P/A/XIX/ 4
ORIGINAL : English
DATE : September 29, 1992

WIPO

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL UNION FOR THE PROTECTION OF INDUSTRIAL PROPERTY (PARIS UNION)

ASSEMBLY

Nineteenth Session (9th Extraordinary)
Geneva, September 21 to 29, 1992

REPORT

adopted by the Assembly

INTRODUCTION

1. The Assembly was concerned with the following items of the Consolidated Agenda (documents AB/XXIII/1 Rev.2 and AB/XXIII/6, paragraphs 16 and 17): 1, 2, 5, 6, 9bis, 13 and 14.

2. The report on the said items, with the exception of items 5 and 6, is contained in the General Report (document AB/XXIII/6).

3. The report on items 5 and 6 is contained in this document.

ITEM 5 OF THE CONSOLIDATED AGENDA:

CONTINUATION OF THE DIPLOMATIC CONFERENCE FOR THE CONCLUSION OF A TREATY SUPPLEMENTING THE PARIS CONVENTION AS FAR AS PATENTS ARE CONCERNED

4. Discussions were based on document P/A/XIX/3.

5. The Assembly unanimously decided that the second part of the Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as far as Patents are Concerned be held in Geneva from July 12 to 30, 1993.

6. The Delegation of Germany stated that, while it agreed with the decision, future events might make those dates unsuitable, and expressed the hope that the Director General would consider convening an extraordinary session of the Paris Union Assembly if necessary to reconsider those dates.

7. In respect of paragraph 8 of document P/A/XIX/3, the Delegation of the United Kingdom, speaking on behalf of Group B, said that the proposal to omit Articles 10, 19, 22, 24, 25 and 26 from the Basic Proposal before the Diplomatic Conference was generally supported by the countries of Group B. The proposal was also supported by the Delegations of Hungary, Chile, Romania, China, Egypt, Czechoslovakia and Poland.

8. The Delegation of the Russian Federation said that, although it would have preferred that at least Articles 19 and 22 were maintained in the Basic Proposal, it was ready to accept the proposal contained in paragraph 8 of document P/A/XIX/3.

9. The Delegation of Japan, while endorsing the statement made on behalf of the countries of Group B, expressed concern in respect of the omission of paragraph (2) of Article 22 (Term of Patents) from the Basic Proposal. The Delegation suggested that the omission should be confined to paragraph (1) of Article 22, whereas paragraph (2) of Article 22 should be retained in the Basic Proposal.

10. The Delegation of Australia was also in favor of retaining Article 22(2) in the Basic Proposal, since that provision was not covered by the draft TRIPS Agreement of GATT. It noted that paragraph (2) was of a procedural nature.

11. The views expressed by the Delegation of Australia were supported by the Delegations of Israel and Canada.

12. The Delegations of Argentina and the United Kingdom said that they had no objection to maintaining paragraph (2) of Article 22 in the Basic Proposal.

13. The Delegation of the United States of America, while supporting the omission of the six articles mentioned in paragraph 7 of document P/A/XIX/3, expressed the view that Article 20 (Prior User) should also be omitted from the Basic Proposal, since that Article had a logical link with Article 19 (Rights Conferred by the Patent), as shown also by the fact that Article 20

started with the phrase "notwithstanding Article 19." If Article 19 was omitted, Article 20 should also be omitted. Such omission would not prevent Contracting Parties from recognizing a prior user right in their laws if they so wished.

14. The Delegation of Israel supported the proposal of the Delegation of the United States of America.

15. The Delegation of the United Kingdom expressed hesitation about taking any decision on the omission of Article 20 of the Basic Proposal at this stage, noting that the interested circles in the United Kingdom attached great importance to the inclusion in the Treaty of a provision on the prior user's right.

16. The Delegation of Argentina said that, while supporting the proposal contained in paragraph 8 of document P/A/XIX/3, the final decision on the articles to be omitted from the Basic Proposal would have to be taken by the Diplomatic Conference itself. The Delegation of Mexico supported the views expressed by the Delegation of Argentina. The Delegation of Germany, supported by the Delegation of Côte d'Ivoire, while supporting the proposal contained in paragraph 8 of document P/A/XIX/3, agreed that the Diplomatic Conference was sovereign as to its own procedure.

17. The Director General stated that it was clear from the discussion that a number of Articles would have to be removed from the Basic Proposal. He noted that the Diplomatic Conference was, naturally, sovereign as to its procedures and would need to formalize the decision of the Paris Assembly to remove certain Articles, but stated that the identity of those Articles was being discussed in the Assembly in order to avoid losing time at the Diplomatic Conference. On the basis of the discussions, he suggested that the Articles specified in paragraph 8 of document P/A/XIX/3 should be deleted from the Basic Proposal, with the exception of paragraph (2) of Article 22, which should be retained, and that, in addition, Article 20 (Prior User) should also be removed from the Basic Proposal, if not now, then at the beginning of the second part of the Diplomatic Conference.

18. The Assembly agreed that Articles 10, 19, 22(1), 24, 25 and 26 should be removed from the Basic Proposal. Thus, Article 22(2) would be maintained in the Basic Proposal. The Assembly noted the need for delegations to be prepared to consider the possible removal of Article 20 in conjunction with the removal (already decided) of Article 19. If such removal is agreed, the corresponding decision would be made at the beginning of the second part of the Diplomatic Conference.

19. The Assembly agreed that the Diplomatic Conference would, at the beginning of its second part, deal with the possible transfer of some questions from Main Committee I to Main Committee II of the Diplomatic Conference.

ITEM 6 OF THE CONSOLIDATED AGENDA:

CERTAIN MATTERS CONCERNING THE PARIS UNION

Draft Guidelines for the Interpretation of Article 6ter(1)(b) and (3)(b) of the Paris Convention for the Protection of Industrial Property

20. Discussions were based on document P/A/XIX/1.

21. Upon a question raised by the Delegation of the United Kingdom, the Secretariat confirmed that the European Community was to be considered as an international intergovernmental organization in the sense of Article 6ter(1)(b) and (3)(b).

22. Some delegations were in favor of the adoption of both the proposed guidelines (paragraph 9 of document P/A/XIX/1) and decisions (paragraphs 10 and 11 of document P/A/XIX/1), while other delegations said that they were able to accept the proposed decisions but the guidelines should not attempt to provide for a definition of the term "international intergovernmental organization."

23. The Delegation of Japan stated that it could not accept the proposed extensive interpretation of the term "international intergovernmental organization" and thus was opposed to the proposed decisions (paragraphs 10 and 11 of document P/A/XIX/1).

24. Upon a revised proposal by the Secretariat, the Assembly adopted the following Guidelines and Decisions with effect on October 1, 1992, and revoked the decisions taken at its sessions in 1979 and 1983 with respect to the interpretation of Article 6ter(1)(b) of the Paris Convention, to the extent that they were contrary to the Guidelines:

I. Guidelines for the Interpretation of Article 6ter(1)(b) and (3)(b) of the Paris Convention for the Protection of Industrial Property

A. For the purposes of the implementation of Article 6ter(1)(b) and (3)(b) of the Paris Convention for the Protection of Industrial Property, the International Bureau shall also communicate armorial bearings, flags, other emblems, abbreviations and names of

(i) any program established by an international intergovernmental organization, provided that the said program constitutes, or is intended to constitute, within the said organization, a permanent entity having specified aims and its own rights and obligations;

(ii) any institution established by an international intergovernmental organization, provided that the said institution constitutes, or is intended to constitute, within the said organization, a permanent entity having specified aims and its own rights and obligations;

(iii) any convention constituting an international treaty to which one or more States members of the Paris Union are party, provided that the said convention establishes, or is intended to establish, a permanent entity having specified aims and its own rights and obligations.

B. For the purposes of the present Guidelines,

- "permanent entity" means an entity which is established for an indefinite period of time; thus entities established to promote a particular issue or celebrate a special event within a limited period of time (for example programs such as "year of ....") are excluded;

- "specified aims" means that the permanent entity is competent for certain subject matters which are clearly defined in its enabling statutes or charter, or in the resolutions or other decisions establishing such entity;

- "own rights and obligations" means that the permanent entity has rights and obligations which are clearly defined in its enabling statutes or charter or in the resolutions or other decisions by which it has been established. Such rights and obligations may concern the management of the permanent entity, election or appointment of its chief executive, finances, reporting of activities, etc."

II. Decisions

(a) The International Bureau shall satisfy the request of the "United Nations Environment Programme (UNEP)" for the communication of its logo.

(b) The International Bureau shall also satisfy the request of the "Convention on Wetlands of International Importance especially as Waterfowl Habitat (RAMSAR, 1971)," for the communication of its name, abbreviation and emblem.

(c) The International Bureau shall not (as already decided by the Assembly of the Paris Union in 1991) satisfy the request of the Alliance of the Orders of St. John of Jerusalem for the communication of its name and emblem.

25. It was noted that, irrespective of any decision of the International Bureau regarding the admissibility of a request to make a communication pursuant to Article 6ter(3)(b), any member country of the Paris Union receiving such a communication from the International Bureau would not be prevented from transmitting its objections according to Article 6ter(4), and member countries would be free to interpret the concept of international intergovernmental organization according to the applicable national law.

Patent Applications Claiming the Priority of Applications for Plant Breeders' Rights

26. Discussions were based on document P/A/XIX/2.

27. The Director General introduced the said document and said that the proposed resolution contained only a recommendation, and not an obligation. The resolution was proposed to establish symmetry with the UPOV Convention which, as revised in 1991, allowed the claiming of the priority of a patent application in connection with an application for a plant breeder's right. It was to be noted that the proposed resolution did not say and did not imply that member countries of the Paris Union would be obliged to grant patents for the protection of plant varieties.

28. The Delegations of Sweden, Australia and the United States of America and the Representative of FICPI spoke in favor of the proposed resolution, stating that there were good reasons of principle to allow the possibility of claiming, in a patent application, a priority on the basis of an earlier application for a plant breeder's right and that, in the absence of such a possibility, the absolute novelty requirement could entail a loss of rights because of the disclosure by the breeder in his first application. It was pointed out that, since the notion of "patent" was not defined in the Paris Convention, nothing in that Convention prevented a country from interpreting as a "patent application" any application for the grant of an exclusive right in which an invention was disclosed. It was also noted that the Paris Convention did not require that an application contain claims as a condition for invoking its priority under Article 4 of that Convention.

29. The Delegation of Mexico expressed objections to the proposed resolution, in particular, in view of the fact that the system of protection of plant varieties was entirely different from the system of protection of inventions. There was no need for symmetry in respect of the priority right. If the resolution were adopted, its implementation would give rise to technical and legal complications.

30. The Delegation of France considered that the list of industrial property titles which was contained in Article 4A(1) of the Paris Convention, and which could serve as a basis for claiming priority, was exhaustive. The addition of a priority right based on an application for a plant breeder's right would be detrimental to an applicant who relied on the exhaustive character of the list of industrial property titles contained in Article 4 of the Paris Convention.

31. The Delegation of Germany, while admitting that, theoretically, an application for a plant breeder's right could be considered as a suitable basis for a right of priority in connection with a patent application, saw legal problems with the proposed resolution. If it were to be recommended to grant a priority right based on an application whose subject was a plant variety, such recommendation should refer to "an application disclosing the invention." Thus, the Delegation of Germany did not share the interpretation of Article 4 suggested by the Delegation of France.

32. The Delegation of Chile stated that the authorities of its country were currently studying the UPOV Convention and that it appeared that the system of protection of plant varieties was different from patent protection. Therefore, the Delegation could not support the proposed resolution.

33. The Delegation of the United Kingdom said that it could not support the proposed resolution and that, if the resolution were adopted, the authorities of the United Kingdom would not be able to follow it. The Delegation pointed out that an enabling disclosure of an invention was required by its national law to be contained in an application for protection of the invention to be able to constitute a priority document, which was highly unlikely to be the case with respect to applications for plant breeder's rights.

34. The Representative of the EPO, while drawing attention to the fact that the EPO was not bound by the Paris Convention but that nevertheless the European Patent Convention provided for a priority right according to Article 4 of the Paris Convention, stated that it opposed the proposed resolution. In a case concerning an application for registration of an industrial design, the Appeal Board of the EPO had decided that such an application could not serve as a basis for a priority right, even if it contained a technical disclosure.

35. In view of the fact that arguments were raised both in favor of and against the proposed resolution and in view of the lack of a clear majority, the Assembly did not take a decision on the proposed resolution.

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