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Contents

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Notifications Concerning Treaties

WIPO Convention

I. Ratification

MADAGASCAR

The Government of Madagascar deposited, on September 22, 1989, its instrument of ratification of the Convention Establishing the World Intellectual Property Organization, signed at Stockholm on July 14, 1967.

The said Convention, as amended on October 2, 1979, will enter into force, with respect to Madagascar, on December 22, 1989.

WIPO Notification No. 146, of September 22, 1989.

II. Accessions

DEMOCRATIC YEMEN

The Government of Democratic Yemen deposited, on September 27, 1989, its instrument of accession to the Convention Establishing the World Intellectual Property Organization.

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

The said Convention, as amended on October 2, 1979, will enter into force, with respect to Democratic Yemen, on December 27, 1989.

WIPO Notification No. 148, of September 27, 1989.

THAILAND

The Government of Thailand deposited, on September 25, 1989, its instrument of accession to the Convention Establishing the World Intellectual Property Organization.

The said Convention, as amended on October 2, 1979, will enter into force, with respect to Thailand, on December 25, 1989.

WIPO Notification No. 147, of September 25, 1989.

Madrid Agreement (Marks)

New Member of the Madrid Union

CUBA

The Government of Cuba deposited, on September 6, 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.

The said instrument of accession contains the following declaration:

> "The Government of the Republic of Cuba declares that the provisions of Article 24 of the Paris Convention, referred to in Article 14(7) of the Madrid Agreement, both as revised at Stockholm on July 14, 1967, are contrary to the Declaration on the Granting of Independence to Colonial Countries and Peoples (resolution 1514) adopted by the General Assembly of the United Nations on December 14, 1960, which proclaims the necessity of putting a speedy and unconditional end to colonialism in all its forms and manifestations." *(Translation)*

The Government of Cuba has also notified the Director General of WIPO that Cuba avails itself of the possibility offered by Article 3*bis* of the Madrid Agreement, according to which the protection resulting from the international registration shall extend to Cuba only at the express request of the proprietor of the mark. Furthermore, in accordance with Article 14(2)*(d)* and *(f)* of the Madrid Agreement, the application of that Agreement shall be limited to marks registered from the date on which the accession of Cuba enters into force.

Cuba 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 at Stockholm on July 14, 1967, and amended on October 2, 1979, will enter into force, with respect to Cuba, on December 6, 1989. On that date, Cuba will become a member of the Madrid Union.

Madrid (Marks) Notification No. 42, of September 6, 1989.

Activities of Other Organizations

International Association for the Protection of Industrial Property (AIPPI)

World Industrial Property Congress
(Amsterdam, June 4 to 10, 1989)

NOTE*

Introduction

The International Association for the Protection of Industrial Property (AIPPI) held its XXXIVth Congress in Amsterdam (Netherlands) from June 4 to 10, 1989. Mr. Johannes B. van Benthem (President of AIPPI) presided over the Congress, which was opened by Mr. A.J. Evenhuis (State Secretary for Economic Affairs of the Netherlands). The work of the Congress was followed by approximately 2,000 members of AIPPI. Ten goverments, as well as several intergovernmental organizations and international non-governmental organizations were represented.

The World Intellectual Property Organization (WIPO) was represented by its Director General, Dr. Arpad Bogsch, Mr. Alfons Schäfers (Deputy Director General) and Dr. Ludwig Baeumer (Director, Industrial Property Division).

At the opening ceremony, the Director General of WIPO delivered an address which is reproduced below.

The Congress dealt in plenary sessions with the following questions: dependent patents and their exploitation; absolute grounds of refusal of registration of trademarks; what may constitute a registrable trademark; harmonization of certain provisions of legal systems for protecting inventions; rights of a prior user of an invention; non-confusing use of another's trademark.

During the same period, the Executive Committee of AIPPI and the Council of Presidents of AIPPI held several meetings. The work of the Congress culminated with the ratification, by the Executive Committee of AIPPI, of a number of resolutions and guidelines, the essential contents of which are also reproduced below.

The Executive Committee also elected the new President and the Bureau of AIPPI. The new President is Eishiro Saito (Japan). The new Bureau is composed as follows: Executive President: Masahiko Takeda (Japan); Executive Vice-President: G. Alexander Macklin (Canada); Secretary General: Martin J. Lutz (Switzerland); Reporter General: Geoffrey Gaultier (France); Treasurer General: Joseph A. DeGrandi (United States of America); Assistant Secretary General: Peter D. Siemsen (Brazil); Assistant Reporter General: Thierry Mollet-Viéville (France); Assistant Treasurer General: Teartse Schaper (Netherlands).

Address by the Director General of WIPO

"Mr. State Secretary for Economic Affairs, Evenhuis,
Mr. President of AIPPI, van Benthem,
Mr. Executive President of AIPPI, Schaper,
Excellencies,
Ladies and Gentlemen,

The World Intellectual Property Organization, in whose name I have the honor to speak today, congratulates your Association, the International Association for the Protection of Industrial Property, in the work accomplished by it since its last Congress.

The Congress, held in London, is still vividly in the memory of most of us and, with your permission, I hereby express once more our thanks to the British Group which organized it. It was a Congress that gave the decisive impetus for the achievements of the last three years.

The World Intellectual Property Organization, as always, follows and participates in your work with the greatest interest. Your Association, composed of most prominent specialists in the field of industrial property, gives ideas and inspiration in the World Organization's endeavors to improve the protection and the administration of industrial property rights. Contributions of your Association's representatives to WIPO meetings stand out by their quality and balanced thoughtfulness. Without you, our work would have far less chance to be useful for the owners of industrial property rights and the patent and trademark attorneys and agents.

It is in the hope that it will further stimulate cooperation between AIPPI and WIPO that I shall now inform

* Prepared by the International Bureau of WIPO.

you about WIPO's more significant recent activities and future plans.

I shall first deal with norm-making, enforcement and dispute settlement.

In the field of norm-making, the preliminary work for a possible multilateral treaty for the harmonization of patent laws is in its fifth year. It deals, among other things, with the filing date of applications, the grace period, provisional protection, the first-to-file system, the manner of describing and claiming an invention, the publication of patent applications and the administrative revocation of patents, the restoration of the right to claim priority and the privilege of the prior user which is on the agenda of this Congress. Arriving, in these matters, at a fairly similar system in the various countries would save a lot of work and, above all, would make patenting more predictable and decrease the danger of errors. In other words, it would make patent applications and prosecution more secure. The preparatory work should end in 1990 and the treaty is planned to be concluded in 1991.

Still in the field of norm-making, the work of the World Intellectual Property Organization is expected to deal more and more with trademarks and biotechnological inventions.

Still in the field of norm-making, a multilateral treaty on the protection of intellectual property in respect of integrated circuits was concluded last month in a diplomatic conference in which 73 countries participated.

I come now to enforcement and dispute settlement.

In the field of enforcement, the introduction of stronger measures in national laws seems to be the most promising method. The need for such stronger measures is particularly felt in the case of counterfeiting, mostly connected with violations of the rights of the owners of trademarks. The World Organization is in the process of preparing a model law which defines counterfeiting and provides for efficient measures for the obtaining of evidence and the punishment of counterfeiters. The final version of the model law should be completed in 1990 or 1991.

In the field of dispute settlement, the Washington Diplomatic Conference on Integrated Circuits of last month was a breakthrough. We have now a treaty—not yet in force but adopted—which, for the first time in history, provides for the handling of intellectual property disputes among States within the framework of WIPO. The disputes would be on the question whether a Contracting Party fulfills its treaty obligations. A separate panel of experts would be established for each dispute, and the procedure may end by a recommendation of the Assembly of the Contracting Parties. All this would be done in the framework of the World Intellectual Property Organization.

This breakthrough or innovation may lead to a further step in the framework of WIPO, namely, the establishment of a general treaty which would set up a dispute settlement mechanism for all *treaties administered by WIPO whether in the field of industrial property or copyright. Proposals for exploring the establishment of such a general treaty will be before the competent intergovernmental bodies of WIPO in September of this year.*

In concluding my remarks concerning norm-making, enforcement and dispute settlement, I wish to refer to the activities of GATT which, in the field of intellectual property, also deal with the same three subjects. Those activities are part of the so-called Uruguay Round of negotiations, negotiations which have been going on for some two-and-a-half years. Will those negotiations and the activities going on in WIPO be 'mutually supportive'—an expression used in GATT resolutions—or will they introduce some confusion in international industrial property relations? This is a question of vital importance whose solution is of direct interest to all those working on better international protection, among them, in particular, naturally, your Association.

I leave now the field of norm-making, enforcement and dispute settlement and turn to WIPO's so-called "registration activities." Among those activities, the PCT, the Madrid Agreement and the Hague Agreement are in the forefront.

The Patent Cooperation Treaty or PCT is used by more and more applicants. In the last three years, the increase in the number of applications was an average of 19% and the number of international applications filed in the current year of 1989 is expected to be 15,000. Canada and Spain are among the countries that plan to accede to the PCT before the end of this year. The worldwide, steep increase in patent applications naturally raises the question whether the PCT system should not be further developed to make it more efficient. For the time being, such an idea does not seem to be greeted—to put it mildly—by everybody with enthusiasm. In any case, the problems caused by the increasing numbers of applications—not only in the PCT but also in many national offices and the European Patent Office—might lead into a crisis situation in the next decade which will have to be alleviated somehow. Unmanageable work loads in the patent offices, inordinately long delays and too steep an increase in costs endanger the credibility of the patent system of today.

In the field of the international registration of trademarks, the next weeks should lead to innovations. There is going to be a diplomatic conference in Madrid which, by the end of this month, will, hopefully, adopt a protocol to the Madrid Agreement. That protocol should introduce changes which are intended to serve two purposes. One is to make it possible for countries not yet members of the Madrid system to become members of that system; this aim should be achieved by making changes that make the adaptation of the national laws and practices of such countries to the Madrid system easier. The other purpose to be achieved by the proposed protocol is to make the future Community Trade Mark system so-to-say interactive with the Madrid system, that is, to allow internationally registered marks to designate the European Communities, and to allow Community

registrations to be the basis of international registrations.

In any case, it is to be noted that the increase in the number of international trademark registrations is as steep as the increase in the PCT.

The same is true for the international deposit of industrial designs under the Hague Agreement. Nevertheless, there too, some updating of the system is desired by many and might be the subject of preliminary studies starting next year. Another objective of these studies would be to examine whether the system should not introduce innovations that would make it easier for non-members of the Hague Union to become members of that Union. An increase in membership is, indeed, desirable, since the present membership covers only a relatively small territory.

Looking forward into what the next century could or should bring in international relations will be the topic of a top-level international WIPO Symposium in Beijing at the beginning of next November.

And, speaking about top-level meetings of interest to professionals, I mention also the WIPO Forum on joint ventures and industrial property that will take place in Moscow next October.

I hope that a great number of AIPPI members will participate in those two events.

In conclusion, Ladies and Gentlemen, I shall say a few words about WIPO's two main Conventions, the Paris Convention and the Berne Convention.

Membership in the Paris Convention continues to increase and now stands at 99. There are a few very important countries still missing, among them India and Pakistan and several Latin American countries.

The Conference on the Revision of the Paris Convention does not seem to advance. Since inventors' certificates are likely to be abolished in the Soviet Union, one of the problems for which the Conference was called will cease to exist. There remain, of course, the other questions, particularly Article 5A on compulsory licenses. Maybe those questions could be further explored in connection with the planned Patent Law Harmonization Treaty. The further steps will be discussed in the Assembly of the Paris Union next September.

The Berne Convention is enjoying a renaissance thanks to the accession of the United States of America, accession that became effective last March. There is hope that accession by the Soviet Union will occur in the not too distant future. China is not a member, but China is working on a copyright law which, it is hoped, will be compatible with the Berne Convention.

This is where matters stand today.

To their further development, your Association will, as in the past, doubtless make decisive contributions.

Your present Congress, so ably organized by the Dutch Group in general and by Bob van Benthem and Teartse Schaper in particular, will set the policy for such contributions for the next three years.

The World Organization thanks, very warmly, the Dutch organizers as well as the main office holders of AIPPI for the role they give to WIPO in this Congress and wishes them and all participants a socially pleasant and a professionally useful meeting."

Resolutions Adopted

Protection of Computer Software

RESOLUTION

....

1. *Scope of Protection*

1.1 AIPPI *acknowledges* that computer software is protectable as written work within the framework of the copyright law.

1.2 AIPPI *notes* that the EC Proposal for a Council Directive on the legal protection of computer programs COM(88)816—final in Article 1(2) is in line with that view, the term "literary work" being understood in the broad sense of Article 2 of the Berne Convention.

1.3 AIPPI *reaffirms* that ideas are not protectable by copyright.

1.4 AIPPI *notes* that for the moment it is not possible to provide firm guidelines as to the breadth of protection and as to the borderline between "idea" and expression. The protection should certainly cover slavish copying, but the degree of extension beyond that must be determined on a case-by-case basis.

1.5 AIPPI *notes* that the EC Proposal for a Council Directive in Article 1(3) is in conformity with that view, except that the words "logic" and "algorithm" are not clear in scope.

1.6 AIPPI *believes* it appropriate to consider that the scope of protection should be proportional to the range of possibilities of expression available to the programmer. The "idea" should not be interpreted too broadly. Furthermore the mere fact that an alternative expression of the idea is possible should not imply that the chosen form of the expression of the idea must be protectable.

2. *Permissible Analyzing*

2.1 *Reaffirming* the resolutions passed at Rio in May 1985 and at Sydney in April 1988, stating that there may be a need for special rules on certain aspects of software protection, AIPPI believes it is important that making a copy of a legally acquired program should be allowed when this is necessary so as to analyze the program for extracting its "idea," so that free access to the unprotected idea is not prevented.

2.2 AIPPI *believes* that the law of contract may allow clauses according to which such copying may be prohibited, but that national law may make such clauses unenforceable, provided that such national law does not impair the legitimate interests of the copyright owner pursuant to Article 9(2) of the Berne Convention.

2.3 AIPPI *notes* that the EC Commission Proposal does not deal with these problems.

3. *Definition of Software*

AIPPI *is of the opinion* that the elements of software which are involved in the operation of a computer are worthy of protection, irrespective of the carrier therefor. Thus logic

devices should not be excluded from copyright protection, to the extent that they express software.

4. *Author of a Computer Program*

4.1.1 AIPPI *observes* that according to general rules of copyright everyone who has made a creative contribution to a computer-generated program has to be regarded as (one of) its author(s). In principle this may be the creator of the generating program, the creator of the program generated, or both.

4.1.2 AIPPI *is of the opinion* that the authorship can be assessed in particular by evaluating to what extent elements of the generating program appear in the program generated.

4.1.3 AIPPI *notes* that, where the creator of the program generated has copyright rights on the basis of the above assessment, he should be able to have his rights enforced independently.

4.2.1 AIPPI *observes* that in an increasing number of countries it is recognized that a legal person can be the original author of a computer program.

4.2.2 AIPPI *observes* that in other countries the author is a natural person and the copyright may vest directly in a legal person.

4.2.3 AIPPI *sees no objection* in a legal person being the original author of a computer program, nor in vesting the copyright directly in a legal person.

4.2.4 AIPPI *reaffirms* the Resolution adopted at Rio in May 1985 that, due to the special commercial nature of software, moral rights should apply to computer programs to an appropriate extent, and believes that it should be possible for them to be waived by the author.

5. *Copying for Private Use*

5.1 AIPPI *reaffirms* its Resolution adopted in Rio in May 1985 that copies for safety reasons (back-up copies) should be allowed.

5.2 AIPPI, while recognizing the difficulties of enforcement of the copyright, *is of the opinion* that copying for private use should not be allowed if such private use saves the user from having to purchase another copy of the program.

5.3 AIPPI *reaffirms* point 3*(b)* of its Resolution adopted in Rio in May 1985 that an author of a program should not be entitled to prohibit adaptation or improvement of his program by a user for his own needs, but provided such alteration is necessary for the intended use for which the first program was designed.

6. *"Shrink-Wrap" Licenses*

AIPPI *is of the opinion* that the validity of "shrink-wrap" licenses is a question of national law, and that such "shrink-wrap" licenses should not unduly restrict the rights of the user.

7. *Liquidation of the Supplier of Computer Software*

Considering that in some countries the liquidator of a company in bankruptcy or similar procedures has the power to disregard existing contracts:

AIPPI *is of the opinion* that the liquidator should not have undue power against a licensee of a computer program to terminate or vary the license, and should not have undue power to inhibit maintenance of a program.

Prior Use

RESOLUTION

The working committee considered the two texts of Article 308 as set out in WIPO documents HL/CE/V/2 and HL/CE/VI/3 Add. as well as the reports of the National Groups (*Yearbook* 1988/V) as summarized in *Rapport de Synthèse* (*Yearbook* 1989/I). The reports of the Groups were based on the HL/CE/V/2 text.

It was clear from the reports of the National Groups that any prior user rights should be limited to those activities which were carried and/or contemplated by the prior user and that any rights or privileges accorded to him should be restricted to those activities.

However, the text of HL/CE/VI/3 Add. drafted by WIPO prior to the sixth session of the Committee of Experts in Geneva (April 1989), introduced in the preamble, the concept of "use of the invention" which needed to be qualified by the subsections to a "restricted" use. The working committee being faced with this new text chose to simplify it and proposes the following amended text:

"*Article 308*
Privilege of Prior Use

(1)*(a)* Subject to subparagraph *(b)*, the owner of a patent shall not enjoy, under that patent, rights against activities within the scope of the patent, not authorized by him, of a person (the prior user) who, at the date of the filing of the application, or where priority is claimed, at the priority date of the application on which the patent is granted, and with a view to industrial or commercial exploitation,

(i) was actually engaged in such activities, or
(ii) was engaged in serious preparations, involving, from the viewpoint of the prior user, significant investment, for such activities,

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.

It is understood that the expression 'industrial or commercial exploitation' comprises every form of exploitation for useful or economic purposes.

(b) Where the prior user engaged in activities or preparations therefor obtained knowledge of the invention protected by the patent from or in consequence of acts performed by the owner of the patent or his predecessor in title, subparagraph *(a)* shall not apply in respect of the said activities.

(2) 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 engaged in the activities or preparations referred to in paragraph (1)*(a)*."

AIPPI *is of the opinion* that the rule should be mandatory.

Absolute Grounds of Refusal of Registration of Trademarks

What May Constitute a Registrable Trademark?

RESOLUTION

AIPPI,

— *having studied* the question which signs may be registered as trademarks,

— *observing* that national law and practice show a number of differences with respect to this question,

— *observing* that national laws which are similar or even identical and international conventions have in practice been subjected to differing interpretations,

— *observing* that the national groups of a number of countries consider future development of law and practice as desirable,

— *observing* that very recently an effort towards harmonization has been made by the 12 countries of the European Communities having different laws and practices, in the form of the so-called "Council Directive of December 21, 1988, to Approximate the Laws of the Member States Relating to Trade Marks" (*Official Journal of the European Communities*, February 11, 1989), and that there exists a draft Council Regulation on the Community Trade Mark of 1988 and that consequently such important documents should be taken into account,

— *observing* that the registrability of trademarks is a subject of continuing evolution,

— *believing* that the rules concerning absolute grounds for refusal listed in Article 6*quinquies* of the Paris Convention could constitute a model for the international harmonization of trademark law,

takes the following position:

A. Absolute Grounds for Refusal of Registration of Trademarks

AIPPI *believes* that:

1. whilst great attention should be given to eliminating undue restrictions upon trademark owners as to the absolute grounds for refusal of registration of trademarks, there is a need for the public and undertakings in general to use signs which are common to a specific trade, industry, product or service, that the public should not be misled by the trademark, and that under specific conditions (immoral marks, public order, "flags," etc.) the registration of certain signs should be forbidden;

2. countries which have strict rules as to absolute grounds for refusal of registration of trademarks should look at those countries where the rules are more relaxed to see whether problems have in practice arisen in those countries due to their being more relaxed;

3. legal terminology can have a different significance from one country to another and consequently such terminology should be defined and examples be given to illustrate such definitions as far as possible;

4. for word marks most of the criteria of registrability are closely linked to the language, national or foreign, and that as language and its knowledge can evolve so can these criteria.

I. Absence of Distinctive Character

AIPPI *observes* that:

5. most countries agree that the main function of the trademark is to distinguish goods and services of one undertaking from the goods and services of another undertaking, and that the distinctive character is relative in the sense that it must be evaluated in relation to the goods and services to which the trademark is applied.

AIPPI *believes* that:

6. a sign is distinctive when, to those to whom it is addressed, it is recognized as identifying goods or services from a particular trade source, or is capable of being so recognized;

7. the distinctive character can evolve and, consequently, that by taking appropriate measures it can be acquired or increased and that by inappropriate conduct it can diminish and possibly disappear;

8. a trademark which has little distinctive character enjoys a narrower scope of protection than a trademark which has a strong distinctive character;

9. different categories of trademarks and registers should not be created depending on degrees of distinctiveness;

10. when a composite trademark contains non-distinctive works, or elements in case of a device trademark, the applicant may be asked to disclaim such words or elements of his trademark.

1. Absence of Requirement of Novelty and Originality

AIPPI *believes* that:

11. the distinctive character of a trademark is not to be confused with its novelty and originality, neither of which is a condition of distinctiveness;

12. simple signs, which are commonplace or lack originality, should not be excluded *per se* from registration;

13. distinctiveness can result from the presentation of a sign that otherwise lacks it.

2. Signs that Cannot be Monopolized

AIPPI *confirms* that:

14. the trademark law cannot permit the monopolization of certain signs that must be free in order to permit the public and undertakings to designate a product or a service or describe its characteristics. These signs are:

(a) necessary signs,
(b) generic signs,
(c) signs in common use,
(d) exclusively descriptive signs.

(a) The Sign Must Not be Necessary

AIPPI *observes* that:

15. a sign is necessary when the use thereof is required to identify the designated goods or services or when the use thereof is imposed by nature of function;

16. when the sign is a word it is necessary when its use is required by the rules of the language;

17. when the sign is a device it is necessary when it exactly represents the goods or services identified thereby.

AIPPI *believes* that:

18. a sign which is necessary cannot enjoy a distinctive character and consequently cannot function as a trademark;

19. if such a sign is a word, however, it can have or acquire distinctive character if it is a deformation of an existing word such as a misspelling or abbreviation, or if the existing word is contained in the trademark;

20. if such a sign is a device it can have or acquire distinctive character by its manner of presentation.

(b) The Sign Must Not be Generic

AIPPI *observes* that:

21. a sign is generic when it defines a category or a type to which the goods or services belong.

AIPPI *believes* that:

22. the criteria which have been laid down for necessary signs should be applied to generic signs.

(c) The Sign Must Not be in Common Use

AIPPI *observes* that:

23. a sign in common use is one which is not imposed by the requirements of the language but is generally and habitually used to identify the goods or services (for instance, colloquial words);

24. the terms "in common use" and "generic" are often used one for another, but in reality their significance is different.

AIPPI *believes* that:

25. a sign can be considered as being in common use if it is used generally and habitually by the public, and the public can either be, taking into consideration the kind of goods or services involved:

— the general public,
— a substantial part of the public,
— the consumers involved,
— the undertakings involved;

26. the criteria which determine whether and from which moment a word has become commonly used are purely factual;

27. a sign in common use may cease to have that character and become registrable.

(d) The Sign Must Not be Exclusively Descriptive

AIPPI *believes* that:

28. a term is descriptive if it consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the services, or other characteristics of the goods or services;

29. a sign consisting exclusively of a descriptive element should not be registrable as a trademark;

30. a sign consisting exclusively of descriptive elements should be registrable if the combination is distinctive;

31. a sign consisting of a distinctive element combined with one or more descriptive elements is registrable;

32. evocative signs should be capable of registration.

3. Acquisition and Loss of Distinctive Character

AIPPI *observes* that:

33. a great diversity exists in the different countries with respect to the causes by which a trademark may become a commonly used sign (in many jurisdictions called "genericness"), such as:

— the fault of the trademark owner, his acts or his inactivity,
— the enormous reputation of the trademark, and the use by the public of the trademark as a common one, although this can be avoided by a correct policy of use and policing of the mark,
— when it is the only way to identify a patented product at the end of the life of the patent,
— under the law in some countries a trademark can never become "in common use."

AIPPI *believes* that:

34. when the owner of a trademark uses it as a common name or tolerates the general use of it as such for a considerable period, then the right to that trademark may be lost;

35. a sign which was non-distinctive when adopted may acquire distinctiveness by use and that distinctiveness is a purely factual matter, depending upon factors such as extent of use, length of use, etc.

4. Date of Evaluation of Distinctive Character in the Registration Procedure

AIPPI *observes* that:

36. the date of evaluation of distinctive character can vary from country to country, depending on the national law, as to what is the event which gives right to a trademark: first use, application, either of them, or registration;

37. there are even some countries where there is no provision for refusal of an application for registration but only cancellation proceedings.

AIPPI *believes* that:

38. the evaluation of distinctive character should be made at the date of the application for registration, whether the distinctive character is examined by the trademark office or only subsequently by the court;

39. nevertheless, such date need not be applied if, subsequent to the application date, use of the trademark has caused either the loss or acquisition of distinctiveness.

5. Neologism

AIPPI *observes* that:

40. a neologism is a verbal expression that is newly formed;

41. it may consist of a totally new invented word which does not have any meaning in its totality or its parts;

42. it may consist of a word which has been deformed by suppression, addition, contraction or misspelling, in such a way that it still retains a certain meaning.

AIPPI *believes* that:

43. a neologism which consists of a totally new invented word is by nature distinctive;

44. nevertheless, the neologism is not distinctive by nature if it has been constructed according to the usual rules of the language involved and the meaning appears evident to the public involved.

6. Words from Foreign Languages

AIPPI *observes* that:

45. international trade is being encouraged, consumers travel more and more in foreign countries, publicity from television and other media is being spread internationally and knowledge of foreign languages is increasing;

46. knowledge of foreign languages can be different from one part of a country to another;

47. knowledge of language can differ according to the kind of public concerned and can also differ from undertaking to undertaking;

48. foreign language can also have an impact on the question whether a trademark is misleading or prohibited.

AIPPI *believes* that:

49. a word in a foreign language, which has passed into the general language in the country concerned, or whose meaning is clearly understood by the relevant public or undertakings, should be subject to the same rules as those which govern words in the national language(s);

50. a foreign word, which has not passed into the general language or whose meaning is not clearly understood by the relevant public or undertakings, can have or acquire a distinctive character;

51. the admission as trademarks, of foreign words of languages known or likely to be known to a significant section of the public, which designate the product or service in the country of origin, should be discouraged;

52. registration in one country of a trademark which is the designation of the product or a service in a foreign country should not serve to prevent the entry into the one country of such goods if on those imported goods the designation is not used as a trade mark.

II. Marks Must Not be Misleading

AIPPI *believes* that:

53. trademarks should not be misleading to the relevant public;

54. the misleading effect can relate to the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the services, or other characteristics of the goods or services;

55. the mere possibility of the trademark being misleading can suffice as a bar to registration;

56. the misleading character of the trademark may result from the presence of one significant misleading element;

57. evocative trademarks may be misleading;

58. a trademark is not misleading if it is clear to the relevant public that the indication conveyed is false, since it cannot induce to error.

Date of Evaluation of the Deceptive Character

AIPPI *believes* that:

59. the time at which the misleading character of a trademark must be evaluated should be the same as for the evaluation of the distinctive character.

III. Signs for Which Registration is Prohibited

AIPPI *observes* that:

60. most national laws correspond to the principle of Article 6*ter* of the Paris Convention.

AIPPI *believes* that:

61. in order to protect public interest or morality, certain signs should not be registrable, notwithstanding their distinctive character. It should be left to each country to decide which signs are subject to this prohibition, but the criteria to be applied should be restricted in order not to add prohibitions that are irrelevant to the public.

B. What May Constitute a Registrable Trademark?

62. The question which signs should be legally admitted for registration has already been the subject of a full study and a Resolution of AIPPI in the Berlin Congress in 1963. In that Resolution AIPPI affirmed that the following signs are capable of constituting trademarks provided only that they are distinctive or have become distinctive in respect of the designated goods or services:

"1. Words or assemblies of words, whether invented or not, including the titles of daily or periodic publications, the titles of collections of works and slogans.
2. Letters.
3. Digits.
4. Device marks including, for example, signatures, portraits, drawings, insignia, images, emblems and monograms.
5. Proper nouns including surnames, forenames and pseudonyms, as well as characteristic components or abbreviations of trade names.
6. The shape or any other presentation of the articles or their contents and wrappings provided that it is not exclusively functional in nature.
7. Colors, in combination with the signs.
8. Combinations of colors.
9. Any combinations of the signs listed above."

1. Definition

AIPPI *observes* that:

63. the majority of national laws provides for a general definition of a trademark and that also the majority of national laws enumerates signs which are capable of constituting a registered trademark, usually by way of illustration.

AIPPI *believes* that:

64. it is desirable that national laws should give a general definition of registrable trademarks and that the decisive criteria for being registrable should be their distinctiveness;

65. it is convenient if national laws provide for examples of registrable signs which should, however, by no means be exhaustive.

2. Distinctive Signs Listed in the Berlin Resolution

....

3. Other Distinctive Signs

AIPPI *observes* that:

68. in a number of countries also colors, three-dimensional marks other than shapes of goods and their packaging as well as sound trademarks are registrable.

AIPPI *believes* that:

69. color *per se* should be registrable when it is or has become distinctive;

70. three-dimensional signs, irrespective of their nature, are registrable; national offices should require from the applicant a sufficient two-dimensional presentation (drawing, picture or any other presentation capable of being printed) and a declaration that it represents a three-dimensional mark; national offices should publish the two-dimensional presentation with an explanation that it represents a three-dimensional mark; a deposit of the three-dimensional mark as such

should not be required, but if national offices allow also the deposit of a three-dimensional specimen of the mark, it should be made accessible to interested parties; the three-dimensional mark registered in a two-dimensional presentation is protected in its three-dimensional form with the consequence that use of such form is use of the registered mark.

4. The Shape of Goods and Their Packaging

AIPPI *observes* that:

71. a great number of national laws exclude the shape of goods or their packaging from registration in certain cases, such as:

72. the shape is imposed by the very nature of the article or its packaging;

73. the shape is necessary to produce an industrial result;

74. the shape imparts substantial value to the article.

AIPPI *believes* that:

75. the shape of goods or their packaging should not be excluded from registration except if the shape is imposed by the very nature of the article or is technically necessary.

5. Sound Trademarks

AIPPI *observes* that:

76. a great number of countries permit the registration of sound trademarks;

77. in general, sound trademarks are registrable, however, only to the extent that they can be and are represented by symbols;

78. and it is not clear whether in those countries the sound is protected or only the registered symbols.

AIPPI *believes* that:

79. sound trademarks should be registrable, at least if they can be represented by symbols;

80. the registration should protect the sound thereby represented.

6. Olfactory Trademarks

AIPPI *observes* that:

81. no national legislation provides for the registration of olfactory trademarks;

82. the national groups have in their majority not expressed a need for such registration;

AIPPI *believes* that:

83. the rather restricted interest in the registration of olfactory trademarks does not justify the complicated administrative and legal problems involved in such registrations.

Non-Confusing Use of Another's Trademark

Resolution

AIPPI *considers* that:

Under trademark law the owner of a trademark has the exclusive right to use his mark to identify his goods and services and their origin. This right is protected by trademark law against the commercial use of the mark by others, if the use (regarding the mark and the goods and services for which it is registered) is likely to deceive or to cause confusion. Trademark laws in general do not inhibit the non-confusing use of another's trademark.

However, there are cases in which the reference to the trademark may not reasonably be construed as indicating the origin of the goods or services, but still may harm the interests of the trademark owner, e.g., the distinctiveness of his mark or the goodwill as symbolized by the mark.

Some of these cases have been known for some time. However, new forms of trading on the goodwill of the owners of trademarks by non-confusing use have created the need for relief;

AIPPI *believes* that there are thus three questions to be considered:

(1) whether the trademark owner should be entitled to relief against non-confusing use,

(2) whether such relief should be provided for under the trademark law, under the laws against unfair competition (including consumer protection laws, market laws, etc.) or by way of other laws, e.g., by civil law, and

(3) whether the creation of specific rights is recommended.

I. Use of the Trademark by Non-Traders

1. Use of a Trademark by Consumer Organizations

AIPPI *considers* that:

— Any consumer organization should be free to refer to the mark in order to identify the goods or services which are the subject of its test results. The public is entitled to such information and there is, in most cases, no other way of identifying the tested goods or services without using their trademarks. Comparative testing is likely to foster competition and to strengthen the quality of goods or services and to promote the transparency of the market. AIPPI affirms the right to criticize and inform.

AIPPI *is of the opinion* that:

— The reference to the tested goods and services by way of their trademark should not be prohibited by trademark law.

— If the consumer organization publishes test results which are wrong, biased or otherwise harmful to the legitimate interests of a trademark proprietor, the appropriate laws (for example, defamation) should give protection.

— These types of cases may rest on a variety of facts which preclude a specific rule, which could be applicable to all such cases.

2. Generic Use of a Trademark

AIPPI *considers* that:

The citation of a trademark in publications, which refer to the mark by implying that it is a generic term or word of the language, may contribute to a process in which the trademark loses its distinctive character. Such use is harmful to the mark in that it diminishes the distinctiveness of the mark and endangers the validity of any registration of or the ability to protect the mark;

AIPPI *is of the opinion* that:

— The trademark owner should be protected against such generic use in dictionaries, encyclopaedias and similar works of reference. Such works of reference define the meaning and quality of words. They are often consulted by the public and by trademark offices. As these works are perceived to be based on careful research they should make it clear whether a certain term is a registered trademark.

— This protection should be granted by trademark law. Although such references are harmful to the interests of the owner in a way other than the usual case of trademark infringement, the remedies against such use are more appropriate in the context of trademark law, where relief can be obtained without proof of intent or negligence.

— Effective relief should be available against the publisher and the author, where appropriate, including the right of the trademark owner to demand a printed correction.

AIPPI *furthermore considers* that:

The use of the mark as a generic term or a word of the language in other types of publications, e.g., in newspapers, on radio, on television or in general literature, may equally severely harm the interests of the trademark owner.

AIPPI *is of the opinion* that:

— The trademark owner should be entitled to effective legal remedies against such use.

— The specific legal remedies and the rules under which they are provided should be left to the national legislation.

II. Use of the Trademark by a Competitor

1. Use of a Trademark in Comparative Advertising

AIPPI *believes* that:

— A competitor who compares his own goods or services with those marked with a registered trademark does not use that mark to identify his own goods or services or their origin. Therefore, trademark law should not be applicable.

AIPPI *is of the opinion* that:

— If comparative advertising is permitted, the use of the trademark of a third party should not be prohibited in such advertising, provided such advertising is truthful and not misleading or unfair.

— Any comparative advertising which is untruthful or misleading or unfair should be prohibited under the laws against unfair competition.

2. Use of a Trademark to Identify the Destination of the Goods

AIPPI *is of the opinion* that:

— The owner of a trademark should not be entitled to prevent the use of his trademark by the supplier of non-original spare parts and accessories (i.e., those not produced by the trademark owner or his licensee) to indicate the trademark of the products for which the spare parts or accessories are intended; provided that he makes it completely clear that he is not selling original spare parts or accessories.

— Confusion is especially difficult to avoid if the trademark is a design or logo. Moreover, use of any trademark on the spare parts or accessories themselves would be likely to cause a substantial risk of confusion even if explanatory text is added.

— In any event, the suppliers of the spare parts or accessories should use the trademark only to an extent which is reasonably necessary to indicate the destination of the spare parts or accessories. Moreover, the supplier must avoid the impression that he is a dealer authorized by the trademark owner.

3. Use of a Trademark for Repaired or Altered Products

AIPPI *is of the opinion* that:

— The owner of the trademark has the exclusive right to put the goods to which his mark is affixed on the market. Once the owner or his licensee have put them on the market, the owner normally cannot prohibit their resale.

— A retailer should be free to resell the goods with the affixed trademark. He may also use the trademark for marketing purposes.

— The retailer should not mislead the public, e.g., by wrongly creating the impression that he is a dealer authorized by the trademark owner.

— If the goods are repaired or altered before they are resold, different cases should be distinguished:

(1) A normal repair, after which the goods are sold as second hand, does not constitute a "re-entry" into the market. Therefore, the trademark owner may not use his trademark rights to prevent this.

(2) The sale of repaired goods as "new" will normally violate the trademark right since the impression is created that they have been produced—such as they are—by the trademark owner. Thus, a situation similar to the entry into the market is created and trademark law should apply.

(3) The trademark right is clearly violated if the goods are significantly changed as to quality or appearance and if they are then sold. In this case, there is in fact an entry of different goods under the mark into the market.

— Trademark laws should cover cases (2) and (3). Moreover, other laws, e.g., laws against unfair competition should apply, particularly if the public is misled.

III. Commercial Use of the Trademark by a Non-Competitor

1. Use of a Trademark as a General Standard in Respect of Quality

AIPPI *considers* that:

— An enterprise citing a well-known trademark as a quality standard for non-competing goods ("the Rolls-Royce of bicycles") may create a danger of confusion. Such citation may also take an unfair advantage of or be detrimental to the distinctive character or the repute of the trademark.

AIPPI *is of the opinion* that:

— If the compared goods are close enough, there could be a risk that the public would assume that the trademark owner

has some connection with the advertised goods, and therefore confusion as to source could arise.

— If the citation as a quality standard refers to goods that are quite disparate, so that the public is not likely to believe that the trademark owner is commercially active in the field ("the Rolls-Royce of cheese"), it should nevertheless be regarded as an act that would take unfair advantage of or be detrimental to the distinctive character or the repute of the trademark.

— In the latter case, the following rule inspired by Article 5(5) of the EEC Trade Mark Directive could be adopted:

> "The proprietor of a trademark shall, in addition to his traditional trademark infringement rights, be entitled to prevent third parties not having his consent from using any sign which is identical with, or similar to, the trademark also for purposes other than to distinguish his goods or services, where such use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark."

— This rule will usually be applicable in those instances where the trademarks involved have a high reputation or are well known.

— The rule applies also if the nature of the goods referred to by the sign has an adverse effect on the reputation of the trademark.

2. Use of the Trademark of the Material for the Marking of Finished Goods

AIPPI *considers* that:

— It is customary for some finished goods to carry an indication regarding the branded material from which they are produced. This information is often valuable to the public, especially when the branded material has certain qualities which might affect the use of the finished goods.

— Such an information of fact is in keeping with the right of the consumer to have such information and does not violate the owner's trademark rights, provided that such use is not made in a way which misleads the consumer into believing that the mark is the brand of the finished goods.

AIPPI *is of the opinion* that:

— It should normally be possible for the manufacturer who produces finished goods principally from a material identified by a trademark to make use of that mark in connection with the sale of his goods as an indication regarding the material.

— The mark should not be used to identify the finished goods themselves.

— The mark should neither be used in a generic sense regarding the branded material nor in a misleading way.

IV. General Rules

(a) AIPPI *affirms* that:

— The rule proposed under III.1 should apply to all cases in which the citation of the trademark is taking unfair advantage of or is detrimental to the distinctive character or the repute of the trademark.

(b) AIPPI *is of the opinion* that:

— Similar rules should be applicable to service marks duly taking into account the inherent differences resulting from the nature of service marks.

Harmonization of Certain Provisions of the Legal Systems for Protecting Inventions

GUIDELINES BY AIPPI

Article 106—Publication of Applications

AIPPI considers that the proposal of WIPO fits into the framework of other harmonization provisions connected with the first-to-file system.

1. AIPPI supports the text of paragraph (1)*(a)*. It should, however, be understood that the requirement of publication is also fulfilled if the application is laid open for public inspection.

2. AIPPI is aware of the fact that there might be different interpretations with respect to the effects of withdrawals or abandonment. It should therefore be understood that the publication should not occur if there is no intent by the applicant to pursue the application. With respect to a rejection, no publication should occur if the application is finally rejected without the possibility of an appeal.

3. There should be a clear statement in the treaty of the point in time up to which he can withdraw his application without it being published; this period for withdrawal should be as long as possible. The rules should state that this period should not be shorter than 17 months after filing or after the priority date.

4. AIPPI is of the opinion that the concept of "national security" in *(c)* should be narrowly interpreted.

5. AIPPI supports the text of *(d)* with the understanding that this provision only regulates the publication of the application after 18 months and nothing is said about the form of publication of the granted patent.

6. The text of paragraph (2) is supported. AIPPI especially welcomes sentence 2 of the provision which has the effect that through an earlier publication the applicant can create a stronger prior art effect also for inventive step.

7. If a patent is granted prior to the expiration of 18 months—paragraph (1)*(b)*—it should be understood that the original application should be laid open for public inspection.

8. In the case of an internal priority or a continuation in part (CIP) filed in time for publication at the expiration of 18 months, the completed, modified application should be so published and the file should be made available for public inspection, in order that third parties have access to the original application.

In the case of a continuation in part filed after the expiration of 18 months or so shortly before that it can no longer be taken into consideration, publication of the CIP should occur as soon as possible.

9. AIPPI is of the opinion that the treaty should also rule on the question of publication of divisionary applications.

10. With respect to Rule 106, AIPPI is of the opinion that information obtainable from the industrial property office should be possible by any technical means, but for the convenience of small and medium-sized companies at least also on paper.

Article 108—Post Grant Opposition

AIPPI favors the introduction of a form of third party participation in the granting process. With respect to the proposed wording of WIPO, it takes the following position.

1. It should be understood that the introduction of an opposition can only be requested for countries with a substantive examination system.

2. In the interest of a speedy granting procedure, AIPPI favors a post-grant opposition.

3. AIPPI regards the introduction of a time limit for an opposition as desirable.

4. With respect to the grounds for opposition, it should be understood that at least the following grounds should be expressly mentioned:

— that an invention is not patentable in the light of printed publications;

— that the invention was not sufficiently disclosed for a person skilled in the art;

— that the application was extended beyond the content of the original filed documents.

5. The text of paragraph (1)*(b)* that third parties shall be given the opportunity to present their arguments is supported by AIPPI.

6. AIPPI is aware of the fact that the mandatory introduction of an opposition or revocation procedure before the patent office may pose problems even in some examining countries and it therefore agrees to offer as an alternative the introduction of a re-examination which could be used by the applicant or third parties at any time during the life of the patent.

The grounds for such a re-examination should at least be that the invention is not patentable in the light of printed publications.

7. AIPPI strongly supports the prohibition of a pre-grant opposition but is also in favor of a transitory period for abolition in countries which presently have a pre-grant opposition.

8. AIPPI supports the text of paragraph (3), namely, that invalidation or cancellation procedures before the courts or quasi-judicial authorities can be available in addition to third party procedures before the patent office.

9. AIPPI furthermore considers that the introduction merely of a re-examination system without full third party involvement is not sufficient and each country therefore should provide third party intervention and review possibility by courts or quasi-judicial authorities.

Article 107 — Time Limits for Search and Substantive Examination

AIPPI supports the principle that patents should be granted in a short term. This enables the applicant to exercise his rights and the public to obtain security about the scope of protection. Among the means to enable this goal, AIPPI supports the following:

1. On filing, the applicant should request the search and pay the search fees. The payment of the search fees may in some countries discourage the filing of patent applications which are not intended to be seriously pursued.

2. After having received the search report, the applicant should have the possibility of a reasonable period of time to request examination. The time limit considered as reasonable by AIPPI is two years after the publication of the search report.

3. Third parties should have the possibility, especially if the time period is longer than two years, to request examination at any time upon payment of the examination fees.

4. Since the fixing of time limits for requesting examination does not necessarily ensure that the examination will soon be accomplished, AIPPI in addition supports the enactment of strong provisional protection for the published application.

Article 110 — Changes in Granted Patents

AIPPI supports the introduction of a possibility of amending granted patents.

With respect to the proposed text of WIPO, AIPPI makes the following observations:

1. The provision of Article 110(1)(i) is acceptable, namely, that claims can be limited.

2. AIPPI is of the opinion that the clarification of ambiguities should be left to the courts, since an *ex-parte* proceeding is not appropriate for such a purpose.

3. AIPPI is in favor of a provision that clerical errors can be corrected, provided that in accordance with the treaty proposal of WIPO the scope of the claims is not enlarged.

4. AIPPI is of the opinion that Article 110(1) should be regarded as a minimum requirement, so that countries can provide also, during a limited period of time, for an enlargement of claims even beyond the correction of these errors, if intervening rights are protected.

5. AIPPI is of the opinion that Rule 110 should be deleted and thus paragraph (2) modified accordingly (deletion of the reference to the regulations).

Article 200 — Patentable Inventions

1. AIPPI is of the opinion that a general definition of inventions as proposed in paragraph (1) should be deleted.

2. AIPPI supports the definition of patentability in paragraph (2) with the following modifications:

(a) The definition of inventive step in the bracket should be deleted ("is non-obvious"), since paragraph (4) still contains such a definition.

(b) It should be stated that the requirement of industrial applicability has the same or a very similar meaning as utility so that after "industrially applicable," "or useful" should be added.

(c) In the definition of industrial applicability in paragraph (5) "(in the technological sense)" should be deleted, and after "in any kind of industry," "or technology" should be added.

(d) Furthermore, the notes should clarify that "industry" must be interpreted in the broadest sense which includes agriculture as well as, for example, medical treatment.

3. AIPPI is in favor of defining the concept of novelty. It prefers, however, the wording as proposed in Geneva "if it does not form part of the prior art," since the word "anticipated" might lead to confusion.

4. In paragraph (3)*(b)*, the bracket "[or any other]" should be deleted so that the prior art defined would only comprise written or other graphic publications and would exclude oral disclosures as well as prior public use. The introduction of the absolute novelty concept should be made optional for the countries.

5. In paragraph (4), the definition of inventive step is supported by AIPPI.

Article 105—Unity of Invention

AIPPI is of the opinion that the trilateral proposal should be made on the basis of the discussion.

1. AIPPI is in favor of paragraphs (1), (3) and (4) of the proposal.

2. AIPPI is also in favor of the introduction of a new requirement expressed in paragraph (2) to the effect that linked inventions must have a technical interrelationship, such interrelationship being expressed in the claims in terms of the same or corresponding technical features with the following qualifications:

(a) The special technical features mean those that appear to define the contribution which each invention *as a whole* makes over the prior art.

(b) The new definition should be transferred to the Rules where it may be more readily modified with the benefit of experience and limited in its applicability to groups of claims falling within the same categories of invention.

3. AIPPI notes that the first paragraph of Note (d) to the Articles is in agreement with PCT Rule 13.2 and recommends that this portion of the Note be transferred to the Rule to define the single general inventive concept for different categories of inventions.

4. With respect to the rules as set forth in document HL/CE/V/5, paragraphs (1), (3) and (4) are endorsed by AIPPI without change.

5. With respect to paragraph (2) of the Rules, AIPPI is of the opinion that a definite date should be announced to the applicant so that he can determine whether he wants to file a divisional application. The reference to "pre-grant" should therefore be deleted and an advance notice similar to the EPC "ready for grant" be provided for.

6. Where lack of unity exists, the applicant should, whenever possible, be given the opportunity to make the selection or pay a second search fee. AIPPI is, however, aware of the fact that such a possibility will be difficult for countries with a fast search where an automatic selection may become necessary.

Article 109—Restoration of the Right to Claim Priority

1. AIPPI favors the introduction of this principle in the international treaty.

However, AIPPI questions whether the two alternatives A and B as proposed by WIPO, which would result in an extension in fact of the priority right, are compatible with the Paris Convention.

2. In case these provisions are compatible with the provisions of Article 4 of the Paris Convention:

(a) AIPPI, for practical reasons, favors alternative A which constitutes a fast and simple procedure to correct errors and deficiencies of priority applications.

Another reason for favoring alternative A can be seen in the fact that the definition "due care" may be interpreted very differently from country to country; some countries might even set an unreasonably high standard of care in order to bar priority applications from abroad.

(b) AIPPI would also be ready to accept alternative B. It notes, however, that such procedure in which factual and legal arguments must be put forward in order to prove that the error was committed in spite of due care can be lengthy and expensive. This may lead to a situation where publication within 18 months will no longer be possible. Nevertheless AIPPI also favors that another month be given to the applicant in order to substantiate his claim for restoration.

3. AIPPI also favors the introduction of the possibility of restoration not only for cases where the application was filed late but also where the priority claim was erroneously omitted, although the application was filed in the priority period.

Article 301—Principle of First to File

AIPPI is of the opinion that the text of Article 60 EPC should be taken as the treaty text. This article would therefore read as follows:

> "(1) The right to a patent shall belong to the inventor or his successor in title.
>
> "(2) If two or more persons have made an invention independently of each other the right to the patent shall belong to the person whose patent application has the earliest date of filing; however, this provision shall apply only if this first publication has been published under Article 106 or in the form of a granted patent."

Such a text would not only institute the principle of first to file but at the same time state that this principle should only apply where the invention was made by two independent inventors.

The provision that only prior applications which are published later constitute a bar follows from the fact that non-published applications do not belong to the prior art.

Article 304—Extent of Protection

AIPPI supports the text of Article 304 as proposed by WIPO.

With respect to Rule 304, AIPPI has the following observations:

1. AIPPI also supports the wording of Rule 304, paragraphs (1) to (3).

2. With respect to paragraph (4), AIPPI is of the opinion that the second part of the sentence ("or for a combination of less than all the said elements") should be deleted.

Such a rule would unnecessarily prevent the courts from finding an infringement where the infringer omits only one feature from a claim of a great number of features but nevertheless achieves the inventive result, even if to a lesser degree ("less advantageous solution").

It would also exclude cases where the patentee has erroneously mentioned an element or a feature which is later found to be unnecessary for the completion of the invention ("over-claiming").

As a general proposal, AIPPI would therefore prefer to adopt the new draft of paragraph (4) proposed by WIPO:

> "A claim for a combination shall not provide independent protection for the individual parts of the combination."

3. Reference should be made to Article 302(3) in the form of "notwithstanding Article 302(3)."

4. AIPPI is of the opinion that paragraph (5) should be deleted.

5. AIPPI supports the wording of paragraphs (6) and (7) of the WIPO draft.

Article 306—Maintenance Fees

AIPPI supports the intended harmonization of the method of payment of maintenance fees.

With respect to the text proposed by WIPO, AIPPI has the following proposals.

1. In order to maintain flexibility, AIPPI confirms its view that payment periods of longer than one year should be allowed.

2. AIPPI is of the opinion that the payment of annuities or maintenance fees should only start after the grant of the patent. Such a rule, which exists in some countries, takes into account that the applicant, through automatic publication after 18 months, has already given valuable information to the public.

Futhermore, if maintenance fees are paid after grant, there is a considerable incentive upon the patent office to speed up examination. The starting of payments after grant also reflects the value the patentee has received by the grant.

The argument that the applicant can already enforce his rights by way of provisional protection does not justify the payment of maintenance fees, since provisional protection only follows from early publication which opens the possibility for competitors to use the invention.

3. AIPPI supports the calculation of the due date as from the first day of the following month in paragraph (3)(i).

4. AIPPI proposes to give examples in the notes as to the meaning of "due date."

Article 307—Provisional Protection

AIPPI supports the introduction of an improved provisional protection. Such protection is necessary as a compensation for early publication.

Studies

Distinctive Devices and Comparative Advertising in Argentine Law

E. ARACAMA ZORRAQUÍN*

Forty Years of the German Democratic Republic— Forty Years of Successful Inventive Activity

J. HEMMERLING*

The Legal Protection of Trademarks in Czechoslovakia

M. VILÍMSKÁ*

News Items

ECUADOR

Director General of Industrial Property

We have been informed that Dr. Alba Salazar Llerena has been appointed Director General of Industrial Property.

PERU

Director of Industrial Property

We have been informed that Mr. Luis Chavez Loyola has been appointed Director of Industrial Property.

UNITED KINGDOM

Comptroller-General of Patents, Designs and Trade Marks

We have been informed that Mr. Paul Hartnack has been appointed Comptroller-General of Patents, Designs and Trade Marks.

WIPO Meetings

WIPO Meetings

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

1989

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 Laws for the Protection of Marks (First Session)

The Committee will examine the draft treaty provisions on the harmonization of laws for the protection of marks and will consider the proposed further contents of the draft treaty.
Invitations: States members of the Paris Union and, as observers, States members of WIPO not members of the Paris Union and certain organizations.

December 1 (Geneva)

Information Meeting for Non-Governmental Organizations on Intellectual Property

Participants in this informal meeting will be informed about the recent activities and future plans of WIPO in the fields of industrial property and copyright and their comments on the same will be invited and heard.
Invitations: International non-governmental organizations having observer status with WIPO.

Other Meetings Concerned with Industrial Property

1989

December 5 to 9 (Munich) — European Patent Organisation (EPO): Administrative Council

1990

May 8 to 11 (Washington, D.C.) — Foundation for a Creative America: Bicentennial Celebration of the Enactment of the United States Patent and Copyright Laws