

QUESTION 1

Rearrangement of the text of the International convention for the Protection of Industrial Property

Yearbook 1954, No 5., 3rd Series, 57th Year, pages 91 - 94 [originally in French]
21st Congress of Brussels, June 7 - 12, 1954

Q1

QUESTION Q1

Rearrangement of the text of the International convention for the Protection of Industrial Property

Resolution

1. Organisation by the Bureau of the International Union of documentation relating to patents and patent applications for which a priority right has been claimed or acknowledged

The Congress recommends that the International Bureau for the Protection of Industrial Property at Berne is to study, through a committee of experts:

a) the appropriate steps to enable it to supply interested parties with information relating to patents and patent applications for which a priority right has been claimed or acknowledged, and to make valuable information accessible to the public at reasonable cost, and

b) on that basis, the proposals from the Dutch Group and those from the French Group.

2. Patentability of chemical products

The Congress recommends that a new Article 4^{quater} reading as follows should be introduced into the Convention:

A. Each of the countries of the Union undertakes to accept patentability of chemical products.

B. However, reservations or limitations concerning the patentability referred to in paragraph A may be laid down by the national legislation of each of the countries of the

Union provided that the invention is still protected as effectively as possible and that in the event that national legislation would require the grant of licences the inventor is ensured equitable remuneration.*)

3. Protection for plant novelties

The Congress expresses a wish that, in the legislation of each of the countries of the Union, inventions relating to plants should be equated with industrial inventions from the point of view of legal protection and that plant novelties are also protected.

4. Well-known marks

The Congress expresses a wish that Article 6^{bis} of the Convention be drafted as follows:

1. The countries of the Union undertake, either administratively if the legislation of the country so permits, or at the request of an interested party, to refuse or to cancel the registration and to prohibit the use of a trade mark which constitutes a reproduction, imitation or translation liable to create confusion with a mark considered by the competent authority of the country of registration or use to be well-known in that country as already being the mark of a person entitled to the benefits of the present Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith. There is no need for the well-known mark to have been used in the country in which protection is sought therefore.

2. A period of at least five years shall be allowed for seeking cancellation or prohibition of the use of such marks. In the former case that period will extend from the date of registration of the mark and in the second case from the beginning of use.

3. No time limit shall be fixed for seeking the cancellation or the prohibition of the use of marks registered or used in bad faith.

4. The provision provided by the present Article extends, subject to rights acquired in good faith, even in relation to goods which are not identical or similar, if there derives therefrom either a possibility of confusion or an unjustified advantage or a real weakening in the distinctive character or the power of attraction of the mark.

5. Limitation on the grounds for refusal of a mark

The Congress expresses a wish for present Article 6 of the Convention to be replaced by the following two Articles 6 and 6^{quinquies}:

Article 6

(1) The conditions for the filing and registration of trade marks shall be determined in each country by its domestic law.

*) Note from the Secretary General: Although the term 'inventor' was adopted by congress, it seems to be of excessively limited scope and not comply with the facts in every case. It seems that 'beneficiary' should be used.

(2) However, no mark filed by a national of the Union in a country of the Union shall be refused or cancelled on the ground that the mark in question has not been filed or registered or renewed in the country of origin.

Article 6quinquies

A. When a trade mark is not in conformity with the legislation in the country in which protection is sought but it has previously been registered in the country of origin, it shall be accepted for filing and registration and protected as it stands under the following conditions:

B. Trade marks shall not be denied registration or cancelled except in the following cases:

1. When they are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed;

2. When they have no distinctive character whatsoever. The following shall be considered in particular as such:

a) descriptive marks, that is to say marks which consist exclusively of signs or indications which may serve in trade to designate the kind, composition, quality, quantity, intended purpose, value, place of origin or time of production of the goods to which the mark is applied; and

b) marks deemed to be generic, that is to say which have become customary in the current language or in the bona fide and established practices of the trade in the country where protection is sought;

3. When they are contrary to morality or public order and in particular when they are of such a nature as to deceive the public. It is understood that a mark may not be considered as contrary to public order for the sole reason that it does not conform to a provision of the law relating to trade marks, except where such provision itself relates to public order;

4. When they were filed under circumstances constituting an act of unfair competition within the terms of Article 10^{bis}.

However, there is no departure from the provision of Article 5, letter C.

C. In determining whether a mark is of distinctive character, all the circumstances must be taken into consideration, in particular:

1. the fact that said mark has been allowed for registration in the country of origin or in another country of the Union after examination of the conditions of allowance or it has been recognised as distinctive in a country of the Union;

2. the period and extent of its use in the countries of the Union;

3. the fact that the interested circles consider it as the distinctive sign for the product that it covers.

D. The country in which registration is sought, before proceeding with definitive registration, may require the production of a certificate of registration in the country of

origin issued by the competent authority. No legalisation will be required for that certificate.

E. A trade mark shall not be refused or cancelled on the ground that it is not strictly identical to the mark registered in the country of origin and, in the case of a mark enjoying the benefit of the priority of a filing in the country of origin, the benefit of that priority shall not be refused on the same ground. The differences introduced, however, shall not alter the distinctive character of the mark; they must leave the possibility of identification thereof.

F. When a trade mark has been duly registered in the country of origin and then in one or more other countries of the Union, each of those national marks shall be considered, as from the date of its registration, as independent of the mark in the country of origin.

G. In accordance with the present Article the country of the Union where the applicant has a real and effective industrial or commercial establishment and, if he has not such an establishment, the Union country where he has his domicile and, if he has no domicile in the Union, the country of his nationality, if he is a national of a Union country, shall be considered as the country of origin.

6. Revision of the Madrid Agreement concerning the international registration of marks

The Congress wants the problem of revision of the Madrid Agreement concerning the international registration of marks to be retained on the agenda; it calls on the Executive Committee to continue with the studies carried out in this matter by the International Bureau in Berne.

7. Introduction into a country of the Union of products lawfully produced abroad

As the Congress considers that this question is important and that it should be studied in greater depth, it refers it to a subsequent Congress.

8. Grant of patents of invention for foodstuffs and stimulants which may not satisfy the laws and regulations relating to such products

The Congress recommends that:

1. a provision should be introduced into the Convention, providing that grant of a patent relating to the composition of a foodstuff or a stimulant or a process for the preparation of such a composition shall not be refused on the ground that said composition or said process is contrary to law;

2. the agenda of a subsequent Congress should include a study on extending the foregoing provision to products other than foods or stimulants.

9. Limitation by the Convention of the option on the part of Union countries to take measures, with a view to safeguarding public interest, which excessively restrict the exclusive right afforded by a patent

The Congress decides to refer to the Executive Committee the study of the problem which will have to be divided into two parts in the following manner:

- a) restrictions imposed on the rights of a patentee in consideration in particular of the public interest or abuses of monopoly; and
- b) the regulations relating to a compulsory licence.

10. Service marks

The Congress considering that protection should be afforded for service marks, decides to continue with the study of this question in order to lay down the appropriate methods, and refers the question to a subsequent Congress.

11. Repercussion of the European Economic Community on the legislation of Union countries concerning industrial property

Resolution No 1

The Congress

1. notes that the International Union for the Protection of Industrial Property has been carrying on for 70 years and is continuing to carry on work of considerable utility in the unification of national laws and in the institution of an international law in relation to industrial property;
2. recalls that the Paris Union is an inter-State organisation with an all-embracing purpose for the protection of industrial property;
3. affirms that it is desirable to avoid the creation in the same area of other international convention rights with an all-embracing purpose;
4. wants the other international organisations to collaborate with the International Bureau in Berne if they should happen to deal with questions involving industrial property; and
5. calls on the Executive Committee to appoint a Special Committee whose function will be as follows:
 - a) in liaison if necessary with other similar groups, to follow any questions which are raised at an international level by the co-ordination of work in matters of industrial, literary and artistic property; and
 - b) to take action with the International Bureau in Berne and to support its action in this matter.

11 a. Repercussion of the European Economic Community on the legislation of Union countries concerning industrial property

Resolution No 2

The Congress invites the Executive Committee, in conjunction with the National Groups involved, to attend to any suitable diplomatic steps with Governments or by way thereof with a view to achieving the following:

1. wide accession to the London text of the Union Convention on the part of the signatory States and the non-signatory States;

2. the inclusion in the Act of independence of States previously subject to external control of a clause providing for the assumption by the successor State of the obligations deriving from the Union Convention, when it was applicable; and

3. the inclusion in said Act of independence of a clause providing for maintenance of legislation for protecting industrial property in conformity with the Union Convention even when the Convention was not applicable in terms of a convention but by virtue of the effect of internal legislation.

* * * * *

QUESTION 1

Rearrangement of the text of the International convention for the Protection of Industrial Property

Yearbook 1956, New Series No. 3, 59th Year, pages 133 - 136
22nd Congress of Washington, May 28 - June 2, 1956

Q1

1 - Rearrangement of the Text of the International Convention for the Protection of Industrial Property

The Congress:

1. approves the draft rearrangement of the text of the International Convention for the Protection of Industrial Property, as drafted by the Special Committee presided over by Professor P. J. POINTET.
2. entrusts the Special Committee (in cooperation, if need be, with the International Chamber of Commerce) with the task of preparing a complementary draft embodying within the amended text, the resolutions passed by the AIPPI (and those passed by the International Chamber of Commerce, if any), since the Revision Conference of 1934.
3. expresses the wish to have these two drafts submitted to the Revision Conference of Lisbon.

3 - Grant of patents for products other than foodstuffs and stimulants, and for processes for making such products, which do not conform to the laws and regulations applicable to the composition or process of manufacture of the said products

The Congress:

1. recommends that a provision be introduced in the Convention to the effect that granting of a patent cannot be refused and that a patent once granted cannot be invalidated because of laws and regulations restricting the working of the subject-matter of the patent in the country concerned, reserving the right for each country to refuse or to invalidate a patent should its subject-matter be contrary to morals or to public order.
2. acknowledges that, owing to the general recommendation formulated above, the recommendation adopted by the Brussels Congress relating to patents for foodstuffs and stimulants becomes aimless.

4 - Termination after 20 years' use of the right to use marks applied to pharmaceutical products

The Congress:

1. reiterates the principle according to which any measure aimed at restricting, for certain products, the duration of the protection or the right to use the mark, must be prohibited.

2. recommends that Art. 7 of the Convention be amended as follows:

„the nature of the product to which the trade mark is to be applied can, in no case, form an obstacle to the registration or the renewal of the mark.

„the exclusive right for the owner or his successor to use a mark thus registered or renewed shall not be suppressed or limited, when the sale, of the product to which it is applied, is lawful“.

3. expresses the wish to have this draft revision of Art. 7 placed upon the agenda of the Lisbon Conference.

6 - Service Marks

The Congress reiterates the need to protect service marks; recommends that in the Paris Union Convention as well as in the Madrid Arrangement, the service mark be assimilated to the trade mark; deems inopportune under the circumstances to give a definition of service mark in the present Acts.

8 - Official languages of the Convention and of the International Bureau

The Congress recommends:

1. to draw up the Convention of the Paris Union in French and English.

2. that both texts be equally authentic except in case of conflict, in which case the French text will be controlling.

3. that the official languages of the International Bureau of Bern, and of its official publications, be French and English, subject to the granting of adequate financial means to the Bureau by the Revision Conference of Lisbon.

11 - Creation of a priority search centre for patents within the International Bureau

The Congress:

1. confirms the recommendation adopted on this matter by the Brussels Congress.

2. postpones the debate in view of the work being done currently by the Committee of Experts.

3. recommends to the national administrations to supply the data requested as rapidly as possible in order to enable the experts to complete their work within the shortest possible time.

4. recommends to the national administrations to mention in their official publications as well as in the patent registers, the number of the application for which priority is claimed beside the country and the date (as per Art. 4 D, 1 and 2).

13 - Prevention of false indications

The Congress:

1. recommends a change in Art. 10 of the Convention, deleting in the first paragraph the words: „when such indication will be joined to a trade name of a fictitious character or used with fraudulent intention.“

Furthermore, the Executive Committee is invited to resume its study on the protection of indications or appellations of origin.

2. recommends the addition of a third paragraph to Art. 10^{bis} (3) reading as follows:

(iii) the false indications or allegations in the course of business which are likely to deceive with respect to the nature, the composition, or the quality of the goods or products offered.

* * * * *

QUESTION 1

Rearrangement of the text of the International convention for the Protection of Industrial Property

Yearbook 1958, New Series No. 6, 61st Year, pages 53 - 57
23rd Congress of Stockholm, May 26 - 31, 1958

Q1

Results of the Examination of the Observations by the Governments and Private Organisations contained in the Fourth Fascicule of the Preliminary Documents for the Lisbon Conference

The Presidents of the National Groups, as well as the Representatives of the International Bureau and the Delegates of the International Chamber of Commerce, of the International Law Association, have in their meetings of 23rd and 24th May, 1958, examined the propositions, counter-propositions and observations communicated by several Union countries and international organizations in reply to questions placed on the agenda of the Lisbon Conference.

The subjects of the discussions were the contents of the Fourth Fascicule, Series A, May 1958 of the Preliminary Documents for the said Conference as well as the observations of the Italian Administration roneotyped by the International Bureau in May, 1958.

The prior Resolutions of the AIPPI are incorporated in the said Fourth Fascicule. To avoid repetitions, these prior Resolutions and Wishes are not contained in the following report.

I. Concept of the „application duly deposited“

(Article 4, letter A, new paragraph 3)

The Committee confirms the prior resolutions of the AIPPI approving the text proposed by the International Bureau of Berne.

II. Prolongation of the period of priority for designs or models and trade marks

(Article 4, letter C, paragraph 1)

The Committee confirms the prior resolutions of the AIPPI approving the text proposed by the International Bureau of Berne.

III. Definition of the first application

(Article 4, letter C, paragraph 2)

The Committee considers the text proposed by the Berne Bureau not to be in contradiction with the text proposed for the new paragraph 3 of article 4, letter A.

Actually, the new paragraph 3 of article 4, letter A, contains a general definition of the

application duly deposited. The new paragraph 2 of article 4, C provides that when a first application has been abandoned or refused without the benefit of the right of priority having been requested, a subsequent second application will give rise to the priority right.

The Committee therefore confirms the prior resolutions of the AIPPI approving the text proposed by the Berne Bureau.

The Committee however proposed the following improvement of the wording of the text: „These periods shall start from the date of deposit of the first application in a Union country. Any application subsequently deposited in the same country of the Union shall however equally be considered as a first application, the date of deposit of which shall give rise to the start of the periods of priority providing that at the time when the priority right based on this subsequent application is claimed, the original application as well as any application which in the meantime may have been deposited in any country of the Union, will have been withdrawn, abandoned, or refused, and that none of those applications has up to that time served as a basis for claiming a priority right. The day of deposit is not included in the period.“

IV. Multiple priorities and part priorities

(Article 4, letter F, new paragraph 2)

1. The Committee confirms the prior resolutions of the AIPPI approving the proposition of the Bureau of Berne, as to its substance.
2. But the Committee suggests that the wording of letter F of article 4 should be modified to improve its scope.

The Rapporteur proposes the following wording which the Committee approves of:

Article 4 F

1. No country of the Union may refuse to acknowledge a priority right or to refuse an application for a patent on the ground that the applicant claims multiple priorities, even if they originate from different countries, or that the application invoking one or more priorities also contains one or more elements not included in the original application.
2. The applicant shall at any time up to the definite grant of the patent be entitled to divide his application and to preserve the benefit of his initial application and, if applicable, the benefit of the right or rights of priority claimed.

V. Divulcation of an invention before the depositing of a patent application

(Article 4, new letter J)

The Committee confirms the prior resolutions of the AIPPI and proposes for this article a modified wording.

VI. Patentability of chemical products

(New article 4quater)

1. The Committee confirms the prior resolutions of the AIPPI, which propose for letter B a new text differing from the Berne draft.
2. The Committee considers, subsidiarily, that a provision should be introduced into the Convention, at least permitting chemical products to be patented under the conditions to be set by the national laws.

VII. Compulsory working of patents, compulsory licence, terms

(Article 5, letter A)

1. Paragraph 1 of the text proposed by the Berne Bureau adds to the old text, and in express terms, the suppression of the invalidation for non-working.

The Committee forcefully confirms its prior resolutions approving the proposition of the Berne Bureau.

2. Paragraph 2 of the text proposed by the Berne Bureau provides for the grant of compulsory licences as a penalty for an abuse of monopolies.

The Committee presents a twofold observation on this text:

- a) The Committee proposes the suppression of the conjunction „however“: its use actually is not justified since the scope of paragraph 2 is larger than that of paragraph 1.
 - b) The Committee upholds its Zurich resolution proposing the following addition to paragraph 2 of the Washington wish: “it being understood that non-working should not in itself be considered an abuse of monopoly.”
3. Paragraph 3 of the text proposed by the Berne Bureau provides that a compulsory licence may not be granted until after a certain period and in the absence of legitimate reasons. On this text, the Committee presents the following observations:

- a) the words „in no case“ should be suppressed. Actually, all countries agree that the compulsory licence, provided for in Article 5 A of the Convention, concerns only the cases of abuse of monopoly. Now, the words „in no case“ could permit the interpretation that paragraph 3 is applicable in all cases of compulsory licences, and especially those for reasons of public interest; there is thus an ambiguity which should be done away with.

- b) Assuming that paragraph 2 will be accepted according to the proposition of the Berne Bureau, the Committee proposes that paragraph 3 should be drafted to take account for instance of the observations of Belgium.

Paragraph 3 might be thus worded:

„When the abuse results from non-working, the grant of a compulsory licence may not be demanded before the end of a period of five years from the deposit of the patent application or of three years from the grant of the patent. The longer of these periods shall be applicable and the grant of the compulsory licence shall be refused if the patentee justifies his inaction by legitimate reasons.“

- c) Assuming that paragraph 2 will be accepted, account being taken of the wish of the AIPPI, paragraph 3 might be suppressed for having no longer any justification.
4. The Committee confirms its prior resolutions concerning:
 - a) the addition of the Washington resolution concerning the introduction of rules on compulsory licences.
 - b) the addition of the Oslo resolution providing for a new Article 5quater relating to licences for reasons of public interest.

VIII. Compulsory working of patents, compulsory licences (Interpretation of Article 5, letter A)

See preceding question.

IX. A. Simultaneous use of the same trade mark by several persons

IX. B. Trade marks the owners of which are neither manufacturers nor merchants (Article 5, letter C, paragraph 3)

1. The Committee confirms its Zurich resolution proposing a different text from that of the Berne Bureau.
2. The Committee possesses itself, without having the time to study them in detail, of the principles of certain suggestions of the countries, especially including Norway.

X. Terms of grace and restoration of lapsed patents (Article 5bis, new paragraph 3)

The Committee confirms the prior resolution of the AIPPI proposing a text differing from that proposed by the Berne Bureau.

XI. Industrial designs or models, definition, protection (New Article 5quater, possibly new Article 7ter)

1. The Committee confirms its Zurich resolution as concerns the necessity of creating a provision in the Convention to assure an international protection of designs and models.

2. The Committee confirms that it would not consider it advisable to introduce into the Convention a definition of designs and models.
3. The Committee confirms its Zurich resolution on the concept of novelty and on the indication of a minimum duration of protection.

XII. Regulation of the trade mark
(Article 6)

The Committee confirms its Zurich resolutions.

XIII. Protection of service marks
(Article 6)

1. The Committee confirms the prior resolution of the AIPPI.
2. Subsidiarily, it approves of the proposition of the ICC.

XIV. Well-known trade mark
(Article 6bis)

The Committee confirms its Zurich resolutions.

XV. Protection of state emblems and hall-marks indicating control or warranty
(Article 6ter)

1. The Committee confirms the prior resolutions of the AIPPI approving the text proposed by the Berne Bureau.
2. The Committee however approves of the propositions of the countries which demand the reestablishment of certain provisions of the former text which have not been incorporated in the new text proposed by the Berne Bureau.

XVI. Assignment of the trade mark
(Article 6quater)

The Committee confirms the prior resolutions of the AIPPI approving the text proposed by Berne.

The Committee hopes that a way will be found adequately to draft a definition satisfying the requirements of all countries, of the concept of the business or goodwill („fonds de commerce ou entreprise“).

XVII. Trade marks registered to an agent
(New Article 6quinquies)

The Committee confirms the prior resolutions of the AIPPI proposing a text differing from that proposed by the Berne Bureau.

The Committee however acknowledges that certain objections put forward by the countries should be taken into consideration.

XVIII. Nature of the product to which the trade mark is applied
(Article 7)

The Committee confirms its Zurich resolution proposing a text which contains amendments as against the text of the Berne Bureau.

The Committee forcefully stresses the necessity of introducing into the Convention the provision under consideration.

XIX. False indications of origin
(Article 10)

Since this question has been placed on the agenda of the Congress, the discussion of the reports is referred to the Plenary Meeting.

XX. Trade marks of „high renown“
(Article 10bis)

The Committee confirms its Zurich resolution.

XXI. Temporary protection of goods in exhibitions
(Article 11)

The Committee confirms the prior resolutions of the AIPPI.

B. Arrangement of Madrid for the prevention of false indications of origin on goods

Since this question has been placed on the agenda of the Congress, the discussion of the report is referred to the Plenary Meeting.

C. Arrangement of the Hague concerning the international deposit of industrial designs or models

1. The Committee stresses the importance of the proposition of the Berne Bureau tending to suppress the word „other“ in Article 1 of the Arrangement.
The object of the suppression of this word is to enforce the principle of the direct and sole international deposit; this international deposit will thus afford protection not only in the other countries from that of the depositor, but also in the country of the depositor.
2. The Berne proposition concerns secondary points upon which the Committee has no observations to make.
3. The Committee approves of the proposition of the Netherlands suggesting a particular conference to improve the conditions of the international deposit.

D. Draft international arrangement concerning the creation of an information centre for patents under priority

The Committee confirms its Zurich resolution.

E. Draft international arrangement concerning the protection of appellations of origin and their international registration

Since this question has been placed on the agenda of the Congress, the discussion of the report is referred to the Plenary Meeting.

F. Draft international arrangement on patents of importation

The Committee confirms its Zurich resolution.

General questions

The Committee confirms its Zurich resolutions in this respect.

* * * * *