

GUIDE
TO THE APPLICATION OF THE
PARIS CONVENTION
FOR THE
PROTECTION OF
INDUSTRIAL PROPERTY

AS REVISED AT STOCKHOLM IN 1967

by

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PERIODICALS CITED IN FOOTNOTES

Ann.	Annales de la Propriété industrielle, artistique et littéraire (France)
G.R.U.R. Int.	Gewerblicher Rechtsschutz und Urheberrecht, Internationaler Teil (Federal Republic of Germany)
I.P.	Industrial Property (BIRPI)
I.P.Q.	Industrial Property Quarterly (BIRPI)
Ing. Conseil	Revue de droit intellectuel, l'Ingénieur Conseil (Belgium)
P.I.	La Propriété industrielle (BIRPI)
Rev. Mex. P.I.	Revista mexicana de la propiedad industrial y artística (Mexico)
R.I.D.A.	Revue internationale du droit d'auteur (France)
R.I.P.I.A.	Revue internationale de la propriété industrielle et artistique (France)
R.P.C.	Reports of Patent, Design and Trade Mark Cases (Great Britain)
Sch. Mitt.	Schweizerische Mitteilungen über gewerblichen Rechtsschutz und Urheberrecht (Switzerland)
U.S.P.Q.	The United States Patents Quarterly (U.S.A.)

**Guide to the Application of the Paris Convention
for the Protection of Industrial Property
as revised at Stockholm in 1967**

I. INTRODUCTORY OBSERVATIONS

The number of States party to the Paris Convention for the Protection of Industrial Property has increased rapidly in recent years: on January 1, 1963, 51 States had acceded to the Convention; on January 1, 1968, this number had risen to 79. A further increase may be expected in the near future, as many States are known to be studying or preparing their accession to the Convention. In view of these facts many more governments, national administrations or courts, practitioners, inventors, and industrial or commercial enterprises will have to apply, or may request the application of, the Convention than ever before. It has therefore appeared useful to establish a concise Guide, briefly commenting upon the principal provisions of the Convention and indicating replies to the main questions which may arise from day to day in relation to its application.

Since the International Bureau, which is entrusted with the administration of the Convention, is not competent to determine how it should be interpreted, the views expressed in this Guide are only those of the author. The International Bureau has limited its role to the publication of the Guide in view of its presumed usefulness.

The purpose of the Guide is to deal in a very simple manner with the principal questions relating to the application of the Convention.

For that reason, theoretical considerations have been omitted, other literature is only occasionally mentioned, and national legislations and case law are cited only as examples. Another reason for these latter limitations is that the author's knowledge of languages is unfortunately limited, so that laws, administrative or judicial decisions and legal studies not published in any language known to him will probably have escaped him. In these circumstances, a certain lack of balance would exist if much attention were given to publications in one language and none to equally important publications in another.

The Guide comments on the Paris Convention as revised at Stockholm in 1967. The Stockholm text is not yet in force at the time of publication of the Guide, but it will no doubt soon become the text of the Convention adhered to by many countries. Since, moreover, with one exception (addition of Article 4 I(1) and (2)), the Stockholm text of the Convention differs from the preceding Lisbon text only in the administrative and final clauses (Articles 13 to 30), the Stockholm text seemed to constitute an appropriate basis for a commentary. This commentary is based on the official text of the Convention in English,¹ established in application of Article 29(1)(b) of the Convention, a text which presents some differences as to form with the former official English translation of the Lisbon text.

The Guide, after briefly sketching the history and the principal rules of the Convention, comments upon each of its articles and paragraphs separately.

¹ See *I.P.*, 1968, p. 122.

II. HISTORY AND PRINCIPAL RULES OF THE CONVENTION

The Convention was drafted, after preparatory work in 1873 and 1878, at a Diplomatic Conference in Paris in 1880, signed, with an additional Final Protocol, by 11 States¹ at a similar Conference in 1883 and ratified by these States in 1884.² It entered into force one month after the deposit of the instruments of ratification, on July 7, 1884.

The Convention specified that the contracting States constituted themselves into a *Union* for the protection of industrial property, a legal construction the consequences of which will be examined hereinafter.

From the start, the Convention (Article 14) provided for periodical Conferences of Revision with a view to the introduction of amendments designed to improve its system. Such Conferences were held in Rome in 1886, in Madrid in 1890 and 1891, in Brussels in 1897 and 1900, and in Washington in 1911, but since none of the adopted texts is still binding on any of the member States they need not be commented upon as such. Further revisions of the Convention took place at The Hague in 1925, at London in 1934, at Lisbon in 1958 and at Stockholm in 1967. All these last-mentioned texts are, or will soon be, in force between some member States; the relations between States bound by different texts will be examined below.

In discussing the articles and paragraphs of the Convention hereinafter, the development of each provision will be traced throughout the different revisions of the Convention, in order to facilitate further study of the background of each provision in the Acts of each Revision

¹ Belgium, Brazil, France, Guatemala, Italy, Netherlands, Portugal, Salvador, Serbia, Spain and Switzerland.

² At the same time instruments of accession were deposited by Ecuador, Tunisia and the United Kingdom.

Conference.¹ Where, in many cases, special reference is made to the history of a provision of the Convention, the purpose is to indicate the questions which were before the Conference or Conferences which established the provision, and to illustrate or clarify its meaning.

As to the *principal rules* of the Convention, a distinction must be made between four different categories of rules which it contains :

1. First, the Convention contains provisions of *international public law* regulating *rights and obligations of the member States* and establishing the *organs of the Union* created by the Convention, as well as provisions of an *administrative character*. Examples of this category are :

Article 6ter(3) and (4), requiring or allowing the member States—and international organizations of which at least one of these States is a member—to make certain communications concerning emblems, etc., to be excluded from registration and use as trademarks ;

Article 12, which requires the member States to establish a national industrial property service which will issue certain publications (cf. also Article 4 D(2)) ;

Article 13, which establishes an Assembly consisting of the member States, and deals with the composition, the powers and duties of the Assembly, and its voting procedure ;

Article 14, establishing an Executive Committee, again with provisions as to its composition, powers, etc ;

Article 15, regulating the functioning of the International Bureau, which will perform the administrative tasks concerning the Union established by the Convention ;

Article 16, regarding finances, that is, the budget of the Union, the contributions of the member States, etc ;

Articles 17 and 18, concerning the amendment of Articles 13 to 17 and revision of the other Articles of the Convention ;

Article 19, envisaging the possibility of special agreements between the member States, which must not, however, contravene the provisions of the Convention ;

Article 20, concerning ratification of and accession to the Convention by countries already members of the Union, that is, countries party to an earlier Act of the Convention ;

¹ With respect to the Revision Conference of Stockholm in 1967, references will be limited to those documents of the Conference which, at the time of writing this Guide, were already published; this was not the case as far as the complete Acts of the Conference of Stockholm are concerned.

Article 21, regarding accession by countries outside the Union ;
Article 22, dealing with the consequences of ratification or accession ;
Articles 23 and 27, regarding the relationship with earlier Acts of the Convention ;
Article 24, regulating the possibility of applying the Convention to dependent territories ;
Article 26, concerning the duration and denunciation of the Convention ;
Article 28, relating to disputes between member States concerning the interpretation or application of the Convention ;
Article 29, concerning signature of the Convention, languages and depositary functions ;
Article 30, containing transitional provisions.

2. Secondly, the Convention contains provisions which *require* or *permit* the member States to *legislate* within the field of industrial property.

In this category the following provisions may be mentioned :

Article 4 D(1), (3), (4) and (5), requiring or allowing member States to regulate certain details concerning the right of priority ;
Article 4 G(2), second sentence, containing a similar rule regarding the division of patent applications ;
Article 5 A(2), granting member States the right to legislate against abuses which might result from the exercise of the exclusive rights conferred by a patent ;
Article 5bis(2), granting member States the right to provide for the restoration of patents which have lapsed by reason of non-payment of fees ;
Article 6bis(2), second sentence, enabling member States to provide a period within which the prohibition must be sought of use by a third party, not made in bad faith, of a mark similar to a well-known mark ;
Article 6septies(3), enabling member States to provide an equitable time limit for the exercise of certain rights of the proprietor of a mark against his agent or representative ;
Article 10bis(1), requiring member States to assure effective protection against unfair competition ;
Article 10ter, obliging member States to provide legal remedies effectively to repress certain unlawful acts concerning trademarks, trade names, false indications of the source of goods or of the

identity of the producer, manufacturer or merchant, and unfair competition ;¹

Article 11, requiring member States to grant temporary protection to patentable inventions, utility models, industrial designs and trademarks, in respect of goods exhibited at official or officially recognized international exhibitions held in the territory of any of them ; and, finally,

Article 25, containing the *general principle* that any country party to the Convention undertakes to adopt, in accordance with its constitution, the measures necessary to ensure the application of the Convention, and specifying that a country acceding to the Convention must be in a position under its domestic law to give effect to the provisions of the Convention.

3. A third category of provisions of the Convention relates to *substantive law* in the field of industrial property regarding *rights and obligations of private parties*, but only to the extent of *requiring the domestic law* of the member States to be applied to these parties.

Under this category comes the very important basic rule of the Convention, that nationals of each member State shall, as regards the protection of industrial property, enjoy in all other member States the advantages that their respective laws grant, or may grant in the future, to nationals of these latter member States (Article 2). Nationals of non-member States who are domiciled or who have real and effective industrial or commercial establishments in the territory of one of the countries of the Union must be treated in the same manner as nationals of the countries of the Union (Article 3).

This is called the principle of "*national treatment*," or "*assimilation with nationals*," a principle which means that, in the field of industrial property as defined by the Convention, each member State must apply to nationals of other member States (and those assimilated to such nationals by Article 3) the *same treatment as it gives to its own nationals*, without being allowed to require reciprocity. The idea of the Convention is that such reciprocity is sufficiently assured by the obligations involved in adherence to the Convention.

Other, more special, provisions by which the Convention requires the application of domestic legislation are Article 9(3), concerning

¹ In contrast, Article 9(6) does not create any obligation for member States to legislate according to the preceding paragraphs of that Article: it merely has the character of an invitation which does not even create a moral obligation. Cf. *Actes de La Haye*, pp. 470, 525, 545.

seizure of goods unlawfully bearing a trademark or trade name, and Article 9(6), regarding other actions and remedies available in such cases, both provisions being equally applicable to false indications of source, etc. (cf. Article 10(1)).

With respect to those provisions of the Convention which require the application of the domestic law of member States, the question arises whether private parties may *directly claim* the application of domestic laws by the administrative and judicial authorities of the countries concerned, *by virtue of the provisions of the Convention*, or whether these latter provisions only create *obligations for member States*, whose *domestic laws* would then have to make special provision for "*national treatment*" of nationals of other member States in order to make these laws applicable in such cases.

This is the well-known question whether the cited provisions of the Convention are or are not "*self-executing*." The answer depends on two further questions: first, whether the constitution or constitutional system of the State concerned permits provisions of an international Convention to be "*self-executing*," that is, directly applicable to private parties without further intervention by the national legislation or possibly even against differing provisions of such legislation, and, secondly, whether the provisions of the international Convention concerned are so drafted as to permit such direct application to private parties. The first question will be discussed below; as to the second, there can be no doubt that the provisions of the Convention cited above may, and therefore must, be directly applied in countries which admit this possibility.

4. Finally, a fourth category of provisions of the Convention contains *rules of substantive law* regarding *rights and obligations of private parties*, rules however which do not merely refer to the application of domestic laws, but the contents of which may *directly govern the situation at issue*.

Here again the question arises whether these provisions *will*, in any given case, directly govern the situation at issue, that is, be considered as "*self-executing*," or whether national legislation is necessary to implement such provisions.

As has been observed above, this depends in the first place on the constitutional system of each member State.¹

¹ Cf. *Actes de Washington*, p. 269; *Actes de La Haye*, pp. 223/4.

In some countries, for example, France, the Soviet Union, the United States, the Netherlands and many others, the constitution or constitutional system permits administrative and judicial authorities to apply directly to private parties the provisions of an international treaty, if these provisions are worded in such a way as to make such direct application possible ("self-executing" provisions).¹ In these countries the provisions of the Convention which are considered "self-executing" may be applied and must be applied without any further intervention by the national legislator.

In other countries, for example, the United Kingdom, Norway, Sweden and several others, the provisions of an international treaty can bind only the *State* and are never applicable to private parties without first having been embodied in domestic legislation. In these countries the provisions of the Convention cannot be "self-executing"; although they may, even without being binding, *influence* an administrative or judicial decision concerning domestic law, they can only become *binding* by application of Article 25 of the Convention, that is, when the country concerned introduces the rules of the Convention into its domestic law.

Whatever the constitutional system of the member States, the provisions of the Convention of the fourth category referred to above constitute a very important *body of common rules* regarding the protection of industrial property, rules which, either directly, or indirectly through the intermediary of national legislation, have to be respected and applied by all member States.

What remains to be decided in countries which admit the possibility of self-executing provisions of a convention is whether the provisions concerned are so worded *as to permit direct application*.

Provisions of this type are to be found, for example, in the definition of industrial property in Article 1, the right of priority regulated in Article 4, the independence of patents (Article 4*bis*), the right of the inventor to be mentioned in the patent (Article 4*ter*), the limitation of the possibilities of refusal and annulment of patents (Article 4*quater*), the regulation of the obligation to exploit patents, trademarks, etc. (Article 5, with the exception of paragraph A(2)), the period of grace for the payment of maintenance fees (Article 5*bis*(1)), the exemption, under certain circumstances, of ships, aircraft, land vehicles, etc., from infringement of patents (Article 5*ter*), the rights of the patentee of a

¹ In some of these States the provisions of an international treaty overrule provisions of domestic law, even if the latter are of later date; in other States the later of both types of provisions prevails.

process of manufacture (Article 5*quater*), the conditions of registration and independence of trademarks (Article 6), the assignment of marks (Article 6*quater*), the protection of registered trademarks in other countries (Article 6*quinquies*), the registration of marks by agents, etc. (Article 6*septies*), the exclusion of all consideration of the nature of goods as a bar to the possible registration of a trademark for such goods (Article 7), the provision concerning the protection of trade names (Article 8), the recognition of interest in pursuing false indications of source, etc. (Article 10(2)), the designation of acts of unfair competition (Article 10*bis*(2) and (3)).¹

Although these common rules regarding the protection of industrial property given in the Convention are of great importance, it should be noted, nevertheless, that their scope is limited and they leave *considerable freedom to the member States* to legislate on questions of industrial property according to their interests or preferences.

In the field of patents, for example, the Convention leaves the member States entirely free to establish the criteria for patentability, to decide whether patent applications should or should not be examined in order to determine, before a patent is granted, whether these criteria have been met, whether the patent should be granted to the first inventor or to the first applicant for a patent, or whether patents should be granted for products only, for processes only, or for both, and in which fields of industry and for what term.² With one exception (Article 5*quater*), the Convention does not specify either the acts of third parties against which a patent should protect the patentee, etc.

In the field of trademarks, the Convention does not prescribe whether the right to a trademark will be acquired either through registration or through use, or both. It also leaves the member States free to decide to what extent they desire to submit applications for registration of a trademark to examination. Neither is the scope of protection of a trademark defined in the Convention, except in a few special cases (Articles 6*bis*, 6*quinquies* and 6*septies*).

Other cases in which the Convention leaves the member States free to legislate will be examined below.

Another aspect of the considerable freedom left by the Convention to the domestic law of the member States is that such laws may grant

¹ In the case of other provisions, for example, Articles 5*quinquies*, 6*bis*, 6*ter*, 6*sexies*, 7*bis*, their self-executing character is questionable. This will be discussed when these Articles are commented upon separately. Articles 9(1) to (5) and 10(1) are not self-executing because of Article 9(6).

² Cf. *Actes de La Haye*, p. 536.

a *more extensive protection* of industrial property than is prescribed in the Convention.¹

For example, the member States may also grant “national treatment,” that is, the treatment accorded to nationals in their national legislation, or certain rights provided in the Convention, such as the right of priority, to persons other than those entitled to such treatment by virtue of the Convention, namely, persons who are neither nationals of any country of the Union (Article 2), nor domiciled or established therein (Article 3). The member States may also improve the protection of industrial property prescribed in the Convention, for example, by protecting well-known trademarks (Article 6*bis*) against identical or similar marks for entirely different goods.

However, there is a limit to this freedom to enlarge the protection of industrial property prescribed in the Convention in that more extensive protection must not prejudice the rights granted by the Convention. This could be the case, for example, if a member State would grant to nationals of certain countries priority rights for longer periods than those of Article 4 C(1) of the Convention.

¹ Cf. *Actes de Paris*, I, p. 131 .

III. COMMENTARY ON THE ARTICLES OF THE CONVENTION

ARTICLE 1, paragraph 1)^(a)

(1) The countries (b) to which this Convention (c) applies (d) constitute a Union (e) for the protection of industrial property (f).

(a) The original text of the Convention of 1883 enumerated the States whose Governments declared that they constituted themselves into a Union for the protection of industrial property. These States were thereafter referred to in the Convention as "contracting States," "States of the Union" or "High Contracting Parties." This terminology was changed at the Revision Conference of Washington in 1911 where, in view of the diversity obtaining in the internal constitution of the contracting parties and the terminology adopted in this respect by similar Conventions,¹ Article 1 of the Convention was worded: "The contracting *countries* constitute themselves into a Union for the protection of industrial property." This text was further modified by the Revision Conference in London in 1934.²

(b) As indicated above, the Convention no longer speaks of "contracting States" but of "*countries* to which this Convention applies." As was observed at the Revision Conference of London in 1934,³ the latter expression could also cover the extension of the scope of the Convention to colonies, etc., which, generally speaking, were not "States." This problem, however, was taken care of by what was then

¹ *Actes de Washington*, p. 41, Note.

² *Actes de Londres*, pp. 166/7 (proposal), 340 (report of First Sub-Committee), 448 (report of Drafting Committee), 510 (adoption in Second Plenary Session).

³ *Ibidem*, p. 166.

Article 16*bis* of the Convention (now, in modified form, Article 24 of the Stockholm text). The main reason for changing the expression "States" into "countries" was probably to enable countries not fully autonomous, such as several British "dominions" and French "protectorates," to claim the status of "country to which the Convention applies" and thus exert the right to vote in revision Conferences.¹

These phenomena have now disappeared and, in view of the generally accepted rule of international public law according to which only *States* (apart from intergovernmental organizations) have the capacity to conclude treaties,² there is no reason to believe that "countries" in the Convention means anything other than "States."³

This question is of some importance because the Convention does not provide any procedure for the admission of new members to the Union. Each member State being therefore its own judge in the matter, it is possible that existing members may not acknowledge the status of a "State" to an entity that newly accedes, and may therefore refuse to recognize its membership.⁴

(c) The Paris Convention, as revised since 1883, is in reality a *series of Conventions* embodied in the successive texts established at the Revision Conferences. However, this series of Conventions, called "Acts" (of the same Convention) since the Revision Conference of Washington in 1911, has constituted and maintained *one and the same Union*. Therefore, in the sentence "to which this Convention applies" the words "this Convention" must be interpreted as meaning "this Convention in whatever text is still in force."

(d) The Convention *applies* to countries by virtue of their ratification after signature (Article 20) or of their accession (Articles 20 and 21). It *applies* also to territories for the external relations of which a member country is responsible, by virtue of a declaration or notification made pursuant to Article 24.

¹ Cf. *Actes de Washington*, pp. 221/2. See also ROUBIER: *Le droit de la propriété industrielle*, 1, pp. 247/9.

² Cf. Report of the International Law Commission (U.N. doc. No. 9 (A/6309/Rev. 1)) pp. 20/25; MCNAIR: *The Law of Treaties*, 1961, p. 35; SØRENSEN: *The Manual of Public International Law*, 1968, pp. 177/82.

³ See also document S/3 prepared for the Revision Conference of Stockholm, p. 18, paragraph 53.

⁴ This situation has arisen and was dealt with by various countries in various ways, when in 1956 the German Democratic Republic declared that it regarded as applicable, upon its territory, several treaties, particularly the Paris Convention (Cf. *P.I.*, 1956, pp. 21, 41, 153, 169), and again in 1964 when the same Republic acceded to the Lisbon Act of that Convention (*I.P.*, 1964, p. 254; 1967, p. 75).

The Convention *ceases to apply* to countries after their denunciation of it (Article 26), and to dependent territories after a notification to that effect (Article 24(2)). It will also cease to apply when a country, after having been part of a member country or having been a territory as indicated above, obtains its independence as a State. According to prevailing opinion in the field of international law,¹ in such cases the new sovereign State is no longer bound by treaties applying to it in its former dependent status, unless it expressly accedes to those treaties. For this subject, see further the commentary on Article 21.

(e) The countries to which the Convention (in whatever text is still in force) applies constitute a *Union* for the protection of industrial property. This is more than a declaration of principle: it has important legal effects.

In the first place, in creating a Union, the Paris Convention has not merely remained a treaty establishing rights and obligations for its member States and, wherever permitted by the constitutions of these States (cf. Chapter II.4, above), also for private parties, but has established a legal entity in international law² with certain organs to carry out its objectives.³ One of the effects of this legal construction is that the Union forms a single entity from the administrative point of view: there is only one budget and one set of accounts, and there is no separate administration for each separate Act of the Convention, although the member countries pay their contributions on the basis of these different Acts.

Secondly, the character of the Union is such that a State acceding to the most recent Act of the Convention becomes bound with respect to all member States of the Union, even those which have not yet acceded to the most recent Act (Article 27(3)).⁴ Similarly, denunciation of the

¹ Cf. CASTRÉN: "Aspects récents de la succession d'Etats," *Recueil des cours Académie de droit international de la Haye*, 1951, 1, p. 430; MCNAIR: *The Law of Treaties*, 1961, p. 601; O'CONNELL: *State Succession in Municipal Law and International Law*, II, 1967, pp. 1, 113, 204/8, 212.

² Cf. PLAISANT: *Traité de droit conventionnel international concernant la propriété industrielle*, 1949, pp. 33/4, 68/70; ROUBIER: *Le droit de la propriété industrielle*, 1, 1952, pp. 225 et seq., 237 et seq.; BOGUSLAWSKI: *Internationale Rechtsprobleme des Erfindungswesens*, 1963, p. 61; TROLLER: *Die mehrseitigen völkerrechtlichen Verträge im internationalen gewerblichen Rechtsschutz und Urheberrecht*, 1965, pp. 180/1; MIOSGA: *Internationaler Marken- und Herkunftsschutz*, 1967, pp. 9/10.

³ These organs are: the Assembly of the Union (Article 13), its Executive Committee (Article 14), the International Bureau (Article 15), the Conferences of Revision (Article 18(2)) and the International Court of Justice (Article 28).

⁴ Cf. Report of Main Committee IV of the Intellectual Property Conference of Stockholm, *I.P.*, 1967, p. 222, paragraphs 16, 17.

most recent Act of the Convention is deemed to constitute also denunciation of all earlier Acts (Article 26(2)). Thus, a State can only enter and leave the Union as a whole. This is important because the nationals of such State, and those assimilated to these nationals, may thus require (or, in the case of denunciation, no longer require) the application of the Convention in all member States of the Union. For these questions, see further the commentary on Article 27.

(f) The Paris Convention has constituted a Union *for the protection of industrial property*. This subject is defined in the following paragraphs (2) to (4) of Article 1, but some general observations may be made here, before proceeding to the commentary on these paragraphs.

The term "industrial property" is a traditional but not entirely exact denomination for certain exclusive rights, resembling property rights, regarding creative ideas or distinguishing signs or designations in the industrial or commercial field, supplemented by certain rules against unfair behaviour in the same field.¹ The term is inexact because "industrial property" presents no more than an analogy with normal property; further, because it covers more than industrial subjects only; and, finally, because the rules against unfair behaviour are not necessarily related to property at all.

The definition and delimitation of the notion of industrial property in the Paris Convention is not merely of theoretical interest. The question has been discussed, for example, whether or not the protection of new varieties of plants, now the subject of a separate Convention signed in Paris on December 21, 1961, or inventors' certificates, now mentioned in Article 4 I of the Paris Convention, come under the definition of industrial property. If the answer is in the affirmative,² this means that the member States, or such member States as will interpret the Convention in this way, will be bound, as regards the subjects mentioned, to assimilate the treatment of nationals of the other member States (and those assimilated to such nationals by Article 3 of the Convention) to that accorded to their own nationals, and to apply to these subjects the relevant rules of the Convention, without

¹ *Actes de La Haye*, pp. 534/5.

² A question left open in Article 4(5) of the Convention for the Protection of New Varieties of Plants, and solved in the affirmative in the case of inventors' certificates in Article 4 I of the Paris Convention, as revised at Stockholm in 1967.

being entitled to require reciprocity of protection for the same subjects.¹

ARTICLE 1, paragraph (2)^(a)

(2) The protection of industrial property has as its object (b) patents (c), utility models (d), industrial designs (e), trademarks (f), service marks (g), trade names (h), indications of source (i) or appellations of origin (j), and the repression of unfair competition (k).

(a) The earlier Acts of the Paris Convention, although they mentioned several subjects of industrial property, did not contain a definition of this notion as such. This definition was introduced at the Revision Conference of The Hague in 1925.² It was afterwards modified only as to form, except that at the Revision Conference of Lisbon in 1958 the subject of service marks was added to the definition.³

(b) When, according to the definition given, the protection of industrial property has as its object certain legal phenomena, the question arises whether under the Convention the member States are bound to provide for the protection of or to regulate *all* these phenomena. This question will be discussed below when some comments have been given on the different subjects.

(c) Although paragraph (4) of the Article under consideration gives an enumeration of the different kinds of patents covered by the Convention, the said instrument does not contain any definition of what a "patent" is. On this question, as in the case of the other subjects (utility models, etc.) enumerated in the provision under consideration, the countries of the Union are free to define in their national legislation the subject indicated, to which the Convention will then apply. If, as has been observed above, under a given national law patents are granted also for varieties of plants the Convention will apply to these patents.

¹ Cf. Chapter II.3 and II.4, above. See also the reverse situation in Belgium, where industrial designs were declared excluded from the protection of industrial property: Cour de Cassation, 20/12/1954, *Ing. Conseil*, 1955, p. 35, and the criticism of this decision by LADAS, *ibidem*, p. 141.

² *Actes de La Haye*, pp. 332 (proposal of France), 410/2 (report of First Sub-Committee), 534/5 (report of Drafting Committee), 572 (adoption in Second Plenary Session).

³ *Actes de Lisbonne*, pp. 624, 626/7 (proposals of U.S.A. and Sweden), 628/33 (discussion in Third Committee), 755/7 (report of Third Committee), 634 (discussion in General Committee), 99 (adoption in Second Plenary Session), 114 (General Report).

The descriptions of the subjects given below represent only what is commonly understood by these subjects and they are merely given to illustrate the probable scope of the Convention. For this purpose, a *patent* can be described as an exclusive right to apply an industrial invention.

(d) *Utility models*, recognized only in a few countries,¹ can be described as second-class patents. They embody an exclusive right destined to cover industrial innovations of lesser importance than patentable inventions, with possible restrictions as to the kind of innovations to which they apply. The exclusive right granted in this form is normally of shorter duration than that of a patent.

(e) *Industrial designs* may be described as consisting of those ornamental aspects or elements of a useful article, including its two-dimensional or three-dimensional features of shape and surface, which make up the appearance of the article.² The proprietor of such industrial design will usually, under existing legislations, have the exclusive right to make, sell and use articles embodying such design.

(f) *A trademark* is usually defined as a sign serving to distinguish the *goods* of one enterprise from those of other enterprises. The proprietor of a trademark generally has the exclusive right to use the trademark, or variations of it, for the same or similar goods.

(g) *A service mark* is a sign serving to distinguish the *services* of one enterprise from those of other enterprises. The right to a service mark³ is analogous to that of a trademark.

¹ Cf., for example, the legislation of the member States: Federal Republic of Germany (*Gebrauchsmustergesetz*, 2/1/1968), Italy (Decree No. 1411 of 25/8/1940), Japan (Utility Model Law No. 123 of 1959), Poland (Inventions Act, 31/5/1962), Portugal (Industrial Property Act, 24/8/1940), Spain (Industrial Property Statute, 26/7/1929 as amended).

² Cf. Bills Nos. 450, 1237 and 3366 introduced in the House of Representatives of the 89th Congress of the United States of America.

³ So far, only a limited number of member States have legislated on service marks, for example, Algeria (Ordinance, 19/3/1966), Canada (Act relating to Trade Marks and Unfair Competition, 14/5/1953), Denmark (Trademarks Act, 11/6/1959), Finland (Trademarks Act, 10/1/1964), France (Act of 31/12/1964), Israel (Trademarks Ordinance, 1938, amended 4/3/1965), Italy (Trademarks Act of 21/6/1942, amended 24/12/1959), Monaco (Law 608 of 20/6/1955), Norway (Trademarks Act, 3/3/1961), Philippines (Trademarks Act No. 166 of 20/6/1947), Rumania (Law on Trademarks and Service Marks, 29/12/1967), Sweden (Trademarks Act, 2/12/1960), Uruguay (Decree of 28/9/1967), U.S.S.R. (Statute on Trademarks, 23/6/1962, amended 31/3/1967), U.S.A. (Trademarks Act, 5/7/1946, as amended), Yugoslavia (Law on Trademarks and Service Marks, 4/11/1961).

(h) *The trade name* is a notion interpreted in differing ways in existing legislations. It can generally, however, be defined as being the name or designation identifying the enterprise of a natural or legal person. The trade name will usually be protected against certain unlawful acts of third parties.

(i) *Indications of source* are generally understood to include all expressions or signs used to indicate that a product or service originates in a given country or group of countries, region or locality.¹ False or misleading use of such indications is usually prohibited.

(j) *An appellation of origin* may be defined as the geographical name of a country, region or locality which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors.² The word "or" in the text of the Convention, introduced at a time when the terminology was more fluid,³ is no longer quite correct. Appellations of origin are now considered to be a *species* of the *genus* "indications of source," characterized by their relationship with quality or characteristics derived from the source.⁴ Some countries have extensive laws to protect their appellations of origin against misuse.

(k) *The repression of unfair competition* is included in the protection of industrial property, because in many cases infringement of industrial property rights, such as the right to a trademark or a trade name, or the misuse of an indication of source or an appellation of origin, will at the same time be an act of unfair competition. However, the Convention (Article 10bis(2) and (3)) also states the general rule

¹ Cf. the Madrid Agreement, of 1891, for the Repression of False or Deceptive Indications of Source on Goods, last revised at Lisbon in 1958, with an Additional Act adopted at Stockholm in 1967.

² Cf. the Lisbon Agreement, of 1958, for the Protection of Appellations of Origin and their International Registration, revised at Stockholm in 1967.

³ *Actes de La Haye*, p. 535.

⁴ Cf. DEVLÉTIAN: "La protection des appellations d'origine et des indications de provenance," *P.I.*, 1956, pp. 225, 250; 1957, pp. 17, 35, 58 (English translation in *I.P.Q.*, April 1957, p. 6) and "The Protection of Appellations of Origin and Indications of Source," *I.P.*, 1968, p. 107; MASCAREÑAS: "Les indications de provenance et les appellations d'origine," *P.I.*, 1959, p. 252. The Revision Conference of Lisbon in 1958 did not accept a proposal to adopt this distinction in the provision under examination, but only because one country thought the actual text sufficient to cover all practical cases: *Actes de Lisbonne*, pp. 771/5.

that any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition, and gives examples of such acts.

A question which was reserved above is whether the States party to the Paris Convention, committed to the protection of industrial property (Article 1(1)), are bound to protect or regulate *all* subjects indicated in the definition. The answer to this question is in the negative, because at the Revision Conference of The Hague, where the definition of industrial property was introduced into the Convention, it was expressly stated that the enumeration of industrial property rights would *not* oblige the member States to legislate on *all* the specific rights enumerated.¹

However, this statement has not completely exhausted the question in view of other provisions in the Convention. Protection of several subjects of industrial property has been expressly prescribed in the Convention, namely, industrial designs (Article 5*quinquies*), service marks (Article 6*sexies*), collective marks (Article 7*bis*), trade names (Articles 8, 9, 10*ter*), indications of source (Articles 10, 10*ter*); and protection against unfair competition (Articles 10*bis* and 10*ter*) is also mandatory, as well as the temporary protection of certain subjects exhibited at international exhibitions (Article 11). Moreover, attention must be directed to Article 25 of the Convention. If a State accedes to the Convention without providing, in its domestic law, for any protection for *important subjects of industrial property*, such as *patents* or *trademarks*, it will not be in a position to give effect to substantial parts of the Convention dealing especially with these subjects, and will therefore probably be considered to have implemented the Convention insufficiently in its domestic law. This opinion seems reasonable, because the reciprocity of protection which is supposed to exist in application of the principle of "national treatment" under the Convention (cf. Chapter II.3, above) would not then exist with respect to the important subjects indicated.

ARTICLE 1, paragraph (3)^(a)

(3) Industrial property shall be understood in the broadest sense and shall apply (b) not only to industry and commerce proper, but likewise to agricultural and extractive industries and to all manu-

¹ *Actes de La Haye*, pp. 410/1 (report of First Sub-Committee), 534 (report of Drafting Committee). See also *Actes de Washington*, pp. 245/6, 248.

factured or natural products, for example, wines, grain, tobacco leaf, fruit, cattle, minerals, mineral waters, beer, flowers, and flour.

(a) Some parts of this provision figured already under paragraph 1 of the Final Protocol established as an integral part of the original text of the Convention of 1883.¹ They were, with minor modifications, maintained in the Protocol until after the Revision Conference of Washington in 1911. The provision, with further modifications, was introduced into the text of the Convention itself at the Revision Conference of The Hague in 1925² and was given the form it still has today at the following Revision Conference of London in 1934.³

(b) The meaning of the provision is not that *all* subjects of industrial property indicated in paragraph (2) of Article 1, such as patents, trademarks, etc., shall apply to *all* activities and products mentioned in paragraph (3). There is therefore no obligation for the member States to grant patents for wine, cattle or fruit, or to protect trademarks with respect to minerals.⁴ The purpose of the provision is merely to avoid *excluding* from the protection of industrial property activities or products which would otherwise run the risk of not being assimilated to those of industry proper.⁵ The various industrial property rights will, however, be applied to those activities and products only in so far as appropriate.

ARTICLE 1, paragraph (4)^(a)

(4) Patents shall include (b) the various kinds of industrial patents recognized by the laws of the countries of the Union, such as patents of importation (c), patents of improvement (d), patents and certificates of addition (e), etc.

(a) This provision was already substantially included under paragraph 2 of the Final Protocol which formed an integral part of

¹ *Actes de Paris*, I, pp. 32/3, 59/60, 127, 150.

² *Actes de la Haye*, pp. 221/2 (proposal), 332/3 (observations), 410/2 (report of First Sub-Committee), 516/7 (report of General Committee), 534/6 (report of Drafting Committee), 570/2 (adoption in Second Plenary Session).

³ *Actes de Londres*, pp. 247 (proposal of Czechoslovakia), 341/4 (report of Second Sub-Committee), 448/9 (report of Drafting Committee), 511 (adoption in Second Plenary Session).

⁴ Cf. in Netherlands: Patent Office (Division of Appeals), 22/12/1960, *G.R.U.R. Int.*, 1963, p. 28.

⁵ *Actes de La Haye*, pp. 535/6; *Actes de Londres*, pp. 341/4, 448/9, 511.

the original text of the Convention of 1883.¹ It remained in the Protocol, after modification, until after the Revision Conference of Washington in 1911 and was introduced, again after modification, into the text of the Convention itself at the Revision Conference of The Hague in 1925.² It underwent only slight changes as to form at subsequent Revision Conferences.

(b) As has been observed above, a patent may be defined as an exclusive right to apply an industrial invention. Several countries, however, recognize in their national laws different kinds of patents.³

The purpose of the provision is to ensure that all these kinds of patents will be included in the application of the Convention, both with respect to the "national treatment" to be granted in each member State to nationals of other member States and persons assimilated to these nationals, and with regard to the rules provided by the Convention itself. The different kinds of patents indicated as examples are:

(c) Patents of importation (sometimes also called patents of introduction, confirmation or revalidation).⁴ These patents are generally patents of relatively short duration granted for an invention which has already been patented in a foreign country and which therefore has lost its novelty, but which is nevertheless protected by a patent of importation in the expectation that the patentee will exploit the invention in the country concerned.

(d) Patents of improvement⁵ granted for improvements of an invention, generally with special provisions as to duration and the payment of maintenance fees.

(e) Patents or certificates of addition⁶ granted in a similar way for additions to an invention which are not necessarily also improvements.

¹ *Actes de Paris*, 1, pp. 127, 150.

² *Actes de La Haye*, pp. 332 (proposal of France), 410/2 (report of First Subcommittee), 534/6 (report of Drafting Committee), 572 (adoption in Second Plenary Session).

³ Cf. "Les différents genres de brevets d'invention," *P.I.*, 1945, pp. 26, 41, 47, 135.

⁴ Cf., for example, the legislations of the member States: Argentina (Patents Law No. 111, 1864), Belgium (Patents Law of 24/5/1854), Iran (Act of 23/6/1931), Spain (Industrial Property Statute of 26/7/1929, as amended), Uruguay (Patent Act No. 10,089 of 12/12/1941). Furthermore, a certain number of British and former British colonies have a system of confirmation or registration of British patents.

⁵ Patents of improvement are available in several member States, for example, Belgium, Mexico, Uruguay.

⁶ Patents or certificates of addition are available under almost all patent legislations.

ARTICLE 2, paragraph (1)^(a)

(1) Nationals (b) of any country of the Union shall, as regards the protection of industrial property (c), enjoy in all the other countries of the Union the advantages (d) that their respective laws (e) now grant, or may hereafter grant, to nationals ; all without prejudice to the rights specially provided for by this Convention (f). Consequently (g), they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with.

(a) The principle of “*national treatment*” or “*assimilation with nationals*” embodied in this provision, which can be considered one of the basic rules of the Convention,¹ was already included in the original text of 1883.² At the Revision Conference of The Hague in 1925 the final part of the first sentence: “without prejudice, etc.,” was added.³

(b) The provision applies to *nationals* of the countries of the Union.

In deciding the question who are such nationals, account has to be taken of the fact that the Convention can also apply to *legal persons or entities*,⁴ so that a distinction must be made between the nationality of *natural* and *legal* persons, respectively.

With respect to *natural* persons, nationality is a quality accorded or withdrawn by the legislation of the State whose nationality is claimed. Therefore it is only the legislation of that State which can define the said nationality and which must be applied also in other countries where it is invoked.

With respect to *legal* persons, the question is more complicated because generally no “nationality” as such is granted to legal persons by existing legislations. Where these legal persons are the States themselves, or State enterprises, or other bodies of *public status*, it

¹ This was particularly underlined when the principle was attacked at the Revision Conference of The Hague in 1925. Cf. *Actes de La Haye*, pp. 333 (proposal of U.S.A.), 413/5 (report of First Sub-Committee).

² *Actes de Paris*, I, pp. 26 (proposal), 33/47, 124/6 (discussions and adoption).

³ *Actes de La Haye*, pp. 222/5 (proposal), 333 (observations), 413/5 (report of First Sub-Committee), 517 (report of General Committee), 536/7 (report of Drafting Committee), 572 (adoption in Second Plenary Session).

⁴ This was unanimously agreed by the Revision Conference at Brussels in 1900: *Actes de Bruxelles*, pp. 196/7 (Third Plenary Session).

would be logical to accord to them the nationality of their country. With regard to corporate bodies of *private status*, such as companies and associations, the authorities of the countries where application of the Convention is sought will have to decide on the criterion of "nationality" which they will employ. This "nationality" can be made dependent upon the law according to which these legal persons have been constituted, or upon the law of their actual headquarters, or even on other criteria.¹ Such law will also decide whether a legal person or entity really exists.

If, by virtue of Article 24, the Convention has been made applicable to territories for the external relations of which a State is responsible, the "nationality" of inhabitants of such territories, even if not the same as that of the State concerned, may be accepted as a basis for application of the Convention. This is reasonable because otherwise application of the Convention to these territories would be only unilateral.

Several other questions may arise with respect to the criterion of nationality, particularly the following:

When does a person have to have the nationality of one of the countries of the Union in order to be able to claim application of the Convention? Generally this will be the moment at which he claims such application with respect to an application for or the right to a subject of industrial property.²

What happens when a person has *more than one nationality*? He will be considered a national of a country of the Union whenever this is justified by one of his nationalities.

Another possibility is that *several persons together* claim application of the Convention on the basis of nationality, for example, when they are co-applicants for, or co-owners of, an industrial property right, whereas, in fact, these persons are not all nationals of a country of the Union. In such case, application of the Convention cannot be claimed because the member States are not obliged to apply it to a person who is not entitled to benefit therefrom.³

¹ Cf. VON DER HEYDTE: *Völkerrecht*, I, 1958, p. 265; BATIFFOL: *Traité élémentaire de droit international privé*, 1959, paragraphs 192/198; SØRENSEN: *Manual of Public International Law*, 1968, p. 480.

² For the particular case of the right of priority, see observation (b) on Article 4 A(1), below.

³ At the Conference of Paris the Chairman expressed a contrary view regarding a trade name belonging jointly to a national and a non-national of a country of the Union (*Actes de Paris*, p. 100), but this has remained an isolated opinion.

(c) The rule of assimilation with nationals applies to the *protection of industrial property* as defined in Article 1 and therefore to all subjects indicated in that Article.

(d) The *advantages* which the nationals of the countries of the Union may claim in any other member country consist in the application, without any discrimination, of the national law as applied to nationals of the country itself. As has already been observed above, under Chapter II.3, this means that no reciprocity of protection can be required by the States party to the Convention. At the Revision Conference of The Hague in 1925, it was pointed out by the United States delegation that this system might lead to inequality of protection under the Convention since, for example, the United States grants patents of a comparatively long duration, without annual maintenance fees and without an obligation to exploit a patent, whereas other member States have more restrictive rules. Notwithstanding these difficulties, the system of "national treatment" embodied in the Convention was found acceptable, the more so because the national legislation of the member States is tending towards greater harmonization.¹

(e) According to the text of the provision under examination, nationals of any country of the Union must enjoy in all the other countries of the Union the advantages that their respective *laws* grant to nationals of these countries. What is the meaning of "laws" in this sentence?² The addition of the phrase, "without prejudice to the rights specially provided for by this Convention," makes it clear that "laws" does not include the application of the Convention itself, wherever such direct application is possible. The word "laws" must therefore be interpreted as meaning "national laws," not including international treaties, unless and in so far, of course, as such treaties have been incorporated in the national law. It is therefore possible for countries of the Union to conclude between themselves, or with other States, treaties the application of which is available only to nationals (and assimilated persons) of a limited number of countries. Bilateral treaties are an example in point, and also some of the Special

¹ Cf. *Actes de La Haye*, pp. 413/5.

² This subject has been discussed particularly with respect to a Draft Convention on a European Patent Law. See, for example: LADAS: *I.P.*, 1962, p. 23; FRAYNE: *I.P.*, 1962, p. 126; COLAS: *I.P.*, 1963, p. 48; ULMER: *I.P.*, 1963, p. 51; LADD: *I.P.*, 1963, p. 124; CHAVANNE: *Revue trimestrielle de droit commercial*, 1963, p. 505; VANDER HAEGHEN and EVRARD: *Ing. Conseil*, 1965, p. 1.

Agreements concluded in application of Article 19 of the Convention.¹ Only where the provisions of such treaty would entirely *replace* the national laws of the member States, so that important subjects of industrial property would no longer be dealt with by national legislation and therefore nationals of other countries of the Union would not have access to these provisions, could it be considered that the Convention was insufficiently implemented in the national law in view of Article 25 of the Convention.²

(f) "National treatment" is not all that can be claimed under the Convention because, as has been pointed out above under Chapter II.4, the Convention also contains a number of *common rules* which have to be respected by the member States. As has been explained, the effect of these common rules in the member States will vary according to their constitutions or constitutional systems. In countries where the possibility of "self-executing" treaty provisions is recognized, nationals of other countries of the Union may directly claim application of the self-executing provisions of the Convention by the administrative and judicial authorities. Examples of such self-executing provisions have been given above and will be further examined below. In countries where the self-executing character of treaty provisions is not accepted, there is no possibility of direct application of the provisions of the Convention by the administrative and judicial authorities, but these countries are bound to introduce such provisions into their domestic law (Article 25 of the Convention), so that they will come under the rule of national treatment.³

The question has been raised whether nationals of a country of the Union will be able to claim application of the Convention also *in their own country*. This question is of no importance with respect to the rule of "*national treatment*" because nationals of a country will enjoy such treatment in their own country anyhow. The question remains, however, whether, in these conditions, nationals can also claim application in their own country of *the common rules of the Convention* in so far as they are accepted as "self-executing" when these rules have not been incorporated in the national law. The provision under examination only states that nationals of a country of the Union can

¹ Cf. Articles 1(2) and 2 of the Madrid Agreement concerning the International Registration of Trademarks, revised at Nice in 1957, and Article 1 of the Hague Agreement concerning the International Deposit of Industrial Designs, revised at London in 1934.

² See above *ad* Article 1(2), final part of observation (*k*).

³ Cf. *Actes de La Haye*, p. 536.

claim application of national laws and of the Convention "in all the other countries" of the Union. This is logical, because the Convention is an international instrument destined to govern international situations. The protection of a national in his own country depends on the domestic legislation of that country and such national will therefore not be able to claim application of the Convention in his own country unless its legislation entitles him to do so.¹

(g) The sentence beginning with the word "Consequently" explains the consequence of the rule in the first sentence of the provision. It is self-explanatory.

ARTICLE 2, paragraph (2)^(a)

(2) However (b), no requirement as to domicile or establishment in the country where protection is claimed may be imposed upon nationals of countries of the Union for the enjoyment of any industrial property rights (c).

(a) This provision was introduced into the Convention at the Revision Conference of Washington in 1911.² It has not been substantially modified since.

(b) The word "however" was added to the text at the Revision Conference of The Hague in 1925 in order to indicate that the provision restricts the rule of paragraph (1) of the Article.³ Even when the conditions imposed upon nationals of a country include the stipulation that *those nationals* can claim protection of certain industrial property rights only if they are domiciled or established in the country, this same stipulation cannot be imposed upon *nationals of other countries* of the Union.⁴

(c) For nationals of the countries of the Union, the question where they are domiciled or established is irrelevant. The fact that no

¹ Cf. in France: Act of 4/4/1931, commented upon by PLAISANT: *Traité de droit conventionnel international concernant la propriété industrielle*, p. 76, and by ROUBIER: *Le droit de la propriété industrielle*, 1, p. 242; in Belgium: Act of 27/4/1965, *Ing. Conseil*, 1965, p. 207.

² *Actes de Washington*, pp. 94 (proposal of France), 270 (report of Sub-Committee), 306 (report to Plenary Committee), 245/6 (discussion and adoption in Third Plenary Session).

³ *Actes de La Haye*, p. 536.

⁴ Cf. in France: Cour de Paris, 14/3/1953, *Ann.*, 1953, p. 15; Cour de Cassation, 3/2/1959, *Ann.*, 1959, p. 1.

establishment in the country where protection is claimed may be required does not however diminish the possibility of an obligation to exploit certain industrial property rights in such country.¹

ARTICLE 2, paragraph (3)^(a)

(3) The provisions of the laws of each of the countries of the Union relating to judicial and administrative procedure (b) and to jurisdiction (c), and to the designation of an address for service or the appointment of an agent (d), which may be required by the laws on industrial property are expressly reserved.

(a) Parts of this provision were already introduced under paragraph 3 in the Final Protocol which formed an integral part of the original Convention of 1883.² The provision was enlarged in the Final Protocol adopted at the Revision Conference of Washington in 1911,³ and was introduced into the Convention itself at the Revision Conference of The Hague in 1925.⁴ Since then it has been changed only as to form.

(b) An example of a permissible discrimination against nationals of other countries of the Union as to procedure is the obligation to deposit a "*cautio iudicatum solvi*."⁵

(c) An example of a permissible discrimination as to jurisdiction is the right to sue a national of another country in a court of the country where the plaintiff is domiciled or established.

(d) In the same category of procedural questions is the obligation, imposed by the legislation of several countries upon persons not domiciled or established in the country, to elect an address for service or to appoint an agent in order to facilitate procedural matters. Such obligation may be imposed upon nationals of the countries of the Union.

¹ *Actes de Washington*, pp. 306 (report to Plenary Committee), 245/6 (declaration in Third Plenary Session).

² *Actes de Paris*, I, pp. 125, 150.

³ *Actes de Washington*, pp. 42/4 (proposal), 270/1 (report of Sub-Committee), 311/2 (report to Plenary Committee), 246/7 (adoption in Third Plenary Session).

⁴ *Actes de La Haye*, pp. 224 (proposal), 517 (report of General Committee), 536/7 (report of Drafting Committee), 572 (adoption in Second Plenary Session).

⁵ Cf. in France: Cour de Lyon, 13/5/1957, *Ann.*, 1958, p. 175.

ARTICLE 3^(a)

Nationals (b) of countries outside the Union who are domiciled (c) or who have real and effective industrial establishments (d) in the territory of one of the countries of the Union shall be treated in the same manner (e) as nationals of the countries of the Union.

(a) This provision appeared already in essence in the original text of the Convention of 1883.¹ The words "real and effective" were added in the Additional Act to the Convention, adopted by the Revision Conference of Brussels in 1900.² Since then the provision has been changed only as to form.

(b) For the criterion of *nationality*, see above at Article 2, paragraph (1), observation (b). The effect of speaking in Article 3 of "nationals" is that only *nationals* of countries outside the Union who also fulfil the further conditions indicated in the Article may claim application of the Convention, and not persons without such nationality fulfilling the same further conditions. However, the member States are free to grant the same protection also to such non-nationals, and they may wish to do so as the wording of the provision would seem unnecessarily narrow.

(c) With respect to the notion of *domicile*, a distinction has again to be made between *natural* and *legal persons*.

With respect to *natural* persons, the word "domicile" can have different meanings depending on national legislation. Under some of these legislations a natural person can obtain "domicile" only by virtue of an official authorization; other legislations interpret "domicile" as more or less equivalent to residence.

It is generally believed³ that the Convention has not sought, by using the expression "domicile," to indicate a legal situation, but rather a *more or less permanent situation of fact*. The purpose of the provision under consideration would thus be to admit to the benefits of the Convention foreign nationals *residing* in a country of the Union.

¹ *Actes de Paris*, I, pp. 129/32, 137/8.

² *Actes de Bruxelles*, pp. 163/4 (proposal of France), 196/200 (discussion in Third Plenary Session), 311 (discussion and adoption in Ninth Plenary Session).

³ Cf. LADAS: *The International Protection of Industrial Property*, pp. 187/8; ROUBIER: *Le droit de la propriété industrielle*, I, pp. 268/9.

With respect to *legal* persons, their "*domicile*" can be considered, according to the same principles, to be the place of their actual headquarters.

Domicile in a country of the Union does not enable the person who is domiciled there to claim application of the Convention in the country itself. This is so because he has to be treated in the same manner as nationals of countries of the Union and these nationals can claim application of the Convention only in the *other* countries of the Union. The protection of persons domiciled in the country itself will depend on the domestic legislation of that country.

(d) A further ground on which nationals of countries outside the Union may claim application of the Convention exists when they have a *real and effective industrial or commercial establishment* in one of the countries of the Union. The words "*industrial or commercial establishment*" will, if necessary, be interpreted by the administrative or judicial authorities of the country where application of the Convention is claimed. The words "*real and effective*" were added in the Additional Act to the Convention adopted by the Revision Conference of Brussels in 1897-1900.¹ The purpose of this addition was to avoid abusive claims to application of the Convention. The question whether an establishment is real and effective, and not a faked or ephemeral one, will again be determined by the administrative or judicial authorities of the country in which application of the Convention is claimed.² In the country itself where the real and effective industrial or commercial establishment exists, its protection will depend, for the same reasons as given above with regard to the criterion of domicile, on the domestic legislation.

(e) The prescribed treatment "*in the same manner*" means that persons who are entitled to benefit from Article 3 of the Convention enjoy, as do nationals of the countries of the Union, "*national treatment*" in other countries, without prejudice to the *rights specially provided for by the Convention*. Whether these latter rights will directly apply depends on the question whether their "*self-executing*" character is recognized in the country concerned.

¹ *Actes de Bruxelles*, pp. 196/200, 311.

² Cf. in U.S.A.: Commissioner of Patents, 21/5/1963, 138 *U.S.P.Q.* 316 (1963).

ARTICLE 4, Section A(1)^(a)

A(1) Any person (*b*) who has duly filed (*c*) an application (*d*) for a patent (*e*), or for the registration of a utility model, or of an industrial design, or of a trademark (*f*), in one of the countries of the Union (*g*), or his successor in title (*h*), shall enjoy, for the purpose of filing (*i*) in the other countries, a right of priority (*j*) during the periods hereinafter fixed (*k*).

(*a*) The right of priority, which is one of the important elements of the Convention,¹ was already incorporated in the original text of 1883.² The extension of the priority right to utility models and to successors in title of the original applicant was introduced at the Revision Conference of Washington in 1911.³ A clause which submitted the exercise of the right of priority to the rights of third parties was eliminated at the Revision Conference of London in 1934.⁴

(*b*) The term "any person" must be interpreted within the context of the rules of the Convention which define the persons capable of benefiting therefrom. The term thus means all persons entitled to claim application of the Convention according to Articles 2 and 3, that is, nationals of a country of the Union and nationals of countries outside the Union who are domiciled or have real and effective industrial or commercial establishments in the territory of one of the countries of the Union. This interpretation is confirmed by the discussion of the provision at the Conference of Paris, where the Convention was originally concluded.⁵ A similar interpretation was later given to the extension of the provision to successors in title (see, below, observation (*h*)).

National legislation may, however, go further and grant a similar right of priority also to other persons.⁶ It may also allow the nationals

¹ Cf. SEPÚLVEDA: "El derecho internacional convencional en materia de prioridad de patentes (La interpretación mexicana)," *Boletín del Instituto de derecho comparado de Mexico*, IX, 25, 1956, pp. 11, 14.

² *Actes de Paris*, I, pp. 26/7 (proposal for Article 3), 47/56, 60/4, 99, 128/32, 138 (discussions and adoption).

³ *Actes de Washington*, pp. 44/6 (proposal), 275/7 (report of Committee), 307 (report to Plenary Committee), 247/8 (discussion and adoption in Third Plenary Session).

⁴ *Actes de Londres*, pp. 167/72 (proposals), 248/50 (observations), 356/61 (report of Second Sub-Committee), 449/52 (report of Drafting Committee), 511/3 (discussion and adoption in Second Plenary Session).

⁵ *Actes de Paris*, pp. 99, 128/32, 137/8.

⁶ Cf. VANDER HAEGHEN: *Ing. Conseil*, 1965, p. 269.

of the country itself to claim priority there, based on an earlier foreign application.

The conditions as to the competence of persons to claim the right of priority under the Convention must be fulfilled both at the time of the application on which the right of priority is based and at the time when the right is invoked, but not necessarily during the whole period of priority. A national of a country of the Union may, for example, assign the right of priority to a person who is not at that time, but afterwards becomes, a national of such country before claiming the priority right, or he may assign this right first to a non-national of a Union country, who subsequently assigns the right to a national of such country; in such cases the priority right can be validly claimed.

(c) The right of priority can be based only on an application *duly filed* in one of the countries of the Union. The definition of what is understood by a regular national filing is given in paragraphs A(2) and (3) of the Article, which will be commented upon below.

(d) The right of priority can further be based only on the *first* application for the subject concerned in a country of the Union. This principle, designed to avoid a chain of successive claims of priority for the same subject, is not stated in the provision under consideration itself, but it follows from Article 4 C(2), where it is said that the period of priority starts from the date of filing of the *first* application, and from Article 4 C(4), where, under exceptional circumstances, a subsequent application is considered to be "the *first* application, of which the filing date shall be the starting point of the period of priority." It is therefore not possible, after filing an application for a patent or for the registration of a trademark, etc., in one country of the Union, to base a right of priority on a later application for the same subject in the same or in another such country.¹ However, an earlier filing in a country not belonging to the Union will not count.

(e) The right of priority is granted for applications for patents and other subjects of industrial property, as enumerated, with the addition of inventors' certificates referred to in Article 4 I. Some of these subjects may be interrelated in the exercise of the right of priority (see Article 4 E(1) and (2), and again Article 4 I).

¹ Cf. in Netherlands: Patent Office (Division of Appeals), 5/10/1960, *G.R.U.R. Int.*, 1961, p. 291.

(f) At the Revision Conference of Lisbon in 1958 the words "service marks" were inserted after "trademarks" in the enumeration of subjects of industrial property contained in Article 1(2). The same words were not inserted in the provision under consideration and the said Revision Conference refused generally to assimilate "service marks" to "trademarks."¹ This means that member States are under no obligation to grant a right of priority for service marks although they are free to do so if they wish.

(g) The right of priority can be based only on a first application filed *in a country of the Union*.² This means that, when an application has been filed in a country before its accession to the Convention becomes effective (cf. Article 21), no right of priority can be claimed for such application under the Convention. Conversely, in a country newly acceding to the Convention, no right of priority can be claimed under the Convention based on applications filed in other countries before the new accession took effect, because at the time of such applications the newly acceding country was not yet one of the "other countries" (of the Union).³ National legislation may, however, adopt a more lenient system.⁴

(h) The right of priority may also be invoked by the "successor in title" of the person who has filed the first application. This provision was added at the Revision Conference of Washington in 1911, where it was stated that such successor in title must be capable of benefiting from the Convention according to Articles 2 and 3.⁵

The right of priority may be transferred to a successor in title independently of the transfer or non-transfer of the first application on which it is based, and which can therefore remain with the original applicant or be transferred to a third person.⁶ The right of priority based on a first application can also be transferred independently for

¹ *Actes de Lisbonne*, pp. 624 (proposal of U.S.A.), 628/33 (discussion in Third Committee), 755/7 (report of Third Committee).

² Or a first application which is equivalent to a regular national filing under a bilateral or multilateral treaty concluded between countries of the Union (see, below, observation (d) on Article 4, Section A(2)).

³ See for U.S.S.R.: communication of Goscommittee, referred to in *G.R.U.R. Int.*, 1966, *Fortl. Ber.*, 1677/66.

⁴ Cf. SCHRICKER: "Die Inanspruchnahme der Unionspriorität bei Beitritt neuer Verbandsländer," *G.R.U.R. Int.*, 1966, p. 373.

⁵ *Actes de Washington*, p. 275.

⁶ Cf. in France: Tribunal de Grande Instance de Valence, 16/2/1962, *Ann.*, 1963, p. 313.

one or more countries of the Union. It remains an independent right until, during the period of its duration, it is used as the basis for an application in one or more countries of the Union, in which case it becomes an accessory of such application.¹

(i) The *subsequent* filing must concern *the same subject* as the *first* filing on which the right of priority is based. This means that in the case of patents, utility models or inventors' certificates it must concern the same invention or innovation, in the case of industrial designs, the same design, and in the case of trademarks, the same trademark for the same goods. However, while preserving the identity of the subject, the right of priority can in some cases be claimed to obtain a different form of protection (see Sections E(1) and (2) and I(1) and (2) of Article 4). Moreover, with regard to patents, special rules concerning the identity of the subject are given in Sections F, G and H of Article 4. These provisions will be commented upon below.

(j) The *consequences* of the right of priority are set out in Article 4 B. See the commentary on that provision.

(k) The *periods* of priority are regulated in Article 4 C(1) to (3), which will be commented upon below.

ARTICLE 4, Section A(2)^(a)

(2) Any filing that is equivalent to a regular national filing (b) under the domestic legislation (c) of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union (d) shall be recognized as giving rise to the right of priority.

(a) According to paragraph (1) of Article 4 the right of priority can be claimed only by a person who has *duly filed* an application for a patent, etc., in one of the countries of the Union. Several questions have arisen as to what is to be understood by "duly filed." Is it necessary that such filing only be correct as to form or also valid as to substance, so that a patent, etc., can be granted on it? Does it matter whether the application once filed is later withdrawn, abandoned, or rejected, etc.? ² Attempts to solve these questions were made by

¹ Cf. MATHÉLY: "Paris Convention — Special Questions concerning Patents and Trademarks," *BIRPI Lecture Course*, 1965, pp. 25/7.

² See LADAS: *The International Protection of Industrial Property*, pp. 272/5.

introducing paragraph (2) of the Article at the Revision Conference of London in 1934,¹ and by the further introduction of paragraph (3) at the Revision Conference of Lisbon in 1958.²

(b) What is meant by a "regular national filing" is further defined in paragraph (3) of the Article under consideration. See below.

(c) The paragraph under consideration states the principle that the question whether a regular national filing exists depends in the first place on the domestic legislation of the country of the Union where the first application is made.

(d) Since the domestic legislation of the country of the Union where the first application is made decides what a regular national filing is, it is conceivable that the said legislation attributes that quality also to a filing in another country or a filing according to an international treaty to which such country is a party. The latter situation would occur according to the Hague Agreement concerning the International Deposit of Industrial Designs of 1925, revised at London in 1934, because Article 4(4) of that Agreement states that the right of priority established by Article 4 of the Paris Convention will be guaranteed to every design which has been the subject of an *international* deposit, without requiring compliance with any of the formalities specified in the latter Article. This is, of course, binding on the member States of the Hague Agreement, but would it also oblige *other* countries, parties to the Paris Convention but *not* to the Hague Agreement, to acknowledge a priority right based on such international deposit or filing? A provision establishing such obligation was introduced at the Revision Conference of London in 1934.³

ARTICLE 4, Section A(3)^(a)

(3) By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned (b), whatever may be the subsequent fate of the application (c).

¹ *Actes de Londres*, pp. 248, 256 (proposals of Switzerland, Germany and Netherlands), 361/2 (report of Second Sub-Committee), 450 (report of Drafting Committee) 512 (discussion and adoption in Second Plenary Session).

² *Actes de Lisbonne*, pp. 311/26, 111.

³ See footnote 1.

(a) The question what is to be understood by "duly filed" not having been entirely solved by the introduction of paragraph (2) in Article 4, the Revision Conference of Lisbon in 1958 decided to introduce a further definition in paragraph (3). The proposal to that effect was extensively discussed and adopted in a modified form.¹

(b) During the discussions at the Lisbon Conference it was made clear that a regular national filing exists when, according to the domestic legislation of the country in which the filing took place, the application filed is correct *only as to form* and, even when it is incomplete or incorrect as to form, if it is sufficient to establish the *date* on which the application was filed.

(c) It was also made clear during the discussions at the Lisbon Conference that the subsequent fate of the first application on which the right of priority is based cannot prejudice this right. It therefore subsists when the first application is withdrawn, abandoned or rejected. It even exists when it pertains to an invention which is excluded from patentability in the country where the application was filed.²

ARTICLE 4, Section B^(a)

B. Consequently, any subsequent filing (b) in any of the other countries of the Union before the expiration of the periods referred to above (c) shall not be invalidated by reason of any acts accomplished in the interval (d), in particular, another filing (e), the publication or exploitation of the invention (f), the putting on sale of copies of the design (g), or the use of the mark (h), and such acts cannot give rise to any third-party right or any right of personal possession (i). Rights acquired by third parties before the date of the first application that serves as the basis for the right of priority are reserved in accordance with the domestic legislation of each country of the Union (j).

(a) This provision explaining the effect of the right of priority was, up to the words "and such acts cannot" etc., already included in essence in the original text of the Convention of 1883.³ However, at

¹ *Actes de Lisbonne*, pp. 311/2 (proposal), 312/7 (observations), 317/25 (discussion in Second Committee), 522/3 (report of Second Committee), 111 (adoption in Second Plenary Session), 114 (General Report).

² *Ibidem*, p. 311.

³ *Actes de Paris*, I, pp. 26/27 (proposal), 47/52, 60/1, 128, 138 (discussions and adoption).

that time the first paragraph of the Article contained a very important reservation in that it stated that the enjoyment of the priority right was "subject to the rights of third parties." At the Revision Conference of London in 1934 this clause was eliminated from Section A(1) and, instead, the final part of Section B, starting with the words "and such acts cannot" etc., and including a new second sentence, was added.¹

(b) For the meaning of "subsequent filing" see, above, observation (i) regarding Article 4, Section A(1).

(c) The periods of priority are referred to in Article 4, Section A(1), but are regulated in Section C(1), (2) and (3), to be examined below.

(d) The provision states that a subsequent filing during the period of the priority right shall not be "invalidated" by any acts accomplished during such period. However, after the deletion of the reservation of third-party rights at the Revision Conference of London in 1934 the scope of the right of priority has become even wider: it means that the effect of the subsequent filing must not be less than it would have been had that filing been effected at the time of the first filing in another country of the Union on which the right of priority is based.² How this end is achieved depends on the domestic legislation of the country in which the right of priority is claimed. However, some *examples* of the effect of the right of priority are indicated in the provision under consideration.

(e) One of the examples of the effect of the right of priority is that another *filing* of an application for the same subject (patent, registration of utility model, design or trademark) during the period of priority cannot invalidate the subsequent filing for which the right of priority is claimed. In case of conflict, the first-mentioned filing will be rejected by the examining Office or invalidated by the courts.

(f) Nor will the *publication* or *exploitation* of the invention, whether by the person who filed the first application for a patent or by third parties,³ during the period of the priority right, invalidate or

¹ *Actes de Londres*, pp. 167/72 (proposal), 248/50 (observations), 356/61 (report of Second Sub-Committee), 449/52 (report of Drafting Committee), 511/13 (discussion and adoption in Second Plenary Session).

² *Actes de Lisbonne*, p. 311; see also in Federal Republic of Germany: *Bundesgerichtshof*, 25/11/1965, *G. R.U.R. Int.*, 1966, p. 382.

³ *Actes de La Haye*, p. 225.

prejudice the subsequent filing for which the right of priority is claimed; particularly, it will neither destroy the novelty of the invention nor diminish the inventive step embodied in it, as considered at the date of the first application on which the right of priority is based.

(g) The same is true for the putting on sale, during the period of priority, of copies of a design for which the right of priority is claimed, or, for that matter, for any other form of publication of such design during the priority period: such acts will neither destroy the novelty nor diminish the originality of a design which was novel or original at the date of the first application for its registration on which the right of priority is based.

(h) In the case of trademarks, the *use* of a mark, in countries where such use in itself has a legal effect, during the period of priority, cannot effect the validity of an application for registration of the mark for which priority is claimed, nor diminish the scope of its protection. As has been observed above, the same is true for a filing of an application for registration of the same mark during the priority period.

(i) The importance of the right of priority granted by the Convention was limited as long as rights of third parties originating in the priority period were expressly reserved. This reservation was generally interpreted as, for example, enabling third parties who had worked an invention during the priority period or who had obtained knowledge of the invention during that period to use or to continue to use it even in the face of a patent granted on the basis of a priority right.¹ The reservation was abolished by the Revision Conference of London in 1934, which replaced it by a sentence with the opposite effect: acts accomplished during the period of the priority right "cannot give rise to any third-party right or any right of personal possession."

(j) Since the right of priority comes into being only at the date of the first regular national filing in a country of the Union, it cannot affect rights of third parties acquired under national laws *before* such first filing. This has always been the intention of those drafting the Convention and, in order to render the situation absolutely clear, a provision to that effect was added at the Revision Conference of London in 1934.² Whether such rights acquired in one of the countries

¹ See LADAS: *The International Protection of Industrial Property*, pp. 308 *et seq.*

² *Actes de Londres*, pp. 167/72 (proposal), 248/50 (observations), 356/61 (report of Second Sub-Committee), 449/52 (report of Drafting Committee), 512/3 (discussion and adoption in Second Plenary Session).

of the Union will also have any effect in the other member States will depend on the domestic legislation of the latter.

ARTICLE 4, Section C(1), (2) and (3)^(a)

C(1) The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks *(b)*.

(2) These periods shall start from the date of filing of the first application *(c)*; the day of filing shall not be included in the period *(d)*.

(3) If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day *(e)*.

(a) These provisions regulate the different periods of duration of the right of priority for the various subjects for which this right may be claimed. In the original text of the Convention of 1883 these periods were six months for patents and three months for industrial designs and trademarks, with an extra month in any of these cases for applications coming from overseas countries. No further regulation of the priority periods was then provided for in the Convention, so that the computation of these periods was left to the member States. Gradually, in the subsequent Revision Conferences, the periods of the duration of the priority right were extended and further rules were given. At the Revision Conference of Brussels in 1900 the priority period for patents was fixed at twelve months and for industrial designs and trademarks at four months, the extra month for overseas applications being abolished. At the Revision Conference of Washington in 1911 these periods were not changed, but the benefit of the right of priority was extended to utility models, with the same period as for patents. Proposals to extend the priority period to twelve months also for industrial designs and trademarks were rejected.¹ At the Revision Conference of The Hague in 1925 the periods of priority for designs and trademarks were fixed at six months, and the additional provisions

¹ *Actes de Washington*, pp. 91 (proposal of Germany), 95 (proposal of France), 275 (report of Sub-Committee), 307 (report to Plenary Committee), 247 (discussion in Third Plenary Session).

of paragraphs (2) and (3) were added.¹ The regulation thus obtained was not substantially changed at the later Revision Conferences of London in 1934 and Lisbon in 1958: proposals to extend the period of duration of the priority right for trademarks made at these Conferences² were not accepted.

(b) The periods of priority must strike a balance between the interests, on the one hand, of the applicant for an industrial property right, who should be allowed to organize the international extension of such right in the countries of the Union during an adequate period, enjoying a priority as from his first filing date, and the interests, on the other hand, of third parties, who should not be confronted with too extensive periods of priority during which rights they might wish to acquire for the same subjects cannot be validly obtained. The periods adopted in the provision under consideration may be considered to strike such a balance, because they have not been changed since 1925.

(c) The question whether an application is the *first* application for the subject concerned is relatively easy to solve for trademarks, industrial designs, and, to a lesser extent, utility models. It may give rise to difficulties with regard to patent applications, where the decisive factor will be in which application the invention is disclosed for the first time,³ as specified by Article 4 H. See, below, the commentary on that provision.

(d) This provision, added at the Revision Conference of The Hague in 1925, is self-explanatory.

(e) This provision, added in substance at the Revision Conference of The Hague and improved by the Revision Conference of London in 1934,⁴ is also self-explanatory.

¹ *Actes de La Haye*, pp. 225/32 (proposals), 334/5 (observations), 426/7 (report of Second Sub-Committee), 518 (report of General Committee), 538 (report of Drafting Committee), 572 (adoption in Second Plenary Session).

² *Actes de Londres*, pp. 169, 172; *Actes de Lisbonne*, p. 538.

³ Cf. in Federal Republic of Germany: Bundesgerichtshof, 6/10/1959, *G.R.U.R. Int.*, 1960, p. 506; see also for the date of filing in case of postdating: U.K. Assistant Comptroller, 3/10/1960, *R.P.C.*, 1961, p. 228.

⁴ *Actes de Londres*, pp. 364 (proposal of Netherlands and report of Second Sub-Committee), 452/3 (report of Drafting Committee).

ARTICLE 4, Section C(4)^(a)

(4) A subsequent application (b) concerning the same subject (c) as a previous first application within the meaning of paragraph (2), above, filed in the same country of the Union, shall be considered as the first application, of which the filing date shall be the starting point of the period of priority (d), if, at the time of filing the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority (e). The previous application may not thereafter serve as a basis for claiming a right of priority (f).

(a) This paragraph, dealing with the exceptional circumstances in which a subsequent application for the subject concerned (patent, registration of utility model, industrial design or trademark) may be considered the *first* application, on which the right of priority is based, was introduced into the Convention at the Revision Conference of Lisbon in 1958.¹

(b) Why did the Lisbon Conference accept that, under certain circumstances, a subsequent application may serve as a basis for a priority right whereas, in principle, only a *first* application in one of the countries of the Union can serve that purpose (cf., above, observation (d) on Article 4, Section A(1))? The reason is that it frequently happens in the case of patents (and possibly also utility models), and may also happen in the case of designs and trademarks, that the first application, made in a hurry because the acquisition of the right concerned, as well as the right of priority, will frequently depend on when the application is filed, does not adequately represent the applicant's intentions. Failing a special provision regulating this matter the applicant would be unable to replace his application by a better one without losing the right of priority, because the said application would not be the *first* concerning the same subject and therefore could not be recognized as a basis for the priority right. In order to eliminate this difficulty the paragraph under consideration allows, *under certain precise conditions*, a subsequent application to replace the first application for the purpose of claiming the priority right.

¹ *Actes de Lisbonne*, pp. 327/8 (proposal), 329/32 (observations), 332/9 (discussion in Second Committee), 523/4 (report of Second Committee), 99 (adoption in Second Plenary Session), 114/5 (General Report).

(c) See observation (i) on Article 4 A(1), above.

(d) The filing date which will be considered the starting point of the period of priority will be the date of *subsequent* application, the first application being disregarded under the conditions indicated in the provision.

(e) In order that the subsequent application may be considered the first application, the following conditions have to be fulfilled with respect to the previous first application filed *for the same subject in the same country* :

the previous application must, *before* the subsequent application is filed, have been *withdrawn, abandoned or refused* ;

the previous application must *not* have been *laid open to public inspection* ;

the previous application must *not leave any rights outstanding* ;

the previous application must *not yet* have served as a *basis for claiming a right of priority*, either in the same or in any other country.

If any of these conditions is not fulfilled, the country of the Union in which priority is claimed on the basis of the subsequent application will refuse to recognize this priority.

Furthermore, the replacement of a previous application by a subsequent application will not be accepted if in the period between these applications *another* application has been filed for the same subject by the same applicant in the same or another country of the Union.¹ This is so because in such cases the subsequent application, at the time of its filing, cannot be considered as being the first.

(f) *After the replacement* of a previous application by a subsequent application as a basis for the right of priority, priority may no longer be recognized in any country of the Union on the basis of the previous application.

ARTICLE 4, Section D^(a)

D(1) Any person desiring to take advantage of the priority of a previous filing shall be required (b) to make a declaration (c) indicating the date of such filing and the country in which it was made (d). Each country shall determine the latest date on which such declaration must be made (e).

¹ *Actes de Lisbonne*, p. 333.

(2) These particulars shall be mentioned in the publications issued by the competent authority, and in particular in the patents and the specifications relating thereto (*f*).

(3) The countries of the Union may require (*g*) any person making a declaration of priority to produce a copy of the application (description, drawings, etc.) previously filed. The copy, certified as correct by the authority which received such application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation (*h*).

(4) No other formalities may be required (*i*) for the declaration of priority at the time of filing the application (*j*). Each country of the Union shall determine the consequences of failure to comply with the formalities prescribed by this Article, but such consequences shall in no case go beyond the loss of the right of priority (*k*).

(5) Subsequently (*l*), further proof may be required.

Any person who avails himself of the priority of a previous application shall be required to specify the number of that application; this number shall be published as provided for by paragraph (2), above (*m*).

(a) The original text of the Convention of 1883 did not contain any rules regarding the questions when and how the right of priority may be claimed. This was unsatisfactory because national legislation could then allow priority to be claimed at a late stage, for example, when the nullity of a patent or of a trademark registration was alleged in court. The claim of priority could thus come as a surprise to third parties, who could not have known of its existence and who had acted accordingly. Furthermore, many different systems could and did exist for claiming the right of priority in the countries of the Union.¹

At the Revision Conference of Washington in 1911 the essence of the provisions regulating when and how the right of priority may be claimed was introduced into the Convention.² Relatively minor

¹ See LADAS: *The International Protection of Industrial Property*, p. 286.

² *Actes de Washington*, pp. 45/6, 227 (proposals), 91, 95, 115 (observations), 275/6 (report of Sub-Committee) 307/8 (report to Plenary Committee), 248 (adoption in Third Plenary Session).

improvements were adopted by the following Revision Conferences of The Hague in 1925,¹ of London in 1934² and of Lisbon in 1958.³

(b) *Some of the formal requirements* for the claiming of the right of priority are *mandatory* for the member States, because it is necessary that third parties be informed of such claims in time (cf. paragraph (2) of the provision under examination). The member States are therefore not allowed to depart from these requirements. If they are not fulfilled, the priority cannot be considered validly claimed.

(c) The form of the declaration may be prescribed by the national legislation of the country concerned.

(d) The mandatory formal requirements for the claiming of the right of priority are the indication of the *date* of the previous filing on which the claim of priority is based, and of the *country* in which such filing was made. The Revision Conference of Lisbon in 1958 added to these requirements the indication of the *number* of the previous application, but in another context and not necessarily with the same consequences (cf. observation (m) below).

In countries where applications, or at least claims of priority, are not examined as to substance, the indication of the above particulars may suffice; they will be noted and published without examining whether they are justified, a question which only the courts can decide later. Other countries may wish to prescribe more formalities—cf. paragraph (3) of the provision under consideration—in order to be able to examine priority claims as to substance, for example, with respect to the question whether the application on which the claim of priority is based was the *first* application for the subject concerned, or as regards the *identity of subject* between the first and the subsequent applications.

(e) It is mandatory for all member States to determine the latest date on which the declaration containing the above particulars

¹ *Actes de La Haye*, pp. 230/1, 233 (proposal), 336 (observations), 428/9 (report of Second Sub-Committee), 518 (report of General Committee), 538/9 (report of Drafting Committee), 572 (adoption in Second Plenary Session).

² *Actes de Londres*, pp. 251/2 (proposals), 365/6 (report of Second Sub-Committee), 453/4 (report of Drafting Committee), 513 (discussion and adoption in Second Plenary Session).

³ *Actes de Lisbonne*, pp. 460/1 (proposal), 465/70 (observations), 471/79 (discussion in Second Committee), 532/3 (report of Second Committee), 99 (adoption in Second Plenary Session), 115 (General Report).

concerning a previous filing on which a claim of priority is based must be made. They may prescribe that such declaration must be made *together* with the filing of the application for which priority is claimed. They may also allow such declaration to be made later, within a certain period after the filing of the latter application, if they wish thus to facilitate the claiming of the right of priority. However, the period for making the declaration after the filing of the subsequent application must be so fixed that the country concerned can comply with the obligation to publish the particulars contained in the declaration in due time, according to paragraph (2) of the provision under examination.

(f) It is recalled that the right of priority provided by the Convention applies not only to patent applications but also to applications for registration of a utility model, an industrial design or a trademark (Article 4, paragraph A(1)). In all publications regarding these applications issued by the competent authorities of the member States, the required particulars concerning the right of priority must be mentioned, in order that third parties can be informed of them as soon as possible. Lack of such *publication* will not, however, invalidate the right of priority.¹

(g) As has been pointed out in observation (d) above, the member States *may* prescribe for the claiming of the right of priority formalities other than a mere declaration containing certain particulars. These possible additional formalities are enumerated in paragraph (3) of the provision under consideration. They may consist in the *production of a copy* of the previous application on which the claim of priority is based, *certified as correct* by the authority with which this first application was filed, and, if required, also in the production of a *certificate* from the same authority showing the *date of filing*, and a *translation*. Details concerning these requirements may be fixed by national legislation. However, such legislation must respect the further requirements in the provision under consideration, namely, that *no authentication* of the certified copy of the original application shall be required and that a *minimum*² *term of three months* after the filing of the subsequent application must be granted for the filing of such copy, *without fee*. For the filing of such copy *after* this minimum term, a fee may be prescribed.³

¹ *Actes de Washington*, p. 307.

² *Actes de La Haye*, pp. 429, 538; *Actes de Londres*, p. 513.

³ *Actes de Londres*, p. 513.

(h) The translation which the national legislation of the country in which priority is claimed may require will naturally be a translation into the official language, or one of the official languages, of that country.

(i) This provision, limiting the formalities which may be required, is again mandatory for the member States, in order to facilitate the claiming of the priority right.

(j) Since paragraphs (1) and (3) of the provision under consideration allow for the filing of documents at a later stage than that of the filing of the application for which the right of priority is claimed, the words "at the time of filing" must be interpreted as meaning during the period of filing when the priority right can be claimed and documentation related to it can be produced. At a later stage—cf. paragraph (5), first sentence, of the provision under examination—for example, when the nullity is alleged of a right or registration already granted with acknowledgement of the right of priority, further proof of the existence of the latter right may be required,¹ for example, regarding the identity of the subject of the first and subsequent applications.

(k) This provision deals only with the consequences of failure to comply with the *formalities* prescribed by the Article under consideration. It must be interpreted as referring not only to the mandatory but also to the permissive formalities. The consequences of failure to comply with these formalities will be determined by national legislation,² but may not go beyond the *loss of the right of priority*. Therefore, the absence of compliance with these formalities will not, *as such*, result in the loss of the right to the patent, utility model, industrial design or trademark involved. However, the loss of such right may occur as a *consequence* of the loss of the right of priority, if, for example, without the latter the former has been anticipated by publication of the invention or by registration or use of the trademark by a third party, etc.

The provision under examination does not concern objections to the claiming of priority other than failure to comply with *formalities*, such as, for example, the objection that such claim is not based on a *first* application in one of the countries of the Union or that there is

¹ *Actes de Washington*, pp. 307/8.

² Cf. in France: Cour de Paris, 10/1/1967, *Ann.* 1967, p. 23.

no identity of subject between the applications on the basis of which and for which priority is claimed. Member States are free to determine in their national legislation the consequences of these objections to a claim of priority.¹

(l) See observation (j) above.

(m) The second sentence of paragraph (5) of the provision under consideration was added at the Revision Conference of Lisbon in 1958, in order to supplement the information to be given regarding claims for priority rights.² Although the indication of the *number* of the previous application on which the claim for the right of priority is based completes the particulars to be given in the declaration required by paragraph (1) of the provision under discussion and has to be included in the publication prescribed in paragraph (2), the obligation to indicate such number has not been included in paragraph (1). The reason is that such indication is not always possible, and the absence of or an error in the indication of the number should not, under national legislation, automatically lead to a loss of the priority right.³

ARTICLE 4, Section E^(a)

E(1) Where an industrial design is filed in a country by virtue of a right of priority based on the filing of a utility model (b), the period of priority shall be the same as that fixed for industrial designs (c).

(2) Furthermore, it is permissible to file a utility model in a country by virtue of a right of priority based on the filing of a patent application, and vice versa (d).

(a) The Convention did not deal with utility models until the Revision Conference of Washington in 1911, when this notion was introduced in Articles 2, 4 A and C, 11 and 12, while the Final Protocol

¹ Cf. SCHRICKER: "Fragen der Unionspriorität im Patentrecht," *G.R.U.R. Int.*, 1967, p. 85 (English translation in *I.P.*, 1967, p. 113).

² *Actes de Lisbonne*, pp. 460/1.

³ *Ibidem*, pp. 465 (observation of Federal Republic of Germany), 471, 478, 532.

contained what is now Article 4 E(1).¹ The entire provision now under E was added to the Convention itself by the Revision Conference of The Hague in 1925.² Since then it has been modified only as to form.

(b) It will rarely happen that an industrial design and a utility model concern the same subject because, in principle, the first concerns ornamental aspects of an industrial article whereas the latter relates to its technical novelty. However, since it is a matter for national legislation to define these subjects, cases of overlapping may occur. In such cases, on condition that the identity of the subject is preserved, the right of priority can be claimed to obtain a different form of protection. The provision under consideration deals only with the case where the *first* application is filed for a *utility model* and afterwards, on the basis of this application, priority is claimed for an application in respect of an *industrial design*. The reverse case is not mentioned, but can be taken to be included.³

(c) In the case regulated by the provision, the period of priority will be that fixed for industrial designs, which is six months. In view of Section C(1) of the Article under consideration the same period of priority will prevail in the reverse case, where the first application is filed in respect of an industrial design, on the basis of which priority is claimed for a utility model.⁴

(d) This provision is self-explanatory.⁵ The period of priority does not present any problem here since it is the same for patents and utility models (twelve months).

ARTICLE 4, Section F^(a)

F. No country of the Union may refuse a priority or a patent application on the ground that the applicant claims multiple

¹ *Actes de Washington*, pp. 42/3, 46, 227 (proposals), 275 (report of Committee), 248/9 (adoption in Third Plenary Session).

² *Actes de La Haye*, pp. 231/3 (proposal), 429/30 (report of Second Sub-Committee), 518 (report of General Committee), 539 (report of Drafting Committee), 572 (adoption in Second Plenary Session).

³ *Ibidem*, pp. 231, 233, 429/30, 495, 518. See also in Federal Republic of Germany: Bundespatentgericht 10/11/1967, *G.R.U.R. Int.*, 1968, p. 204.

⁴ Cf. in Federal Republic of Germany: Bundespatentgericht 10/11/1967, *G.R.U.R. Int.*, 1968, p. 206.

⁵ Cf. for its history: *Actes de La Haye*, pp. 231/2.

priorities (b), even if they originate in different countries (c), or on the ground that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed (d), provided that, in both cases, there is unity of invention within the meaning of the law of the country (e).

With respect to the elements not included in the application or applications whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions (f).

(a) This Section and also the following Sections G and H do not deal with the right of priority regarding *all* subjects of industrial property enumerated in Section A of the Article under consideration, but only with the priority right regarding applications for *patents*.¹ Section F is concerned with the subjects of *multiple* and *partial* priorities,² whereas Section G regulates the question of *dividing applications* for which priority may be claimed. Some parts of these provisions were introduced into the Convention at the Revision Conference of The Hague in 1925.³ At the following Revision Conferences of London in 1934 and of Lisbon in 1958 the subjects concerned were more clearly separated and their regulation was improved (see, below, observation (a) on Section G).

(b) It frequently happens that an invention is not immediately complete, so that, even after a patent application has been filed for it, improvements or additions are found which are made the subject of other patent applications. The Convention makes it possible to claim, *in one and the same later application in other countries of the Union*, separate (multiple) priorities for the different parts of the invention, based on the various first applications made in respect of each of those parts, provided, of course, that these various applications

¹ This does not mean that the member States may not apply the same principles to other subjects of industrial property, for example, in recognizing multiple or partial priorities in case of collective filings of industrial designs or of the same trademark for different goods, but they are under no obligation to do so.

² Cf. SCHRÜCKER: "Fragen der Unionspriorität im Patentrecht," *G.R.U.R. Int.*, 1967, p. 85 (English translation in *I.P.*, 1967, p. 113).

³ *Actes de La Haye*, pp. 337 (proposal of France), 430 (report of Second Subcommittee), 518/9 (report of General Committee), 539 (report of Drafting Committee), 572 (adoption in Second Plenary Session).

are filed within the term of priority counted from the first application. For the question of unity of invention, see under observation (e) below.

(c) According to an addition introduced into the provision at the Revision Conference of Lisbon in 1958,¹ the above procedure is even possible when the first applications in respect of different parts of the invention are filed in different countries.

(d) A second addition made to the provision under examination at the Revision Conference of Lisbon in 1958² concerns the possibility of *partial* priorities. It frequently happens that, after a first application for a patent has been filed, subsequent applications in respect of the same invention for which the priority of the first application is claimed contain elements of the invention which were not present in the first application and for which either no separate patent application has been filed in time to claim multiple priorities or no separate patent application will be filed at all (for example, because the added elements do not, in themselves, have an inventive character). Under the Convention, such additions in later applications will not prevent priority from being recognized for those other elements of the invention which were already present in the first application. It is also possible to combine multiple with partial priorities, if multiple priorities are claimed on the basis of separate first applications in respect of different parts of an invention to which, in the later application for which these priorities are claimed, new elements are also added for which no priority is claimed.

The elements added to an invention for which no priority is claimed in a later application, because they were not contained in any first application, may, of course, create a new priority right on the basis of the application in which they were introduced for the first time. The second sentence of the paragraph under examination makes this clear.³

(e) Many national patent legislations provide that a patent application may concern only one invention. These provisions must also be observed in the case of multiple and partial priorities. If, according

¹ *Actes de Lisbonne*, pp. 342/3 (proposals of Belgium and Netherlands), 345/6, 348 (discussion in Second Committee), 524/5 (report of Second Committee), 100 (adoption in Second Plenary Session), 115 (General Report).

² *Ibidem*, pp. 340/4 (proposal and observations), 345/8 (discussion in Second Committee), 524/5 (report of Second Committee), 100 (adoption in Second Plenary Session), 115 (General Report).

³ *Ibidem*, pp. 346/8.

to the law of the country in which priority is claimed, there is no unity of invention in an application for which multiple and/or partial priorities are claimed, the application may be divided according to Section G of the Article under consideration or, if it is not so divided, it may be refused.

(f) See, above, the final observation under (d).

ARTICLE 4, Section G^(a)

G(1) If the examination (b) reveals that an application for a patent contains more than one invention (c), the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any (d).

(2) The applicant may also, on his own initiative (e), divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized (f).

(a) As has been observed already—see observation (a) regarding Section F of Article 4—the principle of paragraph (1) of this provision concerning the possibility of *dividing patent applications*¹ was introduced into the Convention at the Revision Conference of The Hague in 1925.² At the Revision Conference of London in 1934 the text of this paragraph was separated from what is now Section F, and improved,³ whereas paragraph (2) was added at the Revision Conference of Lisbon in 1958.⁴

¹ See, for this subject, PFANNER: "Die Teilung von Patentanmeldungen," *G.R.U.R. Int.*, 1966, p. 262.

² *Actes de La Haye*, pp. 337 (proposal of France), 430 (report of Second Sub-Committee), 518/9 (report of General Committee), 539 (report of Drafting Committee), 572 (adoption in Second Plenary Session).

³ *Actes de Londres*, pp. 170, 173 (proposal), 255 (observations), 367/9 (report of Second Sub-Committee), 454/5 (report of Drafting Committee), 513/4 (adoption in Second Plenary Session).

⁴ *Actes de Lisbonne*, pp. 501 (proposal of U.K.), 502/5 (discussion in Second Committee), 534 (report of Second Committee), 100 (adoption in Second Plenary Session), 115 (General Report).

(b) This provision will apply only in countries where the examination of patent applications makes it possible to ascertain whether such applications contain more than one invention. This will probably not be the case in countries where patent applications are examined only as to form.

(c) According to the authentic French text of the Convention, which prevails over translations (Article 29(1)(c)), the provision is applicable in all cases where the examination reveals that an application for a patent is “*complexe*.” In the official English text of the Convention the word “*complexe*” has been translated by “contains more than one invention.” This is not quite accurate, because it may happen that, according to the legislation of the country of examination, a patent application is considered “complex” for reasons other than lack of unity of invention,¹ for example, because it contains a forbidden combination of claims for manufacture and use of the same invention. In such cases, the provision under consideration will also apply, although its use in cases where the application contains more than one invention will probably be much more frequent.

(d) When the examination has revealed complexity of the application, the applicant may divide it into a certain number of divisional applications with the consequences attached to such division specified in the provision under examination. The provision is placed in Article 4 concerning the right of priority and normally priority rights will be involved in, and preserved notwithstanding, division of a patent application. However, the words “of the right of priority, if any” show that the provision will also apply if no priority right is claimed.

(e) This provision, concerning the possibility open to the applicant to divide his patent application *on his own initiative*, without previous examination having revealed any complexity in it, was introduced into the Convention at the Revision Conference of Lisbon in 1958. The provision is a broad one: it includes division of patent applications for reasons other than complexity or lack of unity of invention;² it also includes cases where no priority is claimed—see, above, under observation (d)—and it will also apply in countries where patents are examined only as to form.³ Of course, after division of a patent

¹ *Actes de La Haye*, p. 337: the French proposal, which originated the provision, aimed at complexity *within* unity of invention, namely, because of multiple priorities.

² *Actes de Lisbonne*, pp. 503/4.

³ *Ibidem*, p. 504.

application the separated parts must each satisfy the legal conditions for the granting of a patent, in order that such patent may be granted.

(f) The possibility of dividing patent applications on the initiative of the applicant having been accepted by the Convention, the conditions of the exercise of such right—for example, a term within which it must be exercised—are left to be determined by national legislation.¹

ARTICLE 4, Section H^(a)

H. Priority may not be refused on the ground that certain elements of the invention (b) for which priority is claimed do not appear among the claims (c) formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements (d).

(a) This provision was introduced into the Convention at the Revision Conference of London in 1934.²

(b) Although the provision under examination does not explicitly state that it applies only to cases where priority is claimed with regard to applications for *patents*, the word “invention” makes it clear that this is nevertheless the scope of the provision. The reasons for special treatment of applications for patents in this respect are the following :

As has been observed above—observation (i) regarding Article 4 A(1)—the exercise of the priority right requires *identity of subject* between the first application on which the right of priority is based and the subsequent application for which such right is claimed. Such identity of subject is easy to preserve and to establish with respect to applications for the registration of industrial designs, trademarks, and, to a lesser extent, also utility models. The identity of subject is more difficult to preserve and to establish with respect to patent applications, because domestic laws differ widely concerning what may or may not be patented (for example, products and processes of manufacture or of application in various technological fields), and regarding the drawing up of a description of the invention and claims. It is therefore

¹ Cf. in Federal Republic of Germany: Bundespatentgericht, 25/7/1967, *G.R.U.R. Int.*, 1968, p. 132.

² *Actes de Londres*, pp. 170/3 (proposal), 255/6 (observations), 369/70 (report of Second Sub-Committee), 455 (report of Drafting Committee), 514 (adoption in Second Plenary Session).

frequently necessary, when a first patent application has been filed for an invention and priority is to be claimed for subsequent applications in other countries, to adapt such subsequent applications in those countries to their national requirements. It would be unjust if in such cases the right of priority were lost. Therefore some flexibility is given to the requirement of identity of subject in the case of patent applications.¹

(c) Most domestic laws require that the subject for which protection by a patent is claimed must be defined in the patent application in one or more claims, but in some countries these claims have to be very specific, whereas in others the indication of the principles of the invention suffices. In view of these differences the right of priority must be recognized even for elements of the invention which do *not* appear in the *claims* of the application on which the right of priority is based.

(d) It will suffice for the claiming of the right of priority in a subsequent patent application if the elements of the invention for which priority is claimed are specifically disclosed in the documents of the previous application *as a whole* (including the description of the invention, drawings (if any), charts, etc.). The administrative or judicial authorities of the country where priority is claimed will determine whether this condition is fulfilled.²

The provision under consideration must, however, work in two directions. On the one hand, priority will be recognized on the basis of a previous application for all elements of the invention specifically disclosed in that application *as a whole*. On the other hand, if an even earlier application *as a whole* has already specifically disclosed these elements, that application will be considered the *first* application and priority cannot be recognized on the basis of the application mentioned earlier.

ARTICLE 4, Section I(a)

I(1) Applications for inventors' certificates (b) filed in a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate (c) shall give rise to the

¹ *Actes de Londres*, pp. 171, 455.

² *Ibidem*, p. 455. See also ZUTRAUEN: "Zur Frage der Identität zwischen Vor- und Nachanmeldung bei Beanspruchung der Unionspriorität," *G.R.U.R. Int.*, 1960, p. 498.

right of priority provided for by this Article, under the same conditions and with the same effects as applications for patents (*d*).

(2) In a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate, an applicant for an inventor's certificate shall, in accordance with the provisions of this Article relating to patent applications, enjoy a right of priority based on an application for a patent, a utility model, or an inventor's certificate (*e*).

(a) This Section was added to the Convention at the Revision Conference of Stockholm in 1967. The addition was motivated by the fact that the domestic legislations of several member States of the Union¹ have made it possible to obtain, for an invention, at the option of the applicant, *either a patent or an inventor's certificate*, the latter being a legal document under which the right of exploitation of the invention belongs to the State, whereas the inventor obtains a right to a remuneration from the State.

The purpose of the provision is to put applicants for inventors' certificates in those countries of the Union whose laws make provision for the grant of such certificates as an alternative to the grant of patents in the same position in respect of priority rights under Article 4 of the Convention as applicants for patents.²

(b) The countries of the Union are free to define in their national legislation what they understand by "inventors' certificates."

(c) It is believed that inventors' certificates are *generally* less useful than patents to non-nationals of a country who are not established or domiciled there,³ so that countries which granted *only* inventors' certificates, and *not patents*, for inventions would not give sufficient reciprocity of protection to nationals of other countries which, for their part, granted *patents* to the nationals of the countries first mentioned. Therefore, the provision under consideration, granting priority rights to applications for inventors' certificates, applies *only* to such applications filed in a country in which applicants have the

¹ Cf. BIRPI publication, *Study Group on Certificates of Authorship*, containing surveys of the legislation of Bulgaria, Poland, Rumania and U.S.S.R., 1964.

² Cf. Report of Main Committee III of the Intellectual Property Conference of Stockholm, *I.P.*, 1967, p. 217, paragraph 4.

³ See MAST: "Die Einführung der Erfinderscheine in die Pariser Verbandsübereinkunft," *G.R.U.R. Int.*, 1967, p. 462.

right to apply *at their own option either* for a patent *or* for an inventor's certificate.

(d) In the above case, applications for inventors' certificates will give rise to a right of priority under the same conditions and with the same effect as applications for patents, which means that on the basis of a first application for an inventor's certificate priority may be claimed for patent applications in respect of the same subject in other countries of the Union. All provisions of Article 4 A, B, C, D, E(2), F, G and H will apply in such a situation.

(e) Paragraph (2) of the provision under consideration considers the reverse situation, namely, the possibility of claiming priority *in* a country where applicants have the right to apply at their own option either for a patent or for an inventor's certificate. If such an applicant applies for a *patent*, claiming priority on the basis of a first application in another country for a patent or an inventor's certificate, the situation is already covered by the foregoing Sections A to I(1). If, however, the application for which priority is claimed is made for an *inventor's certificate*, the provision under examination ensures that the applicant may claim priority on the basis of a first application, made in another country of the Union, for a patent, a utility model (cf. Section E(2)) or an inventor's certificate.

With respect to countries which would only grant inventors' certificates, and not patents, for inventions, neither of the provisions of Section I would be applicable: applications for inventors' certificates filed in such countries would enjoy no priority right in other countries of the Union, and it would not be possible to claim for such applications a priority based on a first filing in other countries.

ARTICLE 4bis^(a)

(1) Patents (b) applied for in the various countries of the Union by nationals of countries of the Union (c) shall be independent of patents obtained for the same invention (d) in other countries, whether members of the Union or not (e).

(2) The foregoing provision is to be understood in an unrestricted sense, in particular, in the sense that patents applied for during the period of priority (f) are independent, both as regards the grounds for nullity and forfeiture, and as regards their normal duration (g).

(3) The provision shall apply to all patents existing at the time when it comes into effect (h).

(4) Similarly, it shall apply, in the case of the accession of new countries, to patents in existence on either side at the time of accession (i).

(5) Patents obtained with the benefit of priority shall, in the various countries of the Union, have a duration equal to that which they would have, had they been applied for or granted without the benefit of priority (j).

(a) The principle of the mutual independence of patents obtained for the same invention in the various countries of the Union, as embodied in paragraphs (1), (3) and (4) of this Article, was introduced into the Additional Act to the Convention adopted at the Revision Conference of Brussels in 1900.¹ The Revision Conferences of Washington in 1911 and of London in 1934 added paragraphs (2) and (5), respectively.²

(b) A distinction must be made between, on the one hand, "normal" patents, which will include patents of improvement and patents or certificates of addition, and, on the other hand, patents which are "abnormal" in so far as they are *only granted on the basis*

¹ *Actes de Bruxelles*, pp. 41/2 (proposal), 181/3, 311, 331/3 (discussions and adoption in Plenary Session).

² *Actes de Washington*, pp. 47, 228 (proposals), 222 (observation), 276/7 (report of Committee), 249/51, 259/60 (discussions and adoption in Third and Fourth Plenary Sessions); *Actes de Londres*, pp. 257/8 (proposals), 370 (Report of Second Sub-Committee), 455/6 (report of Drafting Committee), 514 (discussion and adoption in Second Plenary Session).

of an existing foreign patent. Such patents (see, above, observation (c) on Article 1, paragraph (4)) are called "patents of importation," "introduction," "confirmation" or "revalidation." These patents are granted, in the countries which make them available, for inventions which have lost their novelty at the time of the patent application and can therefore no longer be patented normally. They are granted, nevertheless, on the basis of an existing foreign patent and in anticipation of the exploitation of the invention in the country in which the patent of importation is granted. In such cases, the duration of the patent of importation may be made dependent on the duration of a foreign patent which is the basis of the grant of the patent of importation.¹

(c) To these nationals are assimilated the persons entitled to the benefits of the Convention by virtue of Article 3.

(d) Independence is prescribed only for patents obtained for "the same invention." However, for patents not obtained for the same invention, independence will of course apply *a fortiori*.

(e) The provision obliges the member States of the Union to consider their patents independent of other patents for the same invention, even if those patents are granted in non-member States.

(f) The sense of this provision is that *even* patents applied for during the period of priority, and for which priority is recognized, will be independent of the patent granted on the application which is the basis of the priority claim. With respect to patents which are not applied for during the period of priority or for which no priority is claimed, the same rule will apply in view of paragraph (1) of the Article under consideration.²

(g) The independence of patents granted for the same invention concerns their normal duration as well as the possibilities of earlier termination. Such possibilities exist not only in cases of forfeiture or nullity but also if prescribed fees for the maintenance of a patent are not paid.

¹ Cf. *Actes de Washington*, pp. 249/51, 259.

² Some confusion seems to have existed on this subject during the Revision Conference of Washington in 1911, at which only patents of importation were the real issue.

(h) This provision is a transitory clause which has lost its meaning, because all patents existing at the time when the provision took effect (September 14, 1901)¹ have meanwhile expired.

(i) This provision is self-explanatory.

(j) The purpose of this provision, added to the Article under consideration by the Revision Conference of London in 1934,² is to make it clear that the duration of patents granted with the benefit of the right of priority may not be calculated from a different date from that of the starting point for the duration of patents for which no priority is recognized.

¹ Cf. Article 3 of the Additional Act of Brussels, 1900, and *Actes de Washington*, pp. 13/4.

² *Actes de Londres*, pp. 257/8 (proposals of France, Germany, U.S.A. and several other countries), 370 (report of Second Sub-Committee), 455/6 (report of Drafting Committee), 514 (discussion and adoption in Second Plenary Session).

ARTICLE 4^{ter}

The inventor shall have the right to be mentioned as such in the patent^{(a)/(b)}.

(a) This provision, concerning what is commonly called the "moral right" of the inventor to be named as such in the patents granted for his invention in all countries of the Union, was introduced into the Convention at the Revision Conference of London in 1934.¹

(b) The procedure for the exercise of this right of the inventor will be regulated by the member States in their national legislation. Since the inventor has only the *right* to be mentioned in the patent, he can waive this right, unless national legislation prescribes otherwise. The original proposals for the provision contained a clause according to which any contract contrary to the provision would be null and void, but this clause was not accepted. This question is therefore a matter for national legislation.

¹ *Actes de Londres*, pp. 259/60 (proposals of Denmark, Mexico, Netherlands and several other countries), 370/3 (report of Second Sub-Committee), 456 (report of Drafting Committee), 514 (discussion and adoption in Second Plenary Session).

ARTICLE 4^{quater}(^a)(^b)

The grant of a patent shall not be refused and a patent shall not be invalidated on the ground that the sale of the patented product or of a product obtained by means of a patented process (c) is subject to restrictions or limitations (d) resulting from the domestic law.

(a) This provision was added to the Convention at the Revision Conference of Lisbon in 1958.¹

(b) The provision was proposed for the following reasons. It sometimes happens that an invention leads to the manufacture of a product which does not conform to the requirements of the national law of a country as to, for example, security or quality. In other cases the manufacture or sale of such product is restricted, because the State concerned has granted a monopoly or an exclusive concession for such manufacture or sale to an organization of public or private law.² It would, however, be unjust to refuse or invalidate patents concerning such inventions. In cases of the first category, the invention may show that the requirements of the law prohibiting the sale of certain products are obsolete, in which case the law may be modified or repealed, which will then allow the application of the invention. In the second case, a patent is justified since the holder of the monopoly may obtain a contractual or a compulsory license for the exploitation of the invention. The provision under examination therefore prescribes that patents may not be refused or invalidated in such cases.

(c) The provision refers only to cases where the *sale* of the patented product or of a product obtained by means of a patented process is restricted or limited by national legislation, and not to the case where the *manufacture* of such product or the application of a patented process itself is subject to analogous restrictions or limitations. It is therefore a matter for national legislation to regulate this latter situation. It would seem reasonable to adopt for these latter cases the same solution as for the cases referred to in the provision.

¹ *Actes de Lisbonne*, pp. 508/9 (proposals of Denmark, Netherlands and several other countries), 510/3 (discussion in Second and General Committees), 534/5 (report of Second Committee), 100 (adoption in Second Plenary Session), 115 (General Report).

² Cf. in Austria: Patentamt (Division of Appeals), 21/10/1960, *Oesterreichisches Patentblatt*, 1961, p. 46; *G.R.U.R. Int.*, 1961, p. 483.

(d) The provision deals with cases where the sale of a product is subject to *restrictions* or *limitations* resulting from the domestic law of the country concerned. The question whether a total *prohibition* of such sale also comes under the provision is left open, but should, in view of the purpose of the provision, be answered affirmatively. In all cases, refusal or invalidation of a patent must remain possible if the invention concerned is *contrary to public order or morality*. This may not, however, be accepted merely because the exploitation of the invention is prohibited or restricted by law or regulation, but only when it is contrary to the basic legal or social concepts of the country concerned.

ARTICLE 5, Section A^(a)

A(1) Importation by the patentee (*b*) into the country where the patent has been granted of articles manufactured (*c*) in any of the countries of the Union (*d*) shall not entail forfeiture of the patent (*e*).

(2) Each country of the Union shall have the right to take legislative measures providing for the grant of compulsory licenses (*f*) to prevent the abuses which might result from the exercise of the exclusive rights conferred by the patent (*g*), for example, failure to work (*h*).

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

(4) A compulsory license may not be applied for on the ground of failure to work or insufficient working (*l*) before the expiration of a period of four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period expires last (*m*); it shall be refused if the patentee justifies his inaction by legitimate reasons (*n*). Such a compulsory license shall be non-exclusive and shall not be transferable, even in the form of the grant of a sub-license, except with that part of the enterprise or goodwill which exploits such license (*o*).

(5) The foregoing provisions shall be applicable, *mutatis mutandis*, to utility models (*p*).

(a) Paragraph (1) of this Section, concerning *importation of patented articles*, was introduced into the original text of the Convention of 1883.¹ It has not been modified since except for minor changes as to form.

Paragraphs (2), (3) and (4) of the Section deal with *the obligation to work a patent* in the country where it is granted,² and more generally with the *abuses* which might result from the exercise of the exclusive

¹ *Actes de Paris*, I, pp. 27 (proposal for Article 4), 56/8, 64/70, 132 (discussions and adoption).

² Cf. for this subject, AKERMAN: *L'obligation d'exploiter et la licence obligatoire en matière de brevets d'invention*, 1936.

right conferred by the patent. The original text of the Convention of 1883 only contained a provision stating that in the case of importation of patented articles (paragraph 1) the patentee remained under the obligation to exploit his patent in accordance with the laws of the country into which he introduced the patented articles. The Revision Conference of Brussels in 1900 added a more general provision concerning the non-working of a patent: Article 2 of the Additional Act adopted in Brussels.¹ This regulation was elaborated further by the following Revision Conferences of Washington (1911), The Hague (1925), London (1934) and Lisbon (1958). At the Conference of The Hague the provision was enlarged to include the regulation of legislative measures intended to prevent the abuses which might result from the exclusive rights conferred by the patent, abuses of which failure to work was cited as an example.² On the other hand, that Conference, and also the following Conferences of London and Lisbon, reduced the possibilities of legislative measures and sanctions in these cases.³

Originally, doubts existed⁴ as to whether the provisions regulating these matters could be considered "self-executing"—in countries which admit such a possibility (see Chapter II.3 and II.4, above)—that is, whether interested parties could directly, even in the absence of or notwithstanding differing national legislation, invoke these provisions before the administrative or judicial authorities of the countries concerned. Paragraph (2) of the Section under consideration is still a provision which merely gives a right to legislate to the member States and therefore has no "self-executing" character. On the other hand, paragraphs (1), (3) and (4), especially after the Revision Conferences of London (1934) and Lisbon (1958), are clearly so worded as to be "self-executing"—in countries which admit such a possibility.⁵

¹ *Actes de Bruxelles*, pp. 82/7, 316/27, 383/8.

² *Actes de La Haye*, pp. 234/7 (proposal), 337/8 (observations), 431/4 (report of Second Sub-Committee), 519 (report of General Committee), 540 (report of Drafting Committee), 573/6 (discussion and adoption in Second Plenary Session).

³ *Actes de Londres*, pp. 173/5, 179 (proposal), 261/3 (observations), 377/80 (report of Second Sub-Committee), 458/60 (report of Drafting Committee), 515 (adoption in Second Plenary Session); *Actes de Lisbonne*, pp. 389/93 (proposals), 395/407 (observations), 411/25 (discussion in Second Committee), 526/9 (report of Second Committee), 100/1 (adoption in Second Plenary Session), 116 (General Report).

⁴ Cf., for example, in France the case law and literature referred to by Chavanne in *Ann.*, 1963, p. 265, and by Roubier, *Ann.*, 1954, p. 257, 1957, p. 367, and finally Cour de Cassation (Chambres réunies), 16/11/1966, *Ann.*, 1967, p. 117; in Belgium: Conseil d'Etat, 9/5/1958, *Ing. Conseil*, 1958, p. 172; in Italy: Court of Appeals of Turin, 15/10/1965, *G.R.U.R. Int.*, 1967, p. 361 (German translation).

⁵ Cf. in France: Cour de Cassation, cited in preceding footnote.

Paragraph (5) of the Section under consideration was added at the Revision Conference of London in 1934.¹

(b) This provision concerning *importation of patented articles by the patentee* into the country where the patent is granted was introduced into the Convention at a time when the question whether such importation could entail forfeiture of the patent was a hotly debated issue. As national legislations have since become less severe on importation of patented articles as such, the issue has lost much of its importance. The provision is rather narrowly worded and leaves the member States free to regulate the importation of patented articles by other means and in other circumstances than those referred to in the provision.

(c) "*Articles manufactured*" must mean "articles manufactured according to the patent" and will include both categories mentioned in Article 4*quater*, namely, articles which are themselves the subject of the patent and articles manufactured by means of a patented process.

(d) The provision applies only in the case of importation of articles *manufactured in any of the countries of the Union* and not if these articles are *manufactured elsewhere and imported from one of those countries*.

(e) The provision stipulates only that importation as indicated shall not entail *forfeiture of the patent*. However, the expression "forfeiture" is not used in all countries of the Union. In view of the purpose of the provision, it must apply to all measures terminating a patent on the ground of importation of patented articles by the patentee, independently of the question whether such measures are called forfeiture, repeal, revocation or annulment.

(f) It would seem, with respect to the prevention of the abuses indicated in this provision, that national legislation can only take legislative measures providing for the grant of *compulsory licences*. This, however is not true, because paragraph (3) makes it clear that *forfeiture* of the patent is another measure which may be provided for. The order in which those measures may apply is prescribed in paragraphs (3) and (4).

(g) The provision concerning the *abuses which might result from the exercise of the exclusive rights conferred by the patent* relates to a

¹ *Actes de Londres*, pp. 379/80 (proposal of Poland), 459/60 (report of Drafting Committee), 515 (adoption in Second Plenary Session).

very important question of patent law. Although patents, even apart from their exploitation, are considered beneficial to industry, as they publish inventions which may inspire other inventions, and fall into the public domain after the expiration of their term, it is believed in many countries that, in order to be fully justified, patents should also be used for *working the patented invention in the country where the patent is granted*, and not merely as an exclusive right to prevent others from doing so or to control importation. On the other hand, immediate exploitation of the same invention in all countries where patents are granted for the invention is generally impossible, so that the patentee must be given sufficient time to organize exploitation, be it by himself or by licensees, in the countries concerned.

The provision under examination aims at striking a balance between the said considerations. It gives the member States the right to legislate against the *abuses* which might result from the exercise of the exclusive rights conferred by the patent, for example, failure to work, but on condition that the provisions of paragraphs (3) and (4) of the Article are respected.

The provision in paragraph (2), and therefore also the provisions of paragraphs (3) and (4) which prescribe rules for its application, do *not* deal with *measures other than those whose purpose is to prevent the abuses referred to*. The member States are therefore free to provide analogous or different measures, for example, compulsory licenses on conditions other than those indicated in paragraph (4), in *other cases where the public interest is deemed to require such measures*.¹ This may be the case when patents concern vital interests of the country in the fields of military security or public health or in the case of so-called "dependent patents,"² etc. In such cases the rules of paragraphs (3) and (4) of the provision under consideration do not apply, so that the member States have freedom to legislate.

In cases where the provision under consideration does apply, namely, when national legislation is aiming at preventing the *abuses which might result from the exercise of the exclusive rights conferred by the patent*, the rules given in paragraphs (3) and (4) are mandatory for the member States and may—in countries which admit this possibility—be directly invoked by interested parties.

¹ Cf. in United Kingdom: House of Lords, 11/3/1954, 71 *R.P.C.* 169 (1954). Cf. also the discussion of this question in the *Actes de Lisbonne*, pp. 393/5, 407/10, 421/2.

² "Dependent patents" are patents which cannot be exploited without applying at the same time an earlier patent, or a patent based on an earlier application or priority.

Among the abuses referred to, *failure to work the patented invention*—which failure, according to paragraph (4), includes *insufficient working*—is cited as an example. Other examples of such abuses may exist in cases where the owner of the patent, although working the patent in the country concerned, refuses to grant licenses on reasonable terms and thereby hampers industrial development, or does not supply the national market with sufficient quantities of the patented product, or demands excessive prices for such product.¹ The member States are free to define these, and other, abuses.²

(h) The member States are also free to define what they understand by “*failure to work*.” Normally, working a patent will be understood to mean working it *industrially*, namely, by *manufacture* of the patented product, or *industrial application* of a patented process. Thus, importation or sale of the patented article, or of the article manufactured by a patented process, will not normally be regarded as “working” the patent.

The member States are equally free to decide whether legislative measures will be taken already in the case of failure to work a patent in the country concerned, or only if such failure to work occurs in a larger territory comprising one or more other countries.³

(i) Paragraph (3) of the Section under consideration is the first of the two paragraphs (3) and (4) which contain *mandatory requirements* concerning the contents of the legislative measures allowed by paragraph (2). Paragraph (3) concerns measures provided to prevent *all abuses* which might result from the exercise of the exclusive rights conferred by the patent; paragraph (4), on the contrary, applies only to compulsory licenses *on the ground of failure to work or insufficient working*.⁴

For the expression “forfeiture,” see the observation under (e) above; the interpretation given there is confirmed by the second sentence of paragraph (3) of the Section under consideration.

(j) The first mandatory requirement for the *forfeiture* of a patent is that such forfeiture, *on the ground of the said abuses*, may be made

¹ *Actes de La Haye*, p. 434.

² *Actes de Londres*, p. 174.

³ See, for example, Article 5 of the Treaty between Germany and Switzerland of 13/4/1892, amended 26/5/1902, BLUM-PEDRAZZINI, *Das schweizerische Patentrecht*, II, p. 609, and Article 136 of the Draft Treaty regarding a European Patent.

⁴ *Actes de Lisbonne*, pp. 416/7, 527, 116.

possible by the national legislation of member States only in cases where the *grant of compulsory licenses is not sufficient* to prevent the said abuses. In view of the second sentence of the same paragraph, this means that after the grant of one or more compulsory licenses it must be considered whether these, or further, compulsory licenses will not suffice to correct the said abuses.

(k) A second mandatory requirement for the forfeiture of a patent on the ground of the said abuses is that *no proceedings for such forfeiture may be instituted before the expiration of two years from the grant of the first compulsory license*. Forfeiture of a patent is therefore a subsidiary measure, only possible after at least one compulsory license has been granted and the decision has been made that the grant of compulsory licenses is not sufficient to prevent the said abuses.

These provisions make it clear that, in countries whose legislation does not provide for compulsory licenses, *forfeiture of a patent on the ground of the said abuses will not be possible*.¹

(l) As has been observed above, this provision applies only to compulsory licenses applied for in cases of *failure to work or insufficient working of a patent* and not in cases of other abuses of the exclusive right.²

(m) The periods prescribed take into account the different patent laws of the member States, which may provide for the grant of patents with or without previous examination of the patent application as to substance. In countries without such examination it is quite likely that a patent will be granted within the first year after filing the application. In order to give the applicant more time to organize the exploitation of his patent, a compulsory license can then only be applied for after four years have expired from the filing of the application. However, if, for example, because of the time involved in examining the application as to substance, the patent is granted more than one year after the filing of the application, a compulsory license cannot be applied for until three years have expired from the grant of the patent.

After expiration of the period which expires last, a compulsory license on the ground of failure to work or insufficient working may be allowed; it may also be allowed later on during the life of the patent and even after a period during which the patent has been

¹ Cf. in France: Cour de Cassation (Chambres réunies), 16/11/1966, *Ann.*, 1967, p. 117.

² *Actes de Lisbonne*, pp. 416/7, 527, 116.

worked in the country, if such working has stopped or has become insufficient.

(n) A compulsory license on the ground of failure to work or insufficient working must be *refused* if the patentee *justifies his inaction by legitimate reasons*. Such reasons may be based on the existence of legal, economic or technical obstacles to exploitation, or more intensive exploitation, of the patent in the country. The competent authorities of the country concerned will decide on this question.¹

(o) This provision, added at the Revision Conference of Lisbon in 1958, tends to prevent the grantee of a compulsory license on the ground of failure to work or insufficient working from obtaining a stronger position than is warranted by the purpose of the license, namely, to provide the possibility of working the patent in the country concerned. National legislation may determine how a compulsory license may be transferred together with the enterprise or part of the enterprise or goodwill which exploits such license.

(p) This provision, added by the Revision Conference of London in 1934,² extends the application of the preceding provisions to utility models. Such application will probably be rare in view of the relatively short duration of utility models and their limited importance.

ARTICLE 5, Section B^(a)

B. The protection of industrial designs shall not, under any circumstance, be subject to any forfeiture (b), either by reason of failure to work (c) or by reason of the importation of articles corresponding to those which are protected (d).

(a) This provision concerns *industrial designs* only. It was introduced into the Convention, as regards forfeiture of protection by reason of importation of articles corresponding to the design, at the Revision Conference of The Hague in 1925.³ It was completed as regards failure to work, at the Revision Conference of London in 1934.⁴

¹ Cf. *Actes de Bruxelles*, pp. 316/7, 322/3, 325/6, 387/8.

² *Actes de Londres*, pp. 379/80 (proposal of Poland), 459/60 (report of Drafting Committee), 515 (adoption in Second Plenary Session).

³ *Actes de La Haye*, pp. 339 (proposals of Germany and several other countries), 497/8 (discussion in Sixth Sub-Committee), 519/20 (report of General Committee), 540/1 (report of Drafting Committee), 576 (adoption in Second Plenary Session).

⁴ *Actes de Londres*, pp. 175/6, 179 (proposal), 263/4 (observations), 380 (report of Second Sub-Committee), 460 (report of Drafting Committee), 515 (adoption in Second Plenary Session).

(b) As has already been observed above—see observations (e) and (j) on Article 5 A—the expression “forfeiture” must be deemed to include other measures which would terminate the protection of a design on the grounds referred to whatever their name, such as repeal, revocation or annulment.

(c) *Failure to work* a design in a member State may not cause forfeiture of the protection of the design. Member States are, however, free to provide in their national legislation for compulsory licenses in case of failure to work.¹ They are also free to define what they understand by “failure to work.” “Work” will normally be understood as meaning the *manufacture* of products representing or incorporating the design.

(d) With respect to *importation of articles* corresponding to the design in a country where the design is protected, the provision has a wider scope than the corresponding provision concerning patents (Section A(1)). In the case of designs, no such importation whatsoever may cause forfeiture, independently of the questions whether the importation is made by the owner of the right to the design or by others, and whether such importation occurs after manufacture of the articles in one of the countries of the Union or elsewhere.

ARTICLE 5, Section C^(a)

C(1) If, in any country, use of the registered mark is compulsory (b), the registration may be cancelled (c) only after a reasonable period (d), and then only if the person concerned does not justify his inaction (e).

(2) Use of a trademark by the proprietor (f) in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered in one of the countries of the Union (g) shall not entail invalidation of the registration (h) and shall not diminish the protection granted to the mark (i).

(3) Concurrent use (j) of the same mark on identical or similar goods by industrial or commercial establishments considered as co-proprietors of the mark according to the provisions of the domestic law of the country where protection is claimed (k) shall not prevent

¹ Cf. *Actes de Londres*, pp. 380, 460, 515.

registration or diminish in any way the protection granted to the said mark in any country of the Union (l), provided that such use does not result in misleading the public and is not contrary to the public interest (m).

(a) This Section concerns various questions related to the use of trademarks. Paragraph (1) of the Section under consideration was introduced into the Convention at the Revision Conference of The Hague in 1925;¹ paragraphs (2) and (3) were added at the Revision Conference of London in 1934.²

Although it would be reasonable to apply these provisions also to service marks, there is no obligation to do so, because the said provisions existed in the Convention before the introduction of service marks by the Revision Conference of Lisbon in 1958, and the latter Conference refused to assimilate service marks to trademarks throughout the Convention.³

(b) The working of a patent in a country may be in the public interest but this is not necessarily true with respect to the use of a trademark in such country, because it is, in principle, a matter of indifference whether goods are sold under a certain trademark or not. Nevertheless, many countries require in their national legislation that trademarks be used, in order to prevent the trademark register becoming clogged with unused marks which preclude the valid registration of identical or similar marks which are used or intended to be used. Thus, the use of a registered trademark is often prescribed under national legislation; use of the mark is then generally understood as meaning the sale of goods bearing such mark.⁴

However, as in the case of patents, the proprietor of the trademark registration must be given reasonable time and opportunity to use his mark in several countries before his registrations of the mark are exposed to sanctions on the ground of non-use. The paragraph under consideration contains provisions to that effect.

¹ *Actes de La Haye*, pp. 338/9 (proposals of Germany, U.K. and other countries), 439/42 (report of Third Sub-Committee), 520 (report of General Committee), 541 (report of Drafting Committee), 576 (adoption in Second Plenary Session).

² *Actes de Londres*, pp. 178/9, 281 (proposals), 264/5 (observations), 386/90 (report of Third Sub-Committee), 460/1 (report of Drafting Committee), 515 (adoption in Second Plenary Session).

³ *Actes de Lisbonne*, pp. 624 (proposal of U.S.A.), 628/33 (discussion in Third Committee), 755/7 (report of Third Committee).

⁴ Cf. *Actes de La Haye*, pp. 441/2, 541.

(c) The provision only stipulates the conditions under which, on the ground of non-use of a *registered* mark, the *registration may be cancelled*. It is, therefore, of limited importance in countries where, according to the national legislation, the *right* to a trademark originates from the (first) use of it and is independent of registration. In such cases *this right* could lapse on the ground of non-use, although the provision under examination would prevent the *registration* from being cancelled.¹

(d) National legislation may define what is meant by a reasonable period, and if this is not done the competent authorities of the country concerned will determine what is a reasonable period in any given case.

(e) Cancellation of a trademark registration on the ground of non-use of the trademark in the country concerned will be possible only if the proprietor of the registration does not justify his inaction. National legislation may define this further, failing which the competent authorities will decide on any alleged justification. Justification will normally be possible if legal or economic conditions have prevented the use of the mark in a given country, for example, if the importation of certain products has been prohibited, or prevented by war, or if there was no market for such products.

(f) This paragraph, which allows the use of a trademark in a form that is not essentially different from that in which it has been registered, applies only to such use when it is made by the *proprietor* of the mark. It will be reasonable to apply it also in cases of legitimate use of a mark by persons other than the proprietor, particularly by his licensees.

(g) The provision deals with the use of a mark in a form which is different from that in which it has been registered *in one of the countries of the Union*. The purpose of the provision is to allow for unessential differences between the form of the mark as it is registered and the form in which it is used, for example, in cases of adaptation or translation of certain elements for such use.² It applies also to similar differences in the form of the mark as used in the country of its original registration. The differences in form must *not alter the*

¹ Cf. in Netherlands: Supreme Court, 5/1/1940, *Bijblad bij de Industriële Eigendom*, 1940, p. 124.

² Cf. *Actes de Londres*, p. 178.

distinctive character of the mark. The competent authorities of the country in which the mark is used in a different form will determine whether this requirement has been complied with.¹

(h) The said differences of form will not entail *invalidation of the registration*, which is self-explanatory.

(i) Neither will the said differences of form *diminish the protection granted to the mark*, which means not only that the mark, in the form in which it is registered, cannot be considered as not being used in view of Article 5, Section C(1), but also that, as regards possible infringement by marks of third parties, it must be considered as having been used in its original form. Whether the different form in which the mark is actually used enters also into consideration depends on the national legislation of the country concerned.

(j) This provision unfortunately does not deal with the type of concurrent legitimate use of a mark by several enterprises which in most countries is by far the most important, namely, concurrent use of a mark by licensor and licensee.² An attempt to cover this subject, made at the Revision Conference of Lisbon in 1958, failed.³

(k) As it stands, the provision has a very narrow scope because it covers only the situation where concurrent use of the same mark on identical or similar goods is made by enterprises which are considered *co-proprietors of the mark* according to the domestic law of the country where protection of the mark is claimed. The provision is intended to eliminate difficulties which have occurred, with regard to this question, under the national legislation of some countries,⁴ but it is of little importance to many other countries.

(l) The provision prescribes that, in the case of the concurrent use referred to, the registration of the mark will not be prevented and its protection will not be diminished. This latter stipulation must be deemed to include the requirement that a registration may not be invalidated on the said ground.

¹ Cf. in France: Tribunal civil de Marseille, 14/12/1954, *Ann.*, 1955, p. 43.

² Cf. HEYDT: "Gleichzeitige Benutzung derselben Marke durch mehrere Personen und Marken von Inhabern ohne Geschäftsbetrieb," *G.R.U.R. Int.*, 1958, p. 457; TORH: "L'emploi simultané de la marque," *P.I.*, 1961, p. 241; BEIER: "Die gemeinschaftliche Benutzung von Warenzeichen in konventionsrechtlicher Sicht," in *Die Warenzeichenlizenz*, 1963, p. 555.

³ *Actes de Lisbonne*, pp. 544/64, 746/50.

⁴ *Actes de Londres*, p. 460.

(m) National legislations are free to define this proviso further, failing which the competent authorities of the country concerned will decide whether the provision will not apply because the concurrent use of a mark results in misleading the public or is contrary to the public interest. Such cases may occur if the concurrent use of the mark would mislead the public as to the source of the goods sold under the same trademark or if the quality of such goods, concurrently sold by co-proprietors of the mark, were different. See also, for a possible conflict with *the public interest*, observation (i) on Article 7bis below.

ARTICLE 5, Section D^(a)

D. No indication or mention of the patent, of the utility model, of the registration of the trademark, or of the deposit of the industrial design (b), shall be required upon the goods as a condition of recognition of the right to protection (c).

(a) This provision, as far as it concerns industrial designs, was introduced into the Convention by the Revision Conference of The Hague in 1925.¹ It was extended to other industrial property rights by the Revision Conference of London in 1934.²

(b) An indication or mention on a product, to the effect that the product is protected by a patent, utility model or the registration of a design, or that a mark which the product carries is protected by registration, may be useful in order to inform third parties of the protection and thereby to warn them against infringement of the right concerned. Several countries, therefore, prescribe such indication or mention, at least for some of the subjects of industrial property referred to.

(c) However, the presence of such indication or mention may not be made a *condition* of the *right to protection*, because this would penalize the owner of the right too severely for the omission of the

¹ *Actes de La Haye*, pp. 339 (proposal of Germany), 496/7 (report of Sixth Sub-Committee), 520 (report of General Committee), 540/1 (report of Drafting Committee), 576 (discussion and adoption in Second Plenary Session).

² *Actes de Londres*, pp. 176/8, 179 (proposal), 265 (observations), 380 (report of Second Sub-Committee), 461 (report of Drafting Committee), 515 (adoption in Second Plenary Session).

indication or mention. Member States are free, however, to provide in their national legislation for other consequences of the omission of such indication or mention. They may, for example, make such omission a criminal misdemeanor or prescribe that in the case of such omission—and although recognition of the right to protection still obtains—damages for infringement can be claimed only if it is proved that the infringer was aware of the right, notwithstanding the omission of any indication or mention.¹

¹ *Actes de La Haye*, pp. 496/7.

ARTICLE 5bis^(a)

(1) A period of grace of not less than six months (b) shall be allowed for the payment of the fees prescribed for the maintenance (c) of industrial property rights, subject, if the domestic legislation so provides, to the payment of a surcharge.

(2) The countries of the Union shall have the right to provide for the restoration of patents (d) which have lapsed by reason of non-payment of fees.

(a) The first paragraph of this Article was introduced into the Convention by the Revision Conference of The Hague in 1925, but the minimum term prescribed for the period of grace was then three months.¹ This minimum term was extended to six months by the Revision Conference of Lisbon in 1958.²

The second paragraph of the Article was introduced in a different form by the Revision Conference of The Hague.³ It was modified by the Revision Conference of Lisbon.⁴

(b) In many countries the *maintenance of certain industrial property rights* is subject to the payment of fees, which are generally annual. In order not to penalize the owner of the right by immediate forfeiture in the event of a delay in the payment of such fees, the provision under consideration grants a period of grace for such payments. This period of grace is of six months' duration, unless the national legislation of the country concerned grants a longer period. During the period of grace the industrial property right concerned must be considered to remain provisionally in force.⁵ If the fee is not paid during this period, the right will lapse. National legislations are free to determine that in such case the right will lapse retroactively, namely, as from the date on which the fee was due.

¹ *Actes de La Haye*, pp. 338, 354 (proposals of U.S.A. and U.K.), 434/5 (report of Second Sub-Committee), 520/1 (report of General Committee), 541 (report of Drafting Committee), 576/7 (discussion and adoption in Second Plenary Session).

² *Actes de Lisbonne*, pp. 426/7 (proposal), 427/435 (observations), 436/46 (discussion in Second Committee), 529/531 (report of Second Committee), 101 (adoption in Second Plenary Session), 116 (General Report).

³ See footnote 1.

⁴ See footnote 2.

⁵ Cf. *Actes de Lisbonne*, pp. 440/1.

(c) The provision under examination concerns only the payment of fees prescribed for the *maintenance* of industrial property rights. It does not apply to payments due for the *acquisition* of the right.¹ Neither is there any obligation to apply the provision to payments due not for *maintenance* but for *renewal* of an industrial property right.

(d) Whereas paragraph (1) of the Article under consideration regulates the period of grace allowed for the payment of fees for the maintenance of *all* industrial property rights, paragraph (2) concerns *patents* only, in cases where they *have already lapsed* by reason of non-payment of fees (for example, maintenance fees, if these fees have not been paid in time or during the period of grace). According to the text adopted at the Revision Conference of The Hague in 1925, the member States undertook, in the case of patents, either to increase the period of grace—then normally fixed at three months—to six months, or to provide for the *restoration of a patent* which had lapsed by reason of non-payment of fees. The first part of this alternative was superseded by the general extension of the period of grace to six months at the Revision Conference of Lisbon in 1958. In view of profound differences of opinion on the subject,² the latter Conference replaced the second part of the alternative by a mere recognition of the *right of the member States to legislate* on the subject of the restoration of patents which have lapsed because of non-payment of fees.

¹ *Actes de La Haye*, p. 576; *Actes de Lisbonne*, p. 426.

² *Actes de Lisbonne*, pp. 427/46.

ARTICLE 5ter^(a)

In any country of the Union the following shall not be considered as infringements of the rights of a patentee (b) :

1. the use (c) on board vessels (d) of other countries of the Union (e) of devices (f) forming the subject of his patent in the body of the vessel (g), in the machinery, tackle, gear and other accessories (h), when such vessels temporarily or accidentally (i) enter the waters (j) of the said country, provided that such devices are used there exclusively for the needs of the vessel (k) ;
2. the use of devices forming the subject of the patent in the construction or operation (l) of aircraft or land vehicles (m) of other countries of the Union, or of accessories of such aircraft or land vehicles, when those aircraft or land vehicles temporarily or accidentally enter the said country.

(a) This Article concerns *patents* only. It was introduced into the Convention by the Revision Conference of The Hague in 1925¹ and has not been changed since, except for some minor modifications as to form.

(b) The Article provides for certain limitations on the exclusive rights conferred by a patent in cases where the full exercise of such rights would cause too much prejudice to the public interest in maintaining freedom of transport. Its effect is, in principle, that if ships, aircraft or land vehicles temporarily visit foreign countries, their owners are not required to obtain licenses on patents in force in these countries in order to avoid infringing such patents.

(c) The provision under consideration covers only the *use* of patented devices and will therefore not apply to the *manufacture* of articles on board vessels, etc., nor to the *sale* to the public of patented products or products obtained by a patented process.²

¹ *Actes de La Haye*, pp. 339 (proposal of France), 435/6 (report of Second Sub-Committee), 521 (report of General Committee), 541/2 (report of Drafting Committee), 577 (adoption in Second Plenary Session).

² *Ibidem*, pp. 435. 541/2.

(d) The national authorities of the member States will be free to interpret the meaning of "vessels," an expression which will probably not include floating islands for purposes of drilling, etc.

(e) In each country of the Union the provision will apply only to vessels of *other countries of the Union*, that is, vessels carrying the flag of such countries, and not to vessels of the country itself, even if such vessels have a home port elsewhere and enter the country only temporarily or accidentally.

(f) A *device* may be the subject of a patent either because it is patented itself or because a patented process is used to operate it.

(g) Freedom to use patents applies in the first place to such use in the *body of the vessel itself*.

(h) This freedom includes the use of a patented invention in *accessories of the vessel*, of which machinery, tackle and gear are given as examples. These accessories include instruments for navigation, loading and unloading, and possibly many others depending on the character of the vessel. See observation (k) below.

(i) Freedom of use applies only if vessels enter the waters of a foreign country *temporarily or accidentally*. Temporary entrance will include periodical entrances.¹ Accidental entrance may be caused by inadvertence or shipwreck. In the latter case, a ship will not infringe patents even if its presence in foreign waters is not temporary.

(j) The *waters* of a foreign country include its territorial waters and all inland waterways and harbours, including docks.

(k) Freedom of use is limited to use of patented devices *exclusively for the needs of the vessel*. These needs may vary considerably, because a hospital ship, a ship for scientific exploration, a warship, and a passenger ship have obviously very different needs. The provision would however not apply if, for example, a ship's tackle were used to move goods from one warehouse to another.

(l) The second paragraph of the provision under consideration does not concern vessels but *aircraft and land vehicles*. It applies to the use of devices which are the subject of a patent, in the *construction*

¹ *Actes de La Haye*, p. 435.

or *operation* of such aircraft or land vehicles or their accessories. The use of objects aboard which do not relate to such construction or operation will therefore not be exempted from patent infringement.

(m) The national authorities of the member States will interpret the meaning of aircraft and land vehicles in case any doubt arises on these subjects.

ARTICLE *Squater*^(a)

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

(a) This Article was introduced into the Convention at the Revision Conference of Lisbon in 1958.¹ Before that Conference the Convention left complete freedom to the member States to define in their national legislation the acts of third parties by which a patent would be infringed. At the Conference of Lisbon it was proposed to change this situation rather drastically by stipulating in the Convention that a patent, granted for a process of manufacture, would be infringed by the importation, sale or use of products obtained by such process in another country. This proposal was not accepted and the adopted Article has a considerably narrower scope.

(b) The legislation of several countries stipulates that, if a patent is granted only for a process, such patent extends its effect to products obtained, or directly obtained, by such process, which means that *not only the application of the process but also, and independently, the sale and use of its products will constitute patent infringement*. The provision under consideration prescribes that, when a country has adopted this system, all rights granted by its legislation, on the basis of the process patent, with respect to products manufactured according to the patented process in the country itself, must also apply in the case of *importation* of such products if they are manufactured according to the said process in another country, even if that process is not patented in the said other country.

¹ *Actes de Lisbonne*, pp. 514 (proposal of Switzerland), 515/9 (discussion in Second Committee), 535 (report of Second Committee), 101 (adoption in Second Plenary Session), 116 (General Report).

ARTICLE *Squinquies*^(a)

Industrial designs shall be protected in all the countries of the Union (b).

(a) This Article was introduced into the Convention at the Revision Conference of Lisbon in 1958.¹ The proposals submitted to that Conference in this respect were ambitious, as they contained not only an obligation to protect industrial designs but also a definition of such designs, a provision concerning the appreciation of their novelty and a requirement as to the minimum duration of their protection. The last three proposals were not accepted, so that these questions continue to be left to the national legislations of the member States.

(b) All that was inserted in the Convention was the mere obligation for member States to *protect industrial designs*. Nothing is said about the means of providing such protection, so that countries may comply with the provision not only through special legislation for the protection of designs, but also through the grant of such protection, for example, in their laws on copyright² or their provisions against unfair competition. What is necessary, but at the same time sufficient, is that, whenever the competent authorities of a member State define or recognize an object as being an "industrial design," for example, in view of its registration as such in the country itself or internationally,³ protection in some form be given to it.

In these circumstances, and since the provision under consideration does not (only) oblige the member States to legislate, but can be deemed to be addressed also to the judicial authorities of these States, the provision may be considered "self-executing"⁴—in countries which admit this possibility—with the result that interested parties can directly invoke the provision in court.

¹ *Actes de Lisbonne*, pp. 865/7 (proposal), 867/74 (observations), 874/9 (discussion in Fifth Committee), 909/10 (report of Fifth Committee), 101 (adoption in Second Plenary Session), 116/7 (General Report).

² Cf. in Belgium: Cour de Cassation, 20/12/1954, *Ing. Conseil*, 1955, p. 35.

³ By virtue of the Hague Agreement concerning the International Deposit of Industrial Designs, concluded at The Hague in 1925, revised at London in 1934.

⁴ See Chapter II.4 above.

ARTICLE 6^(a)

(1) The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation (b).

(2) However, an application for the registration of a mark filed by a national of a country of the Union (c) in any country of the Union may not be refused, nor may a registration be invalidated, on the ground that filing, registration, or renewal, has not been effected in the country of origin (d).

(3) A mark duly registered in a country of the Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin (e).

(a) The original Convention of 1883 contained two principles with respect to the registration of trademarks, one—in Article 6—stating that every trademark duly filed in the country of origin, as defined in that Article, had to be accepted for filing and protected in its original form in the other countries of the Union, and the other—in paragraph 4 of the Final Protocol—stating that the above provision was an exception which concerned only the form of the mark, whereas normally each State should apply its domestic law to filings of trademarks.¹ Thus, the general rule of the Convention was *the application of national laws regarding all trademark registrations* in the countries concerned and the Convention did not *oblige* the applicant first to file his trademark in the country of origin in order to have it accepted also in the other countries of the Union. However, if the applicant *had* made such filing, the Convention gave him the *right* to demand acceptance and protection of his mark in its original form in the other countries. These provisions were modified by the Revision Conferences of Washington (1911), The Hague (1925), and London (1934), but it became gradually less clear what the relationship was between the principle of independence of filings and registrations of the same trademark in various countries—*independence* which was denied by the national legislation of several countries²—and the *exceptional situation* in which, on the basis of an existing *registration* in the *country of origin*, acceptance and protection of the mark in its original form may be claimed in the other countries of

¹ *Actes de Paris*, I, pp. 70/9, 132/5, 138/42; II, pp. 24/33.

² Cf. LADAS: *The International Protection of Industrial Property*, p. 541.

the Union. In order put an end to this confusion, the Revision Conference of Lisbon in 1958 decided¹ to spread the above regulations over two articles : Article 6, which would establish the normal situation of independence of trademark filings and registrations in the countries of the Union, and Article 6*quinquies*, which would regulate the exceptional situation referred to above. Consequently, Article 6, which, prior to the Conference of Lisbon, contained a large part of the subject now regulated by Article 6*quinquies*, now concerns only the principle of independence of trademarks and can be compared with Article 4*bis* dealing with the same subject in respect of patents.

(b) The principle stated in paragraph (1) means, in other words, that with respect to the filing and registration of trademarks the applicant may claim "national treatment" according to Articles 2 and 3 of the Convention. The provision speaks only of trademarks and not of service marks but, since in view of Articles 1, 2 and 3 service marks will also come under the rule of national treatment, they will be treated in the same way.

(c) The expression "national of a country of the Union" must, in view of Article 3 of the Convention, be deemed to include also the nationals of countries outside the Union who may claim the application of the Convention according to Article 3.

(d) The filing and registration of a trademark in each country will be independent of analogous acts regarding the same trademark in other countries, even such acts in the country of origin of the trademark as defined in Article 6*quinquies* A(2). This means that no filing, registration or renewal of the mark in any country other than that of the filing concerned may be required, except, of course, for the acknowledgement of a right of priority, on the basis of a first filing, according to Article 4. The exceptional situation, where a registration in the country of origin is *invoked* in order to claim application of Article 6*quinquies*, is reserved for that Article.

(e) *Once registered* in a country of the Union a trademark *remains* independent and is unaffected by the fate of similar registrations in other countries, including the country of origin.

¹ *Actes de Lisbonne*, pp. 578/9, 581/2 (proposals), 582/99 (observations), 601/2, 616/7 (discussion in Third Committee), 750/5 (report of Third Committee), 617/20 (discussion in General Committee), 101, 106 (adoption in Second Plenary Session), 117/8 (General Report).

ARTICLE 6bis^(a)

(1) The countries of the Union undertake (b), ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark (c) which constitutes a reproduction, an imitation, or a translation, liable to create confusion (d), of a mark (e) considered by the competent authority of the country of registration or use to be well known (f) in that country as being already the mark of a person entitled to the benefits of this Convention (g) and used for identical or similar goods (h). These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith (i).

(2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark (j). The countries of the Union may provide for a period within which the prohibition of use must be requested (k).

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

(a) This Article was introduced into the Convention by the Revision Conference of The Hague in 1925.¹ It was modified by the Revision Conferences of London in 1934² and of Lisbon in 1958.³ At the latter Conference the Article was very thoroughly discussed and its application, which formerly concerned only the refusal or cancellation of the *registration* of a mark conflicting with a mark which is well known in the country concerned, was then extended to a prohibition of the *use* of the mark first mentioned.

(b) One of the questions which arises with respect to this Article is whether it may be considered "self-executing"—in countries which

¹ *Actes de La Haye*, pp. 241/2, 246 (proposal), 341/3 (observations), 453/6 (report of Third Sub-Committee), 523 (report of General Committee), 543/4 (report of Drafting Committee), 577 (adoption in Second Plenary Session).

² *Actes de Londres*, pp. 187 (proposal), 275/6 (observations), 398/400 (report of Third Sub-Committee), 464 (report of Drafting Committee), 516 (adoption in Second Plenary Session).

³ *Actes de Lisbonne*, pp. 637/40 (proposals), 640/56 (observations), 656/66 (discussion in Third Committee), 757/9 (report of Third Committee), 666/8 (discussion in General Committee), 101/2 (adoption in Second Plenary Session), 117 (General Report).

admit such possibility—with the result that interested parties may directly claim its application by the administrative or judicial authorities of the country concerned. This question gives rise to the following observations :

On the one hand, in stipulating that “ the countries of the Union undertake, etc.” the Article is drafted differently from many other Articles of the Convention, which directly refer to rights or obligations of interested parties (for example, Articles 2, 3, 4, 4ter, 5bis, 5ter, 5quater, 6, 6septies, 8), or directly regulate a situation at issue (for example, Articles 4bis, 5 A(1), (3) to (5), B, C, D, 6quater, 6quinquies, 7). Nor, on the other hand, does Article 6bis refer only to an undertaking by the countries of the Union to *legislate* on a particular matter, as is the case, for example, with Articles 10ter and 11. Therefore, and although the Article leaves certain liberties to national legislations (paragraph (1) : “ if their legislation so permits ”; paragraph (2) : “ a period of *at least* five years... shall be allowed...”; “ The countries of the Union *may* provide for a period, etc.”), it cannot be deemed *only* to oblige the member States to *legislate* on the subject concerned, but may be considered to contain an undertaking also on behalf of the administrative and judicial authorities of these States, which—if compatible with their constitutional systems—must then give effect to the provisions of the Article at the request of interested parties.

(c) The provision under consideration refers only to *trademarks* and *not to service marks*. The member States are therefore not obliged to apply it to service marks, but are free to do so in analogous situations.

(d) The purpose of the provision under consideration is to avoid the registration and use of a trademark, liable to create *confusion* with *another* mark already *well known in the country of such registration or use*, although the latter well-known mark is not, or not yet, protected in that country by a registration which would normally prevent the registration or use of the conflicting mark.¹ This exceptional protection of a well-known mark has been deemed to be justified because the registration or use of a *confusingly similar* mark will in most cases amount to an act of unfair competition,² and may also be considered

¹ Cf. LADAS: “ International Protection of Well-known Trademarks,” *Trademark Reporter*, 1951, p. 661; TROLLER: “ La marque de haute renommée,” *P.I.*, 1953, p. 73; BLUM: “ La marque de haute renommée,” *P.I.*, 1954, p. 110.

² *Actes de La Haye*, p. 455.

prejudicial to the interests of those who will be misled.¹ Whether a trademark will be liable to create confusion with a well-known mark will be determined by the competent authority of the country concerned, and in so doing the said authority will have to consider the question from the viewpoint of the consumers of the goods to which the marks are applied.² The provision specifies that such confusion may occur in cases of *reproduction, imitation or translation* of the well-known mark, or even—see final sentence of paragraph (1)—if only an *essential part of a mark* constitutes a reproduction or confusing imitation of the well-known mark.

(e) The word “mark” in itself would not exclude the extension of the envisaged protection also to well-known *service marks*, but the words at the end of the first sentence of paragraph (1), “used for identical or similar goods,” make it clear that only well-known *trade-marks* are covered by the provision. The member States are, however, free to apply the same rules also to service marks in analogous circumstances.

(f) A trademark may be *well known* in a country before its registration there and, in view of the possible repercussions of publicity in other countries,³ even before it is *used* in such country. Whether a trademark is well known in a country will be determined by its competent administrative or judicial authorities. The Revision Conference of Lisbon in 1958 rejected a proposal according to which *use* of a well-known mark in the country in which its protection is claimed would *not* be necessary for such protection.⁴ This means that a member State is not *obliged* to protect well-known trademarks which have not been used on its territory, but it will be free to do so.⁵ In view of the vote taken at the Lisbon Conference,⁶ the great majority of the member States will probably adopt this attitude.

(g) A well-known trademark will, naturally, only be protected by the Article under consideration if it belongs to a person entitled to the

¹ *Actes de La Haye*, pp. 453/4.

² *Ibidem*, pp. 453/4.

³ *Actes de Lisbonne*, pp. 659, 667. See in Brazil: Supremo Tribunal Federal, 26/4/1963, *G.R.U.R. Int.*, 1964, p. 318 (German translation).

⁴ *Actes de Lisbonne*, pp. 659, 666/7.

⁵ *Ibidem*, p. 668.

⁶ The above proposal was rejected at the Lisbon Conference by 2 countries only, while 25 approved it: *Actes de Lisbonne*, pp. 666/7.

benefits of the Convention, that is, to a natural or legal person who may claim the application of the Convention according to Articles 2 or 3.¹ The provision under examination, however, goes further than that when it states that, in order to be protected, the mark must be considered *well known* in the country concerned “*as being already the mark of*” such person. The history of the provision² shows, however, that it will be sufficient if the mark concerned is well known *in commerce* in the country concerned as a mark belonging to a certain enterprise, without its being necessary that it also be known that such enterprise is entitled to the benefits of the Convention. Nor is it necessary—and it is therefore not necessary to prove—that the person who has applied for or obtained a conflicting registration or who uses a conflicting mark possessed such knowledge.

(h) The protection of well-known marks, according to the provision under examination, applies only with respect to other marks filed, registered or used for *identical or similar goods*. Whether this condition is fulfilled will be determined by the administrative or judicial authorities of the country in which protection is claimed.³

(i) See observation (d) above *in fine*.

(j) In order to give the owner of a well-known trademark sufficient time to react to the registration of a conflicting mark, this provision specifies that he must have a period of at least five years during which he may request the cancellation of such registration. This minimum period was three years until the Revision Conference of Lisbon in 1958. The words “at least” indicate that the fixation of the period is left, on condition that it may not be shorter than five years, to the national legislation or to decisions of the administrative or judicial authorities of the member States.⁴

(k) The member States are free also to provide for a period within which the prohibition of *use* of the conflicting mark must be requested, but no minimum is indicated for this period.

¹ *Actes de La Haye*, pp. 456, 543; *Actes de Lisbonne*, p. 637.

² *Actes de La Haye*, p. 543.

³ Cf. in France: Cour de Riom, 1/4/57, *Ann.*, 1959, p. 32, Cour de Paris, 8/12/1962, *Ann.*, 1963, p. 147 with note by DUSOLIER. The question whether, at least for a certain category of marks of high renown, protection should not be extended to non-similar goods was discussed at the Revision Conference of Lisbon, but without giving positive results: *Actes de Lisbonne*, pp. 660/4, 705/24; see also MIOSQA: *Internationaler Marken- und Herkunftsschutz*, pp. 49/50, referring to further literature.

⁴ *Actes de Lisbonne*, pp. 665, 758.

(1) The administrative or judicial authorities of the country in which the protection of a well-known mark is requested will determine whether the conflicting mark is registered or used *in bad faith*, in which case no time limit for action will prevail. Bad faith will normally exist when the person who registers or uses the conflicting mark knew of the well-known mark and presumably intended to profit from the possible confusion between that mark and the one he has registered or used.

ARTICLE 6ter, paragraphs (1) and (2)^(a)

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

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

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

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

(a) Although some parts of what is now paragraph (10) of this Article were introduced into the Final Protocol which formed an integral part of the original Convention of 1883 and were maintained, in amended form, in the Final Protocol by the Revision Conference of Washington in 1911,¹ this was only in the context of what was then

¹ Cf. the history of the Article in *Actes de Lisbonne*, pp. 127 *et seq.*

Article 6 of the Convention (now, in modified form, Article 6quinquies). Article 6ter as such was introduced into the Convention by the Revision Conference of The Hague in 1925.¹ It underwent some minor modifications as to form at the Revision Conference of London in 1934² and was more thoroughly revised by the Revision Conference of Lisbon in 1958,³ where, inter alia, paragraphs (1)(b) and (c) were inserted and several other important changes were made.

(b) The Article concerns *trademarks*, but its purpose is not to regulate their *protection as subjects of industrial property* but rather to *exclude them from becoming such subjects* in certain circumstances.

Here, again, the question arises whether this Article may be considered "self-executing"—in countries which admit such possibility—with the result that interested parties (States, international intergovernmental organizations and possibly third parties interested in suppressing trademarks which would violate the provisions of the Article) may directly claim its application by the administrative or judicial authorities of the country concerned, or whether legislation in such country is necessary to implement the Article. Its situation in this respect is analogous to that of Article 6bis, examined above (see observation (b) on that Article): countries which admit such possibility may be deemed to have agreed to the application of the Article also by their administrative and judicial authorities, so that in these countries the Article is "self-executing."⁴

(c) The competent authorities here referred to are those of the country whose emblems, official signs and hallmarks are involved. These authorities may allow the use of such emblems, signs or hallmarks in certain trademarks, probably of their own nationals. See also, for the effect of such authorization, paragraph (8) of the Article.

(d) The Article under consideration concerns *trademarks* only and not *service marks*. The member States are therefore not obliged

¹ *Actes de La Haye*, pp. 243/5, 247 (proposals for Article 6quater), 343/5 (observations), 457/67 (report of Third Sub-Committee), 523/5 (report of General Committee), 544/5 (report of Drafting Committee), 577 (adoption in Second Plenary Session).

² *Actes de Londres*, pp. 188/9 (proposal); 276/7 (observations), 400 (report of Third Sub-Committee), 465/6 (report of Drafting Committee), 516 (adoption in Second Plenary Session).

³ *Actes de Lisbonne*, pp. 127/33 (proposals), 134/9 (observations), 139/45 (discussion in First Committee), 295/8 (report of First Committee), 145/7 (discussion in General Committee), 102/3 (adoption in Second Plenary Session), 117 (General Report).

⁴ Cf. LADAS: *The International Protection of Industrial Property*, p. 566.

to apply the Article also to service marks, but they are free to apply analogous rules to those marks and will probably do so in view of the purpose of the Article.

(e) The objective of the provision under consideration is to exclude the registration and use of trademarks which are identical or present a certain similarity to *State emblems*, an expression which, in view of the word "other," includes¹ *armorial bearings and flags* of the State concerned. The reasons for this are² that such registration or use would violate the right of the State to control the use of symbols of its sovereignty and furthermore might mislead the public with respect to the origin of goods to which such marks would be applied. It was the intention of the Revision Conference of The Hague in 1925 to include also in the protection of State emblems the escutcheons of reigning Houses,³ as well as emblems of States included in a Federation which was a member of the Union.⁴ Not included, however, are emblems of lower public bodies, such as provinces or municipalities, of member States.⁵

Whether in these conditions an emblem is a State emblem will be determined by the authorities of the country in which its protection is claimed.

(f) The protection given to State emblems is limited to such emblems of the countries of the Union.⁶ Extension of the application of the Article under consideration to emblems of non-member States is impossible in view of paragraph (3) of the Article, but member States are free to protect such other emblems by other appropriate means, for example, by considering their incorporation in trademarks to be contrary to public order.

(g) *Official signs and hallmarks indicating control and warranty* exist in several States with respect to precious metals or products such as butter, cheese, meat, etc.

(h) The official signs and hallmarks indicating control and warranty are protected by the provision under consideration only if

¹ Also when this expression is used alone, for example, in paragraphs (7) and (8) of the Article.

² *Actes de La Haye*, pp. 243/4.

³ *Ibidem*, pp. 459, 464, 544.

⁴ *Ibidem*, pp. 343/4, 464, 544.

⁵ *Ibidem*, p. 245.

⁶ *Actes de Lisbonne*, p. 140.

they are adopted *by a member State itself*, and not in the case of their adoption by a lower public body or an organization of public law in such State.

(i) State emblems and official signs and hallmarks, covered by the provision under examination, are protected not only against registration and use of trademarks which are identical to them or incorporate them as elements thereof, but also against the inclusion in such trademarks of any *imitation of them "from a heraldic point of view."* The imitation thus forbidden has a narrower scope than the imitation which would normally be considered unacceptable between trademarks. The reason for this is that State emblems frequently contain symbols which are in themselves common, such as a lion, a bear, the sun, etc., and which it must be possible freely to adopt in trademarks, *unless the imitation of the emblem concerns the heraldic characteristics which distinguish one emblem from another.*¹ The member States are however free to grant wider protection to State emblems.²

(j) The Revision Conference of Lisbon in 1958 extended—with some limitations which will be commented upon below—the application of the Article under consideration not only to armorial bearings, flags and other emblems but also to names, and abbreviations of such names, of *intergovernmental organizations* of which one or more of the countries of the Union are members.³ Examples of abbreviations of such names are: ALALC, BIRPI, CERN, EFTA, FAO, ILO, Interfund, OAMPI, UNO, Unesco, WHO, UPU, etc.

(k) The Revision Conference of Lisbon in 1958 excepted from protection under this Article the emblems, names and abbreviations of intergovernmental organizations which are *already the subject of international agreements in force, intended to ensure their protection.* The purpose of this exception was not explained,⁴ but it is probably intended to avoid double, and possibly conflicting, protection in cases where the emblems and name of an organization are already protected by a Convention, such as the Geneva Convention for the amelioration of the condition of the wounded and sick in armed forces, of August 12,

¹ *Actes de La Haye*, p. 245. See also *Actes de Lisbonne*, pp. 129/31, 139/40.

² Cf. in Austria: Patent Office (Division of Appeals), 8/5/1959, *G.R.U.R. Int.*, 1960, p. 73.

³ Cf. RONGA: "Der Schutz von Kennzeichen zwischenstaatlicher Organisationen," *G.R.U.R. Int.*, 1966, p. 148.

⁴ *Actes de Lisbonne*, pp. 142 (proposal of U.S.A.), 143 (vote in First Committee).

1949, Article 44 of which protects the emblem of the Red Cross on a white ground, the words "Red Cross" or "Geneva Cross," and analogous emblems.

(l) A second exception to the protection of emblems, names and abbreviations of intergovernmental organizations, for which provision is made in this Article, is not mandatory, but member States are free not to grant the said protection to the prejudice of owners of rights in trademarks *acquired in good faith before the entry into force, in the country concerned, of the Convention* containing this provision, that is, the Convention as revised at Lisbon or Stockholm.¹ It will probably be necessary for such rights to have been acquired *in the country concerned*, and not merely elsewhere, for this exception to apply. Further rules regarding entry into force of the protection are given in paragraphs (5), (6) and (7) of the Article under consideration.

(m) A third exception to the protection of emblems, names and abbreviations of intergovernmental organizations is again not mandatory but may be made at the discretion of the member States. No such State shall be required to grant the said protection when the use or registration of the trademark against which the protection is invoked does not suggest a *connection* between the mark which contains the emblem, etc., and the organization concerned, or when such use or registration will probably *not mislead the public* as to the existence of a connection between the user and the organization.² It follows *a contrario* from this provision that in the case of incorporation in trademarks of emblems *not* of intergovernmental organizations but of States (paragraph (1)(a) of the Article) no such limitation of the application of the Article is possible, so that the protection of these latter emblems is *absolute* and may *not* depend on suggestions of any connection between the trademark and the emblem. The protection of State *armorial bearings* is even further enlarged by paragraph (9) of this Article, which will be commented upon below.

(n) This provision contains another limitation with respect to the protection of *official signs and hallmarks* of States, *indicating control and warranty*. Such protection will apply only in cases where the marks in which they are incorporated are intended to be used on goods *of the same kind as or a similar kind* to the goods to which the official

¹ *Actes de Lisbonne*, p. 142 (proposal of U.S.A.), 143 (vote in First Committee).

² *Ibidem*.

signs or hallmarks apply.¹ Whether this is the case is a question which will be determined by the competent authorities of the country in which the protection is claimed.

ARTICLE 6ter, paragraphs (3) and (4)(a)

(3)(a) For the application of these provisions, the countries of the Union agree to communicate reciprocally, through the intermediary of the International Bureau, the list of State emblems, and official signs and hallmarks indicating control and warranty, which they desire, or may hereafter desire, to place wholly or within certain limits under the protection of this Article, and all subsequent modifications of such list (b). Each country of the Union shall in due course make available to the public the lists so communicated (c).

Nevertheless, such communication is not obligatory in respect of flags of States (d).

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

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

(a) These provisions, in so far as State emblems, official signs and hallmarks are concerned, were introduced into the Convention by the Revision Conference of The Hague in 1925.² The Revision Conference of Lisbon in 1958 excepted State flags from the obligation of communication and added the provision (3)(b) concerning the emblems, etc., of intergovernmental organizations.³

¹ *Actes de La Haye*, pp. 245, 247, 460/1.

² *Ibidem*, pp. 247 (proposal), 344/5 (observations), 460/2, 464 (report of Third Sub-Committee), 523/5 (report of General Committee), 544/5 (report of Drafting Committee), 577 (adoption in Second Plenary Session).

³ *Actes de Lisbonne*, pp. 132/3 (proposal), 143/5 (discussion in First Committee), 295/8 (report of First Committee), 102/3 (adoption in Second Plenary Session), 117 (General Report).

(b) The State emblems, official signs and hallmarks for which the member States wish to obtain protection will be communicated to the International Bureau, which will then transmit these communications to the other member States. The same procedure will be followed in the case of modifications of the lists of emblems, etc., so communicated; for example, when a member State withdraws its claim to the protection of any of these emblems, etc., or replaces one or more by others. The wording of the provision under consideration is less stringent than that of the analogous provision in subparagraph (b) regarding the communication of emblems, etc., of *intergovernmental organizations*. In the latter case it is clear that the protection *depends* on such communication, whereas in the former case such communication is only prescribed by agreement between the States. However, the situation in the former case is further regulated by paragraph (6) of this Article.

(c) At one stage during the Revision Conference of The Hague it was intended that the member States should *publish* the lists of emblems, etc., which would be the subject of protection. However, in order to avoid the costs of such publication, this obligation was changed to an obligation to *make these lists available to the public*, that is, to deposit them for public inspection.¹ Several States, nevertheless, do publish these lists. Originally, the International Bureau also intended to publish them² but, in fact, apart from communicating them to the member States, it only keeps them available for public inspection.

(d) Since the Revision Conference of Lisbon in 1958, the *flags* of States are *exempt* from any communication, probably because these flags are considered to be sufficiently well known.³ The member States are, however, free also to communicate their flags if they so desire.

(e) As has already been observed, the protection of emblems, names and abbreviations of *intergovernmental organizations* is *dependent upon their communication*. See, further, paragraph (6) of this Article.

(f) The member States may, within a period of twelve months, notify their objections to the protection claimed. These objections

¹ *Actes de La Haye*, pp. 523/4.

² *Ibidem*, p. 524.

³ *Actes de Lisbonne*, pp. 141, 143/4, 147.

may, for example, be based on the consideration that the subject for which protection is claimed is not an *emblem* of the *State* or *intergovernmental organization*, or is not an *official sign* or *hallmark* of the *State* indicating *control and warranty*, or that the emblem is already an *emblem of the country itself* or has been communicated as *that of another country*, or that it has fallen into the *public domain* in the country concerned.

The International Bureau will notify such objections to the State or intergovernmental organization whose emblems, etc., are involved. No special procedure is provided for resolving differences of opinion concerning these objections,¹ but disputes may be settled according to Article 28 of the Convention, if that Article applies between the member States concerned. As long as the objection stands, the State which has made it will not be obliged to protect the emblems, etc., concerned.

ARTICLE 6ter, paragraphs (5), (6) and (7)^{(a)(b)}

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

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

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

(a) As to the moment from which the provisions of the Article have to be complied with, the Revision Conference of The Hague in 1925 had introduced a distinction between well-known State emblems and State emblems which are not well known.² This distinction was

¹ Cf. *Actes de La Haye*, pp. 344/5 (proposal of U.K.), 462.

² *Ibidem*, pp. 465 (discussion in Third Sub-Committee), 523/5 (report of General Committee), 544/5 (report of Drafting Committee), 577 (adoption in Second Plenary Session).

abolished by the Revision Conference of Lisbon in 1958,¹ but in view of the text established at that time other distinctions have to be observed.

(b) The general principle underlying the provisions now being considered is to avoid retroactivity.² In this respect a distinction has to be made between, on the one hand, *flags of States* and, on the other hand, *State emblems* other than flags, *official signs and hallmarks*, and *emblems, including flags, names and abbreviations of intergovernmental organizations*. In the case of the first category, the protection under this provision will apply only to marks registered after November 6, 1925, that is, the date of the signature of the text of the Convention as revised at The Hague. In the case of the second category, the protection will apply only to marks registered more than two months after receipt of the communication of the International Bureau. It is recalled that, according to the first sentence of paragraph (1)(c) of this Article, the member States are, moreover, not obliged to grant protection, with respect to emblems, etc., of intergovernmental organizations, to the prejudice of rights acquired in good faith before the entry into force, in the country concerned, of the Lisbon or Stockholm texts of the Convention, even if the trademarks for which these rights were acquired are *registered* more than two months after receipt of the communication of the claim of protection.

A general exception is made in cases of *bad faith*, where the member States even have the right to annul marks registered before November 6, 1925, which incorporate *State emblems, signs and hallmarks*. Bad faith will probably be held to exist if the trademark has been registered in the knowledge that it incorporated the emblem, sign or hallmark concerned.

ARTICLE 6ter, paragraphs (8), (9) and (10)(a)

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

(9) The countries of the Union undertake to prohibit the unauthorized use in trade of the State armorial bearings of the other countries

¹ *Actes de Lisbonne*, pp. 145, 147.

² *Actes de La Haye*, pp. 462/3, 465/6, 524, 544. In this respect it was admitted that, if a trademark was already registered before a certain date, its renewal after such date would not be assimilated to a new registration: *ibidem*, p. 544.

of the Union, when the use is of such a nature as to be misleading as to the origin of the goods (c).

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

(a) The last three paragraphs of Article 6ter date from the Revision Conference of The Hague in 1928, where the Article was first introduced into the Convention.¹ The Revision Conference of Lisbon in 1958 changed these paragraphs in several respects, in particular by eliminating the word "decorations" from paragraph (10) and adding the signs of intergovernment organizations to that paragraph.²

(b) This paragraph is self-explanatory.

(c) This provision extends the protection of the Article to *other uses of State armorial bearings than their use in trademarks*, which latter use is the subject of paragraph (1). The provision under consideration prescribes that any *unauthorized use in trade* of State armorial bearings will be prohibited if the use is of such a nature as to be misleading as to the origin of the goods.³ This gives a wider protection to State armorial bearings: for example, when they are used as mere decorations and not as trademarks.

(d) Paragraph (10) of the Article under consideration maintains a reservation which had already been made in the Final Protocol forming an integral part of the original Convention of 1883. The reservation relates to the application of what was then Article 6 and is now Article 6quinquies of the Convention. The provision states that, apart from their *obligations* under Article 6ter, the member States *remain free* to refuse or invalidate the registration of marks incorporating the emblems, etc., referred to, in cases where Article 6quinquies is invoked, if such marks are considered to be contrary to morality or public order and, in particular, of such a nature as to deceive the public (Article 6quinquies, Section B, paragraph (3)).

¹ *Actes de La Haye*, pp. 247, 344/5, 464, 466, 524/5, 544/5, 577.

² *Actes de Lisbonne*, pp. 133, 147.

³ *Actes de La Haye*, pp. 345 (proposal of Switzerland), 457/60, 463, 466, 524, 544.

ARTICLE 6^{quater}(^a)

(1) When, in accordance with the law of a country of the Union (*b*), the assignment of a mark (*c*) is valid only if it takes place at the same time as the transfer of the business or goodwill to which the mark belongs, it shall suffice for the recognition of such validity that the portion of the business or goodwill (*d*) located in that country be transferred to the assignee, together with the exclusive right to manufacture in the said country, or to sell therein, the goods bearing the mark assigned (*e*).

(2) The foregoing provision does not impose upon the countries of the Union any obligation to regard as valid the assignment of any mark the use of which by the assignee would, in fact, be of such a nature as to mislead the public, particularly as regards the origin, nature, or essential qualities, of the goods to which the mark is applied (*f*).

(*a*) This Article was introduced into the Convention by the Revision Conference of London in 1934.¹ Since then it has undergone only minor changes as to form.

(*b*) In view of the independence of the rights which may be acquired in the same trademark in different countries, as recognized by Article 6, it is frequently felt desirable that these rights should also be transferred or assigned independently for each country. Such transfers or assignments will be governed by the normal rules of international private law.² There are, however, important differences in the national legislation of the various countries regarding the assignment of trademarks in that many of these legislations allow such assignment without simultaneous or corresponding transfer of the enterprise to which the trademark belongs, while others make the validity of the assignment dependent on the simultaneous or corresponding transfer of such enterprise.³ Some countries have even interpreted the requirement of the corresponding transfer of the enterprise as

¹ *Actes de Londres*, pp. 189/91 (proposal), 277/9 (observations), 400/5 (report of Third Sub-Committee), 466/7 (report of Drafting Committee), 517 (discussion and adoption in Second Plenary Session).

² Cf. in Federal Republic of Germany: Bundesgerichtshof, 21/10/1964, *G.R.U.R. Int.*, 1965, p. 504.

³ Cf. MARTIN-ACHARD: *La cession libre de la marque*, 1946; D. REIMER: "La cession libre de la marque," *P.I.*, 1954, pp. 162, 181.

necessitating the transfer of the *entire* enterprise, even if parts of it are located in countries other than that for which the assignment of the trademark is envisaged. In these cases it might not be possible to assign independently the same trademark belonging to the enterprise in these other countries because the entire enterprise would have to be transferred with the first assignment.

The provision under consideration refers to the laws of countries of the Union of the latter type. The principle underlying the provision prescribes that the member States will be free to require, for the validity of the assignment of a trademark, the simultaneous transfer of the enterprise to which such trademark belongs, but that such requirement will not extend to parts of the enterprise which are located in other countries.

(c) The word "assignment" may be interpreted as also including other means of transfer if regulated by the national law concerned. The word "mark" in itself would permit the extension of the application of the provision also to service marks, but the final words of paragraph (1), and also of paragraph (2), exclude this interpretation. Member States are therefore not obliged to apply the provision by analogy to service marks, but they are free to do so and will probably adopt this attitude in view of the purpose of the provision.

(d) The words "business or goodwill" refer to a distinction which was made when the Article under consideration was introduced into the Convention.¹ The enterprise which owns a trademark in a given country may have its *business*, in the sense of an industrial or commercial establishment, in that country, or it may have this material basis of its activities elsewhere but possess *goodwill* in the country concerned in the form of a circle of customers. In these respective cases the assignment of the trademark will be valid if the portion of the business or the goodwill located in the country concerned is transferred together with the trademark.

(e) The final words of the provision under consideration simply mean that in the envisaged situation the *exclusive right to the trademark* with respect to the goods concerned must be assigned together with the portion of the business or goodwill located in the country, if the assignment is to be considered valid. Thus, the assignor would not be entitled in that country to continue to use the mark himself, in so far as it has been assigned, nor to assign or license it to third parties.

¹ *Actes de Londres*, p. 190.

(f) Paragraph (2) of this Article leaves the member States free not to regard as valid the assignment of a trademark with the relevant part of the enterprise, if the use of such mark by the assignee would be of such a nature as to mislead the public, particularly as regards important features of the goods to which the mark is applied. This freedom may be exercised, for example,¹ if a trademark is assigned for part only of the goods to which it is applied, and if these goods are similar to other goods for which the mark is not assigned. In such cases the public may be misled as to the origin or essential qualities of similar goods to which the assignor and assignee will apply the same trademark, independently.

¹ *Actes de Londres*, p. 517.

ARTICLE 6quinquies, Section A^(a)

A(1) Every trademark (b) duly registered (c) in the country of origin (d) shall be accepted for filing and protected as is (e) in the other countries of the Union, subject to the reservations indicated in this Article (f). Such countries may, before proceeding to final registration, require the production of a certificate of registration in the country of origin, issued by the competent authority. No authentication shall be required for this certificate (g).

(2) Shall be considered the country of origin (h) the country of the Union where the applicant has a real and effective industrial or commercial establishment (i), or, if he has no such establishment within the Union, the country of the Union where he has his domicile (j), or, if he has no domicile within the Union but is a national of a country of the Union, the country of which he is a national (k).

(a) Parts of this Article were already included in Article 6 of the original Convention of 1883 and explained under paragraph 4 of the Final Protocol forming part of the Convention.¹ The original Article 6 was modified on various points by the Revision Conferences of Washington (1911),² The Hague (1925)³ and London (1934).⁴ As has been observed above—see observation (a) regarding Article 6—the Revision Conference of Lisbon (1958)⁵ adopted a new Article 6, embodying the principle of the independence of trademark filings and registrations in the countries of the Union, and transferred a considerable part of the former contents of Article 6, with several modifications, to the new Article 6quinquies, now under examination.

¹ *Actes de Paris*, I, pp. 27 (proposal for Article 5), 70/9, 132/5, 138/42; 11, pp. 24/7, 31/3.

² *Actes de Washington*, pp. 49/51, 229/30 (proposals), 92/3, 95/6, 107, 110/1, 113, 224 (observations), 296/301 (report of Sub-Committee), 308/9 (report to Plenary Committee), 252/3 (discussion and adoption in Third Plenary Session).

³ *Actes de La Haye*, pp. 237/41, 245/6 (proposal), 340/1 (observations), 442/52 (report of Third Sub-Committee), 521/3 (report of General Committee), 542/3 (report of Drafting Committee), 577 (discussion and adoption in Second Plenary Session).

⁴ *Actes de Londres*, pp. 179/87 (proposal), 267/74 (observations), 390/8 (report of Third Sub-Committee), 461/4 (report of Drafting Committee), 516 (discussion and adoption in Second Plenary Session).

⁵ *Actes de Lisbonne*, pp. 565/82 (proposals), 582/99 (observations), 600/16 (discussion in Third Committee), 751/5 (report of Third Committee), 617/20 (discussion in General Committee), 106 (adoption in Second Plenary Session), 117/8 (General Report).

(b) As mentioned above—see observation (a) regarding Article 6—Article 6quinquies concerns an exceptional situation. The normal rules of the Convention, embodied in Articles 6, 2 and 3, are that the member States will determine the conditions for filing and registration of trademarks in their domestic legislation (Article 6), and that foreign applicants for registration who are entitled to the benefits of the Convention under Articles 2 or 3 may claim the application of such domestic legislation under the rule of “national treatment” (Article 2). However, this simple system would not take sufficient account, on the one hand, of some important differences in the domestic legislation of the member States regarding the registration of trademarks, and, on the other hand, of the interest of both owners of trademarks and the public in having the same trademark apply to the same goods in various countries. Differences in domestic legislation would prevent this uniform application of the same trademark to the extent that the legislation of some countries admits, and that of others does not admit, trademarks consisting of simple numbers or letters, surnames or geographical names, words written or not written in a certain language or script, three-dimensional objects,¹ musical notes indicating tunes,² etc. In order to diminish the impact of these differences on the registration of trademarks, the provision under consideration states the principle that a trademark duly registered in the country of origin shall be accepted for filing and protected as is in the other countries of the Union, subject to further rules given in the Article. The member States which do not allow the provisions of the Convention to have any “self-executing” character are obliged to embody this principle in their domestic laws. In the other member States, application of this provision may be directly claimed in the exceptional cases where normal application of the domestic legislation would not allow the registration of a trademark which is already registered in the country of origin. In such cases, the applicant may avail himself of this latter registration and may claim more than national treatment according to the domestic legislation concerned: he may claim the application of the special rules of Article 6quinquies.

In view of the fact that the Revision Conference of Lisbon in 1958, which introduced service marks into the Convention, refused to assimilate service marks to trademarks generally throughout the

¹ To be distinguished from pictures of such objects, which pictures as such, if complying with the conditions of the law concerned, will be registrable in the same way as other pictures.

² To be distinguished from such notes in the form of a picture, in which case the picture, and not the tune indicated by the notes, is the subject of the registration.

Convention,¹ the use of the word *trademark* in this Article indicates that the member States are not *obliged* to apply the provision under examination *also to service marks*. They are however free to do so if they so desire.

(c) The first condition for the application of the provision under consideration is that the trademark concerned should be *duly registered* in the country of origin. The mere proper filing—and even less the mere *use*—of the mark in the country of origin is therefore not sufficient: such filing—in any country of the Union—may be sufficient for the claiming of the right of priority according to Article 4 (see the reference to this possibility in Article 6quinquies, Section F), but not for the claiming of the application of Article 6quinquies. *Evidence* of registration in the country of origin may be required according to the second sentence of the provision under consideration.

(d) The second condition for the application of the provision under consideration is that the trademark concerned must be properly registered *in the country of origin*, as defined in paragraph (2) of the provision. This definition will be examined below, but it may be observed here that, for the application of the Article, previous registration in a *country of origin, as defined*, is prescribed in order to prevent the applicant from freely choosing a country in which such registration would be particularly easy to obtain.

(e) A trademark which fulfills the above conditions will be accepted and protected *as is*—in the authentic French text of the Convention, “*telle quelle*”—in the other countries of the Union, subject to further rules given in the Article under consideration. The meaning of the words “*telle quelle*,” considered as indicating the scope within which the provision must be applied, has given rise to abundant legal studies and case law.²

¹ *Actes de Lisbonne*, pp. 624 (proposal of U.S.A.), 628/33 (discussion in Third Committee), 755/7 (report of Third Committee).

² Cf., for example: “A propos de l’Article 6 de la Convention d’Union,” *P.I.*, 1950, p. 110; MASSON: *La protection “telle quelle” des marques de fabrique et de commerce selon l’article 6 de la Convention d’Union de Paris du 20 mars 1883*, 1956; FAVART: *La marque “telle quelle” et l’interprétation de l’article 6 de la Convention d’Union; Etudes sur la propriété industrielle, littéraire, artistique, Mélanges Marcel Plaisant*, 1958, p. 71; MUNZINGER: “Rückwirkungen des “telle quelle”-Prinzips auf das nationale Markenrecht,” *G.R.U.R. Int.*, 1958, p. 464; EDRICH: *Die Klausel “telle quelle” und ihre Ausgestaltung in der Rechtsprechung der Vertragsländer der Pariser Union*, 1962; “Les restrictions nationales à l’application de l’article 6quinquies de la Convention d’Union de Paris (marque “telle quelle”),” *R.I.P.I.A.*, 1966, p. 220.

The history of the provision shows a clear situation at the start. In the original Convention of 1883 Article 6 was worded: "Every trademark duly filed in the country of origin shall be accepted for filing and protected in its original form (in French, "*telle quelle*") in the other countries of the Union." The Final Protocol, which, according to paragraph 7 thereof, was considered an integral part of the Convention, explained the above provision, in paragraph 4, as follows:

"Paragraph 1 of Article 6 should be understood in the sense that no trademark may be excluded from protection in one of the States of the Union for the sole reason that it does not comply, *with regard to the signs of which it is composed*, with the conditions of the laws of that State, provided it complies on this point with the laws of the country of origin and that it has been properly filed there. Subject to this exception, *which only concerns the form of the mark*, and subject to the provision of the other Articles of the Convention, each State shall apply its domestic law" (emphasis added).

At the Revision Conference of Washington in 1911, the basis for the application of the provision was changed from prior *filing* in the country of origin to prior *registration* in such country, but this does not concern the *scope* of the application of the Article. On this question it was proposed to omit the relevant provision in the Final Protocol and to introduce into the Convention itself the rule that the provision would apply to a trademark "with regard to the signs of which it is composed."¹ No objection was raised to this proposal by the member States and, although finally the provision of the Protocol was omitted without the introduction of a corresponding provision in the Convention itself, it is not possible to conclude from this decision that agreement was reached regarding a different scope of application of the provision.² On the contrary, reservations made in the Second Plenary Session of the Washington Conference made it clear that the provision continued to concern only the *signs of which a trademark is composed*—only visual signs were then considered—and that the member States were not obliged to interpret what a "trademark" is otherwise than according to their domestic legislation.³

This leads to the following conclusions:

Whenever a trademark is duly registered in the country of origin, the other countries of the Union are *obliged to accept and protect it*.

¹ *Actes de Washington*, pp. 50/1.

² *Ibidem*, pp. 92/3, 95/6, 107, 110/1, 113, 224 (observations), 308/9 (report to Plenary Committee), 252/3 (discussion in Third Plenary Session).

³ *Ibidem*, pp. 252/3. See also *Actes de Lisbonne*, pp. 568, 573/6, 600/1.

even if, as regards *its form*, that is, *with regard to the signs of which it is composed*, such trademark does not comply with the requirements of the domestic legislation, *subject to the additional rules, particularly the grounds for refusal or invalidation of any mark, considered on its individual merits*, established in the Article.¹ This rule will therefore apply to trademarks consisting of numbers, letters, surnames,² geographical names, words written or not written in a certain language or script, and other signs of which the trademark is composed.

The member States are, however, *not obliged to interpret the notion of a trademark* in a manner which differs from that of their national legislation. If therefore a three-dimensional object as such, or a "signature tune," is registered as a trademark in the country of origin but is not considered a "trademark" in another country, this latter country is not obliged to register and protect these subjects.³ Member States are equally free, regardless of Article 6quinquies, to apply to trademark applications other provisions of their domestic law not concerning the signs of which a trademark is composed, such as a requirement of previous use of the mark,⁴ or the condition that the applicant must possess an industrial or commercial enterprise.⁵

(f) The obligation to accept a trademark duly registered in the country of origin "as is," that is, with regard to the signs of which it is composed, is subject to the reservations indicated in the Article under consideration (Sections B and C). These reservations consist of grounds for refusal or invalidation, *indicated in a limitative enumeration*. The same grounds—but others also—may apply to a trademark which is *not* covered by the Article, either because it is not found to have been duly registered in the country of origin, or because objections to its registration are not related to the signs of which it is composed.

(g) The last two sentences of the provision under consideration relate to the evidence which countries may require as to the registration

¹ Cf. in Italy: Corte di Cassazione, 18/3/1958, *G.R.U.R. Int.*, 1958, p. 580 (German translation), holding also that the protection does not apply to trademarks which are merely *used* in the country where protection is claimed.

² Cf. in Morocco: Cour de Rabat, 3/6/47, *Ann.*, 1949, pp. 271 (II), 283.

³ See, for a wider interpretation, in Federal Republic of Germany: Bundespatentgericht, 29/4/1965, *G.R.U.R. Int.*, 1965, p. 508.

⁴ Cf. in U.S.A.: Commissioner of Patents, 20/3/1963, 137 *U.S.P.Q.* 69 (1963).

⁵ Cf. in opposite sense in Austria: Patent Office (Division of Appeals), 29/11/1961, *G.R.U.R. Int.*, 1963, p. 107. See also, however, with respect to collective marks, Article 7bis(1) *in fine*.

of a trademark in the country of origin. They are self-explanatory and may be compared with analogous provisions concerning the claim of a priority right according to Article 4 D(3) of the Convention.

(h) The definition of the *country of origin* is important because *only* trademarks duly registered in *such country* are covered by the Article under consideration. The reason is that the exceptional protection provided for trademarks by this Article has been considered justified only when the registration on which the protection is based is made in a country to which the owner of the trademark is in some way related and not in a country freely chosen by him because its legislation has made such registration particularly easy. The original text of the Convention of 1883 even defined the country of origin as being primarily the country in which the applicant has his *principal* establishment. The Revision Conferences of Washington in 1911 and The Hague in 1925 enlarged this provision so that it is now possible for all persons who are entitled to invoke the benefits of the Convention under Articles 2 and 3 also to claim the application of the Article under consideration. The provision, as it now stands, applies the same criteria of nationality, domicile, or establishment, as adopted in Articles 2 and 3, but it establishes a different order of priority among these criteria.

(i) *Primarily*, the country of origin is considered to be the country where the applicant has a *real and effective industrial or commercial establishment*. It is no longer necessary for this establishment to be his *principal* establishment. The expressions used in the provision are identical to those used in Article 3 of the Convention and must be interpreted in the same way (see, above, observation (d) on Article 3).

(j) Only when the applicant has no establishment as above in a *country of the Union* (he may have it elsewhere) will the country of origin be the country where the applicant has his *domicile*. This expression is again the same as that used in Article 3 and must be interpreted in the same way (see, above, observation (c) on Article 3).

(k) *Only* if the applicant has *neither* an establishment as aforesaid *nor* a domicile in one of the countries of the Union will the country of origin be the country of which he is a *national* (see, for the criterion of nationality, observation (b) on Article 2, paragraph (1)).

The effect of the order of priority of the criteria for the country of origin is that, if the applicant has an establishment in a country of the

Union, he cannot claim application of the Article under consideration for a trademark registered in a country where he has no such establishment. Similarly, if a person has no establishment in a country of the Union, but is domiciled in such country, he can claim the application of the Article only for trademarks registered in the latter country. And if he has neither establishment nor domicile in the territory of the Union, only a trademark registration in the country of which he is a national will entitle him to the application of the Article.

ARTICLE 6quinquies, Sections B and C^(a)

B. Trademarks covered by this Article (b) may be neither denied registration nor invalidated except in the following cases (c) :

1. when they are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed (d);
2. when they are devoid of any distinctive character (e), or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production (f), or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed (g) ;
3. when they are contrary to morality or public order (h) and, in particular, of such a nature as to deceive the public (i). It is understood that a mark may not be considered contrary to public order for the sole reason that it does not conform to a provision of the legislation on marks, except if such provision itself relates to public order (j).

This provision is subject, however, to the application of Article 10bis (k).

C(1) In determining whether a mark is eligible for protection (l), all the factual circumstances must be taken into consideration, particularly the length of time the mark has been in use (m).

(2) No trademark shall be refused in the other countries of the Union for the sole reason that it differs from the mark protected in the country of origin only in respect of elements that do not alter its distinctive character and do not affect its identity in the form in which it has been registered in the said country of origin (n).

(a) In the original Convention of 1883, the only ground for refusal or invalidation of the registration of trademarks covered by the Article under consideration was contained in the rule (then paragraph 4 of Article 6) that filing may be refused if the object for which it is requested is considered contrary to morality or public order.¹ The Revision Conference of Washington (1911) considerably extended the grounds for refusal or invalidation² and the following Revision Conferences of The Hague (1925), London (1934) and Lisbon (1958) further developed these grounds.³

(b) "*Trademarks covered by this Article*" are those trademarks which are *duly registered* in the *country of origin* and which, *with regard to the signs of which they are composed*, must be accepted for filing and protected, subject to the provisions now to be examined.

(c) The revision of this provision at the Lisbon Conference in 1958 made it even clearer than before that the grounds for refusal or invalidation of registration, indicated in the provision, are *limitative*⁴ (on the understanding, of course, that other provisions of the Convention, such as Articles 5 C(1), *6bis*, *6ter*, and *6septies*, must be applied as well). The member States are therefore not free to apply *other* grounds for refusal or invalidation of the registration of *trademarks covered by the Article*. The sole task of the competent authorities of these States is to determine whether any of the given grounds for refusal or invalidation applies.

(d) The first permitted ground for refusal or invalidation of a trademark covered by the Article exists when such mark infringes *rights of third parties acquired in the country where protection is claimed*.

¹ *Actes de Paris*, I, pp. 73/4, 138.

² *Actes de Washington*, pp. 50/1, 230 (proposals), 93, 96, 107, 113, 224 (observations), 297/300 (report of Sub-Committee), 308/9 (report to Plenary Committee), 252/3 (discussion and adoption in Third Plenary Session).

³ *Actes de La Haye*, pp. 241, 245/6 (proposal), 340/1 (observations), 445/50 (report of Third Sub-Committee), 521/2 (report of General Committee), 542/3 (report of Drafting Committee), 577 (discussion and adoption in Second Plenary Session); *Actes de Londres*, pp. 183/6 (proposal), 269/72 (observations), 393/6 (report of Third Sub-Committee), 462/3 (report of Drafting Committee), 516 (adoption in Second Plenary Session); *Actes de Lisbonne*, pp. 569/71, 576/8, 580/1 (proposal), 582/99 (observations), 601/2, 603/6 (discussion in Third Committee), 752/5 (report of Third Committee), 618 (discussion in General Committee), 106 (adoption in Second Plenary Session), 118 (General Report).

⁴ *Actes de Lisbonne*, pp. 603, 610, 614, 618, 619.

These rights can be either rights in *trademarks* already protected in the country concerned, or other rights, for example, the right to a *trade name* or a *copyright*, if a trademark consisting of a picture or of invented words would infringe such right. The provision under consideration may also be applied if a trademark would infringe a person's *right of privacy*, for example, when it contains, without his authorization, his name or portrait.

(e) The second permitted ground for refusal or invalidation of trademarks covered by the Article consists of three possibilities: it applies to any trademark which, in the country where protection is claimed, is (1) *devoid of any distinctive character*, or (2) *descriptive*, or (3) a *generic name*. That these three possibilities have to be considered separately was shown by the Revision Conferences of The Hague (1925) and London (1934), where proposals to merge them to a certain extent failed.¹

In all three possibilities the trademark has to be considered *on its individual merits*: in view of the main rule of the Article it is not possible, if a trademark is duly registered in the country of origin, to refuse its registration or protection merely because it consists of a surname, or a geographical name, or numbers or letters, as such, but it may still be found that such mark, *considered on its individual merits*, is devoid of distinctive character, or is purely descriptive, for example, of geographical origin, or is a generic name, or—see observation (i) below—is *misdescriptive* or *misleading* and therefore contrary to public order.

In these circumstances registration or protection of a trademark may, in the first place, be refused, if such mark, considered on its individual merits, is *devoid of any distinctive character*, for example, when it is too simple (a single star, crown or letter) or too complicated (giving the impression of being an adornment or decoration of the goods concerned, or of being merely a slogan consisting of a recommendation to buy or use such goods), or when the sign in question is already in general use, or when it does not consist *exclusively* of a description or a generic name but, even with the addition of other elements, cannot distinguish the goods of one enterprise from those of other enterprises.

(f) Registration may also be refused or invalidated if the trademark concerned is *purely descriptive*, that is, consists *exclusively* of

¹ *Actes de La Haye*, pp. 241, 246, 446/7; *Actes de Londres*, pp. 183/4, 186, 393/4.

indications which may serve, in the country where protection is claimed, to designate particulars of the goods concerned as indicated in the provision. Even where a description as such is not known to the general public, and therefore the trademark is not devoid of any distinctive character, its registration may be refused or invalidated because descriptions must remain in the public domain. It should be observed that signs and indications under this provision may include not only written descriptions but also descriptions in the form of pictures.

(g) Registration may also be refused or invalidated if the trademark concerned consists of a *generic name*, that is, a *customary designation of the goods concerned*, in the country where protection is claimed. This has to be determined according to the *bona fide* and established practices of the trade in such country.

(h) The third permissible ground for refusal or invalidation of trademarks covered by the Article exists when such mark, considered on its individual merits, is *contrary to morality or public order*, again as considered in the country where protection is claimed.¹ A mark contrary to morality would, for example, be a mark containing an obscene picture. A mark contrary to public order would be a mark contrary to the basic legal or social concepts of the country concerned. Examples of such marks could be a mark containing a religious symbol, or a mark containing the emblem of a forbidden political party, or the emblem of a public body, even if such latter emblem were not protected by Article 6ter of the Convention (see paragraph (10) of that Article and, above, observation (d) regarding that paragraph).

(i) The Revision Conference of London in 1934 added to this provision, as a special category of trademarks contrary to morality or public order, those trademarks which are *of such a nature as to deceive the public*. The purpose of this addition² was to enable the member States to refuse or invalidate trademarks containing suggestions that the goods concerned possessed non-existing qualities, or unjustified references to rewards or to protection by a patent, etc. The provision will also apply to trademarks containing misleading indications of geographical origin.³

¹ Cf. EGGER: "La protection de la marque 'telle quelle' et l'ordre public," *Schw. Mitt.*, 1960, p. 38.

² *Actes de Londres*, pp. 184/5.

³ Cf. in Switzerland: Bundesgericht, 11/2/1963, *G.R.U.R. Int.*, 1963, p. 609.

(j) The Final Protocol which formed an integral part of the Convention as revised by the Conference of Washington in 1911 had already specified that the mere fact that a trademark *does not conform to a provision of the law* of the country where its protection is claimed is not sufficient reason to consider it *contrary to public order*, except if such provision itself relates to public order.¹ This provision was transferred to the Convention itself by the Revision Conference of The Hague in 1925.² The need for such a provision is evident, because if a member State could refuse or invalidate a trademark registration on the ground of public order, merely because it did not conform to its domestic legislation, the purpose of the Article under consideration, which is to enable applicants to claim, if necessary, more than normal national treatment (see, above, observation (b) on Section A(1) of the Article), would be entirely defeated.

(k) The last sentence of the provision under discussion was added by the Revision Conference of Lisbon in 1958³ after analogous proposals had failed at the preceding Revision Conferences of the Hague (1925) and London (1934). The sentence enables member States to refuse or invalidate the registration of a trademark if, for reasons other than those already mentioned in the Article—for example, infringement of the rights of third parties or deceptive character of the mark—its registration would *constitute an act of unfair competition*. This, for example, could be the case if the mark, in reproducing the picture of a well-known building which is the seat of a competitor, would be liable to cause confusion with that establishment, or if the mark contained a discrediting comparison with the goods of one or more competitors.⁴

(l) After the Revision Conference of The Hague in 1925 and until the Revision Conference of Lisbon in 1958, the Article under consideration contained a provision whereby, *in order to determine the distinctive character of a mark*, all factual circumstances, particularly the length of time the mark has been in use, must be taken into account. The Revision Conference of Lisbon gave a more general scope to this principle by applying it to *the determination of the question whether*

¹ *Actes de Washington*, pp. 297/8, 253.

² *Actes de La Haye*, pp. 246, 447, 542.

³ *Actes de Lisbonne*, pp. 590, 594 (proposals of Netherlands and Switzerland), 604/5, 610, 613, 614, 618/20 (discussions in Third Committee and General Committee), 753, 755 (report of Third Committee), 106 (adoption in Second Plenary Session), 118 (General Report).

⁴ *Actes de Londres*, p. 185.

a mark is eligible for protection, that is, to all possibilities of refusal or invalidation of marks covered by Article 6quinquies, Section B.¹

(m) The *factual circumstances* may, for example, show that, during a long period of simultaneous use, two not very dissimilar trademarks have nevertheless not caused any confusion, so that registration of one of them will not infringe the rights in the other. Or the circumstances may show that a trademark which originally was not distinctive has, in the long run, through use, acquired a "*secondary meaning*" which makes it distinctive. Or, again, the circumstances may show that a mark which seems to contain a deceptive suggestion has not, in fact, led to any deception and may therefore be held not to be of such a nature as to deceive the public.

The competent authorities of the country in which protection of the mark is claimed may draw conclusions of this kind also from circumstances which have arisen in other countries.²

(n) Paragraph (2) of the provision under consideration was added to the Convention by the Revision Conference of London in 1934.³ The provision presents an analogy with Article 5, Section C(2), examined above (see, in particular, observation (g) on that paragraph). This latter provision states that the *use* of a trademark by the proprietor in a form which is not essentially different from that in which it has been registered in one of the countries of the Union shall not diminish the *protection* of the mark. The provision now being considered applies the same principle to the situation where, *on the basis of a prior registration in the country of origin, registration of the trademark as it is sought in other countries of the Union*. Unessential differences between the trademark as registered in the country of origin and as filed in the country where protection is claimed will not diminish the obligation of registration in the latter country. Nor may such differences lead to invalidation of the registration, although this is not explicitly stated in the provision. Unessential differences in this respect are those which consist of elements that do not alter the distinctive character of the mark and do not affect its identity in the form in

¹ *Actes de Lisbonne*, pp. 577, 581, 605/6, 610, 614, 618, 620, 753, 755, 106, 118.

² *Ibidem*, pp. 606, 753. See in Switzerland: Bundesgericht, 15/6/1955, *G.R.U.R. Int.*, 1956, p. 58.

³ *Actes de Londres*, pp. 393 (proposal of Poland and discussion in Third Sub-Committee), 462/3 (report of Drafting Committee), 516 (discussion and adoption in Second Plenary Session).

which it has been registered in the country of origin. Examples of such differences could be the adaptation or translation of certain elements of a trademark with a view to its registration in countries other than the country of origin. The competent authorities of the country in which protection of the mark is claimed will determine whether such differences are unessential.

ARTICLE 6quinquies, Sections D, E and F^(a)

D. No person may benefit from the provisions of this Article if the mark for which he claims protection is not registered in the country of origin (b).

E. However, in no case shall the renewal of the registration of the mark in the country of origin involve an obligation to renew the registration in the other countries of the Union in which the mark has been registered (c).

F. The benefit of priority shall remain unaffected for applications for the registration of marks filed within the period fixed by Article 4, even if registration in the country of origin is effected after the expiration of such period (d).

(a) The first two of these Sections concern the dependence of trademark registrations obtained under this Article on the registration in the country of origin. Section D was introduced by the Revision Conference of Lisbon (1958),¹ to replace another provision adopted by the Revision Conference of London (1934).² Section E dates from the Revision Conference of The Hague (1925).³ Section F, also introduced into the Convention by the Revision Conference of The Hague,⁴

¹ *Actes de Lisbonne*, pp. 578/9, 581 (proposal), 602/3, 610, 613, 614/6 (discussion in Third Committee), 750, 753/5 (report of Third Committee), 617/8 (discussion in General Committee), 106 (adoption in Second Plenary Session), 118 (General Report).

² *Actes de Londres*, pp. 179/83, 186 (proposal), 272/3 (observations), 396/8 (report of Third Sub-Committee), 463 (report of Drafting Committee), 516 (adoption in Second Plenary Session).

³ *Actes de La Haye*, pp. 340 (proposal of U.K.), 450/1 (report of Third Sub-Committee), 522/3 (report of General Committee), 542/3 (report of Drafting Committee), 577 (adoption in Second Plenary Session).

⁴ *Ibidem*, pp. 451 (proposal of Belgium), 451/2 (report of Third Committee), 522 (report of General Committee), 542 (report of Drafting Committee), 577 (adoption in Second Plenary Session).

concerns the relationship between the rules of Article 6quinquies and those of Article 4, regarding the right of priority.

(b) There has frequently been regrettable confusion with respect to the question of the *dependence or independence* of registrations of the same trademark in various countries of the Union. The reason for this confusion is that insufficient distinction has been made between the situation, on the one hand, where such a trademark is registered in various countries *under the normal rule of "national treatment"* of applications, and the *exceptional situation*, on the other hand, where a trademark, *duly registered in the country of origin*, has to be accepted *as is* in the other countries of the Union if it does not comply, with regard to the signs of which it is composed, with the domestic legislation of such countries. The Revision Conference of Lisbon in 1958 arrived at a clear distinction between these situations, for the first of which the *complete independence* of trademark registrations was then recognized in Article 6, whereas for the second, exceptional situation, regulated in Article 6quinquies, the opposite rule was adopted,¹ providing for the *complete dependence* of registrations upon the registration in the country of origin. This means that if, on the basis of a registration in the country of origin, protection is claimed for a trademark, with respect to the signs of which it is composed, notwithstanding the domestic legislation of the country concerned, such registration may *still be refused*, or *cancelled*, or that *protection may be refused*, if the *registration in the country of origin has meanwhile been cancelled, annulled, withdrawn, or has lapsed for any other reason*.

(c) Section E refers to the situation where the registration of a trademark in the country of origin and another registration based on the former, in application of the Article under consideration, do not have the same duration.² If the duration in the country of origin is shorter, and the registration in that country is not renewed, the registration based on it in another country may be cancelled (see, above, observation (b)). If, however, the registration in the country of origin is renewed in time, that fact will not necessitate renewal of a corresponding registration in another country if the normal duration of the latter registration has not yet expired. If, on the contrary, the registration in the country of origin expires later than the corresponding registrations

¹ *Actes de Lisbonne*, pp. 602/3, 613, 614/6, 617/8, 750, 753/5, 106, 118.

² *Ibidem*, p. 608.

in other countries, these latter registrations will have to be renewed independently before renewal in the country of origin.

(d) The application of Article 6quinquies does not affect the right of priority recognized by Article 4. The relationship between these Articles is the following :

On the basis of the *first filing* of an application for the registration of a trademark in *any* country of the Union, a *right of priority* is recognized by Article 4 for the purpose of similar filings, within six months, in the other countries. For that right of priority, it is immaterial whether or not the first filing leads to a registration in the country where it has been effected (Article 4 A(3)).

If, however, a first, *or any other*, filing in the *country of origin* as defined in Article 6quinquies A(2) leads to *registration* in such country, the trademark *must, without any limit of time, be accepted for filing and protected* as is in the other countries of the Union, but the recognition of a right of priority for its registration depends on Article 4.

These rules will normally operate separately but may be combined if a *first filing in the country of origin* is followed, *within six months*, by one or more similar filings in other countries of the Union, and if the first filing leads to a *proper registration* in the country of origin *before* a decision is taken about acceptance of the filings in the other countries. In such cases, the trademark has to be accepted *as is*, in view of Article 6quinquies, and a *right of priority, as of the date of first filing*, will be recognized for its registration, by virtue of Article 4.

ARTICLE 6sexies^(a)

The countries of the Union undertake to protect service marks (b). They shall not be required to provide for the registration of such marks (c).

(a) This Article was introduced into the Convention by the Revision Conference of Lisbon in 1958.¹ As observed above, that Conference did not accept a more ambitious proposal to assimilate service marks to trademarks throughout the Convention.² What has been adopted is an obligation to protect service marks but not also to register them.

(b) According to the provision under consideration, the member States "undertake to protect service marks."³ This raises the question whether the member States are obliged to legislate on the matter or whether the provision introduces a direct obligation to protect the subject concerned, with the result that—in countries which admit such possibility—the provision may be considered "self-executing" and therefore interested parties may directly claim its application by the competent authorities of the country concerned. (See, above, with respect to analogous questions, observation (b) on Article 5quinquies, observation (b) on Article 6bis, and observation (b) on Article 6ter.)

In the case of Article 6sexies, the discussions at the Lisbon Conference made it clear that the provision would *not* oblige the member States to legislate expressly on the subject of service marks, so that these States would comply with the provision not only when they introduce special measures for the protection of service marks into their legislation, but also when they grant such protection by other means, for example, in their laws against unfair competition.⁴

¹ *Actes de Lisbonne*, pp. 624, 626/7 (proposals of U.S.A. and Sweden), 628/33 (discussion in Third Committee), 755/7 (report of Third Committee), 634/6 (discussion in General Committee), 99, 103 (adoption in Second Plenary Session), 114, 118 (General Report).

² *Ibidem*, pp. 624 (proposal of U.S.A.), 628/33 (discussion in Third Committee), 755/7 (report of Third Committee).

³ See, for the notion of service marks, observation (g) on Article 1, paragraph (2), above, and further, MASCAREÑAS: "La marque de service," *P.I.*, 1959, p. 137 (English translation in *I.P.Q.*, July 1960, p. 10); FROSCHMAIER: *Der Schutz von Dienstleistungszeichen*, 1959; DUSOLIER: "La marque de service," *R.I.P.I.A.*, 1965, p. 181.

⁴ *Actes de Lisbonne*, pp. 633, 634, 635, 756/7, 118.

Thus, the provision under consideration does not contain an obligation to legislate, but it does contain an *obligation to protect*, which must be deemed to be an obligation to be complied with by the competent authorities of the member States. Therefore the provision must be considered "self-executing"—in countries which admit this possibility—with the result that interested parties may directly claim the protection of service marks by the competent authorities of the country concerned by all legal means available.

(c) Since the member States will not be obliged to legislate on the protection of service marks, it is logical that they should not have to provide for the registration of such marks, particularly as registration may only be possible on the basis of special legislation.

ARTICLE 6septies^(a)

(1) If the agent or representative (*b*) of the person who is the proprietor of a mark in one of the countries of the Union (*c*) applies, without such proprietor's authorization (*d*), for the registration of the mark in his own name, in one or more countries of the Union (*e*), the proprietor shall be entitled to oppose the registration applied for (*f*) or demand its cancellation (*g*) or, if the law of the country so allows, the assignment in his favor of the said registration (*h*), unless such agent or representative justifies his action (*i*).

(2) The proprietor of the mark shall, subject to the provisions of paragraph (1), above (*j*), be entitled to oppose the use of his mark by his agent or representative if he has not authorized such use (*k*).

(3) Domestic legislation may provide an equitable time limit within which the proprietor of a mark must exercise the rights provided for in this Article (*l*).

(a) This Article was introduced into the Convention by the Revision Conference of Lisbon in 1958.¹

(b) The Article under consideration deals with a special situation, namely, the relationship between the *proprietor of a mark* and his *agent or representative* regarding *registration or use of the mark by the latter*. In many cases such relationship will be adequately regulated by contract, but in other cases a contract will not exist or it will be silent or inadequate on the subject. It will sometimes be in the interest also of the proprietor of the mark if his agent or representative in a given country, on his own initiative, takes the necessary measures to protect the mark by registration and by using it in view of possible user requirements, but grave difficulties may then arise with respect to the exclusive right to use the mark, or once the relationship between the parties is terminated.

If the application of the provision under consideration is requested in a country of the Union, the competent authorities of such country will first have to determine whether the person who has applied for registration of the mark in his own name in that country *can be*

¹ *Actes de Lisbonne*, pp. 680/2 (proposal), 682/6 (observations), 687/92 (discussion in Third Committee), 760/1 (report of Third Committee), 692/3 (discussion in General Committee), 103/4 (adoption in Second Plenary Session), 118 (General Report).

considered to be the agent or representative of the proprietor of the mark in one of the countries of the Union. In view of the purpose of the provision the above wording will probably not be interpreted in a narrow legal sense, so that the provision will also be applied to those who have acted as distributors of goods bearing the mark and who have applied for registration of that mark in their own name.¹

Although there is no reference to service marks in the history of the provision, the adoption of the word "mark," at the time when service marks were introduced into the Convention, will allow the provision to be applied not only to *trademarks* but also to *service marks*.

(c) A second question to be examined by the authorities of the country in which application of the provision under consideration is requested is whether registration of the mark has been applied for by an agent or representative "of the person who is the proprietor of a mark in one of the countries of the Union."

Since there is no reference to any country of origin, as defined, for example, in Article 6quinquies, Section A(2), the provision applies when the person concerned is the proprietor of the mark in *any* country of the Union, including the country in which the agent or representative has applied for or obtained the registration of the mark.² The latter situation may arise if the country concerned does not carry out an examination of applications for registration as to possible conflicts with existing registrations, or if such country allows the property in a mark to be acquired merely by first use.

A person who is the proprietor of a mark in one of the countries of the Union may request application of the provision even if somebody else, and not he, is the proprietor of the mark in other countries, on condition, however, that it is *his* agent or representative who has applied for registration of the mark.

The question *whether* a person is the *proprietor* of the mark in a country of the Union will have to be decided according to the domestic legislation of that country.

(d) The provision under consideration applies only when the agent or representative has applied for registration of the mark *without*

¹ *Actes de Lisbonne*, p. 690. However, the introduction of the words "or client" after "representative" was rejected by the Conference of Lisbon, because the expression "client" was considered too vague: *Actes de Lisbonne*, pp. 690/1, 760.

² *Ibidem*, pp. 688/9, 760.

the authorization of the proprietor. In the event of authorization, the relevant contract will have to regulate the situation, particularly regarding the case of termination of the relationship between the parties.

(e) The provision under consideration is applicable when the agent or representative of the proprietor of the mark in a country of the Union applies for the registration of the mark, in his own name, in one of the countries of the Union. In view of the purpose of the provision, it may be applied also when the mark in respect of which registration is applied for by the agent or representative is *not identical* but *similar* to the mark of the proprietor concerned.¹

(f) It depends on the domestic legislation of the country where the application of the provision under examination is sought whether the registration of the mark applied for by the agent or representative may be *opposed* by the proprietor or whether the latter may only—or also—demand its *cancellation* after registration.

(g) Since the possibility of *opposing* an application for registration under the conditions referred to in the provision may be limited to the period before registration, it is particularly important that the proprietor be allowed to *demand the cancellation of such registration*.

(h) A third possibility open to the proprietor of the mark, if the law of the country concerned so allows, is to demand the *assignment in his favor* of the registration obtained by the agent or representative. Such assignment may place the proprietor of the mark in a better position than if he has first to obtain the cancellation of the registration by the agent or representative and then replace that registration by one in his own name, because by means of an assignment he acquires a registration on the basis of an earlier application, which may be important with respect to rights of third parties.

(i) The Lisbon Conference intended to make the rule in this provision not too rigid² by allowing for the possibility that the *agent or representative may justify his application for registration of the mark*. Such justification would, for example, be possible if the proprietor of the mark had caused his agent or representative to

¹ *Actes de Lisbonne*, p. 681.

² *Ibidem*, pp. 689, 691, 760.

believe that he, the proprietor, had abandoned the mark or was not interested in obtaining rights in it in the country concerned.

(j) One of the further rights conferred on the proprietor of a mark in a country of the Union is the right to oppose the unauthorized use of the mark by his agent or representative. This right is given subject to the provisions of paragraph (1) of the Article under consideration: the right exists only in the same conditions as the rights given to the proprietor in paragraph (1) and with a similar possibility for the agent or representative to justify his unauthorized use of the mark.

(k) The right to oppose the unauthorized use of the mark by the agent or representative is independent of the question whether such agent or representative has applied for registration of such mark or has obtained such registration.

(l) In order to avoid unduly prolonging situations which are legally uncertain, the member States may provide an equitable time limit within which the proprietor of a mark must exercise the rights provided for in the Article under consideration. There is no such time limit in countries which do not prescribe any.

It was understood during the Lisbon Conference¹ that, when a mark registered or used by an agent or representative is well known in the country concerned, Article 6bis of the Convention may also be applied.

¹ Actes de Lisbonne, pp. 691, 761.

ARTICLE 7(a)

The nature of the goods to which a trademark is to be applied shall in no case form an obstacle to the registration of the mark (b).

(a) This Article already appeared in the original text of the Convention of 1883, although it then referred to the filing and not to the registration of a trademark.¹ The provision was modified in this latter respect by the Revision Conference of The Hague.²

(b) The Article under consideration can be compared, to a certain extent, to Article 4^{quater} of the Convention regarding patents. The purpose of these Articles is to make the protection of industrial property independent of the question whether goods in respect of which such protection would apply may or may not be sold in the country concerned. For example, the situation in which a trademark is intended to be used on a pharmaceutical product which has not as such been approved by the competent authorities of a country, and whose sale is consequently not allowed, must not lead to a refusal to register the trademark, because it is of interest to the proprietor to secure his rights in the eventuality that the sale of his product may be permitted later on.³ The Article under consideration would also apply when the use of trademarks is prohibited for any category of goods or when the sale of goods is subject to a monopoly or a concession.

The Article under consideration has a rather narrow scope, as became clear when attempts failed at the Revision Conference of Lisbon in 1958 to give it a wider application, namely, to extend it to *renewals* of registrations and to the *duration of the exclusive right to use* the trademark.⁴

¹ *Actes de Paris*, I, pp. 27 (proposal), 89 (explanation of motives), 97, 143 (discussion and adoption).

² *Actes de La Haye*, pp. 525 (report of General Committee), 545 (report of Drafting Committee), 577 (adoption in Second Plenary Session).

³ *Actes de Paris*, I, p. 89.

⁴ *Actes de Lisbonne*, pp. 694/704, 761/3.

ARTICLE 7bis^(a)

(1) The countries of the Union undertake (b) to accept for filing and to protect collective marks (c) belonging to associations (d) the existence of which is not contrary to the law of the country of origin (e), even if such associations do not possess an industrial or commercial establishment (f).

(2) Each country shall be the judge of the particular conditions (g) under which a collective mark shall be protected and may refuse protection (h) if the mark is contrary to the public interest (i).

(3) Nevertheless, the protection (j) of these marks shall not be refused to any association the existence of which is not contrary to the law of the country of origin (k), on the ground that such association is not established in the country where protection is sought (l) or is not constituted according to the law of the latter country (m).

(a) The main parts of this Article concerning collective marks were introduced into the Convention by the Revision Conference of Washington in 1911.¹ The Article was further elaborated by the Revision Conference of London in 1934.²

(b) In view of the wording of the Article, which refers to an "undertaking of the countries of the Union," the question again arises whether this Article may be considered "self-executing"—in countries which admit such possibility—with the result that interested parties may directly claim its application by the administrative or judicial authorities of the country concerned. The position of the Article in this respect is analogous to that of Article 6bis and reference may therefore be made to observation (b) regarding that Article. Here again the conclusion must be that the Article contains an undertaking also on the part of the administrative and judicial authorities of member States which admit this possibility, so that these authorities must directly give effect to the provisions of the Article at the request of interested parties.

¹ *Actes de Washington*, pp. 51/2, 230/1 (proposals), 93, 96, 107, 223 (observations), 304/5 (report of Sub-Committee), 309 (report to Plenary Committee), 253/4 (discussion and adoption in Third Plenary Session).

² *Actes de Londres*, pp. 193/5 (proposal), 281/3 (observations), 407/9 (report of Third Sub-Committee), 467 (report of Drafting Committee), 517 (discussion and adoption in Second Plenary Session).

This means, for example, that when the domestic legislation of such countries does not contain special provisions on the registration and protection of collective marks the authorities of those countries are, nevertheless, obliged to register and protect such marks. If, on the other hand, a member State has such special legislation, it will be applied to foreign collective marks by virtue of Articles 2 and 3 of the Convention, taking into account the further regulation given in the Article under consideration.

(c) The Article under consideration concerns "*collective marks*."¹ These marks are not defined in the same way by the various national legislations, but they can roughly be said to be signs which serve not to distinguish the goods or services of one enterprise from those of other enterprises, but to distinguish the *geographical origin* or *other common characteristics* of goods or services of *different enterprises* which use the *collective mark under the control of its owner*. These marks generally imply a certain guarantee of quality.

The member States are obliged to accept such marks for registration and to grant protection to them according to the rules given in the Article under consideration.

(d) The Article covers only collective marks "*belonging to associations*," which will generally be associations of manufacturers or sellers of goods produced in a certain country or region or having certain common characteristics or qualities. Collective marks of States or other public bodies are not covered by the provision. A proposal to enlarge it in this respect was not accepted by the Revision Conference of London in 1934.² However, collective marks of States and other public bodies will frequently be protected by virtue of the rule of "national treatment" embodied in Article 2 of the Convention, and those of States—if these marks are at the same time official State signs or hallmarks indicating control and warranty—also by Article 6ter.

(e) Collective marks of associations will be covered by the provision under consideration only when the existence of such associations is "*not contrary to the law of the country of origin*." What is to be understood by the country of origin is not clear. Since there is no reference, in this respect, to the definition of country of origin in Article 6quinquies, Section A(2), and since in view of the final words of

¹ Cf. PAHUD: *La marque collective en Suisse et à l'étranger*, 1938; EGGER: "A propos de la marque collective," *Schw. Mitt.*, 1962, p. 100.

² *Actes de Landres*, pp. 193/4, 409, 467, 517.

Article 7bis(1) the first criterion in that definition would not necessarily apply, it is probable that "country of origin" in Article 7bis does not mean the country of origin of the mark according to Article 6quinquies, Section A(2), but means the country of origin of the association concerned.¹

In order that the provision be applicable, *the existence* of the association to which the collective mark belongs must *not be contrary to the law of the country of origin*. This provision again is not very clear, but it probably means that the association concerned does not have to *prove* that it *conforms* to the legislation of its country of origin, but that registration and protection of its collective mark may be *refused* if the *existence* of such association is found to be *contrary* to such legislation.

(f) It follows already from Article 2(2) of the Convention that, with respect to the rule of "national treatment," no *domicile or establishment in the country where protection is claimed* may be required. The last words of the provision under consideration add the further stipulation that, for the registration and protection of *collective marks belonging to associations*, such associations may not even be required to possess an industrial or commercial establishment *anywhere*. In other words, these associations, without possessing any industrial or commercial establishment themselves, may only *control the use* of a collective mark *by others*. These other parties will then possess the establishments for the goods or services of which the collective mark will be used.

(g) The member States are free to establish or apply the *particular conditions under which they will agree to protect collective marks*, which conditions will then apply both to national marks and to those covered by the Convention. This may be done either by the adoption of general regulations on the matter or by decisions regarding each collective mark whose protection is sought.² The conditions for protection may relate to the character of the associations which claim protection³ and may, for example, preclude that such associations themselves possess an industrial or commercial establishment;⁴ the

¹ Cf. TROLLER: *Die mehrseitigen völkerrechtlichen Verträge im internationalen gewerblichen Rechtsschutz und Urheberrecht*, p. 55.

² *Actes de Washington*, p. 309.

³ See in Federal Republic of Germany: Bundespatentgericht, 4/8/1966, *G.R.U.R. Int.*, 1967, p. 72.

⁴ *Actes de Londres*, pp. 408, 517.

conditions may also relate to the character of the collective mark and the guarantee given by the association concerned as to the proper use of the mark.¹ Member States are, for example, also free to prohibit the assignment of collective marks.²

(h) The words "protected" and "protection" must, in view of the opening words of the preceding paragraph, be deemed to include also the *acceptance of a collective mark for filing* and its registration.³

(i) The member States may, in particular, refuse protection of a collective mark if it is *contrary to the public interest*. The *public interest* (see also Article 5 C(3) *in fine*) should not be confused with *public order* as referred to in Article 6quinquies, Section B(3). The latter expression refers to basic legal or social concepts of the country concerned. The public interest is a much wider notion and relates to the interest of the public in finding the common characteristics of certain goods or services indicated by a collective mark,⁴ generally suggesting a guarantee of quality. If acceptance of the mark would be against such public interest, its registration and protection may be refused.

(j) Here, again, the word "protection" must be deemed to include acceptance for filing and registration.

(k) This part of paragraph (3) merely repeats what has already been said in paragraph (1), but the words which follow give more precision to the provision.

(l) If the existence of the association claiming protection of a collective mark is not contrary to the law of the country of origin, refusal of registration and protection of such mark will not be possible on the ground that *the association is not established in the country where protection is sought*. This rule is in conformity with the general rule given in Article 2(2) of the Convention.

(m) Nor will refusal of a collective mark be possible on the ground that the association claiming protection is not constituted *according to the law of the country where protection is sought*.

¹ *Actes de Washington*, pp. 304, 309, 254.

² *Actes de Londres*, p. 194.

³ *Actes de Washington*, p. 309.

⁴ *Actes de Washington*, pp. 107, 304; *Actes de Londres*, pp. 282, 409.

ARTICLE 8^(a)

A trade name (b) shall be protected (c) in all the countries of the Union without the obligation of filing or registration (d), whether or not it forms part of a trademark (e).

(a) This Article was already included in the original text of the Convention of 1883.¹ The Revision Conference of The Hague in 1925 modified the wording on one point in order to achieve more conformity with other provisions of the Convention.²

(b) As has been observed above—see observation (h) on Article 1, paragraph (2)—the conception of what a “trade name” is varies in the different countries of the Union.³ Whether a name for which protection is sought is or is not a “trade name” is a question of qualification which has to be resolved in the country where such protection is sought.

Although the Article under consideration is generally worded, the protection of a trade name, by virtue of this Article, can be claimed only by a person who is entitled to the benefits of the Convention according to Articles 2 or 3.⁴

(c) The Article under consideration prescribes that a trade name should be *protected*,⁵ but it does not specify how such protection must be given (see also, however, Articles 9 and 10*ter*). The member States are free to regulate such protection either by special legislation or by legislation against unfair competition or by other appropriate means. The protection will generally be given against unlawful acts of third parties consisting, for example, of use of the same or a confusingly similar trade name or of a mark similar to the trade name, if such use is liable to cause confusion among the public. Countries are free to

¹ *Actes de Paris*, I, pp. 27 (proposal), 97/100, 143 (discussions and adoption).

² *Actes de La Haye*, pp. 525 (report of General Committee), 545 (report of Drafting Committee), 577 (adoption in Second Plenary Session).

³ See “Protection du nom commercial en France et en divers autres pays,” *R.I.P.I.A.*, 1962, p. 145.

⁴ *Actes de Paris*, I, pp. 98/100, 143.

⁵ Cf. CONTE: “La protection du nom commercial et l'article 8 de la Convention d'Union,” *P.I.*, 1931, p. 200; SAINT-GAL: “Protection du nom commercial sur le plan international,” *R.I.P.I.A.*, 1962, p. 189; 1964, p. 92; and “Der internationale Schutz des Handelsnamens,” *G.R.U.R. Int.*, 1964, p. 289.

prescribe special measures in cases of use of homonymous surnames as trade names.

The protection given to a foreign trade name must, in view of the principle of national treatment embodied in Article 2 of the Convention, be equal to the protection afforded to national trade names.¹ If, however, a country grants different protection to trade names which are registered in the country and to other national trade names not so registered, it will not be obliged to grant to foreign trade names, not registered in the country concerned, more protection than to unregistered national trade names.² If, in any country, the likelihood of confusion among the public is a criterion for the protection of a trade name against other trade names or marks, such a country may require that a foreign trade name, in order to be protected, should be used or have become known to some extent in the country, because otherwise the likelihood of confusion would not exist.³

(d) A trade name will be protected, according to the Article under consideration, *without any obligation of filing or registration*, which means that, in the country where its protection is claimed, filing or registration of the trade name may be required neither in that country nor in any other country, particularly in the country of origin of the trade name, even if registration is mandatory there.

If the legislation of a country subjects the protection of *national* trade names to registration, the provision under discussion will mean a derogation from such obligation in favor of *foreign* trade names. This is a situation similar to that which may exist with respect to Article 2(2) (see, above, observation (b) on that provision).

(e) The protection of a trade name, according to the Article under consideration, must be independent of the questions whether the trade name serves also as, or is part of, a *trademark*, and whether such trademark is also protected. If, for example, a trademark containing a trade name is abandoned and falls into the public domain, the protection of the trade name will not be affected.⁴

¹ Cf. in France: Cour de Paris, 13/6/1961, *Ann.*, 1962, p. 54; *id.*, 8/12/1962, *Ann.*, 1963, p. 147.

² Cf. in Austria: Oberster Gerichtshof, 2/9/1958, *G.R.U.R. Int.*, 1959, p. 300; *id.*, 21/11/1961, *G.R.U.R. Int.*, 1962, p. 251; in Switzerland: Bundesgericht, 4/5/1964, *G.R.U.R. Int.*, 1966, p. 95; *id.*, 6/10/1964, *ibidem*, 1965, p. 513.

³ Cf. in Federal Republic of Germany: Bundesgerichtshof, 4/11/1966, *G.R.U.R. Int.*, 1967, p. 396, and in Austria and Switzerland the decisions referred to in the preceding footnote.

⁴ *Actes de Paris*, I, p.97.

ARTICLE 9^(a)

(1) All goods unlawfully bearing a trademark or trade name shall be seized on importation into those countries of the Union where such mark or trade name is entitled to legal protection (b).

(2) Seizure shall likewise be effected in the country where the unlawful affixation occurred or in the country into which the goods were imported (c).

(3) Seizure shall take place at the request of the public prosecutor, or any other competent authority, or any interested party, whether a natural person or a legal entity, in conformity with the domestic legislation of each country (d).

(4) The authorities shall not be bound to effect seizure of goods in transit (e).

(5) If the legislation of a country does not permit seizure on importation, seizure shall be replaced by prohibition of importation or by seizure inside the country (f).

(6) If the legislation of a country permits neither seizure on importation nor prohibition of importation nor seizure inside the country, then, until such time as the legislation is modified accordingly (g), these measures shall be replaced by the actions and remedies available in such cases to nationals under the law of such country.

(a) Parts of this Article were already included in the original text of the Convention of 1883.¹ Additional paragraphs were introduced by the Additional Act, adopted by the Revision Conference of Brussels in 1900² and, with further modifications, by the Revision Conference of Washington in 1911.³ The Revision Conference of The Hague in 1925 adopted several further modifications.⁴

¹ *Actes de Paris*, I, pp. 27 (proposal for Article 6), 79/89, 91/7, 142/3 (discussions and adoption).

² *Actes de Bruxelles*, pp. 45/6 (proposal), 246/9, 255/6, 311/2 (discussions and adoption).

³ *Actes de Washington*, pp. 97 (proposal of France), 302/3 (report of Committee), 309 (report to Plenary Committee), 254/5 (discussion and adoption in Third Plenary Session).

⁴ *Actes de La Haye*, pp. 249/50 (proposal), 346 (observations), 469/70 (report of Fourth Sub-Committee), 525 (report of General Committee), 545/6 (report of Drafting Committee), 577 (adoption in Second Plenary Session).

(b) Although in some cases the Convention prescribes measures to be taken in the event of certain infringements of industrial property rights (see Articles *Squater*, *6bis*, *6septies*), it generally leaves the question of the *sanctions or remedies to be provided against infringements* to the domestic legislation of the member States. Attempts made to *prescribe* in the Convention certain sanctions in the case of *importation* of goods unlawfully bearing a *trademark* or a *trade name* protected in the country of importation have proved to be too ambitious. The present wording of the Article under examination, although in appearance very stringent in paragraphs (1), (2), (3) and (5), adds in reality little to the general rule embodied in Articles 2 and 3 of the Convention which ensures to persons entitled to the benefits of the Convention "*national treatment*" in all member States, including sanctions and remedies in the case of infringement of their industrial property rights.

This is the effect of the Article under consideration, because, after prescribing, in cases of violation of rights in a trademark or a trade name, *seizure on importation* of goods bearing such trademark or trade name, or *prohibition* of such importation, or *seizure inside the country*, it adds in paragraph (6) that countries which do not permit such measures may *replace them by the actions or remedies available in such cases to nationals under the law of such country*. Thus, the rule of national treatment will apply to sanctions and remedies with respect to infringement of rights in trademarks and trade names, and will be considered sufficient.

In these circumstances, the importance of the Article under consideration lies solely in the fact that it suggests a series of measures considered desirable in order to protect rights in trademarks and trade names, and that, *if national legislations adopt such measures*, the Article underlines their mandatory application in cases where the Convention applies.¹

The implementation of paragraph (1) of the Article is left entirely to the national legislation and administrative or legal procedures of the country concerned.

(c) Paragraph (2) of the Article indicates that, if the national legislations concerned so provide, seizure of goods unlawfully bearing a trademark or a trade name will be effected in the country where these signs are affixed on such goods as well as in the country of importation.

¹ *Actes de Washington*. pp. 302/3, 309. See also in France: Cour de Paris, 29/6/1962, *Ann.*, 1965, p. 201.

(d) The domestic legislation of the country concerned will determine at whose request seizure will take place. The words "a natural person or a legal entity" do not by themselves imply an obligation to admit requests by federations or associations of interested persons¹ (see, for this question, Article 10*ter*(2)).

(e) This provision is self-explanatory.

(f) This provision is also self-explanatory.

(g) The words "until such time as the legislation is modified accordingly" were added to this provision by the Revision Conference of The Hague in 1925. It was expressly understood that these words were to be interpreted as a *mere invitation* to member States to adopt legislation according to the preceding paragraphs of the Article under examination, but that this invitation would not create any obligation, not even a moral one.²

¹ *Actes de La Haye*, pp. 470, 545.

² *Ibidem*, pp. 470, 525, 545.

ARTICLE 10^(a)

(1) The provisions of the preceding Article shall apply (b) in cases of direct or indirect use (c) of a false indication of the source of the goods (d) or the identity of the producer, manufacturer, or merchant (e).

(2) Any producer, manufacturer, or merchant, whether a natural person or a legal entity, engaged in the production or manufacture of or trade in such goods and established either in the locality falsely indicated as the source, or in the region where such locality is situated, or in the country falsely indicated, or in the country where the false indication of source is used, shall in any case be deemed an interested party (f).

(a) The principal elements of this Article were already included in the original text of the Convention of 1883,¹ but then the provision applied only to goods which falsely bore, as an indication of source, the name of a specified locality and when such indication was joined to a trade name of a fictitious character or used with fraudulent intention. The second paragraph of the Article also had a more limited scope than it has now. The Revision Conferences of Brussels (1900),² Washington (1910),³ The Hague (1925),⁴ London (1934),⁵ and Lisbon (1958),⁶ all modified the Article on several points, but only the Lisbon Conference succeeded in giving it a much wider scope than it had before. It now applies to *all direct or indirect uses of a false indication of the source of goods*, irrespective of whether such indication is the name of a specified locality or country or is joined to a

¹ *Actes de Paris*, I, pp. 27 (proposal for Article 6), 91, 100/4, 144/5 (discussions and adoption).

² *Actes de Bruxelles*, pp. 46 (proposal), 100, 167 (observations), 249/50 (discussion and adoption).

³ *Actes de Washington*, pp. 97, 104 (proposals of France and U.K.), 302/3 (report of Committee), 310 (report to Plenary Committee), 254/5 (adoption in Third Plenary Session).

⁴ *Actes de La Haye*, pp. 250/2 (proposal), 347/8 (observations), 470/2 (report of Fourth Sub-Committee), 525 (report of General Committee), 546 (report of Drafting Committee), 577/8 (discussion and adoption in Second Plenary Session).

⁵ *Actes de Londres*, pp. 195/7 (proposal), 283/7 (observations), 411/7 (report of Fourth Sub-Committee), 468/9 (report of Drafting Committee), 517/9 (discussion and adoption in Second Plenary Session).

⁶ *Actes de Lisbonne*, pp. 776/9 (proposal), 779/84 (observations), 784/7 (discussion in Fourth Committee), 850/2 (report of Fourth Committee), 788 (discussion in General Committee), 104 (adoption in Second Plenary Session), 118 (General Report).

trade name of a fictitious character or used with fraudulent intention. The provision also extends to any direct or indirect use of a *false indication of the identity of the producer, manufacturer or merchant of goods* and is in this respect of the same kind as the provisions of Article 10bis concerning the repression of unfair competition.¹

(b) As has been observed above—see observation (b) on Article 9—application of the provisions of the preceding Article 9 means that also in the case of false indications of source or of the identity of the producer, etc., *the domestic legislation of the country where protection is sought will apply*, and if such legislation provides for seizure on importation of goods bearing such false indications, or other measures as indicated in Article 9, application of such measures will be mandatory in cases covered by the Article under consideration.

(c) *Direct* use of a false indication of source is made when such indication is made in so many words; *indirect* use of such indication is made, for example, when goods are delivered without any indication of source after false publicity has been made as to such source, or when the indication of source is made by a picture suggesting such source.

(d) Since the revision of the Article under examination by the Conference of Lisbon in 1958, it no longer applies *only* to the false indication, as the source of goods, *of the name of a specified locality or country*, that is, to a false indication of *geographical source*. The provision will therefore also apply in cases where the source of goods is falsely indicated otherwise than geographically, for example, as handicraft products (see also Article 10bis(3), subparagraph 3). However, the provision will probably continue to be applied mainly to *false indications of geographical source*, including *appellations of origin*. See, for these notions, observations (i) and (j) on Article 1, paragraph (2), above, and the Special Agreements of Madrid (1891) and Lisbon (1958) referred to in those observations.

One of the difficulties with indications of source and appellations of origin is that what is considered to be an indication of source or appellation of origin in one or more countries is sometimes considered in other countries to be a generic name, not limited to products of a certain source or origin.² It was explained at the Lisbon

¹ See BEIER: "Täuschende Reklame und Schutz der geographischen Herkunftsangaben," *G.R.U.R. Int.*, 1966, p. 197.

² Examples given at the Conference of Paris in 1880 were "*eau de Cologne*," "*cuir de Russie*" and "*velours d'Utrecht*"; cf. *Actes de Paris*, I, p. 88.

Conference¹ that legislation or judicial decisions in the country where protection is sought would have to solve the said difficulty.

(e) Since the revision of this provision at the Lisbon Conference in 1958, the provision is also applicable to cases of direct or indirect use of a false indication of the identity of the producer, manufacturer or merchant. As has been observed above—see observation (b)—this means that also in such cases the domestic legislation of the member States will apply, and if such legislation prescribes seizure on importation of goods bearing such false indications, or other measures as indicated in Article 9, application of the said measures will be mandatory in cases covered by the Article under consideration.

The domestic legislation of the member States will probably deal with the prohibition of false indications of the identity of the producer, manufacturer or merchant as particular cases of the repression of unfair competition. It may give special attention to cases of homonymous surnames.²

(f) Paragraph (2) of the Article under consideration relates to cases where a *locality*, a *region* or a *country* is falsely indicated as the source of goods, and therefore applies only to false *geographical* indications. The difficulty in these cases is that a geographical indication is generally not privately owned, so that, contrary to the situation which prevails regarding trademarks, trade names and false indications of identity, there is no owner or other person obviously competent to object to the use of false geographical indications. The provision under examination establishes such competence by recognizing as interested parties any producer, manufacturer or merchant engaged in the production or manufacture of or trade in the goods concerned and established *either* in the locality or country *falsely indicated* or in the region where such locality is situated, *or* in the country where the false indication of source is *used*. It is clear that the first category of such producers, etc., is directly interested because they may be harmed by the false indication of the locality, region or country where they are established; the second category of producers, etc., can be deemed to be indirectly interested because the use of a false indication of source in any country can be considered an act of unfair competition.

¹ *Actes de Lisbonne*, p. 778.

² *Ibidem*, p. 786.

It has been felt that producers, etc., of the latter category could probably intervene more rapidly.¹

The provision of paragraph (2) of this Article is so worded that it must, in countries which admit this possibility, be directly applied by the competent administrative and judicial authorities ; in other words, it is "self-executing."

¹ *Actes de Londres*, pp. 416/7 (proposal of Cuba), 468/9.

ARTICLE 10bis^(a)

(1) The countries of the Union are bound (b) to assure to nationals of such countries effective protection against unfair competition (c).

(2) Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition (d).

(3) The following in particular shall be prohibited (e) :

1. all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor (f) ;
2. false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor (g) ;
3. indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods (h).

(a) The original Convention of 1883 did not contain any specific provision concerning the repression of unfair competition. In view of the fact that such repression was not even enumerated amongst the subjects of industrial property concerning which "national treatment" must be granted to persons entitled to the benefits of the Convention, the Additional Act, adopted by the Revision Conference of Brussels in 1900, introduced the latter principle with respect to unfair competition in a newly inserted Article 10bis.¹ The Revision Conference of Washington in 1911 went a step further, in introducing into the said Article the obligation for all member States to assure to nationals of the Union effective protection against unfair competition.² This obligation was strengthened, and a definition and examples of acts of unfair competition were included in the Article by the Revision

¹ *Actes de Bruxelles*, pp. 164 (proposal of France), 187/8, 310; 382/3 (discussions and adoption).

² *Actes de Washington*, pp. 53 (proposal), 105, 224 (observations), 305 (report of Committee), 310 (report to Plenary Committee), 255 (discussion and adoption in Third Plenary Session).

Conference of The Hague in 1925.¹ The Revision Conference of London in 1934 improved these provisions,² and the Revision Conference of Lisbon in 1958 added a further example of acts of unfair competition (paragraph (3)3).³

(b) Paragraph (1) of the Article under consideration, on the one hand, and paragraphs (2) and (3), on the other hand, are of a different character.

Paragraph (1) merely contains an *obligation for the member States* by virtue of which they are bound to assure to nationals of the (other) countries of the Union—and those assimilated to them under Article 3—effective protection against unfair competition.

In most countries, it will hardly be possible to assure *effective* protection against unfair competition by means other than *legislation*, but it was admitted at several Revision Conferences⁴ that member States are not obliged to introduce *special* legislation to this effect if their existing general legislation—for example, provisions of civil law directed against torts, or principles of common law—suffices to assure effective protection against unfair competition.

On the other hand, paragraphs (2) and (3) of the Article under consideration contain, *in a directly applicable form*, a *definition* of what an act of unfair competition *is* and *examples* of such acts which *must, in particular, be prohibited*. These provisions are so worded that they must be considered “self-executing,” in countries which admit this possibility, and must therefore be directly applied by the judicial or administrative authorities of the country where protection against unfair competition is sought.⁵ Further observations on these subjects follow below.

¹ *Actes de La Haye*, pp. 252/5 (proposal), 348/51 (observations), 472/8 (report of Fourth Sub-Committee), 525 (report of General Committee), 546/7 (report of Drafting Committee), 578/81 (discussion and adoption in Second Plenary Session).

² *Actes de Londres*, pp. 197/8 (proposal), 287/90 (observations), 417/22 (report of Fourth Sub-Committee), 469/70 (report of Drafting Committee), 519 (adoption in Second Plenary Session).

³ *Actes de Lisbonne*, pp. 725, 784 (proposal of Austria), 725/6 (discussion in Third Committee), 789/90 (discussion in Fourth Committee), 852 (report of Fourth Committee), 726/7, 790 (discussion in General Committee), 106 (adoption in Second Plenary Session), 118 (General Report).

⁴ *Actes de Washington*, pp. 305, 255; *Actes de La Haye*, pp. 472, 578.

⁵ Cf. in Mexico: Juez Primero de Distrito en Materia Administrativa en el Distrito Federal, 28/8/1963, *Rev. Mex. P.I.*, 1963, p. 340, *G.R.U.R. Int.*, 1967, p. 29 (German translation).

(c) The various countries of the Union have different concepts of what is to be understood by “*unfair competition*.” Several acts are considered to be acts of unfair competition in one or more countries, but not—or only in special circumstances—in other countries.¹ In giving effective protection against unfair competition, each country may itself determine which acts come under this category, provided, however, that paragraphs (2) and (3) of the Article under consideration are complied with.

(d) The provision defines acts of unfair competition as *any act of competition contrary to honest practices in industrial or commercial matters*.

What is to be understood by “*competition*” will be determined in each country according to its own concepts: countries may extend the notion of acts of unfair competition to acts which are not competitive in a narrow sense, that is, within the same branch of industry or trade, but which unduly profit from a reputation established in another branch of industry or trade and thereby weaken such reputation.²

Any act of competition will have to be considered unfair if it is contrary to *honest practices in industrial or commercial matters*.³ This criterion is not limited to honest practices existing in the country where protection against unfair competition is sought. The judicial or administrative authorities of such country will therefore also have to take into account honest practices established in international trade.

If a judicial or administrative authority of the country where protection is sought finds that an act complained of is contrary to honest practices in industrial or commercial matters, it will be obliged to hold such act to be an act of unfair competition and to apply the sanctions and remedies provided by its national law. A wide variety of acts may correspond to the above criterion.⁴

¹ See, for example, ULMER c.s.: *Das Recht des unlauteren Wettbewerbs in den Mitgliedstaaten der Europäischen Wirtschaftsgemeinschaft*, 1965, and for other countries, *G.R.U.R. Int.*, 1959, p. 517 (U.S.A.); 1964, pp. 233 (Norway), 300 (Denmark), 358 (Finland) and 493 (U.K.).

² Cf. SAINT-GAL: “*Concurrence déloyale et concurrence parasitaire*,” *R.I.P.I.A.*, 1956, p. 19; and “*Unlauterer und parasitärer Wettbewerb*,” *G.R.U.R. Int.*, 1956, p. 202; 1957, pp. 7, 410; 1958, p. 399.

³ Cf. in Italy: Corte di Cassazione, 31/7/1957, *G.R.U.R. Int.*, 1958, p. 535 (No. 1837) (German abstract).

⁴ Cf. the literature cited in footnote 1, above, and, further, BIRPI’s *Model Law for Developing Countries on Marks, Trade Names, and Acts of Unfair Competition*, 1967, p.78. See also, for example, in Austria: Oberster Gerichtshof, 9/10/1957, *G.R.U.R. Int.*, 1959, p. 397.

(e) Paragraph (3) of the Article under consideration gives examples of acts which are particularly to be regarded as acts of unfair competition and must therefore be prohibited. This provision again contains *common legislation* for all countries of the Union¹ and must either be accepted as part of their domestic legislation or be directly applied by their judicial or administrative authorities. The enumeration of examples given of acts of unfair competition is not limitative and constitutes only a minimum.²

(f) The first example given of acts which must be regarded as acts of unfair competition relates to all acts of such a nature as to create *confusion* by any means whatever with the *establishment*, the *goods*, or the *industrial or commercial activities*, of a *competitor*. Such confusion can be created by the use of identical or similar trademarks or trade names and will then frequently be prohibited by special legislation concerning those subjects. If this is not the case, acts creating confusion by those means must be prohibited as acts of unfair competition. This is also true for other means by which similar confusion can be created, such as the form of packages, titles of publicity,³ references to the seat or other particulars of an enterprise,⁴ etc. It is immaterial whether those acts are committed in good faith, although good faith may have an influence on the sanctions to be applied.⁵

(g) The second example of acts which must be regarded as acts of unfair competition relates to *false allegations* in the *course of trade* of such a nature as to *discredit* the *establishment*, the *goods*, or the *industrial or commercial activities*, of a *competitor*. The mere fact of discrediting a competitor by untrue allegations which would discredit his business, goods or services, even without injurious intention on the part of the person making the allegations, is sufficient for the application of this provision.⁶ It has been left to the domestic legislation or case law of each country to decide whether, and under what circumstances, discrediting allegations which are not strictly *untrue* may also constitute acts of unfair competition.⁷

¹ *Actes de La Haye*, pp. 472, 475/7, 546/7.

² *Ibidem*, p. 547.

³ *Ibidem*, p. 476.

⁴ *Actes de Londres*, p. 198.

⁵ *Actes de La Haye*, pp. 476/7, 581.

⁶ *Ibidem*, p. 477.

⁷ *Actes de Londres*, p. 418.

(h) The third example of acts of unfair competition concerns *misleading allegations* but, this time, not particularly regarding the goods of a competitor—such allegations being generally covered by the preceding item 2—but concerning the *goods of the person who makes the allegations*. The provision under examination applies to all *indications or allegations* the use of which, *in the course of trade*, is liable to *mislead the public* as to the *nature*, the *manufacturing process*, the *characteristics*, the *suitability for their purpose*, or the *quantity*, of the goods concerned. It does not relate to similar indications or allegations as to the *origin or source* of the goods¹ or the *identity of the producer*, his *establishment* or his *industrial or commercial activities*. As to such acts, in so far as they are not covered by Article 10 of the Convention,² national legislations or case law will determine whether they are acts contrary to honest practices in industrial or commercial matters and for that reason must be deemed to be acts of unfair competition.

¹ *Actes de Lisbonne*, pp. 726, 790.

² *Ibidem*, p. 789.

ARTICLE 10^{ter}(^a)

(1) The countries of the Union undertake to assure to nationals of the other countries of the Union appropriate legal remedies effectively to repress all the acts referred to in Articles 9, 10, and 10^{bis}(^b).

(2) They undertake, further, to provide measures to permit federations and associations representing interested industrialists, producers, or merchants, provided that the existence of such federations and associations is not contrary to the laws of their countries, to take action in the courts or before the administrative authorities, with a view to the repression of the acts referred to in Articles 9, 10, and 10^{bis}, in so far as the law of the country in which protection is claimed allows such action by federations and associations of that country (^c).

(^a) This Article was introduced into the Convention by the Revision Conference of The Hague in 1925.¹ Its wording was slightly modified by the Revision Conference of London in 1934.²

(^b) Paragraph (1) of the Article contains an *obligation for the member States* to assure to nationals of the other countries of the Union—and those assimilated to such nationals by Article 3—appropriate *legal remedies* effectively to repress all the acts referred to in Articles 9, 10 and 10^{bis}. This can only be understood as an obligation for member States to introduce, complete or maintain *legislation* effectively repressing (*i*) the trade in goods unlawfully bearing a trademark or a trade name which is entitled to protection in the country concerned, (*ii*) the use of false indications of the source of goods or of the identity of the producer, manufacturer or merchant, and (*iii*) acts of unfair competition. The last obligation (under (*iii*)) is also expressed in Article 10^{bis}(1), to which provision the paragraph under consideration only adds that *appropriate legal remedies* must be provided. With respect to the first two obligations (under (*i*) and (*ii*)), the paragraph under consideration reinforces Article 9(6), which is

¹ *Actes de La Haye*, pp. 252/5 (proposal concerning Article 10^{bis}), 349/51 (observations), 478/80 (report of Fourth Sub-Committee), 525/6 (report of General Committee), 547 (report of Drafting Committee), 581 (discussion and adoption in Second Plenary Session).

² *Actes de Londres*, pp. 422 (proposal of U.K. and report of Fourth Sub-Committee), 470 (report of Drafting Committee), 519 (adoption in Second Plenary Session).

applicable also to Article 10, because it specifies that the actions and remedies available in these cases must be *effective*.

At the Revision Conference of The Hague it was understood that national legislation, in providing for effective repression of the acts referred to, may make a difference between provisions allowing claims for damages and those providing for injunctions against the incriminated acts. Whereas it would be possible not to grant damages with respect to acts committed in good faith, the same would not apply to injunctions.¹

(c) Paragraph (2) of the Article under consideration again contains an "*undertaking*" by the member States. Although this word is also used in Articles 6bis, 6sexies and 7bis of the Convention, the context in which it is used here is different. According to the Articles referred to in the previous sentence, the member States undertake to refuse, cancel, protect, or accept certain things, which may be interpreted in countries which admit such a possibility as imposing direct obligations upon the administrative or judicial authorities of such countries. According to the paragraph under consideration, however, the member States undertake to provide measures to permit, etc., which can only be understood as referring to legislation.

The object of such legislation must be to permit *federations and associations*, representing *interested industrialists, producers or merchants*, to take action when acts referred to in Articles 9, 10 and 10bis are committed. Two provisos are attached to the admission of such competence on the part of federations and associations: first, their existence must not be contrary to the laws of their countries (cf. observation (e) on Article 7bis,² and, secondly, their action may be permitted only to the extent to which the law of the country in which protection is sought allows such action by federations and associations of that country.

¹ *Actes de La Haye*, p. 581.

² Cf. in Italy: Tribunale di Milano, 11/1/1964, *G.R.U.R. Int.*, 1965, p. 253 (German translation).

ARTICLE 11^(a)

(1) The countries of the Union shall, in conformity with their domestic legislation (b), grant temporary protection (c) to patentable inventions, utility models, industrial designs, and trademarks (d), in respect of goods exhibited at official or officially recognized international exhibitions (e) held in the territory of any of them (f).

(2) Such temporary protection shall not extend the periods provided by Article 4. If, later, the right of priority is invoked, the authorities of any country may provide that the period shall start from the date of introduction of the goods into the exhibition (g).

(3) Each country may require, as proof of the identity of the article exhibited and of the date of its introduction, such documentary evidence as it considers necessary (h).

(a) Since lack or inadequacy of protection of industrial property at international exhibitions was one of the reasons which promoted the conclusion of the Convention,¹ it is natural that the principle of such protection should already have been included in the original text of the Convention of 1883.² It was then the intention to oblige the member States to take the necessary legislative measures to that effect but to leave them free in determining the ways and means of achieving this end.³ These principles were confirmed at the Revision Conference of Brussels in 1900,⁴ where the words "in conformity with the domestic law of each country" were introduced into the Article by the Additional Protocol adopted at that Conference. At the Revision Conference of The Hague in 1925 ambitious proposals were made to insert a much more detailed regulation of the subject in the Article, but it only proved possible to add the provisions of paragraphs (2) and (3).⁵

(b) The Article under consideration still contains only an *obligation for the member States to establish and maintain legislation* in order

¹ Cf. LADAS: *The International Protection of Industrial Property*, pp. 73 et seq., 347/8.

² *Actes de Paris*, I, pp. 27 (proposal for Article 9), 104/8 (discussion), 145 (adoption); II, pp. 22, 31, 33/4 (discussion).

³ *Ibidem*, I, pp. 105/7.

⁴ *Actes de Bruxelles*, pp. 47/8 (proposal), 185/6 (discussion), 312 (adoption).

⁵ *Actes de La Haye*, pp. 255/62 (proposal), 351/2 (observations), 436/7 (report of Second Sub-Committee), 526 (report of General Committee), 547 (report of Drafting Committee), 581 (adoption in Second Plenary Session).

temporarily to protect the enumerated subjects of industrial property in respect of goods exhibited at certain exhibitions. It leaves the domestic legislation of a member State free to choose the means for offering such protection.

(c) *Temporary protection*, by domestic legislation, of the enumerated subjects of industrial property may be provided by various means. Such legislation may, for example, grant a *right of priority*, more or less similar to that recognized in Article 4 of the Convention, to applications for protection of exhibited subjects. Such right will apply during a certain period from the day on which the subject concerned was introduced at the exhibition. Such protection by a right of priority is temporary because it will expire if, or in so far as, the right is not exercised within the prescribed period. It is also possible, for example, in the case of exhibited patentable inventions, to make provision for temporary protection by other means, namely, by prescribing that, during a certain period, such exhibition will not *destroy the novelty of the invention* and that the person who exhibits the invention will also be protected against *usurpation* of his invention by *third parties*. Still another possibility of protection consists in the recognition of a right of prior use in favor of the exhibitor as against possible rights acquired by third parties.

(d) The subjects of industrial property which, according to the provision under consideration, are to be protected are *patentable inventions, utility models, industrial designs and trademarks*. The provision is silent on other subjects of industrial property, such as service marks and trade names. There is therefore no *obligation* for member States to grant temporary protection to these subjects also, but they are free to do so if they wish.

(e) The provision under examination applies only to temporary protection of inventions, etc., in respect of goods exhibited at *official or officially recognized exhibitions*.¹ The question whether this condition is fulfilled will be determined by the administrative or judicial

¹ A definition of an "official or officially recognized exhibition" is given in the Convention concerning International Exhibitions, signed in Paris on November 22, 1928. This definition, however, cannot be applied to the Article under consideration because the purpose of this Article, on the one hand, and that of the Convention referred to, on the other hand, are quite different.

authorities of the country where temporary protection is sought. As will be observed under (f), below, this is not necessarily the same country as that in which the exhibition is held.

The authorities referred to above will probably deem an exhibition to be *official* if it is *organized* by a State or other public authority, and will consider it *officially recognized* if it has been *recognized* as such by a State or other public authority. Moreover, the exhibition has to be *international*, which means that it must include the exhibition of goods coming from foreign countries.

Since these definitions leave a certain amount of uncertainty, some member States notify the International Bureau of the exhibitions in respect of which they desire the provision to be applied, after which the Bureau publishes these notifications. Other countries advertise their official or officially recognized international exhibitions in an official Gazette. Such notifications and publications, although not binding upon the authorities of a country where protection according to the provision is sought, provide a basis for their decisions.

Member States are, of course, free to grant in their domestic legislation temporary protection with respect also to exhibitions other than those envisaged in the provision under consideration.

(f) In their domestic legislation the member States must not only grant temporary protection with respect to international exhibitions *in their own territory* but must extend such protection to *all exhibitions, as defined, held in the territory of any other member State*. This means that the temporary protection provided by such legislation may be claimed by persons entitled to the benefits of the Convention, not only with regard to goods exhibited, under the conditions prescribed, in the country itself but also regarding goods exhibited, under the conditions prescribed, in other countries of the Union.

(g) Paragraph (2) of the Article under consideration deals with the relationship between the temporary protection to be granted according to this Article and the *right of priority granted by Article 4 of the Convention*. Particularly if the temporary protection envisaged is given in the form of another right of priority—see observation (c) above—the question arises whether such right and the right of priority granted by Article 4 of the Convention may be cumulated. Such cumulation would mean, for example, that an interested party could first, within the period of priority starting from the date of exhibition, file an application for protection of the subject concerned with priority in one country of the Union and then, on the basis of this first applica-

tion, apply, within a new period of priority granted under Article 4, for protection in the other countries, with *priority as from the exhibition*.

The first sentence of the provision now being considered implies that such cumulation of priorities cannot be claimed, in that it states that the periods of priority provided by Article 4 shall not be extended. However, the second sentence of this provision leaves a certain amount of freedom¹ to the authorities of the country where protection and priority are claimed. If the exhibition of a subject precedes a first application for protection of such subject, the period of priority under Article 4 *may, without being extended*, be counted as *starting* from the date of introduction of the goods into the exhibition.

(h) In order to apply its domestic legislation regarding temporary protection of certain subjects exhibited at international exhibitions as described, each country may require proof, both as to the *identity of the article exhibited* and as to the *date of its introduction at the exhibition*,² in whatever form of documentary evidence it considers necessary. Such documentary evidence may, for example, consist of a certificate relating to both of the points referred to above and issued by the competent authorities of the exhibition concerned or of the country where it was held.

¹ *Actes de La Haye*, p. 526.

² *Ibidem*, p. 437.

ARTICLE 12^(a)

(1) Each country of the Union undertakes to establish a special industrial property service and a central office (b) for the communication to the public of patents, utility models, industrial designs, and trademarks (c).

(2) This service shall publish an official periodical journal (d). It shall publish regularly :

- (a) the names of the proprietors of patents granted, with a brief designation of the inventions patented ;
- (b) the reproductions of registered trademarks (e).

(a) The first paragraph of this Article was already included in essence in the original text of the Convention of 1883.¹ The Final Protocol, which formed an integral part of that Convention, made an addition to this, under paragraph 5, to the effect that the activities of the special industrial property service would include, as far as possible, the publication, in each member State, of an official periodical journal.² The Revision Conference of Washington in 1911 added utility models to the subjects to be communicated to the public and transferred the provision from the Protocol to the Convention itself.³ The Revision Conference of The Hague in 1925 rendered the publication of an official periodical journal mandatory,⁴ and the Revision Conference of London in 1934 specified the subjects which are to be published regularly.⁵

(b) As the protection of industrial property, and particularly its international protection, can obviously not operate without *national administrations* which register the rights concerned and *communicate these rights to the public*, the Convention obliges each member State to establish such administration *in a central office*. As is shown by

¹ *Actes de Paris*, 1, pp. 27/8 (proposal), 108, 145 (adoption).

² *Ibidem*, pp. 151/2.

³ *Actes de Washington*, pp. 55 (proposal), 97, 224 (observations), 310 (report to Plenary Committee), 255 (adoption in Third Plenary Session).

⁴ *Actes de La Haye*, p. 263 (proposal), 353 (observation), 415/6 (report of First Sub-Committee), 526 (report of General Committee), 547/8 (report of Drafting Committee), 581 (adoption in Second Plenary Session).

⁵ *Actes de Londres*, pp. 198/9 (proposal), 344/5 (report of First Sub-Committee), 470/1 (report of Drafting Committee), 519 (adoption in Second Plenary Session).

Article 13(3)(b) of the Convention, member States may also conclude special agreements establishing a *common* office possessing for each of them the character of a special national service of industrial property. An example of such common office is the *African and Malagasy Industrial Property Office*, established at Yaoundé (Cameroon) by virtue of an Agreement between the participating States, dated September 13, 1962.

(c) The administration envisaged by the Article under consideration must be established for the *communication to the public* of *patents, utility models, industrial designs and trademarks*. No mention is made of other subjects of industrial property so that member States are free to decide whether, and how, those subjects should also be communicated to the public.

(d) The publication of an *official periodical journal* by each national administration, made mandatory by the Revision Conference of The Hague in 1925, provides the most practical way of communicating to the public the granting of industrial property rights.

(e) Each national administration must, in particular, publish regularly the *essential data* concerning the most important subjects of industrial property, namely, *patents and trademarks*. These data are the names of proprietors of patents granted, with a brief designation of the inventions patented, and reproductions of registered trademarks. It must also publish data concerning any right of priority claimed (cf. Article 4 D(2) and (5)).

The administrations may, and usually do, publish many more data, such as *dates of grant or registration, dates of applications, analogous data with respect to utility models, industrial designs, service marks, and application of Article 6ter* of the Convention (cf. Article 6ter (3)(a)), etc.

ARTICLE 13^(a)

(1)(a) The Union shall have an Assembly (*b*) consisting of those countries of the Union which are bound by Articles 13 to 17(*c*).

(h) The Government of each country shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.

(c) The expenses of each delegation shall be borne by the Government which has appointed it.

(2)(a) The Assembly shall :

- (i) deal with all matters concerning the maintenance and development of the Union and the implementation of this Convention (*d*) ;
- (ii) give directions concerning the preparation for conferences of revision (*e*) to the International Bureau of Intellectual Property (hereinafter designated as "the International Bureau" referred to in the Convention establishing the World Intellectual Property Organization (hereinafter designated as "the Organization" (*f*)), due account being taken of any comments made by those countries of the Union which are not bound by Articles 13 to 17 (*g*) ;
- (iii) review and approve the reports and activities of the Director General of the Organization concerning the Union, and give him all necessary instructions concerning matters within the competence of the Union (*h*) ;
- (iv) elect the members of the Executive Committee of the Assembly ;
- (v) review and approve the reports and activities of its Executive Committee, and give instructions to such Committee ;
- (vi) determine the program and adopt the triennial budget of the Union, and approve its final accounts (*i*) ;
- (vii) adopt the financial regulations of the Union (*j*) ;
- (viii) establish such committees of experts and working groups as it deems appropriate to achieve the objectives of the Union ;
- (ix) determine which countries not members of the Union and which intergovernmental and international non-governmental organizations shall be admitted to its meetings as observers ;
- (x) adopt amendments to Articles 13 to 17 (*k*) ;

- (xi) take any other appropriate action designed to further the objectives of the Union ;
- (xii) perform such other functions as are appropriate under this Convention (*l*) ;
- (xiii) subject to its acceptance, exercise such rights as are given to it in the Convention establishing the Organization (*m*).

(b) With respect to matters which are of interest also to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization (*n*).

(3)(a) Subject to the provisions of subparagraph (b), a delegate may represent one country only.

(b) Countries of the Union grouped under the terms of a special agreement in a common office possessing for each of them the character of a special national service of industrial property as referred to in Article 12 may be jointly represented during discussions by one of their number (*o*).

(4)(a) Each country member of the Assembly shall have one vote.

(b) One-half of the countries members of the Assembly shall constitute a quorum.

(c) Notwithstanding the provisions of subparagraph (b), if, in any session, the number of countries represented is less than one-half but equal to or more than one-third of the countries members of the Assembly, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the countries members of the Assembly which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiration of this period, the number of countries having thus expressed their vote or abstention attains the number of countries which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains (*p*).

(d) Subject to the provisions of Article 17(2), the decisions of the Assembly shall require two-thirds of the votes cast.

(e) Abstentions shall not be considered as votes.

(5)(a) Subject to the provisions of subparagraph (b), a delegate may vote in the name of one country only.

(b) The countries of the Union referred to in paragraph (3)(b) shall, as a general rule, endeavor to send their own delegations to the sessions of the Assembly. If, however, for exceptional reasons, any such country cannot send its own delegation, it may give to the delegation of another such country the power to vote in its name, provided that each delegation may vote by proxy for one country only. Such power to vote shall be granted in a document signed by the Head of State or the competent Minister (*q*).

(6) Countries of the Union not members of the Assembly shall be admitted to the meetings of the latter as observers.

(7)(a) The Assembly shall meet once in every third calendar year in ordinary session upon convocation by the Director General and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization (*r*).

(b) The Assembly shall meet in extraordinary session upon convocation by the Director General, at the request of the Executive Committee or at the request of one-fourth of the countries members of the Assembly.

(8) The Assembly shall adopt its own rules of procedure.

(a) As has been observed above in Chapter II.1, Article 13 and the following Articles are among those Articles of the Convention which contain provisions of international public law regulating rights and obligations of the member States and establishing the organs of the Union created by the Convention, as well as provisions of an administrative character. Although parts of these Articles and even some of them in their entirety existed already in former texts of the Convention,¹ this latter part of the Convention was entirely rearranged at the Revision Conference of Stockholm in 1967, while many important new provisions were added on the same occasion.

This part of the Convention, which can be considered of an administrative character in a very broad sense, differs from the preceding part in other respects as well. In the first place, the latter

¹ See, for a comparison between the Lisbon text of the Convention and the proposals for the Stockholm Conference, proposals which were to a large extent accepted: document S/3 prepared for the Stockholm Conference, pp. 14/6.

part of the Convention contains very detailed rules and therefore necessitates fewer comments; many of its provisions are self-explanatory. Secondly, the administrative part of the Convention cannot be fully understood without considering at the same time another Convention, concluded simultaneously with the revision of the Paris Convention at Stockholm in 1967, namely, the Convention of July 14, 1967, establishing the *World Intellectual Property Organization*.¹

This new Convention and the Paris Convention are to a large extent independent of each other, and States may—with one important exception: see Article 14(2) of the WIPO Convention—accede to or withdraw from one of these Conventions without acceding to or withdrawing from the other. Nevertheless, both Conventions refer to each other on several points and are destined to complete each other. It is therefore necessary to explain briefly the *objectives and structure of the World Intellectual Property Organization* before commenting upon the administrative provisions of the Paris Convention.²

The objectives of the World Intellectual Property Organization are (see Articles 3 and 2 of the WIPO Convention):

(i) to promote the protection of *intellectual property* throughout the world through cooperation among States and, where appropriate, in collaboration with any other international organization (*intellectual property* includes *industrial property* as defined in Article 1 of the *Paris Convention* as well as copyright and related subjects);

(ii) to ensure administrative cooperation *among the Unions* (these Unions being *the Union established by the Paris Convention*, the Unions and Agreements established in relation with that Union (cf. Article 19 of the Paris Convention), the Berne Union, established by the Convention of September 9, 1886, for the Protection of Literary and Artistic Works, and any other international agreement designed to promote the protection of intellectual property and administered by WIPO).

Membership in WIPO is open to any State which is a *member of any of those Unions*, and also to any State not a member of any of those Unions, provided that:

(i) it is a member of the United Nations, any of the Specialized Agencies brought into relationship with the United Nations, or the

¹ Hereinafter frequently referred to as "WIPO." See the text of this Convention in *I.P.*, 1967, p. 155.

² Cf. KRIEGER and ROGGE: "Die neue Verwaltungsstruktur der Pariser und Berner Union und die neue Weltorganisation für geistiges Eigentum," *G.R.U.R. Int.*, 1967, pp. 462 *et seq.*

International Atomic Energy Agency, or is a party to the Statute of the International Court of Justice, or

(ii) it is invited by the General Assembly of WIPO to become a party to the Convention establishing that Organization.

WIPO has several organs : in the first place, a *General Assembly* consisting of the States party to the WIPO Convention *which are also members of any of the Unions*, for example, the *Paris Union*, and, furthermore, a *Conference* consisting of all States party to the WIPO Convention *whether or not they are members of any of the Unions*.

The *General Assembly* is the supreme organ of the Organization, the *Conference* having a more limited task, confined principally to discussing matters of general interest in the field of intellectual property, in view of which it may adopt recommendations, having regard to the competence and autonomy of the Unions, and to establishing a program of legal-technical assistance in the field of intellectual property to States or organizations.

WIPO also has a *Coordination Committee* consisting of the States party to the WIPO Convention which are members of the *Executive Committee of the Paris Union* (see, below, Article 14 of the Paris Convention), or of the Executive Committee of the Berne Union, or both. One of the tasks of the Coordination Committee is to give advice to the *organs of the Unions*, the General Assembly, the Conference, etc., on all administrative, financial and other matters of *common interest either to two or more of the Unions, or to one or more of the Unions and the Organization*, and in particular on the budget of *expenses common to the Unions* (see, below, observation (d) on Article 16).

In order to attain its objectives, WIPO will have to fulfil several functions, for example, the promotion of measures designed to *facilitate the efficient protection of intellectual property throughout the world* and to *harmonize national legislation in this field*, and the *performance of the administrative tasks of the Paris Union and other Unions*. To this end the Organization will have a *Secretariat* which is called the *International Bureau of Intellectual Property* and which is a continuation of the United Bureaux of the Paris and Berne Unions, known under the name of BIRPI. The International Bureau will be directed by a Director General.

WIPO will have *two separate budgets* : the budget of expenses *common to the Unions*, and the budget of the *Conference*. The *budget of expenses common to the Unions* will include provision for expenses of interest to several Unions ; it will be financed, inter alia, from *contributions of the Unions* which will be fixed by the *Assembly of*

each Union, having regard to the interest the Union has in the common expenses. The *budget of the Conference* will include provision for the expenses of the Conference and for the cost of the legal-technical assistance program; it will be financed, inter alia, from contributions of Member States of WIPO who are not members of any Union and from sums made available to that budget *by the Unions*, according to autonomous decisions taken by the *Assembly of each Union*.

Under transitional provisions in the WIPO Convention it is provided that, until the first Director General of the Organization assumes office, references made in that Convention to the International Bureau or to its Director General shall be deemed to be references to BIRPI, or its Director, respectively.

It will be clear from the foregoing observations that the Paris Convention and the WIPO Convention are, in several respects, inter-related. Further references to this relationship will be made in the following comments on the administrative provisions of the Paris Convention.

(b) Until the Revision Conference of Lisbon in 1958 the Paris Convention had no organ in which the member States were represented, except in the form of the Revision Conferences (Article 14(1),(2), (3) and (4) of the Act of Washington (1911), already partly in existence in earlier texts and unchanged by the Revision Conferences of The Hague (1925), London (1934) and Lisbon (1958)). Such Revision Conferences were comparatively rare and were held at irregular intervals. The Revision Conference of Lisbon provided in Article 14(5) that, during the interval between Revision Conferences, *Conferences of Representatives of all the countries of the Union* would meet every three years, or more frequently. Only limited powers, however, were given to these Conferences of Representatives, as they could only (i) "draw up a report on the foreseeable expenditure of the International Bureau for each three-year period to come," (ii) "consider questions relating to the protection and development of the Union," and (iii) modify, by unanimous decision and on condition that they meet as Conferences of Plenipotentiaries, the maximum annual amount of the expenditure of the International Bureau. Apart from this latter point, no powers of decision were given to the Conference of Representatives, because control of the organization, operation and expenditure of the International Bureau was entrusted to the Government of the Swiss Confederation (Article 13(1) and (10) of the Lisbon Act of the Convention, provisions which had already been substantially included in all earlier Acts).

The Revision Conference of Stockholm in 1967 entirely changed this system by establishing an *Assembly* of the Union as its supreme organ in which are vested all policy-making and controlling powers (see Articles 13(2), 14(2)(a), 16(6), 17(1) and (2)).¹

(c) As the Revision Conference of Stockholm dealt with two entirely different subjects, namely, on the one hand, the introduction into the Convention of provisions (Article 4 I(1) and (2)) concerning the right of priority with respect to inventors' certificates and, on the other hand, a thorough revision of the administrative provisions of the Convention, it decided to give the member States the opportunity to accept only one of these parts of the revision, or one of these parts earlier than the other. This was done because the acceptance of each of these parts in any member State could depend on different considerations and might require different legal procedures. In view of this fact, Article 20(1) of the Stockholm Act specifies that any country which is already a member of the Union may, when ratifying the Stockholm Act or acceding to it, declare in the relevant diplomatic instrument that its ratification or accession will *not* apply :

(i) to Articles 1 to 12 (including the newly introduced Article 4 I(1) and (2)), or

(ii) to Articles 13 to 17 (containing the revised administrative system).

Only member States which have *not* excluded *Articles 13 to 17* from their acceptance of the Stockholm Act and which therefore are *bound* by the revised administrative provisions will be *members of the newly created Assembly*. The other member States of the Union which are *not* (yet) bound by the revised administrative provisions will be admitted to the meetings of the Assembly as observers (Article 13(6)), whereas States not members of the Union *may* only be admitted as observers (Article 13(2)(a)(ix)) . However, a transitional provision (Article 30(2)) attenuates this system by allowing member States of the Union, not (yet) bound by the administrative provisions of Articles 13 to 17 of the Stockholm Act, to exercise, if they so desire and until five years after the entry into force of the WIPO Convention, the rights provided under the said Articles 13 to 17 as if they were bound by those Articles, which means, *inter alia*, that under those conditions and during that period they are deemed to be members of the Assembly.

¹ Cf. also Report of Main Committee IV of the Stockholm Conference, *I.P.*, 1967, p. 220, paragraph 7.

It should be observed that, according to Article 21, States *which have not yet been members of the Union until they accede to the Stockholm Act* may not exclude any part of that Act from their accession. Those States will therefore, upon accession, always be bound by the revised administrative provisions and automatically become members of the Assembly.

(d) This provision vests all policy-making powers concerning the Union in the Assembly. The reference to "implementation" of the Convention is not intended to refer to its application by the legislature, government, or courts of a member State, because the Assembly cannot have any jurisdiction on these subjects with regard to sovereign States, but rather to its implementation by the Secretariat and other organs of the Union.¹

(e) One of the aims of the Paris Convention is continuously to improve its system of international protection of industrial property by submitting the Convention, from time to time, to revision (see Article 18). Since the Revision Conference of Washington in 1911, and until the Stockholm Conference of 1967, the preparation of such revision conferences was entrusted to the Administration of the country in which the Conference was to be held, with the assistance of the International Bureau (paragraph (3) of Article 14 of the texts of Washington, The Hague, London and Lisbon). This system placed a heavy burden on the Administration of the host country of a revision conference and did not give all member States an equal influence on the preparation of a revision conference. Moreover, it made agreement between the member States at a revision conference difficult to achieve as the program of revision was submitted to member States only for written comments and was not further discussed before the opening of the Conference.²

The Revision Conference of Stockholm in 1967 changed this system and entrusted the *Assembly of the Union* with the task of giving *directions* concerning the preparation for conferences of revision *to the Secretariat*. Thus, the preparations for conferences of revision will be directed collectively by the member States. Cooperation between the Secretariat and the Executive Committee (Article 15(7)(a)) and committees of experts or working groups of delegates of member

¹ Cf. document S/3 prepared for the Stockholm Conference, p. 20, paragraph 56.

² Cf. document S/3 prepared for the Stockholm Conference, pp. 10/11, paragraph 28, p. 20, paragraph 57.

States and interested international organizations may further contribute to the adequate preparation of conferences of revision (see Article 13(2)(a)(viii) and Article 15(7)(a) and (b)).

(f) The original text of the Paris Convention of 1883 had already established an international office under the name of International Bureau of the Union for the Protection of Industrial Property, which was entrusted with administrative tasks concerning the Union (Article 13 of the Paris Convention and Article 6 of its Final Protocol). This Bureau was later united with the corresponding Bureau of the Union for the Protection of Literary and Artistic Works and these united Bureaux were known under the common designation of BIRPI.

The Revision Conference of Stockholm in 1967 replaced the said organ by a newly created *International Bureau of Intellectual Property*, which will be the Secretariat of WIPO. As has been observed already, this International Bureau will be a continuation of BIRPI (Article 15(1)(a)). See also the transitional provisions of Article 30(1), (3) and (4).

(g) Since revisions of the Convention concern *all* its member States, and not only those which, having accepted the new administrative provisions, are bound by Articles 13 to 17, it is prescribed that in the preparation of revision conferences *due account must be taken* of any *comments made by member States which are not (yet) bound* by these Articles.

It has been observed already that the International Bureau, in making preparations for revision conferences will cooperate with the Executive Committee and may also consult with intergovernmental and international non-governmental organizations (Article 15(7)(b)). This will no doubt happen frequently since past experience has shown that collaboration with international organizations, especially of private interested circles, may have considerable influence on the development of the international protection of industrial property.

(h) This provision entrusts the Assembly with control over the Secretariat as far as its activities relate to the Paris Union.

(i) According to this provision, the Assembly has the power to determine and control the program, budget and final accounts of the Union. Since the Assembly will normally meet only once in every third calendar year (Article 13(7)(a)), the budget to be approved by it will be triennial. Within the limits of the program and this triennial budget, yearly budgets and programs will be prepared by the Secretariat and

approved by the Executive Committee, and the latter will also report on the yearly accounts (Article 14(6)(iii) and (iv)). This Committee will be controlled by the Assembly, by virtue of Article 13(2)(a)(v).

(j) Financial regulations adopted by the Assembly may contain details regarding the budget, reports and accounts, and all other matters concerning the financial administration of the Union.

(k) Prior to the Revision Conference of Stockholm, only *revision conferences* could modify the provisions of the Convention and, according to established practice, only by *unanimous vote* of the member States participating in such conference (see, below, ad Article 18). This system was considered too cumbersome for the revision of *administrative provisions* which would not affect private interests and only to a limited extent the interests of the member States.¹ In view of this, the Revision Conference of Stockholm introduced a distinction between, on the one hand, *revisions* of the Convention with respect to provisions of substantive law and regarding acceptance or denunciation of the Convention by States, its entry into force, disputes between States, etc., and, on the other hand, *amendments* of the *administrative provisions of Articles 13 to 17*. *Revisions* continue to be within the exclusive competence of *revision conferences* specially convened to that effect (Article 18), whereas *amendments* may be adopted by a simplified procedure for which competence is given to the *Assembly* (Article 17).

(l) This provision indicates that the Assembly may also exercise functions other than those expressly referred to in the preceding subparagraphs. For example, according to Article 14(5)(c) the Assembly will establish the details of the rules governing the election and possible re-election of the members of the Executive Committee.

(m) As has already been mentioned above under observation (b), the Revision Conference of Stockholm envisaged a close relationship between the Paris Convention and the WIPO Convention, both of which Conventions are destined to complement each other. One of the aspects of this relationship is that *in the WIPO Convention* certain rights have been given to *the Assembly of the Paris Union* (see, for example, Article 6(3)(g), Article 11(2)(b)(i), (3)(b)(ii) and (8)(b), and

¹ See document S/3 prepared for the Stockholm Conference, p. 40, paragraph 119.

Article 17(2), of the WIPO Convention). The provision under consideration refers to these regulations.

(n) Several matters to be dealt with by organs of the Paris Union will be of interest also to other Unions, since the Secretariat, headquarters and items of expenditure will be common (see, below, Article 16). In those cases, the Assembly will make its decisions after having taken the advice of the *Coordination Committee*, which has been referred to above as one of the organs of WIPO. After this advice is taken, the decision remains with the Assembly, as the sovereign organ of the Union.

(o) This provision takes into account the special situation of member States which have concluded an agreement by virtue of which a *common office* replaces the *national offices* or services of industrial property, as referred to in Article 12. An example of such common office exists in the *African and Malagasy Industrial Property Office*, established at Yaoundé (Cameroon) by virtue of an Agreement between the participating States, dated September 13, 1962 (see, above, observation (b) on Article 12).

States party to such agreement may, in derogation of the general rule that a delegate may represent only one State (Article 13(1)(b) and (3)(a)), be jointly represented, during *discussions* in the *Assembly*, by one and the same delegate. With respect to *voting*, however, a stricter rule is given in Article 13(5)(b) (see observation (q) below).

(p) Although one-half of the countries members of the Assembly (and which have voting powers according to Article 13(5)(a) and (b)) will constitute the quorum necessary for making decisions, special rules are given for reaching decisions in cases where this quorum is not attained. These rules, although complicated, seem nevertheless self-explanatory. If necessary, they will be further elaborated in the rules of procedure which the Assembly will establish according to Article 13(8).¹

(q) This provision contains a special rule for *voting* by member States grouped under a special agreement in a *common office* possessing for each of them the character of a national office or service of industrial property, a situation which was referred to above

¹ Cf. Report of Main Committee IV of the Stockholm Conference, *I.P.*, 1967, p. 220, paragraph 9.

under observation (*o*). Each delegation of such State may vote by proxy for *one* other such State. This system was adopted as a compromise in view, on the one hand, of the generally accepted practice that each delegation to an Assembly may vote only for its own country and, on the other hand, of the difficulty for member States which do not have national offices of industrial property, but only a common office, to be always adequately represented at the meetings of the Assembly.

(*r*) This provision again derives from the intention that the administrative operations of the Paris Union and of WIPO will complement each other.

ARTICLE 14^(a)

(1) The Assembly shall have an Executive Committee (b).

(2)(a) The Executive Committee shall consist of countries elected by the Assembly from among countries members of the Assembly (c). Furthermore, the country on whose territory the Organization has its headquarters shall, subject to the provisions of Article 16(7)(b), have an ex officio seat on the Committee (d).

(b) The Government of each country member of the Executive Committee shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.

(c) The expenses of each delegation shall be borne by the Government which has appointed it.

(3) The number of countries members of the Executive Committee shall correspond to one-fourth of the number of countries members of the Assembly. In establishing the number of seats to be filled, remainders after division by four shall be disregarded.

(4) In electing the members of the Executive Committee, the Assembly shall have due regard to an equitable geographical distribution and to the need for countries party to the Special Agreements established in relation with the Union to be among the countries constituting the Executive Committee (e).

(5)(a) Each member of the Executive Committee shall serve from the close of the session of the Assembly which elected it to the close of the next ordinary session of the Assembly.

(b) Members of the Executive Committee may be re-elected but only up to a maximum of two-thirds of such members (f).

(c) The Assembly shall establish the details of the rules governing the election and possible re-election of the members of the Executive Committee (g).

(6)(a) The Executive Committee shall (h) :

- (i) prepare the draft agenda of the Assembly ;
- (ii) submit proposals to the Assembly in respect of the draft program and triennial budget of the Union prepared by the Director General ;

- (iii) approve, within the limits of the program and the triennial budget, the specific yearly budgets and programs prepared by the Director General ;
- (iv) submit, with appropriate comments, to the Assembly, the periodical reports of the Director General and the yearly audit reports on the accounts ;
- (v) take all necessary measures to ensure the execution of the program of the Union by the Director General, in accordance with the decisions of the Assembly and having regard to circumstances arising between two ordinary sessions of the Assembly ;
- (vi) perform such other functions as are allocated to it under this Convention (*i*).

(b) With respect to matters which are of interest also to other Unions administered by the Organization, the Executive Committee shall make its decisions after having heard the advice of the Coordination Committee of the Organization (*j*).

(7)(a) The Executive Committee shall meet once a year in ordinary session upon convocation by the Director General, preferably during the same period and at the same place as the Coordination Committee of the Organization (*k*).

(b) The Executive Committee shall meet in extraordinary session upon convocation by the Director General, either on his own initiative, or at the request of its Chairman or one-fourth of its members.

(8)(a) Each country member of the Executive Committee shall have one vote.

(b) One-half of the members of the Executive Committee shall constitute a quorum (*l*).

(c) Decisions shall be made by a simple majority of the votes cast.

(d) Abstentions shall not be considered as votes.

(e) A delegate may represent, and vote in the name of, one country only (*m*).

(9) Countries of the Union not members of the Executive Committee shall be admitted to its meetings as observers (*n*).

(10) The Executive Committee shall adopt its own rules of procedure.

(a) This Article was introduced into the Convention by the Revision Conference of Stockholm in 1967.

(b) Until the Revision Conference of Stockholm the Paris Convention did not contain any provision concerning an Executive Committee. The Conference of Representatives of all countries of the Paris Union, referred to above under observation (b) on Article 13, had set up an Executive Committee, according to rules of procedure which it had established, but since no powers were given to that Committee in the Convention and the powers of the Conference of Representatives itself were very limited, the said Committee could only exercise advisory functions.

The Revision Conference of Stockholm established an Executive Committee and described its functions in the Convention. Since the Assembly of the Union is too large a body to be convened frequently, the Executive Committee is envisaged as a smaller organ of the Union, which will *prepare meetings of the Assembly* (Article 14(6)(a)(i) and (ii)), establish, within the limits of the program and triennial budget set up by the Assembly, *yearly budgets and programs*, and *report on the yearly accounts* (Article 14(6)(a)(iii) and (iv)) and *take all necessary measures to ensure the execution of the program* (Article 14(6)(a)(v)). As has been observed already, the Executive Committee will be controlled by the Assembly, by virtue of Article 13(2)(a)(v).

(c) The Executive Committee will consist of countries elected by the Assembly from among *countries members of the Assembly*. These countries will include countries which have not yet accepted the new administrative system set up by the Stockholm Conference in Articles 13 to 17 of the Convention, but which have given the notification provided for in Article 30(2) and are therefore deemed to be members of the Assembly. However, these latter countries are deemed to be members of the Assembly only until the expiration of a period of five years after the entry into force of the WIPO Convention. If after the expiration of this period they are still not bound by Articles 13 to 17 of the Stockholm text, these countries will cease to be members of the Executive Committee.¹ This will, of course, also be the case for countries which denounce the Convention, when such denunciation takes effect according to Article 26(3).

(d) Article 15 of the Stockholm text of the Convention provides that administrative tasks concerning the Union will be performed by the *International Bureau*, which is the *Secretariat of WIPO* (see Article 13(2)(a)(ii) of the Paris Convention and Article 9 of the WIPO Conven-

¹ See document S/3 prepared for the Stockholm Conference, p. 58, paragraph 175.

tion). According to Article 10 of the WIPO Convention, the headquarters of the Organization, and therefore of the International Bureau, will be in Geneva (Switzerland), unless transferred to another city. The WIPO Convention also prescribes that a headquarters agreement will be concluded with the State on the territory of which the Organization has its headquarters and that such agreement will provide that, when the envisaged working capital fund of the Organization is insufficient, that State will grant advances to the Organization. Parallel provisions have been included in Article 16(7) of the Paris Convention with respect to possible *advances to the Union*. It is logical that a country which undertakes to grant *advances* to the Union, if necessary, should be permitted, as long as this obligation stands, to *participate permanently in the Executive Committee of the Union*, the Committee which deals with *budget and financial management*.¹ This is assured by the second sentence of Article 14(2)(a), now under consideration, in relation with Article 16(7)(a) and (b).

(e) This provision prescribes that the Assembly, in *electing the members of the Executive Committee*, must have due regard to two requirements. One is that those members should represent an *equitable geographical distribution*, which is self-explanatory. The other requirement is that *countries party to the Special Agreements* established in relation with the Union should be among the countries constituting the Executive Committee.

With respect to this latter requirement, reference must be made to Article 19 of the Paris Convention, which allows the member States "to make separately between themselves special agreements for the protection of industrial property, in so far as these agreements do not contravene the provisions of this Convention."

Such agreements have been concluded but it is necessary to distinguish between different categories.

One category consists of the *Agreements prepared by the International Bureau of the Paris Union*, which have been concluded and revised in the same way, and frequently at the same Conferences, as the Paris Convention itself, and which are *administered by the International Bureau*. Several of these Agreements have already been referred to above. They are respectively: the Madrid Agreement, of 1891, concerning the International Registration of Marks, revised at Brussels (1900), Washington (1911), The Hague (1925), London

¹ See document S/3 prepared for the Stockholm Conference, p. 38, paragraph 114.

(1934), Nice (1957) and Stockholm (1967); the Madrid Agreement, of 1891, for the Repression of False or Deceptive Indications of Source on Goods, revised at Washington (1911), The Hague (1925), London (1934) and Lisbon (1958), with its Additional Act of Stockholm (1967); the Hague Agreement, of 1925, concerning the International Deposit of Industrial Designs, revised at London (1934) and The Hague (1960),¹ with its Additional Act of Monaco (1961) and Complementary Act of Stockholm (1967); the Nice Agreement, of 1957, concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, revised at Stockholm (1967); and the Lisbon Agreement, of 1958, for the Protection of Appellations of Origin and their International Registration,² revised at Stockholm (1967).

A second category of the special agreements referred to above consists of agreements made under the auspices of and administered by international organizations other than the Paris Union and its Bureau. Agreements of this type have been elaborated, for example, by the Council of Europe in the form of a European Convention, dated December 13, 1953, relating to the Formalities Required for Patent Applications, a European Convention, dated December 19, 1954, on the International Classification of Patents for Invention, and a Convention, dated November 27, 1963, on the Unification of Certain Points of Substantive Law on Patents for Invention,³ all of which Conventions expressly refer to what was then Article 15 and is now Article 19 of the Paris Convention, cited above.

Other examples of this type of agreement are the Agreement of June 6, 1947, establishing the International Patent Institute in The Hague (Netherlands), and the Agreement of September 13, 1962, regarding the creation of an African and Malagasy Industrial Property Office, which has already been referred to several times above. Although at the time of the signature of this latter Agreement the participating States were not yet members or had not yet confirmed their membership of the Paris Union, they undertook in the Agreement to adhere to that Union and, in view of this, express reference was made to Article 15 (now 19) of the Paris Convention.

A third category of the special agreements referred to in Article 19 of the Paris Convention consists of bilateral agreements between States regarding or including subjects of industrial property. Such agreements

¹ The revised text of The Hague (1960) has not yet entered into force.

² See, for the texts revised or established at Stockholm in 1967, *I.P.*, 1967, pp. 290, 291, 298, 335, 339.

³ This Convention has not yet entered into force.

are frequent. They may form part of general treaties of commerce or concern special subjects, such as the protection of appellations of origin.¹

There can be no doubt that the provision of Article 14(4) of the Paris Convention, now under consideration and providing for representation in the Executive Committee of *countries party to the Special Agreements established in relation with the Union*, refers only to the first category of such agreements, because the administration of the others is entirely independent of the organs of the Paris Union.

(f) Article 14(5)(a) prescribes that each member of the Executive Committee will serve—unless, of course, it withdraws from the Committee, or in cases as described above under observation (c) *in fine*—for the period between the close of two successive ordinary sessions of the Assembly, that is, for a period of roughly three years. According to Article 14(5)(b), all members of the Executive Committee may be re-elected, but only up to a maximum of two-thirds of such members. This rule assures a minimum rotation in the membership of the Executive Committee and is intended to afford an opportunity to every member of the Assembly to serve on the Executive Committee. The Assembly is not bound to renew more than one-third of the Executive Committee, but it may wish to do so. On the other hand, the rule which specifies that members of the Executive Committee may be re-elected up to the given maximum of two-thirds of the members means that re-election of a country is possible not only once but any number of times, so that countries whose presence on the Executive Committee is considered particularly desirable may serve for any appropriate period of time.

(g) The Assembly will establish the details of the rules governing the election and possible re-election of the members of the Executive Committee. The possible contents of such rules were indicated during the Stockholm Conference.²

(h) The main tasks of the Executive Committee have already been summarized above under observation (b). They are self-explanatory.

¹ Cf. DEVLÉTIAN: *I.P.*, 1968, pp. 110/1; KRIEGER: "Zur Auslegung der zweiseitigen Abkommen über den Schutz geographischer Bezeichnungen," *G.R.U.R. Int.*, 1964, p. 499, and "Der deutsch-schweizerische Vertrag über den Schutz von Herkunftsangaben und anderen geographischen Bezeichnungen," *G.R.U.R. Int.*, 1967, p. 334.

² See document S/3 prepared for the Stockholm Conference, p. 26, paragraph 83(c).

(i) Other functions allocated to the Executive Committee are, for example, cooperation with the International Bureau in the preparation for revision conferences (Article 15(7)(a)), and the right to propose amendments to Articles 13 to 17 (Article 17(1)).

(j) This provision parallels Article 13(2)(b) regarding the Assembly. See observation (n) on that Article.

(k) This provision parallels Article 13(7)(a) regarding the Assembly. See observation (r) on that Article.

(l) The quorum necessary for making valid decisions is the same as that of the Assembly, namely, one-half of the members. Since the Executive Committee is much smaller than the Assembly it is considered more probable that this quorum will be reached in every meeting of the Committee. Special rules for obtaining decisions in cases where the quorum is not reached, like those given for the Assembly (Article 13(4)(c)), are therefore not provided for the Executive Committee.

(m) For the same reasons, namely, that the Executive Committee is much smaller than the Assembly, no special rules are given, regarding meetings of the Committee, for representation or voting in the name of more than one country by one delegation (see, for the Assembly, Article 13(3)(b) and (5)(b)).

(n) All countries of the Union, even if they are not (yet) members of the Assembly, will be admitted to the meetings of the Executive Committee as observers. There is no provision for the admittance to those meetings of countries which are not members of the Union or of intergovernmental or international non-governmental organizations (see, for the Assembly, Article 13(2)(a)(ix)).

ARTICLE 15^(a)

(1)(a) Administrative tasks (b) concerning the Union shall be performed by the International Bureau, which is a continuation of the Bureau of the Union united with the Bureau of the Union established by the International Convention for the Protection of Literary and Artistic Works.

(b) In particular, the International Bureau shall provide the secretariat of the various organs of the Union (c).

(c) The Director General of the Organization shall be the chief executive of the Union and shall represent the Union (d).

(2) The International Bureau shall assemble and publish information concerning the protection of industrial property (e). Each country of the Union shall promptly communicate to the International Bureau all new laws and official texts concerning the protection of industrial property. Furthermore, it shall furnish the International Bureau with all the publications of its industrial property service of direct concern to the protection of industrial property which the International Bureau may find useful in its work (f).

(3) The International Bureau shall publish a monthly periodical (g).

(4) The International Bureau shall, on request, furnish any country of the Union with information on matters concerning the protection of industrial property (h).

(5) The International Bureau shall conduct studies, and shall provide services, designed to facilitate the protection of industrial property (i).

(6) The Director General and any staff member designated by him shall participate, without the right to vote, in all meetings of the Assembly, the Executive Committee, and any other committee of experts or working group. The Director General, or a staff member designated by him, shall be ex officio secretary of these bodies.

(7)(a) The International Bureau shall, in accordance with the directions of the Assembly and in cooperation with the Executive Committee, make the preparations for the conferences of revision of the provisions of the Convention other than Articles 13 to 17 (j).

(b) The International Bureau may consult with intergovernmental and international non-governmental organizations concerning preparations for conferences of revision (k).

(c) The Director General and persons designated by him shall take part, without the right to vote, in the discussions at these conferences (l).

(8) The International Bureau shall carry out any other tasks assigned to it.

(a) As has been observed above—see observation (f) on Article 13—the original Convention of 1883 had already established an international office under the name of *International Bureau of the Union for the Protection of Industrial Property*, which was entrusted with *administrative tasks concerning the Union*. This Bureau was later united with the corresponding Bureau of the Union for the Protection of Literary and Artistic Works, and these united Bureaux became known under the common designation of BIRPI.

The Revision Conference of Stockholm in 1967 replaced the said organ by a newly created *International Bureau of Intellectual Property*, which will be the *Secretariat of WIPO*, the said International Bureau being a continuation of BIRPI (see Article 15(1)(a) and Article 13(2)(a)(ii), and also the transitional provisions in Article 30(1), (3) and (4) of the Paris Convention as revised at Stockholm).

(b) The *administrative tasks* to be carried out by the International Bureau are specified in the Convention. They do not substantially differ from the tasks which BIRPI had to perform under former Acts of the Convention.¹ However, several provisions have been made more precise, while the question of languages to be used by the International Bureau, which was formerly regulated in the Convention (see Article 13(2)(a) and (b) of the Lisbon text as compared with Article 13(2) of the London text), is now left to be decided by the *General Assembly of WIPO*, which will take into consideration the practice of the United Nations (Article 6(2)(vii) of the WIPO Convention).

(c) The International Bureau will act, in particular, as a *secretariat*, not only of WIPO (Article 9(1) of the WIPO Convention) but also of the *various organs of the Paris Union*. These organs are the Assembly,

¹ See Report of Main Committee IV of the Stockholm Conference, *I.P.*, 1967, p. 221, paragraph 11.

the Executive Committee, and all committees of experts and working groups which may be established by the Assembly according to Article 13(2)(a)(viii).

(d) Since the International Bureau will be the Secretariat of the Union, its head, namely, the Director General of WIPO, will also be the chief executive of the Union and have competence to represent it.

(e) Already, under the original Convention of 1883, the International Bureau was entrusted with the task of *centralizing information* of every kind relating to the protection of industrial property. Originally, the Bureau was obliged only to *distribute* this information, in the form of general statistics, to the *national Administrations*, but the Revision Conference of The Hague in 1925 replaced this obligation by one to *publish* such information. This obligation was maintained in later texts and was not changed by the Revision Conference of Stockholm in 1967.

(f) The Revision Conference of Stockholm, however, complemented the obligations of the International Bureau by placing the member States under *corresponding obligations*. These latter obligations are twofold : in the first place, each member State will have to communicate to the International Bureau all its *new laws* and *official texts* concerning the protection of industrial property. Secondly, it will furnish the International Bureau with *all the publications of its industrial property service*, but only in so far as these publications are of direct concern to the *protection of industrial property* and if the *International Bureau finds them useful in its work*. Thus, for example, a guide for visitors to a national office, or information as to the availability of inventions, furnished by that office to the domestic industry of the country concerned, would not come under this provision. The International Bureau may, however, always indicate its interest in receiving publications of the national offices of direct concern to the *protection of industrial property*.

(g) The International Bureau at present publishes similar monthly periodicals in English and French : *Industrial Property* and *La Propriété industrielle*; and also a quarterly periodical in Spanish : *La Propiedad Intelectual*.

Originally, and until the Revision Conference of Stockholm in 1967, the Convention provided for the furnishing of free copies of the periodicals and other publications of the International Bureau to each member State, in proportion to its financial contribution to the Union

(see Article 13(4) of the Lisbon text of 1958). The Revision Conference of Stockholm has left this question to be decided by the Assembly.

(h) This provision obliges the International Bureau to give, on request, *information to member States*, that is, to their Governments or industrial property Offices, on *matters concerning the protection of industrial property*. Such information may, for example, concern legislation or administrative practices in other member States. It may also concern the application of the Convention in the States concerned. It may not, however, take a position in controversies regarding the interpretation or application of the Convention in other member States, unless on their request, because the International Bureau is not qualified to pronounce on such questions. *Disputes between member States* concerning the interpretation or application of the Convention may be brought before the *International Court of Justice*, according to Article 28.

The International Bureau will not be obliged to give information other than to member States.

(i) *Studies* of this type are made with a view to improving the international protection of industrial property, for example, by establishing a Patent Cooperation Treaty (PCT).¹ They are also made with a view to examining and, if possible, improving the protection of industrial property in various parts of the world and are in that case frequently organized in congresses, seminars, symposia or committees of experts.²

Services, as referred to, are provided by putting at the disposal of the public a library specializing in the field of industrial property and related subjects. They may, for example, also be organized in the form of a "World Patent Index."³ Other services are performed by the International Bureau by virtue of a number of Special Agreements as referred to above under observation (e) on Article 14.

¹ See *I.P.*, 1967, pp. 58, 161, 301.

² *Ibidem*, 1963, pp. 191 (African Seminar on Industrial Property), 234 (Committee of Experts to Study Industrial Property Problems of Industrially Less Developed Countries); 1964, pp. 164 (Industrial Property Congress for Latin America), 235 (Committee of Experts to Study a Model Law for Developing Countries on Inventions and Technical Know-How); 1966, pp. 54 (Asian Seminar on Industrial Property), 271 (BIRPI East-West Industrial Property Symposium), 274 (Committee of Experts to Study a Model Law for Developing Countries on Marks, Trade Names, Indications of Source, and Unfair Competition).

³ *Ibidem*, 1964, p. 209; 1965, p. 75; 1966, p. 58.

(j) One of the important tasks of the International Bureau is the *preparation of conferences for the revision of the Convention* (Article 18). As has been observed above—see observation (e) on Article 13—the Bureau will carry out this task *in accordance with the directions of the Assembly and in cooperation with the Executive Committee*.

(k) In carrying out the above task, the International Bureau may also consult *with intergovernmental and international non-governmental organizations*. As has already been observed, such consultations have been of great value in the past and will, no doubt, therefore be frequent.

(l) This provision was already introduced in substance into the Convention by the Revision Conference of Washington in 1911. The Revision Conference of Stockholm in 1967 enlarged its scope by including the possibility for the Director General to designate other persons to take part in revision conferences; such persons will generally be members of the staff of the International Bureau (see also Article 15(6)) but may also be advisors from outside that Bureau.

ARTICLE 16^(a)

(1)(a) The Union shall have a budget (b).

(b) The budget of the Union shall include the income (c) and expenses proper to the Union, its contribution to the budget of expenses common to the Unions, and, where applicable, the sum made available to the budget of the Conference of the Organization (d).

(c) Expenses not attributable exclusively to the Union but also to one or more other Unions administered by the Organization shall be considered as expenses common to the Unions. The share of the Union in such common expenses shall be in proportion to the interest the Union has in them.

(2) The budget of the Union shall be established with due regard to the requirements of coordination with the budgets of the other Unions administered by the Organization (e).

(3) The budget of the Union shall be financed from the following sources (f) :

- (i) contributions of the countries of the Union ;
- (ii) fees and charges due for services rendered by the International Bureau in relation to the Union ;
- (iii) sale of, or royalties on, the publications of the International Bureau concerning the Union ;
- (iv) gifts, bequests, and subventions ;
- (v) rents, interests, and other miscellaneous income.

(4)(a) For the purpose of establishing its contribution towards the budget, each country of the Union shall belong to a class (g), and shall pay its annual contributions on the basis of a number of units fixed as follows :

Class I	25
Class II	20
Class III	15
Class IV	10
Class V	5
Class VI	3
Class VII	1

(b) Unless it has already done so, each country shall indicate, concurrently with depositing its instrument of ratification or accession,

the class to which it wishes to belong. Any country may change class. If it chooses a lower class, the country must announce such change to the Assembly at one of its ordinary sessions. Any such change shall take effect at the beginning of the calendar year following the said session (*h*).

(c) The annual contribution of each country shall be an amount in the same proportion to the total sum to be contributed to the budget of the Union by all countries as the number of its units is to the total of the units of all contributing countries (*i*).

(d) Contributions shall become due on the first of January of each year.

(e) A country which is in arrears in the payment of its contributions may not exercise its right to vote in any of the organs of the Union of which it is a member if the amount of its arrears equals or exceeds the amount of the contributions due from it for the preceding two full years. However, any organ of the Union may allow such a country to continue to exercise its right to vote in that organ if, and as long as, it is satisfied that the delay in payment is due to exceptional and unavoidable circumstances (*j*).

(f) If the budget is not adopted before the beginning of a new financial period, it shall be at the same level as the budget of the previous year, as provided in the financial regulations (*k*).

(5) The amount of the fees and charges due for services rendered by the International Bureau in relation to the Union shall be established, and shall be reported to the Assembly and the Executive Committee, by the Director General (*l*).

(6)(a) The Union shall have a working capital fund which shall be constituted by a single payment made by each country of the Union. If the fund becomes insufficient, the Assembly shall decide to increase it (*m*).

(b) The amount of the initial payment of each country to the said fund or of its participation in the increase thereof shall be a proportion of the contribution of that country for the year in which the fund is established or the decision to increase it is made.

(c) The proportion and the terms of payment shall be fixed by the Assembly on the proposal of the Director General and after it has heard the advice of the Coordination Committee of the Organization.

(7)(a) In the headquarters agreement concluded with the country on the territory of which the Organization has its headquarters, it

shall be provided that, whenever the working capital fund is insufficient, such country shall grant advances. The amount of these advances and the conditions on which they are granted shall be the subject of separate agreements, in each case, between such country and the Organization. As long as it remains under the obligation to grant advances, such country shall have an ex officio seat on the Executive Committee (*n*).

(b) The country referred to in subparagraph (a) and the Organization shall each have the right to denounce the obligation to grant advances, by written notification. Denunciation shall take effect three years after the end of the year in which it has been notified.

(8) The auditing of the accounts shall be effected by one or more of the countries of the Union or by external auditors, as provided in the financial regulations. They shall be designated, with their agreement, by the Assembly (*o*).

(a) This Article, introduced into the Convention by the Revision Conference of Stockholm, has established provisions regarding the *finances of the Union* which differ from the former provisions, although it has maintained, in a modified form, some parts of the Article 13 of former texts.

The old provisions prescribed (see Article 13(6) and (7) of the Lisbon text) that the expenditure of the Union would be borne by the countries of the Union in common, according to certain rules (*ibidem*, paragraphs (8) and (9)). It was then provided that this expenditure would *not exceed certain fixed sums* (Article 13(6) and (7) and Article 14(5)(b) of the Lisbon text; the sum indicated in Article 13(6) of the Lisbon text was modified by a unanimous decision of the Conference of Representatives of the countries of the Paris Union, made in Stockholm in 1967).¹ It was further provided (Article 13(10) and (11) of the Lisbon text) that the Government of the Swiss Confederation would supervise the expenditure of the International Bureau and its accounts, and that the annual account of that Bureau would merely be communicated to the other national Administrations.

The establishment of a budget was not prescribed in the former system, although a budget was, in fact, prepared in order to facilitate the supervision of the expenditure by the Swiss Government and also (Article 14(5)(a) of the Lisbon text) in order to enable the Conference

¹ Cf. *I.P.*, 1968, p. 21.

of Representatives, in its three-yearly meetings, to draw up a report on the foreseeable expenditure of the International Bureau for each three-year period to come.

This system was replaced at the Revision Conference of Stockholm in 1967 by a more flexible one, under which *no fixed ceiling for expenses* that can be changed only by a unanimous vote of a Conference of Plenipotentiaries of the member States is established, *but triennial and yearly budgets* will be adopted by *organs formed by the member States* (Assembly: Article 13(2)(a)(vi), and Executive Committee: Article 14(6)(a)(iii) of the Stockholm text). This important change in the financial system of the Union has been supplemented by many other new provisions, some of which are again closely related to WIPO, established by the Stockholm Conference simultaneously with the revision of the Paris Convention.

(b) It is now prescribed in the Convention that the Paris Union *will have a budget* which, as already observed, is *triennial and yearly*. The Convention also indicates the *sources* from which the budget will be *financed* (Article 16(3)) and the *items of expenditure* which will be included in the budget (Article 16(1)(b)). The budget of the Union will be fixed autonomously by its organs,¹ but due regard must be given to the requirements of coordination with the budgets of the other Unions administered by WIPO (see observations (d) and (e), below).

(c) The *income of the Union*, to be included in the budget, will derive from sources indicated in Article 16(3).

(d) The *expenses* to be included in the budget are of three different categories, owing to the envisaged relationship between the Paris Union and WIPO (see also, above, observation (a) on Article 13):

first, the budget will include the *expenses proper to the Union*;

secondly, it will include a contribution by the Union to *the budget of expenses common to the Unions* (see Article 11(2), particularly (b)(i) of the WIPO Convention);

thirdly, it *may also* include a sum made available to the budget of the *Conference of WIPO* (see Article 11(3), particularly (b)(ii) of the WIPO Convention).

Expenses proper to the Union will be the expenses involved in the performance by the Secretariat of tasks exclusively related to the Paris

¹ Report of Main Committee IV of the Stockholm Conference, I.P., 1967, p. 221, paragraph 12.

Union, for example, studies and services regarding the Union, the preparation of revision conferences, etc.

Expenses common to the Unions are defined in Article 16(1)(c). These are expenses incurred by the Secretariat not only in the sole interest of the Paris Union but also in the interest of other Unions administered by it, such as the salary of the Director General and several other staff members, expenses relating to common services, such as those regarding finances, personnel, translation, typing, etc., and the maintenance of the headquarters building. The share of the Union in such common expenses will be in proportion to the interest the Union has in them. This share will be fixed according to a procedure prescribed in the WIPO Convention, which provides that a *triennial budget of expenses common to the Unions* will be established by the General Assembly (Article 6(2)(iv) of the WIPO Convention) and *annual budgets* by the Coordination Committee (*ibidem*, Article 8(3)(iv)), whereas the Coordination Committee will give advice to the organs of the Unions on all administrative, financial or other matters of common interest either to two or more Unions or to one or more of the Unions and the Organization, and *in particular on the budget of expenses common to the Unions* (*ibidem*, Article 8(3)(i)). Since the members of the Executive Committee of the Paris Union are ex officio members of the Coordination Committee (Article 8(1)(a) of the WIPO Convention) no difficulties can be expected regarding these questions. However, the WIPO Convention also prescribes (Article 11(2)(a)(i)) that the contributions of the Unions, and consequently also those of the Paris Union, can only be *fixed* by the *Assembly of that Union*, having regard to the interest the Union has in the common expenses (see also Article 16(1)(c), second sentence, of the Paris Convention).

A contribution by the Paris Union *to the budget of the Conference* of WIPO will also be included in the budget of the Paris Union, *if and when the Assembly of the Paris Union so decides* (Article 11(3)(b)(ii) of the WIPO Convention corresponding to the final part of Article 16(1)(b) of the Paris Convention).

(e) As has been observed above, the Assembly of the Union is autonomous in establishing its triennial budget and the share in the common expenses of the Unions to be included in it. Within the limits of this triennial budget and under the control of the Assembly (Article 13(2)(a)(v)), the Executive Committee has a similar competence with respect to the yearly budgets (Article 14(6)(a)(ii)). Article 16(2), now under consideration, contains the instruction that the budget of the Union must be established with due regard to the requirements of

coordination with the budgets of the other Unions administered by WIPO. The advice of the Coordination Committee of WIPO, referred to above, will be necessary to achieve this end.

(f) *The sources of income* of the Union are largely self-explanatory. See, for the contributions of the member States, the following remarks under (g), (h) and (i). See further, for the fees and charges for services rendered by the International Bureau in relation to the Union, Article 16(5), which should be compared to Article 11(2)(b)(ii) of the WIPO Convention.

(g) The system whereby, in order to determine the contribution of each member State towards the expenses of the Union, *the member States are divided into classes* was already included in the original Convention of 1883 (paragraph 6 of the Final Protocol which formed an integral part of the Convention). Newly acceding countries therefore had to choose the class in which they wished to be placed and the rule was incorporated in the Convention by the Revision Conference of Washington in 1911.

That system was maintained until the Revision Conference of Stockholm in 1967, which modified it to some extent.

The principal modification is that the number of classes is no longer six but seven, which means that a seventh class has been added. This was done in order to give a fairer representation of the relative contributive power of more and less developed countries: under the texts in force from Washington (1911) to Lisbon (1958), the highest contribution was only 8 1/3 times larger than the lowest contribution; by virtue of the Stockholm revision, it will be 25 times larger.¹

(h) The Revision Conference of Stockholm maintained the system allowing complete freedom to each member State to choose the class in which it wishes to be placed, and, if it so desires, to modify its choice later. In addition, however, the Stockholm Act provides that, if a member State wishes to choose a *lower* class for its contributions than it has chosen before, it must announce such change to the Assembly at one of its ordinary, three-yearly, sessions, in which case the change will not take effect until the beginning of the calendar year following the said session. This provision has been made because otherwise the other member States would be obliged to pay a higher share (since each lowering of class by a member State automatically leads to an

¹ See document S/3 prepared for the Stockholm Conference, p. 36, paragraph 107.

increase in the share of the other member States) than contemplated when the last three-yearly budget was adopted.¹

(i) This provision contains the rule for the calculation of the proportion of the contribution of each member State to the total of the contributions of all of those States. Although the rule is different in wording, it maintains the former system (Article 13(8) of the Lisbon text).

(j) This provision, introduced by the Revision Conference of Stockholm in 1967, establishes a rule under which certain *arrears in the payment of contributions* (arrears to the amount of the contributions due for the preceding two full years or more) will deprive a member State of its voting rights in any of the organs of the Union of which it is a member. This incentive to make prompt payment of contributions was considered necessary because it would be unfair to rely on advances payable under Article 16(7)(a) in order to make up for deficiencies in payment by other States. Naturally, once the arrears are paid, the right of the State concerned to vote will automatically revive.

However, the provision adds that the organ concerned (Assembly, Executive Committee) may make exceptions to the rule if, and so long as, it is satisfied that the delay in payment is due to exceptional and unavoidable circumstances.

(k) Especially with regard to the Assembly, where the quorum or the required majority of votes (Article 13(4)(b), (c) and (d)) may not always be reached, difficulties may arise when the budget is not adopted before the beginning of the period to which it must be applied. Since in such case the operations of the Union cannot be allowed to be interrupted, the Revision Conference of Stockholm adopted a rule whereby, in those circumstances, the level of the budget will be the same as that of the year immediately preceding. The financial regulations of the Union (Article 13(2)(a)(vii)) will elaborate further on this provision.

(l) One of the Union's possible sources of income will be the *fees and charges due for services* rendered by the International Bureau in relation to the Union (see observation (f) above). The Director General of the International Bureau will establish the amount of such fees and

¹ See document S/3 prepared for the Stockholm Conference, p. 36, paragraph 108.

charges but will report on them to the Assembly and the Executive Committee, so that these bodies, if they so desire, may express an opinion or give instructions (Article 13(2)(a)(iii) and Article 14(6)(a)(iv)).

(m) Another of the innovations made by the Revision Conference of Stockholm in 1967 is a provision for establishing a *working capital fund* (see also Article 11(8) of the WIPO Convention). This is a fund, constituted in principle by one-time contributions of the member States and intended to enable the International Bureau to operate during the short period between the time when the normal contributions are due (Article 16(4)(d)) and that at which their payment is, in fact, received. The provisions relating to this working capital fund are self-explanatory.

(n) Since the working capital fund may, in certain circumstances, be insufficient to enable the International Bureau to continue its operations within the limits of the established budgets and program, the Revision Conference of Stockholm also adopted provisions which continue, in a modified form, the former system (see Article 13(10) of the Lisbon text) under which the member State in whose territory the International Bureau is established will grant the necessary advances to the latter. The provision to this effect parallels Article 11(9) of the WIPO Convention. As already observed—see observation (d) on Article 14—the above State, which agrees to grant advances to the Union, must be in a position to be fully informed of all financial matters concerning the Union, and will therefore have an *ex officio* seat on the Executive Committee (Article 14(2)(a)). As follows from the following subparagraph (b) of the provision under consideration, the obligation to grant advances may be denounced, but such denunciation will not take effect until three years after the end of the year in which it has been notified. This means that during the latter period the Assembly will meet in ordinary session and may take the necessary measures—for example, deciding to increase the working capital fund.

(o) Under the texts preceding the Revision Conference of Stockholm in 1967, the auditing of the accounts of the International Bureau was organized by the Swiss Government, which supervised those accounts (Article 13(10) of the Lisbon text). Since, under the Stockholm text, the Swiss Government will no longer perform this task of supervision, provision is made for the auditing of the accounts to be effected either by one or more member States, willing to do so,

or by external auditors (a professional accountant firm), designated by the Assembly.¹ The details of this procedure will be regulated by the financial regulations of the Union (see also Article 11(10) of the WIPO Convention).

¹ See document S/3 prepared for the Stockholm Conference, p. 38, paragraph 115.

ARTICLE 17^(a)

(1) Proposals for the amendment of Articles 13, 14, 15, 16, and the present Article (b), may be initiated by any country member of the Assembly, by the Executive Committee, or by the Director General. Such proposals shall be communicated by the Director General to the member countries of the Assembly at least six months in advance of their consideration by the Assembly.

(2) Amendments to the Articles referred to in paragraph (1) shall be adopted by the Assembly (c). Adoption shall require three-fourths of the votes cast, provided that any amendment to Article 13, and to the present paragraph, shall require four-fifths of the votes cast (d).

(3) Any amendment to the Articles referred to in paragraph (1) shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of the countries members of the Assembly at the time it adopted the amendment (e). Any amendment to the said Articles thus accepted shall bind all the countries which are members of the Assembly at the time the amendment enters into force, or which become members thereof at a subsequent date, provided that any amendment increasing the financial obligations of countries of the Union shall bind only those countries which have notified their acceptance of such amendment (f).

(a) This Article was introduced into the Convention by the Revision Conference of Stockholm in 1967. As has been observed above—see observation (k) on Article 13—prior to the Stockholm Conference all modifications of the Convention depended on unanimous decisions of revision conferences, expressly convened to that end (Article 14 of the Lisbon text, which was, in part, already included in the original text of the Convention of 1883). The Stockholm Conference changed this system by establishing a distinction between, on the one hand, *amendments to the administrative provisions of Articles 13 to 17 of the Convention* and *revisions of the Convention with respect to all its other provisions*. Article 17, now under consideration, deals with the first subject; Article 18, with the second. The differences are mainly the following :¹

¹ See document S/3 prepared for the Stockholm Conference, p. 40, paragraph 118.

Amendments are discussed in and adopted by the *Assembly*, which consists *only of the States bound by Articles 13 to 17 of the Convention or deemed to be members of the Assembly* under Article 30(2); the adoption of amendments requires a *qualified majority*, but after such adoption and acceptance they will *bind all members of the Assembly*, except that amendments increasing financial obligations will bind only States which have accepted these amendments.

Revisions, on the other hand, are discussed in and adopted by *revision conferences consisting of all countries of the Union*, even if they are not yet bound by the most recent text of the Convention which is the subject of the revision; their adoption requires *unanimity* and they will bind *only States which have ratified the revised Convention or have acceded to it*.

The reason for having a special procedure for amendments is that the system regarding revision has been considered too cumbersome for the modification of purely administrative provisions of the Convention.

(b) The special procedure for amendments applies only to Articles 13 to 17 of the Convention, which are, indeed, of a purely administrative character. The procedure for the initiation of amendments is self-explanatory.

(c) The *Assembly* is competent to adopt amendments and it is not even required to take account of the views of member States of the Unions which are not members of the Assembly (cf., on the contrary, for revisions, Article 13(2)(a)(ii) *in fine*); this is because these latter States have no direct interest in administrative provisions by which they are not bound. However, since the said States are admitted as observers to the Assembly (Article 13(6)), their views may be heard nevertheless.

(d) Whereas the decisions of the Assembly will normally require a *majority of two-thirds* of the votes cast (Article 13(4)(d)), more substantial qualified majorities are required for the adoption of amendments. Article 13, regulating the powers of the Assembly, has been considered the cornerstone of the administrative system of the Convention. Amendments to that Article therefore require four-fifths of the votes cast. In order that amendment of the Article concerning amendments may not too easily change this majority, the same majority is required for amendments to Article 17(2). Amendments to Articles 14, 15, 16 and 17(1) and (3) will require a three-fourths majority.

(e) Once adopted by the required majority, any amendment will still have to enter into force. This will require *notifications of*

acceptance of such amendment by the States *members of the Assembly at the time it adopted the amendment*, irrespective of whether those States have voted on the amendment and, if so, irrespective of whether they voted for or against it. When such notifications have been received from *three-fourths of the members of the Assembly* (even if the majority required for adoption of the amendment was four-fifths) the amendment will enter into force one month after receipt.

(f) Any amendment thus accepted will—with one exception—bind *all States which are or will become members of the Assembly*. The only exception is that, whenever any amendment increases the financial obligations of member States, it will bind only those States which have notified their acceptance of such amendment. This provision does not apply to States which newly accede to the Union, because for such States there is no question of an *increase of existing* financial obligations: in acceding to the Union they will have to accept the financial obligations as they stand.

ARTICLE 18^(a)

(1) This Convention shall be submitted to revision with a view to the introduction of amendments designed to improve the system of the Union (b).

(2) For that purpose, conferences shall be held successively in one of the countries of the Union among the delegates of the said countries (c).

(3) Amendments to Articles 13 to 17 are governed by the provisions of Article 17 (d).

(a) Paragraphs (1) and (2) of this Article were already included in the original text of the Convention of 1883 (Article 14).¹ They underwent only minor changes as to form during the subsequent Revision Conferences.

Paragraph (3) of the Article, added by the Revision Conference of Stockholm in 1967, is a reminder of the distinction made by that Conference between *amendments* to Articles 13 to 17 and *revision* by way of amendments of other provisions of the Convention (see, above, observation (a) on Article 17).

(b) The member States will be free to decide which amendments will, in fact, improve the system of the Union. Another question, however, is what majority will be required to make such decisions. Although the Convention does not explicitly state this principle, it was considered by the various Revision Conferences² that a *unanimous vote* of all States participating in such Conferences—abstentions not being considered as votes (see also Articles 13(4)(e) and 14(8)(d) of

¹ *Actes de Paris*, I, pp. 28 (proposal for Article 12), 119/20, 145 (discussion and adoption).

² See *Actes de la Conférence de Rome*, 1886, pp. 86/7 (the revision then adopted never entered into force); *Actes de La Haye*, pp. 428, 437; *Actes de Londres*, pp. 164/5, 294 (proposal of Mexico), 351/2 (discussion and vote in First Sub-Committee); *Actes de Lisbonne*, pp. 564, 668, 703/4, 731; Document S/3 prepared for the Stockholm Conference, p. 10, paragraph 27(a), p. 40, paragraphs 118(ii), 119. See also LADAS: *The International Protection of Industrial Property*, p. 128; ROUBIER: *Le droit de la propriété industrielle*, I, p. 257; TROLLER: *Die mehrseitigen völkerrechtlichen Verträge im internationalen gewerblichen Rechtsschutz und Urheberrecht*, p. 195; RONGA: "La règle de l'unanimité pour la révision des Conventions de Paris et de Berne," *R.I.D.A.*, XXXIII (Oct. 1961), p. 3.

the Stockholm text)—was necessary for revision of all the provisions of the Convention (under the Stockholm text, with the exception of Articles 13 to 17: see Article 17). This established rule must be considered binding on the Union until changed by a contrary provision adopted under the same rule.

(c) The delegates of member States participating in a revision conference must be duly empowered, according to their national constitutions or laws, to discuss and vote a revision of the Convention. The special rules for representation and voting in the *Assembly*, given in Article 13(3)(b) and (5)(b), will not apply to *revision conferences*. See, for the *preparation* of revision conferences, Article 13(2)(a)(ii) and Article 15(7)(a) and (b).

(d) As has been observed already under (a), this paragraph is a reminder of the separate rules which govern *amendments* to Articles 13 to 17 of the Convention and *revision* of its other Articles, respectively.

ARTICLE 19^(a)

It is understood that the countries of the Union reserve the right to make separately between themselves (b) special agreements (c) for the protection of industrial property, in so far as these agreements do not contravene the provisions of this Convention (d).

(a) This Article appeared already in the original text of the Convention of 1883.¹ Since then it has undergone only slight changes as to form.

(b) The member States of the Union may make special agreements for the protection of industrial property either bilaterally or in the form of multilateral treaties. It has already been observed above—observation (e) on Article 2, paragraph (1)—that the application of such bilateral or multilateral treaties may be limited to nationals (and persons assimilated to such nationals) of the States concluding such treaties.

(c) The most important of the Special Agreements concluded under the Paris Convention have been enumerated above under observation (e) on Article 14. Several other Agreements have been or are being made, such as the Agreement Establishing an International Classification for Industrial Designs,² signed at Locarno on October 8, 1968, and a Patent Cooperation Treaty,³ in course of preparation.

(d) It has already been observed above—see Chapter II.4 *in fine*—that the Convention leaves much freedom to its member States to legislate in the field of industrial property on points not covered by the Convention. Similar freedom exists with respect to the concluding of special agreements between member States.

¹ *Actes de Paris*, I, pp. 28 (proposal for Article 13), 120/2, 145 (discussion and adoption).

² See *I.P.*, 1964, p. 255; 1966, p. 103.

³ *Ibidem*, 1967, pp. 58, 161, 301.

ARTICLE 20^(a)

(1)(a) Any country of the Union (*b*) which has signed this Act may ratify it, and, if it has not signed it, may accede to it (*c*). Instruments of ratification and accession shall be deposited with the Director General (*d*).

(b) Any country of the Union may declare in its instrument of ratification or accession that its ratification or accession shall not apply (*e*):

- (i) to Articles 1 to 12, or
- (ii) to Articles 13 to 17.

(c) Any country of the Union which, in accordance with subparagraph (b), has excluded from the effects of its ratification or accession one of the two groups of Articles referred to in that subparagraph may at any later time declare that it extends the effects of its ratification or accession to that group of Articles. Such declaration shall be deposited with the Director General (*f*).

(2)(a) Articles 1 to 12 shall enter into force (*g*), with respect to the first ten countries of the Union which have deposited instruments of ratification or accession without making the declaration permitted under paragraph (1)(b)(i), three months after the deposit of the tenth such instrument of ratification or accession.

(b) Articles 13 to 17 shall enter into force, with respect to the first ten countries of the Union which have deposited instruments of ratification or accession without making the declaration permitted under paragraph (1)(b)(ii), three months after the deposit of the tenth such instrument of ratification or accession.

(c) Subject to the initial entry into force, pursuant to the provisions of subparagraphs (a) and (b), of each of the two groups of Articles referred to in paragraph (1)(b)(i) and (ii), and subject to the provisions of paragraph (1)(b), Articles 1 to 17 shall, with respect to any country of the Union, other than those referred to in subparagraphs (a) and (b), which deposits an instrument of ratification or accession or any country of the Union which deposits a declaration pursuant to paragraph (1)(c), enter into force three months after the date of notification by the Director General of such deposit, unless a subsequent date has been indicated in the instrument or declaration deposited. In the latter case, this Act shall enter into force with respect to that country on the date thus indicated.

(3) With respect to any country of the Union which deposits an instrument of ratification or accession, Articles 18 to 30 shall enter into force on the earlier of the dates on which any of the groups of Articles referred to in paragraph (1)(h) enters into force with respect to that country pursuant to paragraph (2)(a), (b), or (c).

(a) Provisions concerning *ratification* of the Convention and *accession* to it, and its *entry into force*, have existed in the Convention from its origin.¹ They have been completed and modified by the successive revision conferences and were thoroughly changed by the Revision Conference of Stockholm in 1967, in view of the amendments to the administrative provisions of the Convention accepted on that occasion.

(b) With respect to the question *how a State may become a party to the Convention* as revised at Stockholm in 1967, a distinction must be made between States which, because of their acceptance of one or more of the earlier Acts of the Convention, are already *members of the Union* and States which are *not such members*. The situation regarding the first category of States is dealt with in Article 20, that of the second category in Article 21.

The principal reasons for this distinction are the following :²

As the Stockholm Conference was a conference of *revision* of the Convention, only States already party to the Convention could participate in it with voting powers and only such States could *sign* the revised Convention. For those member States there are therefore two possibilities: if they have signed the Convention as revised at Stockholm, they may ratify it, and, if they have not signed it, they may accede to it. On the other hand, non-member States, which cannot have signed the revised Convention, may only accede to it.

Furthermore, for reasons already indicated above—see observation (c) on Article 13—States already members of the Union may, when ratifying the Stockholm Act or acceding to it, declare that such ratification or accession will *not* apply to a *certain group of Articles* (Article 20(b) and (c) and observations (e) and (f) below). This possibility of limited accession is not open to States which were not members of the Union until they acceded to the Stockholm Act, because it was considered that such States would have to accept the Convention, as revised at Stockholm, as a whole.

¹ Cf. Articles 16, 18 and 19 of the original text of the Convention of 1883.

² Cf. document S/3 prepared for the Stockholm Conference, p. 44, paragraph 131.

Thirdly, again because the text established at Stockholm was the result of a *revision* of the existing Convention, the number of ratifications and accessions required for entry into force of the Stockholm Act takes into account only ratifications and accessions of *States already members of the Union*, and not accessions of new member States.

(c) The distinction between *ratification* by a State which has signed an international convention and *accession* by a State which has not done so is customary in international public law.

(d) Under former texts of the Convention, and until the Revision Conference of Stockholm in 1967, the function of *depository* for ratifications and accessions was entrusted to and fulfilled by the Government of the Swiss Confederation, which also exercised the supervision over the International Bureau. The Stockholm Conference did not prolong the special functions of the Government of the Swiss Confederation as such (as distinguished from the special situation of the State in which WIPO has its headquarters: see Article 14(2)(a) and Article 16(7)) and therefore transferred the function of depository to the Director General of WIPO, who is at the same time the chief executive of the Paris Union (see Article 15(1)(c) and also the transitional provision of Article 30(1)).¹

(e) As has been observed above—observation (c) on Article 13—the Revision Conference of Stockholm in 1967 dealt with *two entirely different subjects*, namely, on the one hand, the introduction into the Convention of provisions concerning the right of priority with respect to inventors' certificates (Article 4 I(1) and (2)) and, on the other hand, a thorough revision of the administrative provisions of the Convention. As the acceptance of each of these parts of the revised Convention in any member State may depend on different considerations and may require different legal procedures, it was decided to give member States the opportunity to accept *only one of these parts of the revision, or one of these parts earlier than the other*.

Member States may therefore *exclude* from their ratification or accession, at least until further notice, *either Articles 1 to 12 of the Stockholm Act* (which include the newly introduced Article 4 I(1)

¹ See, for the functions of the depository of an international treaty: Summary of the Practice of the Secretary-General as depository of multilateral agreements, U.N. document St/Leg/7, 1959.

and (2) but are otherwise, except for small differences in the English translation, identical with the same Articles of the preceding Lisbon Act), or Articles 13 to 17 (which contain the revised administrative system).

A member State which *excludes* from its ratification or accession Articles 1 to 12 of the Stockholm Act will be bound by the new administrative provisions, whereas, as far as the substantive provisions are concerned, it will continue to be bound by Articles 1 to 12 of that earlier Act, or those earlier Acts, by which it has been bound before its (partial) acceptance of the Stockholm Act;¹ it will, finally, also be bound by Articles 18 to 30 of the Stockholm Act containing final clauses (see Article 20(3)). If, on the contrary, a member State *excludes* from its ratification or accession Articles 13 to 17 of the Stockholm Act, it will be bound only by the new substantive provisions of Articles 1 to 12 (including the provisions of Article 4 1(1) and (2)) and by the final clauses of Articles 18 to 30 (Article 20(3)). As far as the purely administrative provisions are concerned, such State will continue to be bound by Article 13 of the former Acts.²

(f) This provision permits a member State, at any time after its original ratification of or accession to the Stockholm Act, to declare that it extends the effects of its ratification or accession to the group of Articles which it had excluded from its earlier ratification or accession. The effect will be that such State will then become bound by the Stockholm Act in its entirety.

(g) Paragraphs (2) and (3) of Article 20 deal with the *entry into force* of the Stockholm Act of the Convention. The rules governing such entry into force are more complicated than they were in earlier texts of the Convention owing to the possibility given to member States to exclude certain groups of Articles of the Stockholm Act from their ratification or accession. Simply stated, the rules governing the entry into force are the following :

Both the *substantive clauses* of Articles 1 to 12 of the Stockholm Act and its *new administrative clauses* in Articles 13 to 17 will—as the case may be, *separately*—enter into force *three months* after the deposit of the *tenth* instrument of ratification or accession by a member State not excluding the relevant group of Articles from such ratification or accession (Article 20(2)(a) and (b)). Such entry into force

¹ See document S/3 prepared for the Stockholm Conference, p. 46, paragraph 134.

² *Ibidem*, p. 46, paragraph 135.

will bind only member States which have not excluded from their ratification or accession the relevant group of Articles (see, for new members of the Union, Article 21, to be commented upon below).

At the earlier of the dates on which any of the groups of Articles referred to will enter into force, *Articles 18 to 30* of the Stockholm text, *containing final clauses*, will also enter into force (Article 20(3)). This latter part of the Convention will bind *all* member States which have ratified or acceded to the Stockholm Act, even if they have excluded one of the groups of Articles 1 to 12 or 13 to 17 from their ratification or accession, because the final clauses of Articles 18 to 30 must apply together with any other part of the Stockholm Act. Of course, some of the final clauses, because of their nature—for example, those regarding the place of deposit of instruments of ratification or accession—will be applied even before any formal entry into force.

The provisions so far referred to deal only with the *initial* entry into force of the various parts of the Stockholm Act and not with the situation of member States which ratify or accede to that Act after the first ten such States. The member States first mentioned may also, according to Article 20(1)(b) and (2)(c), exclude one of the groups of Articles 1 to 12 or 13 to 17 from their ratification or accession. If they do *not* exclude any group which has been excluded before by any other member State, their ratification or accession will count towards the total of ten ratifications or accessions required for the entry into force of the relevant group of Articles. Subject to their possible exclusion of one of the above groups of Articles, Articles 1 to 17 will enter into force with respect to those member States (Article 20(2)(c)) *three months* after the *date of notification* of their ratification or accession by the Director General to the other member States (Article 29(5)), unless a *subsequent date* has been indicated in the instrument or declaration deposited. At the same time, Articles 18 to 30 of the Stockholm Act will enter into force with respect to such member States (Article 20(3)).

ARTICLE 21^(a)

(1) Any country outside the Union may accede to this Act and thereby become a member of the Union (b). Instruments of accession shall be deposited with the Director General (c).

(2)(a) With respect to any country outside the Union which deposits its instrument of accession one month or more before the date of entry into force of any provisions of the present Act, this Act shall enter into force (d), unless a subsequent date has been indicated in the instrument of accession, on the date upon which provisions first enter into force pursuant to Article 20(2)(a) or (b); provided that :

- (i) if Articles 1 to 12 do not enter into force on that date, such country shall, during the interim period before the entry into force of such provisions, and in substitution therefor, be bound by Articles 1 to 12 of the Lisbon Act,
- (ii) if Articles 13 to 17 do not enter into force on that date, such country shall, during the interim period before the entry into force of such provisions, and in substitution therefor, be bound by Articles 13 and 14(3), (4), and (5), of the Lisbon Act.

If a country indicates a subsequent date in its instrument of accession, this Act shall enter into force with respect to that country on the date thus indicated.

(b) With respect to any country outside the Union which deposits its instrument of accession on a date which is subsequent to, or precedes by less than one month, the entry into force of one group of Articles of the present Act, this Act shall, subject to the proviso of subparagraph (a), enter into force three months after the date on which its accession has been notified by the Director General, unless a subsequent date has been indicated in the instrument of accession. In the latter case, this Act shall enter into force with respect to that country on the date thus indicated.

(3) With respect to any country outside the Union which deposits its instrument of accession after the date of entry into force of the present Act in its entirety, or less than one month before such date, this Act shall enter into force three months after the date on which

its accession has been notified by the Director General, unless a subsequent date has been indicated in the instrument of accession. In the latter case, this Act shall enter into force with respect to that country on the date thus indicated.

(a) This Article, regarding the accession to the Stockholm Act of States which before were not members of the Union and dealing further with the entry into force of the Stockholm Act with respect to those States, was introduced into the Convention by the Revision Conference of Stockholm in 1967. It replaces, with important modifications, Article 16 of the earlier texts.

(b) As has been observed above—see observation (b) on Article 20—States which were not party to the Convention before its revision at Stockholm in 1967 cannot have signed the Stockholm Act and therefore cannot ratify it, but they may accede to it. As further observed—see observation (b) on Article 1, paragraph (1)—the Convention does not provide any procedure for the admission of new members to the Union. However, reference must be made to Article 25, which declares that it should be understood that, at the time a country deposits its instrument of ratification or accession, it will be in a position under its domestic law to give effect to the provisions of the Convention, and which further states that any such country also undertakes to adopt, in accordance with its constitution, the measures necessary to ensure the application of the Convention.

(c) This provision parallels the second sentence of Article 20(1)(a) regarding member States of the Union (see, above, observation (d) on Article 20).

(d) States which were not previously members of the Union may accede to the Stockholm Act only in its entirety: they are not allowed to exclude certain groups of Articles from their accession. However, since member States of the Union may, when ratifying or acceding to the Stockholm Act, exclude certain groups of Articles, the entry into force of the Stockholm Act may be only partial, or may be partial at first.

It has therefore been necessary to give special rules for the entry into force of the Stockholm Act with respect to States outside the Union, which, although they are not allowed to exclude certain groups of Articles from their accession, may be faced with the effect of such exclusion by member States of the Union.

In these rules a distinction has been made between: (i) States outside the Union which deposit their instrument of accession one month or more *before* the entry into force of *any* provisions of the Stockholm Act (Article 21(2)(a)), (ii) States outside the Union which deposit their instrument of accession *after*, or *less than one month before*, *one group of Articles* of the Stockholm Act has entered into force (Article 21(2)(b)), and (iii) States outside the Union which deposit their instrument of accession *after the date of entry into force of the Stockholm Act in its entirety* (Article 21(3)).

The effects of accession in these three cases are described in the provisions referred to.

In the first case, the State concerned must "wait" until the initial entry into force of the Stockholm Act takes place before it becomes bound by that Act. When, afterwards, the Stockholm Act enters into force, the State concerned will (unless it has indicated a subsequent date) immediately be bound by it but, if the Stockholm Act does not then enter into force with respect to a certain group of Articles, such State will, in the interim period before the entry into force of the said provisions, be bound by the corresponding Articles of the Lisbon Act.

In the second case, the acceding State will be *bound by the same Acts* of Stockholm and possibly of Lisbon, but only *three months after the date on which its accession has been notified* by the Director General to the other member States, unless a subsequent date has been indicated in the instrument of accession.

In the third case, the acceding State will be *bound by the entire Stockholm Act* but as from the same *dates* as indicated in the preceding paragraph.

An additional observation may be made regarding territories (colonies, protectorates, etc.) to which the Convention was applied by virtue of Article 16*bis* of the Acts of Washington (1911), The Hague (1925), London (1934) and Lisbon (1958)—the Article which has become, in modified form, Article 24 of the Stockholm Act—but which since then *have obtained their independence as States*. It has already been observed above—see observation (d) on Article 1, paragraph (1)—that in such cases the new State is no longer bound by treaties applying to it in its former dependent status, unless it expressly accedes to these treaties. With respect to the Paris Convention, these States, desiring not to interrupt the application of the Convention, have often not limited themselves to a *new accession*, but have made a *declaration confirming membership* or a *declaration of continuity*, or the said

*declaration combined with accession in the normal form.*¹ Such declarations mean that according to the country concerned the Convention has not ceased to be applicable, as regards that country, between the date of its independence and its subsequent accession.

With respect to the new State, such declaration may be considered to be an accession with retroactive effect from the date of its independence. Although the Convention does not provide for this procedure, it may be accepted with respect to States to which the Convention already applied, because uninterrupted application of the Convention is in the interest of all member States, for example, with respect to the right of priority—see, above, observation (g) on Article 4. Section A—and many other provisions of the Convention.

Declarations as referred to may also be made with regard to accession to the Stockholm Act. Their effect will be that the formerly applicable Act or Acts of the Convention will apply retroactively, whereas the Stockholm Act will apply according to the provisions of Article 21.

¹ See, for example, the declarations of Indonesia, *P.I.*, 1950, p. 222; the Ivory Coast, the Central African Republic, Chad, Upper Volta and Laos, *I.P.*, 1963, p. 214; the Malagasy Republic and Senegal, *I.P.*, 1963, p. 234; Gabon, *I.P.*, 1964, p. 23; Cameroon, *I.P.*, 1964, p. 66; Niger, *I.P.*, 1964, p. 118; Trinidad and Tobago, *I.P.*, 1964, p. 139; Southern Rhodesia, *I.P.*, 1965, p. 43; Zambia, *I.P.*, 1965, p. 43; Malawi, *I.P.*, 1965, p. 239; Mauritania, *I.P.*, 1965, p. 43; Dahomey, *I.P.*, 1966, p. 270; Togo, *I.P.*, 1967, p. 196. See also U.N. document A/CN.4/200/Add.1.

ARTICLE 22^(a)

Subject to the possibilities of exceptions provided for in Articles 20(1)(b) and 28(2), ratification or accession shall automatically entail acceptance of all the clauses and admission to all the advantages of this Act (b).

(a) This Article existed in essence in the original text of the Convention of 1883.¹ It related then, however, only to States newly adhering to the Union. The provision was maintained by the Revision Conferences until that of Stockholm in 1967. This latter Conference made the provision also applicable to States already members of the Union which ratify or accede to the Stockholm Act, and introduced a reservation regarding Articles 20(1)(b) and 28(2).

(b) The purpose of the Article is to *exclude*, with two exceptions, *all possibility of making reservations* by a State which ratifies or accedes to the Stockholm Act. Apart from the two possible exceptions, ratification of or accession to that Act means that *all rights and obligations deriving from the Convention are automatically accepted*. The only exceptions are that, according to Article 20(1)(b), *States already members of the Union* may, as observed above, *exclude* from their ratification of or accession to the Stockholm Act *either Articles 1 to 12 or Articles 13 to 17*, whereas, according to Article 28(2), *any State, whether already a member of the Union or not*, may, when ratifying or acceding to the Stockholm Act, declare that it does not agree to be bound by *the jurisdictional clause of Article 28(1)*. This latter provision will be commented upon below.

¹ *Actes de Paris*, I, pp. 28 (proposal for Article 14), 122, 145/6 (adoption).

ARTICLE 23^(a)

After the entry into force of this Act in its entirety (b), a country (c) may not accede to earlier Acts of this Convention (d).

(a) This provision was introduced into the Convention by the Revision Conference of Stockholm in 1967. No such provision existed in earlier texts of the Convention, but since the Revision Conference of Washington in 1911 the Convention contained other provisions according to which the earlier Act or Acts remained in force between member States which had ratified or acceded to them but had not (yet) accomplished those acts regarding the most recent Act (see, for example, Article 18(4), (5) and (6) of the Lisbon Act, to be compared with Article 27(2)(a), (b) and (c) of the Stockholm Act). These provisions were traditionally¹ interpreted as meaning that earlier Acts of the Convention remained in force *only* for the purpose indicated and could not be independently acceded to after a more recent Act of the Convention had entered into force.

The Article under consideration was inserted in the Stockholm Act in order to confirm this tradition and to avoid future controversies.²

It must be observed, however, that if, in the conditions referred to in the Article, a State accedes to the Stockholm Act, this does not mean that it will not be bound to other States, members of the Union, which have not yet ratified or acceded to the Stockholm Act but are bound by earlier Acts of the Convention (see, for this question, observation (e) on Article 1(1), above, and also the commentary on Article 27, below). This is because the States party to the Convention have constituted a *Union* embodied in successive Acts of the Convention, as a consequence of which a State can only enter (and leave) *the Union as a whole* and must always be *bound*—albeit possibly by different Acts of the Convention—to *all other member States*.³

(b) The provision under consideration applies only after the entry into force of the Stockholm Act *in its entirety*, and not when it has entered into force with the exception of one of the groups of Articles

¹ Although not without exceptions. See LACINA: "The Problem of Conventional Relations between Countries according to the different Texts of the Paris Convention," *I.P.*, 1966, p. 259.

² See document S/3 prepared for the Stockholm Conference, p. 50, paragraph 152.

³ Report of Main Committee IV of the Stockholm Conference, *I.P.*, 1967, p. 222, paragraph 17.

referred to in Article 20(1)(b)(i) and (ii). In the latter case, countries may still accede to the Lisbon Act.

(c) The provision applies both to States which are already members of the Union and to States newly adhering to it.

For the first category of States, this means that a member State which has not ratified or acceded to a more recent Act than that of The Hague (1925) or London (1934) may, under the conditions indicated, only ratify or accede to the Stockholm Act (1967) and not that of Lisbon (1958). The question which Act will govern the relations of such State with other member States will be examined below when considering Article 27.

With respect to the second category of States, the provision means that, under the conditions indicated, such State can only accede to the Stockholm Act and not to any earlier Act. See, for its relations with other member States, Article 27(3), to be examined below.

(d) In the past, some States acceded *not only* to the *most recent Act* of the Convention but to the *Convention as such, as it had been revised and with regard to all revisions still in force*.¹ In view of the Article under consideration, this practice may not be continued with regard to the Stockholm Act.² If it is continued, references in the instrument of ratification or accession to earlier Acts of the Convention will have to be disregarded. As has been said, the question *by which Acts* a State which ratifies or accedes to the Stockholm Act *will be bound*, or which Acts it will apply with regard to other member States of the Union, will be examined below when considering Article 27.

¹ See, for example, the accession of U.S.S.R., *I.P.*, 1965, p. 74; of Uganda, *I.P.*, 1965, p. 98; of Algeria, *I.P.*, 1965, p. 239.

² See document S/3 prepared for the Stockholm Conference, p. 51: proposal for Article 16*quater*, corrected by document S/3 corr. 1; the latter proposal was adopted by the Conference.

ARTICLE 24^(a)

(1) Any country may declare in its instrument of ratification or accession, or may inform the Director General by written notification any time thereafter, that this Convention shall be applicable to all or part of those territories, designated in the declaration or notification, for the external relations of which it is responsible (b).

(2) Any country which has made such a declaration or given such a notification may, at any time, notify the Director General that this Convention shall cease to be applicable to all or part of such territories (c).

(3)(a) Any declaration made under paragraph (1) shall take effect on the same date as the ratification or accession in the instrument of which it was included, and any notification given under such paragraph shall take effect three months after its notification by the Director General.

(b) Any notification given under paragraph (2) shall take effect twelve months after its receipt by the Director General.

(a) Provisions enabling member States to accede to the Convention also on behalf of their colonies and other dependent territories were introduced into the Convention by the Revision Conference of Washington in 1911.¹ These provisions then constituted Article 16*bis* of the Convention, an Article which was only modified on matters of detail by the subsequent Revision Conferences of The Hague (1925), London (1934) and Lisbon (1958). The Revision Conference of Stockholm in 1967, in declaring the Article applicable to territories for the external relations of which a State is responsible, adapted the provision to contemporary terminology; the Stockholm Conference also modified the Article in the light of the new administrative system adopted at that Conference.

(b) A declaration making the Convention applicable to designated territories will have a twofold effect. On the one hand, after such declaration takes effect, nationals of member States of the Union,

¹ *Actes de Washington*, pp. 57, 68, 208 (proposals), 221/2 (observations), 311 (report to Plenary Committee), 256/7 (discussion in Third Plenary Session), 260 (discussion and adoption in Fourth Plenary Session).

and those assimilated to such nationals, will be able to claim application of the Convention in such territories; on the other hand, nationals of those territories and persons who are assimilated to such nationals by Article 3 of the Convention may claim application of the Convention in all other member States (see also, above, observation (b) on Article 2(1)).

(c) This provision and the remaining provisions of the Article under consideration are self-explanatory.

ARTICLE 25^(a)

(1) Any country party to this Convention undertakes to adopt, in accordance with its constitution, the measures necessary to ensure the application of this Convention (b).

(2) It is understood that, at the time a country deposits its instrument of ratification or accession, it will be in a position under its domestic law to give effect to the provisions of this Convention (c).

(a) The original text of the Convention of 1883 contained a provision (Article 17), according to which the carrying out of the reciprocal engagements contained in the Convention was subject, as far as necessary, to the observance of the formalities and rules established by the constitutional laws of the member States. To this was added the provision that member States were bound to procure the application of these engagements, which they undertook to do "with as little delay as possible."¹ This provision underwent only slight changes as to form during subsequent Revision Conferences until that of Lisbon in 1958. At that Conference it was replaced² by what is now, unaltered, with the exception of minor changes as to form, Article 25 of the Stockholm text.

(b) It is obvious that the Convention would not achieve its purpose if the member States did not carry out the obligations which they accepted in acceding to the Convention. These obligations may differ according to the constitutional system of the State concerned.

If such State accepts the "self-executing" character of certain provisions of the Convention—see, above, Chapter II.3 and II.4—its administrative and judicial authorities will have to apply those provisions directly. Moreover, such State will be obliged to adopt and maintain legislation in conformity with the Convention on all points where the Convention requires such legislation and it will also have to carry out its obligations in the administrative field.

A State which according to its constitution or constitutional system cannot accept the "self-executing" character of provisions of an international convention is under the obligation to introduce provisions

¹ *Actes de Paris*, I, pp. 145/6 (adoption: the Acts do not show how the provision came into being).

² *Actes de Lisbonne*, pp. 292 (proposal of U.S.A. and discussion in First Committee), 304 (report of First Committee), 109 (adoption in Second Plenary Session), 120 (General Report).

to the same effect in its domestic legislation, while its further obligations are the same as indicated above.

In practice, there have been several instances where a member State did not, or at least did not for some time, comply with its obligations under the Convention, particularly because it maintained legislation which was not in conformity with the Convention.

Article 17 of the Convention, as it stood from the time of its origin until the Revision Conference of Lisbon in 1958, did not permit a very strong reaction against such practices because, referring first to the observance of formalities and rules established by the constitutional laws of the member States, the Article declared that those States were only bound to apply the Convention "with as little delay as possible."

This was changed by the introduction of the new Article 17 (now Article 25) by the Revision Conference of Lisbon.

Under this provision, the first obligation for any member State is to adopt, in accordance with its constitution, *the measures necessary to ensure the application of the Convention*. Such measures will be, in the first place, the *legislative* measures necessary to carry out the obligations of the Convention and, in the second place, the *administrative* measures necessary in connexion with such legislation or with provisions of the Convention which are considered "self-executing" in the State concerned.

(c) The second obligation imposed upon any member State by the Article under consideration relates to the *moment of its ratification of or accession to the Convention*. It must then be in a position, *under its domestic law*, to give effect to the provisions of the Convention, which means that at that time all measures referred to above under observation (b) *must already have been taken*. This provision has sometimes been violated by member States but until the Revision Conference of Stockholm in 1967 no organ existed to establish formally such violation. The Stockholm Conference has changed this situation by introducing into the Convention Article 28 concerning disputes between member States regarding the interpretation or application of the Convention. This jurisdictional clause binds any member State, unless it declares, at the time of signature or ratification of, or accession to, the Stockholm Act that it does not consider itself bound by it. It will enable States which are bound by it to bring before the International Court of Justice cases where a member State does not comply with Article 25 of the Convention, now under consideration, unless negotiations or other methods of settlement bring about such compliance.

ARTICLE 26^(a)

(1) This Convention shall remain in force without limitation as to time (b).

(2) Any country may denounce this Act by notification addressed to the Director General (c). Such denunciation shall constitute also denunciation of all earlier Acts (d) and shall affect only the country making it, the Convention remaining in full force and effect as regards the other countries of the Union (e).

(3) Denunciation shall take effect one year after the day on which the Director General has received the notification (f).

(4) The right of denunciation provided by this Article shall not be exercised by any country before the expiration of five years from the date upon which it becomes a member of the Union (g).

(a) This Article partly maintains provisions on the duration of the Convention, and the possibility and effect of denunciation of it by a member State, which were already in the original text of the Convention of 1883 (then Article 18 but, since the Revision Conference of Washington, Article 17bis). The Revision Conference of Stockholm in 1967 introduced several modifications which will be commented upon below.

(b) The principle that the Convention is concluded for an *indefinite duration* and that possible denunciations by member States will affect only such States and not the other member States as regards which the Convention will remain in full force has been included in the Convention since its origin.

(c) Denunciations have to be addressed to the depositary of the Convention. Until the Revision Conference of Stockholm in 1967 this was the Government of the Swiss Confederation; according to the Stockholm Act, and in conformity with the adopted changes in the administrative system, it will be the Director General of WIPO.

(d) As has already been observed several times—see observation (e) on Article 1(1) and observation (a) on Article 23—one of the effects of the legal construction of the Paris Convention as a treaty whose member States constitute a Union is that States can only enter and leave the Union *as a whole*. It is therefore not possible for a member

State to denounce, for example, the most recent Act of the Convention, or any earlier Act, and to remain bound by other Acts. If a State denounces the Stockholm Act, this will constitute also denunciation of all earlier Acts.

(e) See observation (b) above.

(f) Several other communications by States, provided for under the Stockholm text of the Convention, will take effect after their notification by the Director General of WIPO (see, for example, Articles 20(2)(c), 21(2)(b) and (3), 24(3)(a)). However, denunciations will take effect one year after the day on which the Director General has received the relevant notification because the effect of a denunciation must not be retarded by the delay involved in its transmission to other countries. See also, for an analogous situation, Article 24(3)(b), and, further, Articles 17(3) and 30(2).

(g) This provision was added to the Article under consideration by the Revision Conference of Stockholm in 1967 in order to prevent hasty decisions as to denunciation of the Convention by States which have not belonged to the Union for a sufficiently long time to have experience to rely on.¹ It is to be noted that the period of five years is counted not from the ratification of or accession to the Stockholm Act but from the date on which the State concerned has become a member of the Union (through accession to any of the successive Acts of the Convention).

¹ See document S/3 prepared for the Stockholm Conference, p. 54, paragraph 162.

ARTICLE 27^(a)

(1) The present Act shall, as regards the relations between the countries to which it applies, and to the extent that it applies, replace the Convention of Paris of March 20, 1883, and the subsequent Acts of revision (b).

(2)(a) As regards the countries to which the present Act does not apply, or does not apply in its entirety, but to which the Lisbon Act of October 31, 1958, applies, the latter shall remain in force in its entirety or to the extent that the present Act does not replace it by virtue of paragraph (1)^(c).

(b) Similarly, as regards the countries to which neither the present Act, nor portions thereof, nor the Lisbon Act applies, the London Act of June 2, 1934, shall remain in force in its entirety or to the extent that the present Act does not replace it by virtue of paragraph (1).

(c) Similarly, as regards the countries to which neither the present Act, nor portions thereof, nor the Lisbon Act, nor the London Act applies, the Hague Act of November 6, 1925, shall remain in force in its entirety or to the extent that the present Act does not replace it by virtue of paragraph (1).

(3) Countries outside the Union which become party to this Act shall apply it with respect to any country of the Union not party to this Act or which, although party to this Act, has made a declaration pursuant to Article 20(1)(b)(i). Such countries recognize that the said country of the Union may apply, in its relations with them, the provisions of the most recent Act to which it is party (d).

(a) This Article deals with the application of earlier Acts of the Convention after the Stockholm Act has—wholly or partly—entered into force and until the moment when all member States will have ratified or acceded to the Stockholm Act in its entirety. With respect to such application of earlier Acts, the Stockholm Act has maintained the system which was introduced into the Convention by the Revision Conference of Washington in 1911¹ and was continued, with the necessary adaptations, by the subsequent Revision Conferences.²

¹ *Actes de Washington*, pp. 232 (proposal for Article 27bis), 311 (report to Plenary Committee), 260/1 (adoption in Fourth Plenary Session).

² *Actes de La Haye*, pp. 266 (proposals), 424 (report of First Sub-Committee); 526 (report of General Committee), 549/50 (report of Drafting Committee), 581 (adoption in Second Plenary Session); *Actes de Londres*, pp. 474 (report of Drafting Committee), 519 (adoption in Second Plenary Session); *Actes de Lisbonne*, p. 109 (discussion and adoption in Second Plenary Session).

However, the Stockholm Act has introduced modifications, first of all because it had to take into account the fact that, in view of Article 20(1)(b), it may enter into force only partially, that is, to the exclusion of a certain group of Articles, and secondly when it added an important provision (Article 27(3)) concerning the application of Acts of the Convention by, and in relation to, a State which was not a member of the Union before acceding to the Stockholm Act.

(b) This provision prescribes that relations between States to which the Stockholm Act applies, because they have ratified it or acceded to it, will be *exclusively governed by the Stockholm Act*, which *replaces*, as far as those relations are concerned, *all earlier Acts*. If, however, such State has excluded from its ratification or accession either Articles 1 to 12 or 13 to 17 of the Stockholm Act, only the other Articles of the Stockholm Act will apply, whereas Articles replaced by the excluded Articles will continue to apply according to the other paragraphs of the Article under consideration.

(c) Paragraphs 2(a)(b) and (c) of this Article maintain, with the exception that they also take into account the possibility of partial entry into force of the Stockholm Act, the system regarding the application of earlier Acts of the Convention adopted by the Revision Conference of Washington (1911) and continued by subsequent Revision Conferences. Unfortunately, although this system raises several questions,¹ it was not explained or commented upon during any of those Conferences. The Revision Conference of Stockholm in 1967 has clarified the situation to some extent, because it was observed there² that a distinction must be made between *accession* to earlier Acts of the Convention and *application* of such Acts, whereas a new provision (Article 27(3)) was adopted regarding the application of Acts of the Convention by, and in relation to, a State which would accede to the Convention without having previously been a member of the Union.

Taking into account those developments, the situation with regard to the application of earlier Acts of the Convention may be described as follows.

¹ See, for the situation before the Revision Conference of Stockholm in 1967: "A propos de l'application simultanée des textes successifs de la Convention d'Union," *P.I.*, 1936, p. 99, and LACINA: "The Problem of Conventional Relations between Countries according to the different Texts of the Paris Convention," *I.P.*, 1966, p. 257. See also *BIRPI Lecture Course on Industrial Property*, 1965, p. 11.

² Report of Main Committee IV of the Stockholm Conference, *I.P.*, 1967, p. 222, paragraph 18.

With respect to States which *were not members of the Union before they acceded to the Stockholm Act*, Article 27(3) will apply. Such States will apply the Stockholm Act not only, of course, with respect to member States which have already ratified or acceded to that Act, but also with respect to member States which have *not* yet ratified or acceded to the Stockholm Act or which have ratified or acceded to that Act *to the exclusion of Articles 1 to 12 thereof*. Although the provision does not say so, the same solution will apply with respect to member States which have ratified or acceded to the Stockholm Act *to the exclusion of Articles 13 to 17 thereof*: such States will continue to be bound by the old administrative system, but the newly acceding State will only be bound by the new administrative system of the Stockholm Act.

On the other hand, the newly acceding State will have to recognize that *any other member State of the Union may* apply, in its relations to that State, the provisions of *the most recent Act to which it is party*. The word "may" indicates that such other member State *may also apply*, in its relations with a newly acceding State, the Stockholm Act; although it has not yet *acceded* to that Act, it may apply it,¹ and the newly acceding State cannot complain because the Stockholm Act is precisely the Act which it has accepted.

The situation is more complicated with respect to States which *were already members of the Union* before they ratified or acceded to the Stockholm Act (to the possible exclusion of one of the groups of Articles 1 to 12 or 13 to 17).

Such States will, of course, apply the Stockholm Act (to the extent that they have accepted it) with respect to all other States which have (and to the extent that they have) accepted the Stockholm Act.

With respect to States which have not done so (or to the extent that they have not done so) the Article under consideration specifies (paragraphs (2)(a), (b) and (c)) that *earlier Acts of the Convention remain in force*.

Nevertheless, a member State which has ratified or acceded to the Stockholm Act *may also apply* it—and may wish to do so because it has modified its domestic legislation accordingly—to member States which have not yet ratified or acceded to that Act. This is so, because there is no reason why a member State of the Union should not be *allowed* to do what a newly acceding State *must* do. The first-mentioned member State *may* however also apply, with respect to any other

¹ This concerns the part of the Convention dealing with substantive law, the application of administrative provisions being regulated in Article 30, paragraph (2).

member State, *the most recent common Act*, and will in any case have to accept that *such other member State will apply*, with regard to it, *the most recent common Act* which according to the provision under examination has remained in force.

But what if there is *no such most recent common Act*, for example, because one member State ratifies the Stockholm Act after having acceded only to the Lisbon Act (1958), whereas another member State has not ratified or acceded to a more recent Act than that of London (1934) or The Hague (1925)? In such case, the member State which has ratified or acceded to the Stockholm Act may still apply that Act in its relations with the other State. It may, however, also apply, although it is not formally *bound by it*, the most recent Act to which the other member State is party, which is all that the other State may claim, not having ratified or acceded to more recent Acts. The State which has ratified or acceded to the Stockholm Act will in any case have to accept that any other member State will apply the most recent Act to which it is party and which has remained in force according to paragraphs (2)(a), (b) and (c) of the Article under consideration.

In view of the uncertainties left by this Article, a declaration by member States regarding the Acts they consider applicable in certain situations¹ will be most useful.

(d) As has been observed, this provision applies only to States which *were not members of the Union* until they acceded to the Stockholm Act. The provision has already been commented upon above.

¹ Cf. Report of Main Committee IV of the Stockholm Conference, *I.P.*, 1967, p. 222, paragraph 18, which, however, erroneously refers to newly acceding States, which are bound by Article 27(3) and therefore cannot make such declaration.

ARTICLE 28^(a)

(1) Any dispute between two or more countries of the Union concerning the interpretation or application of this Convention, not settled by negotiation, may, by any one of the countries concerned, be brought before the International Court of Justice by application in conformity with the Statute of the Court, unless the countries concerned agree on some other method of settlement (b). The country bringing the dispute before the Court shall inform the International Bureau; the International Bureau shall bring the matter to the attention of the other countries of the Union (c).

(2) Each country may, at the time it signs this Act or deposits its instrument of ratification or accession, declare that it does not consider itself bound by the provisions of paragraph (1). With regard to any dispute between such country and any other country of the Union, the provisions of paragraph (1) shall not apply (d).

(3) Any country having made a declaration in accordance with the provisions of paragraph (2) may, at any time, withdraw its declaration by notification addressed to the Director General (e).

(a) This Article, containing a jurisdictional clause, which may however be subject to a declaration of non-acceptance, was introduced into the Convention by the Revision Conference of Stockholm in 1967. Earlier attempts to introduce such a clause, made at the Revision Conferences of The Hague (1925), London (1934) and Lisbon (1958), had failed.¹

(b) The provision grants competence to the International Court of Justice to decide on any *dispute between two or more member States* concerning the *interpretation or application* of the Convention unless, of course, such dispute is settled by negotiation or the States concerned agree on some other method of settlement, for example, by way of international arbitration. Such dispute may be brought before the International Court by application in conformity with the Statute of the Court. This Court, established at The Hague (Netherlands), consists of

¹ *Actes de La Haye*, pp. 353/4 (proposal of U.K.), 420/4 (report of First Sub-Committee); *Actes de Londres*, p. 293 (proposals of Mexico, Netherlands and Switzerland; see also pp. 162/4 for an intended proposal of the International Bureau), 349/51 (report of First Sub-Committee), 472/3 (report of Drafting Committee); *Actes de Lisbonne*, pp. 192/8 (proposal), 199/201 (observations), 202 (discussion in First Committee), 300/1 (report of First Committee).

fifteen members, elected for nine years by the General Assembly and by the Security Council of the United Nations. The Court may be supplemented by judges of the nationality of the litigating parties. It is declared competent to deal with all cases which the parties refer to it and all matters specially provided for in treaties and conventions in force (Article 36, paragraph 1, of the Statute of the Court). *Only States may be parties in cases before the Court* (Article 34, paragraph 1, of its Statute).

(c) It is provided that the *State bringing* a dispute before the Court *must inform the International Bureau*. The Court itself may, subject to and in conformity with its Rules, request of public international organizations, such as WIPO, information relevant to a case before it and it will receive such information presented by such organizations on their own initiative. Moreover, whenever the construction of a convention (such as the Paris Convention) is in question in a case before the Court, the international organization concerned will receive copies of all the written proceedings at the Court (Article 34, paragraphs 2 and 3, of its Statute).

In the provision under consideration, it is further provided that the *International Bureau* will bring a dispute before the Court *to the attention of the other member States of the Union*. This will enable any such State which considers that it has an interest of a legal nature which may be affected by the decision in the case to submit a request to the Court to be permitted to intervene (Article 62 of the Statute). Whenever the construction of a convention in which States other than those concerned in the case are parties is in question, such States have a *right* to intervene, but, if they do so, the construction given by the judgment will be binding upon them (Article 63 of the Statute).

(d) As has already been observed above—see observation (b) on Article 22—the Stockholm Act of the Convention allows States to make reservations, that is, to exclude the application of provisions of the Convention, only on two points. One of these is the applicability of the jurisdictional clause. Any State may at the time of its signature¹ or ratification of, or accession to, the Stockholm Act declare that it does not consider itself bound by the jurisdictional clause, in which case the clause will not apply between such State and any other member State.

(e) A declaration concerning non-applicability of the jurisdictional clause may at any time be withdrawn. The provision is self-explanatory.

¹ The following States made this reservation at the time of their signature of the Stockholm Act (cf. *I.P.*, 1968, p. 33): Algeria, Bulgaria, Indonesia, Poland, Rumania and U.S.S.R.

ARTICLE 29^(a)

(1)(a) This Act shall be signed in a single copy in the French language and shall be deposited with the Government of Sweden (b).

(b) Official texts shall be established by the Director General, after consultation with the interested Governments, in the English, German, Italian, Portuguese, Russian and Spanish languages, and such other languages as the Assembly may designate (c).

(c) In case of differences of opinion on the interpretation of the various texts, the French text shall prevail (d).

(2) This Act shall remain open for signature at Stockholm until January 13, 1968 (e).

(3) The Director General shall transmit two copies, certified by the Government of Sweden, of the signed text of this Act to the Governments of all countries of the Union and, on request, to the Government of any other country (f).

(4) The Director General shall register this Act with the Secretariat of the United Nations (g).

(5) The Director General shall notify the Governments of all countries of the Union of signatures, deposits of instruments of ratification or accession and any declarations included in such instruments or made pursuant to Article 20(1)(c), entry into force of any provisions of this Act, notifications of denunciation, and notifications pursuant to Article 24(h).

(a) Since the Revision Conference of Washington in 1911 the Convention has contained (in Article 19) provisions concerning the signature of each successive Act and the communication of certified copies of those Acts to member States. The Revision Conference of Lisbon in 1958 introduced into this Article additional provisions concerning the languages of the official copy of the Act and of translations thereof. Those provisions were modified and adapted to the new administrative system by the Revision Conference of Stockholm to form what is now Article 29 of the Convention.

(b) The Stockholm Act has maintained the former system according to which there is *only one signed copy* of the Convention, as revised, and that Act is established *in the French language*.

(c) Whereas the Lisbon Act made provision, apart from the signed copy of the Act in French, for official *translations* of that Act in several other languages, the Stockholm Act prescribes that official *texts*—not mere translations—shall be established in such other languages. The status of texts in other languages has thereby been improved.

(d) However, since several texts in different languages may lead to different interpretations, it is also provided that in case of such differences the French text shall prevail.

(e) As in the case of the Lisbon Act, the Stockholm Act remained open for a period during which it could still be signed after the Revision Conference had closed, so that the Governments of member States could still reflect on the desirability of signing. At the closing date, January 13, 1968, the Stockholm Act had been signed by 46 member States.¹

(f) This provision is self-explanatory.

(g) This provision implements an obligation existing under Article 102, paragraph 1, of the Charter of the United Nations, which provides that “every treaty and every international agreement entered into by any Member of the United Nations after the present [U. N.] Charter comes into force shall as soon as possible be registered with the Secretariat [of the U. N.] and published by it.”

(h) This provision is again self-explanatory.

¹ See *I.P.*, 1968, p. 33.

ARTICLE 30^(a)

(1) Until the first Director General assumes office, references in this Act to the International Bureau of the Organization or to the Director General shall be deemed to be references to the Bureau of the Union or its Director, respectively (b).

(2) Countries of the Union not bound by Articles 13 to 17 may, until five years after the entry into force of the Convention establishing the Organization, exercise, if they so desire, the rights provided under Articles 13 to 17 of this Act as if they were bound by those Articles. Any country desiring to exercise such rights shall give written notification to that effect to the Director General; such notification shall be effective from the date of its receipt. Such countries shall be deemed to be members of the Assembly until the expiration of the said period (c).

(3) As long as all the countries of the Union have not become Members of the Organization, the International Bureau of the Organization shall also function as the Bureau of the Union, and the Director General as the Director of the said Bureau (d).

(4) Once all the countries of the Union have become Members of the Organization, the rights, obligations, and property, of the Bureau of the Union shall devolve on the International Bureau of the Organization (e).

(a) This Article, containing transitional provisions, was introduced into the Convention by the Revision Conference of Stockholm in 1967. This was necessary in view of the important modifications of the administrative provisions of the Convention adopted by that Conference. The first three paragraphs of the Article deal with three different periods and also with different questions.¹

Paragraph (1) concerns the period which will elapse until such time as the first Director General of WIPO assumes office and it deals, for that period, with references made in the Act to the said Director General or to the International Bureau of the said Organization.

Paragraph (2) relates to a period of five years after the entry into force of the WIPO Convention and deals with the possibility open to

¹ See document S/3 prepared for the Stockholm Conference, p. 58, paragraph 173.

member States to exercise, during that period, the rights provided by the new administrative system.

Paragraph (3) concerns the period which will end when all member States of the Union have also become Members of WIPO and deals with the functioning of the International Bureau and its head during that period, while paragraph (4) provides for certain consequences which will follow the expiration of the said period.

For all those provisions reference must be made to the close relationship envisaged between the Paris Union and WIPO (see, above, observation (a) on Article 13).

(b) Until the first Director General has assumed office, references made in the Stockholm Act to the International Bureau of Intellectual Property established by the WIPO Convention, or to its Director General, must be understood as references to BIRPI and its Director.¹ Examples of the application of this provision will include the transmittal of copies of the Stockholm Act to Governments (Article 29(3)) and the notifications to be made pursuant to Article 29(5). Those tasks have been assigned by the Stockholm Act to the Director General but, as long as there is no Director General, the said tasks will be carried out by the Director of BIRPI.

(c) Paragraph (2) of the Article under consideration will allow—during a period of five years after the entry into force of the WIPO Convention, entry into force which will complete the new administrative provisions of the Paris Convention—all member States which have not yet accepted the new administrative system embodied in Articles 13 to 17 to exercise, if they so desire, the rights provided under the said Articles as if they were bound by them. This possibility has been provided because the WIPO Convention, as well as the Stockholm Act of the Paris Convention, will enter into force after ratification or accession by comparatively few States and in such circumstances the organs of those Conventions, which would be composed only of the said States, would not have a sufficiently representative character. That is why, during this period, other member States of the Union will also be allowed, if they so desire, to vote in the Assembly, to be elected as members of the Executive Committee, to vote in the Executive Committee and to exercise all the other rights provided in Articles 13 to 17 (see also Article 21(2) of the WIPO Convention). The States which,

¹ See document S/3 prepared for the Stockholm Conference, p. 58, paragraph 174.

at the expiration of the five-year period, are still not bound by Articles 13 to 17 will lose those rights at the end of the fifth year.¹ See also observation (c) on Article 14 above.

(d) As long as there are member States of the Paris Union which are not Members of WIPO, the administrative organ must have a dual identity (see also Article 21(3) of the WIPO Convention): it will function at the same time as BIRPI, supervised by the Swiss Government, and as the International Bureau of Intellectual Property, established by the WIPO Convention and defined in Article 15(1)(a) of the Stockholm Act of the Paris Convention, controlled by the organs of both Conventions. As was explained to the Stockholm Conference, no procedural difficulties are expected in this respect.²

(e) This provision is self-explanatory.

¹ See document S/3 prepared for the Stockholm Conference, p. 58, paragraph 175.

² *Ibidem*, p. 58, paragraph 176; see also the rectification in document S/3 corr.2.

IV

**PARIS CONVENTION
FOR THE PROTECTION
OF INDUSTRIAL PROPERTY ¹**

of March 20, 1883,

as revised

at BRUSSELS on December 14, 1900, at WASHINGTON on June 2, 1911,
at THE HAGUE on November 6, 1925, at LONDON on June 2, 1934,
at LISBON on October 31, 1958,
and at STOCKHOLM on July 14, 1967

Article 1

[Establishment of the Union; Scope of Industrial Property] ²

(1) The countries to which this Convention applies constitute a Union for the protection of industrial property.

(2) The protection of industrial property has as its object patents, utility models, industrial designs, trademarks, service marks, trade names, indications of source or appellations of origin, and the repression of unfair competition.

(3) Industrial property shall be understood in the broadest sense and shall apply not only to industry and commerce proper, but likewise to agricultural and extractive industries and to all manufactured or natural products, for example, wines, grain, tobacco leaf, fruit, cattle, minerals, mineral waters, beer, flowers, and flour.

(4) Patents shall include the various kinds of industrial patents recognized by the laws of the countries of the Union, such as patents of importation, patents of improvement, patents and certificates of addition, etc.

Article 2

[National Treatment for Nationals of Countries of the Union]

(1) Nationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of

¹ Official English text established under Article 29(1)(b).

² Articles have been given titles to facilitate their identification. There are no titles in the signed (French) text.

the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals; all without prejudice to the rights specially provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with.

(2) However, no requirement as to domicile or establishment in the country where protection is claimed may be imposed upon nationals of countries of the Union for the enjoyment of any industrial property rights.

(3) The provisions of the laws of each of the countries of the Union relating to judicial and administrative procedure and to jurisdiction, and to the designation of an address for service or the appointment of an agent, which may be required by the laws on industrial property are expressly reserved.

Article 3

[Same Treatment for Certain Categories of Persons as for Nationals of Countries of the Union]

Nationals of countries outside the Union who are domiciled or who have real and effective industrial or commercial establishments in the territory of one of the countries of the Union shall be treated in the same manner as nationals of the countries of the Union.

Article 4

[A to I. *Patents, Utility Models, Industrial Designs, Marks, Inventors' Certificates*: Right of Priority. — G. *Patents*: Division of the Application]

A(1) Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

(2) Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority.

(3) By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application.

B. Consequently, any subsequent filing in any of the other countries of the Union before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, the putting on sale of copies of the design, or the use of the mark, and such acts cannot give rise to any third-party right or any right of personal possession. Rights acquired by third parties before the date of the first application that serves as the basis for the right of priority are reserved in accordance with the domestic legislation of each country of the Union.

C(1) The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks.

(2) These periods shall start from the date of filing of the first application ; the day of filing shall not be included in the period.

(3) If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

(4) A subsequent application concerning the same subject as a previous first application within the meaning of paragraph (2), above, filed in the same country of the Union, shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, if, at the time of filing the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

D(1) Any person desiring to take advantage of the priority of a previous filing shall be required to make a declaration indicating the date of such filing and the country in which it was made. Each country shall determine the latest date on which such declaration must be made.

(2) These particulars shall be mentioned in the publications issued by the competent authority, and in particular in the patents and the specifications relating thereto.

(3) The countries of the Union may require any person making a declaration of priority to produce a copy of the application (description, drawings, etc.) previously filed. The copy, certified as correct by the authority which received such application, shall not require any authen-

tication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation.

(4) No other formalities may be required for the declaration of priority at the time of filing the application. Each country of the Union shall determine the consequences of failure to comply with the formalities prescribed by this Article, but such consequences shall in no case go beyond the loss of the right of priority.

(5) Subsequently, further proof may be required.

Any person who avails himself of the priority of a previous application shall be required to specify the number of that application; this number shall be published as provided for by paragraph (2), above.

E(1) Where an industrial design is filed in a country by virtue of a right of priority based on the filing of a utility model, the period of priority shall be the same as that fixed for industrial designs.

(2) Furthermore, it is permissible to file a utility model in a country by virtue of a right of priority based on the filing of a patent application, and vice versa.

F. No country of the Union may refuse a priority or a patent application on the ground that the applicant claims multiple priorities, even if they originate in different countries, or on the ground that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed, provided that, in both cases, there is unity of invention within the meaning of the law of the country.

With respect to the elements not included in the application or applications whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions.

G(1) If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.

(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized.

H. Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements.

I(1) Applications for inventors' certificates filed in a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate shall give rise to the right of priority provided for by this Article, under the same conditions and with the same effects as applications for patents.

(2) In a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate, an applicant for an inventor's certificate shall, in accordance with the provisions of this Article relating to patent applications, enjoy a right of priority based on an application for a patent, a utility model, or an inventor's certificate.

Article 4bis

[*Patents: Independence of Patents Obtained for the Same Invention in Different Countries*]

(1) Patents applied for in the various countries of the Union by nationals of countries of the Union shall be independent of patents obtained for the same invention in other countries, whether members of the Union or not.

(2) The foregoing provision is to be understood in an unrestricted sense, in particular, in the sense that patents applied for during the period of priority are independent, both as regards the grounds for nullity and forfeiture, and as regards their normal duration.

(3) The provision shall apply to all patents existing at the time when it comes into effect.

(4) Similarly, it shall apply, in the case of the accession of new countries, to patents in existence on either side at the time of accession.

(5) Patents obtained with the benefit of priority shall, in the various countries of the Union, have a duration equal to that which they would have, had they been applied for or granted without the benefit of priority.

Article 4ter

[*Patents: Mention of the Inventor in the Patent*]

The inventor shall have the right to be mentioned as such in the patent.

Article 4^{quater}

[*Patents: Patentability in Case of Restrictions of Sale by Law*]

The grant of a patent shall not be refused and a patent shall not be invalidated on the ground that the sale of the patented product or of a product obtained by means of a patented process is subject to restrictions or limitations resulting from the domestic law.

Article 5

[A. *Patents: Importation of Articles; Failure to Work or Insufficient Working; Compulsory Licenses.* — B. *Industrial Designs: Failure to Work; Importation of Articles.* — C. *Marks: Failure to Use; Different Forms; Use by Co-proprietors.* — D. *Patents, Utility Models, Marks, Industrial Designs: Marking*]

A(1) Importation by the patentee into the country where the patent has been granted of articles manufactured in any of the countries of the Union shall not entail forfeiture of the patent.

(2) Each country of the Union shall have the right to take legislative measures providing for the grant of compulsory licenses to prevent the abuses which might result from the exercise of the exclusive rights conferred by the patent, for example, failure to work.

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

(4) A compulsory license may not be applied for on the ground of failure to work or insufficient working before the expiration of a period of four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period expires last; it shall be refused if the patentee justifies his inaction by legitimate reasons. Such a compulsory license shall be non-exclusive and shall not be transferable, even in the form of the grant of a sub-license, except with that part of the enterprise or goodwill which exploits such license.

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

B. The protection of industrial designs shall not, under any circumstance, be subject to any forfeiture, either by reason of failure to work or by reason of the importation of articles corresponding to those which are protected.

C(1) If, in any country, use of the registered mark is compulsory, the registration may be cancelled only after a reasonable period, and then only if the person concerned does not justify his inaction.

(2) Use of a trademark by the proprietor in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered in one of the countries of the Union shall not entail invalidation of the registration and shall not diminish the protection granted to the mark.

(3) Concurrent use of the same mark on identical or similar goods by industrial or commercial establishments considered as co-proprietors of the mark according to the provisions of the domestic law of the country where protection is claimed shall not prevent registration or diminish in any way the protection granted to the said mark in any country of the Union, provided that such use does not result in misleading the public and is not contrary to the public interest.

D. No indication or mention of the patent, of the utility model, of the registration of the trademark, or of the deposit of the industrial design, shall be required upon the goods as a condition of recognition of the right to protection.

Article 5bis

[*All Industrial Property Rights* : Period of Grace for the Payment of Fees for the Maintenance of Rights ; *Patents* : Restoration]

(1) A period of grace of not less than six months shall be allowed for the payment of the fees prescribed for the maintenance of industrial property rights, subject, if the domestic legislation so provides, to the payment of a surcharge.

(2) The countries of the Union shall have the right to provide for the restoration of patents which have lapsed by reason of non-payment of fees.

Article 5ter

[*Patents* : Patented Devices Forming Part of Vessels, Aircraft, or Land Vehicles]

In any country of the Union the following shall not be considered as infringements of the rights of a patentee :

- 1.** the use on board vessels of other countries of the Union of devices forming the subject of his patent in the body of the vessel, in the machinery, tackle, gear and other accessories,

- when such vessels temporarily or accidentally enter the waters of the said country, provided that such devices are used there exclusively for the needs of the vessel ;
2. the use of devices forming the subject of the patent in the construction or operation of aircraft or land vehicles of other countries of the Union, or of accessories of such aircraft or land vehicles, when those aircraft or land vehicles temporarily or accidentally enter the said country.

Article 5^{quater}

[*Patents: Importation of Products Manufactured by a Process Patented in the Importing Country*]

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

Article 5^{quinquies}

[*Industrial Designs*]

Industrial designs shall be protected in all the countries of the Union.

Article 6

[*Marks: Conditions of Registration ; Independence of Protection of Same Mark in Different Countries*]

(1) The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation.

(2) However, an application for the registration of a mark filed by a national of a country of the Union in any country of the Union may not be refused, nor may a registration be invalidated, on the ground that filing, registration, or renewal, has not been effected in the country of origin.

(3) A mark duly registered in a country of the Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin.

Article 6bis

[Marks : Well-Known Marks]

(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

(2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

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

Article 6ter

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

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

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

(c) No country of the Union shall be required to apply the provisions of subparagraph (b), above, to the prejudice of the owners of rights acquired in good faith before the entry into force, in that country, of this Convention. The countries of the Union shall not be required

to apply the said provisions when the use or registration referred to in subparagraph (a), above, is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization.

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

(3)(a) For the application of these provisions, the countries of the Union agree to communicate reciprocally, through the intermediary of the International Bureau, the list of State emblems, and official signs and hallmarks indicating control and warranty, which they desire, or may hereafter desire, to place wholly or within certain limits under the protection of this Article, and all subsequent modifications of such list. Each country of the Union shall in due course make available to the public the lists so communicated.

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

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

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

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

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

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

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

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

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

Article 6*quater*

[Marks: Assignment of Marks]

(1) When, in accordance with the law of a country of the Union, the assignment of a mark is valid only if it takes place at the same time as the transfer of the business or goodwill to which the mark belongs, it shall suffice for the recognition of such validity that the portion of the business or goodwill located in that country be transferred to the assignee, together with the exclusive right to manufacture in the said country, or to sell therein, the goods bearing the mark assigned.

(2) The foregoing provision does not impose upon the countries of the Union any obligation to regard as valid the assignment of any mark the use of which by the assignee would, in fact, be of such a nature as to mislead the public, particularly as regards the origin, nature, or essential qualities, of the goods to which the mark is applied.

Article 6*quinquies*

[Marks: Protection of Marks Registered in One Country of the Union
in the Other Countries of the Union]

A(1) Every trademark duly registered in the country of origin shall be accepted for filing and protected as is in the other countries of the Union, subject to the reservation indicated in this Article. Such countries may, before proceeding to final registration, require the production of a certificate of registration in the country of origin,

issued by the competent authority. No authentication shall be required for this certificate.

(2) Shall be considered the country of origin the country of the Union where the applicant has a real and effective industrial or commercial establishment, or, if he has no such establishment within the Union, the country of the Union where he has his domicile, or, if he has no domicile within the Union but is a national of a country of the Union, the country of which he is a national.

B. Trademarks covered by this Article may be neither denied registration nor invalidated except in the following cases :

1. when they are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed ;
2. when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed ;
3. when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public. It is understood that a mark may not be considered contrary to public order for the sole reason that it does not conform to a provision of the legislation on marks, except if such provision itself relates to public order.

This provision is subject, however, to the application of Article 10*bis*.

C(1) In determining whether a mark is eligible for protection, all the factual circumstances must be taken into consideration, particularly the length of time the mark has been in use.

(2) No trademark shall be refused in the other countries of the Union for the sole reason that it differs from the mark protected in the country of origin only in respect of elements that do not alter its distinctive character and do not affect its identity in the form in which it has been registered in the said country of origin.

D. No person may benefit from the provisions of this Article if the mark for which he claims protection is not registered in the country of origin.

E. However, in no case shall the renewal of the registration of the mark in the country of origin involve an obligation to renew the

registration in the other countries of the Union in which the mark has been registered.

F. The benefit of priority shall remain unaffected for applications for the registration of marks filed within the period fixed by Article 4, even if registration in the country of origin is effected after the expiration of such period.

Article 6sexies

[Marks: Service Marks]

The countries of the Union undertake to protect service marks. They shall not be required to provide for the registration of such marks.

Article 6septies

[Marks: Registration in the Name of the Agent or Representative of the Proprietor Without the Latter's Authorization]

(1) If the agent or representative of the person who is the proprietor of a mark in one of the countries of the Union applies, without such proprietor's authorization, for the registration of the mark in his own name, in one or more countries of the Union, the proprietor shall be entitled to oppose the registration applied for or demand its cancellation or, if the law of the country so allows, the assignment in his favor of the said registration, unless such agent or representative justifies his action.

(2) The proprietor of the mark shall, subject to the provisions of paragraph (1), above, be entitled to oppose the use of his mark by his agent or representative if he has not authorized such use.

(3) Domestic legislation may provide an equitable time limit within which the proprietor of a mark must exercise the rights provided for in this Article.

Article 7

[Marks: Nature of the Goods to which the Mark is Applied]

The nature of the goods to which a trademark is to be applied shall in no case form an obstacle to the registration of the mark.

Article 7bis

[Marks: Collective Marks]

(1) The countries of the Union undertake to accept for filing and to protect collective marks belonging to associations the existence of

which is not contrary to the law of the country of origin, even if such associations do not possess an industrial or commercial establishment.

(2) Each country shall be the judge of the particular conditions under which a collective mark shall be protected and may refuse protection if the mark is contrary to the public interest.

(3) Nevertheless, the protection of these marks shall not be refused to any association the existence of which is not contrary to the law of the country of origin, on the ground that such association is not established in the country where protection is sought or is not constituted according to the law of the latter country.

Article 8

[Trade Names]

A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark.

Article 9

[Marks, Trade Names : Seizure, on Importation, etc., of Goods Unlawfully Bearing a Mark or Trade Name]

(1) All goods unlawfully bearing a trademark or trade name shall be seized on importation into those countries of the Union where such mark or trade name is entitled to legal protection.

(2) Seizure shall likewise be effected in the country where the unlawful affixation occurred or in the country into which the goods were imported.

(3) Seizure shall take place at the request of the public prosecutor, or any other competent authority, or any interested party, whether a natural person or a legal entity, in conformity with the domestic legislation of each country.

(4) The authorities shall not be bound to effect seizure of goods in transit.

(5) If the legislation of a country does not permit seizure on importation, seizure shall be replaced by prohibition of importation or by seizure inside the country.

(6) If the legislation of a country permits neither seizure on importation nor prohibition of importation nor seizure inside the country, then, until such time as the legislation is modified accordingly, these measures shall be replaced by the actions and remedies available in such cases to nationals under the law of such country.

Article 10

[*False Indications : Seizure, on Importation, etc., of Goods Bearing False Indications as to their Source or the Identity of the Producer*]

(1) The provisions of the preceding Article shall apply in cases of direct or indirect use of a false indication of the source of the goods or the identity of the producer, manufacturer, or merchant.

(2) Any producer, manufacturer, or merchant, whether a natural person or a legal entity, engaged in the production or manufacture of or trade in such goods and established either in the locality falsely indicated as the source, or in the region where such locality is situated, or in the country falsely indicated, or in the country where the false indication of source is used, shall in any case be deemed an interested party.

Article 10bis

[*Unfair Competition*]

(1) The countries of the Union are bound to assure to nationals of such countries effective protection against unfair competition.

(2) Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition.

(3) The following in particular shall be prohibited :

1. all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor ;
2. false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor ;
3. indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.

Article 10ter

[*Marks, Trade Names, False Indications, Unfair Competition : Remedies, Right to Sue*]

(1) The countries of the Union undertake to assure to nationals of the other countries of the Union appropriate legal remedies effectively to repress all the acts referred to in Articles 9, 10, and 10bis.

(2) They undertake, further, to provide measures to permit federations and associations representing interested industrialists, producers, or merchants, provided that the existence of such federations and associations is not contrary to the laws of their countries, to take action in the courts or before the administrative authorities, with a view to the repression of the acts referred to in Articles 9, 10, and 10*bis*, in so far as the law of the country in which protection is claimed allows such action by federations and associations of that country.

Article 11

[Inventions, Utility Models, Industrial Designs, Marks: Temporary Protection at Certain International Exhibitions]

(1) The countries of the Union shall, in conformity with their domestic legislation, grant temporary protection to patentable inventions, utility models, industrial designs, and trademarks, in respect of goods exhibited at official or officially recognized international exhibitions held in the territory of any of them.

(2) Such temporary protection shall not extend the periods provided by Article 4. If, later, the right of priority is invoked, the authorities of any country may provide that the period shall start from the date of introduction of the goods into the exhibition.

(3) Each country may require, as proof of the identity of the article exhibited and of the date of its introduction, such documentary evidence as it considers necessary.

Article 12

[Special National Industrial Property Services]

(1) Each country of the Union undertakes to establish a special industrial property service and a central office for the communication to the public of patents, utility models, industrial designs, and trademarks.

(2) This service shall publish an official periodical journal. It shall publish regularly:

- (a) the names of the proprietors of patents granted, with a brief designation of the inventions patented;
- (b) the reproductions of registered trademarks.

Article 13

[Assembly of the Union]

(1)(a) The Union shall have an Assembly consisting of those countries of the Union which are bound by Articles 13 to 17.

(b) The Government of each country shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.

(c) The expenses of each delegation shall be borne by the Government which has appointed it.

(2)(a) The Assembly shall :

- (i) deal with all matters concerning the maintenance and development of the Union and the implementation of this Convention ;
- (ii) give directions concerning the preparation for conferences of revision to the International Bureau of Intellectual Property (hereinafter designated as "the International Bureau") referred to in the Convention establishing the World Intellectual Property Organization (hereinafter designated as "the Organization"), due account being taken of any comments made by those countries of the Union which are not bound by Articles 13 to 17 ;
- (iii) review and approve the reports and activities of the Director General of the Organization concerning the Union, and give him all necessary instructions concerning matters within the competence of the Union ;
- (iv) elect the members of the Executive Committee of the Assembly ;
- (v) review and approve the reports and activities of its Executive Committee, and give instructions to such Committee ;
- (vi) determine the program and adopt the triennial budget of the Union, and approve its final accounts ;
- (vii) adopt the financial regulations of the Union ;
- (viii) establish such committees of experts and working groups as it deems appropriate to achieve the objectives of the Union ;
- (ix) determine which countries not members of the Union and which intergovernmental and international non-governmental organizations shall be admitted to its meetings as observers ;
- (x) adopt amendments to Articles 13 to 17 ;
- (xi) take any other appropriate action designed to further the objectives of the Union ;
- (xii) perform such other functions as are appropriate under this Convention ;
- (xiii) subject to its acceptance, exercise such rights as are given to it in the Convention establishing the Organization.

(b) With respect to matters which are of interest also to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization.

(3)(a) Subject to the provisions of subparagraph (b), a delegate may represent one country only.

(b) Countries of the Union grouped under the terms of a special agreement in a common office possessing for each of them the character of a special national service of industrial property as referred to in Article 12 may be jointly represented during discussions by one of their number.

(4)(a) Each country member of the Assembly shall have one vote.

(b) One-half of the countries members of the Assembly shall constitute a quorum.

(c) Notwithstanding the provisions of subparagraph (b), if, in any session, the number of countries represented is less than one-half but equal to or more than one-third of the countries members of the Assembly, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the countries members of the Assembly which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiration of this period, the number of countries having thus expressed their vote or abstention attains the number of countries which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

(d) Subject to the provisions of Article 17(2), the decisions of the Assembly shall require two-thirds of the votes cast.

(e) Abstentions shall not be considered as votes.

(5)(a) Subject to the provisions of subparagraph (b), a delegate may vote in the name of one country only.

(b) The countries of the Union referred to in paragraph (3)(b) shall, as a general rule, endeavor to send their own delegations to the sessions of the Assembly. If, however, for exceptional reasons, any such country cannot send its own delegation, it may give to the delegation of another such country the power to vote in its name, provided that each delegation may vote by proxy for one country only. Such power to vote shall be granted in a document signed by the Head of State or the competent Minister.

(6) Countries of the Union not members of the Assembly shall be admitted to the meetings of the latter as observers.

(7)(a) The Assembly shall meet once in every third calendar year in ordinary session upon convocation by the Director General

and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization.

(b) The Assembly shall meet in extraordinary session upon convocation by the Director General, at the request of the Executive Committee or at the request of one-fourth of the countries members of the Assembly.

(8) The Assembly shall adopt its own rules of procedure.

Article 14

[Executive Committee]

(1) The Assembly shall have an Executive Committee.

(2)(a) The Executive Committee shall consist of countries elected by the Assembly from among countries members of the Assembly. Furthermore, the country on whose territory the Organization has its headquarters shall, subject to the provisions of Article 16(7)(b), have an ex officio seat on the Committee.

(b) The Government of each country member of the Executive Committee shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.

(c) The expenses of each delegation shall be borne by the Government which has appointed it.

(3) The number of countries members of the Executive Committee shall correspond to one-fourth of the number of countries members of the Assembly. In establishing the number of seats to be filled, remainders after division by four shall be disregarded.

(4) In electing the members of the Executive Committee, the Assembly shall have due regard to an equitable geographical distribution and to the need for countries party to the Special Agreements established in relation with the Union to be among the countries constituting the Executive Committee.

(5)(a) Each member of the Executive Committee shall serve from the close of the session of the Assembly which elected it to the close of the next ordinary session of the Assembly.

(b) Members of the Executive Committee may be re-elected, but only up to a maximum of two-thirds of such members.

(c) The Assembly shall establish the details of the rules governing the election and possible re-election of the members of the Executive Committee.

(6)(a) The Executive Committee shall :

- (i) prepare the draft agenda of the Assembly ;**
- (ii) submit proposals to the Assembly in respect of the draft program and triennial budget of the Union prepared by the Director General ;**
- (iii) approve, within the limits of the program and the triennial budget, the specific yearly budgets and programs prepared by the Director General ;**
- (iv) submit, with appropriate comments, to the Assembly the periodical reports of the Director General and the yearly audit reports on the accounts ;**
- (v) take all necessary measures to ensure the execution of the program of the Union by the Director General, in accordance with the decisions of the Assembly and having regard to circumstances arising between two ordinary sessions of the Assembly ;**
- (vi) perform such other functions as are allocated to it under this Convention.**

(b) With respect to matters which are of interest also to other Unions administered by the Organization, the Executive Committee shall make its decisions after having heard the advice of the Coordination Committee of the Organization.

(7)(a) The Executive Committee shall meet once a year in ordinary session upon convocation by the Director General, preferably during the same period and at the same place as the Coordination Committee of the Organization.

(b) The Executive Committee shall meet in extraordinary session upon convocation by the Director General, either on his own initiative, or at the request of its Chairman or one-fourth of its members.

(8)(a) Each country member of the Executive Committee shall have one vote.

(b) One-half of the members of the Executive Committee shall constitute a quorum.

(c) Decisions shall be made by a simple majority of the votes cast.

(d) Abstentions shall not be considered as votes.

(e) A delegate may represent, and vote in the name of, one country only.

(9) Countries of the Union not members of the Executive Committee shall be admitted to its meetings as observers.

(10) The Executive Committee shall adopt its own rules of procedure.

Article 15

[International Bureau]

(1)(a) Administrative tasks concerning the Union shall be performed by the International Bureau, which is a continuation of the Bureau of the Union united with the Bureau of the Union established by the International Convention for the Protection of Literary and Artistic Works.

(b) In particular, the International Bureau shall provide the secretariat of the various organs of the Union.

(c) The Director General of the Organization shall be the chief executive of the Union and shall represent the Union.

(2) The International Bureau shall assemble and publish information concerning the protection of industrial property. Each country of the Union shall promptly communicate to the International Bureau all new laws and official texts concerning the protection of industrial property. Furthermore, it shall furnish the International Bureau with all the publications of its industrial property service of direct concern to the protection of industrial property which the International Bureau may find useful in its work.

(3) The International Bureau shall publish a monthly periodical.

(4) The International Bureau shall, on request, furnish any country of the Union with information on matters concerning the protection of industrial property.

(5) The International Bureau shall conduct studies, and shall provide services, designed to facilitate the protection of industrial property.

(6) The Director General and any staff member designated by him shall participate, without the right to vote, in all meetings of the Assembly, the Executive Committee, and any other committee of experts or working group. The Director General, or a staff member designated by him, shall be ex officio secretary of these bodies.

(7)(a) The International Bureau shall, in accordance with the directions of the Assembly and in cooperation with the Executive Committee, make the preparations for the conferences of revision of the provisions of the Convention other than Articles 13 to 17.

(b) The International Bureau may consult with intergovernmental and international non-governmental organizations concerning preparations for conferences of revision.

(c) The Director General and persons designated by him shall take part, without the right to vote, in the discussions at these conferences.

(8) The International Bureau shall carry out any other tasks assigned to it.

Article 16

[Finances]

(1)(a) The Union shall have a budget.

(b) The budget of the Union shall include the income and expenses proper to the Union, its contribution to the budget of expenses common to the Unions, and, where applicable, the sum made available to the budget of the Conference of the Organization.

(c) Expenses not attributable exclusively to the Union but also to one or more other Unions administered by the Organization shall be considered as expenses common to the Unions. The share of the Union in such common expenses shall be in proportion to the interest the Union has in them.

(2) The budget of the Union shall be established with due regard to the requirements of coordination with the budgets of the other Unions administered by the Organization.

(3) The budget of the Union shall be financed from the following sources :

- (i) contributions of the countries of the Union ;
- (ii) fees and charges due for services rendered by the International Bureau in relation to the Union ;
- (iii) sale of, or royalties on, the publications of the International Bureau concerning the Union ;
- (iv) gifts, bequests, and subventions ;
- (v) rents, interests, and other miscellaneous income.

(4)(a) For the purpose of establishing its contribution towards the budget, each country of the Union shall belong to a class, and shall pay its annual contributions on the basis of a number of units fixed as follows :

Class I	25
Class II	20
Class III	15
Class IV	10
Class V	5
Class VI	3
Class VII	1

(b) Unless it has already done so, each country shall indicate, concurrently with depositing its instrument of ratification or accession, the class to which it wishes to belong. Any country may change class. If it chooses a lower class, the country must announce such change to the Assembly at one of its ordinary sessions. Any such change shall

take effect at the beginning of the calendar year following the said session.

(c) The annual contribution of each country shall be an amount in the same proportion to the total sum to be contributed to the budget of the Union by all countries as the number of its units is to the total of the units of all contributing countries.

(d) Contributions shall become due on the first of January of each year.

(e) A country which is in arrears in the payment of its contributions may not exercise its right to vote in any of the organs of the Union of which it is a member if the amount of its arrears equals or exceeds the amount of the contributions due from it for the preceding two full years. However, any organ of the Union may allow such a country to continue to exercise its right to vote in that organ if, and as long as, it is satisfied that the delay in payment is due to exceptional and unavoidable circumstances.

(f) If the budget is not adopted before the beginning of a new financial period, it shall be at the same level as the budget of the previous year, as provided in the financial regulations.

(5) The amount of the fees and charges due for services rendered by the International Bureau in relation to the Union shall be established, and shall be reported to the Assembly and the Executive Committee, by the Director General.

(6)(a) The Union shall have a working capital fund which shall be constituted by a single payment made by each country of the Union. If the fund becomes insufficient, the Assembly shall decide to increase it.

(b) The amount of the initial payment of each country to the said fund or of its participation in the increase thereof shall be a proportion of the contribution of that country for the year in which the fund is established or the decision to increase it is made.

(c) The proportion and the terms of payment shall be fixed by the Assembly on the proposal of the Director General and after it has heard the advice of the Coordination Committee of the Organization.

(7)(a) In the headquarters agreement concluded with the country on the territory of which the Organization has its headquarters, it shall be provided that, whenever the working capital fund is insufficient, such country shall grant advances. The amount of these advances and the conditions on which they are granted shall be the subject of separate agreements, in each case, between such country and the Organization. As long as it remains under the obligation to grant advances, such country shall have an ex officio seat on the Executive Committee.

(b) The country referred to in subparagraph (a) and the Organization shall each have the right to denounce the obligation to grant advances, by written notification. Denunciation shall take effect three years after the end of the year in which it has been notified.

(8) The auditing of the accounts shall be effected by one or more of the countries of the Union or by external auditors, as provided in the financial regulations. They shall be designated, with their agreement, by the Assembly.

Article 17

[Amendment of Articles 13 to 17]

(1) Proposals for the amendment of Articles 13, 14, 15, 16, and the present Article, may be initiated by any country member of the Assembly, by the Executive Committee, or by the Director General. Such proposals shall be communicated by the Director General to the member countries of the Assembly at least six months in advance of their consideration by the Assembly.

(2) Amendments to the Articles referred to in paragraph (1) shall be adopted by the Assembly. Adoption shall require three-fourths of the votes cast, provided that any amendment to Article 13, and to the present paragraph, shall require four-fifths of the votes cast.

(3) Any amendment to the Articles referred to in paragraph (1) shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of the countries members of the Assembly at the time it adopted the amendment. Any amendment to the said Articles thus accepted shall bind all the countries which are members of the Assembly at the time the amendment enters into force, or which become members thereof at a subsequent date, provided that any amendment increasing the financial obligations of countries of the Union shall bind only those countries which have notified their acceptance of such amendment.

Article 18

[Revision of Articles 1 to 12 and 18 to 30]

(1) This Convention shall be submitted to revision with a view to the introduction of amendments designed to improve the system of the Union.

(2) For that purpose, conferences shall be held successively in one of the countries of the Union among the delegates of the said countries.

(3) Amendments to Articles 13 to 17 are governed by the provisions of Article 17.

Article 19

[Special Agreements]

It is understood that the countries of the Union reserve the right to make separately between themselves special agreements for the protection of industrial property, in so far as these agreements do not contravene the provisions of this Convention.

Article 20

[Ratification or Accession by Countries of the Union ; Entry Into Force]

(1)(a) Any country of the Union which has signed this Act may ratify it, and, if it has not signed it, may accede to it. Instruments of ratification and accession shall be deposited with the Director General.

(b) Any country of the Union may declare in its instrument of ratification or accession that its ratification or accession shall not apply :

- (i) to Articles 1 to 12, or
- (ii) to Articles 13 to 17.

(c) Any country of the Union which, in accordance with subparagraph (b), has excluded from the effects of its ratification or accession one of the two groups of Articles referred to in that subparagraph may at any later time declare that it extends the effects of its ratification or accession to that group of Articles. Such declaration shall be deposited with the Director General.

(2)(a) Articles 1 to 12 shall enter into force, with respect to the first ten countries of the Union which have deposited instruments of ratification or accession without making the declaration permitted under paragraph (1)(b)(i), three months after the deposit of the tenth such instrument of ratification or accession.

(b) Articles 13 to 17 shall enter into force, with respect to the first ten countries of the Union which have deposited instruments of ratification or accession without making the declaration permitted under paragraph (1)(b)(ii), three months after the deposit of the tenth such instrument of ratification or accession.

(c) Subject to the initial entry into force, pursuant to the provisions of subparagraphs (a) and (b), of each of the two groups of Articles referred to in paragraph (1)(b)(i) and (ii), and subject to the provisions

of paragraph (1)(b), Articles 1 to 17 shall, with respect to any country of the Union, other than those referred to in subparagraphs (a) and (b), which deposits an instrument of ratification or accession or any country of the Union which deposits a declaration pursuant to paragraph (1)(c), enter into force three months after the date of notification by the Director General of such deposit, unless a subsequent date has been indicated in the instrument or declaration deposited. In the latter case, this Act shall enter into force with respect to that country on the date thus indicated.

(3) With respect to any country of the Union which deposits an instrument of ratification or accession, Articles 18 to 30 shall enter into force on the earlier of the dates on which any of the groups of Articles referred to in paragraph (1)(b) enters into force with respect to that country pursuant to paragraph (2)(a), (b), or (c).

Article 21

[Accession by Countries Outside the Union ; Entry Into Force]

(1) Any country outside the Union may accede to this Act and thereby become a member of the Union. Instruments of accession shall be deposited with the Director General.

(2)(a) With respect to any country outside the Union which deposits its instrument of accession one month or more before the date of entry into force of any provisions of the present Act, this Act shall enter into force, unless a subsequent date has been indicated in the instrument of accession, on the date upon which provisions first enter into force pursuant to Article 20(2)(a) or (b) ; provided that :

- (i) if Articles 1 to 12 do not enter into force on that date, such country shall, during the interim period before the entry into force of such provisions, and in substitution therefor, be bound by Articles 1 to 12 of the Lisbon Act,
- (ii) if Articles 13 to 17 do not enter into force on that date, such country shall, during the interim period before the entry into force of such provisions, and in substitution therefor, be bound by Articles 13 and 14(3), (4), and (5), of the Lisbon Act.

If a country indicates a subsequent date in its instrument of accession, this Act shall enter into force with respect to that country on the date thus indicated.

(b) With respect to any country outside the Union which deposits its instrument of accession on a date which is subsequent to, or precedes by less than one month, the entry into force of one group of Articles

of the present Act, this Act shall, subject to the proviso of subparagraph (a), enter into force three months after the date on which its accession has been notified by the Director General, unless a subsequent date has been indicated in the instrument of accession. In the latter case, this Act shall enter into force with respect to that country on the date thus indicated.

(3) With respect to any country outside the Union which deposits its instrument of accession after the date of entry into force of the present Act in its entirety, or less than one month before such date, this Act shall enter into force three months after the date on which its accession has been notified by the Director General, unless a subsequent date has been indicated in the instrument of accession. In the latter case, this Act shall enter into force with respect to that country on the date thus indicated.

Article 22

[Consequences of Ratification or Accession]

Subject to the possibilities of exceptions provided for in Articles 20(1)(b) and 28(2), ratification or accession shall automatically entail acceptance of all the clauses and admission to all the advantages of this Act.

Article 23

[Accession to Earlier Acts]

After the entry into force of this Act in its entirety, a country may not accede to earlier Acts of this Convention.

Article 24

[Territories]

(1) Any country may declare in its instrument of ratification or accession, or may inform the Director General by written notification any time thereafter, that this Convention shall be applicable to all or part of those territories, designated in the declaration or notification, for the external relations of which it is responsible.

(2) Any country which has made such a declaration or given such a notification may, at any time, notify the Director General that this Convention shall cease to be applicable to all or part of such territories.

(3)(a) Any declaration made under paragraph (1) shall take effect on the same date as the ratification or accession in the instrument of which it was included, and any notification given under such paragraph

shall take effect three months after its notification by the Director General.

(b) Any notification given under paragraph (2) shall take effect twelve months after its receipt by the Director General.

Article 25

[Implementation of the Convention on the Domestic Level]

(1) Any country party to this Convention undertakes to adopt, in accordance with its constitution, the measures necessary to ensure the application of this Convention.

(2) It is understood that, at the time a country deposits its instrument of ratification or accession, it will be in a position under its domestic law to give effect to the provisions of this Convention.

Article 26

[Denunciation]

(1) This Convention shall remain in force without limitation as to time.

(2) Any country may denounce this Act by notification addressed to the Director General. Such denunciation shall constitute also denunciation of all earlier Acts and shall affect only the country making it, the Convention remaining in full force and effect as regards the other countries of the Union.

(3) Denunciation shall take effect one year after the day on which the Director General has received the notification.

(4) The right of denunciation provided by this Article shall not be exercised by any country before the expiration of five years from the date upon which it becomes a member of the Union.

Article 27

[Application of Earlier Acts]

(1) The present Act shall, as regards the relations between the countries to which it applies, and to the extent that it applies, replace the Convention of Paris of March 20, 1883, and the subsequent Acts of revision.

(2)(a) As regards the countries to which the present Act does not apply, or does not apply in its entirety, but to which the Lisbon Act of October 31, 1958, applies, the latter shall remain in force in its entirety or to the extent that the present Act does not replace it by virtue of paragraph (1).

(b) Similarly, as regards the countries to which neither the present Act, nor portions thereof, nor the Lisbon Act applies, the London Act of June 2, 1934, shall remain in force in its entirety or to the extent that the present Act does not replace it by virtue of paragraph (1).

(c) Similarly, as regards the countries to which neither the present Act, nor portions thereof, nor the Lisbon Act, nor the London Act applies, the Hague Act of November 6, 1925, shall remain in force in its entirety or to the extent that the present Act does not replace it by virtue of paragraph (1).

(3) Countries outside the Union which become party to this Act shall apply it with respect to any country of the Union not party to this Act or which, although party to this Act, has made a declaration pursuant to Article 20(1)(b)(i). Such countries recognize that the said country of the Union may apply, in its relations with them, the provisions of the most recent Act to which it is party.

Article 28

[Disputes]

(1) Any dispute between two or more countries of the Union concerning the interpretation or application of this Convention, not settled by negotiation, may, by any one of the countries concerned, be brought before the International Court of Justice by application in conformity with the Statute of the Court, unless the countries concerned agree on some other method of settlement. The country bringing the dispute before the Court shall inform the International Bureau; the International Bureau shall bring the matter to the attention of the other countries of the Union.

(2) Each country may, at the time it signs this Act or deposits its instrument of ratification or accession, declare that it does not consider itself bound by the provisions of paragraph (1). With regard to any dispute between such country and any other country of the Union, the provisions of paragraph (1) shall not apply.

(3) Any country having made a declaration in accordance with the provisions of paragraph (2) may, at any time, withdraw its declaration by notification addressed to the Director General.

Article 29

[Signature, Languages, Depositary Functions]

(1)(a) This Act shall be signed in a single copy in the French language and shall be deposited with the Government of Sweden.

(b) Official texts shall be established by the Director General, after consultation with the interested Governments, in the English, German, Italian, Portuguese, Russian and Spanish languages, and such other languages as the Assembly may designate.

(c) In case of differences of opinion on the interpretation of the various texts, the French text shall prevail.

(2) This Act shall remain open for signature at Stockholm until January 13, 1968.

(3) The Director General shall transmit two copies, certified by the Government of Sweden, of the signed text of this Act to the Governments of all countries of the Union and, on request, to the Government of any other country.

(4) The Director General shall register this Act with the Secretariat of the United Nations.

(5) The Director General shall notify the Governments of all countries of the Union of signatures, deposits of instruments of ratification or accession and any declarations included in such instruments or made pursuant to Article 20(1)(c), entry into force of any provisions of this Act, notifications of denunciation, and notifications pursuant to Article 24.

Article 30

[Transitional Provisions]

(1) Until the first Director General assumes office, references in this Act to the International Bureau of the Organization or to the Director General shall be deemed to be references to the Bureau of the Union or its Director, respectively.

(2) Countries of the Union not bound by Articles 13 to 17 may, until five years after the entry into force of the Convention establishing the Organization, exercise, if they so desire, the rights provided under Articles 13 to 17 of this Act as if they were bound by those Articles. Any country desiring to exercise such rights shall give written notification to that effect to the Director General; such notification shall be effective from the date of its receipt. Such countries shall be deemed to be members of the Assembly until the expiration of the said period.

(3) As long as all the countries of the Union have not become Members of the Organization, the International Bureau of the Organization shall also function as the Bureau of the Union, and the Director General as the Director of the said Bureau.

(4) Once all the countries of the Union have become Members of the Organization, the rights, obligations, and property, of the Bureau of the Union shall devolve on the International Bureau of the Organization.

V

MEMBER STATES
of the International Union for the Protection
of Industrial Property (Paris Union) as on April 1, 1968

Member States *	Date on which adhesion to the Union took effect	Latest Act by which the State is bound and date on which the ratification of or accession to such Act became effective
Algeria	March 1, 1966	Lisbon: March 1, 1966
Argentina	February 10, 1967	Lisbon: February 10, 1967
Australia	October 10, 1925	London: June 2, 1958
Austria	January 1, 1909	London: August 19, 1947
Belgium	July 7, 1884	Lisbon: August 21, 1965
Brazil	July 7, 1884	The Hague: October 26, 1929
Bulgaria	June 13, 1921	Lisbon: March 28, 1966
Cameroon	May 10, 1964	Lisbon: May 10, 1964
Canada	June 12, 1925	London: July 30, 1951
Central African Republic	November 19, 1963	Lisbon: November 19, 1963
Ceylon	December 29, 1952	London: December 29, 1952
Chad	November 19, 1963	Lisbon: November 19, 1963
Congo (Brazzaville)	September 2, 1963	Lisbon: September 2, 1963
Cuba	November 17, 1904	Lisbon: February 17, 1963
Cyprus	January 17, 1966	Lisbon: January 17, 1966
Czechoslovakia	October 5, 1919	Lisbon: January 4, 1962
Dahomey	January 10, 1967	Lisbon: January 10, 1967
Denmark	October 1, 1894	London: August 1, 1938
Dominican Republic	July 11, 1890	The Hague: April 6, 1951
Finland	September 20, 1921	London: May 30, 1953
France	July 7, 1884	Lisbon: January 4, 1962
Gabon	February 29, 1964	Lisbon: February 29, 1964
Germany (Federal Republic)	May 1, 1963	Lisbon: January 4, 1962
Greece	October 2, 1924	London: November 27, 1953
Haiti	July 1, 1958	Lisbon: January 4, 1962
Holy See	September 29, 1960	London: September 29, 1960
Hungary	January 1, 1909	Lisbon: March 23, 1967
Iceland	May 5, 1962	London: May 5, 1962
Indonesia	December 24, 1950	London: December 24, 1950
Iran	December 16, 1959	Lisbon: January 4, 1962

Member States *	Date on which adhesion to the Union took effect	Latest Act by which the State is bound and date on which the ratification of or accession to such Act became effective
Ireland	December 4, 1925	Lisbon: June 9, 1967
Israel	March 24, 1950	Lisbon: July 18, 1966
Italy	July 7, 1884	London: July 15, 1955
Ivory Coast	October 23, 1963	Lisbon: October 23, 1963
Japan	July 15, 1899	Lisbon: August 21, 1965
Kenya	June 14, 1965	Lisbon: June 14, 1965
Laos	November 19, 1963	Lisbon: November 19, 1963
Lebanon	September 1, 1924	London: September 30, 1947
Liechtenstein	July 14, 1933	London: January 28, 1951
Luxembourg	June 30, 1922	London: December 30, 1945
Madagascar	December 21, 1963	Lisbon: December 21, 1963
Malawi	July 6, 1964	Lisbon: July 6, 1964
Malta	October 20, 1967	Lisbon: October 20, 1967
Mauritania	April 11, 1965	Lisbon: April 11, 1965
Mexico	September 7, 1903	Lisbon: May 10, 1964
Monaco	April 29, 1956	Lisbon: January 4, 1962
Morocco	July 30, 1917	Lisbon: May 15, 1967
Netherlands	July 7, 1884	London: August 5, 1948
New Zealand	July 29, 1931	London: July 14, 1946
Niger	July 5, 1964	Lisbon: July 5, 1964
Nigeria	September 2, 1963	Lisbon: September 2, 1963
Norway	July 1, 1885	Lisbon: May 10, 1964
Philippines	September 27, 1965	Lisbon: September 27, 1965
Poland	November 10, 1919	The Hague: Nov. 22, 1931
Portugal	July 7, 1884	London: November 7, 1949
Rhodesia	April 6, 1965	Lisbon: April 6, 1965
Rumania	October 6, 1920	Lisbon: November 19, 1963
San Marino	March 4, 1960	London: March 4, 1960
Senegal	December 21, 1963	Lisbon: December 21, 1963
South Africa	December 1, 1947	Lisbon: April 17, 1965
Spain	July 7, 1884	London: March 2, 1956
Sweden	July 1, 1885	London: July 1, 1953
Switzerland	July 7, 1884	Lisbon: February 17, 1963
Syrian Arab Republic	September 1, 1924	London: September 30, 1947
Tanzania	June 16, 1963	Lisbon: June 16, 1963
Togo	September 10, 1967	Lisbon: September 10, 1967
Trinidad and Tobago	August 1, 1964	Lisbon: August 1, 1964
Tunisia	July 7, 1884	London: October 4, 1942
Turkey	October 10, 1925	London: June 27, 1957
Uganda	June 14, 1965	Lisbon: June 14, 1965

Member States *	Date on which adhesion to the Union took effect	Latest Act by which the State is bound and date on which the ratification of or accession to such Act became effective
Union of Soviet Socialist Republics	July 1, 1965	Lisbon: July 1, 1965
<i>United Arab Republic</i>	<i>July 1, 1951</i>	<i>London: July 1, 1951</i>
United Kingdom of Great Britain and Northern Ireland	July 7, 1884	Lisbon: January 4, 1962
United States of America	May 30, 1887	Lisbon: January 4, 1962
Upper Volta	November 19, 1963	Lisbon: November 19, 1963
Uruguay	March 18, 1967	Lisbon: March 18, 1967
<i>Viet-Nam</i>	<i>December 8, 1956</i>	<i>London: December 8, 1956</i>
Yugoslavia	February 26, 1921	Lisbon: April 11, 1965
Zambia	April 6, 1965	Lisbon: April 6, 1965

(Total: 79 States)

* Explanation of type:

Heavy type: States bound by the Lisbon Act (1958).

Italics: States bound by the London Act (1934).

Roman type: States bound by the Hague Act (1925).