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Royal Decree on Applications for Patents, and the Granting and Maintenance of Patents (of December 2, 1986, as amended by the Royal Decree of May 25, 1987) (*Replacement sheets*) Text 2-005

(Continued overleaf)

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DENMARK

- Order Concerning Patents for Inventions of Pharmaceutical Products (No. 450 of September 16, 1983) Text 2-003
- Executive Order Concerning Patents for Inventions of Foodstuffs and Patents for Processes for the Manufacture of Foodstuffs (No. 511 of August 23, 1988) Text 2-004

FINLAND

- Decree Concerning the Grant of Patents for Foodstuffs and Pharmaceuticals (No. 932 of December 4, 1987) Text 2-003

GERMANY, FEDERAL REPUBLIC OF

- Order Concerning the German Patent Office (of September 5, 1968, as last amended by the Order of June 24, 1988) (*This text replaces the one previously published under the same code number*) Text 1-003
- Order Concerning Applications for Utility Models (of November 12, 1986) Text 2-005

LUXEMBOURG

- Law of December 29, 1988, on the Legal Protection of Topographies of Semiconductor Products Text 1-001

SRI LANKA

- Code of Intellectual Property Act (No. 52 of 1979, as amended by the Code of Intellectual Property (Amendment) Act, No. 30 of 1980, and the Code of Intellectual Property (Amendment) Act, No. 2 of 1983) (*Replacement sheets*) Text 1-001

MULTILATERAL TREATIES**World Intellectual Property Organization**

- Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (as signed at Madrid on June 28, 1989) Text 3-007

Notifications Concerning Treaties

Paris Convention

New Member of the Paris Union

LESOTHO

The Government of Lesotho deposited, on June 27, 1989, 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, and amended on October 2, 1979.

Furthermore, the said instrument of accession contains the following declaration:

"Pursuant to Article 28(2) of the said Convention, the Government of the Kingdom of Lesotho declares that it does not consider itself bound by the provisions of paragraph 1 of Article 28 of the said Convention."

Lesotho 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 Lesotho, on September 28, 1989. On that date, Lesotho will become a member of the Paris Union.

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

Paris Notification No. 121, of June 28, 1989.

Madrid Agreement (Marks)

New Member of the Madrid Union

CHINA

The Government of China deposited, on July 4, 1989, its instrument of accession to the Madrid Agreement Concerning the International Registration of Marks of April 14, 1891, as revised at Stockholm on July 14, 1967, and as amended on October 2, 1979.

The said instrument of accession contains the following declarations:

1. Re Article 3*bis*: the protection resulting from the international registration shall extend to China only at the express request of the proprietor of the mark;
2. Re Article 14(2)(d): except in the case of international marks which have already been the subject in China of an earlier identical national registration still in force, and which shall be immediately recognized upon the request of the interested parties, application of this Act shall be limited to marks registered from the date on which this accession enters into force." (*Translation*)

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

The Madrid Agreement, as revised, will enter into force, with respect to China, on October 4, 1989. On that date, China will become a member of the Madrid Union.

Madrid (Marks) Notification No. 41, of July 4, 1989.

Budapest Treaty

Acquisition of the Status of International Depositary Authority

IMET—NATIONALE SAMMLUNG VON
MIKROORGANISMEN

(German Democratic Republic)

The following written communication, addressed to the Director General of WIPO by the Government of the German Democratic Republic under Article 7 of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, was received on April 27, 1989, and is published by the International Bureau of WIPO pursuant to Article 7(2)(a) of the said Treaty:

According to Article 7(1) of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent

Procedure, the German Democratic Republic herewith nominates the IMET—Nationale Sammlung von Mikroorganismen (IMET—National Collection of Microorganisms), associated with the Zentralinstitut für Mikrobiologie und experimentelle Therapie (Central Institute for Microbiology and Experimental Therapy) of the Academy of Sciences of the German Democratic Republic, as an International Depository Authority. The Collection meets and will continue to meet the requirements under Article 6(2) of the Budapest Treaty regarding the activities of an international depository authority.

Name and address of the depository authority:

IMET—Nationale Sammlung von Mikroorganismen
 IMET-Hinterlegungsstelle
 Beutenbergstrasse 11
 6900 Jena
 German Democratic Republic

The IMET-Hinterlegungsstelle is part of the National Collection of Microorganisms existing since 1965. The Collection was registered in 1972 under No. 217 in the World Directory of Culture Collections published by the World Federation for Culture Collections (WFCC). It is a member of the WFCC and of the European Culture Collections' Organization (ECCO). The Collection has been working since November 1979 as the officially acknowledged depository authority of the German Democratic Republic for the purposes of patent procedure. Up to now, 490 strains have been deposited for the purposes of patent procedure.

The Collection has a staff of 16, including six scientists holding a doctor's degree and five qualified technical assistants. All staff members are involved in collecting activities as well as in taxonomic basic research. The strains are preserved in parallel over liquid nitrogen and by freeze-drying (lyophilization). If required, other preservation methods are applied alternatively. The strains preserved by these two methods are kept in separate premises. The strains deposited for the purposes of patent procedure and

the pertinent records are specially provided against unauthorized access.

The IMET-Hinterlegungsstelle accepts strains of bacteria, including actinomycetes and cyanobacteria, fungi, including yeasts, unicellular and filamentous algae, bacterial viruses, plasmids *per se* or included in strains. Strains and materials constituting a danger for man's health or a hazard for the environment, or for the storage or maintenance of which the depository authority is technically not in a position, may be excluded from deposit.

The IMET-Hinterlegungsstelle charges the following fees:

	Marks
1. for the deposit, the issuance of a receipt and the first viability statement, a non-recurring fee of	1,500
2. for every subsequent viability statement	100
3. for furnishing a sample	100

Fees have to be paid in advance together with the application for the respective service.

The official language of the IMET-Hinterlegungsstelle is German. Correspondence may also be in English.

*(Translation by the Government of
 the German Democratic Republic)*
 [End of text of the communication
 of the Government of the German
 Democratic Republic]

Pursuant to Article 7(2)(b) of the Budapest Treaty, the IMET—Nationale Sammlung von Mikroorganismen acquires the status of international depository authority as from August 31, 1989.

Budapest Communication No. 55 (this Communication is the subject of Budapest Notification No. 82, of May 29, 1989).

WIPO Meetings

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

(Madrid, June 12 to 28, 1989)

NOTE*

In 1986, the International Bureau of WIPO started with the preparation of two Protocols relating to the Madrid Agreement Concerning the International Registration of Marks. The aim of one of those Protocols would have been to amend certain provisions of the Madrid Agreement in order to facilitate the accession of new countries to the registration system instituted by the said Agreement, in particular the four member countries of the European Communities not party to the Madrid Agreement (Denmark, Greece, Ireland, United Kingdom). The other Protocol would have been designed to establish links between the Madrid Agreement and the future Community Trade Mark registration system which is under preparation by the European Communities. The drafts of those two Protocols were submitted to a Working Group set up by the Assembly of the Madrid Union and composed of all the member countries of the Madrid Union, the four above-mentioned countries and several intergovernmental and non-governmental organizations. The Working Group met in January 1986, July 1986 and June 1987.¹ In view of the degree of agreement reached at the last session of that Working Group, the Assembly of the Madrid Union decided, in September 1987, the convocation of a diplomatic conference in 1989 and of a preparatory committee to that conference.

The Preparatory Committee for the Diplomatic Conference, which met from December 5 to 7, 1988,² decided that the document to be prepared for the Diplomatic Conference should consist of the draft of a single Protocol, instead of two, and that the said Protocol should be open not only to States but also to any intergovernmental organization maintaining a regional trademark registry. Furthermore, the Preparatory Committee established the list of the States and organi-

zations to be invited to the Diplomatic Conference, as well as the draft Agenda and the draft Rules of Procedure of the Diplomatic Conference. Finally, it decided that the invitation of the Government of Spain to hold the Diplomatic Conference in Madrid should be accepted and that the Diplomatic Conference should be held from June 12 to 28, 1989.

In accordance with the above-mentioned decisions, the Diplomatic Conference for the Conclusion of a Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks was convened and organized by WIPO, at the facilities offered by the Spanish authorities, in Madrid, from June 12 to 28, 1989.

Twenty-four of the 27 member countries of the Madrid Union participated in the Diplomatic Conference with the right to vote; they are the following: Algeria, Austria, Belgium, Bulgaria, Czechoslovakia, Democratic People's Republic of Korea, Egypt, France, German Democratic Republic, Germany (Federal Republic of), Hungary, Italy, Liechtenstein, Luxembourg, Mongolia, Morocco, Netherlands, Portugal, Romania, Soviet Union, Spain, Switzerland, Viet Nam, Yugoslavia. Furthermore, Denmark, Greece, Ireland and the United Kingdom, as well as the European Communities, participated in the Diplomatic Conference with the right to vote. The following countries, members of the Paris Union for the Protection of Industrial Property participated in the Conference in an observer capacity: Argentina, Burundi, Cameroon, China, Côte d'Ivoire, Finland, Japan, Lebanon, Libya, Nigeria, Republic of Korea, Senegal, Sweden, United States of America, Uruguay, Zaire.

The Benelux Trademark Office and 29 non-governmental organizations were represented in an observer capacity. The list of the latter appears below.

The Secretariat of the Diplomatic Conference, led by the Director General of WIPO, was provided by the staff of the International Bureau of WIPO. It was assisted by some 14 persons placed at the disposal of the Conference by the Registry of Industrial Property of Spain.

* Prepared by the International Bureau; a more detailed Note will be published in a future issue.

¹ See *Industrial Property*, 1986, pp. 185 to 195, and pp. 376 to 393; 1987, pp. 396 to 401.

² *Ibid.*, 1989, pp. 100 and 101.

The meetings were held in the building of the *Instituto Nacional de Industrias* in Madrid.

The Conference unanimously elected Mr. Julio Delicado Montero-Ríos (Spain) as President of the Conference. The Main Committee of the Conference was chaired by Mr. Jean-Claude Combaldieu (France), whereas the Drafting Committee was chaired by Mr. Jean-Louis Comte (Switzerland) and the Credentials Committee by Mr. Lev E. Komarov (Soviet Union).

The Director General of WIPO, Dr. Arpad Bogsch, participated in the Conference.

The list of participants and the list of officers appear at the end of this Note.

The Diplomatic Conference adopted, on June 27, 1989, a Protocol consisting of 16 Articles under the title "Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks." The Protocol was opened for signature on June 28, 1989, and signed by the following 19 States: Belgium, Democratic People's Republic of Korea, Denmark, Egypt, France, German Democratic Republic, Germany (Federal Republic of), Hungary, Italy, Liechtenstein, Luxembourg, Mongolia, Morocco, Portugal, Soviet Union, Spain, Switzerland, United Kingdom, Yugoslavia. It will remain open for signature until the end of 1989.

The text of the Protocol is reproduced both hereafter and in the *Industrial Property Laws and Treaties* part of this issue.

Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

(as signed at Madrid on June 28, 1989)

LIST OF THE ARTICLES OF THE PROTOCOL

Article 1:	Membership in the Madrid Union
Article 2:	Securing Protection through International Registration
Article 3:	International Application
Article 3bis:	Territorial Effect
Article 3ter:	Request for "Territorial Extension"
Article 4:	Effects of International Registration
Article 4bis:	Replacement of a National or Regional Registration by an International Registration
Article 5:	Refusal and Invalidation of Effects of International Registration in Respect of Certain Contracting Parties
Article 5bis:	Documentary Evidence of Legitimacy of Use of Certain Elements of the Mark
Article 5ter:	Copies of Entries in International Register; Searches for Anticipations; Extracts from International Register
Article 6:	Period of Validity of International Registration; Dependence and Independence of International Registration

Article 7:	Renewal of International Registration
Article 8:	Fees for International Application and Registration
Article 9:	Recordal of Change in the Ownership of an International Registration
Article 9bis:	Recordal of Certain Matters Concerning an International Registration
Article 9ter:	Fees for Certain Recordals
Article 9quater:	Common Office of Several Contracting States
Article 9quinquies:	Transformation of an International Registration into National or Regional Applications
Article 9sexies:	Safeguard of the Madrid (Stockholm) Agreement
Article 10:	Assembly
Article 11:	International Bureau
Article 12:	Finances
Article 13:	Amendment of Certain Articles of the Protocol
Article 14:	Becoming Party to the Protocol; Entry into Force
Article 15:	Denunciation
Article 16:	Signature; Languages; Depositary Functions

Article 1 Membership in the Madrid Union

The States party to this Protocol (hereinafter referred to as "the Contracting States"), even where they are not party to the Madrid Agreement Concerning the International Registration of Marks as revised at Stockholm in 1967 and as amended in 1979 (hereinafter referred to as "the Madrid (Stockholm) Agreement"), and the organizations referred to in Article 14(1)(b) which are party to this Protocol (hereinafter referred to as "the Contracting Organizations") shall be members of the same Union of which countries party to the Madrid (Stockholm) Agreement are members. Any reference in this Protocol to "Contracting Parties" shall be construed as a reference to both Contracting States and Contracting Organizations.

Article 2 Securing Protection Through International Registration

(1) Where an application for the registration of a mark has been filed with the Office of a Contracting Party, or where a mark has been registered in the register of the Office of a Contracting Party, the person in whose name that application (hereinafter referred to as "the basic application") or that registration (hereinafter referred to as "the basic registration") stands may, subject to the provisions of this Protocol, secure protection for his mark in the territory of the Contracting Parties, by obtaining the registration of that mark in the register of the International Bureau of the

World Intellectual Property Organization (hereinafter referred to as "the international registration," "the International Register," "the International Bureau" and "the Organization," respectively), provided that,

- (i) where the basic application has been filed with the Office of a Contracting State or where the basic registration has been made by such an Office, the person in whose name that application or registration stands is a national of that Contracting State, or is domiciled, or has a real and effective industrial or commercial establishment, in the said Contracting State,
- (ii) where the basic application has been filed with the Office of a Contracting Organization or where the basic registration has been made by such an Office, the person in whose name that application or registration stands is a national of a State member of that Contracting Organization, or is domiciled, or has a real and effective industrial or commercial establishment, in the territory of the said Contracting Organization.

(2) The application for international registration (hereinafter referred to as "the international application") shall be filed with the International Bureau through the intermediary of the Office with which the basic application was filed or by which the basic registration was made (hereinafter referred to as "the Office of origin"), as the case may be.

(3) Any reference in this Protocol to an "Office" or an "Office of a Contracting Party" shall be construed as a reference to the office that is in charge, on behalf of a Contracting Party, of the registration of marks, and any reference in this Protocol to "marks" shall be construed as a reference to trademarks and service marks.

(4) For the purposes of this Protocol, "territory of a Contracting Party" means, where the Contracting Party is a State, the territory of that State and, where the Contracting Party is an intergovernmental organization, the territory in which the constituting treaty of that intergovernmental organization applies.

Article 3 **International Application**

(1) Every international application under this Protocol shall be presented on the form prescribed by the Regulations. The Office of origin shall certify that the particulars appearing in the international application correspond to the particulars appearing, at the time of the certification, in the basic application or basic registration, as the case may be. Furthermore, the said Office shall indicate,

- (i) in the case of a basic application, the date and number of that application,
- (ii) in the case of a basic registration, the date and number of that registration as well as the date

and number of the application from which the basic registration resulted.

The Office of origin shall also indicate the date of the international application.

(2) The applicant must indicate the goods and services in respect of which protection of the mark is claimed and also, if possible, the corresponding class or classes according to the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks. If the applicant does not give such indication, the International Bureau shall classify the goods and services in the appropriate classes of the said classification. The indication of classes given by the applicant shall be subject to control by the International Bureau, which shall exercise the said control in association with the Office of origin. In the event of disagreement between the said Office and the International Bureau, the opinion of the latter shall prevail.

(3) If the applicant claims color as a distinctive feature of his mark, he shall be required

- (i) to state the fact, and to file with his international application a notice specifying the color or the combination of colors claimed;
- (ii) to append to his international application copies in color of the said mark, which shall be attached to the notifications given by the International Bureau; the number of such copies shall be fixed by the Regulations.

(4) The International Bureau shall register immediately the marks filed in accordance with Article 2. The international registration shall bear the date on which the international application was received in the Office of origin, provided that the international application has been received by the International Bureau within a period of two months from that date. If the international application has not been received within that period, the international registration shall bear the date on which the said international application was received by the International Bureau. The International Bureau shall notify the international registration without delay to the Offices concerned. Marks registered in the International Register shall be published in a periodical gazette issued by the International Bureau, on the basis of the particulars contained in the international application.

(5) With a view to the publicity to be given to marks registered in the International Register, each Office shall receive from the International Bureau a number of copies of the said gazette free of charge and a number of copies at a reduced price, under the conditions fixed by the Assembly referred to in Article 10 (hereinafter referred to as "the Assembly"). Such publicity shall be deemed to be sufficient for the purposes of all the Contracting Parties, and no other publicity may be required of the holder of the international registration.

Article 3bis
Territorial Effect

The protection resulting from the international registration shall extend to any Contracting Party only at the request of the person who files the international application or who is the holder of the international registration. However, no such request can be made with respect to the Contracting Party whose Office is the Office of origin.

Article 3ter
Request for "Territorial Extension"

(1) Any request for extension of the protection resulting from the international registration to any Contracting Party shall be specially mentioned in the international application.

(2) A request for territorial extension may also be made subsequently to the international registration. Any such request shall be presented on the form prescribed by the Regulations. It shall be immediately recorded by the International Bureau, which shall notify such recordal without delay to the Office or Offices concerned. Such recordal shall be published in the periodical gazette of the International Bureau. Such territorial extension shall be effective from the date on which it has been recorded in the International Register; it shall cease to be valid on the expiry of the international registration to which it relates.

Article 4
Effects of International Registration

(1)(a) From the date of the registration or recordal effected in accordance with the provisions of Articles 3 and 3ter, the protection of the mark in each of the Contracting Parties concerned shall be the same as if the mark had been deposited direct with the Office of that Contracting Party. If no refusal has been notified to the International Bureau in accordance with Article 5(1) and (2) or if a refusal notified in accordance with the said Article has been withdrawn subsequently, the protection of the mark in the Contracting Party concerned shall, as from the said date, be the same as if the mark had been registered by the Office of that Contracting Party.

(b) The indication of classes of goods and services provided for in Article 3 shall not bind the Contracting Parties with regard to the determination of the scope of the protection of the mark.

(2) Every international registration shall enjoy the right of priority provided for by Article 4 of the Paris Convention for the Protection of Industrial Property, without it being necessary to comply with the formalities prescribed in Section D of that Article.

Article 4bis
**Replacement of a National or Regional
Registration by an International Registration**

(1) Where a mark that is the subject of a national or regional registration in the Office of a Contracting Party is also the subject of an international registration and both registrations stand in the name of the same person, the international registration is deemed to replace the national or regional registration, without prejudice to any rights acquired by virtue of the latter, provided that

- (i) the protection resulting from the international registration extends to the said Contracting Party under Article 3ter(1) or (2),
- (ii) all the goods and services listed in the national or regional registration are also listed in the international registration in respect of the said Contracting Party,
- (iii) such extension takes effect after the date of the national or regional registration.

(2) The Office referred to in paragraph (1) shall, upon request, be required to take note in its register of the international registration.

Article 5
**Refusal and Invalidation of Effects of
International Registration in Respect of
Certain Contracting Parties**

(1) Where the applicable legislation so authorizes, any Office of a Contracting Party which has been notified by the International Bureau of an extension to that Contracting Party, under Article 3ter(1) or (2), of the protection resulting from the international registration shall have the right to declare in a notification of refusal that protection cannot be granted in the said Contracting Party to the mark which is the subject of such extension. Any such refusal can be based only on the grounds which would apply, under the Paris Convention for the Protection of Industrial Property, in the case of a mark deposited direct with the Office which notifies the refusal. However, protection may not be refused, even partially, by reason only that the applicable legislation would permit registration only in a limited number of classes or for a limited number of goods or services.

(2)(a) Any Office wishing to exercise such right shall notify its refusal to the International Bureau, together with a statement of all grounds, within the period prescribed by the law applicable to that Office and at the latest, subject to subparagraphs (b) and (c), before the expiry of one year from the date on which the notification of the extension referred to in paragraph (1) has been sent to that Office by the International Bureau.

(b) Notwithstanding subparagraph (a), any Contracting Party may declare that, for international regis-

trations made under this Protocol, the time limit of one year referred to in subparagraph (a) is replaced by 18 months.

(c) Such declaration may also specify that, when a refusal of protection may result from an opposition to the granting of protection, such refusal may be notified by the Office of the said Contracting Party to the International Bureau after the expiry of the 18-month time limit. Such an Office may, with respect to any given international registration, notify a refusal of protection after the expiry of the 18-month time limit, but only if

- (i) it has, before the expiry of the 18-month time limit, informed the International Bureau of the possibility that oppositions may be filed after the expiry of the 18-month time limit, and
- (ii) the notification of the refusal based on an opposition is made within a time limit of not more than seven months from the date on which the opposition period begins; if the opposition period expires before this time limit of seven months, the notification must be made within a time limit of one month from the expiry of the opposition period.

(d) Any declaration under subparagraphs (b) or (c) may be made in the instruments referred to in Article 14(2), and the effective date of the declaration shall be the same as the date of entry into force of this Protocol with respect to the State or intergovernmental organization having made the declaration. Any such declaration may also be made later, in which case the declaration shall have effect three months after its receipt by the Director General of the Organization (hereinafter referred to as "the Director General"), or at any later date indicated in the declaration, in respect of any international registration whose date is the same as or is later than the effective date of the declaration.

(e) Upon the expiry of a period of ten years from the entry into force of this Protocol, the Assembly shall examine the operation of the system established by subparagraphs (a) to (d). Thereafter, the provisions of the said subparagraphs may be modified by a unanimous decision of the Assembly.

(3) The International Bureau shall, without delay, transmit one of the copies of the notification of refusal to the holder of the international registration. The said holder shall have the same remedies as if the mark had been deposited by him direct with the Office which has notified its refusal. Where the International Bureau has received information under paragraph (2)(c)(i), it shall, without delay, transmit the said information to the holder of the international registration.

(4) The grounds for refusing a mark shall be communicated by the International Bureau to any interested party who may so request.

(5) Any Office which has not notified, with respect to a given international registration, any provisional or final refusal to the International Bureau in accordance

with paragraphs (1) and (2) shall, with respect to that international registration, lose the benefit of the right provided for in paragraph (1).

(6) Invalidation, by the competent authorities of a Contracting Party, of the effects, in the territory of that Contracting Party, of an international registration may not be pronounced without the holder of such international registration having, in good time, been afforded the opportunity of defending his rights. Invalidation shall be notified to the International Bureau.

Article 5bis

Documentary Evidence of Legitimacy of Use of Certain Elements of the Mark

Documentary evidence of the legitimacy of the use of certain elements incorporated in a mark, such as armorial bearings, escutcheons, portraits, honorary distinctions, titles, trade names, names of persons other than the name of the applicant, or other like inscriptions, which might be required by the Offices of the Contracting Parties shall be exempt from any legalization as well as from any certification other than that of the Office of origin.

Article 5ter

Copies of Entries in International Register; Searches for Anticipations; Extracts from International Register ,

(1) The International Bureau shall issue to any person applying therefor, upon the payment of a fee fixed by the Regulations, a copy of the entries in the International Register concerning a specific mark.

(2) The International Bureau may also, upon payment, undertake searches for anticipations among marks that are the subject of international registrations.

(3) Extracts from the International Register requested with a view to their production in one of the Contracting Parties shall be exempt from any legalization.

Article 6

Period of Validity of International Registration; Dependence and Independence of International Registration

(1) Registration of a mark at the International Bureau is effected for ten years, with the possibility of renewal under the conditions specified in Article 7.

(2) Upon expiry of a period of five years from the date of the international registration, such registration shall become independent of the basic application or the registration resulting therefrom, or of the basic regis-

tration, as the case may be, subject to the following provisions.

(3) The protection resulting from the international registration, whether or not it has been the subject of a transfer, may no longer be invoked if, before the expiry of five years from the date of the international registration, the basic application or the registration resulting therefrom, or the basic registration, as the case may be, has been withdrawn, has lapsed, has been renounced or has been the subject of a final decision of rejection, revocation, cancellation or invalidation, in respect of all or some of the goods and services listed in the international registration. The same applies if

- (i) an appeal against a decision refusing the effects of the basic application,
- (ii) an action requesting the withdrawal of the basic application or the revocation, cancellation or invalidation of the registration resulting from the basic application or of the basic registration, or
- (iii) an opposition to the basic application

results, after the expiry of the five-year period, in a final decision of rejection, revocation, cancellation or invalidation, or ordering the withdrawal, of the basic application, or the registration resulting therefrom, or the basic registration, as the case may be, provided that such appeal, action or opposition had begun before the expiry of the said period. The same also applies if the basic application is withdrawn, or the registration resulting from the basic application or the basic registration is renounced, after the expiry of the five-year period, provided that, at the time of the withdrawal or renunciation, the said application or registration was the subject of a proceeding referred to in item (i), (ii) or (iii) and that such proceeding had begun before the expiry of the said period.

(4) The Office of origin shall, as prescribed in the Regulations, notify the International Bureau of the facts and decisions relevant under paragraph (3), and the International Bureau shall, as prescribed in the Regulations, notify the interested parties and effect any publication accordingly. The Office of origin shall, where applicable, request the International Bureau to cancel, to the extent applicable, the international registration, and the International Bureau shall proceed accordingly.

Article 7

Renewal of International Registration

(1) Any international registration may be renewed for a period of ten years from the expiry of the preceding period, by the mere payment of the basic fee and, subject to Article 8(7), of the supplementary and complementary fees provided for in Article 8(2).

(2) Renewal may not bring about any change in the international registration in its latest form.

(3) Six months before the expiry of the term of protection, the International Bureau shall, by sending an unofficial notice, remind the holder of the international registration and his representative, if any, of the exact date of expiry.

(4) Subject to the payment of a surcharge fixed by the Regulations, a period of grace of six months shall be allowed for renewal of the international registration.

Article 8

Fees for International Application and Registration

(1) The Office of origin may fix, at its own discretion, and collect, for its own benefit, a fee which it may require from the applicant for international registration or from the holder of the international registration in connection with the filing of the international application or the renewal of the international registration.

(2) Registration of a mark at the International Bureau shall be subject to the advance payment of an international fee which shall, subject to the provisions of paragraph (7)(a), include,

- (i) a basic fee;
- (ii) a supplementary fee for each class of the International Classification, beyond three, into which the goods or services to which the mark is applied will fall;
- (iii) a complementary fee for any request for extension of protection under Article 3ter.

(3) However, the supplementary fee specified in paragraph (2)(ii) may, without prejudice to the date of the international registration, be paid within the period fixed by the Regulations if the number of classes of goods or services has been fixed or disputed by the International Bureau. If, upon expiry of the said period, the supplementary fee has not been paid or the list of goods or services has not been reduced to the required extent by the applicant, the international application shall be deemed to have been abandoned.

(4) The annual product of the various receipts from international registration, with the exception of the receipts derived from the fees mentioned in paragraph (2)(ii) and (iii), shall be divided equally among the Contracting Parties by the International Bureau, after deduction of the expenses and charges necessitated by the implementation of this Protocol.

(5) The amounts derived from the supplementary fees provided for in paragraph (2)(ii) shall be divided, at the expiry of each year, among the interested Contracting Parties in proportion to the number of marks for which protection has been applied for in each of them during that year, this number being multiplied, in the case of Contracting Parties which make an exam-

ination, by a coefficient which shall be determined by the Regulations.

(6) The amounts derived from the complementary fees provided for in paragraph (2)(iii) shall be divided according to the same rules as those provided for in paragraph (5).

(7)(a) Any Contracting Party may declare that, in connection with each international registration in which it is mentioned under Article 3ter, and in connection with the renewal of any such international registration, it wants to receive, instead of a share in the revenue produced by the supplementary and complementary fees, a fee (hereinafter referred to as "the individual fee") whose amount shall be indicated in the declaration, and can be changed in further declarations, but may not be higher than the equivalent of the amount which the said Contracting Party's Office would be entitled to receive from an applicant for a ten-year registration, or from the holder of a registration for a ten-year renewal of that registration, of the mark in the register of the said Office, the said amount being diminished by the savings resulting from the international procedure. Where such an individual fee is payable,

- (i) no supplementary fees referred to in paragraph (2)(ii) shall be payable if only Contracting Parties which have made a declaration under this subparagraph are mentioned under Article 3ter, and
- (ii) no complementary fee referred to in paragraph (2)(iii) shall be payable in respect of any Contracting Party which has made a declaration under this subparagraph.

(b) Any declaration under subparagraph (a) may be made in the instruments referred to in Article 14(2), and the effective date of the declaration shall be the same as the date of entry into force of this Protocol with respect to the State or intergovernmental organization having made the declaration. Any such declaration may also be made later, in which case the declaration shall have effect three months after its receipt by the Director General, or at any later date indicated in the declaration, in respect of any international registration whose date is the same as or is later than the effective date of the declaration.

Article 9

Recordal of Change in the Ownership of an International Registration

At the request of the person in whose name the international registration stands, or at the request of an interested Office made *ex officio* or at the request of an interested person, the International Bureau shall record in the International Register any change in the ownership of that registration, in respect of all or some of the Contracting Parties in whose territories the said registration has effect and in respect of all or some of the

goods and services listed in the registration, provided that the new holder is a person who, under Article 2(1), is entitled to file international applications.

Article 9bis

Recordal of Certain Matters Concerning an International Registration

The International Bureau shall record in the International Register

- (i) any change in the name or address of the holder of the international registration,
- (ii) the appointment of a representative of the holder of the international registration and any other relevant fact concerning such representative,
- (iii) any limitation, in respect of all or some of the Contracting Parties, of the goods and services listed in the international registration,
- (iv) any renunciation, cancellation or invalidation of the international registration in respect of all or some of the Contracting Parties,
- (v) any other relevant fact, identified in the Regulations, concerning the rights in a mark that is the subject of an international registration.

Article 9ter

Fees for Certain Recordals

Any recordal under Article 9 or under Article 9bis may be subject to the payment of a fee.

Article 9quater

Common Office of Several Contracting States

(1) If several Contracting States agree to effect the unification of their domestic legislations on marks, they may notify the Director General

- (i) that a common Office shall be substituted for the national Office of each of them, and
- (ii) that the whole of their respective territories shall be deemed to be a single State for the purposes of the application of all or part of the provisions preceding this Article as well as the provisions of Articles 9quinquies and 9sexies.

(2) Such notification shall not take effect until three months after the date of the communication thereof by the Director General to the other Contracting Parties.

Article 9quinquies

Transformation of an International Registration into National or Regional Applications

Where, in the event that the international registration is cancelled at the request of the Office of origin

under Article 6(4), in respect of all or some of the goods and services listed in the said registration, the person who was the holder of the international registration files an application for the registration of the same mark with the Office of any of the Contracting Parties in the territory of which the international registration had effect, that application shall be treated as if it had been filed on the date of the international registration according to Article 3(4) or on the date of recordal of the territorial extension according to Article 3ter(2) and, if the international registration enjoyed priority, shall enjoy the same priority, provided that

- (i) such application is filed within three months from the date on which the international registration was cancelled,
- (ii) the goods and services listed in the application are in fact covered by the list of goods and services contained in the international registration in respect of the Contracting Party concerned, and
- (iii) such application complies with all the requirements of the applicable law, including the requirements concerning fees.

Article 9sexies

Safeguard of the Madrid (Stockholm) Agreement

(1) Where, with regard to a given international application or a given international registration, the Office of origin is the Office of a State that is party to both this Protocol and the Madrid (Stockholm) Agreement, the provisions of this Protocol shall have no effect in the territory of any other State that is also party to both this Protocol and the Madrid (Stockholm) Agreement.

(2) The Assembly may, by a three-fourths majority, repeal paragraph (1), or restrict the scope of paragraph (1), after the expiry of a period of ten years from the entry into force of this Protocol, but not before the expiry of a period of five years from the date on which the majority of the countries party to the Madrid (Stockholm) Agreement have become party to this Protocol. In the vote of the Assembly, only those States which are party to both the said Agreement and this Protocol shall have the right to participate.

Article 10 Assembly

(1)(a) The Contracting Parties shall be members of the same Assembly as the countries party to the Madrid (Stockholm) Agreement.

(b) Each Contracting Party shall be represented in that Assembly by one delegate, who may be assisted by alternate delegates, advisors, and experts.

(c) The expenses of each delegation shall be borne by the Contracting Party which has appointed it, except for the travel expenses and the subsistence allowance of one delegate for each Contracting Party, which shall be paid from the funds of the Union.

(2) The Assembly shall, in addition to the functions which it has under the Madrid (Stockholm) Agreement, also

- (i) deal with all matters concerning the implementation of this Protocol;
- (ii) give directions to the International Bureau concerning the preparation for conferences of revision of this Protocol, due account being taken of any comments made by those countries of the Union which are not party to this Protocol;
- (iii) adopt and modify the provisions of the Regulations concerning the implementation of this Protocol;
- (iv) perform such other functions as are appropriate under this Protocol.

(3)(a) Each Contracting Party shall have one vote in the Assembly. On matters concerning only countries that are party to the Madrid (Stockholm) Agreement, Contracting Parties that are not party to the said Agreement shall not have the right to vote, whereas, on matters concerning only Contracting Parties, only the latter shall have the right to vote.

(b) One-half of the members of the Assembly which have the right to vote on a given matter shall constitute the quorum for the purposes of the vote on that matter.

(c) Notwithstanding the provisions of subparagraph (b), if, in any session, the number of the members of the Assembly having the right to vote on a given matter which are represented is less than one-half but equal to or more than one-third of the members of the Assembly having the right to vote on that matter, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the members of the Assembly having the right to vote on the said matter which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiry of this period, the number of such members having thus expressed their vote or abstention attains the number of the members which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

(d) Subject to the provisions of Articles 5(2)(e), 9sexies(2), 12 and 13(2), the decisions of the Assembly shall require two-thirds of the votes cast.

(e) Abstentions shall not be considered as votes.

(f) A delegate may represent, and vote in the name of, one member of the Assembly only.

(4) In addition to meeting in ordinary sessions and extraordinary sessions as provided for by the Madrid (Stockholm) Agreement, the Assembly shall meet in extraordinary session upon convocation by the Director General, at the request of one-fourth of the members of the Assembly having the right to vote on the matters proposed to be included in the agenda of the session. The agenda of such an extraordinary session shall be prepared by the Director General.

Article 11 **International Bureau**

(1) International registration and related duties, as well as all other administrative tasks, under or concerning this Protocol, shall be performed by the International Bureau.

(2)(a) The International Bureau shall, in accordance with the directions of the Assembly, make the preparations for the conferences of revision of this Protocol.

(b) The International Bureau may consult with intergovernmental and international non-governmental organizations concerning preparations for such conferences of revision.

(c) The Director General and persons designated by him shall take part, without the right to vote, in the discussions at such conferences of revision.

(3) The International Bureau shall carry out any other tasks assigned to it in relation to this Protocol.

Article 12 **Finances**

As far as Contracting Parties are concerned, the finances of the Union shall be governed by the same provisions as those contained in Article 12 of the Madrid (Stockholm) Agreement, provided that any reference to Article 8 of the said Agreement shall be deemed to be a reference to Article 8 of this Protocol. Furthermore, for the purposes of Article 12(6)(b) of the said Agreement, Contracting Organizations shall, subject to a unanimous decision to the contrary by the Assembly, be considered to belong to contribution class I (one) under the Paris Convention for the Protection of Industrial Property.

Article 13 **Amendment of Certain Articles of the Protocol**

(1) Proposals for the amendment of Articles 10, 11, 12, and the present Article, may be initiated by any Contracting Party, or by the Director General. Such proposals shall be communicated by the Director

General to the Contracting Parties at least six months in advance of their consideration by the Assembly.

(2) Amendments to the Articles referred to in paragraph (1) shall be adopted by the Assembly. Adoption shall require three-fourths of the votes cast, provided that any amendment to Article 10, and to the present paragraph, shall require four-fifths of the votes cast.

(3) Any amendment to the Articles referred to in paragraph (1) shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of those States and intergovernmental organizations which, at the time the amendment was adopted, were members of the Assembly and had the right to vote on the amendment. Any amendment to the said Articles thus accepted shall bind all the States and intergovernmental organizations which are Contracting Parties at the time the amendment enters into force, or which become Contracting Parties at a subsequent date.

Article 14 **Becoming Party to the Protocol; Entry into Force**

(1)(a) Any State that is a party to the Paris Convention for the Protection of Industrial Property may become party to this Protocol.

(b) Furthermore, any intergovernmental organization may also become party to this Protocol where the following conditions are fulfilled:

- (i) at least one of the member States of that organization is a party to the Paris Convention for the Protection of Industrial Property;
- (ii) that organization has a regional Office for the purposes of registering marks with effect in the territory of the organization, provided that such Office is not the subject of a notification under Article 9^{quater}.

(2) Any State or organization referred to in paragraph (1) may sign this Protocol. Any such State or organization may, if it has signed this Protocol, deposit an instrument of ratification, acceptance or approval of this Protocol or, if it has not signed this Protocol, deposit an instrument of accession to this Protocol.

(3) The instruments referred to in paragraph (2) shall be deposited with the Director General.

(4)(a) This Protocol shall enter into force three months after four instruments of ratification, acceptance, approval or accession have been deposited, provided that at least one of those instruments has been deposited by a country party to the Madrid (Stockholm) Agreement and at least one other of those instruments has been deposited by a State not party to the Madrid (Stockholm) Agreement or by any of the organizations referred to in paragraph (1)(b).

(b) With respect to any other State or organization referred to in paragraph (1), this Protocol shall enter into force three months after the date on which its ratification, acceptance, approval or accession has been notified by the Director General.

(5) Any State or organization referred to in paragraph (1) may, when depositing its instrument of ratification, acceptance or approval of, or accession to, this Protocol, declare that the protection resulting from any international registration effected under this Protocol before the date of entry into force of this Protocol with respect to it cannot be extended to it.

Article 15 Denunciation

(1) This Protocol shall remain in force without limitation as to time.

(2) Any Contracting Party may denounce this Protocol by notification addressed to the Director General.

(3) Denunciation shall take effect one year after the day on which the Director General has received the notification.

(4) The right of denunciation provided for by this Article shall not be exercised by any Contracting Party before the expiry of five years from the date upon which this Protocol entered into force with respect to that Contracting Party.

(5)(a) Where a mark is the subject of an international registration having effect in the denouncing State or intergovernmental organization at the date on which the denunciation becomes effective, the holder of such registration may file an application for the registration of the same mark with the Office of the denouncing State or intergovernmental organization, which shall be treated as if it had been filed on the date of the international registration according to Article 3(4) or on the date of recordal of the territorial extension according to Article 3ter(2) and, if the international registration enjoyed priority, enjoy the same priority, provided that

- (i) such application is filed within two years from the date on which the denunciation became effective,
- (ii) the goods and services listed in the application are in fact covered by the list of goods and services contained in the international registration in respect of the denouncing State or intergovernmental organization, and
- (iii) such application complies with all the requirements of the applicable law, including the requirements concerning fees.

(b) The provisions of subparagraph (a) shall also apply in respect of any mark that is the subject of an

international registration having effect in Contracting Parties other than the denouncing State or intergovernmental organization at the date on which denunciation becomes effective and whose holder, because of the denunciation, is no longer entitled to file international applications under Article 2(1).

Article 16 Signature; Languages; Depositary Functions

(1)(a) This Protocol shall be signed in a single copy in the English, French and Spanish languages, and shall be deposited with the Director General when it ceases to be open for signature at Madrid. The texts in the three languages shall be equally authentic.

(b) Official texts of this Protocol shall be established by the Director General, after consultation with the interested governments and organizations, in the Arabic, Chinese, German, Italian, Japanese, Portuguese and Russian languages, and in such other languages as the Assembly may designate.

(2) This Protocol shall remain open for signature at Madrid until December 31, 1989.

(3) The Director General shall transmit two copies, certified by the Government of Spain, of the signed texts of this Protocol to all States and intergovernmental organizations that may become party to this Protocol.

(4) The Director General shall register this Protocol with the Secretariat of the United Nations.

(5) The Director General shall notify all States and international organizations that may become or are party to this Protocol of signatures, deposits of instruments of ratification, acceptance, approval or accession, the entry into force of this Protocol and any amendment thereto, any notification of denunciation and any declaration provided for in this Protocol.

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Alternate Head of the Delegation

R. Luoma, Commercial Counsellor, Ministry of Trade and Industry

Delegate

S.-L. Lahtinen, Head of Department, National Board of Patents and Registration

Alternate Delegate

J. Turtola, Assistant Commercial Attaché, Embassy of Finland, Madrid

JAPAN

Delegates

T. Miyamoto, First Secretary, Embassy of Japan, Madrid
S. Takakura, First Secretary, Permanent Mission, Geneva

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Delegate

G. Ayoub, Conseiller, Ambassade du Liban, Madrid

LIBYA

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NIGERIA

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E.O. Jegede, Registrar of Trade Marks, Patents and Designs, Federal Ministry of Trade

REPUBLIC OF KOREA

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S.D. Ahn, Counsellor, Embassy of the Republic of Korea, Madrid

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Delegate

A.M. Dieng, Chef de service de la propriété industrielle et de la technologie, Ministère du développement industriel et de l'artisanat

SWEDEN

Head of the Delegation

S. Niklasson, Director-General, Royal Patent and Registration Office

Alternate Heads of the Delegation

K. Sundström, Head, Trademark Department, Royal Patent and Registration Office

A. Morner, Legal Adviser, Ministry of Justice

Adviser

H.O.J. Regner, Secretary to the Standing Committee on Civil Law Legislation, The Swedish Parliament (the Riksdag)

UNITED STATES OF AMERICA

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R.G. Bowie, Attorney-Adviser, Office of Legislation and International Affairs, Patent and Trademark Office, Department of Commerce

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T. Bate Tangale, Ambassadeur, Ambassade du Zaïre, Madrid

Alternate Head of the Delegation

D. Mbala, Premier Conseiller d'ambassade, Ambassade du Zaïre, Madrid

III. Intergovernmental Organization*Benelux Trademark Office (BBM)*

M. Engels, Président de l'Office néerlandais des brevets et Président du Conseil d'administration du Bureau Benelux des marques

L.J.M. van Bauwel, Directeur, Bureau Benelux des marques

IV. International Non-Governmental Organizations

Association française des praticiens du droit des marques et des modèles, France (APRAM): J. Charrière (Vice-président; Juriste, Responsable du département de la propriété industrielle, Société Roussel Uclaf, Paris)

Benelux Association of Trade Mark and Design Agents (BMM): F. Gevers (Ancien président)

Bundesverband der Deutschen Industrie e.V., Federal Republic of Germany (BDI): W. Boekel (Patent Department, Siemens AG, Erlangen); F. Winter (Patent Department, BASF AG, Ludwigshafen)

Centre for the International Study of Industrial Property (CEIPI): B. de Passemar (Chargé de mission auprès de la Direction générale)

Chambre des spécialistes en marques et modèles, France (CSMM): A. Armengaud (Conseil en brevets d'invention, Paris); H. Thireau (Conseil en marques, dessins et modèles, Paris)

Chartered Institute of Patent Agents, United Kingdom (CIPA): T.L. Johnson (Patent Agent, London); B. Fisher (Past President; Patent Agent, London)

Colegio Oficial de Agentes de la Propiedad Industrial, Spain (COAPI): V. Gil Vega (Presidente); M.A. Baz (Abogado de Patentes, Madrid); A. Elizaburu (Abogado de Patentes, Madrid)

Committee of National Institutes of Patent Agents (CNIPA): N. Alber (Patent Attorney, Munich); A. Hansmann (Patent Attorney, Munich); H.-J. Mueller (Patent Attorney, Munich); T.L. Johnson (Patent Agent, London)

De Danske Patentagenter Forening (DPAA): F. Nielsen (Patent Attorney, Advocate, Tastrup)

Deutsche Vereinigung für gewerblichen Rechtsschutz und Urheberrecht, Federal Republic of Germany (DVGR): F. Winter (Patent Department, BASF AG, Ludwigshafen); W. Boekel (Patent Department, Siemens AG, Erlangen)

European Association of Industries of Branded Products (AIM): G. Kunze (Vice-President, Société des Produits Nestlé S.A., Vevey)

European Communities Trade Mark Practitioners' Association (ECTA): F. Gevers (Secrétaire-général); D. Bandin (Membre du Conseil; Unilever, Espagne, S.A., Madrid); A. Elizaburu (Miembro del Consejo; Abogado de Patentes, Madrid)

European Federation of Pharmaceutical Industries' Associations (EFPIA): P. Bocken (Trademark Attorney, Smith Kline and French Laboratories, Genval-Rixensart); P. Leardini (Conseiller juridique, Bruxelles)

Federal Chamber of Patent Attorneys, Federal Republic of Germany (FCPA): N. Alber (Patent Attorney, Munich); A. Hansmann (Patent Attorney, Munich); H.-J. Mueller (Patent Attorney, Munich)

Institute of Trade Mark Agents, United Kingdom (ITMA): D.G. Turner (President); J.A. Groom (Trademark Agent, Croydon); T.L. Johnson (Patent Agent, London)

International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP): A. Bercovitz (Profesor, Departamento de Derecho Mercantil, Universidad a Distancia, Madrid); E. Galan (Profesor, Departamento de Derecho Mercantil, Facultad de Derecho, Universidad de Salamanca)

International Association for the Protection of Industrial Property (AIPPI): R. Harle (Membre d'honneur; Conseil en brevets d'invention, Paris)

International Chamber of Commerce (ICC): F. Pombo (Abogado, Madrid)

International Federation of Industrial Property Attorneys (FICPI): B. Fisher (President); H. Sonn (Vice President, Patent Attorney, Vienna); T.L. Johnson (Patent Agent, London); A. de Sampaio

(Patent Agent, Lisbon); A. Hansmann (Patent Attorney, Munich)

International League for Competition Law (LIDC): G. Ulloa (Abogado, Madrid)

Istituto Nazionale per la Difesa, Identificazione e la Certificazione dei Marchi Autentici, Italy (INDICAM): L. Bordoni (Managing Director); G. Jacobacci (Vice-President)

Max Planck Institute for Foreign and International Patent, Copyright and Competition Law (MPI): H.P. Kunz-Hallstein (Senior Research Fellow)

Pharmaceutical Trade Marks Group, United Kingdom (PTMG): A. Cox (Assistant Trade Marks Manager, Wellcome Foundation, Ltd., London); D.T. Rossitter (Honorary President)

The United States Trademark Association (USTA): R.A. Rolfe (Executive Director); J. Lauber (Chairman, International Advisory Group); Y. Chicoine (International Manager); R. Kareken (Immediate Past President; Assistant General Counsel, Eastman Kodak Company, New York)

Trade Marks, Patents and Design Federation, United Kingdom (TMPDF): D.H. Tatham (President Elect; Member of the Council); D.T. Rossitter (Member of the Council; Director, Compu-mark (UK) Ltd., London)

Union des fabricants pour la protection internationale de la propriété industrielle et artistique, France (UNIFAB): A. Thierri (Directeur général)

Union of European Practitioners in Industrial Property (UEPIP): C. Kik (Trésorier; Avocat, La Haye); M.A. Baz (Abogado de Patentes, Madrid)

Union of Industrial and Employers' Confederations of Europe (UNICE): H. Molijn (Chef du département des marques, Unilever N.V., Rotterdam); M. Van Kaam (Head, Trademarks Section, Philips International B.V., Eindhoven)

World Federation of Advertisers (WFA): P.P. de Win (Director General)

V. Officers and Committees

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- A. Schäfers, Deputy Director General
- F. Curchod, Director of the Office of the Director General
- G. Ledakis, Legal Counsel
- P. Maugué, Senior Counsellor, Industrial Property (Special Projects) Division
- M. Qayoom, Senior Program Officer, Development Cooperation and External Relations Bureau for Asia and the Pacific
- C. Graffigna Sperling, Senior Program Officer, Development Cooperation and External Relations Bureau for Latin America and the Caribbean
- I. Pérez-Fernández, Translator-Reviser, Languages Section
- R. Derqué, Translator, Languages Section
- T. Niinomi, Associate Officer, Industrial Property Law Section, Industrial Property Division
- A. Damond, Head, Registry, Documents and Meetings Service
- C. Claa, Senior Administrative Assistant, Registry, Documents and Meetings Service

Paris Union

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

Sixth Session
(Geneva, April 24 to 28, 1989)

NOTE*

Introduction

The Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions (hereinafter referred to as "the Committee of Experts") held its sixth session¹ in Geneva from April 24 to 28, 1989.

The following States members of the Paris Union were represented at the session: Algeria, Argentina, Australia, Belgium, Brazil, Bulgaria, Cameroon, Canada, China, Côte d'Ivoire, Czechoslovakia, Denmark, Egypt, Finland, France, German Democratic Republic, Germany (Federal Republic of), Ghana, Hungary, Indonesia, Ireland, Israel, Italy, Japan, Madagascar, Mexico, Netherlands, New Zealand, Nigeria, Norway, Philippines, Poland, Portugal, Republic of Korea, Senegal, Soviet Union, Spain, Sweden, Switzerland, Tunisia, Turkey, United Kingdom, United States of America, Zambia (44).

The following States members of WIPO were represented by observers: Bangladesh, Chile, Colombia, Ecuador, El Salvador, Honduras, India, Panama, Paraguay (9). Representatives of four intergovernmental organizations and 29 non-governmental organizations also participated in an observer capacity. The list of participants follows this Note.

The Committee of Experts considered 11 questions in the following order:

- (i) publication of application;
- (ii) time limits for search and substantive examination;
- (iii) administrative revocation of patents ("post-grant opposition");
- (iv) changes in granted patents;
- (v) patentable inventions;
- (vi) unity of invention;
- (vii) restoration of the right to claim priority;

(viii) several applications in respect of the same invention;

- (ix) determination of the extent of protection;
- (x) maintenance fees;
- (xi) provisional protection.

The first five of the above-mentioned questions were considered by the Committee of Experts for the first time. Those questions related to proposals and ideas presented during the second part of the fifth session of the Committee of Experts (December 12 to 16, 1988) by the Delegation of Japan (questions (i), (iii) and (iv)), the Delegation of the United States of America (question (ii)) and the Delegation of the United Kingdom (question (v)).

The remaining six of the above-mentioned questions had been previously considered by the Committee of Experts on the following occasions: question (vi) on three occasions, namely, during the second, third and fifth sessions (second part) of the Committee of Experts; question (vii) on two occasions, namely, during the fourth and fifth sessions (first part) of the Committee of Experts; questions (viii) and (ix) on two occasions, namely, during the third and fifth sessions (first part) of the Committee of Experts; and questions (x) and (xi) on two occasions, namely, during the fourth and fifth sessions (first part) of the Committee of Experts.

Memoranda prepared by the International Bureau on questions (vi) to (xi) were reproduced in full in *Industrial Property* as follows: on question (vi), 1987, pp. 264 to 270; on question (vii), 1988, pp. 384 to 387; on question (viii), 1987, pp. 216 to 227; on question (ix), 1987, pp. 227 to 234; on question (x), 1988, pp. 226 to 233; and on question (xi), 1988, pp. 226 to 233.

The discussions of the sixth session of the Committee of Experts were based on the following documents prepared by the International Bureau of WIPO: "Draft Treaty on the Harmonization of Patent Laws; Draft Regulations (Articles 106, 107, 108, 110 and 200 and Rules 106, 107 and 110)" (document HL/CE/VI/2), "Corrigendum to Document HL/CE/VI/2" (document HL/CE/VI/2 Corr. E), "Draft Treaty on the Harmonization of Patent Laws; Draft Regulations (Articles 105, 109, 301, 304, 306, 307 and 308 and Rules 105 and 304)" (document HL/CE/VI/3), "Supplement to Document HL/CE/VI/3" (document HL/CE/VI/3 Add.); as well as a proposal by the Dele-

* Prepared by the International Bureau.

¹ For Notes on the first, second, third, fourth and the two parts of the fifth session, see *Industrial Property*, 1985, p. 267; 1986, p. 309; 1987, p. 204; 1988, p. 179; 1988, p. 358; and 1989, p. 53.

gation of Australia entitled "Draft Article 108(1)" (document HL/CE/VI/4) and proposals by the Delegation of the United States of America entitled "Draft Article and Draft Rule on Unity of Invention" (document HL/CE/V/5) and "Rule 304 (Alternative A)" (document HL/CE/V/3 Rev.). Those documents are quoted hereafter together with the relevant portions of the report of the sixth session of the Committee of Experts (document HL/CE/VI/5).

After hearing general statements from a number of delegations and representatives of intergovernmental and non-governmental organizations, the Committee of Experts discussed the questions set out below.

Article 106: Publication of Application

Rule 106: Manner of Publication

Two texts concerning Article 106 were submitted to the Committee of Experts, the first proposed by the Delegation of Japan during the second part of the fifth session of the Committee of Experts ("the December 1988 meeting"), and the second elaborated by the International Bureau. Those texts, and the Rule also elaborated by the International Bureau, read as follows:

Article 106

[TEXT PROPOSED BY THE DELEGATION OF JAPAN
DURING THE DECEMBER 1988 MEETING]

"Any pending application shall be published, at the latest, promptly after the expiration of 18 months from its filing date or, where priority is claimed, the priority date or, in the case of divisional, continuation or continuation-in-part application, from the earliest filing date of that application, unless the application contains expressions or drawings which, in the opinion of the competent authority, are contrary to morality or public order." (Document HL/CE/V/6, page 3)

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

(1) [Requirement to Publish Applications]
(a) Subject to subparagraphs (b) to (d), the industrial property office shall, within the time limit provided for in paragraph (2) and in the manner prescribed in the Regulations, publish all applications filed with it.

(b) No application shall be published if, before the industrial property office completes the technical preparations for publication, the application is withdrawn, is considered withdrawn or is rejected. If, by the time an application should be published according to paragraph (2), a patent on that application has been granted, the application need not be published.

(c) Any Contracting State may prohibit the publication of any application for reasons of national security.

(d) If, in the opinion of the industrial property office, an application contains words or drawings that are contrary to morality or public order or that are disparaging, that office may omit such words and

drawings from copies of the application generally made available to the public. It shall, however, indicate in such copies the fact that they are incomplete and that a copy of the omitted words or drawings may be obtained from it on request.

(2) [Time Limit of Publication] The industrial property office shall publish each application filed with it promptly after the expiration of 18 months from the filing date, or from the priority date, of the application, as the case may be. However, where, before the expiration of the said period of 18 months, the applicant presents a written request to the industrial property office that his application be published, the industrial property office shall publish the application promptly after the receipt of the request."

Rule 106

"For the purposes of Article 106 and Rule 107, publication shall be effected by the industrial property office through putting at the disposal of any person wishing to obtain them copies of the application. The putting at disposal may be against payment or free of charge. The copies shall be on paper. The text and the drawings shall be legible to the naked eye."

The portion of the report of the Committee of Experts concerning the discussion of Article 106 and Rule 106 reads as follows:

"The Delegation of Japan, referring to its proposal in the December 1988 meeting of the Committee of Experts (document HL/CE/V/6), stated that it was prepared to exchange views on the basis of the text elaborated by the International Bureau pursuant to the said proposal. The ensuing discussion was therefore based on that text. It received general support, subject to the following comments.

Article 106(1)(a). There appeared to be a consensus in favor of the principle itself of early publication, however, with the understanding voiced by numerous delegations and representatives that the provision must be linked to various types of safeguards contained in other provisions of the draft Treaty, such as Article 307 on provisional protection, and to the provision on time limits for search and substantive examination (Article 107).

Article 106(1)(b), first sentence. There was general agreement as to the principle that all applications which retained some legal effect should be published, although various objections were voiced as to the drafting of this provision.

One delegation suggested introducing a reference to abandonment, which under its national law differed from a withdrawal. Another delegation suggested adding a reference to the 'shelving' of an application, which occurred under its national law in

cases of non-compliance with a time limit. It was also suggested by several delegations that the draft Treaty make it clear that a rejection of an application must be final in order for Article 106(1)(b), first sentence, to apply. Some delegations and representatives preferred that the draft Treaty fix a specific period of time until when an application could be withdrawn with the effect that its publication would not take place.

Taking into account the said comments, the majority of delegations recommended to revise the text in the sense that, instead of referring to the specific cases when an application should not be published (e.g., if withdrawn or rejected), it would only establish the rule itself: if an application lost all its legal effects with respect to both the applicant and third parties, it should not be published; if an application retained any legal effects, it must be published. Thus, all the different circumstances that could arise under various national laws would be taken into account and treated uniformly.

It was also recommended to revise the text so that it would provide for the possibility of withdrawing the application, and thus avoiding publication, within a time limit of, for example, 17 months after the priority date, or until the time the industrial property office completed the technical preparations for publication if that time was later than the expiration of the said time limit. Thus, the specificity of a fixed period of time would be introduced, while retaining the advantages under the PCT of being able to withdraw an application as late as possible.

Article 106(1)(b), second sentence. Several delegations stated that that sentence would be acceptable only if the file containing the application as filed was available to the public in those cases where a patent was granted and published before the publication of the application. This was seen as particularly important for the effective functioning of Article 202 on prior art effect of applications.

Article 106(1)(c). General support was expressed for the principle contained in that provision, although it was recognized that the term 'national security' could be subject to a variety of interpretations. Allowance for such flexibility would probably have to be accepted and referred to in the corresponding explanatory Notes.

Article 106(1)(d). Different opinions were expressed with respect to that provision. They ranged from the desire to have the provision deleted to the position that the entire application should not be published if it contained words contrary to morality or public order or that were disparaging. In light of such disparate views, the Chairman suggested that the text elaborated by the International Bureau, which was based on the language of

the PCT, may be sufficient, as it represented a compromise among the various opinions.

Article 106(2). There seemed to be unanimous support for the 18-month time limit set for the publication of applications. However, differences of opinion arose as to whether publication should occur 'promptly,' as provided in the present text, or 'as soon as possible' after the expiration of the said time limit. It was agreed that the International Bureau would reconsider that question, in particular in the light of the terminology used in the PCT.

Two other problems were raised by several delegations and representatives, which, it was agreed, would have to be taken into account at least in the corresponding explanatory Notes: the manner of calculating the time limit for publication in the case of divisional and continuation-in-part applications, and the manner of calculating that time limit in the case of applications claiming multiple or internal priorities.

Rule 106. There seemed to be general agreement as to the principle contained in that provision, in particular regarding the need to define 'publication' along the lines of the first sentence thereof and to assure that copies of the application could be obtained at least in paper form. However, it was agreed that the International Bureau should endeavor to simplify Rule 106, it being understood that the second sentence, allowing publication either against payment or free of charge, could be deleted."

Article 107: Time Limits for Search and Substantive Examination

Rule 107: Separate or Delayed Publication of Search Report

Article 107 of the draft Treaty as submitted by the International Bureau to the Committee of Experts was based on an idea presented by the Delegation of the United States of America during the December 1988 meeting of the Committee of Experts. The description of that idea and the texts of the Article and Rule elaborated by the International Bureau on the basis of that idea read as follows:

Article 107

[IDEA PRESENTED BY THE DELEGATION
OF THE UNITED STATES OF AMERICA
DURING THE DECEMBER 1988 MEETING]

"[A] provision should be introduced which would require searches to be completed not later than 18 months after the filing date of an application for a patent, and which would require that substantive examination be commenced within 36 months after the filing date of an application for a patent.... [T]he proposal would mean that both the application and the search report would have to be published within 18 months of the filing date." (Document HL/CE/V/7, paragraphs 89 and 90)

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

“(1) [Time Limits] If the national law requires that inventions claimed in applications be the subject of examination as to their patentability (‘substantive examination’), the industrial property office shall, in respect of each application,

(i) publish, together with the publication of that application under Article 106, a report, established by or on behalf of that office, citing any documents that reflect the prior art relevant to the invention claimed in the said application (‘search report’), and

(ii) start the substantive examination within three years from the filing date, or from the priority date, of the application, as the case may be.

(2) [Separate Publication of the Search Report] Notwithstanding paragraph (1)(i), where Article 106(2), second sentence, applies, the publication of the search report need not accompany the publication of the application, provided that the publication of the search report shall be effected, in the manner prescribed in the Regulations, as soon as possible but not later than the expiration of 18 months from the filing date, or from the priority date, of the application, as the case may be.

(3) [Delay in the Publication of the Search Report] If, notwithstanding paragraphs (1) and (2), for any exceptional reason, the publication of the search report cannot be effected as provided for in paragraphs (1) or (2), the search report shall be published, in the manner prescribed in the Regulations, as soon as possible after the publication of the application, and in no case later than the expiration of 24 months from the filing date, or from the priority date, of the application, as the case may be.”

Rule 107

“Where Article 107(2) or (3) applies, the industrial property office shall either republish the application and incorporate in such publication the search report or shall publish the search report separately. In the latter case, the publication shall identify the application to which the search report relates by referring at least to the latter’s serial number and date of publication.”

The portion of the report of the Committee of Experts concerning the discussion of Article 107 and Rule 107 reads as follows:

“The Delegation of the United States of America, referring to the idea presented by it in the December 1988 meeting of the Committee of Experts (document HL/CE/V/7, paragraphs 89 and 90), explained that it had initially put forward that idea because of the burden many applicants faced in

countries where substantive examination could be unduly delayed. This burden was also shared by third parties and the public at large who did not know what rights would eventually result from the long-pending applications and what liabilities could possibly be incurred if use was made of matter covered by such applications in the event patents were eventually granted thereon. Specific reference was made to the situation faced by patent applicants in Japan where two and a half million applications were pending before the industrial property office any one of which could mature into a patent. Under such circumstances, the burden of carrying out searches and examinations was transferred from the industrial property office to the public, which was not fair to the latter. Countries should move towards a world patent system where every application was searched and examined promptly, unless it was abandoned. Within the framework of the European Patent Convention, European countries had already departed from the seven-year deferred examination system. Although some would argue that the problem was reduced by the fact that chemicals and pharmaceuticals must undergo major pre-marketing approval delays anyway, this situation concerned only a few products and did not justify major search and examination delays in all fields of technology. If the objective was to ensure an effective and efficient patent system, the time had come to require at least that search reports be published within 18 months and that substantive examination be started within three years from the filing or priority date. This was not a perfect solution, as it did not ensure a time limit for the completion of the examination, but, along with the prohibition of pre-grant opposition (Article 108), it would represent a major step towards reducing the delays experienced in the processing of patent applications in many countries today.

Several representatives spoke up in support of the position taken by the Delegation of the United States of America and the proposal contained in Article 107. They expressed their concern about what was referred to as ‘patent flooding,’ where a large number of applications awaited processing for significant periods of time, during which third parties were not sure of the merits and seriousness of the applications, whereas the applicants benefited from provisional protection without even being required to request that their applications be examined.

Nevertheless, the majority of delegations of those countries whose industrial property offices carry out substantive examinations did not support the proposal contained in Article 107 in its present form. Two delegations opposed the proposal and proposed that it be deleted. Therefore, it was agreed that the International Bureau should attempt to revise the text, taking into account the following principal comments and suggestions made during the discussion:

- the question of whether it was advisable to separate the search and examination processes by imposing two separate time limits therefor, since the major problem seemed to lie with examination;
- the suggestion made by several delegations and representatives that it should also be possible for third parties to request examination, without, however, having to bear all examination costs;
- the observations made by some delegations and representatives that Article 107 was linked to other provisions in the draft Treaty, such as Articles 108, 307 and 308;
- the question as to whether a time limit should not be imposed also for the completion of substantive examination (in this respect, reference was made to the law of the United Kingdom where substantive examination must be completed within four and a half years from the filing or priority date);
- the question of whether one should not also provide for the speeding up of the examination procedure, in particular upon the request of third parties;
- the situation in a number of countries where the industrial property offices did not have the infrastructure or resources to be able to comply with the time limits fixed in Article 107.

The Director General stated that it was intended that Article 107, as well as all the other provisions of the Treaty, would only be applicable to applications filed after the entry into force of the Treaty.”

Article 108: Administrative Revocation of Patents (“Post-Grant Opposition”)

Article 108 of the draft Treaty as submitted by the International Bureau to the Committee of Experts was based on a proposal made by the Delegation of Japan during the December 1988 meeting of the Committee of Experts. The text of that proposal and the text elaborated by the International Bureau on the basis of that proposal read as follows:

[TEXT PROPOSED BY THE DELEGATION OF JAPAN DURING THE DECEMBER 1988 MEETING]

“(1)(a) A Contracting State shall provide any person with an opportunity to file pre-issue and/or post-issue opposition to the competent authorities with respect to any allowed application or issued patent.

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

(2) Any Contracting State shall provide an applicant or a patentee and an opponent with a fair opportunity to make an argument.” (Document HL/CE/V/6, page 2)

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

“(1) [Administrative Revocation] (a) *Any interested party shall have the right to request the indus-*

trial property office that it revoke, in whole or in part, a patent that the said office has granted. Such a request shall be presentable during a period to be fixed by the national law between three and nine months after the publication of the patent and may be based at least on any of the following grounds:

(i) *that the invention for which the patent was granted is not patentable, in its entirety or in respect of certain claims,*

(ii) *that the disclosure of the invention as contained in the granted patent is not complete.*

(b) *Both the party requesting revocation and the owner of the patent shall be given full opportunity to present their arguments to the industrial property office before a decision is made in respect of the request for revocation.*

(2) [Prohibition of Pre-Grant Opposition] *No Contracting State shall allow interested parties to oppose, before its industrial property office, the grant of patents, provided that, where the national law of a Contracting State provides for such pre-grant opposition, that State may, for a period not exceeding 10 years from the date on which this Treaty entered into force with respect to it, continue to do so and, for the same period, it shall not be obliged to apply paragraph (1). Any State that wishes to apply the preceding sentence shall notify the Director General accordingly.*

(3) [Cancellation, etc.] *The provisions of paragraphs (1) and (2) shall not affect the freedom of any Contracting State to provide for the cancellation, invalidation or annulment of any granted patent by courts or quasi-judicial authorities.”*

The portion of the Report of the Committee of Experts concerning the discussion of Article 108 reads as follows:

“In addition to the text proposed by the Delegation of Japan during the second part of the fifth session of the Committee of Experts and the text elaborated by the International Bureau (HL/CE/VI/2), the Committee of Experts also discussed a proposal by the Delegation of Australia for a draft Article 108(1) (document HL/CE/VI/4). It was concluded that the International Bureau should prepare a new draft taking into account the following comments and observations made on the draft of Article 108 as elaborated by the International Bureau and on draft Article 108(1) as proposed by the Delegation of Australia.

Article 108(1) (Text of the International Bureau). When discussing this provision, most delegations and representatives based their interventions on the understanding that an obligation to provide an administrative system of post-grant opposition or revocation should be limited to those Contracting

States whose national law provided for the substantive examination of patent applications.

A number of delegations considered that, even though the grounds of revocation specified in paragraph (1)(a)(i) and (ii) were non-exhaustive, it should be specifically provided that revocation should be available on certain additional grounds. In particular, certain delegations and representatives considered that the inclusion in a patent of matter that did not appear in the original parts of the application should be specified as being available as a ground of revocation, although one delegation opposed such an inclusion.

It was suggested by one delegation that the ground of revocation specified in paragraph (1)(a)(i) should be amended to read 'that the invention for which the patent was granted is not patentable, in its entirety or in part' so that it was possible to redraft claims.

A number of delegations, referring to the wording of draft Article 103 (Manner of Description), proposed that the ground of revocation specified in paragraph (1)(a)(ii) should be amended to read 'that the disclosure of the invention as contained in the grant of patent is not complete enough to enable the invention to be carried out by a person skilled in the art.'

One delegation expressed concern that the time limits fixed for revocation proceedings in paragraph (1)(a) were too restrictive.

As regards the way in which the nature of the opportunity to present arguments, required by paragraph (1)(b), should be qualified, some delegations suggested deleting the qualification 'full' before 'opportunity,' while others favored the replacement of 'full' by 'adequate' or 'fair.' It was recommended that the International Bureau should examine an appropriate qualification, and that the notes to the provision in the next draft should reflect the understanding that the opportunity to be granted should allow each party to present full arguments, while at the same time allowing the industrial property office concerned the possibility of efficiently terminating the revocation hearing.

Some delegations favored a requirement in paragraph (1)(b) that the patent owner be given the opportunity to present the last argument in revocation proceedings. Other delegations considered that such a formal rule might constrict the flexibility that was necessary to dispose of revocation proceedings on the merits of each case.

A number of delegations considered that paragraph (1)(b) should specify that each party should have the opportunity to present arguments either in writing or orally.

Article 108(2). Fundamental differences of view existed between, on the one hand, those delegations and representatives that favored the prohibition of pre-grant opposition and the limitation of such

proceedings to post-grant revocation and, on the other hand, those that favored either pre-grant opposition or the choice for Contracting States to select either pre-grant opposition or post-grant revocation.

Those delegations and representatives that favored an exclusive system of post-grant revocation expressed concern at the delays which pre-grant opposition often produced in the processing of patent applications, referring to pre-grant opposition hearings that sometimes lasted for a period of eight to 10 years. They also emphasized the need to expedite the processing of patent applications in view of the large backlogs that existed in some countries, and the view that provisional protection was, compared to full protection, always limited in some way.

Those delegations and representatives that favored pre-grant opposition drew attention to the role played by a system of public inspection in ensuring that defective patents were not issued, the function of pre-grant opposition in perfecting the examination of patent applications in offices where resources and documentation were limited and the view that provisional protection was tantamount to full protection.

The Delegation of Japan sought to clarify the reference that had been made on a number of occasions to the fact that there were 2,500,000 pending applications before the Japanese Patent Office (JPO). It stated that that figure was not correct. The correct number, on the basis of the annual report of the JPO, was 2,270,000 pending applications. However, included in the correct number were utility model applications, which were outside the scope of the discussions of the harmonization of patent laws, as well as patent applications for which examination had not been requested. In respect of the latter class of applications, past experience indicated that examination would never be requested in respect of a large number of those applications. It was estimated that the number of pending patent applications for which examination would be requested was 650,000, so that the real number of pending patent applications should be considered to be 650,000, rather than 2,500,000.

It was agreed, in conclusion, that the further consideration of Article 108(2) should be deferred until agreement could be reached on Article 108(1).

Article 108(3). There was general support for this provision in its existing form."

Article 108(1)(Proposal by the Delegation of Australia)

Draft Article 108(1) as proposed by the Delegation of Australia (document HL/CE/VI/4) read as follows:

"(1)(a) A Contracting State which grants a patent following substantive examination shall provide any

person with an opportunity to file at the industrial property office a request

- (i) to revoke, in whole or in part; or
- (ii) to re-examine

the patent that the said office has granted.

(b) Where paragraph (a)(i) applies, such a request shall be presentable during a period fixed by the national law and may be based at least on any of the following grounds:

- (i) that the invention for which the patent was granted is not patentable, in its entirety or in respect of certain claims;
- (ii) that the disclosure of the invention as contained in the granted patent is not complete.

(c) Where paragraph (a)(ii) applies, such a request shall be presentable at any time during the term of the patent and may be based at least on the ground that the invention as claimed in any claim of the patent is not patentable in the light of any printed publication.

(d) Both the person requesting revocation and the owner of the patent shall be given full opportunity to present their arguments to the industrial property office before a decision is made in respect of the request for revocation."

The portion of the report of the Committee of Experts concerning the discussion of draft Article 108(1) proposed by the Delegation of Australia reads as follows:

"The Delegation of Australia introduced its proposal for draft Article 108(1) (document HL/CE/VI/4). It stated that the proposal was limited so as to apply only to those Contracting States whose national law required that patent applications be the subject of substantive examination. The Delegation stated that the proposal attempted to separate the procedure of administrative revocation from that of re-examination and to offer Contracting States the choice of adopting either one of the procedures or both of the procedures because of a constitutional difficulty in Australia associated with administrative revocation on extensive grounds. In the light of the discussion that had succeeded the drafting of the proposal, the Delegation suggested that paragraph (1)(a)(ii) of its proposal could be amended to read 'to re-examine for the purposes of limiting or confirming the scope of protection conferred by.' The Delegation explained that the intention of paragraph (1)(b) was to provide a procedure for administrative revocation which would be available during a period of time to be determined by national law (which would presumably be relatively short) on grounds which were more extensive than those available for the re-examination procedure. In contrast to paragraph (1)(b), the intention of paragraph (1)(c) was that re-examination should be allowable at any time during the term of a patent on the minimum ground that the invention claimed is or is not patentable in the light of any printed publication available on or before the priority date of the application pursuant to which the patent is granted. The rationale of limiting the grounds of re-examination to printed publications forming part of the prior art was to facilitate a relatively quick and effi-

cient procedure before the industrial property office, which would not necessarily have the experience or expertise to determine the difficult questions of evidence and proof often raised by questions of prior use. The Delegation noted that paragraph (1)(d) of its proposal was the same as paragraph (1)(b) of the text of the International Bureau. The opportunity which the paragraph required be granted to present arguments was deliberately restricted to revocation proceedings and did not extend to re-examination. In conclusion, the Delegation stated that it understood that those parts of its proposal which were based on the text of the International Bureau (notably the grounds of revocation specified in paragraph (1)(b) and the obligation to give an opportunity to present arguments in paragraph (1)(d)) were subject to the comments that had been made concerning the text of the International Bureau.

In response to requests for information and clarification, the Delegation of the United States of America explained the practice of re-examination adopted in its Patent and Trademark Office. Pursuant to that procedure, any person (including the patent owner) could request that the subject matter of a patent be re-examined, provided that that person could demonstrate that a substantial new question of patentability existed as a result of the discovery of a printed publication that had not been previously taken into account by the Office, but that had been issued before the priority date of the application. If the request was admitted by the Office, both the patent owner and, if different, the requesting party could make statements; an *ex parte* procedure took place between the patent owner and the examiner, in which the subject matter of the patent was examined in the same manner as the original examination of the application and subject to the same appeal procedures as the original examination of the application. The examiner could have recourse not only to the new printed publication brought to the attention of the Office in the request for re-examination, but also any other printed publications that were considered pertinent. At the end of the re-examination, a certificate was issued by the Office which specified the status of the patent as a result of the re-examination, whether confirmed in whole or in part or revoked. That certificate was published and was appended to any copy of the patent subsequently made available by the Office. Requests for re-examination could be made in respect of the same patent on as many occasions as the initial condition of demonstrating a substantial new question of patentability as a result of the discovery of a new printed publication could be satisfied. If several requests for re-examination were admitted simultaneously in respect of the same patent, the proceedings were merged. A re-examination could also proceed at the same time as court proceedings, although in practice re-examination

was usually requested prior to court proceedings. The procedure of re-examination had been introduced in order to provide a quicker, cheaper and more specific (since it related only to printed publications forming part of the prior art) procedure than judicial invalidation, as well as to benefit from the technical expertise of examiners in the assessment of prior art.

It was agreed that the proposal of the Delegation of Australia should be further examined by the International Bureau, taking into account the following observations and questions:

(a) What was the correct terminology that should be used to describe 're-examination' since, prior to re-examination, only the patent application and not the patent would have been examined?

(b) Some delegations expressed concern over the multiplicity of procedures that would be available following the grant of a patent (administrative revocation, re-examination and invalidation proceedings before a court), and the way in which those various procedures should be related to each other.

(c) A number of delegations expressed concern that the choice in the proposal of the Delegation of Australia was not between parallel options, since the procedures of administrative revocation and re-examination were entirely different.

(d) A number of delegations considered that any new draft of Article 108 should make it clear which parties could use which procedures.

(e) Some delegations also proposed that any article dealing with re-examination should make provision for the publication of the result of re-examination.

(f) One delegation considered that the grounds of re-examination should not be limited to printed publications forming part of the prior art."

Article 110: Changes in Granted Patents

Rule 110: Manner of Publication of Changes in Granted Patents

Article 110 and Rule 110 of the draft Treaty as submitted by the International Bureau to the Committee of Experts were based on a proposal made by the Delegation of Japan during the December 1988 meeting. The text of that proposal and of the Article and Rule elaborated by the International Bureau read as follows:

Article 110

[TEXT PROPOSED BY THE DELEGATION OF JAPAN DURING THE DECEMBER 1988 MEETING]

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

(2) Such correction shall not enlarge the scope of the claim or claims." (Document HL/CE/V/6, page 4)

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

"(1) [Request for Changes] *The owner of a granted patent may request the industrial property office having granted the patent to make changes in the text or drawings of the granted patent where the changes would*

(i) *limit the scope of the protection conferred by the claim or claims, or*

(ii) *clarify ambiguities or correct obvious mistakes or clerical errors, provided that the scope of protection conferred by the claim or claims is not enlarged.*

(2) [Decision in Respect of the Request and Publication of the Changes] *If, and to the extent to which, the industrial property office accepts the request referred to in paragraph (1), it shall record the changes and publish them in the manner prescribed in the Regulations."*

Rule 110

"Where Article 110(2) applies, the industrial property office shall either republish the patent as changed or publish the changes separately. In the latter case, the publication shall identify the patent to which the changes relate by referring at least to the latter's serial number and date of publication."

The portion of the report of the Committee of Experts concerning the discussion of Article 110 and Rule 110 reads as follows:

"The discussions were based on the text elaborated by the International Bureau.

Article 110(1). There was general support for the inclusion of that provision in the draft Treaty, subject to the comments and observations set out in the succeeding paragraph. In particular, the majority of delegations and representatives favored the inclusion of paragraph (1)(i) in the draft Treaty as a minimum guarantee, and expressed the view that this provision alone was sufficient to justify an Article in the Treaty.

The majority of delegations and representatives considered that the obligation to allow changes in granted patents should apply also to those Contracting States whose national law did not provide for the substantive examination of patent applications. One delegation, whose national law did not provide for substantive examination as to patentability in most fields of technology, referred to a favorable experience with a procedure for allowing changes in granted patents. Other delegations emphasized the particular importance for offices that did not undertake substantive examination to allow changes in granted patents.

A variety of views were expressed with respect to the provision in paragraph (1)(ii).

Some delegations considered that the proviso in paragraph (1)(ii), which required that the scope of

protection conferred by claims should not be enlarged as a result of the changes specified in the provision, should apply only where the changes were made to clarify ambiguities and not where they were made to correct obvious mistakes or clerical errors.

A number of delegations expressed concern at the allowance of changes in order to clarify ambiguities, as envisaged by paragraph (1)(ii), on the basis that such a possibility would be conducive to legal uncertainty.

One delegation considered that the proviso in paragraph (1)(ii) should require not only that the scope of protection conferred by claims should not be enlarged, but also that the scope of protection should not be substantially altered.

One delegation proposed that, where any mistake, whether or not obvious or clerical, had been made by a patent owner without deceptive or abusive intent, the patent owner should be permitted, during a limited time after grant, to make changes in the patent, even if such changes resulted in the scope of protection being enlarged. Where such changes were permitted, the rights of third parties affected by changes that enlarged the scope of protection should be safeguarded. The proposal was supported by a number of delegations and representatives, but opposed by others on the basis that changes which enlarged the scope of protection might force the re-opening of revocation proceedings.

It was suggested by the Director General that the proposal to allow changes that would enlarge the scope of protection might best be accommodated by way of an option available to Contracting States, rather than as a mandatory requirement, while maintaining a minimum obligation for Contracting States to allow the other changes described in the present text of paragraph (1) that would not result in the enlargement of the scope of protection. Any Contracting State authorizing changes enlarging the scope of protection would have to provide for the respect of the rights of third parties that would have relied on the patent originally granted with narrower claims and would have to provide for a time limit of one year from the grant of the patent for requesting changes that would result in an enlargement of the scope of protection.

It was generally agreed that any change, whether or not enlarging the scope of protection, should not be allowed if it resulted in the disclosure of new matter that went beyond the initial disclosure in the patent application as filed.

Article 110(2). The text of this provision was generally supported, subject to the amendment mentioned in the next paragraph.

Rule 110. It was suggested that, since the Treaty did not deal with the manner of publication of

patents (as opposed to patent applications), this Rule should be deleted. The deletion of the Rule would require a consequential amendment to Article 110(2) by the deletion from that provision of the words 'in the manner prescribed in the Regulations.'

Article 200: Patentable Inventions

Article 200 of the draft Treaty as submitted by the International Bureau to the Committee of Experts was based on a suggestion made by the Delegation of the United Kingdom during the December 1988 meeting of the Committee of Experts. The description of that suggestion and the text of the Article elaborated by the International Bureau read as follows:

[SUGGESTION OF THE DELEGATION
OF THE UNITED KINGDOM
MADE DURING THE DECEMBER 1988 MEETING]

"[A]greement on a general definition of what constituted an invention would constitute a major step of harmonization." (Document HL/CE/V/7, paragraph 98)

[TEXT ELABORATED BY THE INTERNATIONAL BUREAU]

"(1) [Invention] *Any idea which permits in practice the solution of a specific problem in the field of technology shall be deemed to be an invention.*

(2) [Patentability] *A patent shall be granted for an invention which is novel, involves an inventive step (is non-obvious) and is industrially applicable.*

(3) [Novelty] (a) *An invention shall be considered new if it is not anticipated by the prior art.*

(b) *The prior art shall consist of everything which, before the filing date or, where priority is claimed, the priority date of the application claiming the invention, has been disclosed to the public anywhere in the world in a written or other graphic [or any other] form.*

(4) [Inventive Step] *An invention shall be considered to involve an inventive step if, having regard to the prior art as defined in paragraph (3)(b), it is not obvious to a person skilled in the art.*

(5) [Industrial Applicability] *An invention shall be considered industrially applicable if, according to its nature, it can be made or used (in the technological sense) in any kind of industry."*

The portion of the report of the Committee of Experts concerning the discussion of Article 200 reads as follows:

"*Article 200(1).* It was agreed that the Treaty should not include a definition of invention.

Article 200(2). This provision was generally supported, subject to the following observations.

It was agreed that the opening words of paragraph (2) should be redrafted along the following lines: 'An invention shall be patentable if it is ...'

Some delegations considered that the words 'is non-obvious' in parenthesis should be deleted, since the meaning of inventive step was elaborated in paragraph (4).

A number of delegations considered that the condition of industrial applicability ought to be replaced by a condition of utility or usefulness, drawing attention to conflicting views as to which of the conditions of industrial applicability or utility could be considered to be broader. It was generally agreed that Contracting States should be allowed an option to apply either industrial applicability or utility as the third condition of patentability.

Article 200(3). While some delegations expressed concern that the inclusion of a definition of novelty, as well as the definitions of inventive step and industrial applicability in paragraphs (4) and (5), respectively, might call for excessive discussion and thereby delay the conclusion of the Treaty, the majority of delegations and representatives expressed the view that the harmonization of a definition of what constituted, as a minimum, the prior art, would represent a major step in harmonization.

In respect of paragraph (3)(a), some delegations expressed concern that the word 'anticipated' might entail associations of idea with the notions of both inventive step and novelty. It was suggested that the words 'not anticipated by' could be replaced by the words 'does not form part of.'

In respect of paragraph (3)(b), three questions in particular concerning the definition of the prior art were discussed, namely, whether the prior art should include prior use; whether it should include both oral disclosures and written or graphic disclosures; and whether oral disclosures and, if included, prior use, should include disclosures and use anywhere in the world or only in the country.

In order to resolve differences of approach to the prior art, it was proposed that a minimum standard of prior art could be established in the draft Treaty, which would include written and graphic disclosures anywhere in the world, and that Contracting States could be permitted, in addition, to consider as forming part of the prior art oral disclosures anywhere in the world or in the country, as well as prior use anywhere in the world or in the country.

It was understood that the definition of prior art in paragraph (3)(b) was subject to Article 201, which would have the effect of deleting matter from the prior art, and Article 202, which would have the effect of adding matter to the prior art.

Article 200(4). The text of this provision was accepted.

Article 200(5). In conformity with comments made in respect of the third condition of patentability in paragraph (2), a number of delegations considered that paragraph (5) should be expanded to

include a reference to utility or usefulness as an alternative to industrial applicability, or as a condition which would apply in addition to the condition of industrial applicability.

While some delegations questioned whether the condition of industrial applicability or utility served any useful purpose, other delegations supported the retention of the condition on the basis that it served to exclude from patentability such inventions as chemical compounds for which no use was disclosed, perpetual motion machines and the like.

It was generally agreed that the term 'industry' should be elaborated so as to make it clear that it included therapeutic, medical and agricultural uses and activities, as well as research.

It was agreed that the International Bureau should revise the wording of paragraph (5) revising, in particular, the terminology used in the present text."

Article 105: Unity of Invention

Rule 105: Unity of Invention; Division of Application

Discussions were based on both a proposal for a draft Article and draft Rule on unity of invention submitted by the United States of America to the December 1988 meeting of the Committee of Experts and Article 105 and Rule 105 as submitted by the International Bureau to the sixth session of the Committee of Experts.

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

Article 105

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

(2) *If, notwithstanding paragraph (1), a patent is granted without the requirement of unity of invention having been complied with, the validity of such patent shall not be affected thereby."*

Rule 105

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

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

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

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

- (c) *an independent claim for a process for, or also for, the manufacture of the said product, and an independent claim for a use of the said product (combination A + B + C);*
- (d) *an independent claim for a process for, or also for, the manufacture of the said product, and an independent claim for a means for, or also for, carrying out the said process (combination A + B + D);*
- (e) *an independent claim for a process for, or also for, the manufacture of the said product, an independent claim for a means for, or also for, carrying out the said process, and an independent claim for a use of the said product (combination A + B + D + C);*
- (ii) *the combination of an independent claim for a given process with an independent claim for a means for, or also for, carrying out the said process (combination B + D).*

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

(3) *The inclusion in the same application of independent claims of different categories in combinations other than the combinations referred to in paragraph (1), or of claims of the same category, or of dependent claims and of multiple dependent claims (even where the features of a dependent claim or of a multiple dependent claim constitute in themselves an invention), shall be allowed to the extent that the requirement of unity of invention is complied with."*

The draft Article and draft Rule proposed by the Delegation of the United States of America during the December 1988 meeting read as follows:

Draft Article

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

(2) Where a group of inventions is claimed, the link in paragraph (1) must be a technical interrelationship expressed in the claims in terms of the same or corresponding special technical features. The expression 'special technical features' means those technical features which define the contribution which each invention makes over the prior art.

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

(4) Failure to comply with the requirement of unity of invention shall not be a ground for invalidation or revocation of a patent." (Document HL/CE/V/5, page 3)

Draft Rule

"(1) The applicant has the right to file one or more divisional applications, in particular in order to meet an

objection of lack of unity of invention with regard to the parent application.

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

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

(4) If there is a lack of unity of invention in an application, the invention, or group of inventions within the meaning of paragraphs (1) and (2) of the Article, first mentioned in the claims will be the elected invention for purposes of search and examination." (Document HL/CE/V/5, pages 8 and 9)

The portion of the report of the Committee of Experts concerning the discussion of Article 105 and Rule 105 reads as follows:

"Discussions were based on the text of Article 105 and Rule 105 prepared by the International Bureau (document HL/CE/VI/3) and the draft for Article 105 and Rule 105 proposed by the United States of America (document HL/CE/V/5). The Committee of Experts noted the written comments which had been made on the proposal of the United States of America by various States and non-governmental organizations and which had been distributed by the International Bureau (Note C. 4959-422 of March 5, 1989), as well as the response to those comments made by the United States Patent and Trademark Office and also distributed by the International Bureau (Note C. 4982-422 of April 24, 1989).

The majority of delegations and representatives expressed support, in principle, for the draft Article and draft Rule proposed by the United States of America, and it was decided that the discussions should concentrate on that draft Article and draft Rule. References in succeeding paragraphs to the 'draft Article' and 'draft Rule' are references to the draft Article and draft Rule as set out in document HL/CE/V/5.

The Delegation of the United States of America introduced the draft Article and draft Rule, stating that they resulted from two years' work undertaken jointly by the European Patent Office, the Japanese Patent Office and the United States Patent and Trademark Office. The Delegation stated that the goal of its proposal was a unity procedure based upon and consistent with EPO practice, that is, as definite as possible, and capable of being implemented in all offices in a uniform manner. The Delegation stated that, even though unity of invention was a largely procedural matter, harmonization of the matter might lead to the possibility of a determination on unity of invention made by one office being adopted by other offices. Such a possibility would, in turn, constitute a good starting point for the eventual adoption by one office of searches carried out in other offices.

Draft Article: Paragraph (1). There was general support for this provision in its present form.

Draft Article: Paragraph (2). The attempt to formulate a general principle of unity of invention contained in this paragraph was supported. The following observations were made with respect to the present text of the paragraph.

It was noted that, while the second sentence of paragraph (2) referred to the contribution which each invention makes over the prior art, paragraph (2) was not intended to imply that a search of the prior art had to be undertaken in order to apply the principle set out in paragraph (2). Rather, it was intended that the principle should be applied in order to make a preliminary determination of whether the claims indicated that unity of invention existed by reference to special technical features, without a search of the prior art being needed. That preliminary determination would, of course, be subject to the possibility that a search of the prior art, where conducted, might later reveal that special technical features did not exist in the inventions claimed. It was suggested that the Notes to the Article should clarify that the principle in paragraph (2) did not require a search of the prior art.

Some delegations and representatives expressed concern that the principle in paragraph (2) might be applied restrictively so as to require the expression of special technical features in each sub-claim and dependent claim, so that unity of invention might be considered not to exist where a sub-claim was not defined by reference to the prior art in the same way as the main claim. It was agreed that, in applying unity of invention, the totality of the claims had to be taken into consideration, and that a consequential drafting amendment might be necessary to the second sentence of paragraph (2) to make this clear. One such suggested amendment was that the second sentence should read: "The expression "special technical features" means those technical features which define the contribution which the subject matter claimed considered as a whole makes over the prior art."

While some delegations considered that paragraph (2) contained a fundamental principle and should, therefore, remain as a paragraph of the Article, the majority of delegations and representatives favored placing paragraph (2) in the Rule. The preference for the location of the paragraph in the Rule was based on the consideration that paragraph (2) was merely explanatory of paragraph (1), and thus hierarchically inferior, and the view that the location of the paragraph in the Rule would enable drafting amendments to be made to the paragraph on the basis of the experience that would be gained by offices in the application of the principle. It was suggested that, in the next draft, paragraph (2) should appear in both the Article and the Rule, in each case contained in square brackets, with a footnote indi-

ating that the exact location would be decided later.

Considerable discussion took place on whether the first paragraph of Note (d) to the draft Article (see document HL/CE/V/5, page 4), which interprets paragraph (2) in respect of claims of different categories, should be elevated to the Rule. Some delegations considered that the addition of the first paragraph of Note (d) to the Rule might constitute a source of confusion owing to differing interpretations in respect of categories of claims. The majority of delegations, however, were of the view that, since the first paragraph of Note (d) contained an interpretation of the principle in paragraph (2) of the draft Article, it should be placed in the Rule, provisionally in square brackets. It was agreed, however, that it would be necessary to re-draft the first two lines to make clear the relationship between the provisions of the first paragraph of Note (d) and those of paragraph (2). It was also agreed that the last two paragraphs of Note (d), which define the meaning of the first paragraph of Note (d), should also be placed in the Rule in double square brackets for further consideration.

Draft Article: Paragraph (3). The text of this paragraph was generally accepted, subject to the following observations.

Since paragraph (3) was explanatory of the general principle of unity of invention, the majority of delegations and representatives considered that it should be located in the Rule. It was agreed that, as with paragraph (2), paragraph (3) should be placed in square brackets in both the Article and the Rule in the next draft, with a footnote indicating that the precise location would be determined later.

It was agreed that paragraph (3) was concerned only with the requirement of unity of invention, and was not to be interpreted as enabling any form of claim to be presented, regardless of considerations such as clarity or conciseness of claims and the claims fee system applicable in a particular office. Reference was made in this regard to the last sentence of Note (e) to the draft Article (document HL/CE/V/5, pages 4 and 5). It was suggested that a further note should be added to the next draft to make it clear that paragraph (3) was not intended to be an encouragement to the use of alternatives within a single claim, but was intended to clarify that the criterion for the determination of unity of invention was the same regardless of the form of claim used.

Draft Article: Paragraph (4). The text of this paragraph was generally accepted in its present form.

Draft Rule. In view of the proposals to transpose paragraphs (2) and (3) of the draft Article to the Rule, as well as to include the first paragraph of Note (d) to the draft Article in the Rule, it was agreed that, in the next draft, two Rules relating to Article 105 should

be included, the first dealing with questions of the interpretation of Article 105, and the second dealing with divisional applications (presently dealt with in paragraphs (1) to (3) of the draft Rule).

Draft Rule: Paragraph (1). The text of the provision in its present form was generally accepted, it being noted that the paragraph covered both of the cases in which divisional applications were required to be allowed by Article 4G of the Paris Convention (namely, divisional applications made to meet an objection of lack of unity of invention and spontaneous divisional applications).

Draft Rule: Paragraph (2). It was agreed that, since multiple divisional applications could be made, the word 'parent' in the first line should be replaced by a more suitable word or expression, such as 'undivided,' 'application from which it is derived' or 'earlier.'

As regards the identification of the time up to which an application could be divided, it was noted that the proposal in paragraph (2) was to constitute a minimum time period during which an application could be divided. Various proposals were made in order to make more precise the time limit, including up to 'grant' and 'the industrial property office makes a decision on the grant of a patent,' because the latter covers the case of rejection. One delegation, whilst supporting the principle of paragraph (2), pointed out the problem the proposed time limit might sometimes create for States which have an overall time limit for completion of examination. It was considered that the International Bureau should re-examine the question, but that a solution involving any unsolicited notification by the industrial property office was to be avoided.

One delegation considered that paragraph (2) should be limited to divisional applications made in consequence of a lack of unity of invention, since the Rule related to an Article on unity of invention, and since Article 4G(2) of the Paris Convention enabled each member State of the Paris Union to determine the conditions under which divisional applications, made otherwise than as a result of lack of unity of invention, should be authorized.

Draft Rule: Paragraph (3). It was agreed that this paragraph should be amended so that the opening words would read: 'The priority documents and any required translations thereof'

The majority of delegations or representatives considered that the words 'already' and 'again' in the first line of this paragraph should be deleted so as to make it clear that priority documents and any required translations thereof need be filed only once, in respect of the 'parent' application, whether filed before or after the divisional application.

Differences of view existed as to whether paragraph (3) should not only exempt the need to re-file

priority documents (and translations thereof) in respect of divisional applications, but also exempt the need for a priority claim or declaration to be made in respect of divisional applications, where such a priority claim is made in respect of the 'parent' application.

Draft Rule: Paragraph (4). No agreement could be reached on this paragraph and it was suggested that it be placed in square brackets in the next draft.

Among the problems expressed with respect to the paragraph, it was pointed out that the paragraph seemed to preclude the rejection of an application for lack of unity of invention, whereas such a ground of rejection existed presently in national practice.

Some delegations and representatives considered that the automatic selection of the invention or group of inventions first mentioned in the claims that was required by the paragraph operated to the prejudice of applicants, who should be provided with the opportunity to choose which invention or group of inventions should be elected for the purposes of search and examination. Other delegations favored the automatic selection prescribed by the Rule on the basis that it was conducive to a harmonized approach and to the eventual adoption of determinations of unity of invention and search reports made by other offices. The problem of arguing or appealing against a decision in non-search, non-examination countries was also referred to.

It was particularly pointed out by several delegations that the Notes on the draft Article and draft Rule had a special meaning and significance and should be retained with the draft Article and draft Rule for purposes of explanation."

Article 109: Restoration of the Right to Claim Priority

Article 109 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

"Where an application ('the subsequent application') claiming the priority of an earlier application is filed after the date on which the 12-month priority period provided for in the Paris Convention expired but before the expiration of a period of two months from that date, the industrial property office shall restore the right of priority

[Alternative A: upon payment of the fee prescribed for such restoration provided that the payment is made to the industrial property office before the expiration of the said two-month period.]

[Alternative B: upon an express request submitted to the industrial property office before the expiration of the said two-month period, if the request states and the industrial property office finds that, in

spite of due care, the subsequent application could not have been filed within the said 12-month priority period. The request for restoration shall state the grounds on which it is based, and the industrial property office may require the production of corresponding evidence. The request may be subjected to the payment of a fee to the industrial property office.]”

The portion of the report of the Committee of Experts concerning the discussion of Article 109 reads as follows:

“A number of delegations, somewhat fewer than in the last meeting of the Committee of Experts at which the Article was discussed, expressed doubts about the compatibility of the Article with the Paris Convention, mentioning, in particular, the differing standards that might apply in respect of the priority period between two countries that were both party to the Paris Convention, but only one of which was party to the Harmonization Treaty. Certain of these delegations also expressed the view that the subject matter of the Article would be more appropriately discussed within the context of the revision of the Paris Convention.

In respect of the Alternatives provided in the Article, a large majority of the delegations and representatives favored Alternative B, on the basis that an extension of the priority period should only be available where the filing of a subsequent application was delayed owing to circumstances beyond the control of the applicant, and that Alternative A amounted to a mere extension of the priority period by two months.

Some delegations and representatives requested that consideration be given to making Alternative A an option that could be provided by national law instead of Alternative B.

It was suggested that the International Bureau should give consideration to redrafting the Article so as to allow an extension of the priority period not only when the subsequent application was filed after the expiration of the priority period, but also when the subsequent application, although filed within the priority period, failed to include a priority claim.

It was also suggested that consideration be given by the International Bureau to the inclusion of a Rule related to Article 109 that would specify that an applicant would be permitted, following the submission of a request for an extension of the priority period within the two months following the expiration of the priority period, to submit within the next (third) month the grounds on which the request was based, as well as corresponding evidence.

A number of delegations expressed concern at the lack of provision for the safeguard of the rights of third parties. In this respect, it was noted that, if the

Article were silent on this question, national law could provide for the safeguard of the rights of third parties.

One delegation suggested that consideration be given to replacing the words ‘in spite of due care’ in lines 3 and 4 of Alternative B by the words ‘by frustration of the applicant’s intention formed in good time before the expiry of the priority period.’”

Article 301: Several Applications in Respect of the Same Invention

Article 301 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

“Where two or more applications have been filed in respect of the same invention, the application which has the earliest filing date, or, where priority is claimed, the earliest priority date, shall prevail.”

The portion of the report of the Committee of Experts concerning the discussion of Article 301 reads as follows:

“There was general agreement that it was necessary to have a separate Article which established clearly the principle of the first-to-file rule as far as it determines the right to the patent (it being understood that agreement to such a rule on the part of some delegations was subject to the rule forming part of a balanced treaty package).

It was also generally agreed that the function of Article 301 was independent of, and addressed a different question than, Article 202 (Prior Art Effect of Applications). The role of Article 202 was to determine, between two applications, that the disclosure in the earlier of those applications would, in the circumstances described in that Article, have a novelty-defeating effect in respect of the later application. Article 202 was, therefore, concerned with the patentability of the subject matter of applications. In contrast, Article 301 was not concerned with the patentability of the subject matter of an application or a patent, but with the right to the patent where two or more persons have made the same invention independently of each other.

Lengthy discussion took place concerning the way in which the Article establishing the first-to-file rule should be drafted. Concerning the present text of the Article, a number of delegations expressed difficulties with respect to the word ‘prevail.’ It was suggested that the Article, rather than the Notes, should make it clear that the application with the earliest filing date prevailed only if the other conditions of patentability were fulfilled. In this respect, it was suggested that words similar to the following could be added at the end of Article 301: ‘... provided that it fulfills all the requirements that an application has to fulfill to be eligible for the grant of a patent.’ It

was pointed out by some delegations, however, that reference to the conditions of patentability would include reference to the inventive step, with the result that the decision on a later application would have to await the examination of the earlier application. In addition, reference to the conditions of patentability might risk confusing the separate issues of patentability of subject matter and right to a patent.

Two major tendencies emerged concerning points of departure for the drafting of a new text for Article 301. The first suggestion, which enjoyed the support of a number of delegations and representatives, was to proceed on the basis of the provision contained in Article 60(2) of the European Patent Convention. The second suggestion, made by the Delegation of the United Kingdom and supported by several other delegations, was to draft the Article in such a way as to make it clear that an applicant could not base his application on any fact that occurred prior to the priority date, thereby excluding the possibility of invoking the fact that the invention was made earlier than the priority date and earlier than the invention claimed in the competing application. In respect of the second suggestion, it was pointed out that care would need to be exercised to ensure that such an Article would not exclude the possibility of bringing legal proceedings against a patent owner who had not separately made an invention but had derived it from someone else.

Opinions differed as to whether publication of the earlier application or of the patent granted on the basis of that earlier application was necessary. The intention of requiring that the earlier application or patent be published was to ensure that, if the earlier application was withdrawn before publication, it would have no effect on the entitlement of the inventor having filed the later application. While some delegations considered that publication should be necessary, other delegations considered that the question of publication related to Article 202 and should not affect the question of the right to a patent. In particular, the view was expressed that an applicant who abandoned an application should retain the right to defeat a later application even if that applicant's application was not published prior to abandonment. It was also pointed out that the requirement of publication could not operate satisfactorily in the Treaty unless all offices published applications.

One delegation suggested that further consideration should be given to the term 'same invention' in Article 301, or any later version of the Article, and, in particular, to the relationship between the term 'same invention' in Article 301 and the term 'novelty' in Articles 200 (Patentable Inventions) and 202 (Prior Art Effect of Applications). The delegation cited the example of an earlier application claiming subject matter that was only marginally

different from a later application. Experience indicated that, as a result of different practices and differing standards of novelty, in some cases patents issued on both applications, whereas in others the later application failed because of the similarity with the earlier application.

It was suggested by one delegation that a Rule relating to Article 301 should be added that would make it clear that a later applicant could file a divisional application in respect of any invention not anticipated by the earlier application.

One delegation expressed the view that Article 301 should regulate the precedence of two or more applications in respect of the same invention not only filed by different persons but also filed by the same person. Most delegations considered, however, that Article 301 should deal only with the right to a patent between two or more different applicants in respect of the same invention, and that the question of precedence of two or more applications by the same applicant in respect of the same invention should be resolved on the basis of Article 202.

A number of delegations considered that the reference in Article 301 to 'the same invention' should be replaced by reference to 'the same invention claimed.'"

Article 304: Determination of the Extent of Protection
Rule 304: Extent of Protection and Interpretation of Claims

Article 304 and Rule 304 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

Article 304

"The extent of the protection conferred by the patent shall be determined by the claims of the patent, with due regard to the description and drawings."

Rule 304

"(1) [Equivalents] (a) Any claim shall be considered to cover not only all the elements as expressed in the wording of that claim but also equivalents of any such elements.

(b) An element shall be considered as being equivalent to an element as expressed in the wording of the claim if it functions in substantially the same manner and produces substantially the same result as does the element as expressed in the wording of the claim.

(2) [Disclaimed Equivalents] Where the applicant or the owner of the patent has, in the description or during any procedure concerning the application or the patent, expressly stated that a specific equivalent element is not to be considered as covered by a claim, paragraph (1) shall not apply.

(3) [Examples] *If the patent contains examples of the embodiment of the invention or examples of the functions or results of the invention, the claims shall not be interpreted as limited to those examples.*

(4) [Combinations] *A claim for a combination of elements shall not provide independent protection for any of those elements taken separately or for a combination of less than all the said elements.*

(5) [Dependent Claims] *A dependent claim shall not provide independent protection for any of its elements taken separately from the elements of the claim on which the dependent claim depends.*

(6) [References to Drawings] *Any reference to a drawing or part of a drawing in a claim shall be construed as illustrative only and shall not be construed as limiting the extent of protection to what the drawing or part thereof shows.*

(7) [Abstract] *The abstract of a patent shall not be taken into account for the purpose of determining the extent of protection."*

The portion of the report of the Committee of Experts concerning the discussion of Article 304 and Rule 304 reads as follows:

"Article 304. It was agreed that the principles concerning the determination of the extent of protection contained in the Article and the Rule should apply also to the claims of a patent application for the purposes of provisional protection.

It was agreed that the Article should make it clear that it was not obligatory to take into account the description and drawings, but that the description and drawings should be considered only if necessary.

A number of delegations stated that they considered that the principles contained in Rule 304 were of fundamental importance and should be contained in the Article. Other delegations considered, however, that the principles contained in Rule 304 might be subject to evolution and should be retained in the Rule in order to facilitate their amendment by the Assembly of the Union in the light of experience with the application of the principles. Attention was drawn to a possible intermediate solution in which the subject matter of the Rule could be included in the Article and the final provisions of the Treaty would enable the Assembly to amend those provisions of the Article, subject to ratification of the change by a qualified majority of the Assembly.

Rule 304. The Delegation of the United States of America referred to and confirmed the proposal which it had made with respect to Rule 304 during the first part of the fifth session of the Committee of Experts (document HL/CE/V/3 Rev.), and to the fact that the present text of Rule 304 did not contain a statement making it explicit that a claim conferred

the rights specified in Article 302 (Rights Conferred by a Patent) against any product or process that fell within the literal wording of that claim (see paragraph (1) of the proposal in document HL/CE/V/3 Rev.). It was generally agreed that such a provision should be included as a minimum guarantee of protection either in a revised version of the present text of Rule 304(1)(a) or in an independent paragraph in the Rule. The Delegation of Japan stated that this provision should be deleted because there was a danger of a claim being interpreted in too broad a way in favor of the patentee, especially where the claim was not fully supported by the description or drawings.

The Delegation of France considered that Rule 304 should be preceded by a preliminary declaration analogous to the text of the Protocol on the Interpretation of Article 69 of the European Patent Convention and that the text of the Rule, particularly paragraphs (1) and (2), should be preceded by a sentence indicating that the provisions were concerned with principles. Reference was also made by one representative to the individual nature of each text and to the possibility of something like the said Protocol on the Interpretation of Article 69 of the European Patent Convention.

It was considered necessary to achieve a proper balance between the interests of the patentee, on the one hand, and the rights of third parties to be able to ascertain the scope of the monopoly with certainty, on the other hand.

Rule 304(1). It was generally agreed that it was necessary to provide for the protection of equivalents and that the present text of paragraph (1) provided a good starting point for the provision of that protection.

Rule 304(1)(a). Some delegations considered that only obvious equivalents should be protected, so that protection should not extend to equivalents which went to the heart of an invention and were not obvious to one skilled in the pertinent art. Other delegations, however, opposed such a limitation, on the basis that it confused the issues for patentability and infringement and that it would lead logically to the erroneous view that a patent of improvement could never constitute an infringement of the master patent.

Rule 304(1)(b). A number of delegations expressed concern that the wording of the present text, in particular, the words 'functions in substantially the same manner and produces substantially the same result,' was too broad. In the discussion of alternative wording, it was suggested that consideration be given to placing more emphasis on equivalence of result than of function and to the assessment of equivalence in the context of the invention as a whole.

It was suggested by one delegation that, in order to constitute an equivalent, it was not necessary that the element function in the same manner in every case, but only in the case of the invention. It was suggested that words similar to 'at least in regard to the invention' could be added after the word 'functions' in line two of Rule 304(1)(b).

Rule 304(2). It was agreed that the words 'to such equivalent' should be added at the end of the paragraph.

After some discussion, it was agreed that the word 'expressly' in line three should be retained, since a patent owner should be deprived of protection for an equivalent only if he had manifested an express intention to exclude the equivalent.

Rule 304(3). The text of the present provision was generally accepted, subject to the proposal referred to in the next paragraph.

The Delegation of the United States of America referred to paragraph (3) of the proposal for Rule 304 which it had made during the first part of the fifth session of the Committee of Experts (document HL/CE/V/3 Rev.). That proposal would introduce two amendments to Rule 304(3) that the Delegation considered necessary. First, it would expand on the principle that claims shall not be interpreted as limited to examples by making it explicit that additional features not found in disclosed examples, or the omission of the features found in disclosed examples, should not remove a product or process from the protection conferred by a claim. Secondly, the proposal would seek to make it clear that the fact that a product or process did not achieve every object or possess every advantage described in the patent would not, of itself, remove the product or process from the scope of protection conferred by the claim. It was agreed that consideration should be given to amending Rule 304(3) in order to accommodate the proposal.

The Delegation of Japan stated that it was conceivable that the scope of protection would have to be confined to what was clearly supported by examples or equivalents thereof, especially where the claim was not well supported by the description or drawings. The Delegation opposed both the text of paragraph (3) as proposed by the International Bureau and the proposal referred to in the preceding paragraph.

Rule 304(4). While there was general agreement that it was appropriate that protection of combination claims should not extend to the individual parts of the combination, it was considered that the present wording of the paragraph failed to give satisfactory expression to the principle. In particular, it was agreed that the second part of the paragraph ('or for a combination of less than all the said elements')

might unduly restrict protection of combination claims, and that the reference to 'elements' in the paragraph should be replaced by a reference to 'parts.'

It was suggested that the paragraph could be redrafted along the following lines: 'A claim for a combination shall not provide independent protection for the individual parts of the combination.' It was also suggested that, since understandings differed as to what constituted a combination claim, the Notes should explain what was meant by 'claim for a combination.' It was also pointed out that the proposed Rule seemed to exclude the possibility of indirect or contributory infringement.

Rule 304(5). It was agreed that this paragraph was unnecessary and should be deleted.

Rule 304(6). It was agreed that the present wording of this paragraph was too broad and required reconsideration.

In the discussion of the role of references to drawings in claims, a distinction was drawn between, on the one hand, references using words ('as shown by "a" in drawing No. 2') to drawings or parts of drawings that were essential to the understanding of the claim, and, on the other hand, references, by a sign, usually appearing in square brackets, (e.g., ["a", drawing No. 2]) which were inserted in claims with the intention that they be illustrations only and which were not essential to a reading of the claim. In the former case, the extent of protection might be limited by the reference, whereas, in the latter case, the reference was merely illustrative and did not limit the extent of protection. In order to express this distinction in the paragraph, and to ensure that reference signs were not construed in a limiting way, it was proposed that the paragraph be drafted so as to indicate that any reference to a drawing or part of a drawing in a claim shall be construed as illustrative only and shall not be construed as limiting the extent of protection to what the drawing or part thereof shows 'unless the claim clearly indicates otherwise.' It was further suggested that the Notes to the paragraph should define the circumstances in which a claim might be considered to indicate that a reference to a drawing or part of a drawing was not merely illustrative.

Rule 304(7). This paragraph was accepted in its present form.

Rule 304: Additional Paragraph. The Delegation of the United States of America expressed its support for the inclusion of an additional paragraph in Rule 304 in the same form as paragraph (5) of Rule 304, Alternative A of the previous draft Treaty (document HL/CE/V/2, page 89). An inconclusive

discussion took place concerning the merits of such a provision. Some delegations and representatives emphasized the essential fairness of requiring a patent owner to maintain the same interpretation of the claims in his patent, or in the application on which the patent was based, in proceedings before the patent office and in invalidation and infringement proceedings. Other delegations considered that such a provision would introduce problems of proof and fetter the independent jurisdiction of different administrative and judicial tribunals, and that the emphasis may be different in *inter partes* than in *ex parte* proceedings."

Article 306: Maintenance Fees

Article 306 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

"Applicants and owners of patents may be required to pay periodically to the industrial property office a fee for maintaining in force their applications and patents ('maintenance fee'). Such maintenance fees shall:

- (i) be for periods of one year each;*
- (ii) be payable for the fourth and subsequent years following the filing date of the application;*
- (iii) be due on the first day of the month following the month of the anniversary of the filing date of the application, provided that a period of grace of six months shall be allowed; the industrial property office may require the payment of a surcharge where advantage is taken of the period of grace."*

The portion of the report of the Committee of Experts concerning the discussion of Article 306 reads as follows:

"Opinions were evenly divided over whether maintenance fees constituted an appropriate matter for harmonization.

Those who favored the retention of an Article on maintenance fees pointed to the simplification of administration that could be achieved for both patent owners and industrial property offices through a uniform date for the payment of maintenance fees. On the side of industrial property offices, while some delegations considered that one uniform date for the payment of maintenance fees would cause a bunching of work and might have adverse consequences on cash flow, other delegations referred to favorable experience with one uniform date, which also had the advantage of making uniform the expiration of grace periods for failure to pay fees. On the side of patent owners, one uniform date was supported as facilitating the accurate programming of computer reminder

systems (since instructions were given for one day only, rather than 31).

Those delegations which considered that the Article should be deleted questioned whether the advantages to be derived from harmonization in this matter were sufficient to justify changes of their individual national practices.

Item (i). A number of delegations and representatives supported the introduction of an option for a patent owner, which Contracting States would be obliged to provide, to pay maintenance fees in advance. Such an option would simplify administration for patent owners, as well as enable the public to note clearly whether a patent was still in force.

Item (ii). A number of delegations expressed the view that maintenance fees should be prohibited before grant of the patent, on the basis that delays in the processing of applications were due to circumstances entirely beyond the control of the applicant. Other delegations considered, however, that maintenance fees on applications were justified in return for the provisional protection that an applicant would enjoy, and for the work being done in respect of an application by an office.

The majority of delegations considered that maintenance fees should be payable for the third and subsequent years following the filing date of the application. The Delegation of Japan stated that, once a patent had been granted, maintenance fees for the patent should be payable even within four years from the filing date.

Item (iii). There was no general agreement on which day should be selected as being the uniform due date for the payment of maintenance fees. Support was expressed for both the present text of item (iii) and the anniversary of the filing date of the application.

One delegation suggested that the uniform date selected for the payment of maintenance fees should correspond to the date for the commencement of the term of protection in Article 305 in order to avoid *pro rata* payments."

Article 307: Provisional Protection

Article 307 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

"(1) [Full Protection] (a) Subject to the other provisions of this Article, any invention that is claimed in an application for a patent shall, from the date on which the application was published by the competent authority, enjoy the same protection as if a patent had been granted for that invention with the claims as appearing in the published application.

(b) *Where the application is withdrawn or rejected and a person has made payments to the applicant in respect of claims in the application invoked by the applicant, or that person has suffered damage on account of such claims having been invoked by the applicant, the applicant shall reconstitute the said payments to that person and shall compensate that person for any damage suffered by him.*

(c) *Where the patent issued on the application does not contain certain claims that appeared in the published application, or contains claims that are narrower in their scope than the claims in the published application, and a person has made payments to the applicant in respect of claims invoked by the applicant that are not contained in the patent, or that are broader in their scope than the claims contained in the patent, or that person has suffered damage on account of such claims having been invoked by the applicant, the applicant shall reconstitute a corresponding part of the said payments to that person and shall give a corresponding compensation to that person for any damage suffered by him.*

(d) *The applicable national law may provide that the user of the invention claimed in the application who is not authorized by the applicant to use that invention must receive a written notice from the applicant indicating that the application is pending and indicating the serial number under which it was published; in such a case, the national law may also provide that the date of receipt of the notice shall, for the purposes of subparagraph (a), replace the date of the publication of the application.*

(e) *The applicable national law of a Contracting State may provide that, where that State is designated in an application filed under the Patent Cooperation Treaty or a treaty providing for the grant of regional patents, and the publication of that application is effected in a language other than the official language or one of the official languages of that State, the date corresponding to the provisions in the relevant treaty dealing with translations into an official language of designated States shall, for the purposes of subparagraph (a), replace the date of the said publication.*

(2) [Right to Compensation Only] *The national law may provide that the rights that an applicant would otherwise have under paragraph (1) shall be limited to a right to adequate compensation."*

The portion of the report of the Committee of Experts concerning the discussion of Article 307 reads as follows:

"Discussions were based on the broad principles of the approach in the present text of Article 307, namely, full protection for a published patent application, subject to the terms of paragraph (1), and a right to adequate compensation as a minimum guarantee, as set out in paragraph (2).

Article 307(1). There was general agreement that provisional protection for a published patent application, in its contents or its exercise, should not be the same as the full protection provided for a patent. In particular, the following limitations in respect of provisional protection received considerable support:

(a) Injunctive relief and criminal sanctions should not be available as part of the provisional protection.

(b) Some delegations considered that legal proceedings should not be able to be commenced before the grant of a patent. Other delegations expressed the view that legal proceedings ought to be permitted to commence, but that such proceedings should be suspended until after the decision on the patent application.

(c) The service of written notice on an infringer of the existence of a patent application and of the alleged infringement of that application or, alternatively, proof of actual knowledge on the part of the alleged infringer of the patent application and the alleged infringement of the patent application should be conditions for the obtaining of relief on the basis of provisional protection. The Delegation of France considered that it was desirable to distinguish between facts occurring before the date of publication of the patent application and those occurring after that date. The Delegation indicated that, in the latter case, a notice should not be required.

(d) Relief should also be conditional on the infringement constituting an infringement of both the claims of the patent application and of the granted patent or, at least, of claims in the patent application which were substantially the same as those in the granted patent. The Delegation of Japan stated that, where a written notice was required, the provisional protection should be granted in respect of the invention which was contained in both the written notice and the claims of the granted patent.

(e) It should be made clear that any provisions concerning the payment of damages or the restitution of damages paid should be able to be varied by free contractual arrangements between the alleged infringer and the patent applicant.

Article 307(2). It was agreed that the obligation should be a minimum rather than a maximum and that the minimum obligation on the part of Contracting States to provide provisional protection should encompass the right to damages on the part of a patent applicant. It was suggested by one delegation that, in the case of willful infringement, punitive damages should also be available to the patent applicant.

It was agreed that the International Bureau should prepare a new text of Article 307, taking into account the preceding observations and merging paragraphs (1) and (2)."

Article 308: Privilege of Prior User

Article 308 of the draft Treaty as submitted by the International Bureau to the Committee of Experts read as follows:

"(1) [Prior User] (a) Subject to subparagraphs (b) to (d), the owner of a patent shall not enjoy protection against the use, not authorized by him, of any invention that is claimed in his patent by a person ('the prior user') who, at the date of the filing of the application on which the patent is granted or, where priority is claimed, at the priority date of the application,

- (i) was actually using that invention, or
- (ii) was engaged in serious preparations, involving, from the viewpoint of the prior user, significant investment, for the actual use of that invention,

in the territory and any other place or space to which the sovereignty of the Contracting State extends and in or for which State the patent is granted.

(b) Where the prior user of any invention claimed in the patent obtained knowledge thereof through an unlawful act committed by him or any other person, subparagraph (a) shall not apply in respect of the said invention.

(c) Where the patent covers two or more inventions and the use or preparations referred to in subparagraph (a) related to one or some only of the inventions claimed in the patent, subparagraph (a) shall apply only to the latter invention or inventions.

(d) For the purposes of this Article, 'use' means only that kind or those kinds of activities in relation to the invention or inventions claimed in the patent that, at the date referred to in subparagraph (a), was or were actually carried out by the prior user, or for which the prior user was making serious preparations, with a view to the industrial or commercial exploitation of the invention or inventions.

(2) [Successor in Title of the Prior User] Paragraph (1) shall not apply to a successor in title of the prior user unless that successor in title is the owner of the enterprise or business, or that part of the enterprise or business, in which the prior user made the use or preparations referred to in paragraph (1)(a)."

Owing to lack of time, the Committee did not discuss Article 308 and decided to postpone its consideration of that Article to its next session.

Future Work

It was agreed that the seventh session of the Committee of Experts would be held in Geneva from November 13 to 24, 1989.

LIST OF PARTICIPANTS**

I. Member States

Algeria: K.H.A. Benhamza; H. Yahia-Cherif. **Argentina:** A.G. Trombetta. **Australia:** P.A.D. Smith. **Belgium:** G. De Cuyper. **Brazil:** G. Ferreira Martins; P.R. de Almeida; A.R. Holanda Cavalcanti; T. da Silva Nunes. **Bulgaria:** M. Tosheva. **Cameroon:** I. Meutcheye. **Canada:** J.H.A. Gariépy; A. Troicuk. **China:** Gao Lulin; Ma Yao-Yang. **Côte d'Ivoire:** A. N'Takpe N'Cho. **Czechoslovakia:** J. Hak; M. Hujerova. **Denmark:** L. Østerborg; K. Gudmand; N. Ravn. **Egypt:** N. Gabr. **Finland:** E.-L. Viikonen; E. Häkli; E. Nourlahti-Solarmo. **France:** J. Divoy. **German Democratic Republic:** S. Schröter. **Germany (Federal Republic of):** I. Koch; W. Niedlich; H. Bardehle. **Ghana:** J.P. Wartemberg; A.M. Abdullah. **Hungary:** I. Iványi; M. Sümeghy; Z. Szabó. **Indonesia:** I. Cotan; E. Jusin. **Ireland:** B. O'Farrell. **Israel:** M. Cohn. **Italy:** M. Carro Sciamanna. **Japan:** F. Yoshida; T. Yoshida; S. Uemura; Y. Muranaga; K. Sato. **Madagascar:** M.-F. Narove. **Mexico:** A. Fuchs. **Netherlands:** W. Neervoort. **Nigeria:** G.E. Okafor. **Norway:** P.T. Lossius; E. Liljegen. **New Zealand:** A. Macey. **Philippines:** D. Menez-Rosal. **Poland:** G. Lachowicz. **Portugal:** J. Mota Maia. **Republic of Korea:** T.-C. Choi; W.T. Kim. **Senegal:** A. Ndiaye. **Soviet Union:** A. Kortchagine. **Spain:** J. Gómez Montero. **Sweden:** R. Halvorsen; B. Sandberg. **Switzerland:** J.-L. Comte; E. Caussignac; F.A. Jenny. **Tunisia:** H. Tebourbi. **Turkey:** A. Algan. **United Kingdom:** A. Sugden; P. Hayward; H.E. Griffiths. **United States of America:** D.J. Quigg; M.K. Kirk; L.J. Schroeder; R.F. Burnett; L. Boland. **Zambia:** O.M.M. Banda.

II. Observer States

Bangladesh: M.I. Talukdar. **Chile:** P. Romero. **Colombia:** J.M. Cano. **Ecuador:** R. Rivadeneira. **El Salvador:** M. Gallegos Nejandro. **Honduras:** N. Valenzuela. **India:** L. Puri. **Panama:** M. Saavedra Polo. **Paraguay:** V. Abente.

III. Intergovernmental Organizations

Commission of the European Communities (CEC): S. Jessel; L.M. Ferrão. **European Patent Office (EPO):** U. Schatz; A.G. Rémond; R. Teschemacher; G. Kolle; V. Ahmann. **General Agreement on Tariffs and Trade (GATT):** A. Subramanian. **Latin American Economic System (SELA):** N. Elkin.

IV. Non-Governmental Organizations

American Bar Association (ABA): W.B. Brunet. **American Intellectual Property Law Association (AIPLA):** W.S. Thompson; J.A. De Grandi; H.R. Workman. **Asian Patent Attorneys Association (APAA):** I. Shamoto; Y. Inoue. **Bundesverband der Deutschen Industrie (BDI):** H.-J. Schulze-Steinen; H. Goldrian. **Center for Advanced Study and Research on Intellectual Property (CASRIP):** D.S. Chisum; A.G. Trampusch; H. Aizawa. **Centre for International Industrial Property Studies (CEIPI):** B. de Passemar. **Chartered Institute of Patent Agents (CIPA):** R.C. Petersen. **Committee of National Institutes of Patent Agents (CNIPA):** R.C. Petersen. **European Council of Chemical Manufacturers' Federations (CEFIC):** H.-J. Schulze-Steinen. **European Federation of Agents of Industry in Industrial Property (FEMIP):** G. Tasset. **Federal Chamber of Patent Attorneys (FCPA):** G. Schmitt-Nilson. **Institute of**

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

Professional Representatives Before the European Patent Office (EPI): R.C. Petersen. **Intellectual Property Owners, Inc. (IPO):** R.C. Witte. **Inter-American Association of Industrial Property (ASIPI):** J.A. De Grandi. **International Association for the Protection of Industrial Property (AIPPI):** M. Santarelli; J. Pagenberg. **International Chamber of Commerce (ICC):** J. Buraas. **International Federation of Industrial Property Attorneys (FICPI):** G. Schmitt-Nilson; J. Beier. **International Federation of Inventors' Associations (IFIA):** C.P. Feldmann. **International Federation of Pharmaceutical Manufacturers Associations (IFPMA):** R.B. Arnold; H.-J. Schulze-Steinen. **Japan Patent Association (JPA):** T. Hayashi. **Japanese Patent Attorneys Association (JPAA):** I. Shamoto. **Latin American Association of Pharmaceutical Industries (ALIFAR):** M.N. Levis; R. Zavalla Carbó. **Max Planck Institute for Foreign and International Patent, Copyright and Competition Law (MPI):** J. Pagenberg. **New York Patent, Trademark and Copyright Law Association, Inc. (NYPTC):** W.J. Brunet. **Pacific Industrial Property Association (PIPA):** K. Kamisugi. **Trade Marks, Patents and Design Federation (TMPDF):** J.L. Beton. **Union of European Practitioners in Industrial Property (UEPIP):** R. Goetz. **Union of Industrial and Employers' Confederation of Europe (UNICE):** H.-J. Schulze-Steinen; J.L. Beton; H. Goldrian.

V. Bureau

Chairman: J.-L. Comte (Switzerland). *Vice-Chairmen:* M. Abdullah (Ghana); A. Kortchagine (Soviet Union). *Secretary:* L. Baeumer (WIPO).

VI. International Bureau of WIPO

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

Studies

**The African Intellectual Property Organization (OAPI)
from Libreville to Bangui**

B. CAZENAVE*

News Items

CYPRUS

*Official Receiver and Registrar of
Patents and Trade Marks*

We have been informed that Mrs. Maria A. Kyriacou has been appointed Official Receiver and Registrar of Patents and Trade Marks.

DEMOCRATIC PEOPLE'S REPUBLIC OF KOREA

Chairman, Invention Committee

We have been informed that Mr. Kim Ung Ho has been appointed Chairman of the Invention Committee.

Calendar of Meetings

WIPO Meetings

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

1989

- September 25 to October 4 (Geneva)** **Governing Bodies of WIPO and the Unions Administered by WIPO (Twentieth Series of Meetings)**
 All the Governing Bodies of WIPO and the Unions administered by WIPO meet in ordinary sessions every two years in odd-numbered years.
 In the sessions in 1989, the Governing Bodies will, *inter alia*, review and evaluate activities undertaken since July 1988, and consider and adopt the draft program and budget for the 1990-91 biennium.
Invitations: States members of WIPO and the Unions and, as observers, other States members of the United Nations and certain organizations.
- September 26 (Geneva)** **Permanent Committee on Industrial Property Information (PCIPI) (Second Session)**
 The Committee will discuss its main activities and plans for the future.
Invitations: States and organizations members of the Committee and, as observers, certain other States and organizations.
- October 9 to 13 (Moscow)** **International Forum on the Role of Industrial Property in Economic Cooperation Arrangements** (organized jointly with the State Committee for Inventions and Discoveries of the Soviet Union)
 The Forum will deal with questions of industrial property in joint ventures (among capitalist and socialist countries) and other cooperative economic arrangements (among capitalist and socialist countries), particularly in the field of the transfer of high technology, trade in goods bearing trademarks and franchizing of services.
Invitations: The Forum will be open to the public. Participants, other than representatives of governments, will be requested to pay a registration fee.
- November 1 and 2 (Beijing)** **Worldwide Symposium on the International Patent System in the 21st Century** (organized jointly with the Chinese Patent Office)
 The Symposium will be conducted in three half-day sessions, each dealing with one of the following three topics: internationalization of the patent system; computerization of the patent system; patent documentation, search and examination.
Invitations: States members of WIPO, certain intergovernmental organizations and non-governmental organizations having observer status in WIPO.
- November 6 to 10 (Geneva)** **Committee of Experts on Model Provisions for Legislation in the Field of Copyright (Second Session)**
 The Committee will continue to consider proposed standards in the field of literary and artistic works for the purposes of national legislation on the basis of the Berne Convention for the Protection of Literary and Artistic Works.
Invitations: States members of the Berne Union or WIPO and, as observers, certain organizations.
- November 13 to 24 (Geneva)** **Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Inventions (Seventh Session)**
 The Committee will continue to examine a draft treaty on the harmonization of certain provisions in laws for the protection of inventions.
Invitations: States members of the Paris Union and, as observers, States members of WIPO not members of the Paris Union and certain organizations.
- November 27 to December 1 (Geneva)** **Committee of Experts on the Harmonization of Certain Provisions in Laws for the Protection of Trademarks (First Session)**
 The Committee will examine the draft treaty provisions on the harmonization of certain provisions in laws for the protection of trademarks.
Invitations: States members of the Paris Union and, as observers, States members of WIPO not members of the Paris Union and certain organizations.

UPOV Meetings

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

1989

October 16 (Geneva)

Consultative Committee (Fortieth Session)

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

Invitations: Member States of UPOV.

October 17 and 18 (Geneva)

Council (Twenty-third Ordinary Session)

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

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

Other Meetings Concerned with Industrial Property

1989

December 5 to 9 (Munich)

European Patent Organisation (EPO): Administrative Council

