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Negotiating Group on Trade-Related Aspects of Intellectual Property Rights, including Trade in Counterfeit Goods

PROVISIONS OF EXISTING INTERNATIONAL CONVENTIONS PROVIDING PROTECTION FOR INTELLECTUAL PROPERTY

Communication from the WIPO Secretariat

At its fifth meeting, the Group authorised the Chairman to invite the WIPO Secretariat to prepare with respect to conventions administered by WIPO a factual statement providing a reference to provisions of existing international conventions providing protection for types of intellectual property included in MTN.GNG/NG11/W/12 (Section II, sub-paragraphs (i) through (vi)) (MTN.GNG/NG11/5, paragraph 37). In response, the WIPO Secretariat has provided the attached document.

Introduction

1. The present document has been prepared by the International Bureau of the World Intellectual Property Organization (WIPO) in response to an invitation received on December 2, 1987, from the Chairman of the Negotiating Group on Trade-Related Aspects of Intellectual Property Rights, including Trade in Counterfeit Goods. During its meeting of November 23 and 24, 1987, that Group had decided, inter alia, to:

> "1. Authorize the Chairman to invite the WIPO Secretariat:
>
> (A) to prepare with respect to conventions administered by WIPO a factual statement providing a reference to provisions of existing international conventions providing protection for types of intellectual property included in MTN.GNG/NG11/W/12 (Section II, sub-paragraphs (i) through (vi)).
>
> (B) to prepare the same kind of factual information as asked for in paragraph 1(A) as far as ongoing work in WIPO is concerned for updating the Note for the Chairman on "Activities in Other International Organizations of Possible Interest in Relation to Matters Raised in the Group"."

2. The present document contains the factual statement referred to under (A), above. The factual information referred to under (B), above, has been prepared and sent to the Chairman of the Group separately.

3. The "types of intellectual property included in MTN.GNG/NG11/W/12 (Section II, sub-paragraphs (i) through (vi)" are the following:
(i) patents; (ii) copyright and neighbouring rights; (iii) trademarks; (iv) appellations of origin and geographical indications; (v) industrial designs; and (vi) integrated circuits. For each of those "types of intellectual property," the relevant provisions of existing conventions administered by WIPO are referred to below, with brief indications on their contents. Such indications should be read together with the full text of the provisions, which is available from WIPO.

4. The present document does not cover those conventions administered by WIPO which do not directly provide protection but which, by facilitating the obtaining of protection abroad, contribute to better international protection. Those conventions are the Madrid Agreement Concerning the International Registration of Marks, the Hague Agreement Concerning the International Deposit of Industrial Designs, the Patent Cooperation Treaty, the Trademark Registration Treaty and the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure. For the same reason, the present document does not cover those provisions of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration which deal with the international registration of appellations of origin.

Patents

5. Provisions providing protection for patents are to be found in the Paris Convention for the Protection of Industrial Property of March 20, 1883, as last revised at Stockholm on July 14, 1967 (hereinafter referred to as "the Paris Convention").

6. The following provisions of the Paris Convention are relevant:

Article 2: this Article provides for national treatment to the benefit of nationals of Contracting States*, without prejudice to the rights specially provided for by the Convention.

Article 3: this Article extends the national treatment principle to nationals of non Contracting States who are domiciled or who have real and effective industrial or commercial establishments in a Contracting State.

Article 4: this Article grants any person who has duly filed a patent application in a Contracting State, or his successor in title, a right of priority for the purposes of filing in the other Contracting States. It also provides for the possibility of dividing patent applications.

Article 4bis: this Article provides for the principle of independence of patents obtained for the same invention in different countries.

Article 4ter: this Article grants the inventor the right to be mentioned as such in the patent.

Article 4quarter: this Article prohibits the refusal or invalidation of a patent on the ground that the sale of the product covered by that patent is subject to restrictions or limitations resulting from the domestic law.

Article 5A: this Article deals with the measures (compulsory licences, forfeiture) which can or cannot be taken in case of importation of articles or of failure to work a patented invention.

Article 5D: this Article provides that no indication or mention of the patent can be required upon the goods as a condition of recognition of the right to protection.

Article 5bis: this Article grants a period of grace for the payment of the fees prescribed for the maintenance of patents and allows for the restoration of patents which have lapsed by reason of non-payment of fees.

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*Throughout the present document, the expression "Contracting States" means States party to the international convention under consideration.

Article 5ter: this Article provides that certain acts in connection with means of transportation cannot be considered as patent infringements.

Article 5quarter: this Article deals with the importation of products manufactured by a process patented in the importing country.

Article 11: this Article grants temporary protection to patentable inventions in respect of goods exhibited at certain exhibitions.

Article 19: this Article reserves the right of Contracting States to make separately between themselves special agreements for the protection of patents, in so far as these agreements do not contravene the provisions of the Convention.

Copyright and Neighbouring Rights

7. Provisions providing copyright protection are to be found in the Berne Convention for the Protection of Literary and Artistic Works of September 9, 1886, as last revised at Paris on July 24, 1971 (hereinafter referred to as "the Berne Convention").

8. The following provisions of the Berne Convention are relevant:

Article 2: this Article deals with the subject matter for copyright protection, i.e., "literary and artistic works." The notion includes every production in the literary, scientific and artistic domain whatever may be the mode or form of its expression. A detailed non-exhaustive list of such works is offered. Special rules for specific kinds of works are also provided for in this Article.

Article 2bis: this Article gives national law a possibility to limit the protection for certain types of works, such as political speeches and public lectures or addresses.

Article 3: this Article defines the criteria of eligibility for protection according to which, as a general rule, protection under the Convention shall apply to authors who are nationals of, or have their habitual residence in, a Contracting State, for their published or unpublished works, and to other authors for works which are first published in such a State.

Article 4: this Article provides for special criteria of eligibility for protection under the Convention for authors of, in particular, cinematographic works (protection is granted if the maker has his headquarters or

habitual residence in a Contracting State) and works of architecture (protection is granted if the work is erected in such a State).

Article 5: this Article establishes the basic principles for protection under the Convention: national treatment shall be granted to authors of protected works, and the protection shall include the rights specially granted under the convention; the enjoyment and the exercise of the rights shall not be subject to any formality.

Article 6: this Article allows a Contracting State to restrict the protection of certain works of nationals of countries outside the Convention which fail to protect in an adequate manner works of authors who are nationals of the first mentioned State.

Article 6bis: this Article deals with the so-called moral rights, that is, the right to claim authorship of the work and to object to modifications of, or other derogatory action in relation to, the said work which would be prejudicial to the author's honour or reputation.

Article 7: this Article deals with the term of protection, in general and in respect of certain categories of works. The general term of protection shall be the life of the author and fifty years after his death.

Article 7bis: this Article deals with the term of protection for works of joint authorship, in which case the terms measured from the death of the author shall be calculated from the death of the last surviving author.

Article 8: this Article grants authors the exclusive right of making and authorizing the translation of their works.

Article 9: this Article grants authors the exclusive right of authorizing the reproduction of their works in any manner or form. Exceptions to this right are allowed in national laws in certain special cases but only if such reproduction does not conflict with the normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author.

Article 10: this Article allows the national law to provide for the free use of works for making quotations and for providing illustrations in publications, broadcasts and sound or visual recordings for teaching.

Article 10bis: this Article allows the national law to provide for the free use of works for the purpose of reproducing, broadcasting or communicating to the public articles or broadcast works relating to current economic, political or religious events, or for the purpose of reporting current events when the works have been seen or heard in the course of the event.

Article 11: this Article grants authors of dramatic, dramatico-musical and musical works the exclusive rights of authorizing the public performance of their works and the communication to the public of such performances.

Article 11bis: this Article grants authors the exclusive rights of authorizing, inter alia, the broadcasting of their works and the communication to the public by wire or by rebroadcasting of such broadcasts, and allows national laws to determine the conditions for the exercise of these rights.

Article 11ter: this Article grants authors of literary works the exclusive rights of authorizing the public recitation of their works and the communication to the public of such recitations.

Article 12: this Article gives authors the exclusive right of authorizing the adaptation, arrangement and other transformation of their works.

Article 13: this Article allows Contracting States to impose reservations and conditions on the exclusive right of authorizing sound recording of musical works and words pertaining to them.

Article 14: this Article grants authors the exclusive right of authorizing, inter alia, the cinematographic adaptation and reproduction of their works, as well as the distribution of the works thus adapted or reproduced, and the public performance and communication to the public by wire of the works thus adapted or reproduced.

Article 14bis: this Article deals with the exclusive rights of owners of copyright in cinematographic works - which are to be protected as original works - and with the ownership of rights in respect of such works.

Article 14ter: this Article contains facultative provisions on the right to an interest in the sale of original works of art and original manuscripts of writers and composers ("droit de suite").

Article 15: this Article contains provisions on the right to enforce protected rights and establishes, inter alia, certain presumptions as to ownership of copyright in a work for the purpose of enforcement.

Article 16: under this Article, infringing copies are liable to seizure within the country where the work enjoys protection; seizure shall be effected also in respect of reproductions coming from a country where the work is not protected or has ceased to be protected.

Article 17: this Article reserves the right of Governments to control or prohibit the circulation, presentation or exhibition of works.

Article 18: this Article deals with the application of the Convention to works existing on the entry into force of the Convention.

Article 19: this Article reserves the right to make claims to the benefit of any greater protection which may be granted by the legislation of a Contracting State.

Article 20: this Article reserves the right of Governments to enter into special agreements granting to authors more extensive rights than those granted by the Convention or containing other provisions not contrary to the Convention.

Appendix, Article I: this Article contains provisions on the possibility for developing countries to avail themselves of the faculties provided for in Articles II and III.

Appendix, Article II: this Article allows developing countries to institute a system of non-exclusive and non-transferable licences in respect of translation, for the purpose of teaching, scholarship or research.

Appendix, Article III: this Article allows developing countries to institute a system of non-exclusive and non-transferable licences in respect of reproduction and publication of editions for use in connection with systematic instructional activities.

Appendix, Article IV: this Article contains provisions common to licences under Articles II and III, concerning, inter alia, the procedure, the application on the copies made of an indication of the author and the title of work, the prohibition of export of copies and the obligation to pay a just compensation to the owner of the right of translation and reproduction, respectively.

Appendix, Article V: this Article allows developing countries to apply, in respect of the right of translation, as an alternative to the licence scheme under Article II, a special regime provided for in the 1886 and 1896 Acts of the Convention (the so-called "ten-year regime").

9. Provisions providing protection for neighbouring rights are to be found in the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations of October 26, 1961 (hereinafter referred to as "the Rome Convention"), in the Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms of October 29, 1971 (hereinafter referred to as "the Phonograms Convention") and in the Convention Relating to the Distribution of Programme-Carrying Signals Transmitted by Satellite of May 21, 1974 (hereinafter referred to as "the Satellites Convention").

10. The following provisions of the Rome Convention are relevant:

Article 1: this Article provides that no provision of the Convention should be interpreted as prejudicing the protection of copyright in literary and artistic works.

Article 2: this Article defines the concept of national treatment under the Convention in respect of performers, producers of phonograms and broadcasters; national treatment shall be subject to the protection specifically guaranteed, and the limitations specifically provided for, in the Convention.

Article 3: this Article contains definitions of the certain notions used in the Convention: "performer," "phonogram," "producer of phonogram," "publication," "reproduction," "broadcasting," and "rebroadcasting."

Article 4: this Article establishes the conditions for granting performers national treatment, on the basis of certain points of attachment, in respect of live performances, performances fixed on a phonogram and unfixed performances carried by a broadcast.

Article 5: this Article establishes the conditions for granting producers of phonograms national treatment in respect of their phonograms on the basis of certain points attachment.

Article 6: this Article establishes the conditions for granting broadcasting Organizations national treatment in respect of their broadcasts, on the basis of certain points of attachment.

Article 7: this Article deals with the minimum protection of performers; this protection shall include the possibility of preventing, under certain conditions, specific acts, notably the broadcasting and the communication to the public of their performances, the fixation of such performances and the reproduction of such fixations.

Article 8: this Article allows national laws to specify the manner in which performers will be represented, for the purpose of exercise of their rights, when several of them participate in the same performance.

Article 9: this Article allows national laws to extend the protection under the Convention to artists who do not perform literary or artistic works.

Article 10: this Article grants producers of phonograms the right to authorize or prohibit the direct or indirect reproduction of their phonograms.

Article 11: this Article deals with formalities allowed for protecting the rights of producers of phonograms and/or of performers in relation to phonograms.

Article 12: this Article contains provisions on the obligation to pay a single equitable remuneration to the performers or to the producers of the phonogram, or to both, if a phonogram published for commercial purposes is used directly for broadcasting or for any communication to the public.

Article 13: this Article grants broadcasting organizations the right to authorize or prohibit the rebroadcasting of their broadcasts, the fixation of their broadcasts and, under certain conditions, the reproduction of such fixations.

Article 14: this Article deals with the term of protection under the Convention which shall be at least 20 years.

Article 15: this Article describes the exceptions allowed in national legislation to the protection guaranteed by the Convention, for instance as regards private use; in principle the same limitations are allowed as in respect of the protection of copyright in literary and artistic works.

Article 16: this Article deals with the possibilities for Contracting States to make reservations, notably as regards the application of
Article 12.

Article 19: this Article states that once a performer has consented to the incorporation of his performance in a visual or audiovisual fixation, Article 7 shall have no further application.

Article 21: this Article states that the protection provided for in the Convention shall not prejudice any protection which is otherwise secured to the beneficiaries under the Convention.

Article 22: this Article reserves the right of Contracting States to enter into special agreements granting the beneficiaries under the Convention more extensive rights than those granted by the Convention or containing other provisions not contrary to the Convention.

11. The following provisions of the Phonograms Convention are relevant:

Article 1: this Article contains definitions of certain notions used in the Convention: "phonogram," "producer of phonograms," "duplicate" and "distribution to the public."

Article 2: this Article contains an obligation for Contracting States to protect producers of phonograms

against the making of duplicates without the consent of the producer and against the importation of such duplicates when such making or importation is for the purpose of distribution to the public and against the distribution of such duplicates to the public.

Article 3: this Article leaves to Contracting States the means for the implementation of the obligations under the Convention. This implementation shall include one or more of the following: granting of a copyright or other specific right, protection under the law on unfair competition and protection by means of penal sanctions.

Article 4: this Article deals with the duration of the protection. This is a matter for each Contracting State; if, however, that law prescribes a specific duration, this shall not be less than 20 years.

Article 5: this Article deals with formalities allowed in respect of the protection of phonograms.

Article 6: this Article describes the limitations permitted in national laws; in principle the same kinds of limitations are permitted as in respect of the protection of authors of literary and artistic works; compulsory licences are, however, permitted only under certain specific conditions.

Article 7: this Article states, in its paragraph (1), that the Convention shall in no way be interpreted to limit or prejudice the protection otherwise secured to authors, performers, producers of phonograms, or broadcasting organizations, under any domestic law or international agreement. Paragraph (2) contains a provision to the effect that it shall be a matter for the domestic law of each Contracting State to determine the extent, if any, to which performers whose performances are fixed on a phonogram are entitled to enjoy protection and the conditions for such enjoyment.

12. The following provisions of the Satellites Convention are relevant:

Article 1: this Article contains definitions of certain notions used in the Convention: "signal," "programme," "satellite," "emitted signal," "derived signal," "originating organization," "distributor" and "distribution."

Article 2: this Article contains essentially an undertaking for Contracting States to take adequate measures to prevent the distribution on or from its territory of programme-carrying signals by any distributor for whom the signal emitted to or passing through the satellite is not intended, if the organization originating the signals is a national of another Contracting State.

Articel 3: this Article states that the Convention shall not apply in respect of signals intended for direct reception from the staellite by the general public.

Article 4: this Article contains provisions on certain special cases (such as using short excerpts for informatory purposes, quotations and - in respect of developing countries - programs distributed for the purpose of teaching or scientific research) where contracting States are not required to apply the protection against the distribution of signals.

Article 6: this Article states that the Convention shall in no way be interpreted to limit or prejudice the protection secured to authors, performers, producers of phonograms or broadcasting organizations, under any domestic law or international agreement.

Article 7: this Article provides that the Convention shall in no way be interpreted as limiting the right of any Contracting State to apply its domestic law in order to prevent abuses of monopoly.

Article 8: this Article contains a provision to the effect that no reservations are permitted except in certain special cases namely as regards the point of attachment for protection of the satellite signals under Article 2 and as regards the distribution of programme-carrying signals by wire in certain circumstances.

Trademarks

13. Provisions providing protection for trademarks are to be found in the Paris Convention.

14. The following provisions of the Paris Convention are relevant:

Article 2: this Article provides for national treatment to the benefit of nationals of Contracting States, without prejudice to the rights specially provided for by the Convention.

Article 3: this Article extends the national treatment principle to nationals of non Contracting States who are domiciled or who have real and effective industrial or commercial establishments in a Contracting State.

Article 4A to D: this Article grants any person who has duly filed an application for the registration of a trademark in a Contracting State, or his successor in title, a right of priority for the purposes of filing in other Contracting States.

Article 5C: this Article deals with the conditions under which the registration of an unused mark may be cancelled and with other questions connected with the use of marks.

Article 5D: this Article provides that no indication or mention of the registration of the trademark can be required upon the goods as a condition of recognition of the right to protection.

Article 5bis: this Article grants a period of grace for the payment of the fees prescribed for the maintenance of trademark registrations.

Article 6: this Article provides for the principle of independence of registrations obtained for the same trademark in different countries.

Article 6bis: this Article provides for the protection of well-known marks.

Article 6quater: this Article deals with the assignment of marks.

Article 6quinquies: this Article deals with the relations between the registration of a trademark in the country of origin and its registration in the other Contracting States.

Article 6sexies: this Article provides for the protection of service marks.

Article 6septies: this Article protects the proprietor of a mark against the unauthorized registration of that mark in the name of his agent or representative.

Article 7: this Article prevents the nature of the goods to which a trademark is to be applied from forming an obstacle to the registration of the mark.

Article 7bis: this Article provides for the protection of collective marks.

Article 9: this Article deals with the measures, such as seizure, to be applied in case of goods unlawfully bearing a trademark.

Article 10ter: this Article obliges Contracting States to provide for appropriate legal remedies in case of goods unlawfully bearing a trademark and deals with the right to sue in such a case.

Article 11: this Article grants temporary protection to trademarks in respect of goods exhibited at certain exhibitions.

Article 19: this Article reserves the right of Contracting States to make separately between themselves special agreements for the protection of marks, in so far as these agreements do not contravene the provisions of the Convention.

Appellations of Origin and Geographical Indications

15. Provisions providing protection for appellations of origin and geographical indications are to be found in the Paris Convention, in the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods of April 14, 1891, as last revised at Lisbon on October 31, 1958 (hereinafter referred to as "the Madrid Agreement (Indications of Source)"), and in the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of October 31, 1958, as revised at Stockholm on July 14, 1967 (hereinafter referred to as "the Lisbon Agreement").

16. The following provisions of the Paris Convention are relevant:

Article 2: this Article provides for national treatment to the benefit of nationals of Contracting States, without prejudice to the rights specially provided for by the Convention.

Article 3: this Article extends the national treatment principle to nationals of non Contracting States who are domiciled or who have real and effective industrial or commercial establishments in a Contracting State.

Article 5bis: this Article grants a period of grace for the payment of any fees prescribed for the maintenance of rights concerning appellations of origin and other geographical indications.

Article 10: this Article deals with the measures, such as seizure, to be applied in case of goods bearing a false indication of source.

Article 10ter: this Article obliges Contracting States to provide for appropriate legal remedies in case of goods bearing a false indication of source and deals with the right to sue in such a case.

Article 19: this Article reserves the right of Contracting States to make separately between themselves special agreements for the protection of appellations of origin and other geographical indications, in so far as these agreements do not contravene the provisions of the Convention.

17. The following provisions of the Madrid Agreement (Indications of Source) are relevant:

Article 1: this Article deals with the measures, such as seizure, to be applied in case of goods bearing a false or deceptive indication of source.

Article 2: this Article deals with the procedure of seizure.

Article 3: this Article reserves the right of the vendor to indicate, subject to certain conditions, his name and address on imported goods.

Article 3bis: this Article obliges Contracting States to prohibit the use of certain deceptive indications in the nature of publicity.

Article 4: this Article reserves the right of the courts not to apply the Agreements to generic appellations, regional appellations concerning the source of products of the vine being, however, excluded from that reservation.

18. The following provisions of the Lisbon Agreement are relevant:

Article 1: This Article obliges Contracting States to protect appellations of origin registered at the International Bureau of WIPO.

Article 2: this Article defines the notions of appellation of origin and of country of origin.

Article 3: this Article defines the content of the protection to be granted to the appellations of origin referred to in Article 1.

Article 4: this Article reserves the protection granted to appellations of origin under other international instruments or by virtue of national legislation or court decisions.

Article 6: this Article prevents an appellation of origin from becoming generic as long as it is protected as an appellation of origin in the country of origin.

Article 8: this Article deals with legal proceedings.

Industrial Designs

19. Provisions providing protection for industrial designs are to be found in the Paris Convention.

20. The following provisions of the Paris Convention are relevant:

Article 2: this Article provides for national treatment to the benefit of nationals of Contracting States, without prejudice to the rights specially provided for by the Convention.

Article 3: this Article extends the national treatment principle to nationals of non Contracting States who are domiciled or who have real and effective industrial or commercial establishments in a Contracting State.

Article 4A to E: this Article grants any person who has duly filed an application for the registration of an industrial design in a Contracting State, or his successor in title, a right of priority for the purposes of filing in other Contracting States.

Article 5B: this Article provides that the protection of industrial designs cannot be subject to any forfeiture by reason of failure to work or of importation of articles.

Article 5D: this Article provides that no indication or mention of the deposit of the industrial design can be required upon the goods as a condition of recognition of the right to protection.

Article 5bis: this Article grants a period of grace for the payment of the fees prescribed for the maintenance of industrial design registrations.

Article 5quinquies: this Article obliges Contracting States to protect industrial designs.

Article 11: this Article grants temporary protection to industrial designs in respect of goods exhibited at certain exhibitions.

Article 19: this Article reserves the right of Contracting States to make separately between themselves special agreements for the protection of industrial designs, in so far as these agreements do not contravene the provisions of the Convention.

Integrated Circuits

21. There are no provisions in existing conventions administered by WIPO which provide protection for integrated circuits as such. However, to the extent that integrated circuits or elements thereof constitute inventions, literary or artistic works or industrial designs, the provisions quoted above in connection with such "types of intellectual property" are relevant.

Final Remark

22. Article 10bis of the Paris Convention, which obliges Contracting States to assure effective protection against unfair competition, may be applicable, depending on the circumstances, in connection with any of the six "types of intellectual property" covered by this document.