria:** E. Stefanova. **Canada:** H.P. Knopf; P.A. Van Brakel. **China:** He Ru Ying; Ning Yan Wu. **Denmark:** J. Norup-Nielsen; L. Østerborg; H.J. Riis-Vestergaard; M. Koktvedgaard. **Finland:** J. Lieder; S. Lahtinen; M.-L. Mansala; K.M. Tarhio; S. Henriksson. **France:** J. Jonquères; B. Vidaud. **Germany (Federal Republic of):** I. Koch; J. Schade. **Greece:** N. Couniniotis. **Hungary:** G. Pálos. **India:** G. Soni; S.R. Tayal. **Ireland:** A. Coleman-Dunne. **Israel:** M. Ophir. **Italy:** M.G. Fortini; C. Pompei. **Japan:** Z. Kitagawa; Y. Masuda; S. Kamogawa; Y. Nakata. **Morocco:** M.S. Benryane. **Netherlands:** E.C. Nooteboom. **Nigeria:** T.A. Osinuga; E.O. Jegede. **Norway:** J. Bing. **Pakistan:** Z. Akram. **Republic of Korea:** K.H. Lee. **Soviet Union:** V. Myasnikov; V.V. Varfolomeev. **Sweden:** A.H. Olsson; J.-E. Bodin; K. Hökborg. **Switzerland:** J. Borloz; W. Moser; J.-M. Souche. **United Kingdom:** D.M. Haselden. **United States of America:** R. Oman; H. Winter; M. Keplinger; D. Schrader; M.J. Remington; V. Weinman.

II. Intergovernmental Organizations

United Nations Educational, Scientific and Cultural Organization (UNESCO): Y. Gaubiac. **Commission of the European Communities (CEC):** R.J. Coleman; B. Posner. **European Patent Organisation (EPO):** G.D. Kolle.

III. Non-Governmental Organizations

British Computer Society (BCS): R.J. Hart; B. Niblett. **Committee of National Institutes of Patent Agents (CNIPA):** J.U. Neukom; J.E.M. Galama; W. von Willich. **Computer and Business Equipment Manufacturers Association (CBEMA):** F.T. Boehm. **Electronic Industries Association of Japan (EIAJ):** K. Nakamura; K. Ogasawara. **European Electronic Component Manufacturers Association (EECA):** R.J. Boxall; A. Koerber. **International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP):** I. Cherpillod. **International Association for the Protection of Industrial Property (AIPPI):** T. Mollet-Vieville; P. Guilguet. **International Chamber of Commerce (ICC):** F.T. Boehm; J.M.W. Buraas. **International Federation of Industrial Property Attorneys (FICPI):** H. Bardehle; K. Raffinsoe; J. Lecca. **International League for Competition Law (LIDC):** J.-F. Leger. **International Patent and Trademark Association (IPTA):** R.S. Laurie. **International Publishers Association (IPA):** J.A. Koutchoumow. **Union of European Practitioners in Industrial Property (UEPIP):** J. Lecca; H.-E. Bohmer. **Union of Industries of the European Community (UNICE):** J.E.M. Galama; R.J. Hart; M. Colombe.

IV. Officers

Chairman: A.H. Olsson (Sweden). *Vice Chairmen:* Z. Kitagawa (Japan); V.A. Myasnikov (Soviet Union). *Secretary:* J. Erstling (WIPO).

V. International Bureau of WIPO

A. Bogsch (Director General); K. Pfanner (Deputy Director General); L. Baeumer (Director, Industrial Property Division); J. Erstling (Head, Industrial Property Law Information Section, Industrial Property Division); M. Weil-Guthmann (Consultant, Industrial Property Division).

International Patent Classification (IPC) Union

Committee of Experts

Fourteenth Session
(Geneva, January 20 to 24, 1986)

NOTE*

The Committee of Experts of the International Patent Classification (IPC) Union held its fourteenth session in Geneva from January 20 to 24, 1986.¹ Fourteen States, members of the Committee of Experts—Brazil, Denmark, Finland, France, Germany (Federal Republic of), Japan, Netherlands, Norway, Soviet Union, Spain, Sweden, Switzerland, United Kingdom, United States of America—and the European Patent Office (EPO) were represented at the session. The list of participants follows this Note.

This session was the second of a series of sessions of the Committee of Experts that will lead to the adoption of the fifth edition of the IPC (to be published in 1989).

The Committee of Experts approved amendments (in both the English and the French versions) submitted to it by the Working Group on Search Information of the WIPO Permanent Committee on Patent Information (PCPI). Those amendments affect 61 subclasses of the IPC and relate to the following areas:

Section A: the amendments affect nine subclasses; they include, in particular, substantive revision of the area of subclass A 61 G dealing with transport of, and accommodation for, patients;

* Prepared by the International Bureau.

¹ For a Note on the thirteenth session, see *Industrial Property*, 1985, p. 111.

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

Section B: the amendments affect 18 subclasses; they include, in particular, several subclasses of class B 41, dealing with printing;

Section C: the amendments affect 11 subclasses; they include, in particular, the creation of a new subclass C 12 S providing for further classification of processes using enzymes or microorganisms;

Section D: the amendments affect one subclass;

Section E: the amendments affect three subclasses;

Section F: the amendments affect nine subclasses;

Section G: the amendments affect six subclasses;

Section H: the amendments affect four subclasses; they include, in particular, subclass H 01 S dealing with lasers.

The Committee of Experts adopted a recommendation concerning the printing of non-obligatory classification symbols and non-obligatory indexing codes on patent documents.

The Committee of Experts discussed the matter of the revision of IPC areas relating to rapidly developing technologies and recommended the PCPI Working Group on Planning to elaborate a procedure to deal with some IPC revision requests with very high priority.

LIST OF PARTICIPANTS**

I. Member States

Brazil: P. França. **Denmark:** S.T. Simonsen. **Finland:** H.I. Lommi. **France:** M. Lyon. **Germany (Federal Republic of):** K. Molewski. **Japan:** Y. Masuda. **Netherlands:** S. de Vries. **Norway:** P.E. Lillejordet. **Soviet Union:** V.V. Belov; S.B. Erofeeva. **Spain:** J.D. Vila Robert. **Sweden:** J. von Döbeln. **Switzerland:** E. Caussignac. **United Kingdom:** G.K. Lindsey. **United States of America:** T.F. Lomont.

II. International Organizations

European Patent Office (EPO): R. Baré; E. de Bundel.

III. Officers

Chairman: J. von Döbeln (Sweden). **Vice-Chairmen:** V.V. Belov (Soviet Union); K. Molewski (Germany (Federal Republic of)). **Secretary:** B. Hansson (WIPO).

IV. International Bureau of WIPO

P. Claus (*Director, Patent Information and Classification Division*); B. Hansson (*Head, Patent Classification Section, Patent Information and Classification Division*); A. Sagarminaga (*Senior Patent Classification Officer, Patent Classification Section*); Y. Mizutani (*Patent Classification Officer, Patent Classification Section*).

WIPO Permanent Committee on Patent Information (PCPI)

Working Group on Search Information

Fifteenth Session

(Geneva, November 25 to December 6, 1985)

NOTE*

The PCPI Working Group on Search Information (hereinafter referred to as "the Working Group") held its fifteenth session in Geneva from November 25 to December 6, 1985.¹ The following 12 States and one organization, members of the Working Group, were represented at the session: Denmark, Finland, France, German Democratic Republic, Germany (Federal Republic of), Japan, Norway, Spain, Sweden, Switzerland, United Kingdom, United States of America, European Patent Office (EPO). The list of participants follows this Note.

The following items were dealt with:

IPC Revision Projects Carried Over from 1984. The Working Group dealt with 21 IPC revision projects still pending. Of those projects, 17 belong to the mechanical field and four to the chemical field. Substantial amendments were agreed to in respect of subclasses C 07 D and C 07 J, relating to "coating compositions" and "adhesives compositions," respectively.

Other IPC Revision Projects in the Program for the 1984/1985 Biennium. The Working Group dealt with 38 of the other IPC revision projects in the program for the 1984/1985 biennium. Of those projects, 24 belong to the mechanical field and 14 to the chemical field. Substantial amendments were agreed to in respect of subclass A 61 J, relating to "medical or pharmaceutical containers."

Subsidiary Bodies. The Working Group approved the report of Subgroup J, which, in Munich from May 20 to 23, 1985, dealt with the IPC revision project for class G 03, relating to "photosensitive compositions," and expressed its satisfaction with the results achieved.

The Working Group decided to create a further ad hoc Working Group (Subgroup K) to be entrusted with the IPC revision project for subclass C 07 C, relating to "organic compounds."

* Prepared by the International Bureau.

¹ For a Note on the preceding session, see *Industrial Property*, 1985, p. 237.

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

LIST OF PARTICIPANTS**

I. Member States

Denmark: H.J. Petersen. Finland: H.I. Lommi.² France: M. Lyon; L. Hornik;² M. Lavé.² German Democratic Republic: H. Konrad.² Germany (Federal Republic of): K. Molewski;² G. Greif;² E. Moritz;² H.F. Schneider.² Japan: A. Nakamura; Y. Masuda.² Norway: P.E. Lillejordet.² Spain: J.M. Elena. Sweden: J. von Döbeln. Switzerland: E. Caussignac;² J. Borloz;² V. Candolfi. United Kingdom: J. Hillman;² P. Redding; J.L. Twin.² United States of America: P. Sullivan; G. King.

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

² Attended part of the session only.

II. Member Organization

European Patent Office (EPO): E. de Bundel; J.F.C. Atkins;² R. Espeel;² J.-M. Moreau.²

III. Officers

Chairman: E. de Bundel (EPO). Vice-Chairmen: J. Hillman (United Kingdom); M. Lyon (France). Secretary: B. Hansson (WIPO).

IV. International Bureau of WIPO

P. Claus (*Director, Patent Information and Classification Division*); B. Hansson (*Head, Patent Classification Section, Patent Information and Classification Division*); A. Sagarminaga (*Senior Patent Classification Officer, Patent Classification Section*); Y. Mizutani (*Patent Classification Officer, Patent Classification Section*).

General Studies

**The Semiconductor Chip Protection Act
of 1984: Statutory Framework;
Copyright Office Regulations; and
Effect on International Protection
of Chip Designs***

R.S. LAURIE**

**The 1984 Law Amending the
Austrian Patent Law**

O. LEBERL and N. MARTERER*

News from Industrial Property Offices

THE GAMBIA

Registrar General

We have been informed that Mr. Musa N. Bitaye has been appointed Registrar General.

MONGOLIA

*Chairman, State Committee on
Science and Technology*

We have been informed that Mr. Munkhdorjiin Dash has been appointed Chairman of the State Committee on Science and Technology.

SAUDI ARABIA

Director, Patent Office

We have been informed that Dr. A.A. Al-Rasheed has been appointed Director of the Patent Office.

Calendar of Meetings

WIPO Meetings

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

1986

- April 8 to 11 (Geneva) — Permanent Committee for Development Cooperation Related to Industrial Property
- April 14 to 18 (Geneva) — Permanent Committee on Patent Information (PCPI): Working Group on General Information
- May 5 to 7 (Geneva) — Paris Union: Committee of Experts on Protection Against Counterfeiting
- May 12 to 14 (Geneva) — WIPO International Forum on Collective Administration of Copyrights and Neighboring Rights
- May 22 to June 6 (Geneva) — Permanent Committee on Patent Information (PCPI): Working Group on Search Information
- May 26 to 30 (Geneva) — Paris Union: Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions
- June 2 to 6 (Paris) — Committee of Governmental Experts on Audiovisual Works and Phonograms (convened jointly with Unesco)
- June 4 to 6 (Geneva) — Permanent Committee on Patent Information (PCPI): Working Group on Patent Information for Developing Countries
- June 9 to 13 (Geneva) — Permanent Committee on Patent Information (PCPI): Working Groups on Special Questions and on Planning
- June 23 to 27 (Geneva) — Committee of Experts on Intellectual Property in Respect of Integrated Circuits
- September 1 to 5 (Geneva) — Permanent Committee on Patent Information (PCPI) and PCT Committee for Technical Cooperation (PCT/CTC)
- September 8 to 10 (Geneva) — WIPO Patent and Trademark Information Fair
- September 8 to 12 (Geneva) — Governing Bodies (WIPO Coordination Committee, Executive Committees of the Paris and Berne Unions, Assembly of the Berne Union)
- October 13 to 17 (Geneva) — Permanent Committee on Patent Information (PCPI): Working Group on General Information
- November 24 to December 5 (Geneva) — Permanent Committee on Patent Information (PCPI): Working Group on Search Information
- December 8 to 12 (Geneva) — Permanent Committee on Patent Information (PCPI): Working Groups on Special Questions and on Planning

UPOV Meetings

1986

- April 15 (Geneva) — Consultative Committee
- April 16 and 17 (Geneva) — Administrative and Legal Committee
- May 21 to 23 (Hannover) — Technical Working Party on Automation and Computer Programs
- May 26 to 29 (Pontecagnano-Salerno) — Technical Working Party for Vegetables, and Subgroup
- June 3 to 6 (Dublin) — Technical Working Party for Agricultural Crops, and Subgroup
- July 15 to 18 (Wageningen) — Technical Working Party for Ornamental Plants and Forest Trees, and Subgroup
- September 15 to 19 (Wädenswil) — Technical Working Party for Fruit Crops, and Subgroup
- November 18 and 19 (Geneva) — Administrative and Legal Committee
- November 20 and 21 (Geneva) — Technical Committee
- December 1 (Paris) — Consultative Committee
- December 2 and 3 (Paris) — Council

Other Meetings Concerned with Industrial Property

1986

- June 1 to 4 (San Diego) — The United States Trademark Association: Annual Meeting
- June 2 to 6 (Munich) — European Patent Organisation: Administrative Council

June 3 to 6 (Strasbourg) — Center for the International Study of Industrial Property: Seminar on Transfer of Technology (first module: Nature of License Contracts and of the Transfer of Technology)

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

September 13 to 17 (Lucerne) — International League for Competition Law: XXIXth Congress

September 23 to 26 (Strasbourg) — Center for the International Study of Industrial Property: Seminar on Transfer of Technology (second module: Strategy and Procedures for the Transfer of Technology)

December 1 to 5 (Munich) — European Patent Organisation: Administrative Council