Withdrawals

Withdrawals under Chapter I (Article 24(1)(i) and Rule 90*bis*)

What? international application, designations, priority claim

When? before the expiration of 20 months from the priority date

How? by a notice of withdrawal signed by all applicants, their agent or the appointed common representative, and filed with the RO or the IB

Effect?
- withdrawal effective upon receipt by the RO or the IB
- withdrawal has no effect in DOs where national processing or examination has already started
- withdrawal of international application or designations:
  - effect ceases in each designated State concerned, with same consequences as withdrawal of a national application in that State
  - if notice of withdrawal received by the IB before completion of technical preparations for international publication, there will be no international publication (withdrawal can be made conditional on receipt in time to prevent publication)
- withdrawal of priority claim: time limits which have not expired are re-computed on the basis of the revised priority date resulting from the withdrawal

Withdrawals under Chapter II (Article 37 and Rule 90*bis*)

What? international application, designations, demand, elections, priority claim

When? before the expiration of 30 months from the priority date

How? by a notice of withdrawal signed by all applicants, their agent or the appointed common representative, and filed with:
- the RO, the IB or the IPEA, if withdrawing international application or priority claim
- the IB, if withdrawing demand or elections

Effect?
- withdrawal effective upon receipt by appropriate Authority (see above)
- withdrawal has no effect in DOs/EOs where national processing or examination has already started
- withdrawal of demand or elections: withdrawal after expiration of Chapter I time limit for entry into national phase is considered to be withdrawal of the international application in relation to the State(s) concerned
- withdrawal of priority claim: time limits which have not expired are re-computed on the basis of the revised priority date resulting from the withdrawal

Indications Relating to Deposited Microorganisms

Pertinent Portions of the PCT

- Rule 13*bis*
- Administrative Instructions Section 209

06 Feb 96

Microorganisms in an International Application

- National laws of certain designated States require deposit of a microorganism.
- Deposit
  - Is made with a recognized depositary institution;
  - Enables the claimed invention when the microorganism is not readily available to the public.

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The PCT

- Sets forth the contents of reference to deposited microorganism (Rule 13*bis* .3).
- Sets forth the time for furnishing any such indication (Rule 13*bis*.4).

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Deposit Under the Budapest Treaty

- Is made with any depositary institution having acquired the status of an international depositary authority (IDA);
- Eliminates the need of deposit in each country in which protection is sought.

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States Party to the Budapest Treaty

- As of 01 September 1995 there are 35 states party to the treaty
  - 32 are PCT contracting States
  - 3 are States not bound by the PCT.
- The EPO has declared that it recognizes the effects of the Budapest Treaty.

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Budapest Treaty States (1 Sep 1995)

- Australia
- Austria
- Belgium
- Bulgaria
- China
- Cuba *
- Czech Republic
- Denmark
- Finland
- France
- Germany
- Greece
- Hungary
- Iceland
- Italy
- Japan
- Latvia
- Liechtenstein
- Netherlands
- Norway
- Philippines *
- Poland
- Republic of Korea
- Republic of Moldova
- Russian Federation
- Singapore
- Slovakia
- Spain
- Sweden
- Switzerland
- Tajikistan
- Trinidad and Tobago
- United Kingdom
- United States of America
- Yugoslavia *

* State not bound by the PCT

Necessary Information For a Deposited Microorganism

- Name and address of the depositary institution;
- Date of deposit;
- Accession number; and
- Any additional indications, if applicable (see Annex L of PCT Applicant's Guide).

06 Feb 96

National Laws Concerning Microorganisms

- Certain States require that the indications
  - be provided upon filing the international application;
  - be in the description.
- Form PCT/RO/134 may be used.

06 Feb 96

Notification of Additional Indications

- International Bureau notified of additional matter required by certain States.
- Additional matter published in the PCT Gazette at least two months before becoming a requirement.

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L Deposits of Microorganisms L

Requirements of designated and elected Offices

Only offices whose applicable national law contains provisions concerning the deposits of microorganisms are listed in this table. Unless otherwise indicated in the table, deposits may be made for the purposes of patent procedure before these Offices with any depositary institution having acquired the status of international depositary authority under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure (these institutions are indicated further in this Annex and are notified from time to time in "Industrial Property and Copyright", a publication of WIPO).

Designated (or Elected) Office	Time (if any) earlier than 16 months from priority date by which applicant must furnish: the indications prescribed in Rule 13bis.3(a)(i) to (iii)	Time (if any) earlier than 16 months from priority date by which applicant must furnish: any additional matter specified in the adjacent right-hand column	Additional indications (if any) which must be given besides those prescribed in Rule 13bis.3(a)(i) to (iii) pursuant to notifications from the offices concerned
Albania			
Albanian Patent Office	None	At the time of filing (as part of the application)	To the extent available to the applicant, relevant information on the characteristics of the microorganism
Deposits may also be made for the purposes of patent procedure before the Albanian Patent Office with any depositary institution specialized for that purpose			
Australia			
Australian Patent Office	None	At the time of filing (as part of the application)	To the extent available to the applicant, relevant information on the characteristics of the microorganism
An applicant may give notice that the furnishing of a sample of a microorganism shall only be effected prior to the grant of a patent, or prior to the lapsing, refusal or withdrawal of the application, to a person who is a skilled addressee without an interest in the invention (Regulation 3.54(3) of the Australian Patents Regulations). A notice to this effect must be filed by the applicant with the Australian Patent Office before the application is made available to the public under Section 90 of the Australian Patents Act. If such a notice has been filed, a request for the furnishing of a sample must nominate the person to whom the sample will be furnished. Applicants should be aware that if release of a sample of micro-organism is to be restricted to a person who is a skilled addressee, then the Australian Patent Office should be notified of this before the application is published in accordance with Section 90 of the Australian Patents Act 1990.			
Austria			
Austrian Patent Office	Before completion of technical preparations for international publication	At the time of filing (as part of the application)	To the extent available to the applicant, all significant information on the characteristics of the microorganism

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Deposits of Microorganisms - Requirements of designated and elected Offices (continued)

Designated (or Elected) Office	Time (if any) earlier than 16 months from priority date by which applicant must furnish: the indications prescribed in Rule 13bis.3(a)(i) to (iii)	Time (if any) earlier than 16 months from priority date by which applicant must furnish: any additional matter specified in the adjacent right-hand column	Additional indications (if any) which must be given besides those prescribed in Rule 13bis.3(a)(i) to (iii) pursuant to notifications from the offices concerned
Bulgaria			
Bulgarian Patent Office	Within 3 months after the filing date	At the time of filing (as part of the application)	None
China			
Chinese Patent Office	None	None	The scientific name (with its latin name) of the microorganism, relevant information on the characteristics of the microorganism, a receipt of deposit and the viability proof from the depositary institution of a sample of the microorganism

Deposits may be made for the purposes of patent procedure before the Chinese Patent Office with CGMCC or CCTCC (see further in this Annex), or with any depositary institution having acquired the status of international depositary authority under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of the Patent Procedure.

Czech Republic			
Industrial Property Office	None	None	None
Denmark			
Danish Patent Office	Where applicant requests publication earlier than 16 months from the priority date, not later than that request	At the time of filing (as part of the application)	To the extent available to the applicant, all significant information on the characteristics of the microorganism

The applicant may request that, until the application has been laid open to public inspection (by the Danish Patent Office), or has been finally decided upon by the Danish Patent Office without having been laid open to public inspection, the furnishing of a sample shall only be effected to an expert in the art. The request to this effect shall be filed by the applicant with the Danish Patent Office not later than at the time when the application is made available to the public under Sections 22 and 33(3) of the Danish Patents Act. If such a request has been filed by the applicant, any request made by a third party for the furnishing of a sample shall indicate the expert to be used. That expert may be any person entered on a list of recognized experts drawn up by the Danish Patent Office or any person approved by the applicant in the individual case.

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Deposits of Microorganisms - Requirements of designated and elected Offices (continued)

Designated (or Elected) Office	Time (if any) earlier than 16 months from priority date by which applicant must furnish: the indications prescribed in Rule 13bis.3(a)(i) to (iii)	Time (if any) earlier than 16 months from priority date by which applicant must furnish: any additional matter specified in the adjacent right-hand column	Additional indications (if any) which must be given besides those prescribed in Rule 13bis.3(a)(i) to (iii) pursuant to notifications from the offices concerned
Finland			
National Board of Patents and Registration	Where applicant requests publication earlier than 16 months from the priority date, not later than that request	At the time of filing (as part of the application)	To the extent available to the applicant, all significant information on the characteristics of the microorganism

The applicant may request that, until the application has been laid open to public inspection (by the National Board of Patents and Registration), or has been finally decided upon by the National Board of Patents and Registration without having been laid open to public inspection, the furnishing of a sample shall only be effected to an expert in the art. The request to this effect shall be filed by the applicant with the International Bureau before the expiration of 16 months from the priority date (preferably on the Form PCT/RO/134 reproduced in Annex Z of Volume I of the PCT Applicant's Guide). If such a request has been filed by the applicant, any request made by a third party for the furnishing of a sample shall indicate the expert to be used. That expert may be any person entered on a list of recognized experts drawn up by the National Board of Patents and Registration or any person approved by the applicant in the individual case.

Georgia			
Georgian Patent Office	None	None	None

Deposits may also be made for the purposes of patent procedure before the Georgian Patent Office with "any scientifically recognized institution at home and abroad" and that includes all institutions published further in this Annex.

Germany			
German Patent Office	None	None	None

Deposits may also be made for the purposes of patent procedure before the German Patent Office with "any scientifically recognized institution at home and abroad" and that includes all institutions published further in this Annex.

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Deposits of Microorganisms - Requirements of designated and elected Offices (continued)

Designated (or Elected) Office	Time (if any) earlier than 16 months from priority date by which applicant must furnish: the indications prescribed in Rule 13bis.3(a)(i) to (iii)	Time (if any) earlier than 16 months from priority date by which applicant must furnish: any additional matter specified in the adjacent right-hand column	Additional indications (if any) which must be given besides those prescribed in Rule 13bis.3(a)(i) to (iii) pursuant to notifications from the offices concerned
Hungary			
Hungarian Patent Office	At the time of filing for the notification of the fact that a deposit was made on or before the filing date	None	To the extent available to the applicant, the characteristics of the microorganism and a taxonomic description
Deposits may also be made for the purposes of patent procedure before the Hungarian Patent Office with "any internationally well-known depositary institution in case of reciprocity".			
Iceland			
Icelandic Patent Office	Where applicant requests publication earlier than 16 months from the priority date, not later than that request	At the time of filing (as part of the application)	To the extent available to the applicant, all significant information on the characteristics of the microorganism
The applicant may request that, until the application has been laid open to public inspection (by the Icelandic Patent Office), or has been finally decided upon by the Icelandic Patent Office without having been laid open to public inspection, the furnishing of a sample shall only be effected to an expert in the art. The request to this effect shall be filed by the applicant with the Icelandic Patent Office not later than at the time when the application is made available to the public under Sections 22 of the Icelandic Patent Act. If such a request has been filed by the applicant, any request made by a third party for the furnishing of a sample shall indicate the expert to be used. That expert may be any person entered on a list of recognized experts drawn up by the Icelandic Patent Office or any person approved by the applicant in the individual case.			
Japan			
Japanese Patent Office	At the time of filing (must be in the description) (except as to the date of deposit of the microorganism)	At the time of filing (must be in the description)	Relevant information on (i) the characteristics which identify, (ii) the process for producing, (iii) the usefulness of the microorganism

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Deposits of Microorganisms - Requirements of designated and elected Offices (continued)

Designated (or Elected) Office	Time (if any) earlier than 16 months from priority date by which applicant must furnish: the indications prescribed in Rule 13bis.3(a)(i) to (iii)	Time (if any) earlier than 16 months from priority date by which applicant must furnish: any additional matter specified in the adjacent right-hand column	Additional indications (if any) which must be given besides those prescribed in Rule 13bis.3(a)(i) to (iii) pursuant to notifications from the offices concerned
Kazakstan			
Kazak Patent Office	None	None	To the extent available to the applicant, relevant information on the characteristics of the microorganism
Deposits may also be made for the purposes of patent procedure before the Kazak Patent Office with any depositary institution.			
Kenya			
Kenya Industrial Property Office	None	None	To the extent available to the applicant, relevant information on the characteristics of the microorganism
Latvia			
Latvian Patent Office	None	At the time of filing as part of the application	To the extent available to the applicant, relevant information on the characteristics of the microorganism
Lithuania			
Lithuanian Patent Office	None	None	To the extent available to the applicant, relevant information on the characteristics of the microorganism
Deposits may also be made for the purposes of patent procedure before the Lithuanian Patent Office with any depositary institution.			

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Deposits of Microorganisms - Requirements of designated and elected Offices (continued)

Designated (or Elected) Office	Time (if any) earlier than 16 months from priority date by which applicant must furnish: the indications prescribed in Rule 13bis.3(a)(i) to (iii)	Time (if any) earlier than 16 months from priority date by which applicant must furnish: any additional matter specified in the adjacent right-hand column	Additional indications (if any) which must be given besides those prescribed in Rule 13bis.3(a)(i) to (iii) pursuant to notifications from the offices concerned
Mexico			
Mexican Patent Office	None	At the time of filing (must be in the description)	To the extent available to the applicant, relevant information on the characteristics of the microorganism
Netherlands[1]			
Netherlands Industrial Property Office	At the time of filing (must be in the description) (except as to the accession number)	At the time of filing (must be in the description)	To the extent available to the applicant, relevant information on the characteristics of the microorganism

Deposits may also be made for the purposes of patent procedure before the Netherlands Industrial Property Office with IFO, NLM and PC (see further in this Annex). If the applicant wishes that, until the date of a grant of a Netherlands patent or until the date on which the application is refused or withdrawn or lapsed, the microorganism shall be made available as provided in Rule 31F(1) of the Patent Rules only by the issue of a sample to an expert nominated by the requester, the applicant must inform the Netherlands Industrial Property Office accordingly on a prescribed form. Said information must be furnished to the Netherlands Industrial Property Office before the date on which the application is made available to the public under Section 22C or Section 25 of the Patents Act of the Kingdom of the Netherlands, whichever of the two dates occurs earlier.

Norway			
Norwegian Patent Office	Where applicant requests publication earlier than 16 months from the priority date, not later than that request	At the time of filing (as part of the application)	To the extent available to the applicant, all significant information on the characteristics of the microorganism

The applicant may request that, until the application has been laid open to public inspection (by the Norwegian Patent Office), or has been finally decided upon by the Norwegian Patent Office without having been laid open to public inspection, the furnishing of a sample shall only be effected to an expert in the art. The request to this effect shall be filed by the applicant with the Norwegian Patent Office not later than at the time when the application is made available to the public under Sections 22 and 33(3) of the Norwegian Patents Act. If such a request has been filed by the applicant, any request made by a third party for the furnishing of a sample shall indicate the expert to be used. That expert may be any person entered on a list of recognized experts drawn up by the Norwegian Patent Office or any person approved by the applicant in the individual case.

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[1] The information presented in this box is relevant only as regards international applications filed before April 1, 1995.

Deposits of Microorganisms - Requirements of designated and elected Offices (continued)

Designated (or Elected) Office	Time (if any) earlier than 16 months from priority date by which applicant must furnish: the indications prescribed in Rule 13bis.3(a)(i) to (iii)	Time (if any) earlier than 16 months from priority date by which applicant must furnish: any additional matter specified in the adjacent right-hand column	Additional indications (if any) which must be given besides those prescribed in Rule 13bis.3(a)(i) to (iii) pursuant to notifications from the offices concerned
Poland			
Polish Patent Office	None	None	Name and address of the depositor

Deposits may also be made for the purposes of patent procedure before the Polish Patent Office with the national depositary authority - Institut of Agricultural and Food Biotechnology, according to the agreement published in the Official Journal of the Office (WUP No. 10/1993).

Portugal			
National Institute of Industrial Property	None	At the time of filing (must be in the description)	To the extent available to the applicant, relevant information on the characteristics of the microorganism
Republic of Korea			
Korean Industrial Property Office	At the time of filing (must be in the description)	None	None

For the purposes of patent procedure before the Korean Industrial Property Office a deposit is required not later than at the date of filing the international application. A receipt attesting the deposit and its acceptance issued by the depositary institution with which the microorganism was deposited must be submitted to the Korean Industrial Property Office within the time limit applicable under PCT Article 22 or 39(1).

Republic of Moldova			
Moldova Patent Office	None	None	To the extent available to the applicant, relevant information on the characteristics of the microorganism

Deposits may also be made for the purposes of patent procedure before the Moldova Patent Office with any depositary institution.

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Deposits of Microorganisms - Requirements of designated and elected Offices (continued)

Designated (or Elected) Office	Time (if any) earlier than 16 months from priority date by which applicant must furnish: the indications prescribed in Rule 13bis.3(a)(i) to (iii)	Time (if any) earlier than 16 months from priority date by which applicant must furnish: any additional matter specified in the adjacent right-hand column	Additional indications (if any) which must be given besides those prescribed in Rule 13bis.3(a)(i) to (iii) pursuant to notifications from the offices concerned
Russian Federation			
Russian Patent Office	None	None	To the extent available to the applicant, relevant information on the characteristics of the microorganism

Deposits may also be made for the purposes of patent procedure before the Russian Patent Office with any depositary institution.

Singapore			
Registry of Patents	None	None	A copy of the receipt of deposit

The applicant may request that the furnishing of a sample of the microorganism shall only be made available to an expert. The request to this effect must be filed by the applicant with the International Bureau before the completion of the technical preparations for international publication of the application.

Slovakia			
Industrial Property Office	None	None	None
Slovenia			
Slovenian Intellectual Property Office	Where applicant requests publication earlier than 16 months from the priority date, not later than that request	At the time of filing (as part of the application)	To the extent available to the applicant, relevant information on the characteristics of the microorganism

Deposits may also be made for the purposes of patent procedure before the Slovenian Intellectual Property Office with any depositary institution recognized by the Office (a list is published in the official journal of the Office). The furnishing of samples to a third party may be subjected to the condition that that party: (a) has a right to demand that a sample of the microorganism be made available; (b) has undertaken the obligation to make the applicant not to allow access to the sample of the deposited microorganism to any third party before the prescribed period of the validity of the patent expires.

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Deposits of Microorganisms - Requirements of designated and elected Offices (continued)

Designated (or Elected) Office	Time (if any) earlier than 16 months from priority date by which applicant must furnish: the indications prescribed in Rule 13bis.3(a)(i) to (iii)	Time (if any) earlier than 16 months from priority date by which applicant must furnish: any additional matter specified in the adjacent right-hand column	Additional indications (if any) which must be given besides those prescribed in Rule 13bis.3(a)(i) to (iii) pursuant to notifications from the offices concerned
Spain			
Spanish Patent and Trademark Office	None	At the time of filing (must be in the description)	To the extent available to the applicant, relevant information on the characteristics of the microorganism
Sweden			
Swedish Patent Office	Where applicant requests publication earlier than 16 months from the priority date, not later than that request	At the time of filing (as part of the application)	To the extent available to the applicant, relevant information on the characteristics of the microorganism

The applicant may request that, until the application has been laid open to public inspection (by the Swedish Patent Office), or has been finally decided upon by the Swedish Patent Office without having been laid open to public inspection, the furnishing of a sample shall only be effected to an expert in the art. The request to this effect shall be filed by the applicant with the International Bureau before the expiration of 16 months from the priority date (preferably on the Form PCT/RO/134 reproduced in Annex Z of Volume I of the PCT Applicant's Guide).
If such a request has been filed by the applicant, any request made by a third party for the furnishing of a sample shall indicate the expert to be used. That expert may be any person entered on a list of recognized experts drawn up by the Swedish Patent Office or any person approved by the applicant in the individual case.

Switzerland			
Swiss Federal Intellectual Property Institute	None	None	None

Deposits may also be made for the purposes of patent procedure before the Swiss Federal Intellectual Property Office with FIB, IAM, IFO and SBL (see further in this Annex). The furnishing of samples to a third party may be subjected to the condition that that party indicates to the depositary institution its name and address for the purpose of information of the depositor and undertakes: (a) not to make available the deposited culture or a culture derived from it to a third party; (b) not to use the culture outside the purview of the law; (c) to produce, in case of a dispute, evidence that the obligations under items (a) and (b) have not been violated.

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Deposits of Microorganisms - Requirements of designated and elected Offices (continued)

Designated (or Elected) Office	Time (if any) earlier than 16 months from priority date by which applicant must furnish: the indications prescribed in Rule 13bis.3(a)(i) to (iii)	Time (if any) earlier than 16 months from priority date by which applicant must furnish: any additional matter specified in the adjacent right-hand column	Additional indications (if any) which must be given besides those prescribed in Rule 13bis.3(a)(i) to (iii) pursuant to notifications from the offices concerned
Tajikistan			
Tajik Patent Office	None	None	To the extent available to the applicant, relevant information on the characteristics of the microorganism

Deposits may also made for the purposes of patent procedure before the Tajik Patent Office with any depositary institution.

The former Yugoslav Republic of Macedonia			
Industrial Property Protection Office	None	At the time of filing (must be in the description)	To the extent available to the applicant, relevant information on the characteristics of the microorganism

Deposits may also be made for the purposes of patent procedure before the Industrial Property Protection Office with any international depositary institution recognized by the Office (a list is published in the official journal of the Office). The furnishing of samples to a third party may be subjected to the condition that that party: (a) has a right to demand that a sample of the microorganism be made available; (b) has undertaken the obligation to make the applicant not to allow access to the sample of the deposited microorganism to any third party before the prescribed period of the validity of the patent expires.

Turkey			
Turkish Patent Institute	None	At the time of filing (must be in the description)	To the extent available to the applicant, relevant information on the characteristics of the microorganism

Deposits may also be made for the purposes of patent procedure before the Turkish Patent Institute with any depositary institution specialized for that purpose

Turkmenistan			
Turkmen Patent Office	None	None	To the extent available to the applicant, relevant information on the characteristics of the microorganism

Deposits may also be made for the purposes of patent procedure before the Turkmen Patent Office with any depositary institution.

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Deposits of Microorganisms - Requirements of designated and elected Offices (continued)

Designated (or Elected) Office	Time (if any) earlier than 16 months from priority date by which applicant must furnish: the indications prescribed in Rule 13bis.3(a)(i) to (iii)	Time (if any) earlier than 16 months from priority date by which applicant must furnish: any additional matter specified in the adjacent right-hand column	Additional indications (if any) which must be given besides those prescribed in Rule 13bis.3(a)(i) to (iii) pursuant to notifications from the offices concerned
Ukraine			
Ukraine Patent Office	None	None	To the extent available to the applicant, relevant information on the characteristics of the microorganism

Deposits may also be made for the purposes of patent procedure before the Ukraine Patent Office with any depositary institution.

United Kingdom			
Patent Office	Where applicant requests publication earlier than 16 months form the priority date, not later than that request	None	Where applicable, the identification of any international agreement under which the deposit was made

Deposits may also be made for the purposes of patent procedure before the UK Patent Office with "any depositary institution anywhere in the world". It is the responsibility of the applicant to select the depositary institution with which he wishes to make his deposit and to ensure that samples of the culture deposited will be made available in accordance with Rule 17 and Schedule 2, UK Patents Rules 1995. The applicant may give notice in writing to the International Bureau before technical preparations for publication of the international application are completed, that a sample should be made available only to an expert.

United States of America			
United States Patent and Trademark Office (USPTO)	The name and address of the depositary institution at the time of filing	At the time of filing	(a) A statement that the deposit was made on or before the priority date of the international application (where a date of deposit prior to that date has not been indicated, pursuant to Rule 13bis.3(a)(ii)). (b) To the extent feasible, a taxonomic description of the microorganism.

Deposits may also be made for the purposes of patent procedure before the USPTO with "any foreign or domestic depositary institution obligated by law, treaty or contract to accept, store and release specimens under the conditions specified in the United States jurisprudence". In the USPTO, if the same indications concerning the name and address of the depositary institution are not also included in an earlier application the priority of which is claimed, the priority of the earlier application will not be accorded in the national processing of the application.

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Deposits of Microorganisms - Requirements of designated and elected Offices (continued)

Designated (or Elected) Office	Time (if any) earlier than 16 months from priority date by which applicant must furnish: the indications prescribed in Rule 13bis.3(a)(i) to (iii)	Time (if any) earlier than 16 months from priority date by which applicant must furnish: any additional matter specified in the adjacent right-hand column	Additional indications (if any) which must be given besides those prescribed in Rule 13bis.3(a)(i) to (iii) pursuant to notifications from the offices concerned
Eurasian Patent Organization			
Eurasian Patent Office (EAPO)	None	None	To the extent available to the applicant, relevant information on the characteristics of the microorganism

Deposits may also be made for the purposes of patent procedure before the Eurasian Patent Office with any depositary institution.

European Patent Organisation			
European Patent Office (EPO)	None	At the time of filing	To the extent available to the applicant, relevant information on the characteristics of the microorganism

Deposits may also be made for the purposes of patent procedure before the EPO with FIB and IFO (see further in this Annex). Deposits with CNCM can be made under the Budapest Treaty or, as far as the deposits of cell cultures, mycoplasma and rickettsiae are concerned, under a bilateral agreement with the EPO. If the applicant wishes that, until the publication of the mention of the grant of a European patent or until the date on which the application is refused or withdrawn or is deemed to be withdrawn, the microorganism shall be made available as provided in Rule 28(3) of the Implementing Regulations under the European Patent Convention only by the issue of a sample to an expert nominated by the requester (Rule 28(4) of the said Implementing Regulations), the applicant must inform, by a written statement, the International Bureau accordingly before completion of technical preparations for publication of the international application. Such statement must be separate from the description and the claims of the international application and must preferably be made on the Form PCT/RO/134, referred to in Section 209 of the Administrative Instructions under the PCT and reproduced in Annex Z of Volume I of the PCT Applicant's Guide.

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L Deposits of Microorganisms L

List of depositary institutions

Agricultural Research Service Culture Collection (NRRL)[1]
1815 North University Street
Peoria, Illinois 61604
United States of America

American Type Culture Collection (ATCC)[1]
12301 Parklawn Drive
Rockville, Maryland 20852
United States of America

Australian Government Analytical Laboratories (AGAL)[1]
The New South Wales Regional Laboratory
1 Suakin Street
Pymble, NSW 2073
Australia

Belgian Coordinated Collections of Microorganisms (BCCM)[1]

Headquarters:

Prime Minister's Services
Science Policy Office
Rue de la Science 8
B-1040 Brussels
Belgium

Collections to which deposits must be addressed:

Institut d'Hygiène et d'Epidémiologie-Mycologie (IHEM)[1]
Rue J. Wytsman 14
B-1050 Brussels
Belgium

Laboratorium voor Moleculaire Biologie-Plasmidencollectie (LMBP)[1]
Universiteit Gent
K. L. Ledeganckstraat 35
B-9000 Gent
Belgium

Laboratorium voor Microbiologie-Bacteriënverzameling (LMG)[1]
Universiteit Gent
K. L. Ledeganckstraat 35
B-9000 Gent
Belgium

Mycothèque de l'Université Catholique de Louvain (MUCL)[1]
Place Croix du Sud 3
B-1348 Louvain-la-Neuve
Belgium

Centraal Bureau voor Schimmelcultures (CBS)[1]
Oosterstraat 1
Postbus 273
NL-3740 AG Baarn
Netherlands

Center for General Microbiological Culture Collection (CGMCC)[1]
China Committee for Culture Collection of Microorganisms
Beijing 100080
China

China Center for Type Culture Collection (CCTCC)[1]
Luo Jia Shan
Wuhan 430072
China

Colección Española de Cultivos Tipo (CECT)[1]
Microbiology Department
Biological Science Faculty
University Valencia
46100 Burjasot (Valcenia)
Spain

Collection nationale de cultures de micro-organismes (CNCM)[1]
Institut Pasteur
28 rue de Docteur Roux
75724 Paris Cedex 15
France

[continued on next page]

Note: This table does not indicate in relation to depositary institutions the kind of microorganisms which may be deposited with and the fees charged by them. This information may be obtained directly from the institutions. As regards depositary institutions which have acquired the status of international depositary authority under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, such informtion is published at the time of the acquisition of the status of international depositary authority in the WIPO monthy review "Industrial Property". Furthermore, the January issue of the said review indicates, for each international depositary authority, the kinds of microorganisms that it accepts and the fees charged by it.

[1] Depositary institution having acquired the status of international depositary authority under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure.

List of depositary institutions (continued)

Culture Collection of Algae and Protozoa (CCAP)[1]
Institute of Freshwater Ecology
Windermere Laboratory
The Ferry House
Far Sawrey
Ambleside, Cumbria LA22 0LP
United Kingdom
and
Dunstaffnage Marine Research Laboratory
P.O. Box 3
Oban, Argyll PA34 4AD
United Kingdom

Czech Collection of Microorganisms (CCM)[1]
ul. Tvrdého c. 14
Masaryc University
60200 Brno
Czech Republic

Culture Collection of Yeasts (CCY)[1]
Institute of Chemistry
Slovak Academy of Sciences
Dúbrasvská cesta 9
84238 Bratislava
Slovakia

Deutsche Sammlung von Mikroorganismen und Zellkulturen (DSM)[1]
Mascheroder Weg 1b
D-38124 Braunschweig
Germany

European Collection of Cell Structures (ECACC)[1]
Centre for Applied Microbiology
and Research
Porton Down, Salisbury, Wiltshire SP4 0JG
United Kingdom

National Institute of Bioscience and Human-Technology (NIBH)[1]
Ministry of International Trade and Industry
1-3 Higashi 1-chome, Tsukuba-shi
Ibaraki-ken 305
Japan

Forschunginstitut Borstel (FIB)
Institut für Experimentelle Biologie
und Medizin
D-23845 Borstel
Germany

Institute of Applied Microbiology (IAM)
Culture Collection
Center for Cellular and Molecular Research
Institute of Molecular and Cellular Biosciences
The University of Tokyo
1-1 Yayoi, 1-chome, Bunkyo-ku
Tokyo 113
Japan

Institute for Fermentation (IFO)
17-85 Juso-honmachi 2-chome
Yodogawa-ku
Osaka 532
Japan

International Mycological Institute (IMI)[1]
Bakeham Lane
Englefield Green
Egham, Surrey TW20 9TY
United Kindgom

Korean Cell Line Research Foundation (KCLRF)[1]
Cancer Research Institute
Seoul National University College of Medicine
28 Yungon-dong, Chongno-gu
Seoul 110-799
Republic of Korea

Korea Research Institute of Bio-science
and Biotechnology (KRIBB)[1]
52, Oun-Dong, Yusong-ku,
Taejon 305-333
Republic of Korea

Korean Culture Center of Microorganisms (KCCM)[1]
College of Engineering
Yonsei University
Sodaemun-gu
Seoul 120-749
Republic of Korea

Laboratorium voor Microbiologie (NLM)
Julianalaan 67a
Delft
Netherlands

[continued on next page]

[1] Depositary institution having acquired the status of international depositary authority under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure.

List of depositary institutions (continued)

National Bank for Industrial Microorganisms and Cell Cultures (NBIMCC)[1]
125 Tsarigradsko shosse blvd., 2
1113 Sofia
Bulgaria

National Collection of Agricultural and Industrial Microorganisms (NCAIM)[1]
Department of Microbiology and Biotechnology
University of Horticulture and Food Industry
Somlói ut 14-16
H-1118 Budapest
Hungary

National Collection of Food Bacteria (NCFB)[1]
AFRC Institute of Food Research
Reading Laboratory
Earley Gate, Whiteknights Road
Reading, Berkshire RG6 2EF
United Kingdom

National Collections of Industrial and Marine Bacteria Ltd. (NCIMB)[1]
23 St. Machar Drive
Aberdeen AB2 1RY
Scotland
United Kingdom

National Collection of Type Cultures (NCTC)[1]
Central Public Health Laboratory
61 Colindale Avenue
London NW9 5HT
United Kingdom

National Collection of Yeast Cultures (NCYC)[1]
Institute of Food Research
Norwich Laboratory
Norwich Research Park
Colney
Norwich NR4 7UA
United Kingdom

Phabagen Collection (PC)
Rijksuniversiteit Utrecht
Vakgroep Moleculaire Celbiologie
Padualaan 8
3584 CH Utrecht
Netherlands

Statens Bakteriologiska Laboratorium (SBL)
10521 Stockholm
Sweden

State Scientific Centre for Antibiotics (VNIIA)[1]
Nagatinskaya ul. 3a
Moscow 113105
Russian Federation

Russian Collection of Microorganisms (VKM)[1]
Prospekt Naouki, 5
142292 Puschino, Moskovskaya obl.
Russian Federation

Russian National Collection of Industrial Microorganisms (VKPM)[1]
GNII Genetika
1 Dorozhny proezd, 1
113545 Moscow
Russian Federation

[1] Depositary institution having acquired the status of international depositary authority under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure.

Applicant's or agent's file reference number	International application No.

INDICATIONS RELATING TO A DEPOSITED MICROORGANISM

(PCT Rule 13*bis*)

A. The indications made below relate to the microorganism referred to in the description on page _____, line _____

B. IDENTIFICATION OF DEPOSIT Further deposits are identified on an additional sheet ☐

Name of depositary institution

Address of depositary institution (*including postal code and country*)

Date of deposit	Accession Number

C. ADDITIONAL INDICATIONS *(leave blank if not applicable)* This information is continued on an additional sheet ☐

D. DESIGNATED STATES FOR WHICH INDICATIONS ARE MADE *(if the indications are not for all designated States)*

E. SEPARATE FURNISHING OF INDICATIONS *(leave blank if not applicable)*

The indications listed below will be submitted to the International Bureau later (*specify the general nature of the indications, e.g., "Accession Number of Deposit"*)

For receiving Office use only	For International Bureau use only
☐ This sheet was received with the international application	☐ This sheet was received by the International Bureau on:
Authorized officer	Authorized officer

Form PCT/RO/134 (July 1992)

Procedure in Case of Nucleotide and/or Amino Acid Sequence Listing

Pertinent Portions of the PCT

- Rules
  - 5.2
  - 13*ter*
- Administrative Instructions
  - Section 208
  - Annex C

06 Feb 96

WIPO Standards

- ST.23 - recommendation for the presentation of nucleotide and amino acid sequences in patent applications and in published patent documents.
- ST.24 - recommendation concerning the filing of nucleotide and amino acid sequence listings in computer-readable form.

06 Feb 96

PCT Rule 5.2 specifies that

- The description contain at the end a listing for any nucleotide and/or amino acid sequence disclosed; and
- The listing comply with standard prescribed in the PCT Administrative Instructions.

06 Feb 96

PCT Rule 13*ter*

- Allows the ISA to invite applicant to furnish within a time limit
  - a listing complying with the prescribed standard and/or
  - a listing in a machine readable form.

06 Feb 96

The machine readable form of the sequence listing

- Permits search and examination of applications containing a sequence listing by computer.

06 Feb 96

If applicant does not comply with the invitation

- The ISA will search the application only to the extent possible without the aid of the sequence listing.

06 Feb 96

In response to the invitation

- Applicant should file
  - a copy of the listing in machine readable form; and
  - a statement to the effect that the listing does not include matter which goes beyond the disclosure of the application as filed.

06 Feb 96

A later-filed sequence listing

- Is placed in the application for use by the ISA;
- Is not published as part of the international application.

06 Feb 96

Chapter II and National Phase

- The IPEA may request the sequence listing from the ISA.
- A designated Office may require applicant to provide
  - a copy of any listing furnished to the ISA; and/or
  - a listing complying with the standard prescribed in the Administrative Instructions and/or with the listing in machine readable form.

06 Feb 96

USPTO Sequence Listing Requirements

- A sequence listing complying with WIPO Standard ST.23 and presented in machine readable form as provided in Annex C of the Administrative Instructions.
- USPTO requirements for US national applications apply to International Applications where USPTO acts as the ISA and IPEA (see 37 CFR 1.821 to 1.825).

06 Feb 96

EPO Sequence Listing Requirements

- A sequence listing complying with WIPO Standard ST.23 and presented in machine readable form as provided in Annex C of the Administrative Instructions.

- EPO requirements for European applications apply to International Applications where EPO acts as the ISA and IPEA (see EPO OJ No. 12 (Suppl. No. 2) and No. 1-2/1993).

06 Feb 96

PCT Administrative Instructions
Section 208
Sequence Listings

(a) Any nucleotide and/or amino acid sequence listing ("sequence listing") shall be presented in a format complying with WIPO Standard ST.23 (Recommendation for the Presentation of Nucleotide and Amino Acid Sequence Listings in Patent Applications and in Published Patent Documents).[4]

(b) Any machine readable form of a sequence listing shall comply with the required format in accordance with Annex C.

(c) Any sequence listing not forming part of the international application shall, when furnished, be accompanied by a statement to the effect that the listing does not include matter which goes beyond the disclosure in the international application as filed.

(d) Sheets of a sequence listing in printed form not forming part of the international application shall be sequentially numbered in a series separate from that used in numbering the sheets of the international application; the number of each sheet shall preferably consist of two Arabic numerals separated by a slant, the first being the sheet number and the second being the total number of such sheets (for example 1/3, 2/3, 3/3).

[4] Published in the WIPO Handbook on Industrial Property Information and Disclosure

ANNEX C

FORMAT FOR NUCLEOTIDE AND /OR AMINO ACID SEQUENCE LISTINGS IN MACHINE READABLE FORM

Australian Patent Office

Machine readable form is not required.

OCR format is accepted and must comply with WIPO Standard ST.22.[12]

No requirement for electronic form but acceptable as follows:

(a) Medium:

Diskette:
5.25 inch, 360 Kb storage;
5.25 inch, 1.2 Mb storage;
3.5 inch, 720 Kb storage;
3.5 inch, 1.44 Mb storage;

Magnetic tape: 0.5 inch, up to 2400 feet;

Density: 1600 or 6250 bits per inch, 9 track;
Format: raw, unblocked;

(b) Character codes:

ASCII;

(c) Computer hardware and operating systems configuration:

Computer: IBM PC/XT/AT, IBM PS/2, or compatibles;

Operating system: PC-DOS or MS-DOS (Versions 2.1 or above);

Austrian Patent Office

Machine readable form is not required.

OCR format is accepted and must comply with WIPO Standard ST.22.[12]

[12]Published in the WIPO Handbook on Industrial Property Information and Documentation.

European Patent Office

(Modification of Annex C - Requirements of the European Patent Office as published in PCT Gazette No. 32/1992 pages 15240-15241).

Machine readable form on diskette is required. The diskette shall be readable on one of the computer/operating-system configurations or comply with the specified format described in subparagraphs (a) and (b) below:

(a) Computer: IBM PC/XT/AT, IBM PS/2 or compatibles;

Operating System PC-DOS or MS-DOS (Versions 2.1 or above);
Line Terminator: Carriage Return plus Line Feed;
Pagination: Form Feed or Series of Line Terminators;
End-of-File: Ctrl-Z;

Media:
Diskette - 5.25 inch, 360 Kb storage;
Diskette - 5.25 inch, 1.2 Mb storage;
Diskette - 3.50 inch, 730 Kb storage;
Diskette - 3.50 inch, 1.44 Mb storage;
Print command: PRINT filename.extensive;

(b) Apple Mactinosh

Operating system: Mactinosh;
Mactinosh File Type: Text with line termination;
Line Terminator: Pre-defined by text type file;
Pagination: Pre-defined by text type file;

Media:
Diskette - 3.50 inch, 400 Kb storage;
Diskette - 3.50 inch, 800 Kb storage;
Diskette - 3.50 inch, 1.4 Mb storage;
Print command: Use PRINT command from any Macintosh application that processes text files, such as MacWrite or TeachText.

The EPO recommends the use of the PatentIn software for the preparation of the sequence listings.

Together with the diskette, the applicant has to file a statement of conformity between the content of the diskette and the diskette and the listing in written form, as follows: "It is hereby stated that the information recorded on the data carrier is identical to the written sequence listing".

(For more details, see Supplement No. 2 to OJ EPO 12/1992).

Japanese Patent Office

The Japanese Patent Office (JPO) recommends that a listing of sequence in an electronic form application shall be recorded as code data complying with WIPO Standard ST.23[13], but the recommendation is not a statutory requirement.

Requirements for electronic form:

(a) Medium:

Floppy disk:
8 inches both-sided double density (2d) (JIS X6201);
5.25 inches high density (2HD) (JIS X6211);
3.5 inches high density (2HD) (JIS 6223);

On-line:

ISDN (64kb/s);
Digital Data Exchange of Packet (9600b/s);

(b) Character codes:

Code of Japanese graphic character set for information interchange (JIS X 0208- 1983);

(c) Computer hardware and operating systems configuration:

Not specified, but in accordance with the JPO's electronic application standards;

(d) Computer software:

Not specified, but in accordance with the JPO's electronic application standards;

(e) Other requirements:

floppy disk application:

File specification for Japanese Documents Interchange (JIS X4004- 1988);

On-line application:

OSI & CCITT T.73;

Russian Patent Office

Machine readable form is not required.

Swedish Patent Office

Machine readable form is not required.

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[13]Published in the WIPO Handbook on Industrial Property Information and Documentation.

United Kingdom Patent Office

Machine readable form is not required.

United States Patent and Trademark Office (USPTO)

A sequence listing is required for all disclosures of sequence information in which the sequence has four or more amino acids or ten or more nucleotides. Branched sequences and those including D-amino acids are excluded from the rules.

The USPTO has not adopted the use of an OCR format and it is not expected that such a format will be adopted by the USPTO.

Sections 1.821 to 1.825 of title 37, Code of Federal Regulations (37 CFR) relate to sequence listings submitted to the USPTO. Sections 1.824 and 1.825 which set forth the requirements for sequence listings in machine (computer) readable form are reproduced below:

37 CFR 1.824 Form and format for nucleotide and/or amino acid sequence submissions in computer readable form.

(a) The computer readable form required by Section 1.821(e) shall contain a printable copy of the "Sequence Listing," as defined in Sections 1.821(c), 1.822, and 1.823, recorded as a single file on either a diskette or a magnetic tape. The computer readable form shall be encoded and formatted such that a printed copy of the "Sequence Listing" may be recreated using the print commands of the computer/operating-system configuration specified in paragraph (f) of this section.

(b) The file in paragraph (a) of this section shall be encoded in a subset of the American Standard Code for Information Interchange (ASCII). This subset shall consist of all the printable ASCII characters including the ASCII space character plus line termination, pagination, and end-of-file characters associated with the computer/operating-system configurations specified in paragraph (f) of this section. No other characters shall be allowed.

(c) The computer readable form may be created by any means, such as word processors, nucleotide/amino acid sequence editors, or other custom computer programs, however, it shall be readable by one of the computer/ operating-system configurations specified in paragraph (f) of this section, and shall conform to the specifications in paragraphs (a) and (b) of this section.

(d) The entire printable copy of the "Sequence Listing" shall be contained within one file on a single diskette or magnetic tape unless it is shown to the satisfaction of the Commissioner that it is not practical or possible to submit the entire printable copy of the "Sequence Listing" within one file on a single diskette or magnetic tape.

(e) The submitted diskette or tape shall be write-protected such as by covering or uncovering diskette holes, removing diskette write tabs, or removing tape write rings.

(f) As set forth in paragraph (c), above, any means may be used to create the computer readable form, as long as the following conditions are satisfied. A submitted diskette shall be readable on one of the computer/operating-system configurations described in paragraphs (1) through (3), below. A submitted tape shall satisfy the format specifications described in paragraph (4), below

(1) Computer: IBM PC/XT/AT, IBM PS/2, or compatibles;

Operating system: PC-DOS or MS-DOS (Versions 2.1 or above);
Line Terminator: ASCII Carriage Return plus ASCII Line Feed;
Pagination: ASCII Form Feed or Series of Line Terminators;
End-of-File: ASCII SUB (Ctrl-Z);

Media:
- Diskette - 5.25 inch, 360 Kb storage;
- Diskette - 5.25 inch, 1.2 Mb storage;
- Diskette - 3.50 inch, 720 Kb storage;
- Diskette - 3.50 inch, 1.44 Mb storage;

Print Command: PRINT filename.extension;

(2) Computer: IBM PC/XT/AT, IBM PS/2, or compatibles;

Operating system: Xenix;
Line Terminator: ASCII Carriage Return;
Pagination: ASCII Form Feed or Series of Line Terminators;
End of-File: None;

Media:
- Diskette - 5.25 inch, 360 Kb storage;
- Diskette - 5.25 inch, 1.2 Mb storage;
- Diskette - 3.50 inch, 720 Kb storage;
- Diskette - 3.50 inch, 1.44 Mb storage;

Print Command; lpr filename;

(3) Computer: Apple Macintosh;

Operating System: Macintosh;
Macintosh File Type: text with line termination;
Line Terminator: Pre-defined by text type file;
Pagination: Pre-defined by text type file;
End-of-file: Pre-defined by text type file;

Media
- Diskette - 3.50 inch, 400 Kb storage;
- Diskette - 3.50 inch, 800 Kb storage;
- Diskette - 3.50 inch, 1.4 Mb storage;

Print Command: Use PRINT command from any Macintosh
Application that processes text files, such as MacWrite or TeachText;

(4) Magnetic tape: 0.5 inch, up to 2400 feet;

Density: 1600 or 6250 bits per inch, 9 track;
Format: raw, unblocked;
Line Terminator: ASCII Carriage Return plus optional ASCII Line Feed;
Pagination: ASCII Form Feed or Series of Line Terminators;
Print Command (Unix shell version given here as sample response-mt/dev/rmt0; lpr/dev/rmt0):

(g) Computer readable forms that are submitted to the Office will not be returned to the applicant.

(h) All computer readable forms shall have a label permanently affixed thereto on which has been handprinted or typed, a description of the format of the computer readable form as well as the name of the applicant, the title of the invention, the date on which the data were recorded on the computer readable form, and the name and type of computer and operating system which generated the files on the computer readable form. If all of this information can not be printed on a label affixed to the computer readable form, by reason of size or otherwise, the label shall include the name of the applicant and the title of the invention and a reference number, and the additional information may be provided on a container for the computer readable form with the name of the applicant, the title of the invention, the reference number, and the additional information affixed to the container. If the computer readable form is submitted after the date of filing under 35 U.S.C. 111, after the date of entry in the national stage under 35 U.S.C. 371, or after the time of filing, in the United States Receiving Office, an international application under the PCT, the labels mentioned herein must also include the date of the application and the application number, including series code and serial number.

37 CFR 1.825 Amendments to or replacement of sequence listing and computer readable copy thereof.

(a) Any amendment to the paper copy of the "Sequence Listing" (Section 1.821(c)) must be made by the submission of substitute sheets. Amendments must be accompanied by a statement that indicates support for the amendment in the application, as filed, and a statement that the substitute sheets include no new matter. Such a statement must be a verified statement if made by a person not registered to practice before the Office.

(b) Any amendment to the paper copy of the "Sequence Listing," in accordance with paragraph (a) of this section, must be accompanied by a substitute copy of the computer readable form (Section 1.821(e)) including all previously submitted data with the amendment incorporated therein, accompanied by a statement that the copy in computer readable form is the same as the substitute copy of the "Sequence Listing." Such a statement must be a verified statement if made by a person not registered to practice before the Office.

(c) Any appropriate amendments to the "Sequence Listing" in a patent, e.g., by reason of reissue or certificate of correction, must comply with the requirements of paragraphs (a) and (b) of this section.

(d) If, upon receipt, the computer readable form is found to be damaged or unreadable, applicant must provide, within such time as set by the Commissioner, a substitute copy of the data in computer readable form accompanied by a statement that the substitute data is identical to that originally filed. Such a statement must be a verified statement if made by a person not registered to practice before the Office.

Annexes

PATENT COOPERATION TREATY (PCT) PUBLICATIONS
U.S. DOLLAR PRICES FOR THE YEAR 1996

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The following PCT publications, in English and French except where otherwise indicated, may be ordered from the International Bureau of the World Intellectual Property Organization (address overleaf).

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Updating Service for 1996** (only for those who owned the Guide in 1995)	84.00	168.00
PCT text and Regulations***	15.00	26.00
The First Twenty-Five Years of the PCT 1970-1995	67.00	140.00
Records of the Washington Diplomatic Conference, 1970 (hard bound)	126.00	180.00
Basic Facts about the PCT	free	free

* Published in Chinese, English, French, German, Japanese, Russian or Spanish, if the application was filed in one of these languages; published in English, if filed in a language other than the preceding seven; English-language abstract is always included. May be supplied in single copies by number of publication, or supplied automatically upon publication in two modes: either all of them, or selected pamphlets according to International Patent Classification (IPC) symbols.

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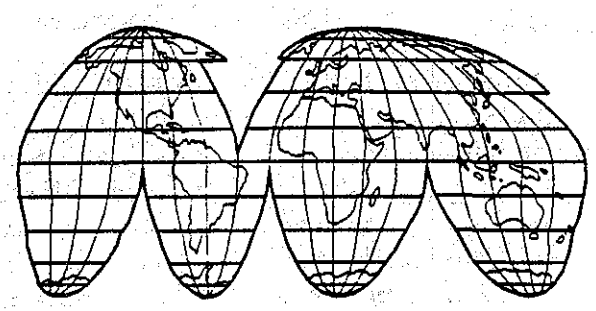

A US Company's Experience with P.C.T.

by: T. David Reed, Section Head
The Procter & Gamble Company
Patent Division - International

After many years of successfully filing patent applications in each country or regional patent office of interest, in late 1990 Procter & Gamble (P&G) changed to a practice under the **Patent Cooperation Treaty** (PCT). Since implementing this change, P&G has filed over 1,400 international applications, designating more than 12,000 country-filings of interest. P&G has entered the National Phase from over 500 of these applications resulting in over 3,500 individual national/regional entries. From this base of PCT experience we will explore: 1) why P&G changed to a PCT practice, 2) how the change was implemented, 3) how the practice evolved, 4) the level of success (i.e., was the change worthwhile), and 5) helpful hints for those considering or just beginning a PCT practice[1].

BACKGROUND

To help you understand and relate P&G's experiences to your practice, it is important to have a basic understanding of PCT procedures as well as a familiarity with P&G's patent operations.

The PCT

The Patent Cooperation Treaty provides a procedure whereby an applicant in a PCT country (contracting state) can lodge a patent application and obtain a filing date in one or more contracting states by filing a single application in applicant's home country and in applicant's home language. At time of this writing, there are seventy-eight (78) states that have subscribed to the PCT covering a growing majority of the developed and developing nations. (See listing in Appendix I.)

The procedures under the PCT are administered by the World Intellectual Property Organization (WIPO) in Geneva and are executed by the PCT *International Bureau (IB)* of WIPO and the patent offices of some contracting states acting in the capacity of *International Searching Authority (ISA)* and *International Preliminary Examining Authority (IPEA)* and/or *Receiving Office*

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[1] P&G's experience with the PCT is based on filing international applications in the US Receiving Office with international searches and international preliminary examinations conducted by either the EPO or the USPTO. The story of P&G's experience, however, should be beneficial to both current and future users of the PCT, regardless of the receiving office and international searching and preliminary examining authorities utilized.

(RO). For example, for applicants who are residents or nationals of the United States, PCT filings are made in English in the RO which is part of the United States Patent & Trademark Office (USPTO); for applicants who are residents or nationals of Japan, filings under the PCT are lodged in either Japanese or English with the receiving office which is part of the Japanese Patent Office[2]. Applicants who are residents or nationals of each PCT contracting state have at least one *competent* RO for filing international applications (see PCT Rule 19). Additionally, the IB serves as a RO for international applications from applicants who are residents or nationals of all PCT contracting states.[3] Importantly, for applicants who are residents or nationals of a PCT contracting state, lodging an international application with the Receiving Office has the same legal effect as individually lodging a national patent application in each of the contracting states designated at the time of filing.

Once filed, an international (PCT) application begins a two step process consisting of an International Phase followed by a National or Regional Phase. The National/Regional Phase is conducted in the individual national/regional patent offices and, for the most part, follows procedures similar to direct filings. ***The major advantages of filing under the PCT lie in the procedures and options available during the International Phase.*** The International Phase consists of two parts, the second of which is optional. During the first part (usually called *Chapter I* after the section of the Treaty where it is set forth), an application undergoes a formal examination by the RO and is transmitted to an ISA for a prior art search and report, and to the IB for publication and distribution to the patent offices of the contracting states designated in the *Request* (application). Following issuance of the *International Search Report (ISR)*, the PCT provides an applicant a period of time in which claim amendments may be submitted to the IB (PCT Article 19 & Rule 46).

The timing of all events occurring during the International Phase is based on the earliest priority date of an application. If an application is first filed under the PCT (filed without any priority claim under the provisions of the Paris Convention), the "earliest priority date" is the international (PCT) filing date. If a PCT application is filed claiming priority under the provisions of the Paris Convention, this date is the earliest priority date claimed in the application. (PCT-event time lines covering each of these situations are shown in Appendix II.) For applications first filed under the PCT, the *International Search Report* issues approximately nine months after filing; for PCT Paris Convention filings, the report issues about sixteen months after the earliest priority date. **Regardless of whether an international application is the first-filed application or is filed under the Paris Convention, the application and its search report will be published about eighteen (18) months after the earliest priority date.**

Under Chapter I procedures, the PCT affords an applicant ***twenty (20) months*** from the

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[2] English language international applications filed in the JPO as PCT Receiving Office must be searched (and, if international preliminary examination is requested, examined) by the EPO.

[3] For national security reasons, the national laws of some contracting states preclude the use of the RO/IB in some circumstances. It is the responsibility of an applicant to insure compliance with all applicable national security restrictions.

earliest priority date to evaluate the claimed invention, consider the prior art in the search report, and make a decision whether to invest the money required to enter the national or regional patent offices, and, if necessary, obtain translations. This is an additional eight months beyond the twelve-month limit available under the Paris Convention alone.

To further increase the time for decision making and to obtain the additional benefit of an examination on the merits, for most PCT contracting states (see Appendix I) applicants can avail themselves of the optional procedures under *Chapter II* of the PCT. Provided an applicant files a *Demand for International Preliminary Examination* with a competent IPEA (PCT Rule 59) within nineteen (19) months of the earliest priority date, the time to enter the National/Regional Phase is extended from twenty months to ***thirty (30) months*** after the earliest priority date. This additional ten months allows time for the IPEA to examine the application and (in general) to issue a *Written Opinion* regarding the novelty, inventive step and industrial applicability of the claimed invention. In the Written Opinion, the IPEA examiner may also comment regarding any number of other matters believed to require amendment (PCT Rule 66.2). Following receipt of the Written Opinion, an applicant is given the opportunity to respond to the IPEA examiner's opinion with arguments, data and/or amendments. Additionally, an applicant is entitled to an interview with the examiner. Under the PCT, however, **no response to a Written Opinion is required.** At some time before about twenty eight months from the earliest priority date, the IPEA examiner makes a final review of the application, including any arguments and/or amendments submitted in response to the Written Opinion, and issues an *International Preliminary Examination Report* (IPER). This advisory report is forwarded to the applicant and to the patent office of each of the PCT contracting states elected at the time of filing the Demand. An applicant, now having both the ISR and the IPER, is faced with the decision if and where to enter the National/Regional Phase. The National/Regional Phase entry must be made on or before the thirty-month anniversary of the priority filing.[4]

The complete procedures, requirements and options offered under the PCT are too numerous to be discussed here. Before filing a PCT application, an applicant should be thoroughly familiar with the Articles, Rules and Administrative Instructions of the PCT as set forth in the *PCT Applicant's Guide* and other PCT publications (available through WIPO in Geneva). It is also suggested that new PCT practitioners attend one of the PCT training courses given in many countries by WIPO personnel.

Procter & Gamble

P&G has patent operations in the United States, Europe and Japan. The staff effort at each location is divided into a national or first-filing function and an international function. The patent professionals performing the first-filing duties are located at the various technical centers throughout the world. They work with and are part of P&G's research and development teams. These practitioners are responsible for drafting, filing and prosecuting P&G's first-filed applications. First

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[4] The local laws of some contracting states/offices allow an additional month for entering the National/Regional Phase (for example Australia and the EPO). For these states/offices, entry from Chapter I must occur within 21 months from the earliest claimed priority date and entry from Chapter II must occur within 31 months.

filings are generally made directly in the "home" patent office (USPTO, JPO, or EPO). The first-filing attorney retains responsibility for all aspects of the first-filed application through acceptance and grant. The international function is responsible for all subsequent patent filings, including filings made under the Paris Convention and *via* the PCT.

About eight to nine months after the first filing, a summary of each first-filed application is sent to a "technology coordinator" for recommendations regarding additional filings. Each of the technology coordinators is a senior technical manager responsible for keeping abreast of the Company's global development efforts in their area of specialty. These coordinators are in the best position to gather the corporate input necessary to judge the commercial interest of each invention on a geographic basis and determine where to file. The coordinators' filing decisions are communicated to the international patent function for action. Prior to changing to practice under the PCT, the international groups lodged the applications directly in the appropriate national and regional patent offices.

WHY AND HOW P&G CHANGED

Why

Direct national/regional practice had served P&G well for many years. Tried and true procedures were in place, operations were running smoothly and the Company's needs were being served. So, "Why change?"

In a phrase, "business needs were changing!" With the Company's changing needs, the patenting procedures also needed to change to continue serving the Company's interests. P&G is a multi-national company manufacturing and marketing a wide variety of consumer, medical and industrial products encompassing a wide scope of technologies. The geographic interests of the Company are ever expanding. For any given product or technology area, the countries of interest tomorrow most likely will not be limited to the countries of interest today. To best serve the Company, the Patent Division needed to keep a wide spectrum of geographic patent filing options open for as long as possible. New developments keep coming from the global research and development groups at an increasing rate. Often there are more promising developments than can be properly evaluated in the time afforded by the Paris Convention. P&G needed more time to assess the costs versus the benefits of obtaining patent protection for each of the new developments. Additionally, in an atmosphere of expanding geographic interests and variable international monetary conditions, it is advantageous to delay patenting expenditures (translations, filing costs, etc.) to allow more informed decisions regarding the allocation of intellectual-property-protection funds. **In brief, we needed to keep the maximum number of options open for as long as possible to allow the *final* national patent filing decisions to be made in light of the maximum scientific and business information.**

Keying on these needs, a practice under the PCT had the potential to help in each area:

1) for PCT contracting states, final filing decisions could be delayed up to thirty months from the priority filing -- eighteen months longer than is available under the

Paris Convention alone,

2) national/regional options could easily (and relatively inexpensively) be reserved in a wide range of geographies, and

3) the outlay of filing and translation expenses could be delayed until National Phase entry.

All in all, for P&G, the additional expense of lodging an application under the PCT appeared more than justified by the flexibility available under the PCT.[5]

While the PCT seemed to offer the options required to best serve the Company's needs, PCT procedures and the effects of international processing on our patent applications were unknown. Our concern was heightened by tales circulating around the US "patent bar" indicating that in actual practice, the PCT was fraught with problems: lost cases leading to lost property rights, inconsistent legal decisions, sloppy operations, inflexible rules, etc. Since any change in our patent operations could not put any of the Company's potential patent rights in jeopardy, we launched an investigation into these rumors. Our investigation found that while there were some problems during the start-up of our RO, most of the horrible stories were ancient history and corrective actions had been taken by the RO staff and WIPO. We concluded that practice under the PCT was "safe" for the Company's applications and we decided to **"Go For It!"**

How

Making the decision to adopt a new procedure like practice under the PCT, and actually implementing the change in an effective and efficient manner are quite different matters. As attractive as PCT practice was to P&G, it was clearly a new procedure with unfamiliar rules. In addition to training the international patent staff about the PCT, the technology coordinators and others in the Company had to be educated in the advantages PCT offered. Procedures needed to be put in place to fully and effectively utilize the flexibility afforded under the PCT.

Educating the international patent staff in PCT procedures was accomplished by three routes: 1) reading as many publications on PCT practice as possible, such as the *PCT Applicant's Guide*, the Treaty itself and the implementing rules, 2) attending seminars on PCT practice, especially those taught by WIPO personnel, and 3) learning as much as possible from experienced PCT practitioners. For someone contemplating or just beginning practice under the PCT, the *PCT Applicant's Guide* is an invaluable source of information. The *Applicant's Guide*, along with the text of the Treaty and

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[5] The costs of lodging a PCT application vary depending on the length of the application, the number of designated states, the ISA, and, under Chapter II, the IPEA utilized. The costs of an application are detailed by RO, ISA and IPEA in Volume I of the *PCT Applicant's Guide*. Additionally, the costs of entering the National/Regional Phase for each contracting state can be found in Volume II of the *PCT Applicant's Guide*. Several contracting states offer reduced national fees under certain circumstances. Be sure to consult the *PCT Applicant's Guide* to learn about your specific situation. Our experience has been that, on the average, the overall cost of using the PCT is about equivalent to the cost of from one to two foreign language translations.

rules will quickly become the foundation of your PCT library. Additionally, the patent laws and rules of each individual contracting state may have been amended to include sections on PCT practice. A full understanding of the PCT-related sections of local law is also needed.

Educating the Company about how to best utilize the provisions of practice under the PCT was a bit more challenging and was not truly complete for almost eighteen months. Even though the advantages of the PCT were thoroughly explained, until National Phase entries were imminent, the advantages afforded by our new PCT practice were merely promises. As the first National Phase entry decisions were made, the flexibility gained by the extended timing and expanded geographic options under the PCT were finally realized.

With the "book learning" over, all applications having a Paris Convention deadline in December 1990 were set for filing under the PCT. We began ...

INTERNATIONAL PHASE PROCEDURAL EVOLUTION

The Starting Point

Being somewhat unsure in this new arena, we began cautiously. Since our main purpose in filing under the PCT was to buy decision making time, maintain geographic options for as long as possible and to postpone major filing costs, the delay in National/Regional Phase entry to thirty months from the priority date obtained under Chapter II was a must. In our caution, we chose not to exercise any of the other available PCT options since they were not directly related to achieving these three benefits. Our decision included passing the opportunity to respond to Written Opinions. Since we did not have any experience with the effect of the advisory IPER's on National/Regional Phase prosecution, we did not plan to respond to Written Opinions. We only extracted the useful information and set them aside them for future reference.

As the first months of our fledgling PCT practice passed, and our practical PCT experience grew, we reexamined our procedures based on our early learning.

1) Procedures under the PCT are easy to understand and are not difficult to follow, but they do differ from procedures used in national practice.

2) PCT formal rules are strictly enforced by the Receiving Office. Any application deviating from formal PCT requirements was met with an *Invitation to Correct* in which an applicant is given 30 days to rectify formal deficiencies.

3) With the large volume of papers handled by the RO, occasionally a submission temporarily went astray or a required RO action did not occur. As frustrating as this can be, all instances of lost papers or missed actions were remedied provided proof the applicant took the necessary action in a timely manner could be presented (mailing receipts, etc.).

4) Invitations to Correct are the "scourge" of PCT practice and are to be avoided if at all possible. They cause the applicant needless rework, and delay the orderly progression of applications through the RO. It is in an applicant's best interests to file all applications in as near perfect condition as possible.

5) Treaty timing regarding issuance of the Search Report was not always met. (In the ISA/US, the delay was often dependent on the case backlog in the "art group" conducting the search.)

6) International Search Reports issued by the patent office where the first-filed application was lodged were generally a rehash of information already known from prosecution of the first-filed case -- in general, no new learning was gained for the search fees paid.

7) The PCT runs on paper. The RO, the IB, and the ISA issue a piece of paper to the applicant at every step of the PCT process. When the volume of paper generated by each application starts to arrive, it can be overwhelming. We learned, however, that each notice is important and each should be reviewed by the applicant.

All-in-all, as P&G's experience with PCT increased, we confirmed our judgment that using PCT presented no more risk to our applications than a direct national filing. We also concluded that an internal tracking system to monitor and follow-up on critical events in the PCT process was needed to help avoid future problems. In the PCT process, an applicant has a responsibility to be sure all the necessary PCT actions are occurring properly and should immediately follow-up with the RO, IB, ISA or IPEA if any problems are detected.

One other aspect of the transition to practice under the PCT that we monitored closely was the effect of the new procedures on staff effort. For some time prior to the change to PCT, our filing staff prepared all the formal documents needed for our national filings on the computer by merging case information contained in a database with the appropriate "shell" documents contained in a word-processing program. It took several months for the staff to become comfortable with the PCT forms and a year or so before the PCT forms could be integrated into our automated document system. After some time and experience, however, the new procedures became a part of our routine operations. (Anyone having a broad international practice should consider the use of a computerized merge-document system to generate formal documents. The time savings and decreased possibility of error when compared to hand typing is considerable.)

An unexpected increase in staff time arrived with our first Invitations-to-Correct. The RO was considerably more "picky" than we had expected and correcting the formal defects in our applications began taking a significant amount of time. As time passed, we came into alignment with the RO on the interpretation of the Rules and the number of Invitations-to-Correct began to wane. The PCT formal requirements are clearly laid out in, *inter alia*, Rule 11 and once we were aligned with the RO, avoiding Invitations-to-Correct was merely a matter of insuring our applications met the requirements.

Overall, the staff effort required for a PCT filing is currently between one and one and one-half times the effort required for a single national filing.

Procedural Revisions

Following the learning obtained in the first months of PCT practice, we reexamined our procedures and made several changes:

- The PCT uniquely offers a simple and convenient way to keep geographic options open for up to eighteen months following the Paris Convention deadline. To help determine when we should avail ourselves of these opportunities, we established guidelines based on consideration of PCT costs and corporate interest as expressed at the time of PCT filing.

  If an application was recommended for filing in only about one or two PCT contracting states, the expense of a PCT filing was generally not justified. In these cases, we do not use PCT, but file the applications directly in the one or two countries/regional offices of interest.

  If the original filing recommendation includes three through seven PCT contracting states, we view this level of filing as indicative of moderate corporate interest and file the application *via* the PCT designating the three to seven states of interest. While this does not give expanded geographic options at the time of National Phase entry, it does reserve the option to delay final decisions regarding the states of early interest until National Phase entry. It therefore represents a potential cost savings over direct national filings at the end of the Convention year.

  If the original recommendation includes eight or more PCT contracting states, we take advantage of the PCT provision that does not levy designation fees for states beyond the first ten designations (regional offices count as one (1) designation). For eight or more recommended contracting states, we designate all PCT contracting states. This statement needs to be qualified somewhat. If a contracting state is also a member of the EPO (or ARIPO), we designate that state through the EPO (or ARIPO) only. We learned that if we checked the individual EPO states in addition to the EPO, we set off a chain of events that generates a lot of paper to and from the individual EPC patent offices. This is over and above the mountain of paper generated by the PCT procedure alone. Since we don't usually pursue patent protection in EPO countries by the national route, we save our effort and the effort expended in the individual patent offices by not designating the EPO states individually. There are pros and cons to filing through the EPO versus filing directly in the individual EPO states. The proper route to take must be reviewed and chosen based on your needs.

- Our initial (cautious) procedures called for search and examination by the ISA/US and IPEA/US. This position was quickly replaced by having US originated

applications searched and examined by the EPO while European first-filed cases were processed by the USPTO. (Our Japanese first-filed applications are searched and examined by the USPTO or the EPO depending on individual case needs.) This procedure gives the Company search results from both the EPO and the USPTO for every case, and avoids the waste of search-money that occurs when the search obtained in conjunction with the first-filed application is recycled by the ISA. The extra search allows for more informed decisions at National Phase entry.

✡ To help avoid future problems, we docket and track all critical PCT events. This is not to say that every paper generated during a PCT filing needs to be tracked, but certain events must occur for the PCT process to work.

1) We always send/request a return-receipt with every PCT submission and monitor the return of this receipt. We insure the receipt is sufficiently detailed that it can be used as proof of receipt by the RO, IB, ISA, or IPEA of every required submission.

2) We also track the receipt of the application by the IB. With acknowledgement of receipt by the IB (Form PCT/IB/301), an applicant knows that the application will be properly published and distributed to the designated offices. This also provides the first opportunity to check the case data, priority claim(s) and intended country designations against what has been entered into the computer at the IB. If there is a mistake in the data entry, or if you forgot to make a designation at the time of filing, there may be time to correct the problem. By contacting Geneva, data entry errors can be corrected. If the fifteenth month deadline hasn't passed, omitted designations may be "added" under PCT Rule 4.9(c) by confirming the appropriate precautionary designation(s).

3) Tracking receipt of the International Search Report is also important. Not only is the report a valuable piece of information, but preliminary examination will not proceed without it. (Additionally, for PCT applications based on earlier filed US applications, the information in the International (PCT) Search Report may require the filing an Information Disclosure Statement for the earlier filed US application in order to comply with 37 CFR §1.56.)

4) In order to insure meeting the nineteenth month deadline for filing the Demand for International Preliminary Examination, we docket this event for the middle of the 18th month. This way we insure that all demands are sent and received by the appropriate IPEA well before the deadline.

5) We track receipt of the Demand by the IPEA and also follow the IB's notification to the elected offices that Chapter II provisions apply (Form PCT/IB/332). If the IB notification is not issued, the elected offices will not know the time for

entering the National Phase has been extended from 20 months to 30 months. Unaware that the National/Regional Phase deadline has been extended under Chapter II, some offices will inform the applicant that the international application is deemed withdrawn for failure to enter the National/Regional Phase by the twenty-month Chapter I deadline. It is easier to anticipate and correct problems like this with the IPEA and IB than to work the issue with each individual local office.

6) During Chapter II processing we track only the receipt of the IPER (due by the end of the twenty-eighth month). (Of course we docket the response deadline for any Written Opinions in the same manner we docket all office actions we receive.) Regardless of whether the IPER is timely-received or not, applications must enter the National Phase within the thirty month time limit.

7) In addition to these PCT events, we also docket the start of our internal procedures to obtain National/Regional Phase entry recommendations from our technology coordinators. This request is made at the twenty-sixth month. Our target is to process and dispatch National/Regional Phase entries between the twenty-eighth and twenty-ninth months to give local agents at least a full month to prepare, translate (if necessary), and to effect National/Regional Phase entry.

✡ Following the receipt of the ISR, the PCT affords an applicant the opportunity to enter amendments to the claims (through the IB). Since meeting our basic goals requires filing a Demand and entering Chapter II, we chose not to enter claim amendments under PCT Article 19, but instead, any amendments to the claims (or the disclosure and drawings) are submitted with the Demand or during international preliminary examination under PCT Article 34.

✡ The biggest change to our starting operational philosophy relates to responses to Written Opinions. Going-in we planned to note Written Opinions but not formally respond to any of them. As time passed it became clear that this decision caused us to miss an outstanding opportunity to advance prosecution of our applications in many countries with the effort of a single response.

Common sense tells us that substantive issues raised in an IPER will need to be addressed in every office where National/Regional Phase entry is effected. Just because one chooses not to respond to the international examiner during Chapter II examination will not make the issue(s) raised by the IPEA disappear. Therefore, if one can argue against a negative finding or amend the application during Chapter II and get a favorable IPER, significant time may be saved during National/Regional Phase prosecution. In the absence of a successful Written Opinion response, the negative issues raised in the IPER will have to be addressed on a country-by-country basis in the National/Regional Phase. (The EPO has stated that the first official EPO action following Regional Phase entry will require addressing all negative matters raised in the IPER.) Based on the realization that a Written Opinion response leading to a favorable IPER for novelty, inventive step and industrial applicability can save

a great deal of time and energy during National/Regional Phase examination, we changed our philosophy and now respond to Written Opinions whenever possible.

While it is clear that a response to a Written Opinion leading to a favorable final report is the best route to take, there are a few *caveats* that temper our enthusiasm for universally responding to Written Opinions.

1) In many states, the actual effect of a favorable report is unknown. (For example, an informal conversation with a JPO examiner indicated that Japanese examiners take favorable reports under advisement but will continue to do their normal, full-fledged examination of each application. Our early experience in Australia, on the other hand, indicates a favorable report leads to a speedy acceptance, provided local formalities are met.)

2) A necessary data submission or argument for patentability may be rendered ineffective in the national offices if it is insufficient to change the international examiner's negative opinion. The Articles and Rules under the PCT require the IPEA examiner to issue a statement regarding the novelty, inventive step and industrial applicability of each claimed invention, citation of supporting prior art and "with such explanations as the circumstances may require." (Article 35(2)) If an applicant submits an unconvincing response to a Written Opinion, the examiner may not only make statements regarding the relation between the claimed invention and the cited art, but may also make a statement similar to,

> "Applicant's argument that ... has been considered and found unconvincing because ...".

Since this opinion will be distributed to all elected offices, the IPEA examiner has not only issued a negative opinion that will require attention during national examination, the report has potentially rendered the argument(s) used during the international phase ineffective. The same can be true for data. If a data submission is judged insufficient and the IPEA examiner states this opinion in the IPER, the use of the same data (alone or in conjunction with additional data) in front of a national examiner may be less effective or ineffective. With the effect of one's basic argument and/or supporting data weakened by the IPEA examiner's comments, prosecution to a successful conclusion in the national offices may be more difficult.[6]

We have received IPERs containing statements regarding the inadequacy of arguments and data submitted during Chapter II examination. We have not, however, experienced any negative effects in the National/Regional Phase from these

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[6] Under PCT Article 38(1), the nature of international preliminary examination is confidential and the IPEA file is not available without the consent of the applicant. The one exception to this IPEA/applicant confidentiality is the file is made available to the elected offices (on request) once the IPER has been established.

opinions. The downside risk discussed above is speculative from this standpoint. Because of the potential consequences, submitting arguments and/or data in response to a Written Opinion that may be less than convincing may not be the best approach. Because of this risk, we have adopted the posture of responding to every Written Opinion in which we assess that our arguments, data and/or amendments have an eighty percent chance or better of resulting in a favorable report. (Remember, during the International Phase an applicant is entitled to receive one Written Opinion and make one response. Due to Treaty timings and the extra effort required by the IPEA, second Written Opinions are rare and becoming more so. The "give and take" found during prosecution in most national patent office examinations is not a practical part of the PCT procedure (although it is not precluded).)

✡ To respond or not to respond ... In light of the comments above, an applicant can choose to substantively respond to a Written Opinion or not. If the decision is not to substantively respond, what should an applicant do -- nothing, or inform the IPEA that no response will be forthcoming? For most of our PCT practice, P&G subscribed to the philosophy that a response was needed whether or not the content was substantive. We chose this approach because 1) it puts a piece of paper in the hands of the IPEA examiner that effectively says, "we'll handle substantive issues as appropriate during national prosecution." This signals the examiner that the IPER may issue without further delay. 2) It puts a document in our files that indicates the Written Opinion was considered and a conscious decision was made not to respond. The IPEA/EP has indicated that such notices are helpful. Consequently, we respond to every Written Opinion received from the IPEA/EP, even if the response only acknowledges receipt of the Written Opinion and informs the IPEA/EP that we will not be sending a substantive response. On the other hand, informal conversations with several USPTO examiners led us to conclude that such notices, while occasionally helpful, probably should not be sent to the IPEA/US since they are just another piece of paper that had to be handled. Based on this we have ceased sending notices of non-response to the IPEA/US (we still put a note in our file, however, to indicate the non-response was intentional). As you begin your PCT practice, it would be helpful to determine whether or not the IPEA(s) you will be using would prefer receiving a response for every Written Opinion, or only substantive responses.

NATIONAL/REGIONAL PHASE PROCEDURES

In June of 1992 we lodged our first National Phase entries. The initial entries went very smoothly due, in part, to the preparations made for this event. Six months prior to the deadline, we wrote each of our agents and asked them to list every item required to insure a smooth National Phase entry. Additionally, we asked each agent to list the information that would be helpful to them, but not absolutely required for National/Regional Phase entry. We received a wide spectrum of answers ranging from "we don't really need anything except authorization to proceed," to "send us a copy of every paper sent to or received from the international authorities." We compiled the essential items from each agent and looked for common and important items from the "nice-to-have"

lists. A study of this information led to the development of a standard package of information that supplies the minimum requirements of all agents and the majority of the "nice-to-have" items. Our goal was to have a standard submission that we could send to every agent. Using a standard package allows the case preparation staff to treat every National/Regional Phase entry essentially the same, regardless of where entry occurs. The packet we send to each agent includes:

1) a data sheet containing any special instructions, all pertinent data regarding the application and indicating the contents of the package;

2) the WIPO publication or a copy of the application as originally filed and a copy of the International Search Report;

3) the Demand for Preliminary Examination;

4) all Written Opinions;

5) any substantive responses to Written Opinions and amendments;

6) the IPER;

7) formal documents required for entry (varies by country); and

8) any desired preliminary amendment to be entered following National/Regional Phase entry.

To insure each agent completely understands the status of any amendments entered during the International Phase as well as any preliminary amendments, we cover the IPER or Written Opinion response(s), and/or preliminary amendment with brightly colored sheets of paper detailing the exact status of any amendment contained in the document. These colored "flag" sheets help insure our instructions are clear and that nothing is missed.

For applications first-filed in Europe and Japan, our US filings are made *via* the PCT. As a consequence, we have also gained some experience in entering the US National Phase under 35 USC §371 which may be of interest. When entering the US National Phase we use a different approach since a) we are the agents, and b) at P&G we use this opportunity to transfer the responsibility for prosecution to the appropriate Company (national) patent group. As with our initial PCT filings, when entering the US National Phase we always utilize the pre-printed form supplied by the USPTO. Proper use of this form insures all the minimum formal requirements for entry under 35 USC §371 are met and it acts as a great checklist to insure nothing is overlooked. Secondly, if a PCT application has European-style claim dependencies, US National Phase entry is a perfect time to enter the necessary preliminary amendment to bring the claims into conformance with, *inter alia*, 37

CFR §1.75(c)[7], before claims fees are calculated. The required Inventor's Oath or Declaration and, if available and appropriate, the assignment are also submitted at this time.

SUCCESS OR FAILURE?

With over four years of PCT practice behind us, was the change worthwhile? Without qualification, "YES!" Over the past four years our organization has learned to use PCT to accomplish all of our initial goals. P&G has utilized the built-in delays to better manage patenting decisions, better evaluate our inventions, and delay costs. We have often taken advantage of the expanded geographic options available by entering the National Phase in contracting states that were not of interest at the close of the Paris Convention year. During the first six months of PCT practice, we ran a "success study." The countries designated by our technology coordinators during this period were the same countries that would have been filed directly in the national offices under the previous system (i.e., they had not yet been trained in the possibility of reserving a filing date in a broader geography for a small price). Tracking the cases filed under the PCT during the first six months through National Phase entry revealed that the additional decision making time resulted in almost twenty percent of the PCT applications filed being "dropped" completely. More importantly, looking at the individual-designation level, almost thirty percent of the individual applications that would have been filed nationally under the old non-PCT system of operations were dropped.

After the six-month test period ended, broader designations were made than would have been recommended in the absence of PCT, so exact data on the advantages gained under the PCT cannot be made. However, a review of the overall application and designation attrition rate clearly shows P&G continues to take increasing advantage of the benefits offered by PCT through better patent-application portfolio management.

PCT AND YOU
Helpful Hints from P&G's Experience

During the first four years of practice under the PCT, P&G has developed a list of helpful hints and suggestions regarding PCT practice. We offer the following list for your consideration. Please realize not all these items are necessarily proper or useful in all situations, they are offered merely to help advance your practice under the PCT. You will have to review your own internal procedures and the needs of your client to determine which, if any, of these hints have application in your practice.

- Be aware that while filing under the PCT looks like a familiar game, it is governed by a different set of rules and regulations. Procedures under the PCT are not complicated or difficult, but you must NEVER assume that your local rules of practice apply in your PCT practice; doing so can prove fatal to your client's applications. Study and

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[7] 37 CFR §1.75(c) states, *inter alia*, that a multiply dependent claim may not depend from another multiply dependent claim. Failure to amend claims so they are in compliance with 37 CFR §1.75(c) before claims fees are calculated can lead to very high fees.

follow the provisions of the PCT and the implementing rules. "Playing the PCT game" by the PCT rules will allow you to reap the benefits of the PCT; ignoring the PCT rules or trying to "play" by local practice rules will only lead to frustration and possible loss of an application.

- Insure your PCT applications are as formally perfect as possible. Publication requirements demand that PCT Rule 11 be strictly enforced by the RO. Conforming to Rule 11 at the time of filing will save you (and the RO) time.

- If you file a significant number of PCT applications, a computerized merge-document system for generating the Request, Demand, and all the formal documents required for National Phase entry is recommended.

- Use appropriately detailed return receipts for **EVERYTHING** submitted to the RO, IB, ISA and IPEA (and your national office).

- Docket and track all critical PCT events; follow-up with the RO, ISA, IPEA or IB if expected events don't occur or errors are discovered. Docket actions required of the applicant so they occur well in advance of the deadline. [Submissions may be made by facsimile to the IB and some other offices. The date of receipt will be taken as the date the FAX arrives at its destination, **NOT** the date you send the facsimile. In some cases, papers filed by FAX must be followed by a hard copy within two weeks or the receipt date will be vacated (See PCT Rule 92.4 and *Annex B* of the *PCT Applicant's Guide*). One *caveat* regarding the use of filing documents by facsimile; missing or illegible sheets in the transmission are the responsibility of the sender and not the recipient. A bad FAX transmission could invalidate a submission and the sender may not learn of the problem until after the deadline for response has passed (PCT Rule 92.4(c)). We only use FAX for critical submissions when no other route to meeting a deadline is available.]

- Decide whether or not to respond to Written Opinions on a case-by-case basis. It is to your advantage to respond to as many opinions as possible. Individual case circumstances should dictate whether responding is in the best interests of your client. If you do not respond, it is a good idea to put a note in your file to indicate responding was considered and rejected (and send a notice to the IPEA, if such notices are desired by the IPEA concerned).

- In light of the ISR and the IPER, reevaluate your original designations/elections prior to National Phase entry. Proceed only with those applications and countries of continuing interest.

- Regardless of what PCT papers may be available from the national patent offices, supply your agents with all the documents they will need to effect National Phase entry **and** be sure to give your agents sufficient time to get the job done right. This makes National Phase entry easier for all and less expensive.

- If you enter the National Phase in your own country, be sure you are fully familiar with the requirements for entry and the documents that must be supplied. Use of any available standard form(s) help(s) insure nothing is forgotten. Be familiar with the relevant sections of your local laws and rules. At the time of National Phase entry, the application returns to your "home field" where, within the provisions of PCT Article 27, your local regulations and procedures, and not those of the PCT, apply. (Be sure to read PCT Article 27, especially Article 27(1) relating to the applicability of PCT rules regarding form and content of the application in the National/Regional Phase. These provisions of the PCT may be beneficial to you during National/Regional Phase processing.)

WHAT'S IN THE FUTURE

Some exciting things are happening in the PCT. More and more countries are joining the PCT (see Appendix I). In the future, electronic filing of PCT applications is expected to be available. In a joint effort, WIPO, the USPTO and the EPO are developing EASY (Electronic Application SYstem). To keep up with new developments in PCT operations, you may want to subscribe to the *PCT Newsletter*, the *PCT Gazette*, or both.

PARTING THOUGHT

The PCT provides a valuable tool for the patent practitioner. While it is not the proper procedure to use for every application or for every client, the PCT offers enough advantages that it should be considered whenever multiple-country filings are anticipated. The procedures under the PCT are continually being revised and refined in an attempt to make practice under the PCT safe, easy and advantageous to the greatest number of applicants. The success of the change to PCT practice at P&G is just one story of many that could be told. Look at the PCT, examine your client's needs, and talk to current users of the PCT; your practice could be the next PCT success story.

APPENDIX I

PCT CONTRACTING STATES (78)

EUROPE

EPO

Austria
Belgium ▲
Denmark
France ▲
Germany
Greece ▲■
Ireland ▲
Italy ▲
Liechtenstein ■
Luxembourg
Monaco ▲
Netherlands ▲
Portugal
Spain ■
Sweden
Switzerland ■
United Kingdom

Non-EPO

Belarus
Bulgaria
Czech Republic
Estonia
Finland
Hungary
Iceland
Latvia
Lithuania
Norway
Moldova (Rep. of)
Poland
Romania
Russian Federation
Slovakia
Slovenia
Ukraine

▲ EPO Patent Only
■ Not Bound by Chapter II
♦ ARIPO Patent Only

ASIA & PACIFIC

Armenia
Australia
P.R.O. China
D.P.R.O. Korea
Georgia
Japan
Kazakhstan
Kyrgystan
Mongolia
New Zealand
Republic of Korea
Singapore
Sri Lanka
Tajikistan
Turkmenistan
Uzbekistan
Vietnam

AMERICAS

Barbados
Brazil
Canada
Mexico
Trinidad & Tobago
United States

AFRICA

OAPI

Benin
Burkina Faso
Cameroon
Cent. African Rep.
Chad
Congo
Côte d'Ivoire
Gabon
Guinea
Mali
Mauritania
Niger
Senegal
Togo

ARIPO

Kenya
Malawi
Sudan
Swaziland ♦
Uganda

Non-OAPI/ARIPO

Liberia
Madagascar

STATES CONSIDERING ACCESSION TO THE PCT

EUROPE

Cyprus
Malta
Turkey

ASIA & PACIFIC

Indonesia
Israel
Malaysia
Philippines
Thailand

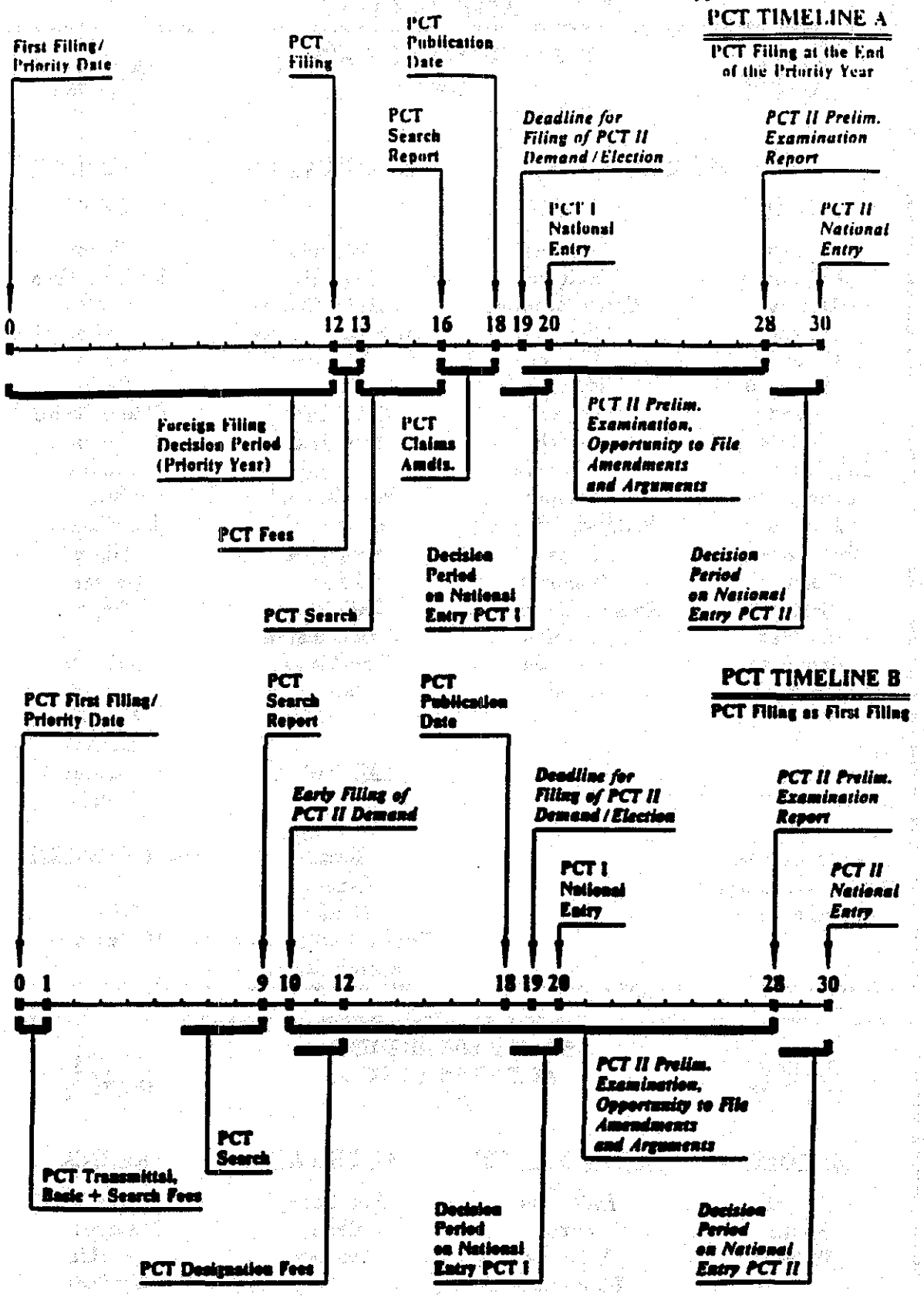
AMERICAS

Argentina
Chile
Uruguay

AFRICA

Algeria
Egypt
Gambia
Morocco
Zambia

P&G & The PCT - Appendix II-1



This chart is being used with the permission of WIPO (PCT Legal Division).

APPENDIX II-2

CRITICAL TIMINGS UNDER THE PCT

Month 0:		Filing date of PCT first filed application (PCT/FF) **OR** the earliest claimed priority date for a PCT/Paris Convention application (PCT/PC).
Month 1:	PCT/FF:	Deadline for payment of PCT basic, transmittal and search fees
Month 3:	PCT/FF:	RO and IB filing receipts should be in hand
Month 9:	PCT/FF:	International Search Report issues
Month 10:	PCT/FF:	Early Demand may be filed
Month 12:	PCT/FF: PCT/PC:	Deadline to pay designation fees Paris Convention deadline to lodge international application
Month 13:	PCT/PC:	Deadline to pay basic, transmittal, search and designation fees
Month 14:	PCT/PC:	RO and IB filing receipts should be in hand
Month 15:	ALL:	Deadline for confirming precautionary designations
Month 16:	PCT/PC	Deadline for submitting certified copy of priority document; International Search Report issues
Month 17½:	ALL:	Deadline to stop publication by withdrawing appln. or earliest priority date
Month 18°:	ALL:	Approximate deadline for claim amendments under Article 19 (° Deadline is actually the later of 2 months from the issuance of the International Search Report or 16 months from the priority date)
Month 18:	ALL:	Application publishes in *PCT Gazette*; application is distributed to designated offices
Month 19:	ALL:	Deadline for extending National Phase entry deadline to 30 months by filing a Demand for Preliminary Examination with the IPEA
Month 20:	ALL:	Deadline for effecting National Phase entry for 1) applications not entering Chapter II, 2) states not bound by Chapter II, 3) applications entering Chapter II with Demands filed after the 19th month deadline.
Month 20:	PCT/PC	Deadline for extending time to enter the National Phase by withdrawing earliest priority claim.
Months 21-28	ALL:	International preliminary examination including Written Opinions responses. (Each applicant is entitled to an interview with the examiner during preliminary examination.)
Month 28:	ALL:	International Preliminary Examination Report issues to applicant and elected offices
Month 30:	ALL:	Deadline for entering the National Phase for applications undergoing Chapter II examination following filing a Demand by the 19th month deadline

WIPO

WO/INF/127
ORIGINAL: English
DATE: August 1995

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

IMPLICATIONS OF THE TRIPS AGREEMENT ON TREATIES ADMINISTERED BY WIPO

Paper prepared by the International Bureau of WIPO in August 1995

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[copied from n:\orgall\irf127e.doc]

1. The General Assembly of WIPO, in its September/October 1994 session, decided that "...the International Bureau should prepare studies on the implications of the said [the TRIPS] Agreement on the treaties administered by WIPO" (document WO/GA/XV/3, paragraph 74).

2. The present paper takes one-by-one each of the 73 Articles of the TRIPS Agreement and, where the Article seems to have "implications" on any WIPO-administered treaty, dwells longer on the Article and points out, unless obvious, any possible change in the obligations of a State which is a party to the relevant WIPO-administered treaty and which is also a Member of WTO and therefore will be bound (generally as from January 1, 1996) by the TRIPS Agreement. The change in such obligations is obvious where this paper contains, in respect of provisions of the TRIPS Agreement, words to the effect that there are no corresponding provisions in the relevant WIPO-administered treaty. Of course, this does not necessarily imply that changes in national legislation would, in all cases, be required, since, in many cases, such legislation is already in harmony with the TRIPS Agreement.

3. More time and more discussions will be needed to make the studies complete. Therefore, the present paper should be considered to be, and is presented as, a first draft. Comments on it will be welcomed by the International Bureau, which, in any revised paper, will take into account such comments.

4. It is to be noted that this paper and any further studies of the International Bureau do not constitute an official interpretation of the WIPO-administered treaties, the TRIPS Agreement or any other official text in the field of intellectual property.

5. On July 31, 1995, the following States were party to the Paris Convention and/or the Berne Convention and the following entities were Members of WTO:

	Paris (135)	Berne (116)	WTO (97 States; 100 total)
Albania	x	x	-
Algeria	x	-	-
Antigua and Barbuda	-	-	x
Argentina	x	x	x
Armenia	x	-	-
Australia	x	x	x
Austria	x	x	x
Bahamas	x	x	-
Bahrain	-	-	x
Bangladesh	x	-	x
Barbados	x	x	x
Belarus	x	-	-
Belgium	x	x	x
Belize	-	-	x
Benin	x	x	-
Bolivia	x	x	-
Bosnia and Herzegovina	x	x	-
Botswana	-	-	x

	Paris	Berne	WTO
Brazil	x	x	x
Brunei Darussalam	-	-	x
Bulgaria	x	x	-
Burkina Faso	x	x	x
Burundi	x	-	-
Cameroon	x	x	-
Canada	x	x	x
Central African Republic	x	x	x
Chad	x	x	-
Chile	x	x	x
China	x	x	-
Colombia	-	x	x
Congo	x	x	-
Costa Rica	x	x	x
Côte d'Ivoire	x	x	x
Croatia	x	x	-
Cuba	x	-	x
Cyprus	x	x	-
Czech Republic	x	x	x
Democratic People's Republic of Korea	x	-	-
Denmark	x	x	x
Djibouti	-	-	x
Dominica	-	-	x
Dominican Republic	x	-	x
Ecuador	-	x	-
Egypt	x	x	x
El Salvador	x	x	x
Estonia	x	x	-
European Community	-	-	x
Fiji	-	x	-
Finland	x	x	x
France	x	x	x
Gabon	x	x	x
Gambia	x	x	-
Georgia	x	x	-
Germany	x	x	x
Ghana	x	x	x
Greece	x	x	x
Guinea	x	x	-
Guinea-Bissau	x	x	x
Guyana	x	x	x
Haiti	x	-	-
Holy See	x	x	-
Honduras	x	x	x
Hong Kong	-	-	x
Hungary	x	x	x

	Paris	Berne	WTO
Iceland	x	x	x
India	-	x	x
Indonesia	x	-	x
Iran (Islamic Republic of)	x	-	-
Iraq	x	-	-
Ireland	x	x	x
Israel	x	x	x
Italy	x	x	x
Jamaica	-	x	x
Japan	x	x	x
Jordan	x	-	-
Kazakstan	x	-	-
Kenya	x	x	x
Kuwait	-	-	x
Kyrgyzstan	x	-	-
Latvia	x	x	-
Lebanon	x	x	-
Lesotho	x	x	x
Liberia	x	x	-
Libya	x	x	-
Liechtenstein	x	x	-
Lithuania	x	x	-
Luxembourg	x	x	x
Macau	-	-	x
Madagascar	x	x	-
Malawi	x	x	x
Malaysia	x	x	x
Maldives	-	-	x
Mali	x	x	x
Malta	x	x	x
Mauritania	x	x	x
Mauritius	x	x	x
Mexico	x	x	x
Monaco	x	x	-
Mongolia	x	-	-
Morocco	x	x	x
Myanmar	-	-	x
Namibia	-	x	x
Netherlands	x	x	x
New Zealand	x	x	x
Niger	x	x	-
Nigeria	x	x	x
Norway	x	x	x
Pakistan	-	x	x
Paraguay	x	x	x
Peru	x	x	x

	Paris	Berne	WTO
Philippines	x	x	x
Poland	x	x	x
Portugal	x	x	x
Republic of Korea	x	-	x
Republic of Moldova	x	x	-
Romania	x	x	x
Russian Federation	x	x	-
Rwanda	x	x	-
Saint Kitts and Nevis	x	x	-
Saint Lucia	x	x	x
Saint Vincent and the Grenadines	x	x	x
San Marino	x	-	-
Senegal	x	x	x
Singapore	x	-	x
Slovakia	x	x	x
Slovenia	x	x	-
South Africa	x	x	x
Spain	x	x	x
Sri Lanka	x	x	x
Sudan	x	-	-
Suriname	x	x	x
Swaziland	x	-	x
Sweden	x	x	x
Switzerland	x	x	x
Syria	x	-	-
Tajikistan	x	-	-
Thailand	-	x	x
The former Yugoslav Republic of Macedonia	x	x	-
Togo	x	x	x
Trinidad and Tobago	x	x	x
Tunisia	x	x	x
Turkey	x	x	x
Turkmenistan	x	-	-
Uganda	x	-	x
Ukraine	x	x	-
United Kingdom	x	x	x
United Republic of Tanzania	x	x	x
United States of America	x	x	x
Uruguay	x	x	x
Uzbekistan	x	-	-
Venezuela	x	x	x
Viet Nam	x	-	-
Yugoslavia	x	x	-
Zaire	x	x	-
Zambia	x	x	x
Zimbabwe	x	x	x

Contents

(The titles of each chapter of this paper are the same as the titles of the Parts or Sections of the TRIPS Agreement.)

Part I of the TRIPS Agreement, entitled "GENERAL PROVISIONS AND BASIC PRINCIPLES"

6. This Part of the TRIPS Agreement consists of eight Articles (Articles 1 to 8).

7. **Article 1, entitled "Nature and Scope of Obligations,"** contains criteria as to who--on the basis of nationality--the beneficiaries of the protection provided for by the TRIPS Agreement are. Those criteria are similar to the criteria contained in the Paris, Berne and Rome Conventions (see TRIPS Agreement, Article 1, paragraph 3; Paris Convention, Articles 2 and 3; Berne Convention, Articles 3 and 4; Rome Convention, Articles 4, 5 and 6). This Article also defines the term "intellectual property" as referring to "all categories of intellectual property that are the subject of Sections 1 through 7 of Part II" (paragraph 2). Other areas of intellectual property (for example, utility models) are therefore not covered by the TRIPS Agreement.

8. **Article 2, entitled "Intellectual Property Conventions,"** is of utmost importance, since it provides that, in respect of the following Parts of the TRIPS Agreement, Members must comply with Article 1 through 12 and Article 19 of the Paris Convention: Part II which is entitled "Standards Concerning the Availability, Scope and Use of Intellectual Property Rights" and contains sections on copyright and related rights, trademarks, geographical indications, industrial designs, patents, layout-designs (topographies) of integrated circuits, protection of undisclosed information, control of anti-competitive practices in contractual licenses, Part III which is entitled "Enforcement of Intellectual Property Rights," and Part IV which is entitled "Acquisition and Maintenance of Intellectual Property Rights and Related *Inter-Partes* Procedures." It is useful that the same Article confirms that--with the exception of the TRIPS provisions on dispute prevention and settlement, transitional arrangements, institutional arrangements and final provisions--nothing in the TRIPS Agreement "shall derogate from existing obligations that Members may have to each other under the Paris Convention, the Berne Convention, the Rome Convention and the Treaty on Intellectual Property in Respect of Integrated Circuits" (paragraph 2).

9. **Article 3, entitled "National Treatment,"** provides for national treatment in terms similar to those provided for in the Paris Convention (Articles 2 and 3) and the Berne Convention (Articles 3 and 4). As far as the beneficiaries of related rights are concerned, however, national treatment only applies in respect of the related rights provided for under the TRIPS Agreement itself.

10. **Article 4, entitled "Most-Favoured-Nation Treatment,"** introduces a principle that is absent from the Paris and Berne Conventions. The principle is expressed as follows: "With regard to the protection of intellectual property, any advantage, favour, privilege or immunity granted by a Member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other Members." There are exemptions to this rule. Among them, are related rights not provided for in the TRIPS Agreement itself and--under certain conditions--international agreements related to the protection of intellectual property which entered into force prior to the entry into force of the WTO Agreement.

11. **Article 5, entitled "Multilateral Agreements on Acquisition or Maintenance of Protection,"** provides that the above-mentioned rules on national treatment and

most-favoured-nation treatment "do not apply to procedures provided in multilateral agreements concluded under the auspices of WIPO relating to the acquisition or maintenance of intellectual property rights." At the present time (July 1995), the Patent Cooperation Treaty (PCT), the Madrid Agreement Concerning the International Registration of Marks, the Hague Agreement on the International Deposit of Industrial Designs and at least the provisions concerning registration of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration seem to be such treaties.

12. **Article 6, entitled "Exhaustion,"** provides that (subject to the provisions on national treatment and most-favoured-nation treatment) for the purposes of dispute settlement under the TRIPS Agreement "nothing in this [the TRIPS] Agreement shall be used to address the issue of the exhaustion of intellectual property rights." This is a provision that has no corresponding provision in either the Paris Convention or the Berne Convention, both of which are silent on exhaustion of rights whether for the purpose of dispute settlement or any other purpose.

13. **Article 7, entitled "Objectives,"** states what intellectual property should contribute to. It is a "should" rather than a "shall" provision. There is no corresponding statement in the Paris and Berne Conventions.

14. **Article 8, entitled "Principles,"** empowers Members to adopt measures in the interest of the protection of public health and nutrition, the promotion of the public interest in certain cases as well as the prevention of the abuse of intellectual property rights and "the resort to practices which unreasonably restrain trade or adversely affect the international transfer of technology." However, in any of these cases, the measures must be "consistent with the provisions of this [the TRIPS] Agreement." Neither the Paris Convention nor the Berne Convention contains comparable statements but it goes without saying that States party to either or both of those Conventions may take such measures provided such measures are consistent with the requirements of the Paris and Berne Conventions.

Part II of the TRIPS Agreement, entitled "STANDARDS CONCERNING THE AVAILABILITY, SCOPE AND USE OF INTELLECTUAL PROPERTY RIGHTS"

15. This Part of the TRIPS Agreement consists of eight Sections (Copyright and Related Rights, Trademarks, Geographical Indications, Industrial Designs, Patents, Layout-Designs (Topographies) of Integrated Circuits, Protection of Undisclosed Information, Control of Anti-Competitive Practices in Contractual Licenses) and 32 Articles (Articles 9 to 40). Each Section is presented separately.

Part II, Section 1, of the TRIPS Agreement, entitled "COPYRIGHT AND RELATED RIGHTS"

16. This Section consists of six Articles (Articles 9 to 14). Five of those Articles deal with copyright (Articles 9 to 13), and one of them (Article 14) deals with what is called related rights. ("Neighboring rights" is a term usually used in WIPO documents to designate related rights, that is, the rights of performers, producers of phonograms and broadcasting organizations.)

17. It is to be borne in mind that Part I of the TRIPS Agreement (General Provisions and Basic Principles), described at the beginning of this paper, applies also to copyright and related rights.

18. **Article 9, entitled "Relation to the Berne Convention,"** consists of two paragraphs.

19. Paragraph 1 reads as follows: "Members shall comply with Articles 1 through 21 of the Berne Convention (1971) and the Appendix thereto. However, Members shall not have rights or obligations under this Agreement in respect of the rights conferred under Article 6*bis* of that Convention or of the rights derived therefrom."

20. *Provisions of the Berne Convention to Be Complied With.* Article 1 of the Berne Convention establishes the Berne Union.

21. Articles 2 to 19 of the Berne Convention contain the substantive copyright law provisions of that Convention. They deal with the following questions: works to be protected (Article 2), works which may be excluded from protection (Article 2*bis*), criteria of eligibility for protection under the Convention (Articles 3 and 4), national treatment, etc. (Article 5), possible restriction of protection in respect of certain works of nationals of certain countries not party to the Convention (Article 6), minimum term of protection (Articles 7 and 7*bis*), right of translation (Article 8), right of reproduction (Article 9), possible cases in which a work may be freely used (Articles 10 and 10*bis*), rights of performance and communication to the public of dramatic and musical works (Article 11), broadcasting and connected rights (Article 11*bis*), rights of recitation and communication to the public of literary works (Article 11*ter*), right of adaptation, etc. (Article 12), possible limitation of the right of recording of musical works (Article 13), cinematographic and connected rights (Article 14), ownership of copyright in cinematographic works (Article 14*bis*), *droit de suite* in works of art and manuscripts (Article 14*ter*), persons entitled to enforce rights (Article 15), seizure of infringing copies (Article 16), rights of Governments to permit, control or prohibit the circulation, presentation and exhibition of works (Article 17), applicability of the Convention by a country to works that exist when that country becomes party to the Convention (Article 18) and applicability of protection that is provided in the national law of a country and which protection is greater than the protection provided for by the Convention (Article 19).

22. Article 20, first sentence, of the Berne Convention is of particular relevance for the relations between the Berne Convention and the TRIPS Agreement and, therefore, is quoted in full: "The Governments of the countries of the [Berne] Union reserve the right to enter into special agreements among themselves, in so far as such agreements grant to authors more extensive rights than those granted by the [Berne] Convention, or contain other provisions not

contrary to this Convention." This provision is of particular importance since, for States that are party to the Berne Convention and are Members of WTO (and, consequently, are bound by the TRIPS Agreement), the TRIPS Agreement is a "special agreement" in the sense of Article 20 of the Berne Convention.

23. Finally, Article 21 of the Berne Convention and the Appendix to it provide for the possibility of developing countries to grant a protection less than the other provisions of the Berne Convention would require in respect of the right of translation and the right of reproduction. The limits of such lesser protection are specified in the Appendix. To make use of the possibilities offered by the Appendix, the developing country must make a corresponding declaration to the Director General of WIPO. No such declaration was in effect at the time of writing this paper (July 1995) but, as from September 2, 1995, one declaration will be in effect; it is a declaration by Thailand which, unless renewed, will lose its effect on October 10, 2004.

24. *Provisions of the Berne Convention Not to Be Complied With.* As already indicated, the TRIPS Agreement provides that "Members shall not have rights or obligations under this Agreement in respect of the rights conferred under Article 6*bis* of that [the Berne] Convention or of the rights derived therefrom" (Article 9, paragraph 1).

25. The rights conferred under Article 6*bis* of the Berne Convention are the so-called moral rights. It is customary to distinguish between two kinds of them, namely, "the right to claim authorship of the work" (Article 6*bis* (1), called "right of paternity") and the right "to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work" (*ibid*, called "right of respect").

26. The TRIPS Agreement does not specify which are the rights "derived" from Article 6*bis* of the Berne Convention. It is believed that the right provided in Article 10(3) of the Berne Convention may be such a right. Under paragraphs (1) and (2) of that Article, the author may not oppose, under certain circumstances, that quotations be made--without his authorization--from his work or that his work be used--without his authorization--for illustration in the course of teaching. It is in respect of these so called "free uses" that Article 10(3) of the Berne Convention provides that mention must be made of the name of the author. In other words, it provides that the right of the paternity be respected. It would seem therefore that the TRIPS Agreement excludes the application of Article 10(3) of the Berne Convention, that is, that, under the TRIPS Agreement the said quotations and illustrations need not mention the name of the author. The same applies to Article IV(3) of the Appendix to the Berne Convention which provides that "The name of the author shall be indicated on all copies of the translation or reproduction published under a license granted under Article II or Article III." Furthermore, it would seem that the TRIPS Agreement also excludes the application of Article 11*bis*(2) of the Berne Convention to the extent that the latter provides that "they [that is, the conditions that may be determined under Article 11*bis*(2)] shall not in any circumstances be prejudicial to the moral rights of the author."

27. It is important to note that under Article 2, paragraph 2 of the TRIPS Agreement "nothing in Parts I to IV of this Agreement [and Article 9 is in Part II] shall derogate from existing obligations that Members may have to each other under ... the Berne Convention ..."

28. Consequently, it would seem that a Member of WTO which is not party to the Berne Convention will not have to apply the provisions of the Berne Convention on moral rights and rights derived therefrom but that a Member of WTO which is party to the Berne Convention will--by virtue of the most favored nation rule of the TRIPS Agreement (Article 4)--have to apply those provisions even in its relations with Members of WTO which are not party to the Berne Convention. However, it would seem that disputes concerning the said provisions could in no case be the subject of WTO dispute settlement procedures since such procedures are--in the field of intellectual property--only available for disputes under the TRIPS Agreement (see Article 64 of that Agreement as well as under Article 1 and Appendix 1 of the WTO Understanding on Rules and Procedures Governing the Settlement of Disputes).

29. *Non-protectable Subject Matter.* Paragraph 2 of Article 9 of the TRIPS Agreement provides that "Copyright protection shall extend to expressions and not to ideas, procedures, methods of operation or mathematical concepts as such."

30. The Berne Convention does not contain any specific provision on this issue; however, on the basis of the legislative history of the Berne Convention, as reflected in the records of the various diplomatic conferences adopting and revising the Berne Convention and on the basis of its generally accepted interpretation, the principles set forth in the above-quoted provision of the TRIPS Agreement have always been followed under the Berne Convention. This is so because the Berne Convention protects *works*, and it does not protect ideas, etc., since ideas, etc., are *not* works. Consequently, in this matter there is no difference between the requirements of the Berne Convention and the TRIPS Agreement.

31. **Article 10, entitled "Computer Programs and Compilations of Data,"** consists of two paragraphs.

32. *Computer Programs.* Paragraph 1 provides that "Computer programs, whether in source or object code, shall be protected as literary works under the Berne Convention (1971)."

33. The question arises why the TRIPS Agreement speaks of literary works.

34. There is only one provision in the Berne Convention in which the term "literary works" appears rather than the term "literary and artistic works," namely Article 11*ter* of the Convention on the public recitation of literary works (and the communication to the public of the recitation of such works). This, however, does not seem to be relevant to computer programs because computer programs are hardly susceptible of recitation.

35. It would rather seem that the reference to literary works is intended to discard any possibility of considering computer programs as artistic works and, in particular, works of applied art. Works of applied art have, under the Berne Convention, a minimum term of protection that is shorter (25 years) than the general term of protection (50 years), and their protection is subject to reciprocity (see Berne Convention, Articles 2(7) and 7(4)).

36. The Berne Convention does not mention computer programs. However, it is generally believed that it covers them since the Berne Convention provides that it applies to "every production in the literary, scientific and artistic domain, whatever may be the mode or form of

its expression" (Article 2(1)) and that a computer program is a production in the literary domain. Presumably, it was still considered safer by the authors of the TRIPS Agreement not to rely only on this interpretation of the Berne Convention but to provide in the TRIPS Agreement *expressis verbis* for the protection (as literary works) of computer programs.

37. Consequently, States party to the Berne Convention and the TRIPS Agreement whose national copyright laws do not mention computer programs among protected works would be well advised if they would complete their laws accordingly.

38. *Compilations of Data.* Paragraph 2 of Article 10 of the TRIPS Agreement provides that "Compilations of data or other material, whether in machine readable or other form, which by reason of the selection or arrangement of their contents constitute intellectual creations shall be protected as such. Such protection, which shall not extend to the data or material itself, shall be without prejudice to any copyright subsisting in the data or material itself."

39. It is to be noted that the TRIPS Agreement provides that compilations of data and other material must be protected "as such." It is not said that such compilations must be protected as works. But this can be assumed since the provision appears in that part of the TRIPS Agreement which deals with copyright (rather than related rights).

40. This assumption can also be based on the fact that Article 10, paragraph 2 of the TRIPS Agreement uses some basic elements of the language of Article 2(5) of the Berne Convention. It is a kind of adapted version of the latter, but the key words--"which, by reason of the selection [and] [or] arrangement of their contents, constitute intellectual creations, shall be protected as such"--are the same. This seems to be a sufficiently clear indication that what is meant under Article 10, paragraph 2 of the TRIPS Agreement is the same as what is meant under Article 2(5) of the Berne Convention, namely that these "intellectual creations" are to be protected as works under the Berne Convention, and, because no specific status of such works is referred to, they are to be protected under the general provisions of the Convention concerning "literary and artistic works."

41. The "contents," the selection and/or arrangement of which may constitute "intellectual creations," are different in the two provisions: in the case of Article 2(5) of the Berne Convention, the contents must be "literary and artistic works," while, in the case of Article 10, paragraph 2 of the TRIPS Agreement, the contents are "data or other material." This does not seem to mean, however, that the latter provision provides for the protection of productions that are not protected under the Berne Convention: In the case of collections or compilations, it is not their contents what is the subject matter of protection but the intellectual creation consisting of the selection and/or arrangement of the contents. Since, under Article 2(1) of the Berne Convention, every production in the literary, scientific and artistic domain is protected as a literary and/or artistic work, any production consisting of the original selection of data and/or other material not protected by copyright (the same kind of creation as the one in respect of which Article 2(5) of the Berne Convention clarifies that it is also protected as a literary and/or artistic work) is also protected--although not under Article 2(5), but under Article 2(1) of the Berne Convention--as a literary and/or artistic work.

42. Consequently, as far as compilations of data and other material are concerned, there seems to be no substantive difference between the requirements of the TRIPS Agreement and

the Berne Convention, notwithstanding the fact that there are differences between the texts of the said Agreement and Convention in this respect.

43. **Article 11, entitled " Rental Rights,"** provides a rule (in its first sentence) and two exceptions to that rule (in the second and third sentences).

44. The rule is as follows: "In respect of at least computer programs and cinematographic works, a Member shall provide authors and their successors in title the right to authorize or prohibit the commercial rental to the public of originals or copies of their copyright works."

45. The first exception is qualified and conditional. It covers cinematographic works. It reads as follows: "A Member shall be excepted from this obligation in respect of cinematographic works unless such rental has led to widespread copying of such works which is materially impairing the exclusive right of reproduction conferred in that Member on authors and their successors in title." In other words, whether a rental right of cinematographic works is to be recognized depends on the factual situation in the country or other Member of WTO: if the commercial rental has led to widespread unauthorized copying, the rental right must be recognized; if the commercial rental has not led to widespread unauthorized copying, the rental right need not be recognized.

46. The second exception concerns computer programs. It reads as follows: "In respect of computer programs, this obligation [that is, the obligation of providing for a right to authorize or prohibit commercial rental] does not apply to rentals where the program itself is not the essential object of the rental." This seems to mean that when what is rented is something that mainly consists of an object other than a protected computer program and when the presence of a computer program is of secondary importance or incidental, the right of rental need not be recognized.

47. The Berne Convention does not mention rental rights; therefore, the obligations referred to above are new for countries party to the Berne Convention.

48. **Article 12, entitled "Term of Protection,"** reads as follows: "Whenever the term of protection of a work, other than a photographic work or a work of applied art, is calculated on a basis other than the life of a natural person, such term shall be no less than 50 years from the end of the calendar year of authorized *publication*, or, failing such authorized publication within 50 years from the making of the work, 50 years from the end of the calendar year of *making*" (emphasis added).

49. Under the Berne Convention, the minimum term of protection is 50 years and must be calculated from the *author's death* (see Article 7(1)). However, according to the Berne Convention, in three cases, national legislations may, and in one case, must depart from this rule.

(i) In the case of a cinematographic work, the minimum term is 50 years and it may be calculated from the work's *having been made available to the public* with the consent of the author or, failing such an event, from the *making* of the cinematographic work (see Article 7(2)).

(ii) In the case of a photographic work, the minimum term is 25 years and it may be calculated from the *making* of the work (see Article 7(4)).

(iii) In the case of a work of applied art, the minimum term is 25 years and it may be calculated from the *making* of the work (see Article 7(4)).

(iv) In the case of an anonymous or pseudonymous work, the minimum term is 50 years and it must be calculated from the work's *having been made available to the public*, provided the making available was lawful; however, this rule is subject to two possible exceptions: one is that where the author discloses his identity, the 50-year term must be calculated from *the author's death*; the other is that when it is reasonable to presume that the author has been dead for 50 years, the protection may be discontinued 50 years after *the author's death* (see Article 7(3)).

50. The rules of the Berne Convention are not affected by the TRIPS Agreement as far as photographic works and works of applied art are concerned since Article 12 of the TRIPS Agreement is, according to the terms of that Article, not applicable to those works.

51. However, the rules of the Berne Convention are affected by the TRIPS Agreement in respect of cinematographic works whenever a State member of the Berne Convention makes use of the faculty of calculating the term not from the author's death but from the cinematographic work's *having been made available to the public* or, failing such event, from its *making*. Under the TRIPS Agreement, when the term is calculated on a basis other than the life of a natural person--and the case just described is such a case--the minimum term is 50 years and must be calculated "from the end of the calendar year of authorized *publication* [i.e., making available of copies] or, failing such authorized publication within 50 years from the making of the work, 50 years from the end of the calendar year of *making*" [emphasis added].

52. *Publication* is a form of *being made available to the public* (since it involves *making available copies of the work to the public*). There are, however, also other forms of making available to the public which are not covered by the notion of "publication" under Article 3(3) of the Berne Convention, since they do not involve making available copies of the work (such as public performance, broadcasting or other communication to the public). This means that, in certain cases, the minimum term of protection may be longer under the TRIPS Agreement than under the Berne Convention; namely in cases where the first lawful making available a work to the public is not through publication but in another form (such as public performance). In such a case, the 50-year term of protection starts under the Berne Convention but does not start yet under the TRIPS Agreement; under the latter, it only starts with the eventual authorized publication of the work, and, thus, ends later.

53. The same applies in respect of anonymous and pseudonymous works.

54. **Article 13, entitled "Limitations and Exceptions,"** provides that "Members shall confine limitations or exceptions to exclusive rights to certain special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder."

55. The Berne Convention contains a similar provision concerning the exclusive right of reproduction (Article 9(2)) and a number of exceptions or limitations to the same and other exclusive rights (see Articles 10, 10*bis* and 14*bis*(2)(b)) and, it permits the replacement of the exclusive right of broadcasting, and the exclusive right of recording of musical works, by non-voluntary licenses (see Articles 11*bis*(2) and 13(1)).

56. None of the limitations and exceptions permitted by the Berne Convention should, if correctly applied, conflict with the normal exploitation of the work and none of them should, if correctly applied, prejudice unreasonably the legitimate interests of the right holder.

57. Thus, generally and normally, there is no conflict between the Berne Convention and the TRIPS Agreement as far as exceptions and limitations to the exclusive rights are concerned.

58. **Article 14 is entitled "Protection of Performers, Producers of Phonograms (Sound Recordings) and Broadcasting Organizations."**

[Reserved for any future revised version of this paper]

Part II, Section 2, of the TRIPS Agreement, entitled "TRADEMARKS"

59. This Section consists of six Articles (Articles 15 to 21).

60. It is to be borne in mind that Part I of the TRIPS Agreement ("General Provisions and Basic Principles"), described at the beginning of this paper, applies also to marks and, in particular, that the provisions of the Paris Convention concerning marks must be complied with by Members of WTO (see Article 2, paragraph 1 of the TRIPS Agreement). Apart from provisions of the Paris Convention applying to all kinds of industrial property (such as national treatment (Articles 2 and 3) and grace period for the payment of fees (Article 5*bis*(1))) and which consequently apply to marks, the Paris Convention also contains provisions expressly dealing with marks, particularly on the right of priority (Article 4), on the use of the mark (Article 5C), the indication on goods of the fact that the mark is a registered mark (Article 5D), the independence of a registration of a mark in a country from the fate of the same mark in another country (Article 6), protection of well-known marks (Article 6*bis*), prohibitions concerning State emblems, etc. (Article 6*ter*), assignment of marks (Article 6*quater*), conditions of the registration of a mark which has been registered in another country (Article 6*quinquies*), protection of service marks (Article 6*sexies*), registration of a mark in the name of an agent of the proprietor (Article 6*septies*), nature of the goods or services (Article 7), collective marks (Article 7*bis*), enforcement measures (Article 9), temporary protection at certain international exhibitions (Article 11), and establishment of a special industrial property service (Article 12).

61. It is to be noted that the present paper uses the term "mark" in a sense that it covers both marks relating to goods (that is, trademarks in its narrower sense) and to marks relating to services (service marks). This terminology corresponds to that of the Trademark Law Treaty (1994), hereinafter referred to as the TLT (not yet in force at the time of writing this paper). The TRIPS Agreement uses the term "trademark" in the broader sense, that is, in the sense that it covers marks both for goods and for services.

62. **Article 15, entitled "Protectable Subject Matter,"** consists of five paragraphs dealing with the questions invoked below.

63. *Definition.* The TRIPS Agreement defines the signs that must be considered as capable of constituting a mark (paragraph 1); the Paris Convention does not contain a definition.

64. *Registrability and Priority Right.* The TRIPS Agreement requires the registrability of marks, and provides for a priority right, in respect of goods and services (paragraph 1 and Article 62, paragraph 3). The Paris Convention requires the registrability of marks, and provides for a priority right, in respect of goods but not services, although it requires that marks for services be protected (Article 6*sexies).* The TLT requires the registrability of marks, and provides for a priority right, in respect of services (Article 16).

65. *Distinctiveness.* The TRIPS Agreement states that, where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use (paragraph 1). Article 6*quinquies* B(2) of the Paris Convention, which applies to the registration of marks which have been duly registered in the country of origin, provides that a mark may be denied registration if it is devoid of any distinctive character, whereas Article 6*quinquies* C(1) requires that all factual circumstances be taken into consideration in determining whether a mark is eligible for protection, including the length of time the mark has been in use.

66. *Visually Perceptible Signs.* The TRIPS Agreement allows Members to require, as a condition of registration a mark, that a sign be visually perceptible (paragraph 1). The Paris Convention neither allows nor prohibits such a requirement. The TLT does not apply to holograms or to marks not consisting of visible signs (Article 2(1)(b)).

67. *Grounds for Denying Registration.* The TRIPS Agreement confirms that no ground for denial of a registration of a mark may "derogate" from the provisions of the Paris Convention (paragraph 2 and Article 2, paragraph 2). The Paris Convention contains an exhaustive list of the grounds on which a mark that has been registered in the country of origin may be refused protection in other countries members of the Paris Union (Article 6*quinquies* B).

68. *Use as a Requirement for Filing an Application.* Under the TRIPS Agreement, Members may not require use as a condition for filing an application for registration (paragraph 3). The Paris Convention is silent on this question, but the TLT does not allow use as a requirement for the filing of an application for registration (Article 3).

69. *Use as a Requirement for Registration.* The TRIPS Agreement allows Members to make registrability dependent on use of the mark, but an application for registration may not be rejected merely because the mark has not been used within three years after the filing date (paragraph 3). The Paris Convention does not expressly deal with this issue, but Article 6*quinquies*B contains an exhaustive list of grounds for denial of a registration based on the registration of the mark in the country of origin, which does not include non-use.

70. *Nature of the Goods or Services.* The TRIPS Agreement provides that the nature of the goods or services to which a mark is to be applied cannot be an obstacle to the registration of

the mark (paragraph 4). The Paris Convention contains the same rule in respect of marks concerning goods (Article 7). The TLT extends this rule to marks concerning services (Article 16).

71. *Publication.* The TRIPS Agreement provides that "Members shall publish each trademark either before it is registered or promptly after it is registered..." (paragraph 5). The Paris Convention requires the publication of "the reproductions of registered trademarks" (Article 12(2)(b)). It would seem, therefore, that publication only before registration, without at least a published reference to the mark (for goods) after registration, would not be sufficient in the case of Members of WTO that are party also to the Paris Convention.

72. *Cancellation.* The TRIPS Agreement provides that Members must "afford a reasonable opportunity for petitions to cancel the registration" of a mark (paragraph 5). The Paris Convention is silent on the matter, but most countries party to the Paris Convention provide for the possibility of petitioning the cancellation of the registration of a mark.

73. *Opposition.* The TRIPS Agreement provides that "In addition [i.e., in addition to the possibility of asking for cancellation], Members *may* afford an opportunity for the registration of a trademark to be opposed" (paragraph 5; emphasis added). The Paris Convention is silent on the possibility of opposition, but many States party to the Paris Convention provide for such a possibility.

74. **Article 16, entitled "Rights Conferred,"** consists of three paragraphs. Paragraph 1 deals with the rights of the owner of any registered mark, whereas paragraphs 2 and 3 deal with well-known marks.

75. *Rights in a Registered Mark.* The TRIPS Agreement provides for the exclusive right to use by the owner of the registration (paragraph 1). It also allows Members to make rights available on the basis of use (rather than registration) (paragraph 1). The Paris Convention is silent on these matters.

76. *Rights in Well-Known Marks.* Article 6*bis* of the Paris Convention contains detailed rules on the protection of well-known marks for goods. The TRIPS Agreement makes these rules also applicable to well-known marks for services (paragraph 2). The TLT extends the application of Article 6*bis* of the Paris Convention to service marks (Article 16).

77. Furthermore, whereas the Paris Convention requires that the mark be considered well known by the competent authority of the country of registration or use (see Article 6*bis*(1)), the TRIPS Agreement obliges Members also to "take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark" (paragraph 2). The Paris Convention is silent on knowledge in the relevant sector of the public and on knowledge resulting from publicity.

78. Finally, whereas the Paris Convention protects well-known marks in respect of "identical or similar goods," that is, goods that are identical with or similar to the goods for which the well-known mark is registered or used (see Article 6*bis*(1)), the TRIPS Agreement provides, in

special circumstances, for the protection of well-known marks in respect also of non-similar goods or services (paragraph 3).

79. **Article 17, entitled "Exceptions,"** stipulates that "Members may provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided that such exceptions take account of the legitimate interests of the owner of the trademark and of third parties." Since, as already stated, the Paris Convention does not, whereas the TRIPS Agreement does, contain rules concerning the rights of the owner of the mark, it is only logical that the Paris Convention does not contain a provision on exceptions to rights.

80. **Article 18, entitled "Term of Protection,"** provides in its first sentence that "Initial registration, and each renewal of registration, of a trademark shall be for a term of no less than seven years." The Paris Convention has no corresponding rule. According to the TLT, the duration of each term is 10 years (Article 13(7)).

81. The second sentence of the said Article of the TRIPS Agreement provides that "The registration of a trademark shall be renewable indefinitely." The Paris Convention contains no corresponding rule, but all States party to the Paris Convention allow the renewal of registrations indefinitely.

82. **Article 19 is entitled "Requirement of Use."** Neither the Paris Convention nor the TRIPS Agreement require, but both allow, that non-use be sanctioned by the cancellation of the registration of the mark (see Article 5C(1) of the Paris Convention and the first sentence of Article 19, paragraph 1, of the TRIPS Agreement). Where use is required, and the mark is not used, its registration may be cancelled, under the TRIPS Agreement, "only after an uninterrupted period of at least three years of non-use" (Article 19, paragraph 1); under the Paris Convention, "only after a reasonable period [of non-use]" (Article 5C(1)). Both treaties provide for the possibility of justifying the non-use (see the same Articles), which justification prevents cancellation.

83. **Article 20, entitled "Other Requirements,"** prohibits any unjustifiable encumbering of the use of a mark. There is no provision to the same effect in the Paris Convention.

84. **Article 21 is entitled "Licensing and Assignment."** Under the Paris Convention, a country may require that the assignment of a registration be accompanied by the transfer of the corresponding business or goodwill (Article 6*quater*(1)). Under the TRIPS Agreement, concurrent transfer of the business may not be required (Article 21).

85. The same Article of the TRIPS Agreement also provides that the compulsory licensing of trademarks is not permitted. The Paris Convention is silent on this question but, as far as verifiable, none of the States party to it permit compulsory licensing.

Part II, Section 3, of the TRIPS Agreement, entitled "GEOGRAPHICAL INDICATIONS"

86. This Section consists of three Articles (Articles 22, 23 and 24).

87. It is to be borne in mind that Part I of the TRIPS Agreement (General Provisions and Basic Principles), described at the beginning of this paper, applies also to geographical indications and, in particular, that the provisions of the Paris Convention concerning "indications of source and appellations of origin" (notions that encompass geographical indications) must be complied with by Members of WTO (see Article 2, paragraph 1 of the TRIPS Agreement). Apart from provisions of the Paris Convention applying to all kinds of industrial property (such as national treatment (Articles 2 and 3)) and which consequently apply to indications of source and appellations of origin, the Paris Convention contains provisions expressly dealing with indications of source and appellations of origin, particularly on seizure of goods bearing false indications as to their source or the identity of the producer (Article 10) and on remedies and the right to sue (Article 10*ter*). Article 10*bis* on unfair competition is also relevant in respect of geographical indications. It is to be noted that there are two special treaties concerning appellations of origin administered by WIPO and open only to countries party to the Paris Convention. They are the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods (1891) and the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (1958). Hereafter, they are referred to as "the Madrid (Indications of Source) Agreement" and "the Lisbon Agreement," respectively. In July 1995, the number of the States party to the first was 31 and to the second was 17. No reference is made to either of these two Agreements in the TRIPS Agreement.

88. **Article 22, entitled "Protection of Geographical Indications,"** deals with the following matters.

89. *Definition.* According to the TRIPS Agreement, geographical indications are "indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin" (paragraph 1). The Paris Convention contains no definition of "geographical indications"; in fact, it uses different terms, "indications of source" and "appellations of origin" (see Article 1(2)), which it does not define. The Lisbon Agreement defines appellations of origin as the "geographical name of a country, region, or locality, which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographic environment, including natural and human factors" (Article 2(1)), and states that the country of origin is the "country whose name, or the country in which is situated the region or locality whose name, constitutes the appellation of origin which has given the product its reputation" (Article 2(2)). The Madrid (Indications of Source) Agreement speaks of "goods bearing a false or deceptive indication by which one of the countries to which this Agreement applies, or a place situated therein, is directly or indirectly indicated as being the country or place of origin" (Article 1(1)).

90. *Misleading, False or Deceptive Acts.* According to the TRIPS Agreement, Members must provide "the legal means for interested parties to prevent ... the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good" (paragraph 2(a)).

91. The Paris Convention provides for seizure "in cases of direct or indirect use of a false indication of the source of the goods" (Article 10(1)). (The same provision in the Paris Convention also provides for seizure in cases of direct or indirect use of "the identity of the producer, manufacturer or merchant"; in such a case, the false indication concerns something else than a geographical indication.)

92. The Madrid (Indications of Source) Agreement provides that "all goods bearing a false or deceptive indication by which one of the countries to which this Agreement applies, or a place situated therein, is directly or indirectly indicated as being the country or place of origin shall be seized upon importation into any of the said countries" (Article 1(1)), and that "Seizure shall also be effected in the country where the false or deceptive indication of source has been applied, or into which the goods bearing the false or deceptive indication have been imported" (Article 1(2)).

93. *Unfair Competition.* According to the TRIPS Agreement, Members must provide "the legal means for interested parties to prevent [in respect of geographical indications] ... any use which constitutes an act of unfair competition within the meaning of Article 10*bis* of the Paris Convention (1967)" (paragraph 2(b)). The Paris Convention states that "Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition" (Article 10*bis* (2)). Among the examples given in paragraph (3) of that Article, the following seems to be of particular relevance for geographical indications: "all acts of such a nature as to create confusion by any means whatever with the ... goods ... of a competitor" (item 1), "false allegations in the course of trade of such a nature as to discredit the ... goods ...of a competitor" (item 2) and "indications ... the use of which in the course of trade is liable to mislead the public as to the nature, ... [or] the characteristics ... of the goods" (item 3).

94. *Misleading Marks.* The TRIPS Agreement provides for the refusal or invalidation of the registration of a mark "which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in that Member is of such a nature as to mislead the public as to the true place of origin" (paragraph 3).

95. The Paris Convention expressly permits the denial or the invalidation of the registration of a mark based on registration in the country of origin where the mark is "of such a nature as to deceive the public" (Article 6*quinquies* B.3).

96. *Literally True but Misleading Indications.* The TRIPS Agreement states that the protection for geographical indications must be applied even when the geographical indication is "literally true as to the territory, region or locality in which the goods originate, [but] falsely represents to the public that the goods originate in another territory" (paragraph 4).

97. **Article 23, entitled "Additional Protection for Geographical Indications for Wines and Spirits,"** deals with the following matters.

98. *Indications Accompanied by True Indication, Translation or "Kind," etc.* The TRIPS Agreement requires the prevention of the use of a geographical indication identifying wines or spirits not originating in the place indicated by the geographical indication, even where the

indication of the true origin of the wine or spirit is also indicated, or the geographical indication is used in translation, or the geographical indication is accompanied by expressions such as "kind," "type," "style," "imitation" or in the like (see paragraph 1).

99. The Paris Convention contains no corresponding provisions. However, the Lisbon Agreement states that protection must be ensured against usurpation or imitation of the geographical indication even if the true origin of the product (which may be wine or spirit) is indicated or if the appellation is used in translated form or is accompanied by terms such as "kind," "type," "make," "imitation," or the like (Article 3).

100. *Trademarks and Homonyms.* The TRIPS Agreement contains special provisions for wines and spirits also in connection with trademarks and homonymous indications (paragraphs 2 and 3). There are no provisions in the Paris Convention which would strictly correspond to those provisions.

101. *Notification and Registration System for Wines.* The TRIPS Agreement provides that "In order to facilitate the protection of geographical indications for wines, negotiations shall be undertaken in the Council for TRIPS concerning the establishment of a multilateral system of notification and registration of geographical indications for wines eligible for protection in those Members participating in the system" (paragraph 4). It would seem that the contemplated system will not necessarily apply to all the Members of WTO. It is recalled that the Lisbon Agreement provides for the registration of appellations of origin applying to the "geographical name of a country, region, or locality, which serves to designate a product [not only wines] originating therein, the quality and characteristics of which are due exclusively or essentially to the geographic environment, including natural and human factors" (Article 2). Such names are registered by the International Bureau of WIPO in Geneva. Up to January 1, 1995, 730 registrations for appellations of origin had been obtained, out of which 717 were still in force; of those, 482 concerned, or concerned also, wines.

102. **Article 24, entitled "International Negotiations; Exceptions,"** deals with certain matters proper to WTO, for which the Paris Convention contains no corresponding provisions. In addition, that Article contains provisions regarding non-diminution of rights (paragraph 3), prior use or registration (paragraphs 4 and 5), genericness (paragraph 6), adverse use (paragraph 7), use of a person's name (paragraph 8) and the effect of lack of protection or use in the country of origin (paragraph 9). It should be noted that Article 6 of the Lisbon Agreement states that an appellation of origin which has been granted protection, on the basis of an international registration under the Lisbon Agreement, in one of the countries party to the Lisbon Agreement cannot, in that country, be deemed to have become generic, as long as it is protected as an appellation of origin in the country of origin.

Part II, Section 4, of the TRIPS Agreement, entitled "INDUSTRIAL DESIGNS"

103. This Section consists of two Articles (Articles 25 and 26).

104. It is to be borne in mind that Part I of the TRIPS Agreement (General Provisions and Basic Principles), described at the beginning of this paper, applies also to industrial designs and, in particular, that the provisions of the Paris Convention concerning industrial designs

must be complied with by Members of WTO (see Article 2, paragraph 1 of the TRIPS Agreement). Apart from provisions of the Paris Convention applying to all kinds of industrial property (such as national treatment (Articles 2 and 3) and grace period for the payment of fees (Article 5*bis*(1))) and which consequently apply to industrial designs, the Paris Convention also contains provisions expressly dealing with industrial designs, particularly on the obligation to protect industrial designs (Article 5*quinquies*), on the right of priority (Article 4), on failure to work an industrial design (Article 5B), on the importation of articles constituting or containing an industrial design (Article 5B), on the indication upon the goods enjoying industrial design protection of the fact that an industrial design has been deposited (Article 5D), on temporary protection at certain international exhibitions (Article 11) and on establishment of a special industrial property service (Article 12).

105. **Article 25, entitled "Requirements for Protection,"** deals with the following matters.

106. *Obligation of Protection.* The TRIPS Agreement (paragraph 1), like the Paris Convention (Article 5*quinquies)*, requires the protection of industrial designs.

107. *Conditions of Protection.* According to the TRIPS Agreement, an industrial design which is "independently created" and "new or original" must be protected (paragraph 1). The TRIPS Agreement also states that a design need not be regarded as new or original if it does not "significantly differ from known designs or combinations of known design features" (*ibid.)*. It also allows denial of protection where the design is "dictated essentially by technical or functional considerations" (*ibid.)*. The Paris Convention has no provisions to these effects.

108. *Textile Designs.* The TRIPS Agreement contains special provisions on textile designs (paragraph 2). It requires Members to "ensure that requirements for securing protection for textile designs, in particular in regard to any cost, examination or publication, do not unreasonably impair the opportunity to seek and obtain such protection." The Paris Convention contains no corresponding provisions. The TRIPS Agreement also provides that the said obligation concerning the protection of textile designs can be met by Members "through industrial design law or through copyright law" (*ibid.*). It would seem that, if a Member provides for protection through copyright, the requirements concerning cost, examination or publication simply disappear since the Berne Convention disallows any formality (and the costs caused by formalities), whereas the other provisions of the TRIPS Agreement concerning designs and the incorporation by reference, into the TRIPS Agreement, of the provisions of the Paris Convention concerning industrial designs become inapplicable and are replaced by what is provided for in the TRIPS Agreement concerning copyright, including the incorporation by reference, into the TRIPS Agreement, of the substantive provisions of the Berne Convention (except the latter's Article 6*bis*).

109. **Article 26, entitled "Protection,"** deals with the following matters.

110. *Rights.* The TRIPS Agreement specifies the rights in an industrial design (paragraph 1) and the possible exceptions to such rights (paragraph 2). The Paris Convention does not contain comparable provisions, but it provides that protection of an industrial design cannot be lost by reason of failure to work (the industrial design in the territory of the State in which it is protected) or by reason of the importation (into the territory of such a State) of articles corresponding to those which are protected (in that State) (see Article 5B). These provisions

of the Paris Convention also bind Members of WTO which are not party to the Paris Convention; this follows from Article 2, paragraph 1 of the TRIPS Agreement.

111. *Term of Protection.* The TRIPS Agreement provides that the duration of protection available for an industrial design is at least ten years (paragraph 3). The Paris Convention contains no provision on the duration of the protection, but those States party to the Paris Convention which are also party to the 1960 Act of the Hague Agreement Concerning the International Deposit of Industrial Designs must make protection for internationally deposited and renewed industrial designs available for at least ten years (Article 11(1)(a)(1960)), while those States party to the Paris Convention which are also party to the 1934 Act of the Hague Agreement must provide for a duration of protection of 15 years from the date of deposit at the International Bureau (Article 7).

Part II, Section 5, of the TRIPS Agreement, entitled "PATENTS"

112. This Section consists of eight Articles (Articles 27 to 34).

113. It is to be borne in mind that Part I of the TRIPS Agreement (General Provisions and Basic Principles), described at the beginning of this paper, applies also to patents and, in particular, that the provisions of the Paris Convention concerning patents must be complied with by Members of WTO (see Article 2, paragraph 1 of the TRIPS Agreement). Apart from provisions of the Paris Convention applying to all kinds of industrial property (such as national treatment (Articles 2 and 3) and grace period for the payment of fees (Article 5*bis*(1))) and which consequently apply to patents, the Paris Convention also contains provisions expressly dealing with patents, particularly on the right of priority (Articles 4A, B, C, D, F and H), on the division of a patent application (Article 4G), on the independence of a patent application filed or of a patent obtained in a country from the patent applications filed or patents obtained for the same invention in other countries (Article 4*bis*), on the right of the inventor to be mentioned as the inventor in the patent granted for his invention (Article 4*ter*), on the independence of patent grants and renewals from any restriction on the sale of the patented product or process (Article 4*quater*), on the independence of a patent in a country in which it has been granted from any importation into that country of articles manufactured in another country (Article 5A(1)), on the possibilities and conditions of granting compulsory licenses and forfeiture (Article 5A(2) to (4)), on the indication upon the goods enjoying patent protection of the fact that a patent has been granted (Article 5D), on the presence of patented devices forming part of vessels, aircraft or land vehicles (Article 5*ter*), on the importation of products manufactured by a process patented in the importing country (Article 5*quater*), on temporary protection at certain international exhibitions (Article 11) and on establishment of a special industrial property service (Article 12).

114. **Article 27, entitled "Patentable Subject Matter,"** deals with the following matters.

115. *Inventions for Which Patents Must Be Available.* According to the TRIPS Agreement and subject to certain exceptions or conditions, patents must be available for "any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application," and patents must be available (and patent rights must be enjoyable) "without discrimination as to the place of invention, the field

of technology and whether products are imported or locally produced" (paragraph 1). These provisions have no corresponding provisions in the Paris Convention.

116. *Inventions Which May Be Excluded From Patentability.* According to the TRIPS Agreement, "Members may exclude from patentability inventions, the prevention within their territory of the commercial exploitation of which is necessary to protect *ordre public* or morality, including to protect human, animal or plant life or health or to avoid serious prejudice to the environment, provided that such exclusion is not made merely because the exploitation is prohibited by their law" (paragraph 2). According to another provision of the same Article, "Members may also exclude from patentability (a) diagnostic, therapeutic and surgical methods for the treatment of humans or animals; (b) plants and animals other than micro-organisms, and essentially biological processes for the production of plants or animals other than non-biological and microbiological processes" (paragraph 3).

117. The Paris Convention has no provision corresponding to the above quoted TRIPS provisions and needs none: since it does not stipulate for which inventions patents must be granted, it need not stipulate the inventions for which patents do not have to be granted.

118. It is to be noted that the TRIPS Agreement allows any developing country Member to delay the application of the provisions of the TRIPS Agreement concerning patents for products (*not* for processes) if the subject matter of the invention falls in an area of technology not patentable according to that Member's laws when the TRIPS Agreement comes into effect in that Member. An example of such an area of technology is pharmaceutical technology. Such a delay may be five years, added to the four-year general delay granted to developing countries and the one-year delay granted to all Members, for a total of ten years. A least-developed country is entitled to a general transitional period of 11 years (the additional five year delay for product patents does not apply), which the Council for TRIPS will extend upon duly motivated request. Naturally, any interested country is entitled not to make use of these delays. For the statements made in this paragraph, see Articles 65 and 66 of the TRIPS Agreement.

119. It is to be further noted that the TRIPS Agreement provides, in respect of pharmaceutical and agricultural chemical products, important qualifications of, and derogations to, what is said in the preceding paragraph (see Article 70 (entitled "Protection of Existing Subject Matter"), paragraphs 8 and 9).

120. In particular, any Member that does not make available as of the date of entry into force of the WTO Agreement (that is, January 1, 1995) patent protection for pharmaceutical and agricultural chemical products as provided for in Article 27 of the TRIPS Agreement, must do the following: it must accept the filing, with its national patent office, of applications for patents for such products, and it must do so from January 1, 1995, even if it is a country which may delay (as indicated above) the application of the (other provisions of the) TRIPS Agreement for a certain number of years (as indicated above); once the TRIPS Agreement becomes applicable in the Member (that is, where a country could and did benefit from a delay of a certain number of years, then from the expiration of that delay and, in particular, from the expiration of the additional five year delay for product patents mentioned above, if any), it must take a decision in respect of the application (i.e., either reject it or grant a patent) but, in doing so, it must apply (retroactively) the criteria of patentability as laid down in the TRIPS

Agreement; if its decision is to grant a patent, that patent will be available "for the remainder of the patent term" (see Article 70, paragraph 8). This term is at least 20 years from the filing of the application (see Article 33), and the "remainder" of it will be the period which starts on the day the patent is granted and ends on the day the said (at least) 20 years expire. However, "an exclusive marketing right" must be granted by the Member to the invention which is the subject matter of the said application if, after January 1, 1995, in *another* Member--for the same product--a patent application has been filed, a patent has been granted and marketing approval has been obtained. Such a marketing right in the Member will be in force from the date of the obtention of the marketing approval in the Member itself and will end when the Member has rejected or granted the patent application filed in the Member, except that when the rejection or grant happens later than five years after obtaining marketing approval in the Member, then the marketing right in the Member will expire five years after the marketing approval was given in the Member (see Article 70, paragraph 9).

121. *Plant Varieties.* The TRIPS Agreement provides that "Members shall provide for the protection of plant varieties either by patents or by an effective *sui generis* system or by any combination thereof" (Article 27, paragraph 3(b)). The Paris Convention contains no provisions concerning plant varieties. The International Convention for the Protection of New Plant Varieties (1961, revised in 1972, 1978 and 1991, commonly called "the UPOV Convention") provides for a *sui generis* system, and the laws of any State wishing to be party to the UPOV Convention must be found, by the Council of UPOV, to conform with the provisions of the Convention (Article 34(3)).

122. **Article 28, entitled "Rights Conferred,"** deals with the following matters.

123. *Exclusive Rights.* This Article enumerates the exclusive rights that a patent confers on its owner (paragraph 1). The Paris Convention contains no corresponding provision, but the national laws of the States members of that Convention generally protect the same rights.

124. *Change in Ownership; Licensing.* The TRIPS Agreement provides that patent owners "have the right to assign, or transfer by succession, the patent and to conclude licensing contracts" (paragraph 2). The Paris Convention contains no corresponding provision, but these rights are generally recognized in the States members of that Convention.

125. **Article 29, entitled "Conditions on Patent Applicants,"** deals with the following matters.

126. *Disclosure.* The TRIPS Agreement provides that "Members shall require that an applicant for a patent shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art and may require the applicant to indicate the best mode for carrying out the invention known to the inventor at the filing date or, where priority is claimed, at the priority date of the application" (paragraph 1). For all practical purposes, the same result is accomplished by the corresponding provision in the Patent Cooperation Treaty (1970), hereinafter referred to as the PCT (a WIPO-administered treaty concluded 24 years earlier than the TRIPS Agreement to which 81 of the States party to the Paris Convention belonged on July 31, 1995) (Article 5; Rule 5.1(a)(v)). The Paris Convention has no corresponding provision.

127. *Corresponding Foreign Applications and Grants.* The TRIPS Agreement provides that "Members may require an applicant for a patent to provide information concerning the applicant's corresponding foreign applications and grants" (paragraph 2). The Paris Convention allows countries party to that Convention to "require any person making a declaration of priority [that is, the applicant] to produce a copy of the application (description, drawings, etc.) previously filed" (Article 4D(3)). The main differences between the two provisions are that the Paris Convention speaks about "a copy" of the priority application, whereas the TRIPS Agreement speaks about "information" concerning *any* corresponding foreign application and *patent.*

128. **Article 30, entitled "Exceptions to Rights Conferred,"** reads as follows: "Members may provide limited exceptions to the exclusive rights conferred by a patent, provided that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties." The Paris Convention has no corresponding provisions and needs none: since it does not contain provisions on exclusive rights, it need not stipulate exceptions from such rights.

129. **Article 31 is entitled "Other Use Without Authorization of the Right Holder."** Both the TRIPS Agreement (in its Article 31) and the Paris Convention (in its Article 5A(2) and (4)) contain detailed and relatively long provisions on the possibility of government authorities granting (in the case of the TRIPS Agreement, subject to the possibility of judicial review) licenses to use a patented invention without the authorization of the owner of the patent. These licenses are called "compulsory" in the Paris Convention. Some of the provisions of the two treaties are similar but others deal with different questions. Since the TRIPS Agreement provides that Members must comply with Articles 1 through 12 of the Paris Convention--and Article 5A (2) and (4) dealing with compulsory licenses is among them--the safest course seems to be to incorporate in the national laws the conditions of both treaties and to follow, in respect of each case of a compulsory license, the relevant provisions of *both* treaties.

130. **Article 32, entitled "Revocation/Forfeiture,"** reads as follows: "An opportunity for judicial review of any decision to revoke or forfeit a patent shall be available." There is no corresponding provision in the Paris Convention.

131. **Article 33, entitled "Term of Protection,"** reads as follows: "The term of protection available shall not end before the expiration of a period of twenty years counted from the filing date." There is no corresponding provision in the Paris Convention.

132. **Article 34, entitled "Process Patents: Burden of Proof,"** deals with the burden of proof in civil proceedings in respect of the alleged infringement of the patent rights concerning a patent which is for a process for obtaining a product ("process patent"). There is no corresponding provision in the Paris Convention.

Part II, Section 6, of the TRIPS Agreement, entitled "LAYOUT-DESIGNS (TOPOGRAPHIES) OF INTEGRATED CIRCUITS"

133. This Section consists of four Articles (Articles 35 to 38).

134. It is to be borne in mind that Part I of the TRIPS Agreement (General Provisions and Basic Principles), described at the beginning of this paper, applies also to layout-designs (topographies) of integrated circuits.

135. The Paris Convention does not contain provisions specifically dealing with layout-designs (topographies) of integrated circuits.

136. **Article 35, entitled "Relation to the IPIC Treaty,"** partly incorporates the IPIC Treaty into the TRIPS Agreement.

137. "IPIC Treaty" stands for "Treaty on Intellectual Property in Respect of Integrated Circuits." The IPIC Treaty was adopted by a Diplomatic Conference organized by WIPO in Washington in 1989. The Treaty has not yet entered into force as of July 31, 1995.

138. *Incorporation, by Reference, of Parts of the IPIC Treaty.* The Article in question of the TRIPS Agreement provides that "Members agree to provide protection to the layout-designs (topographies) of integrated circuits (referred to in this [the TRIPS] Agreement as "layout-designs") in accordance with Articles 2 through 7 (other than paragraph 3 of Article 6), Article 12 and paragraph 3 of Article 16 of the Treaty on Intellectual Property in Respect of Integrated Circuits and, in addition, to comply with the following provisions [that is, Articles 36, 37 and 38 of the TRIPS Agreement]."

139. The provisions of the IPIC Treaty which Members of WTO have to apply deal with the following matters: definitions, including the definitions of the concepts of "integrated circuits" and "layout-design (topography)" (Article 2), the obligation to protect layout-designs (topographies) of integrated circuits (Article 3), the legal form of the protection (*sui generis* or industrial property or copyright) (Article 4), national treatment (Article 5), acts requiring, and acts not requiring, the authorization of the holder of the right (Article 6(1) and (2)), sale and distribution of infringing integrated circuits acquired innocently (Article 6(4)), exhaustion of rights (Article 6(5)), faculty to require exploitation and/or registration (Article 7), the safeguard of the obligations that Contracting Parties may have under the Paris and/or Berne Conventions (Article 12), and non-retroactivity (Article 16(3)).

140. *Exclusion of Parts of the IPIC Treaty.* The substantive provisions of the IPIC Treaty which are excluded from the TRIPS Agreement are the provisions concerning compulsory licenses (Article 6(3)) and the duration of the protection (Article 8). The latter reads as follows: "Protection shall last at least eight years."

141. **Article 36, entitled "Scope of the Protection,"** resembles very much Article 6(1)(a)(ii) of the IPIC Treaty, except that Article 36 of the TRIPS Agreement also extends protection to articles incorporating an integrated circuit which, in turn, incorporates a protected layout-design. The title of Article 6 of the IPIC Treaty is "The Scope of Protection," and the title of paragraph (1) of that Article is "Acts Requiring the Authorization of the Holder of the Right." Those acts, in both treaties, are reproduction (incorporated by reference into the TRIPS Agreement), importing, selling and otherwise distributing for commercial purposes.

142. **Article 37 is entitled "Acts Not Requiring the Authorization of the Right Holder."** Paragraph 1 resembles Article 6(4) of the IPIC Treaty, except that Article 37 of the TRIPS Agreement also refers to articles incorporating an integrated circuit which in turn incorporates a protected layout-design, and provides, in the case of infringing layout-designs acquired innocently, that stock on hand or ordered before sufficient notice of infringement was given may be imported, sold or distributed upon payment of a reasonable royalty to the right holder.

143. Paragraph 2 of Article 37 deals with the question of compulsory licenses, a question dealt with in the IPIC Treaty in a provision (Article 6(3)) not incorporated into the TRIPS Agreement, as mentioned above. The question is differently regulated in the two treaties, the main difference being that the TRIPS Agreement, as far as layout-designs (topographies) of integrated circuits are concerned, allows compulsory licenses only for public non-commercial use or to remedy an anti-competitive practice, subject to detailed procedural requirements (see Article 37, paragraph 2, which incorporates, *mutatis mutandis*, Article 31, dealing with compulsory licenses in the case of patents), while the IPIC treaty would, if it entered into force, allow compulsory licenses (subject to less detailed procedural requirements) where "necessary to safeguard a national purpose deemed to be vital by the granting authority"(Article 6(3)(a)) or "in order to secure free competition and to prevent abuses by the holder of the right" (Article 6(3)(b)).

144. **Article 38, entitled "Term of Protection,"** replaces the eight-year minimum term under Article 8 of the IPIC Treaty with a 10-year minimum term. There are detailed rules on the starting point of those 10 years. The TRIPS Agreement also provides that, in any case, "a Member may provide that protection shall lapse 15 years after the creation of the layout-design" (paragraph 3).

Part II, Section 7, of the TRIPS Agreement, entitled "PROTECTION OF UNDISCLOSED INFORMATION"

145. This Section consists of one Article **(Article 39)**.

146. It is to be borne in mind that Part I of the TRIPS Agreement (General Provisions and Basic Principles), described in the beginning of this paper, applies also to "undisclosed information" (term used in the title of the Section).

147. The Paris Convention does not contain provisions expressly dealing with protection of undisclosed information, but Article 10*bis* on unfair competition requires protection against any act of competition contrary to honest practices in industrial or commercial matters.

148. *Reference to the Paris Convention.* The TRIPS Agreement links the protection of undisclosed information to the Paris Convention, treating such protection as a special case of protection against unfair competition. This is expressed in the following way in the TRIPS Agreement: "In the course of ensuring effective protection against unfair competition as provided in Article 10*bis* of the Paris Convention (1967), Members shall protect undisclosed information in accordance with paragraph 2 and data submitted to governments or governmental agencies in accordance with paragraph 3" (paragraph 1).

149. *Protected Subject Matter.* The protected subject matter is information lawfully within the control of a natural or legal person that is secret, that has commercial value because it is secret and that has been subject to reasonable steps under the circumstances, by the person lawfully in control of the information, to keep it secret (paragraph 2). Such information is sometimes called a "trade secret," but this expression is not used in the TRIPS Agreement. "Secret" is defined as "secret in the sense that it [the information] is not, as a body or in the precise configuration and assembly of its components, generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question" (paragraph 2(a)).

150. *Protection.* The protection consists of offering to natural and legal persons "the possibility of preventing information lawfully within their control from being disclosed to, acquired by, or used by others without their consent in a manner contrary to honest commercial practices so long as such information" corresponds to the criteria indicated above (paragraph 2).

151. Examples of disclosing "in a manner contrary to honest commercial practices" are given in footnote 10 to paragraph 2 (breach of contract; breach of confidence; inducement to breach; acquisition of undisclosed information by third parties who knew, or were grossly negligent in failing to know, that practices contrary to honest commercial practices were involved in the acquisition). Paragraph 3 contains specific provisions concerning the protection of test data relating to pharmaceutical and agricultural chemical products.

Part II, Section 8 of the TRIPS Agreement, entitled "CONTROL OF ANTI-COMPETITIVE PRACTICES IN CONTRACTUAL LICENSES"

152. This Section consists of one Article **(Article 40)** whose first paragraph reads as follows: "Members agree that some licensing practices or conditions pertaining to intellectual property rights which restrain competition may have adverse effects on trade and may impede the transfer and dissemination of technology." The provisions of this Article authorize Members to legislate and take other measures against abuses of intellectual property rights (see paragraph 2), and provide for obligatory consultations between Members, upon request of either, where a national of one Member is accused of engaging in anti-competitive practices in the jurisdiction of the other Member (see paragraphs 3 and 4).

153. There are no corresponding provisions on this matter in the Paris Convention.

Part III of the TRIPS Agreement, entitled "ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS"

154. This Part of the TRIPS Agreement consists of five Sections (General Obligations, Civil and Administrative Procedures and Remedies, Provisional Measures, Special Requirements Related to Border Measures, Criminal Procedures) and 21 Articles **(Articles 41 to 61)**. They regulate in great detail the obligations of Members in the field of the enforcement of intellectual property rights.

155. The corresponding provisions of the Berne Convention (Articles 15 and 16) and of the Paris Convention (Articles 9, 10 and 10*ter*) are much less detailed. There seems to be no conflict between the enforcement provisions of the TRIPS Agreement and those of the Berne and Paris Conventions, and the former also cover the latter.

156. Few presently existing national laws seem to incorporate all the details required by this Part of the TRIPS Agreement, so that many Members of WTO will have to complete their rules concerning enforcement.

Part IV of the TRIPS Agreement, entitled
"ACQUISITION AND MAINTENANCE OF INTELLECTUAL PROPERTY RIGHTS AND RELATED *INTER-PARTES* PROCEDURES"

157. This Part of the TRIPS Agreement consists of one Article (**Article 62**). Briefly stated, it establishes principles that should ensure that formalities and procedures concerning the acquisition and maintenance of intellectual property rights existing in a Member are reasonable and that final administrative decisions in a Member are generally subject to review by a judicial or quasi-judicial authority.

158. Among the WIPO-administered treaties, it is particularly the PCT, the Trademark Law Treaty, the Madrid Agreement and the Hague Agreement that deal with formalities of acquiring and maintaining patents, marks and industrial designs, respectively. The provisions of those treaties are much more detailed than those of the TRIPS Agreement, the latter concentrating on principles rather than the implementation of those principles.

159. There seems to be no conflict between the principles of the TRIPS Agreement and the provisions of the WIPO-administered treaties in respect of the acquisition and maintenance of intellectual property rights, and the latter complete the former. However, the national laws of many Members of WTO will have to be amended so that they comply with the said principles of the TRIPS Agreement. This is particularly true for States that are not yet party to the above-mentioned WIPO-administered treaties.

Part V of the TRIPS Agreement, entitled
"DISPUTE PREVENTION AND SETTLEMENT"

160. This Part of the TRIPS Agreement consists of two Articles (Articles 63 and 64).

161. **Article 63, entitled "Transparency,"** consists of four paragraphs.

162. *Publication of Laws, etc.* Paragraph 1 obliges the Members to publish (or, where publication is not practicable, make publicly available) their laws, regulations, final judicial decisions, administrative rulings of a general application, and bilateral agreements between Members, pertaining to the subject matter of the TRIPS Agreement. There are no corresponding provisions in the Paris and Berne Conventions, but most, if not all States proceed, and have traditionally proceeded, with such publications.

163. *Notification of Laws and Regulations, etc.* Paragraph 2, first sentence, provides that "Members shall notify the laws and regulations referred to in paragraph 1 to the Council for TRIPS in order to assist that Council in its review of the operation of the Agreement."

164. The Berne Convention provides that "Each Country of the [Berne] Union shall promptly communicate to the International Bureau all new laws and official texts concerning the protection of copyright" (Article 24(2)); the Paris Convention provides the same in respect of laws and official texts concerning the protection of industrial property (see Article 15(2)). Thus, States that are party to both the TRIPS Agreement and the Paris and/or Berne Conventions would have to communicate certain texts to both WTO and WIPO. The TRIPS Agreement is aware of such potential duplication and envisages a solution to it in the second sentence of the paragraph under consideration (i.e., paragraph 2) which reads as follows: "The Council [for TRIPS] shall attempt to *minimize* the burden on Members in carrying out this obligation and may decide to waive the obligation to notify such laws and regulations directly to the Council [for TRIPS] if consultations with WIPO on the establishment of a common register containing these laws and regulations are successful." At the time of writing this paper (July 1995), such consultations have started.

165. The Berne and the Paris Conventions also provide that the International Bureau shall assemble and publish information concerning the protection of copyright and industrial property, respectively (see the first sentences of Article 24(2) of the Berne Convention and Article 15(2) of the Paris Convention).

166. Whereas the duty of assembling, by the Council for TRIPS, the laws and regulations notified to it seems to be implicit in the TRIPS Agreement (otherwise it could not carry out its duty to review the operations of the TRIPS Agreement), the TRIPS Agreement does not provide for the publication by the Council for TRIPS of any information concerning the protection of copyright and industrial property.

167. *Notification of State Emblems, etc.* Article 6*ter* of the Paris Convention provides for the possibility of States party to that Convention to communicate to the International Bureau their State emblems and official signs and hallmarks indicating control and warranty. The communication of such emblems, etc., is intended for the protection of the emblems, etc., against use in marks or use in trade. This is a description which only gives the essence of Article 6*ter*.

168. The third sentence of Article 63, paragraph 2 of the TRIPS Agreement reads as follows: "The Council [for TRIPS] shall also consider in this connection [i.e., in connection with the consultations with WIPO] any action required regarding notifications pursuant to the obligations under this Agreement stemming from the provisions of Article 6*ter* of the Paris Convention (1967)." At the time of writing this paper (July 1995), the Council for TRIPS, as far as known to the International Bureau, has not yet completed its consideration of this matter.

169. *Further details.* Paragraphs 3 and 4 contain certain details and qualifications to the obligations of Members provided for in paragraphs 1 and 2.

170. **Article 64 is entitled "Dispute Settlement."** Since it is expected that the September 1995 sessions of the WIPO Governing Bodies will make decisions concerning WIPO's plans to elaborate a WIPO system for the settlement of disputes between states in the field of intellectual property and since such decisions may yield new insights in the possible relations between that (for the moment merely planned) system, the WTO system of dispute settlement and the dispute settlement system of the International Court of Justice, whose jurisdiction is stipulated in the Berne Convention (Article 33) and the Paris Convention (Article 28), this matter will be dealt with in any subsequent version of the present paper.

Part VI of the TRIPS Agreement, entitled "TRANSITIONAL ARRANGEMENTS"

171. This Part of the TRIPS Agreement consists of three Articles (Articles 65 to 67).

172. **Articles 65 and 66, entitled "Transitional Arrangements" and "Least-Developed Country Members,"** determine the dates by which Members are obliged to apply the provisions of the TRIPS Agreement. Expressed in a somewhat simplified and different way than in the TRIPS Agreement itself, the result seems to be the following:

(i) Any least-developed country Member may delay the application of the TRIPS Agreement--except the provisions concerning national treatment and most-favored-nation-treatment--until January 1, 2006; it may, however, apply for extensions of that deadline by the Council for TRIPS (Article 66, paragraph 1).

(ii) Any developing country Member (other than a least-developed country Member) may delay the application of the TRIPS Agreement--except the provisions concerning national treatment and most-favored-nation-treatment--until January 1, 2000 (Article 65, paragraph 2), plus an additional five years (until January 1, 2005) for product patent protection in certain cases (Article 65, paragraph 4).

(iii) Any country Member (other than a least-developed or a developing country) "which is in the process of transformation from a centrally-planned into a market, free-enterprise economy and which is undertaking structural reform of its intellectual property system and facing special problems in the preparation and implementation of intellectual property laws and regulations" may delay the application of the TRIPS Agreement--except the provisions concerning national treatment and most-favored-nation treatment--until January 1, 2000 (Article 65, paragraph 3).

(iv) Any Member not falling into any of the three categories described in (i), (ii) and (iii), above, may delay the application of the TRIPS Agreement until January 1, 1996 (Article 65, paragraph 1).

(v) Any Member falling into any of the four categories described above (that is, any WTO Member) is obliged to apply the provisions of the TRIPS Agreement concerning national treatment and most-favored-nation treatment as from January 1, 1996.

173. Any Member taking advantage of the transitional periods described above must "ensure that any changes in its laws, regulations and practice made during that period do not result in a

lesser degree of consistency with the provisions of this [the TRIPS] Agreement" (Article 65, paragraph 5); this is referred to as the "standstill" or "no-rollback" provision.

174. **Article 67, entitled "Technical Cooperation,"** establishes the obligation of developed country Members to provide, on request and on mutually agreed terms and conditions, technical and financial cooperation in favor of developing and least-developed country Members in order to facilitate the implementation of the TRIPS Agreement by the latter countries.

175. As far as least-developed countries are concerned, Article 66, paragraph 2 of the TRIPS Agreement also obliges developed country Members to "provide incentives to enterprises and institutions in their territories for the purpose of promoting and encouraging technology transfer to least-developed country Members in order to enable them to create a sound and viable technological base."

176. It is to be noted that WIPO has always had, and will continue to have, a permanent program on development cooperation for developing countries, including the least developed countries (LDCs). Under that program, WIPO is at the disposal of any such country, which so desires, for advice on legislation and for assistance in institution building and development of human resources.

Part VII of the TRIPS Agreement, entitled
"INSTITUTIONAL ARRANGEMENTS; FINAL PROVISIONS"

177. This Part of the TRIPS Agreement consists of six Articles (Articles 68 to 73).

178. **Article 68, entitled "Council for Trade-Related Aspects of Intellectual Property Rights,"** specifies the tasks of the Council for TRIPS and states that "In consultation with WIPO, the Council shall seek to establish, within one year of its first meeting [which took place on March 9, 1995], appropriate arrangements for cooperation with bodies of that Organization." At the time of writing this paper (July 1995), informal consultations have started between the Chairman of the Council for TRIPS and the Director General of WIPO.

179. **Article 69, entitled "International Cooperation," Article 70, entitled "Protection of Existing Subject Matter," Article 71, entitled "Review and Amendment," Article 72, entitled "Reservations," and Article 73, entitled "Security Exceptions,"** are reserved for any subsequent version of this paper. However, it should be noted that, in the present paper's chapter dealing with patents, reference is made to those provisions of **Article 70** that concern patent protection for pharmaceutical and agricultural chemical products (Article 70, paragraphs 8 and 9). Other paragraphs of that Article deal with obligations in respect of, *inter alia*, effectiveness of the Agreement concerning subject matter existing on the date of application of the Agreement in a Member (paragraph 2), lack of obligation to restore protection for subject matter in the public domain (paragraph 3), limitation of remedies with respect to acts which become infringing as a result of the Agreement (paragraph 4), exceptions to certain obligations in specified cases (paragraphs 5 and 6) and amendment of applications to claim enhanced protection under the Agreement (paragraph 7).

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