

QUESTION 67

Revision of the Paris Convention

Yearbook 1977/I, pages 147 - 150
Executive Committee and Council of Presidents of Montreux,
September 26 - October 2, 1976

Q67

Question Q67

Revision of the Paris Convention

Resolution

On the Draft General Declaration

The IAPIP considers

1. that the text drafted by the Group of Experts in December 1975 is unacceptable if it is to become a preamble to the Paris Convention;
2. that this text could serve only as Guidelines for the next Diplomatic Conference for the Revision of the Paris Convention;
3. that no preamble of any kind should be introduced into the Paris Convention;
4. that, however, if it were decided to introduce a preamble into the Convention, the text of this preamble should be sufficiently general to embrace all objectives of industrial property.

On Preferential Treatment (Article 2 of the Convention)

The IAPIP

1. decides formally in favour of maintaining the basic principle of Article 2, which is the foundation of the Convention;
2. is opposed to the extension of the term of priority in favour of developing countries. In fact, the extension is not necessary, taking into account the advantages conferred by the PCT, and would in practice only lead to inextricable difficulties in the various countries of the Union;

3. is opposed to the reduction of fees favouring nationals of developing countries, and confirms its London Resolution (1975) accepting that countries may allow for a difference in the level of the fee, but taking into account solely the resources of the applicant and not his nationality.

On the Definition of the Patent

The IAPIP

1. recommends the introduction into the Convention of a definition of the patent of invention;

2. decides to continue with the study of the question on the basis of the following principles:

(a) the definition of patentability adopted by the IAPIP at the Berlin Congress;

(b) the right conferred by the patent is an exclusive and temporary right of exploitation; this right should run for a reasonable minimum time;

(c) the definition should be precise, so as to clearly distinguish the patent from other titles of protection, and in particular from the inventor's certificate.

On Working

The IAPIP

1. states that the excuses that the patentee can invoke to justify nonworking of his patent under the terms of Article 5 (4) include also economic reasons;

2. confirms its traditional position according to which revocation of the patent should not be the main sanction for nonworking or insufficient working;

proposes to institutionalize the obligation to have amicable negotiations before any sanction;

3. envisages the institution of a compulsory temporary and nonexclusive license of importation in favour of developing countries as long as the protected invention is not exploited in the country;

4. is opposed to the compulsory license having an exclusive character.

On the Inventor's Certificate

The IAPIP

1. confirms its Tokyo Resolution (1966) under the terms of which the inventor's certificate must be considered as an industrial property title, and recognized as such within the Convention by reason of the Union's universality;

2. recognizes that from the viewpoint of legal mechanics, it is not possible to provide for a total assimilation of the inventor's certificate to the patent of invention, due to the difference existing between the two titles, notably as far as the rights conferred are concerned;

the problem is, however, one of drafting, and the study should be continued;

3. accepts that for economic reasons the nationals of the countries which issue patents must be able to choose between the certificate and the patent in those countries which issue inventors' certificates.

Article 4 (i), introduced into the Convention at Stockholm, is therefore a useful provision.

A conciliation on this subject must be sought.

On Time Limits for Exploiting Marks

The IAPIP

1. considers that it is not up to Convention law to impose upon the countries that they require use of the mark and that they provide for the revocation in cases of nonuse;

2. considers that the present text of Article 5 C (I) of the Convention should not be amended but notes that this Article, which requires a "reasonable period" to organize the use of the mark, does not fix the duration of this period.

The IAPIP considers that the minimum period could be fixed at 5 years.

On the Abrogation of Article 6bis (Well-Known Marks)

The IAPIP considers that Article 6bis of the Convention should be retained since the protection which it institutes in favour of the public benefits not only the nationals of developing countries but also those of industrialized countries.

On Compulsory Licenses of Trademarks

The IAPIP considers that compulsory licenses for trademarks should be refused and that a particular rule in this sense should be introduced into the Convention to avoid contrary interpretations being given to the Convention, in view of its silence on this subject.

On the Independence of Trademarks

The IAPIP considers that the independence of trademarks should be maintained.

On the Conflict between a Trademark and a Geographical Name

The IAPIP

1. reaffirms the interest and the value of geographical names, particularly for less industrialized countries, and it decides to continue the study of the question of conflict between trademarks and geographical names;
2. expresses the wish that Article 10bis, § 3, of the Convention, listing the acts of unfair competition that the states agree to prohibit, be completed by a provision concerning the use of geographical names as trademarks where this use is liable to deceive the public on the source of the product.

On Industrial Designs

The IAPIP

1. confirms the definition of industrial designs worked out in the Berlin (1963) and Tokyo (1966) Congresses;
2. rejects the proposal to revoke Article 5quinquies of the Convention, which requires that member countries protect industrial designs;
3. is opposed to any system of compulsory licensing of industrial designs. Such licenses are not justified, since industrial designs protect only the form or the new aspect of an object and not its functional features;
4. affirms that any forfeiture of industrial designs which is excluded by Article 5 B of the Convention cannot be justified since it conflicts with the object of the right: the product can always be made and marketed under a different esthetic or decorative form.

On the Majority Required for the Adoption of Decisions of the Revision Conference

The IAPIP

1. considers that the unanimity rule could be replaced by that of a highly-qualified majority;
2. but considers that this amendment can only be envisaged after examination of the consequences resulting from Article 27, § 3, of the Convention.

Service Marks

The IAPIP

favours an amendment of Article 6sexies of the Paris Convention to provide for the registration of service marks.

* * * * *

QUESTION 67

Revision of the Paris Convention

Yearbook 1978/II, pages 150 - 153
30th Congress of Munich, May 15 - 19, 1978

Q67

Question Q67

Revision of the Paris Convention

The IAPIP

has thoroughly examined the last proposals for the revision of the Paris Convention of 1883 and has reached the following results:

1. Preferential treatment

The IAPIP reaffirms the position taken by its Executive Committee at Montreux that

- no valid reasons exist for increasing the term for claiming priority in favour of nationals of developing countries;
- it is not in order to provide for a reduction of fees in favour of nationals of developing countries.

(See *Annuaire AIPPI* 1977/I, p. 259.)

2. Time limit in Article 5 C (1) of the Paris Convention

After considering such related matters as the time limit in Article 19 of the Trademark Registration Treaty and the time limit in the proposed European Trademark System, the IAPIP unanimously affirms its position taken in Montreux of maintaining the present wording of Article 5C(1).

(See *Annuaire AIPPI* 1977/I, p. 149.)

3. Independence of marks

The IAPIP reaffirms its position taken in Montreux that the independence of marks must be maintained pursuant to Article 6 of the Paris Convention.

4. Article 5quater of the Paris Convention (process patents)

After considering the practical relevance of Article 5quater to the developing countries and the question of any possible relation to Article 5 A, the IAPIP reaffirms its position taken in Montreux that Article 5quater must be retained in the Paris Convention.

(See *Annuaire AIPPI 1977/I*, pp. 261, 262.)

5. Inventors' certificates

(a) New Article 1(I)-(4) of the Paris Convention

The IAPIP studied the proposal by the PIC Working Group on Inventors' Certificates (first part) (reproduced as Annex I, p. 153) which was presented at the June 1977 PIC meeting.

The IAPIP notes that this proposal responds to its desire expressed most recently as to the inclusion of a definition of patents and inventors' certificates in the Paris Convention.

(See *Annuaire AIPPI 1977/I*, pp.260, 261.)

It is however of the opinion that the wording of Article 1 (2)(b) could be improved from a drafting standpoint.

(b) New Article 1(5) of the Paris Convention

The IAPIP studied the following documents:

- proposal of the PIC Working Group on Inventors' Certificates submitted at the June 1977 PIC meeting (second part) (reproduced as Annex II, p. 154);
- proposal of the Group D countries submitted at the November 1977 PIC Working Group meeting (reproduced as Annex III, p. 154);
- proposal of the Group B countries submitted to the June 1978 PIC Working Group meeting (reproduced as Annex IV, p. 155).

The IAPIP is of the opinion that the text of Annex IV constitutes an acceptable basis for the drafting of a new Article 1(5) of the Paris Convention.

6. Proposal for a new Article 5 A of the Paris Convention

The IAPIP has again considered the PIC proposal for a new Article 5A of the Paris Convention (see Annex V, p. 155) and confirms its position taken in Montreux that a compulsory licence because of its very nature can never be an exclusive one.

7. Name and emblem of Olympic Games

The IAPIP has taken notice of a proposal originating from certain developing countries seeking the inclusion of a new article in the Paris Convention providing for a special protection of the name and emblem of the Olympic Games. It is of the opinion that the matter was inappropriate for regulation in the Paris Convention.

8. Exclusion of South Africa from the revision process

The IAPIP was informed that the invitation of South Africa to the November 1977 PIC meeting was withdrawn by WIPO following the vote of the WIPO Coordination Committee. This vote has the effect that a member of the Paris Convention is prohibited to be represented at the meetings of WIPO. The IAPIP affirms its opinion that no such exclusion measure can be taken against a member country of the Paris Convention.

9. International protection of appellations of origin and indications of source

The IAPIP has taken notice of several proposals made within the Intergovernmental Preparatory Committee on the Revision of the Paris Convention concerning the protection of geographical indications in general and particularly with regard to trademarks.

The IAPIP appreciates the general tendency expressed in these proposals to strengthen the protection of geographical indications, the importance of which it has underlined in its preceding resolutions of Melbourne (1974), San Francisco (1975) and Montreux (1976) and which present a particular interest for developing countries.

A. On the proposal to amend Article 10bis(3) of the Convention

The IAPIP agrees with the text proposed in document WIPO (TAO PR/PIC/III/6):

"3. The following in particular shall be prohibited:

...

3. Indications, including trademarks and service marks, or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the geographical origin, the suitability for their purpose or the quantity, of the goods or services."

Indeed, the inclusion of misrepresentations as to the geographical origin corrects a serious gap in the international system of prohibiting unfair competition.

Furthermore, the express mention of trademarks avoids any ambiguity as to the interpretation of the term "indication" of the present text.

Nevertheless, the approval of the proposed text by the IAPIP must not be considered as an anticipated decision on the question whether the protection of geographical indication within the framework of the TAO Treaty should extend to services.

B. On a new article to be included in the Convention concerning the registration of a geographical indication as a trademark

The IAPIP has taken notice that document WIPO PR/PIC/III/10 proposes two different versions of a new article to be included in the Paris Convention.

It agrees with the principle according to which a contracting State should refuse or cancel the registration as a trademark of a geographical indication which is likely to mislead the public as to the geographic origin of the product or service.

It is, however, of the opinion that the restriction of the application of that principle to well-known geographical names would considerably limit the effects of the provision.

Consequently, the IAPIP expresses the wish that the new article to be included in the Convention should be drafted as follows:

"1. Each country of the Union undertakes to refuse or to cancel the registration of a mark which is likely to mislead the public as to the geographic origin of the products or services for which the registration is requested or has been effected.

2. To determine whether the mark is likely to mislead the public, all the factual circumstances must be taken into consideration, particularly the length of time the mark has been in use, and the distinctive character it has acquired by such use."

Paragraph 1 will permit member States not to refuse the registration of a mark which is identical to a geographical name if that name is not considered by the public of the country where the protection is requested as a geographical indication of source.

Paragraph 2 is intended to institute an interpretation rule based on the model of Article 6quinquies C (1) which would allow the member States not to refuse the registration of a mark consisting of a geographical indication if that indication is not or is no longer likely to deceive the public as to the origin because of the distinctive character which the mark has acquired by its use in respect of the products or services of an enterprise.

The IAPIP adds that in case that the new wording of Article 10bis(3) is not accepted, it would appreciate that the text of a new article as proposed at B supra would be amended by a new provision according to which the member countries of the Paris Convention would undertake to *prohibit the use of a mark* which is likely to deceive the public as to the geographical origin.

* * * * *

QUESTION 67

Revision of the Paris Convention

Yearbook 1980/I, pages 118 - 120

Q67

Executive Committee and Council of Presidents of Toronto, September 23 - 29, 1979

Question Q67

Revision of the Paris Convention

Resolution

I. The IAPIP has thoroughly examined the "Basic Proposals" for the revision of the Paris Convention, contained in WIPO document PR/DC/3 and has reached the following results:

1. Protection of Inventions by Patents and Inventors' Certificates - Article 1 (2) - (5) Paris Convention

a) The IAPIP reaffirms the position taken at its Munich Congress.

(See *Annuaire IAPIP 1978/II*, p. 151 (b)).

b) The IAPIP notes that with respect to the proposed definition of a patent (Art. 1 (2)), the drafting suggestion by the Director General of WIPO to replace the word "patents" by the words "patents for inventions" is helpful and supports this suggestion. It recommends, however, that in such a case draft Article 1(4) must be maintained.

2. Working and Non-Voluntary Licences - Article 5A Paris Convention

a) The IAPIP has studied the different paragraphs of draft Article 5A in detail. With respect to draft Article 5A (6), it reaffirms the principle adopted in Montreux and Munich that a compulsory licence should never be exclusive in nature.

(See *Annuaire IAPIP 1977/I*, page 263; *1978/II*, page 151).

b) The IAPIP notes that draft Article 5A (1) (b) first sentence is of a self-executing character. The effects of this being undesirable, the IAPIP proposes the following substitute language:

"(1) (b) Any country of the Union has the right to determine whether or not the importation of articles incorporating the patented invention or made by the patented process fulfil the requirement of working the patented invention."

c) With respect to the possible sanctions in case of failure to work or insufficient working (draft Article 5A (4)), the IAPIP notes that the draft article does not state with sufficient clarity that in cases of simple failure to work or simple insufficient working, forfeiture or revocation must be preceded by a procedure for the grant of a non-voluntary licence.

d) With respect to draft Article 5A (8), the IAPIP is of the opinion that Article 5A should be of a universal character. It, therefore, takes the position that draft Article 5A (8) should not be included in the Paris Convention.

e) Even if draft Article 5A (8) (a) were to be adopted, the IAPIP strongly opposes the inclusion of draft Article 5A (8) (b) in the Paris Convention.

f) Furthermore, if the Revision Conference should adopt a provision along the lines of draft Article 5A (8) (b), the IAPIP urges that the sanction of forfeiture be replaced by temporary suspension of the patent rights ("French Proposal" - Document PR/DC/3 para. 140).

3. Process Patents - Article 5^{quater} Paris Convention

The IAPIP confirms its position taken in Montreux and Munich that Article 5^{quater} must be retained in the Paris Convention.

(See Annuaire IAPIP 1977/I, pp. 261, 262; Annuaire IAPIP 1978/II, p. 151)

4. Preferential Treatment

The IAPIP has studied the basic proposals "Article A" and "Article B", containing previous proposals already considered at Montreux and Munich.

a) It reaffirms the position that a reduction of fees in favour of nationals of developing countries should not be provided for.

b) It reaffirms the position that the terms for claiming priority should not be increased in favour of nationals of developing countries.

(See Annuaire IAPIP 1977/I, p. 259; 1978/II, p. 150)

5. Furnishing of Information - New Article 12 bis Paris Convention

The IAPIP has studied proposed New Article 12^{bis} requiring national patent offices to furnish on request information concerning corresponding applications and patents. The IAPIP doubts the usefulness of such a proviso and declares against the inclusion of New Article 12^{bis} in the Paris Convention.

6. Contribution of the Union to the Development of Developing Countries - New Article 12^{ter} Paris Convention

The IAPIP approves the spirit of proposed New Article 12^{ter}. It is of the opinion, however, that the proposed English text could be improved from a drafting standpoint.

7. Final Provisions - Article 20-30 Paris Convention

a) Entry into Force - Article 21 Paris Convention

The IAPIP stresses that only those countries which are members of the Union at the time of ratifying or acceding to the revised act of the Paris Convention should be able to cause this act to enter into force. It is of the opinion that the number of ratifications or accessions necessary for this entry into force, should be at least ten. The IAPIP, therefore, supports Alternative B of draft Article 21.

b) Closing of earlier Acts - Article 23 Paris Convention

The IAPIP notes the link between draft Article 23 and draft Article 21. It, therefore, takes the position that Alternative B of draft Article 23 is acceptable if Alternative B of draft Article 21 is adopted. In the event that Alternative A of draft Article 21 is adopted, then the IAPIP is of the opinion that Alternative A of draft Article 23 should be adopted.

c) Territories - Article 24 Paris Convention

Having considered the sensitive political aspects of this question, the IAPIP nevertheless, came to the conclusion that a deletion of this article would entail considerable juridical uncertainty as to the law applicable in those territories. It, therefore, takes the position that with respect to Article 24 Alternative B should be adopted.

d) Application of the New Act - Article 27 Paris Convention

(i) The IAPIP notes that Article 27 (3) of the present text does not appear in draft Article 27. It is, therefore, of the opinion that the problem of Article 23 (3) of the present text raised in Montreux no longer exists.

(See Annuaire IAPIP 1977/I, p. 150)

(ii) With respect to draft Article 27 (2) (a) and (b) the IAPIP is of the opinion that this provision should be of universal character. It, therefore, opposes special provisions applicable only to developing countries and favours the deletion of the words "which are developing countries and" in square brackets in draft Article 27 (2) (a) and (b).

e) Settlement of Disputes - Article 28 Paris Convention

The IAPIP has studied draft Article 28 (Alternative B). It is of the opinion that the present text of Article 28 Paris Convention should be retained (Alternative A).

f) Original and Official Text - Article 29 Paris Convention

The IAPIP is of the opinion that, as a practical matter, for the interpretation of the Convention one text, viz. the French text, should prevail. It, therefore, favours retaining the present text of Article 29 (1) (c) (Alternative A).

8. Protection of the Olympic Symbol

The IAPIP has studied the draft Protocol on the Protection of the Olympic Symbol. It affirms the position taken in Munich that the matter of protecting the Olympic Symbol is inappropriate for regulation in the Paris Convention.

(See *Annuaire AIPPI* 1978/II, p. 151)

II. The IAPIP has examined the Provisional Rules of Procedure of the Diplomatic Conference on the Revision of the Paris Convention, contained in WIPO document PR/DC/2, and has reached the following results.

1. Having studied in particular Chapter VII of the Provisional Rules of Procedure relating to voting, the IAPIP is of the opinion that, as a minimum, the Rules of Procedure should be adopted unanimously.

2. The IAPIP notes with concern that Proposed Rule 2 provides for the participation of non-member states of the Union in the Diplomatic Conference. This is in conflict with Article 18 Paris

Convention, and the fact that non-member states of the Union will not have the right to vote, does not alleviate the IAPIP's concern.

3. Having studied the question of replacing the existing principle of unanimity for revising the Paris Convention by a system of qualified majority, the IAPIP takes the position:

- that even a highly qualified majority would not exclude the possibility of a revision conference deciding against the votes of a significant minority group of countries, and

- that, on the other hand, it would seem only necessary to exclude the possibility of one state using its voting right as a veto.

The IAPIP therefore proposes that the Revised Text shall not be adopted if at least three member states of the Union vote against such adoption.

* * * * *

QUESTION 67

Revision of the Paris Convention

Yearbook 1981, pages 144 - 145
31st Congress of Buenos Aires, November 16 - 21, 1980

Q67

Question Q67

Revision of the Paris Convention

Resolution

I. On Article 5-A

1. *Obligation to Work Patents (1(a))*

The IAPIP

recognizes the right of States to impose through national law the obligation to work patented inventions. The IAPIP, however, emphasizes that such obligations must not come into being until the grant of the patent.

2. *Compulsory Licenses (6)*

The IAPIP

reaffirms its resolution adopted in Montreux in 1976, Munich in 1978 and Toronto in 1979 that a compulsory license should never be exclusive in nature.

3. *Sanctions under Article 5 A*

The IAPIP

urges that the text of Article 5 A makes it clear that the sanctions provided therein are applicable only to cases of simple failure to work or insufficient working. The IAPIP affirms that failure to work or insufficient working is not of itself abuse of the patent right.

4. *Special Provisions for Developing Countries (8(a) and (b))*

The IAPIP

reaffirms the Resolution adopted in Toronto in 1979.

The IAPIP favours further study of the sanction of temporary suspension of the patent right (French proposal).

5. The IAPIP

believes that consideration should be given to the introduction into the Paris Convention of provisions specifically designed to benefit developing countries, provided that such provisions entail no weakening of the basic principles of the Paris Convention. The IAPIP favours further study of constructive proposals for such provisions.

II. On Inventor's Certificates

The IAPIP

reaffirms its Resolution of Toronto in 1979.

* * * * *

QUESTION 67

Revision of the Paris Convention

Yearbook 1982/III, pages 106 - 107

Q67, Q45

Executive Committee and Council of Presidents of Moscow, April 19 - 24, 1982

Question Q67

Revision of the Paris Convention

Question Q45

Value of Industrial Property for Technical Development and Economic Progress in Developing Countries

Resolution

I. On Art. 5 A: Sanctions for Failure to Work; Compulsory License and Lapsing, Suspension

The IAPIP

recalls that the Convention presupposes the existence in all countries of the Union of a patent system which is effective and which therefore permits the universal application of its provisions.

a) The IAPIP

affirms once again emphatically that the consequence of the weakening of the protection of industrial property would be to raise obstacles to the transfer of technology;

is convinced that certain proposals, formulated at the Nairobi session, and alleged to be put forward as beneficial to developing countries, would lead, if adopted in the national law of these countries, to their no longer having an effective system for the protection of patents, even though these countries would remain members of the Union and, as such, would continue to benefit from the provisions of the Paris Convention;

declares itself opposed to the introduction in the Paris Convention of provisions of such a character, which would affect the Convention in a fundamental manner;

and affirms that, if such provisions should nevertheless be introduced into the Convention, they should be applicable only to developing countries, despite the difficulty which it recognizes in defining developing countries.

b) After having examined the proposal formulated at the Nairobi session permitting developing countries to provide in their national law a provision pursuant to which a compulsory license could, under certain conditions, be exclusive even as against the patentee,

the IAPIP

believes that no situation justifies turning a patent against the inventor himself so that this inventor is excluded from the working of his own invention;

is convinced that such a measure would constitute a serious obstacle to the transfer of technology;

and affirms once more that a compulsory license must never be exclusive.

c) After having examined the proposal formulated at the Nairobi session permitting developing countries to provide in their national law a provision pursuant to which the lapsing or revocation of a patent could be declared under certain conditions as the primary sanction without need for the preliminary measure of a compulsory license,

the IAPIP

believes that the elimination of a preliminary compulsory license which today constitutes a condition precedent, would destroy all objective criteria and render the application of the sanction of lapsing subject exclusively to decision by a national authority,

re-affirms, as it has always maintained, its opposition in principle to this sanction, because such a sanction results in the destruction of the very patent right itself.

d) The IAPIP

has taken knowledge with interest of a proposal for the substitution of the sanction of suspension to the sanctions of a compulsory license and lapsing.

Under this solution, when a patent has not been worked by the expiration of a certain term, the rights of the patentee are suspended. As the rights of the patentee are suspended, anyone is entitled to work the invention or import the patented goods. If the patentee undertakes to work the invention, the effects of the patent are restored, but a person who has begun to work may continue to work by virtue of his vested right. On the other hand, a person who has simply imported the goods would not be entitled to continue importing.

However, the IAPIP has noted the difficulties which the sanction of suspension is likely to raise, and has decided to continue an in-depth study of this question.

II. On the final clauses: Art. 20 and following

After having examined the proposals for revision of Art. 20 and 27,

1. On Art. 20: Ratification or Adherence by the Countries of the Union; Coming into Force

The IAPIP

notes that, at the Nairobi session, it was proposed to provide that a country which signed the new act could, in order to be bound by this act, either ratify this act, or else declare its acceptance or approval of this act.

In order to insure the juridical certainty of nationals of member states of the Union, the IAPIP expresses the wish that whatever procedure may be used - ratification, acceptance or approval - the national laws of country shall provide that the new act shall be directly applicable to such nationals in the state in question.

2. On Art. 27: Application of Prior Acts

The IAPIP

has taken knowledge of the draft Art. 27 of the basic proposals and of the elimination, in this draft, of paragraph 3 which presently appears in the Stockholm text, pursuant to which countries outside the Union, which become party to the new act, shall apply the same as against any country of the Union which is not a party to this act, while such country shall apply, in its relations with the countries of the Union which have become party to the new Act, the most recent act to which it is a party;

recognizes that the retention of the rule of Art. 27, paragraph 3, in the text of the contemplated new act, would result in permitting the new act to be applied even as against nationals of a state which has not yet ratified this new act. Such a result, however, would be very serious by reason of the fact, most particularly, that Art. 5 A constitutes a weakening of the rights of the patentee,

notes that the provision which appears in the proposal for a new Art. 27 (2) leaves to each of the countries of the Union in regard to which the new act has not come into force, the option to declare that it agrees that countries party to the new act may apply this act to its nationals, and is of the opinion that in the circumstances, no solution more satisfactory than the elimination of paragraph 3 of Art. 27 appears possible.

* * * * *

QUESTION 67

Revision of the Paris Convention

Yearbook 1984/I, pages 156 - 160
32nd Congress of Paris, May 22 - 27, 1983

Q67

Question Q67 Revision of the Paris Convention

Resolution

I. Article 5A Paris Convention

(Geneva proposal 1982)

The AIPPI notes with satisfaction that the new draft Article 5A responds to one major concern expressed by AIPPI, by providing that a compulsory license should never be exclusive;

(1) *Considering* that the new subparagraph (8) (b) follows the present wording of Article 5A (4) insofar as it allows forfeiture in case of *insufficient* working, a provision which is pertinent only as far as the grant of compulsory licenses (non-voluntary licenses) is concerned.

Considering, however, that such possibility would prejudice the interests of small and medium sized enterprises in developing countries in working their own patents,

The AIPPI takes the position that all references to *sufficient* or *insufficient* working in the new draft Article 5A (8) (b) be deleted.

(2) *Considering* that some of the harshness of forfeiture or revocation arising from the new text of Article 5A (8) (b) could be avoided by incorporating an improvement which draws on the basic idea of suspension and calls for preserving as much as possible the patent right. With these views the AIPPI proposes a solution found in national patent law and in Article 5 bis of the Paris Convention, namely to provide for the *restoration* of the forfeited or revoked patent under certain conditions.

Consequently, the AIPPI proposes that draft Article 5A (8) be completed by adding two new subparagraphs (c) and (d) reading as follows:

(c) A patent which has been forfeited or revoked in accordance with subparagraph (b) above shall be restored in case the patentee starts, either by himself or through a voluntary licensee, the working of the patented invention within a period of three years after the date forfeiture or revocation took place.

(d) Any person having commenced working the patented invention in the country during the time of forfeiture or revocation may continue such working notwithstanding the restoration of the patent as provided in subparagraph (c) above.

II. Article 5quater Paris Convention

(Geneva proposal 1982)

It has been the position of the AIPPI that article 5quater should be maintained. The AIPPI notes, however, that the new text for revision of Article 5A (Annex I) proposes that any developing country shall have the right not to apply Article 5quater and that this proposal seems to be an integral part of the "package" involving the solution of all issues under Article 5A.

The AIPPI is of the opinion that any country of the Union could solve difficulties it may have with article 5quater by simply reducing the scope of protection of process patents afforded by the national law.

Under these circumstances the AIPPI resolves that the proposed amendment to Article 5quater is acceptable as part of the package solution envisaged for Article 5A (Annex I).

III. Article 1 Paris Convention

(Geneva proposal 1982)

The AIPPI is of the opinion that it is extremely important that the Paris Convention includes clear definitions of both patents and inventor's certificates. It came to the conclusion that neither definition contained in the Geneva proposals satisfactorily defines a patent right. In particular, the AIPPI notes that the proposal advanced by the Group B countries (Annex II) is deficient insofar as it may include certain types of inventors' certificates which reserve the right to exploit the invention to the State and confer on the holder of the title only the right to prevent others from exploiting the invention. On the other hand the proposal of the Group D countries (Annex III) is deficient insofar as it reduces the patent right to a mere right of industrially working the patented invention and thereby excludes the right to sell or import.

Consequently the AIPPI *urges* the countries of the Union to continue their efforts to come to a satisfactory definition of the patent right which distinguishes this right clearly from any type of inventors' certificate.

IV. Duration of Protection

The AIPPI

notes with concern that recently enacted patent laws of some countries drastically reduce the duration of patents;

recalls that only a sufficient duration of a patent ensures the promotion of the technical and economic development of all countries;

underlines that the system of the Paris Convention necessarily presupposes a patent protection which is sufficient, in particular as regards the duration of patents.

Therefore, at its XXXIInd Congress celebrating the centenary of the Paris Convention, the AIPPI invites all countries to provide in their national laws for a sufficient duration of patents .

V. On the Continuation of the Work of AIPPI

Furthermore, the AIPPI resolves that the Working Committee 67 should continue, on the basis of the work of the AIPPI, to study the definition of a patent and an inventor's certificate including the important issue of sufficient duration of protection.

Annex I.

I. Article 5A

(1) (a) Any country of the Union has the right to require by its national law that the inventions for which that country has granted a patent, or in the case of countries providing for a deferred examination when a provisional protection has been granted, be worked in its territory by the owner of the patent or under his authorization.

b) Importation of articles incorporating the patented invention or made by the patented process does not constitute working of the patented invention. However, any country of the Union has the right to regard the importation of articles incorporating the patented invention or made by the patented process as fulfilling the requirements of working the patented invention.

(2) (a) For the purposes of this Article, "non-voluntary license" means a license to work a patented invention without the authorization of the owner of the patent; it also means a license to work a patented invention given by the owner of the patent where the national law obliges him to give such a license.

(b) Any country of the Union has the right to adopt legislative measures to prevent abuses resulting from the exercising of the rights granted by the patent. However, importation into the country where the patent has been granted of articles manufactured in any of the countries of the Union shall not, in the absence of circumstances constituting abuse of the patent rights, entail forfeiture of the patent.

(3) Forfeiture of the patent shall not be provided for except in cases where the grant of non-voluntary licenses would not have been sufficient to prevent the said abuses. No proceedings for the forfeiture or revocation of the patent may be instituted before the expiration of two years from the grant of the first non-voluntary license.

(4) A non-voluntary license may not be applied for on the ground of failure to work or insufficient working before the expiration of a period of four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period expires last; it shall be refused if the owner of the patent proves circumstances which in the judgement of the national authorities competent to grant non-voluntary licenses justify the non-working or insufficient working of the patented invention.

(5) Any country of the Union has the right to provide in its national law, where the exploitation of the patented invention is required by reason of public interest, in particular national security, nutrition, health or the development of other vital sectors of the national economy for the possibility of exploitation, at any time, of the patented invention by the government of that country or by third persons authorized by it.

(6) Any non-voluntary license shall be non-exclusive and shall not be transferable, even in the form of a grant of a sublicense, except with that part of the enterprise or goodwill which exploits such license.

(7) Any decision relating to the grant of a non-voluntary license or to exploitation in the public interest, including the amount of the just payment to which the patentee is entitled, or any decision relating to the revocation or forfeiture of a patent shall be subject to review at a distinct higher level in accordance with the applicable national law.

(8) Notwithstanding anything contained in paragraphs (3) and (4), developing countries have the right to apply the following provisions:

(a) Any developing country has the right to grant non-voluntary licenses where the patented invention is not worked, or is not sufficiently worked, by the owner of the patent or under his authorization in the territory of that country within 30 months from the grant of the patent in that country, unless the owner of the patent proves circumstances which in the judgement of the national authorities competent to grant non-voluntary licenses justify the non-working or insufficient working of the patented invention. Where the national law provides for deferred examination for patentability and the procedure for such exami-

nation has not been initiated within three years from the filing of the patent application, the time limit referred to in the preceding sentence shall be four years from the filing of the said application.

(b) Any developing country has the right to provide in its national law that the patent may be forfeited or may be revoked where the patented invention is not worked, or is not sufficiently worked, in the country before the expiration of five years from the grant of the patent in that country, provided that the national law of the country provides for a system of non-voluntary licenses applicable to that patent and that, in the opinion of the national authorities competent for forfeiture or revocation, at the time of the decision concerning forfeiture or revocation, the grant of a non-voluntary license would not be possible because there is no applicant for a non-voluntary license who could ensure sufficient working, or that the beneficiary of a non-voluntary license, if one was granted before the decision concerning forfeiture or revocation, did not, in fact, ensure sufficient working, unless the owner of the patent proves circumstances which in the judgement of the national authorities competent for forfeiture or revocation justify the non-working or insufficient working of the patented invention.

(9) The foregoing provisions shall be applicable, mutatis mutandis, to utility models.

II. Article 5 quater

(1) [Same as present of Article 5quater]

(2) Any developing country has the right not to apply the provisions of paragraph (1).

Annex II.

Article 1

Proposal by the Delegation of Switzerland presented in the name of the Group B countries

Definition of the patent proposal partly amending document PR / DC/21

(2) (b) For the purposes of this Convention:

(i) patents are titles by virtue of which inventors, their successors in title or other holders enjoy, for a limited period of time, an exclusive right which includes the right to prevent others from exploiting the invention without their authorization.

(ii) ...

Note of the Secretariat. In the October 8, 1982, meeting of Main Committee II of the Conference, the Director General said that the Secretariat would process only amendments presented by Delegations of States and - and no amendments referring to one or several "Groups" - since Rule 31(1) and (2)(i) of the Rules of Procedure* speaks only of Delegations and not of Groups. Since the Spokesman of Group B insists that the present amendment refer to his Group, the present document was issued by the Secretariat but the Director General will ask the Plenary to give clear instructions to the Secretariat as to the correct interpretation of Rule 31(1) and (2) (i).*

Annex III.

Article 1

Proposal by the Delegation of the Soviet Union, supported by the Delegations of Bulgaria, Czechoslovakia, the German Democratic Republic, Hungary, Poland, the Byelorussian SSR and the Ukrainian SSR to amend document PR/DC/22

(2) (b) For the purposes of this Convention:

(i) patents are titles by virtue of which inventors, their successors in title or other holders in accordance with the law of the country of the Union having granted such a title enjoy, for a limited period of time, an exclusive right which includes the right to work the invention and the right to prevent others from working the invention without their authorization,

(ii) inventor's certificates are titles by virtue of which inventors, their successors in title or other holders in accordance with the law of the country of the Union having granted such a title

- have the right to remuneration and also other rights and privileges provided for by the State, which acquires the exclusive right of a limited duration in the invention and takes care of the working of the invention, or in which the working of the invention by others requires for a limited period of time authorization of a State authority, or

- have the right to work the invention and, for a limited period of time, to receive from others remuneration, the amount of the latter and other conditions of working of the invention by others being approved by a State authority, but have no right to prevent others from working the invention.

This proposal replaces the proposal contained in document PR/DC/43.

* * * * *

*(1) Any Delegation of a State member of the Paris Union may propose amendments to the basic proposals.
(2) Any Delegation of a State not member of the Paris Union may propose amendments to the basic proposals provided that:
(i) where the proposal is made in writing, it is made jointly with a Delegation of a State member of the Paris Union;"

QUESTION 67

Revision of the Paris Convention

Yearbook 1984/III, page 96

Q67

Council of President of Athens 1983, November 6 - 9, 1983

Question Q67

Revision of the Paris Convention

Resolution

On Article 1

The AIPPI suggests that for the revision of Article 1 of the Paris Convention the following wording be adopted for:

Article 1 (2) (b)

For the purposes of this Convention, patents are titles by virtue of which inventors, their successors in title or other holders enjoy, for a limited period of time, the exclusive right to exploit the patented invention and to permit the exploitation by third parties. This exclusive right includes the right to prevent others from exploiting the invention without the authorization of the patentee. It must be capable of being held and exercised by private persons through this period.

Article 1 (5) (a)

Each country of the Union shall protect inventions

(i) by the grant of patents, or

(ii) by the grant of both patents and other forms of protection such as inventors' certificates in the same fields of technology and for the same categories of subject matter such as products or processes.

On Article 5A

I.

The AIPPI notes

1) that the Developing Countries have asked to add to Draft Article 5A (8) a new subparagraph enabling Developing Countries to ensure the "economic viability" of the

enterprise of a non-voluntary licensee by taking "appropriate measures" not directly related to patent law;

2) that the concern of the Developing Countries is understandable. Indeed, it seems at least theoretically possible that a patentee who enjoys a strong market position could somehow misuse this position to the detriment of the holder of a non-voluntary licensee;

3) that, however, it is the opinion of the AIPPI based on experience that such a case of actual misuse has always been and in the future, would be of an exceptional nature;

4) that, as a consequence, the problem raised by the Developing Countries does not seem to require an express provision in the Paris Convention. Indeed, as a matter of law, such a provision would seem inappropriate for inclusion in the Paris Convention;

5) that, nevertheless, if such problems really arise in practice, all countries of the Union already have the possibility adequately to treat them under their national law.

II.

In order to dispel any doubt which may exist on this point, the AIPPI proposes that relevant explanatory comments on this matter be included in the Minutes of the Diplomatic Conference.

The AIPPI wishes, however, to emphasize that any measure aiming to protect the holder of a non-voluntary licence against certain acts of competition of the patentee, should never prejudice the right of the patentee to exploit the patented invention.

* * * * *