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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL UNION FOR THE PROTECTION OF INDUSTRIAL PROPERTY

(PARIS UNION)

DIPLOMATIC CONFERENCE
ON THE REVISION OF THE PARIS CONVENTION

Third Session, Second Part
Geneva, November 23 to 27, 1982

REPORT

of the Chairman of Main Committee I,
Ambassador F. Jiménez Dávila (Argentina),
to the Diplomatic Conference, meeting in Plenary
on November 27, 1982

Mr. President,

Main Committee I, which I have the honor to chair, held, during this third session of the Diplomatic Conference, 11 meetings, namely on October 11, 13, 14, 19, 20, 22, 25, 26, 27 and November 27, 1982. Main Committee I dealt with Articles 6ter and 10quater. As agreed in the first session of the Diplomatic Conference, those meetings were chaired by Dr. Claës Uggla (Sweden). Those parts of this report which deal with the said two articles were prepared by him and are presented jointly by him and me.

The basic proposals concerning Articles 6ter and 10quater are contained in document PR/DC/4. In addition to the basic proposals, various proposals concerning Articles 6ter and 10quater were presented during the third session of the Diplomatic Conference, which have been reproduced and distributed in documents PR/DC/42, 44, 44 Rev., 46 and 48 and which contain amendments to the basic proposals.

As regards Article 6ter, after a full discussion, agreement was reached on October 22, 1982, on the text which is reproduced in Annex I to this report and which extends the protection under Article 6ter to official names of States. Main Committee I unanimously adopted this text and transmitted it to the Drafting Committee.

As regards Article 10quater, a Working Group was established by Main Committee I on October 22, which was composed of the Delegations of Argentina, Austria, Brazil, Bulgaria, Canada, Czechoslovakia, Egypt, France, Germany (Federal Republic of), the German Democratic Republic, Hungary, Poland, Portugal, the Soviet Union, Switzerland, the Syrian Arab Republic, Tanzania, the Ukrainian SSR, the United States of America, Uruguay and Yugoslavia, and chaired by Dr. Claës Uggla (Sweden), the Chairman of Main Committee I for questions concerning Articles 6ter and 10quater.

The Chairman of the Working Group on Article 10quater reported to Main Committee I on the discussions which had taken place in the Working Group. Main Committee I noted his report, which is reproduced in Annex II to this report.

In the course of this third session of the Conference, I started consultations with various delegations with a view to searching for a formula that would make it possible to arrive at a consensus on Article 5A in the form in which it emerged from the Nairobi session. After a first round of informal consultations, unofficial consultations, I was able to work out a text that I personally thought could lead to a convergence of views; this text will be reproduced as an Annex* to my report on the work of the Main Committee. I circulated it on my responsibility as a suggestion to the various delegations. The said text was considered at informal consultations that I arranged with a certain group of delegations representing all the regional groups, yet unfortunately, Mr. President, those consultations did not lead to the consensus which I had tried to achieve.

Thank you, Mr. President.

[The Annexes follow]

* See Annex III of this document.

ARTICLE 6^{ter}
OF THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY,
AS ADOPTED ON OCTOBER 22, 1982, BY MAIN COMMITTEE I
AND TRANSMITTED TO THE DRAFTING COMMITTEE

Article 6^{ter}

[Marks: Prohibitions concerning
Names of States, State Emblems,
Official Hallmarks, and Emblems of
Intergovernmental Organizations]

(1) (a) The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, as well as the official names, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.

(b) The provisions of subparagraph (a), above, shall apply equally to armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations of which one or more countries of the Union are members, with the exception of armorial bearings, flags, other emblems, abbreviations, and names, that are already the subject of international agreements in force, intended to ensure their protection.

[Article 6ter(1), continued]

(c) No country of the Union shall be required to apply the provisions of subparagraph (b), above, to the prejudice of the owners of rights acquired in good faith before the entry into force, in that country, of this Convention. The countries of the Union shall not be required to apply the said provisions when the use or registration referred to in subparagraph (a), above, is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization.

(2) Prohibition of the use of official signs and hallmarks indicating control and warranty shall apply solely in cases where the marks in which they are incorporated are intended to be used on goods of the same or a similar kind.

(3) (a) For the application of these provisions, the countries of the Union agree to communicate reciprocally, through the intermediary of the International Bureau, their official names and the list of State emblems, and official signs and hallmarks indicating control and warranty, which they desire, or may hereafter desire, to place wholly

[Article 6ter(3) (a), continued]

or within certain limits under the protection of this Article, and all subsequent modifications of such list. Each country of the Union shall in due course make available to the public the lists so communicated.

Nevertheless such communication is not obligatory in respect of flags of States.

(b) The provisions of subparagraph (b) of paragraph (1) of this Article shall apply only to such armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations as the latter have communicated to the countries of the Union through the intermediary of the International Bureau.

(4) Any country of the Union may, within a period of twelve months from the receipt of the notification, transmit its objections, if any, through the intermediary of the International Bureau, to the country or international intergovernmental organization concerned.

(5) In the case of State flags, the measures prescribed by paragraph (1), above, shall apply solely to marks registered after November 6, 1925.

[Article 6ter, continued]

(6) In the case of official names of States, State emblems other than flags, and of official signs and hallmarks of the countries of the Union, and in the case of armorial bearings, flags, other emblems, abbreviations, and names, of international inter-governmental organizations, these provisions shall apply only to marks registered more than two months after receipt of the communication provided for in paragraph (3), above.

(7) In cases of bad faith, the countries shall have the right to cancel even those marks incorporating official names of States, State emblems, signs, and hallmarks, which were registered before November 6, 1925.

(8) Nationals of any country who are authorized to make use of the official name, State emblems, signs, and hallmarks, of their country may use them even if they are similar to those of another country.

(9) The countries of the Union undertake to prohibit the unauthorized use in trade of the official names and State armorial bearings of the other countries of the Union, when the use is of such a nature as to be misleading as to the origin of the goods.

[Article 6ter, continued]

(10) The above provisions shall not prevent the countries from exercising the right given in paragraph (3) of Article 6quinquies, Section B, to refuse or to invalidate the registration of marks incorporating, without authorization, the official name of a country of the Union, armorial bearings, flags, other State emblems, or official signs and hallmarks adopted by a country of the Union, as well as the distinctive signs of international intergovernmental organizations referred to in paragraph (1), above.

[End of Annex I;
Annex II follows]

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
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Third Session, Second Part
Geneva, November 23 to 27, 1982

REPORT

of the Chairman of the Working Group of
Main Committee I established to consider Article 10quater,
Dr. Claës Uggla (Sweden), to Main Committee I

Mr. Chairman,

The Working Group on Article 10^{quater} (hereinafter referred to as "the Working Group"), which was set up by Main Committee I on October 22, 1982, whose composition was decided upon on October 25, 1982, and which I had the honor to chair, held four meetings, namely on October 25, 26, 27 and 28, 1982. The Delegations of the following States are members of the Working Group: Argentina, Austria, Brazil, Bulgaria, Canada, Czechoslovakia, Egypt, France, Germany (Federal Republic of), the German Democratic Republic, Hungary, Poland, Portugal, the Soviet Union, Switzerland, the Syrian Arab Republic, Tanzania, the Ukrainian SSR, the United States of America, Uruguay and Yugoslavia. All delegations were admitted to follow the discussions of the Working Group.

The Working Group discussed paragraphs (1), (2), (5) and (6) of Article 10^{quater}. It recommended to the Main Committee that paragraphs (1), (2) and (5) should be worded as follows:

(5) should be worded as follows:

Paragraph (1)

(a) Each country of the Union undertakes, either ex officio if its legislation so permits or at the request of an interested party as defined in Article 10(2) or a federation, association or any other organization having legal capacity to represent the interests of the producers, manufacturers or merchants concerned, in so far as the law of the country in which protection is claimed allows such request by federations, associations or any other organizations of that country,

(i) to refuse or to invalidate registration of a trademark which contains or consists of a geographical or other indication denominating or suggesting a country of the Union, a region or a locality in that country with respect to goods not originating in that country if the use of the indication for such goods is of a nature as to mislead the public as to the true country of origin, and

(ii) to prohibit the use of such an indication if that use for such goods misleads the public as to the true country of origin.

(b) The provisions of subparagraph (a) shall apply in particular to names commonly used to indicate the States of the Union, as well as to translations and to modified, adjectival and abbreviated forms of these names, it being understood that these provisions are without prejudice to the provisions of Article 6^{ter}.

Paragraph (2)

The preceding paragraph shall also apply to a geographical indication which, although literally true as to the country, region or locality in which the goods originate, falsely represents to the public that the goods originate in another country.

Paragraph (5)

Under the preceding paragraphs, all factual circumstances must be considered, particularly the meaning of the trademark and of the geographical or other indication in the country in which the challenge is made, taking into account the extent to which the place denominated or suggested is known, the reputation of the indication, the length of time the trademark has been in use, and any distinctive character the trademark may have acquired through use.

As regards paragraph (6), the Working Group examined in detail various possibilities and agreed, subject to possible improvements in the drafting, with the following text, it being understood that the exact place of the paragraph in question should be determined once Article 10^{quater} has been considered as a whole.

"The provisions of the preceding paragraphs shall not prevent countries of the Union from concluding, [pursuant to]* [under]* Article 19, bilateral or multilateral agreements concerning the rights under those paragraphs, with a view to increasing the protection for specific geographical or other indications." (Original: English)

In addition, it was noted that, since Article 10^{quater} constituted a whole and since several paragraphs had not yet been considered, final action on the above mentioned paragraphs would have to wait until the totality of the said article has been considered.

Let me conclude by saying that the discussions of the Working Group were guided by a most constructive spirit on all sides. I thank all the Delegations who participated in the Working Group.

[End of Annex II;
Annex III follows]

*One of these alternatives will have to be chosen.

Draft Text
of the Chairman of Main Committee I
(Geneva, October 28, 1982)

I. ARTICLE 5A

...

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

(a) [Same as in document PR/DC/37, Annex II, as amended in the meetings of Main Committee I of October 23, 1981 (see document PR/SM/5, pages 88 to 94)]*

(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.

...

II. ARTICLE 5QUATER

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

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

[End of Annex III and of document]

* "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 examination 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."

** "When a product is imported into a country of the Union where there exists a patent protecting a process of manufacture of the said product, the patentee shall have all the rights, with regard to the imported product, that are accorded to him by the legislation of the country of importation, on the basis of the process patent, with respect to products manufactured in that country."

of the Chairman of Main Committee I
(Geneva, October 28, 1983)

ARTICLE 2A

1. Notwithstanding anything contained in paragraphs (1) and (2),
developing countries have the right to apply the following provisions:

(a) [Same as in document TR/DC/77, Annex II, as amended in the
meeting of Main Committee I on October 22, 1977 (see document TR/DC/77, page
25 to 26)]

Any developed 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
judgment of the national authorities competent for forfeiture or revocation
justify the non-working or insufficient working of the patented invention.

ARTICLE 2B

(1) [Same as present text of Article 2B(a)]
(2) Any developing country has the right to apply the provisions of
paragraph (1).

[End of Annex III and of document]

* Any developed 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 10 months from the grant of the patent in that country, unless
the owner of the patent proves circumstances which in the judgment 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 of patent applications and the
procedure for such examination 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 application.

** When a product is imported into a country in the form of a package
bearing a patent protecting a process of manufacture of the said product, the
package shall have all the rights with regard to the imported product, and
the rights shall be by the legislation of the country of importation, on the
date of the process patent, with respect to products manufactured in that
country.