HR 719

87TH CONGRESS 1st Session

HOUSE OF REPRESENTATIVES REPORT No. 719

PARIS CONVENTION ON PATENTS AND TRADEMARKS

JULY 13, 1961.----Referred to the House Calendar and ordered to be printed

Mr. LIBONATI, from the Committee on the Judiciary, submitted the following

REPORT

[To accompany H.R. 5754]

The Committee on the Judiciary, to whom was referred the bill (H.R. 5754) to carry into effect a provision of the Convention of Paris for the Protection of Industrial Property as revised at Lisbon, Portugal, October 31, 1958, having considered the same, report favorably thereon with amendments and recommend that the bill do pass.

The amendments are as follows:

Page 1, line 9, and page 2, line 12, strike out "a foreign country" and insert in lieu thereof "the same foreign country".

Page 2, line 24, after "filed" add "in the United States".

Page 2, line 25, after "revised" add "at the time of such filing".

EXPLANATION OF THE AMENDMENTS

Amendment No. 1 is a technical amendment to conform the language of the bill to language contained in article 4 of the Paris Convention as revised (1958 revision, Lisbon, Portugal).

Amendment No. 2 is clarifying in nature and makes certain that the applications referred to in section 3 of the bill are those "filed in the United States" and not applications filed "in a foreign country."

Amendment No. 3 confines the rights of applicants under section 3 to those benefits to which they are entitled under the Convention as it exists at the time of such filings.

PURPOSE AND STATEMENT

The purpose of the bill is to carry into effect a provision of the Convention of Paris for the Protection of Industrial Property as revised at Lisbon, Portugal, October 31, 1958.

The provisions of the Convention of Paris are not self--executing, and legislation is therefore needed to carry into effect any provision

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not already in our present law. The revised Convention makes quite a number of changes in detail over the previous revision of that instrument. However, with one exception, these changes are already provided for or taken care of by existing law in the United States. The one exception which requires a specific amendment of our Federal statutes is the subject matter of the instant bill. It relates to new paragraph 4 which has been added to article 4C of the Convention, and it

relates to the "right of priority" which applicants for patents and trademarks obtain under the international instrument.
Section 119 of title 35, United States Code, pursuant to the Convention of Paris, provides than an application for a patent filed in the United States by a person who has previously filed an application for a patent for the same invention in a foreign country, which affords similar privileges, shall have the same effect as if filed in this country on the date on which it was first filed in the foreign country. The instant bill, pursuant to the 1958 revision of the Convention of Paris, would grant the same priority rights with respect to a subsequent application filed in a foreign country if the first filed foreign application has been withdrawn, abandoned, or otherwise disposed of without leaving any rights outstanding. A similar change would be made in section 1126(d) of title 15, United States Code, which pertains to the revision of trademarks.
The amendments to our patent and trademark laws suggested by this bill closely follow the substance of subparagraph 4 of article 4C of the Convention of Paris as revised at Lisbon on October 31, 1958.

BACKGROUND OF CONVENTION OF PARIS
The committee wishes to point out that the Paris Convention----an international treaty----has reciprocal provisions, and American inventions are entitled to similar privileges when applications for them are made in foreign countries. The Convention, to which the United States is a party, applies to some 50 countries. These include all the countries of Europe except Russia, Albania, and Anderra: other members are Canada, Mexico, Cuba, Brazil, the United Arab Republic, Morocco, Union of South Africa, Israel, Turkey, Japan, Australia, New Zeland, and others. The treaty was first formed in 1883 and started with about a dozen countries. The United States adhered in 1887. Since 1883, the Convention or treaty has been revised at diplomatic conferences in 1900 (Brussels), 1911 (Washington), 1925 (The Hague), 1934 (London), and most recently in 1958 (Lisbon). Since each of these revisions is in effect a new treaty, each must go through the usual ratification procedures to come into effect, although most of the provisions of one revision are similar provisions of the proceding one. At the diplomatic conference at Lisbon in 1958 delegates from 40 member countries were present as well as delegates from 8 nonmember countries who were present as observers. Article 19 of the new treaty provides that it comes into force on June 1, 1963, between those countries which have by then ratified it and deposited the instruments of ratification with the Swiss Government. However, if at least six countries have ratified the treaty and deposited the ratification before that date, it will come into force earlier.
The U.S. Senate last year approved a resolution advising and consenting to the ratification of the instant revision of the Paris "Conven

tion." The Convention or treaty by its terms is not self--executing, however, and the Senate was advised by the Secretary of State that the ratification of the United States would not be deposited with the Swiss Government (which is needed for it to become effective) until after the instant legislation making the necessary changes in our domestic patent and trademark laws was enacted.
While the revision of Lisbon contains various changes over the earlier treaty, it so happens that with one exception all of the changes made are in consonance with U.S. law, and changes in our Federal statutes are not necessary. The only new provision in the revised treaty which needs

specific changes in our patent and trademark laws to harmonize these laws with the revision is a change relating to the so--called right of priority, which is the purpose of the instant bill and which is explained earlier in this report.

EXECUTIVE COMMUNICATIONS

This legislation is sponsored by the Department of Commerce, and has the approval of the Department of State. Representatives from both these agencies testified in support of this legislation before the committee. Also made a part of this report is "Statement of Need for and Purpose of the Proposed Legislation" prepared by the Department of Commerce.

THE SECRETARY OF COMMERCE.
Washington, D.C., March 17, 1961.

Hon. EMANUEL CELLER,
Chairman, Committee on the Judiciary, House of Representatives, Washington, D.C.

DEAR MR. CHAIRMAN: On January 17, 1961, before the present administration took office, the Department of Commerce submitted to the 87the Congress for introduction the following item of draft legislation to carry into effect a provision of the Convention of Paris for the Protection of Industrial Property as revised at Lisbon, Portugal, October 31, 1958.

The draft legislation was referred to your committee for consideration on January 18, 1961, by Executive Communication No. 367 but has not as yet been introduced.

You are advised that the Department has reexamined this item and we continue to support its enactment and urge that it be introduced.

The Bureau of the Budget has advised that there is no objection from the standpoint of the administration's program to our continued support of this draft legislation.

Sincerely yours, LUTHER H. HODGES,
Secretary of Commerce.

STATEMENT OF NEED FOR AND PURPOSE OF PROPOSED LEGISLATION

The International Convention for the Protection of Industrial Property, to which the United States has been a party since 1887, was revised on October 31, 1958, and the new convention has been submitted for ratification by the Senate (Congressional Record, Feb.

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17, 1960, pp. 2529--253). This convention is not self--executing and legislation would be required to carry into effect any provisions not already in our present law. Article 17 of the new convention also requires that the time an instrument of ratification is deposited the country must be in a position under its domestic law to give effect to its terms.

The revised convention makes quite a number of changes in detail over the previous revision of the instrument. However, most of these changes are already provided for or taken care of in one way or another by existing law in the United States. There is one change which would require a specific amendment to the statutes. This is new paragraph 4 which has been added to article 4C of the convention, relating to the right of priority.

According to article 4 of the Convention, if a person has regularly filed an application for a patent in one country and thereafter within 1 year files another application for patent for the same invention in another country, the second application is given as an effective filing date the date of filing the first application; in effect, the filing of an application for patent in one country constitutes a constructive filing of applications for patent for the same invention in all the other countries on the same date, which constructive filing is made actual in a particular country by the filing of a formal application in that country within 1 year of the date of filing of the first application. The period of priority is specified in article 4C as 1 year from the date of filing of the first application in the case of patent applications and 6 months in the case of trademark applications. This provision of the Convention is enacted in title 35, United States Code, section 119 in the case of patent applications and in title 15, United States Code, section 1126(d) in the case of trademark applications.

The revision of article 4C of the Convention provides that under certain exceptional circumstances the period of 1 year for the right of priority may start from a second or later filed application, instead of from the filing date of the first foreign application. The conditions under which this may be done are somewhat limited but the provision would be an advantage to American citizens filing abroad in some cases. Inasmuch as title 35, United States Code, section 119 and title 15, United States Code, section 1126(d) are both limited in language to the first foreign application, an amendment to these two sections is necessary. The proposed form of the amendment is merely the addition of a paragraph to the two sections mentioned, in language paralleling the language of the treaty.

DEPARTMENT OF STATE,
Washington, May 16, 1961.

Hon. EMANUEL CELLER,
Chairman, Committee on the Judiciary, House of Representatives.

DEAR MR. CHAIRMAN: In your letter of April 28, 1961, you advise the Department that Subcommittee No. 3 will conduct public hearings, May 18, 1961, on a bill (H.R. 5754) to carry into effect a provision of the Convention of Paris for the Protection of Industrial property as revised at Lisbon, Portugal, October 31, 1958, and suggest the "sub

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mission" of a statement for the record, if the Department does not plan to send a representative to testify.

The Department appreciates the invitation to provide a representative at these hearings to acquaint the subcommittee with its views on the bill. Although it does not plan to have a representative testify, the Department is strongly in favor of the bill and has prepared a statement of inclusion in the record supporting its enactment. The statement is enclosed.

Sincerely yours, BROOKS HAYS

Assistant Secretary
(For the Secretary of State).

DEPARTMENT OF STATE STATEMENT ON H.R. 5754

The Convention of Paris for the Protection of Industrial Property, to which H.R. 5754 pertains, is the major intergovernmental instrument assuring protection abroad of industrial property rights of U.S. nationals (patents, trademarks, designs, commercial names, and related rights). The Department also considers this Convention the most effective mechanism for insuring continuing and sound cooperative relations with other countries in the industrial property rights field. The Convention is based on two important principles; namely, "national treatment" and the extension of special rights or advantages. Under the "national treatment" principle each member country is required to extend to nationals of other member countries the same protection and rights which it grants to its own nationals in this field. Under the second principle each country is required to provide certain rights or special advantages for other members' nationals. One of the most important of these rights is the right of priority for foreign patent and trademark applicants. H.R. 5754 deals specifically with implementation of these right of priority provisions in the United States.

This Convention, to which the United States and approximately 50 other countries are parties, was originally adopted in 1883 and was revised 4 times (1900, 1911, 1925, and 1934) prior to the revision adopted at Lisbon in 1958. The changes which have been made over the years in these four revisions have strengthened and made more effective the patent and trademark protection afforded nationals of the member countries.

The United States became a party to the original convention and these four subsequent revisions. The Lisbon revision is not yet in force as between any countries. The Department believes, however, that this new revision is particularly significant and merits this Government's strong support because of the far-reaching improvements which it has provided for in the international industrial property field. One of the most important of these improvements relates to the establishment of machinery for interim meetings by the member governments between diplomatic conferences of revision to enable them to study and discuss more frequently than in the past problems arising under the Convention. In this connection, the revised Convention includes a provision

for regular triennial meetings of representatives of the member governments. Significant changes have also been effected by the Lisbon revision through a rewriting of the basic provisions in the Convention concerning the protection of trademarks. These have been rewritten in such a way so as to increase substantially the protection accorded for the trademark rights of nationals of member countries. Also for the first time specific reference to the protection of trademarks associated with services, as distinct from those used to identify goods, has been provided for in the new Convention revision.

The Lisbon revision of the Convention was transmitted to the Senate by the President on February 17, 1960

(S. Doc. Ex. D. 86th Cong. 2d sess.) and received the Senate's advice and consent to ratification on August 17, 1960. This new revision received strong support of the Department in testimony by Assistant Secretary of State for Economic Affairs, Mr. Edwin M. Martin, before the Senate Foreign Relations Committee, June 21, 1960. Leading business and professional groups in the United States interested in the industrial property rights field, such as the National Foreign Trade Council, the U.S. Council of the International Chamber of Commerce, and the Patent and Trademark Section of the American Bar Association, also wholeheartedly endorsed this new

revision. In fact, the Department is not aware of any business or professional group that is opposed to the United States becoming a party to this latest revision. Under the terms of article 17 of the Lisbon revision, this revision is not self--executing; that is, its ratification would not by itself modify our domestic law. This article specifies that at the time a country deposits its instrument of ratification it must be in a position under domestic law to give effect to the Convention's terms. Most of the changes embodied in the new revision do not require amendments to U.S. statutes since such changes are already consonant with our law. Only minor changes will be needed in the right of priority provisions of our patent and trademark laws in order fully to implement the new Convention. These changes would be effected with the enactment of H.R. 5754. The United States, therefore, will not be able to deposit its instrument of ratification until after enactment of the legislation embodied in H.R. 5754 which is designed to make these necessary changes in our patent and trademark laws.

The Department accordingly is strongly in favor of the enactment of H.R. 5754 at an early date since the legislation which it embodies is essential for ratification of the revised Convention and its entry into force as between the United States and other countries. Also, U.S. participation in the new revision will insure that our relations with the other member countries will continue on a sound basis in this important area of our foreign economic policy relating to the protection of industrial property rights. For these reasons the Department is strongly convinced that enactment of H.R. 5754 is most desirable and that it will be in the public

interest by fully implementing under our present laws the Industrial Property Convention as revised at Lisbon.

[Changes in existing law section OMITTED]