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INDUSTRIAL PROPERTY LAWS AND TREATIES (INSERT)

Editor's Note

AUSTRALIA

Trade Marks Act 1955 (Reprinted as at 31 December 1986 and further amended by the Jurisdiction of Courts (Miscellaneous Amendments) Act 1987 (No. 23 of 1987)) Text 3-001

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Notifications Concerning Treaties

Paris Convention

Accession

MALAYSIA

The Government of Malaysia deposited, on June 23, 1988, its instrument of accession to the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Stockholm on July 14, 1967.

Malaysia has not heretofore been a member of the International Union for the Protection of Industrial Property ("Paris Union"), founded by the Paris Convention.

The Paris Convention, as revised at Stockholm on July 14, 1967, and amended on October 2, 1979, will enter into force, with respect to Malaysia, on the date indicated by the Government of Malaysia, that is, on January 1, 1989. On that date, Malaysia will become a member of the Paris Union.

Malaysia will belong to class VII for the purpose of establishing its contribution towards the budget of the Paris Union.

Paris Notification No. 120, of June 24, 1988.

Budapest Treaty

Extension of the List of Kinds of Microorganisms Accepted for Deposit

NATIONAL COLLECTIONS OF INDUSTRIAL AND MARINE BACTERIA LTD. (NCIMB)
(United Kingdom)

The Director General of WIPO was informed by a notification received on June 19, 1988, from the Government of the United Kingdom that the list of kinds of microorganisms accepted for deposit by the National Collections of Industrial and Marine Bacteria

Ltd. (NCIMB), an international depositary authority under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, has been extended to include the following:

- (a) Yeasts (including those containing plasmids) that can be preserved without significant change to their properties by liquid nitrogen freezing or by freeze-drying, that are allocated to a hazard group no higher than Group 2 as defined by the UK Advisory Committee on Dangerous Pathogens (ACDP), and which require physical containment no higher than level II as defined by the UK Advisory Committee on Genetic Manipulation (ACGM).
- (b) Seeds that can be dried to a low moisture content and/or stored at low temperatures without excessive impairment of germination potential. The right is reserved to refuse the deposit of seeds where dormancy is exceptionally difficult to break.

Where statutory provisions require NCIMB to obtain a license or certificate prior to accepting a deposit of seeds, the actual cost of obtaining any such license or certificate will be charged to the depositor.

The acceptance of seeds by NCIMB and the furnishing of samples thereof are subject at all times to the provisions of the Plant Health (Great Britain) Order 1987, including any future amendments or revisions of that Order.

NCIMB must be notified in advance of all intended deposits of seeds so that it may ensure that all relevant regulations are complied with. Any seeds received without prior notification may be destroyed immediately.

[End of text of the notification of the Government of the United Kingdom]

The extension of the list of kinds of microorganisms accepted for deposit by the National Collections of Industrial and Marine Bacteria Ltd. (NCIMB) will take effect as from the date of publication in the present issue of *Industrial Property* (August 31, 1988) (see Rule 3.3 of the Regulations under the Budapest Treaty).

Budapest Communication No. 44 (this Communication is the subject of Budapest Notification No. 71, of July 4, 1988).

WIPO Meetings

Madrid Union

Assembly

Nineteenth Session (12th Extraordinary)

Committee of Directors

Seventeenth Session (10th Extraordinary)

(Geneva, April 18 to 22, 1988)

NOTE*

The Assembly and the Committee of Directors of the Madrid Union for the International Registration of Marks (hereinafter referred to as "the Assembly and Committee of Directors") met in extraordinary session in Geneva, from April 18 to 22, 1988.

The following States were represented at the session: Algeria, Austria, Belgium, Bulgaria, Czechoslovakia, Democratic People's Republic of Korea, Egypt, France, German Democratic Republic, Germany (Federal Republic of), Hungary, Italy, Mongolia, Morocco, Netherlands, Portugal, Romania, Soviet Union, Spain, Sudan, Switzerland, Viet Nam, Yugoslavia (23). Denmark participated in an observer capacity.

The representatives of one intergovernmental organization and eight non-governmental organizations also took part in the session in an observer capacity. The list of participants follows this Note.

Discussions were based on document MM/A/XIX/2-MM/CDIR/XVII/2, containing draft Regulations under the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as "the draft") and on a proposal submitted by the Delegation of Switzerland (document MM/A/XIX/3-MM/CDIR/XVII/3), for the insertion of a new rule in those Regulations.

A brief general debate was followed by a rule-by-rule examination of the draft, which was adopted by the Assembly and Committee of Directors subject to some amendments. The Regulations adopted differ from the Regulations now in force in the following main respects:

- a new rule (Rule 1) defines the abbreviated expressions used in the Regulations, as in the majority of Regulations under treaties administered by WIPO;
- a new rule deals with representation before the International Bureau (Rule 2);
- a new rule deals with cases in which there are two or more owners (Rule 3);
- publication of the mark in color is henceforth provided for in the Regulations (Rule 9(2)(ii));
- the rule on the form and contents of notifications of invalidation has been completed (Rule 18);
- a new rule has been inserted on the recording of certain judicial or administrative decisions (Rule 19);
- the amount of the complementary fee for territorial extension to one country has been increased from 68 to 88 Swiss francs (Rule 32(1)(a)(iii)).

The Regulations were adopted on April 23, 1988, and will enter into force on January 1, 1989, on which date they will replace the Regulations Under the Madrid Agreement Concerning the International Registration of Marks of June 21, 1974, as amended on September 29, 1975, November 24, 1981, and December 15, 1983.

LIST OF PARTICIPANTS**

I. Member States

Algeria: O. Bouhnik; F. Mekidèche. **Austria:** G. Mayer-Dolliner. **Belgium:** W. Peeters. **Bulgaria:** P. Karayanev. **Czechoslovakia:** E. Mück; J. Prošek. **Democratic People's Republic of Korea:** Kim Yu Chol; Kim Song Hak; Pak Dok Hun. **Egypt:** A.G.M. Fouad. **France:** J.C. Combaldieu; G. Rajot; J.M. Parra. **German Democratic Republic:** K. Stöcker; K. Wendler. **Germany (Federal Republic of):** M. Bühring; T. John. **Hungary:** G. Pusztai; J. Bobrovsky. **Italy:** M.G. Fortini; M.G. Del Gallo Rossoni. **Mongolia:** T. Dorjiin; G. Lkhagvajav. **Morocco:** M.S. Abderrazik. **Netherlands:** H.R. Furstner. **Portugal:** J. Mota Maia; R. Serrão. **Romania:** R. Susan. **Soviet Union:** : I. Vedernikova; L. Salenko. **Spain:** M.T. Yeste Lopez; C. Ubierna. **Sudan:** A.H. El Tinay. **Switzerland:** J.D. Pasche. **Viet Nam:** Than Nguyen Duc; Ngo Dinh Kha. **Yugoslavia:** R. Tešić.

II. Observer States

Denmark: L. Østerborg; A.M. Broberg.

* Prepared by the International Bureau of WIPO.

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

III. Intergovernmental Organizations

Benelux Trademark Office (BBM): L.J.M. van Bauwel.

IV. Non-Governmental Organizations

Benelux Association of Trademark and Design Agents (BMM): L.J. Verschoor. European Communities Trade Mark Practitioners' Association (ECTA): J. Charrière. French Association of Practitioners in Trademark and Designs Law (APRAM): R. Baudin. Institute of Trade Mark Agents (ITMA): D.B. Lutkin. International Association for the Protection of Industrial Property (AIPPI): R. Harlé. International Chamber of Commerce (ICC): J.M.W. Burras. International Organization for Standardization (IOS): J. Blanc. Union of European Practitioners in Industrial Property (UEPIP): C. Kik.

V. Officers

President: J.C. Combaldieu (France). *Secretary:* P. Mangué (WIPO).

VI. International Bureau of WIPO

F. Curchod (*Director of the Office of the Director General*); P. Mangué (*Senior Counsellor, Industrial Property (Special Projects) Division*); A. Ilardi (*Senior Legal Officer, Industrial Property Law Section, Industrial Property Division*); S. Di Palma (*Head, Trademark and Industrial Design Registries*); R. Unterkircher (*Head, International Trademark Registry*).

Activities of Other Organizations

International Association for the Protection of Industrial Property

Executive Committee
(Sydney, April 10 to 15, 1988)

NOTE*

Introduction

The Executive Committee of the International Association for the Protection of Industrial Property (AIPPI) met in Sydney, Australia, from April 10 to 15, 1988. There were some 200 participants from 40 countries.

The World Intellectual Property Organization (WIPO) was represented by Mr. François Curchod, Director, Office of the Director General, who addressed the meeting at the opening ceremony on April 10, 1988.

The matters examined by the Executive Committee included legal protection of software, the relationship between patent protection for biotechnological inventions and plant variety protection, the patentability of animal breeding, the use requirements for acquisition and maintenance of rights in registered trademarks, the protection of service marks and the harmonization of

patent law. The Executive Committee adopted various resolutions on these matters, with the exception of the last-mentioned item. As regards the harmonization of patent law, the Executive Committee adopted a resolution on one specific point (self-collision). The texts of these resolutions are reproduced below. The Committee further examined the draft WIPO Treaty on the Harmonization of Certain Provisions in Laws for the Protection of Inventions.

Resolutions Adopted

QUESTION 57

Legal Protection of Computer Software

RESOLUTION

I. *Having reviewed* the question of protection of computer software in the light of legal developments and experience

* Prepared by the International Bureau of WIPO.

acquired since the resolution passed at Rio¹ in May 1985, AIPPI observes the following:

1. The countries which have adopted legislation have based the protection for software on copyright.

2. By using the copyright route, States can provide protection for software in general terms effectively and quickly; copyright has not hitherto given rise to major difficulties in its application to computer software.

3. Such protection by means of copyright may be supplemented by rules of unfair competition or by the law of contract.

4. It is immaterial as a matter of principle whether software is treated the same as other existing types of copyright works or as a separate species of copyright work.

5. But having regard to the specific nature of software, there may be a need for special rules on certain aspects of software protection and such rules should be harmonized internationally.

II.1. AIPPI confirms the basic principles of the resolution passed at Rio (*Yearbook* 1985/III).

2. AIPPI further specifically confirms the following points thereof, namely:

- translation (para. 3(c));
- back-up copies (para. 3(d)(i));
- moral rights (para. 4);
- duration (para. 5);
- deposit formalities (para. 6);
- and also that the use, storing, storage, loading and running of an unauthorized copy of a program should be a prohibited act (cf. para. 3(d)(i));
- and in addition that the international conventions on copyright are applicable.

3. According to the resolution passed at San Francisco (*Yearbook* 1975/III),² AIPPI is of the opinion that patent protection should be available for technological inventions incorporating software.

III. AIPPI further affirms as follows:

1. An effective regime for the enforcement of protection of computer software is essential.

2. For a program to qualify for copyright protection, it should not be necessary for a degree of non-obviousness (in the patent sense), or for technical improvement to be present.

3. The fact that a computer program is of its essence functional in nature should not preclude it from protection by copyright.

4. Whether by natural application of copyright law or by express provisions, the rental of a copy of a program, even if legally acquired, should require an express authorization from the copyright owner.

5. A screen display as such should be protectable by copyright to the same extent as any other graphic or textual work; the scope of protection should include the particular form of the display, but should not be so broad as to protect the content of the display as such.

6. Having regard to the fact that commercially successful software may define a "de facto" standard for interconnection with other equipment or for the user's convenience, AIPPI is of the opinion that such software should remain protectable subject to the normal national rules of copyright and that the ordinary anti-trust or anti-monopoly rules are the appropriate legal basis for preventing an abuse of the position so obtained.

7. Where copyright law provides that works made by an employee belong to the employer, such provision is equally applicable to the copyright in computer software.

8. The protection by copyright should clearly cover slavish copying, copying of a substantial part only of a program, and adaptation of a program. It should not cover the ideas embodied in a program, or algorithms as such.

9. The traditional distinction between ideas and expression should be applicable but special consideration should be given to where the line between ideas and expression should be drawn. Copyright should not prevent further development in programming, it being recognized that treating the program as a literary work may lead to protection which is too broad. In that respect, the analogy with scientific works is more suitable than with literary works. In the application of Article IVbis of the Geneva Convention (UCC), the "recognition" test should not be applied too broadly, and should be limited to the expression and not extended to the ideas.

IV. AIPPI considers that it should in the context of its previous work continue study on the following points:

1. To seek to provide firmer guidelines for the application of the distinction between ideas and expression to computer software. It seems appropriate to consider that the scope of protection be proportional to the range of expression available to a programmer. The ideas should not be too broadly stated. Furthermore the mere fact that an alternative expression of the idea is possible should not imply that the chosen form of the expression of the idea must be protectable.

2. In order to enable further progress to take place in programming, consideration should be given to the possibility of decompiling a legally acquired copy of a program to examine its content, which has—perhaps inappropriately—been termed "reverse engineering," provided that this activity does not lead to a work which is itself infringing. A subsidiary question is whether the contractual exclusion of such an activity may be enforced.

3. On the definition of software, in particular as to whether it includes programmable logic devices (when programmed) which might otherwise appear to be unprotected. In defining computer software, consideration should be given to the border line between copyright protection and chip protection.

4. Is the author of a computer-generated work (which may itself be a program) the person who initiates the creation of the work?

5. Are normal copyright rules relating to copying for private use applicable to computer software, or should special provisions apply as has been proposed in relation to reprographic copying? Also, should a legitimate owner of a program have the automatic right to translate, modify or adapt a program to run on different hardware, and if so should it be permissible to exclude this right by contract?

¹ See *Industrial Property*, 1985, p. 271, and *Copyright*, 1985, p. 354.

² See *Industrial Property*, 1975, p. 324.

6. The so-called "shrink-wrap" license practice (under which a purchaser is assumed to agree with the terms of a contract by opening the package containing a program) in particular as to its enforcement by law and as to the scope of the rights which could thereby be retained.

7. The problem that arises when a software provider ceases to exist such as due to liquidation, in ensuring continuity of maintenance for the software user and to enable the user to develop the program further. It seems equitable that the interests of the software user should override the ordinary liquidation rules in this respect. Similar considerations can arise in cases of bankruptcy or reorganization.

V. AIPPI *recommends* to the special committee considering the GATT negotiations that it should take account of the need for efficient border controls, when appropriate and for preliminary injunctions, in relation to computer software.

QUESTION 89C

"Self-Collision"

RESOLUTION

Article 202³ of the WIPO draft Treaty on Harmonization of patent law is concerned with the prior art effect of an earlier but unpublished application on the novelty of an invention in a later application, i.e., the "whole contents" approach.

The article tentatively provides for an exception in the case of identity of the applicants or inventors in the two applications, i.e., an exception for "self-collision."

AIPPI *has been considering* the desirability of such an exception and the detailed provisions which might be made.

AIPPI *is wholly in favor* of an exception for "self-collision."

In considering the details, AIPPI concluded that the exception should arise when there is identity of applicants and that this identity could be partial, i.e., the exception should arise if one application is in the names A & B and the other in the names A & C.

AIPPI *discussed* the possibility of creating the exception by assignment of one application to an applicant in the other application, but *decided* that the exception should depend on identity of the applicants at the date of filing the later application. AIPPI *also considered* the possibility of arguing for "identity" when one applicant is an owned or controlled associate company of the other applicant. In both cases, AIPPI *was of the opinion* that these were complicating considerations which might reduce the possibility of the "self-collision" exception being incorporated in the Treaty.

In considering the possibility of the "self-collision" exception arising from identity of inventors, AIPPI *was fairly evenly divided*. Bearing in mind the not infrequent problem of determining the true inventors at the time of filing, the greater difficulty there may be in making corrections to inventorship after filing, movement of inventors from one company to another and the possibility of inventors not wishing to be

named at all, *it was felt* that, on balance, it would be better to restrict the exception to identity of applicants.

AIPPI *is of the opinion* that the "self-collision" exception should be accompanied by a provision against double patenting.

AIPPI *recognizes* that internal priority is a necessary complement to the self-collision exception.

RESOLUTION

1. In the WIPO draft Treaty on Harmonization of Certain Provisions in Laws for the Protection of Inventions, there should be a provision in Article 202 on Prior Effect of Applications which excludes "self-collision" between applications in which there is at least partial identity of the applicants for the respective applications at the date of filing the later application.

2. The Treaty should exclude the possibility of double patenting in these circumstances.

3. In the Treaty, internal priority should also be provided for.

QUESTION 92A

Use Requirements for the Acquisition and the Maintenance of Registered Trademarks

RESOLUTION

The AIPPI, having studied the question whether use of a trademark should constitute a condition for acquiring and maintaining a trademark registration, *observing* that the national law and practice still shows a number of differences in respect to this question, therefore *welcoming* the WIPO initiative for a harmonization of trademark law, and *keeping in mind* that some of the related questions may not be suitable for being regulated on the national or international level but may, nevertheless, be harmonized by case law and practice, *takes the following position:*

I. Condition of Use for Acquiring a Right in a Registered Trademark

1(a) The AIPPI *observes*

— that already the majority of national laws does not require a sign which is distinctive and eligible for trademark protection to be used as a condition for its registration as a trademark;

— that, in those (three) countries where the national law still requires a trademark to be in use before registration, this condition is eased for foreign applicants who are entitled to the benefits of the Paris Convention for the Protection of Industrial Property;

— that the great majority of national laws does not even require that there should be an intention to use the trademark as a condition of registration.

(b) The AIPPI *believes*

— that modern national and international trademark legislation should not establish any use or intention to use requirement as a condition for the registration of signs which are distinctive and eligible for trademark protection, provided

³ *Ibid.*, 1988, p. 186.

— that it is appropriate to provide for sanctions against unjustified non-use of a registered trademark.

2(a) The AIPPI *observes*

— that most national laws do not exclude the registration of reserve marks,

— that, indeed, in most countries the grace period for using a registered trademark amounts to a factual and temporary admission of reserve marks.

(b) The AIPPI *believes*

— that such a solution satisfies a practical need.

II. Condition of Use for Maintaining Registered Marks

(a) The AIPPI *observes*

— that the great majority of national laws requires a registered trademark to be used to maintain the rights relating to that mark (“obligation to use”).

(b) The AIPPI *confirms* the position taken at the Munich Congress⁴ and *emphasizes*

— that in enforcing the obligation to use a registered trademark the function of the trademark should be taken into account which is to distinguish the products or services of a business. (*Annuaire AIPPI* 1978/II, p. 160 *et seq.*)

A. Nature and Form of Required Use

1. Use as a Trademark

(a) The AIPPI *observes*

— that the majority of national laws does not define the nature and amount of use necessary to maintain the rights relating to a registered trademark (“required use”);

— that, nevertheless, the opinion prevails that the required use of the mark must be made in relation to goods or services.

(b) The AIPPI *believes*

— that the evaluation of required use should be made taking into account all factual circumstances.

(c) The AIPPI *observes*

— that, in the majority of national laws use of a sign merely as a business name or a business symbol, i.e., not in relation to goods or services, does not fulfill the conditions of required use, and

— that, as a rule, use of merely a sign as a descriptive or geographical indication does not constitute use as a trademark.

2. Required Use as Public Use

The AIPPI *observes*

— that in the majority of national laws the required use must be of a public nature,

— that use of the mark within a group of associated or related companies may fulfill the conditions of required use provided that such is made in connection with a normal business transaction.

3. Form of Required Use

(a) The AIPPI *observes*

— that national law and practice is divided on the question whether use in commercial documents or in advertising fulfills the conditions of required use;

— that, in countries having experience with the protection of service marks, the use of such marks on business documents, including stationary, fulfills the conditions of required use.

(b) The AIPPI *confirms* the position taken at the Munich Congress and *emphasizes*

— that the use of a mark in an advertisement announcing a future sale should fulfill the conditions of required use provided that the process of putting the goods on the market or providing services has been started and that the customer can obtain the goods or the services in the near future. (*Annuaire AIPPI* 1978/I, p. 35)

4. Extent and Genuineness of Required Use

(a) The AIPPI *observes*

— that in all countries where the national law requires a registered trademark to be used, such required use needs to be genuine, token use not being sufficient.

(b) The AIPPI, *recalling* the position taken at the Munich Congress, *believes*

— that the question whether, in a given case, the extent and genuineness of required use can be considered adequate is a question of fact which requires the consideration of all factual circumstances;

— that under these conditions use for the purpose of market tests is normally sufficient;

— that, consequently, the use of a trademark in conjunction with trials (e.g., clinical trials which may not involve the sale of goods) may also fulfill the conditions of required use. (*Annuaire AIPPI* 1978/I, p. 35)

B. Products of Services in Respect of Which the Required Use Must Take Place

1. Effects of Use Which is Limited to One or More of the Registered Goods or Services

(a) The AIPPI *observes*

— that national law and practice differ in considering the effect of use limited to one or more of the registered goods or services (“limited use”).

(b) The AIPPI, *recalling* the position taken at its Munich Congress, *believes*

— that consideration of the effects of limited use should take into account the scope of protection of the registered trademark which should always extend to similar goods or services and not necessarily to all goods or services falling in the same class or in respect of which the mark has been registered. (*Annuaire AIPPI* 1978/I, p. 35 *et seq.*)

2. Effects of Use Limited to Specific Goods or Services

The AIPPI *observes*

— that, in case of trademarks registered for goods or services identified by a general term of the official classification (e.g., cosmetics), use which is limited to specific goods or services (e.g., mascara) suffices in most countries to maintain the registration for the general term.

C. Form of the Mark—Elements Which Need to be Used

(a) The AIPPI *observes*

— that with respect to the question of use of the mark in a form differing in elements which do not alter the distinctive character of the registered mark, the national law responds to the principles established in Article 5C(2) of the Paris Convention for the Protection of Industrial Property.

(b) The AIPPI *believes*

— that, as a matter of principle and subject to Article 5C(2) of the Paris Convention for the Protection of Industrial Property, the required use should take place in the form in which the mark has been registered,

— that, in the case of composite marks consisting of several elements, the use of the essential elements should be sufficient,

⁴ *Ibid.*, 1978, p. 243.

— that, in the case of word marks, the mark may be used in any form, typography or color and may be used in combination with additional elements (e.g., trade names, descriptive terms), provided that the mark maintains its distinctive character,

— that, in the case of marks registered and used to distinguish all or a range of products or services of an undertaking, the mark may always be used in combination with (different) product marks,

— that, if a word mark and a device mark are registered separately, combined use of both marks is sufficient to maintain both registrations.

D. Persons Using the Mark

(a) The AIPPI observes

— that the majority of national laws allows for the required use to be made by a third party with the consent of the trademark owner,

— that this consent may, as a rule, be given *a posteriori*,

— that, however, such consent *a posteriori* may not have effect if the registration was challenged before,

— that the third party using the trademark with the consent of the trademark owner need not be a related company or the holder of a formal license,

— that there is no common opinion as to the question whether effective use by a third party presupposes the existence of a written agreement,

— that there is no common opinion as to the question whether the agreement authorizing use by a third party should be legally valid or recorded and should not give rise to objections under the law of unfair competition.

(b) The AIPPI, confirming the position taken at the Munich Congress and at the Toronto Executive Committee Meeting, believes

— that when considering use by a third party the function of the trademark should be taken into account, and

— that, consequently, it should be sufficient that the third party is effectively and genuinely entitled to use the mark on behalf of the trademark owner irrespective of whether the agreement is legally valid or recorded or may give rise to criticism under unfair competition law. (*Annuaire AIPPI* 1978/I, p. 37; 1980/I, p. 121)

E. Place of Use

(a) The AIPPI observes

— that, unless otherwise provided for in international treaties, the majority of national laws provides that the required use must take place within the country of registration,

— that there is a growing number of countries in which the conditions of required use are considered to be fulfilled whenever the mark is used only in relation to goods to be exported.

(b) The AIPPI confirms the position taken at the Toronto Executive Committee Meeting and emphasizes

— that in case of a mark used in international trade it might suffice that either the mark had become known in the country where it was registered or that there was a serious proposal to use the mark in that country. (*Annuaire AIPPI* 1980/I, p. 121)

F. Period Within Which Use is to Take Place

(a) The AIPPI observes

— that the law of a growing number of countries provides for a grace period of five years from registration within which required use has to take place,

— that the national law of most countries does not prohibit a new and independent registration of the mark during the

grace period.

(b) The AIPPI confirms its position taken at the Munich Congress and emphasizes

— that there should be a grace period of five years which should run from the date when the registration is issued,

— that use of the registered mark after expiry of the grace period should revalidate the mark provided that such use takes place before the validity of the mark is called into question. (*Annuaire AIPPI* 1978/I, p. 38 *et seq.*)

G. Extenuating Circumstances

The AIPPI confirms the position taken at the Munich Congress and emphasizes

— that reasons justifying the non-use of a registered trademark within the meaning of Article 5C(1) of the Paris Convention for the Protection of Industrial Property should not only be cases of “*force majeure*” but any other circumstance which is not due to the fault or negligence of the proprietor of the mark. (*Annuaire AIPPI* 1978/I, p. 39)

H. Sanctions and Procedure

(a) The AIPPI observes

— that in almost all countries failure of required use does not lead to lapse or *ex officio* cancellation of the registered trademark,

— that in all countries failure of required use may lead to cancellation of the mark upon request of a third party,

— that in most countries the trademark owner need not prove use at the time of renewal of the registration.

(b) The AIPPI believes

— that evidence of use should not be required for the renewal of a trademark registration,

— that, on the other hand, it is appropriate to put the burden of proof of required use in cancellation proceedings on the owner of the registered trademark,

— that a simple and inexpensive cancellation procedure be provided in which, upon the request of an interested party, the trademark owner must submit *prima facie* evidence of required use.

QUESTION 92B

Protection of Service Marks

RESOLUTION

Whereas the Revision Conference of Lisbon in 1958 introduced by way of Article 6*sexies* of the Paris Convention the obligation of member countries to protect marks for services; and

Whereas there has been a substantial growth in service activities throughout the world; and

Whereas there is general recognition that significant economic and other benefits flow from the certainty provided by a registration system for marks used in relation to goods and no practical distinction can be drawn in respect of marks used in relation to services; and

Whereas a majority of member countries have undertaken to protect marks for services and to provide for the registration thereof; and

Whereas on the basis of the reports submitted by national groups and the Summary Report, AIPPI seeks to develop and enhance the protection of marks for services with a view to their greater acceptance and the harmonization of the laws relating thereto;

Now Therefore Be It Resolved:

1. That a service mark be considered as a mark used in connection with a service performed for another, distinguishing such service from services performed by others.

2. That the public interest would best be served by providing for registration of marks for services.

3. That any person or entity may be the proprietor of a mark for services including a mark relating to social or charitable services.

4. That for purposes of registration of marks for services, countries may include collective and guarantee (certification) marks.

5. That the same general principles governing the obtaining, maintaining, and protection of a mark for goods be applied to marks for services. The same general principles shall also govern in particular the relationship between marks for goods and marks for services.

6. That following the practice of a number of countries, the principle of Article 4A(1) of the Paris Convention granting priority rights in respect of marks for goods be applied to marks for services.

QUESTION 93

Biotechnology

RESOLUTION

Relationship between protection by means of patents for biotechnological inventions and protection for plant varieties: Patentability of animal breeds.

After having considered the working guidelines, the reports of the National Groups (*Yearbook 1987/V*) and after re-consideration of the resolution of Rio de Janeiro on Question 82 (*Yearbook 1985/III*, p. 312),

AIPPI

Re-affirms the principle that inventions relating to living organisms, be they microorganisms, plants, animals or parts thereof, or to other biological material or to processes for obtaining or using them should be patentable on the sole condition that they comply with the usual criteria of patentability. The resolution of Rio de Janeiro, which laid down this principle has been well accepted and has had a positive influence on the ongoing work in WIPO.

Three years after Rio de Janeiro there is no reason to introduce any limitation whatsoever into this principle which should be applied in its generality. In particular, the notion of biotechnological inventions should not be limited to certain specific techniques.

The positive effects of patent protection for technological, economic and social progress together with the existing experience with patent protection for chemicals, pharmaceuticals, microorganisms and foodstuffs convince AIPPI that patent protection will be equally beneficial in fostering the much-needed innovation in the fields of plant and animal production. The remedies against abuses of patent rights which exist under national laws are viewed as being sufficient and satisfactory.

The need for patent protection in this field is reinforced by the fact that wide differences in the numbers of species protected by individual member countries of the UPOV Convention results in a lack of protection by plant breeders rights for many species in particular countries.

The moral or ethical problems which could arise from the application of new techniques in biotechnology should be primarily regulated by laws specifically dealing with those issues to which the patent laws of nearly all countries refer in excluding from patentability inventions contrary to morals or public order.

AIPPI

Expresses its desire to recognize all the consequences following from this fundamental principle, in particular:

- (a) All prohibitions on the patentability of living things, be they plants, animals or other organisms, or of processes for obtaining them which exist in national laws and international treaties, especially the European Patent Convention, should be abolished as soon as possible.

Since such a change will take time to achieve, during the interim period, the present provisions should be interpreted so as to provide the minimum limitation on patent protection. AIPPI endorses the proposals of WIPO in suggested Solutions 1 and 9 of document BIOT/III/2, dated April 8, 1987, which are to the effect that patent protection should be allowed for all plants or animals when produced by patentable processes and for plants, plant material or animals other than plant or animal varieties as such; it being understood that the effects of such patents are not affected by any existing exclusion of plant or animal varieties from patent protection.

- (b) It is necessary to approve firmly the position expressed at Rio de Janeiro that the prohibition on double protection by patent and by plant breeders' rights, where it still exists, in particular in Article 2(1) of the UPOV Convention, and in the laws of the member States, should be abolished. The full freedom should be restored, not only the right to choose the form of protection, patent or plant breeder's right, but also the possibility to have the same subject matter protected by a patent and by a plant breeder's right if and when the requirements of the pertinent law are complied with.

The possibility of protection being provided by both the patent and plant breeders' rights systems may result in different parties having rights covering the same subject matter. In the event that it becomes necessary to obtain a license in order to avoid infringement of the rights of a party, either between the parties as such or other interested parties, AIPPI considers usual commercial agreement between the parties as the means appropriate for the resolution of licensing matters.

- (c) The importance and value of the protection of plant varieties under the UPOV Convention is recognized. Such protection should be strengthened in order to provide better protection for those innovations which do not comply with the criteria for patentability and to enable the holders of such protection to take part effectively in commercial negotiations. In particular, Article 5(3), which permits the free utilization of a protected variety as an initial source for breeding new varieties should be amended to provide, at least, for a royalty in the case of commercial exploitation of that new variety. The existence of Article 5(4) which

provides for protection of end products is noted and AIPPI would encourage member States to take advantage in their national laws of this provision at least in respect of ornamental plants.

AIPPI

Is of the opinion that in relation to patent protection for self-replicable materials the matter of exhaustion of the patent right in relation to the replication or differentiation of, or derivation from, the patented product or the product of a patented process is uncertain in many countries. AIPPI considers the solution as being an evolving one which may

require resolution by legislative and judicial means, but in the meantime supports the Suggested Solutions Nos. 12, 13 and 14 proposed by WIPO in document BIOT/III/2, dated April 8, 1987, which are to the effect that the protection granted should in principle extend to the products of replication, differentiation or derivation.

AIPPI

Decides to continue study of improvements and amendments to be made to the UPOV Convention and invites Committee 51 to prepare a corresponding report for presentation at the occasion of the Congress of Amsterdam in June 1989.



Studies

Remedies in Intellectual Property Cases

R.I. BARKER*

Books and Articles

Book Reviews

La protection des produits semi-conducteurs, Institut de recherche en propriété intellectuelle Henri-Desbois, Librairies Techniques, Paris, 1988. — 142 pages.

This publication contains the proceedings of a colloquium organized by the Henri-Desbois Institute for Research in Intellectual Property (*Institut de recherche en propriété intellectuelle Henri-Desbois—IRPI*) in Paris on December 15, 1987, on the protection of intellectual property in respect of integrated circuits. The timing of the colloquium was most opportune, the colloquium having been held a little over one month after the promulgation of the new French Law of November 4, 1987, on the Protection of Topographies of Semiconductor products and on the Organization of the National Institute of Industrial Property. The colloquium was chaired by Mr. Jean Foyer, Deputy, who had played an important role in the adoption of this Law by the National Assembly.

Four papers, which had been presented at the colloquium, are reproduced in the publication:

- The New French Regime, by Mr. J. Dragne, Assistant Director General of the National Institute of Industrial Property (Institut national de la propriété industrielle—INPI);
- The Protection of Semiconductors Abroad: the Situation in EEC Countries by Mrs. M. Langer of the Commission of the European Communities;
- The Protection of Semiconductors Abroad: the Situation in the United States and Japan, by Mr. J. Fort, Patent Counsel; and
- The Response in Practice, by Mr. P. Guilguet, Member of the *Conseil supérieur de la propriété industrielle*.

Each of the papers contains a clear and comprehensive exposition of its subject matter. Together, the papers constitute an important contribution to the understanding of the present situation of the international market for semiconductor products, the reasons why it was deemed necessary to legislate specifically with respect to the protection of layout-designs of integrated circuits and the operation of some of the principal legislative texts which had, by the date of the colloquium, emerged, namely, the Semiconductor Chip Protection Act of 1984 of the United States of America, the 1985 Act Concerning the Circuit Layout of a Semiconductor Integrated Circuit of Japan and the Council Directive of December 16, 1986, of the European Communities on the Legal Protection of Topographies of Semiconductor Products, as well as the new French Law mentioned above.

The papers reproduce some useful and interesting statistical information concerning both the international market for semiconductor products, and on registrations of layout-designs under the American and Japanese Laws. In respect of the international market for semiconductor products, it is indicated that exceptional growth has occurred and is likely to continue. On one estimation given (page 6), the world market for semiconductor products was valued at 17 billion US dollars in 1983, rose to 31 billion dollars in 1987, and was expected to reach 70 billion US dollars in 1992.

Of particular interest in respect of the practice which had emerged from the experience in the United States is a survey of 500 registrations conducted by the Mask Work Department of the Library of Congress, which indicated that in only 6.6% of cases were parts of mask works withheld from publication in order to protect confidential information.

The publication also contains a number of useful annexes, reproducing several major legislative texts on the protection of intellectual property in respect of integrated circuits, the report of the third session of the WIPO Committee of Experts on Intellectual Property in Respect of Integrated Circuits and a bibliography.

In this one, relatively small publication the Henri-Desbois Institute for Research in Intellectual Property has succeeded in bringing together some valuable analytical treatments of the protection in intellectual property in respect of integrated circuits, as well as major source materials.

News Items

DOMINICA

*Attorney-General,
Office of the Attorney-General and Minister
for Legal Affairs, Immigration and Labour*

We have been informed that Mr. Brian G.K. Alleyne has been appointed Attorney-General, Office of the Attorney-General and Minister for Legal Affairs, Immigration and Labour.

FIJI

*Administrator-General,
Administrator-General's Department*

We have been informed that Mr. Aminiasi Katoni-vualiku has been appointed Administrator-General, Administrator-General's Department.

JAPAN

*Director General,
Japanese Patent Office*

We have been informed that Mr. Fumitake Yoshida has been appointed Director General of the Japanese Patent Office.

SYRIA

*Director of Industrial and Commercial Property,
Directorate of Industrial and Commercial Property*

We have been informed that Mr. Riad Mitri has been appointed Director of Industrial and Commercial Property, Directorate of Industrial and Commercial Property.

TUVALU

*Secretary, Commerce and Natural Resources,
Department of Agriculture*

We have been informed that Mr. Saufatu Sopoaga has been appointed Secretary of Commerce and Natural Resources, Department of Agriculture.

ZIMBABWE

*Controller of Patents, Trade Marks
and Industrial Designs*

We have been informed that Mr. Naboth Mvere has been appointed Controller of Patents, Trade Marks and Industrial Designs.

Calendar of Meetings

WIPO Meetings

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

1988

- September 12 to 19 (Geneva)** **IPC (International Patent Classification) Committee of Experts (Seventeenth Session)**
- The Committee will adopt the final amendments, as well as the revised Guide, to the fourth edition of the International Patent Classification (IPC) and decide on the policy for the revision work during the next (sixth) revision period (1989-93).
Invitations: States members of the IPC Union and, as observers, certain organizations.
- September 14 to 16 (Geneva)** **WIPO Worldwide Forum on the Impact of Emerging Technologies on the Law of Intellectual Property**
- The Forum will consider the impact of new technology on intellectual property law, with special emphasis on biotechnology, computer technology, the new technology for the recording of sounds and images, new broadcasting technology (for instance by direct broadcasting satellite) and new technology for transmission of programs by cable.
Invitations: States members of WIPO, the Paris Union or the Berne Union, certain organizations and the general public.
- September 19 to 23 (Geneva)** **Consultative Meeting on the Revision of the Paris Convention (Fifth Session)**
- The meeting will deal with Articles 5A (Patents and Utility Models: Importation of Articles; Failure to Work or Insufficient Working; Compulsory Licenses), *Squater* (Patents: Importation of Products Manufactured by a Process Patented in the Importing Country) and *10quater* (Geographical Indications and Trademarks, etc.), and possibly other Articles on the program of the Diplomatic Conference.
Invitations: Selected governments. No observers.
- September 22 and 23 (Geneva)** **Permanent Committee on Industrial Property Information (PCIPI) (Second Session)**
- The Committee will review the work done on the tasks of the program during the first nine months of 1988. It will start to work on the elaboration of a medium-term program for the PCIPI and of a global policy for, and the orientation of, the work of the PCIPI during the 1990-91 biennium.
Invitations: States and organizations members of the Committee and, as observers, certain other States and organizations.
- September 26 to October 3 (Geneva)** **Governing Bodies of WIPO and of Some of the Unions Administered by WIPO (Nineteenth Series of Meetings)**
- The WIPO General Assembly will consider the establishment of an International Register of Audiovisual Works. The WIPO Coordination Committee and the Executive Committees of the Paris and Berne Unions will, *inter alia*, review and evaluate activities undertaken since July 1987 and prepare the draft agendas of the 1989 ordinary sessions of the WIPO General Assembly and the Assemblies of the Paris and Berne Unions.
Invitations: As members or observers (depending on the body), States members of WIPO, the Paris Union or the Berne Union and, as observers, certain organizations.
- October 24 to 28 (Geneva)** **Committee of Experts on Biotechnological Inventions and Industrial Property (Fourth Session)**
- The Committee will examine possible solutions concerning industrial property protection of biotechnological inventions.
Invitations: States members of WIPO or the United Nations and, as observers, certain organizations.
- November 7 to 22 (Geneva)** **Committee of Experts on Intellectual Property in Respect of Integrated Circuits (Fourth Session)**
- The Committee will examine a revised version of the draft Treaty on the Protection of Intellectual Property in Respect of Integrated Circuits and studies on the specific points identified by developing countries.
Invitations: States members of WIPO or the Paris Union and, as observers, other States members of the Berne Union, as well as intergovernmental and non-governmental organizations.

- November 7 to 22 (Geneva)** **Preparatory Meeting for the Diplomatic Conference on the Adoption of a Treaty on the Protection of Intellectual Property in Respect of Integrated Circuits**
- The Preparatory Meeting will decide what substantive documents should be submitted to the Diplomatic Conference—scheduled to be held in Washington, D.C. in May 1989—and which States and organizations should be invited to the Diplomatic Conference. The Preparatory Meeting will establish draft Rules of Procedure of the Diplomatic Conference.
- Invitations:* States members of WIPO or the Paris Union and, as observers, intergovernmental organizations.
- December 5 to 9 (Geneva)** **Madrid Union: Preparatory Committee for the Diplomatic Conference for the Adoption of Protocols to the Madrid Agreement**
- This Committee will make preparations for the diplomatic conference scheduled for 1989 (establishment of the list of States and organizations to be invited, the draft agenda, the draft rules of procedure, etc.).
- Invitations:* States members of the Madrid Union and Denmark, Greece, Ireland and the United Kingdom.
- December 12 to 16 (Geneva)** **Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions (Fifth Session; Second Part)**
- The Committee will continue to examine a draft treaty on the harmonization of certain provisions in laws for the protection of inventions.
- Invitations:* States members of the Paris Union and, as observers, States members of WIPO not members of the Paris Union and certain organizations.
- December 12 to 16 (Geneva)** **Executive Coordination Committee of the PCIPI (Permanent Committee on Industrial Property Information) (Third Session)**
- The Committee will review the progress made in carrying out tasks of the Permanent Program on Industrial Property Information for the 1988-89 biennium. It will consider the recommendations of the PCIPI Working Groups and review their mandates.
- Invitations:* States and organizations members of the Executive Coordination Committee and, as observers, certain organizations.
- December 19 (Geneva)** **Information Meeting for Non-Governmental Organizations on Intellectual Property**
- Participants in this informal meeting will be informed about the recent activities and future plans of WIPO in the fields of industrial property and copyright and their comments on the same will be invited and heard.
- Invitations:* International non-governmental organizations having observer status with WIPO.
- 1989**
- February 20 to March 3 (Geneva)** **Committee of Experts on Model Provisions for Legislations in the Field of Copyright (First Session)**
- The Committee will work out standards in the field of literary and artistic works for the purposes of national legislation on the basis of the Berne Convention for the Protection of Literary and Artistic Works.
- Invitations:* States members of the Berne Union or WIPO and, as observers, certain organizations.
- April 3 to 7 (Geneva)** **WIPO Permanent Committee for Development Cooperation Related to Copyright and Neighboring Rights (Eighth Session)**
- The Committee will review and evaluate the activities undertaken under the WIPO Permanent Program for Development Cooperation Related to Copyright and Neighboring Rights since the Committee's last session (March 1987) and make recommendations on the future orientation of the said Program.
- Invitations:* States members of the Committee and, as observers, States members of the United Nations not members of the Committee and certain organizations.
- May 1 to 5 (Geneva)** **WIPO Permanent Committee for Development Cooperation Related to Industrial Property (Thirteenth Session)**
- The Committee will review and evaluate the activities undertaken under the WIPO Permanent Program for Development Cooperation Related to Industrial Property since the Committee's last session (May 1988) and make recommendations on the future orientation of the said Program.
- Invitations:* States members of the Committee and, as observers, States members of the United Nations not members of the Committee and certain organizations.
- May 8 to 26 (Washington, D.C.)** **Diplomatic Conference for the Conclusion of a Treaty on the Protection of Intellectual Property in Respect of Integrated Circuits**
- The Diplomatic Conference will negotiate and adopt a Treaty on the protection of layout-designs of integrated circuits. The negotiations will be based on a draft Treaty prepared by the International Bureau. The Treaty is intended to provide for national treatment and to establish certain standards in respect of the protection of layout-designs of integrated circuits.
- Invitations:* States members of WIPO or the Paris Union and, as observers, certain organizations.

UPOV Meetings

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

1988

October 17 (Geneva)

Consultative Committee (Thirty-eighth Session)

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

Invitations: Member States of the Union.

October 18 and 19 (Geneva)

Council (Twenty-second Ordinary Session)

The Council will examine the accounts of the 1986-87 biennium, the reports on the activities of UPOV in 1987 and the first part of 1988 and specify certain details of the work for 1989.

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

Other Meetings Concerned with Industrial Property

1988

September 15 to 18 (Angers)

International League for Competition Law (LIDC): Congress

September 28 to 30 (Stockholm)

Pharmaceutical Trade Marks Group (PTMG): Conference on "A Commission of Enquiry—In Search of a System"

October 4 to 7 (Strasbourg)

Center for the International Study of Industrial Property (CEIPI): Licensing and Technology Transfer Course (second module)

November 7 to 11 (Buenos Aires)

Inter-American Association of Industrial Property (ASIPI): Congress

December 5 and 6 (Ithaca, New York)

Cornell University, Department of Agricultural Economics: Animal Patent Conference (Consideration of Applicable United States and International Law, Technicalities of Deposit Requirements, Status of Animal Science Research into Potentially Patentable Animal Types, Anticipated Impact of Patents on Livestock Breeding Sector and Production Agriculture, and Perspectives of Farmers and Those Concerned About Ethical Issues Involved)

December 5 to 9 (Munich)

European Patent Organisation (EPO): Administrative Council

