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

SYNOPTIC TABLES SETTING OUT EXISTING INTERNATIONAL STANDARDS AND PROPOSED STANDARDS AND PRINCIPLES

Prepared by the Secretariat

Revision

1. At its meeting of 11-12 May 1989, the Negotiating Group requested the secretariat to prepare synoptic tables setting out in a comparative manner the proposals tabled in the Group on standards and principles concerning the scope, availability and use of trade-related intellectual property rights and corresponding provisions of existing international treaties.

The tables in the present note have been prepared in response to the request made by the Group at its meeting of 11, 12 and 14 December 1989 to the secretariat to propose a final revision of the tables. It takes into account the additional specific proposals made by participants up to the end of 1989.

2. The following tables are attached to this note:

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3. The first column in each table sets out existing international standards on the matters on which specific proposals have been made. The content of this column has been prepared drawing on the document prepared by the International Bureau of WIPO on the Existence, Scope and Form of Generally Internationally Accepted and Applied Standards/Norms for the Protection of Intellectual Property (MTN.GNG/NG11/W/24/Rev.1). The following points about the scope of the information contained in this column should be borne in mind:

- Only standards contained in multilateral treaties have been included. Regional or bilateral treaties have not been referred to.

- The information given refers to the most recent revision of the treaty in question, unless otherwise indicated.

- In order to enable the information to be presented synoptically, it has been necessary in many instances to present the existing standards in summary form. References have been included to the articles of the treaties in question where the full text of existing international standards can be found.

- Under each entry, a reference is made to the corresponding Part and Section of document MTN.GNG/NG11/W/24/Rev.1 prepared by WIPO, e.g. (III (1)) refers to Part III (on trademarks), Section (1) (on subject matter to which right applies/does not apply). It will be recalled that this document not only contains information on existing standards in international treaties, but also information on standards suggested in model legislations, on WIPO activities and on national provisions and practices. Where there is a second reference in brackets, this refers to the records of any discussion of that point in the Group (e.g. 7/17; 7/20 refers to paragraphs 17 and 20 of MTN.GNG/NG11/7).

- The national treatment standard, as laid down in the Paris, Berne, Universal Copyright, Rome or Integrated Circuits Conventions, is widely relevant to the matters referred to in the tables. It has only been mentioned explicitly in the tables where a specific standard of this nature has been proposed in relation to a particular intellectual property right. It will be recalled that various proposals have been made for general national treatment obligations, in connection with item I(A) of the Group's agenda.

4. The other columns of the tables set out in full the specific proposals made by the United States (MTN.GNG/NG11/W/14/Rev.1), Japan (MTN.GNG/NG11/W/17/Adds.1-3), the European Communities (MTN.GNG/NG11/W/26), Australia (MTN.GNG/NG11/W/35), Norway on behalf of the Nordic countries (MTN.GNG/NG11/W/36), India (MTN.GNG/NG11/W/37) and Switzerland (MTN.GNG/NG11/W/38 and Add.1), Peru (MTN.GNG/NG11/W/45), New Zealand (MTN.GNG/NG11/W/46), Canada (MTN.GNG/NG11/W/47), Republic of Korea (MTN.GNG/NG11/W/48), Hong Kong (MTN.GNG/NG11/W/51), Austria (MTN.GNG/NG11/W/55) and Brazil (MTN.GNG/NG11/W/57). Where there is a reference in brackets below an entry in these columns, this refers to the records of the meeting of the Group at which that point was discussed.

5. A written submission of a more general nature presenting views on questions of standards and principles concerning the scope, availability and use of trade-related intellectual property rights has also been circulated by Thailand. The Thai statement (MTN.GNG/NG11/W/27) inter alia emphasises that the two fundamental goals pursued by governments when granting intellectual property protection are the stimulation or encouragement of intellectual property creation and the accord of proper and legitimate protection of the public interest; the former must not put an undue burden on or adversely affect the latter.

6. The tables also do not reflect the proposal made by Mexico (MTN.GNG/NG11/W/60), which was received too late to be taken into account. In regard to the provision of adequate standards and principles, it states that the negotiations should comprehensively cover standards on patents, trademarks, geographical

indications including appellations of origin, copyright, integrated circuits and trade secrets, and puts forward proposals on each of these.

7. Many participants have, of course, expressed their views orally at meetings of the Group. Since the April 1989 TNC decision, the views expressed on standards and principles are recorded in MTN.GNG/NG11/12, paragraphs 5, 6 and 9; MTN.GNG/NG11/13, paragraph 5; MTN.GNG/NG11/14, paragraphs 3-91; MTN.GNG/NG11/16, paragraphs 2-64; and MTN.GNG/NG11/17, paragraphs 36-49.

8. The following are the full titles of the various international treaties referred to in column one of the tables:

(a) Industrial Property

- Paris Convention for the Protection of Industrial Property (WIPO) (1883, revised 1900, 1911, 1925, 1934, 1958 and 1967, and amended 1979);
- Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods (WIPO) (1891, revised 1911, 1925, 1934 and 1958; Additional Act 1967);
- Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration (WIPO) (1958, revised 1967, and amended 1979);
- Nairobi Treaty on the Protection of the Olympic Symbol (WIPO) (1981);
- Patent Cooperation Treaty (PCT) (WIPO) (1970, amended 1979 and modified 1984);
- Madrid Agreement Concerning the International Registration of Marks (WIPO) (1891, revised 1900, 1911, 1925, 1934, 1957 and 1967, and amended 1979) and the Madrid Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (1989);[1]
- Treaty on Intellectual Property in Respect of Integrated Circuits (WIPO, 1989).[1]

(b) Copyright

- Berne Convention for the Protection of Literary and Artistic Works (WIPO) (1886, completed 1896, revised 1908, completed 1914, revised 1928, 1948, 1967 and 1971, and amended 1979);
- Universal Copyright Convention (Unesco) (1952, revised 1971).

(c) Neighbouring Rights

- Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (ILO, Unesco, WIPO) (1961);
- Geneva Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of their Phonograms (WIPO, in cooperation with ILO and Unesco for matters relating to their respective fields of competence) (1971).

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1Not yet in force.

TABLE I: COPYRIGHT

(1) RELATION TO BERNE AND OTHER INTERNATIONAL CONVENTION OBLIGATIONS

Existing International Standards

(Part II)
(7/17)

United States (W/14/Rev.1

(14/23.1)

Australia (W/35)

Rights in the copyright field should be protected in accordance with the existing provisions of the most broadly subscribed acts of relevant international conventions; including the Berne Convention for the Protection of Literary and Artistic Works (1886).
(14/6; 14/23.1)

Switzerland (W/38)

(14/3; 14/23.1)

Canada (W/47)

All countries should comply with the substantive obligations of the Paris text of the Berne Convention for the Protection of Literary and Artistic Works.
(16/19)

Austria (W/55)

The standards of the Paris Act of the Berne Convention are in general adequate and should therefore serve as a guideline for further discussion.

Thus, authors and their successors in title shall enjoy the economic and moral rights provided for in the Berne Convention.

Any limitations and exemptions to the exclusive rights of authors shall only be those provided for in the Berne Convention. In applying any of those limitations or exemptions, authors shall be guaranteed due process of law.

Japan (W/17 and Add.1)

Participants shall accede to and frame national laws based upon the Paris Act of the Berne Convention for the Protection of Literary and Artistic Works.
(9/12, 14/23.1)

Nordics (W/36)

(14/4)

Peru (W/45)

Peru considers that the Berne Convention for the Protection of Literary and Artistic Works grants the necessary protection in this area.
(16/20)

Republic of Korea (W/48)

The standard for the protection of copyrights should be at the level of the Berne Convention, and participation in the convention should be decided by each country.
(16/21)

Brazil (W/57)

Concerning the protection of literary and artistic works, the Berne Convention and the national legislation are the adequate instruments to deal with the subject.

European Communities (W/26)

Authors and their successors in title shall enjoy the rights conferred upon them by the Paris Act of the Berne Convention for the Protection of Literary and Artistic Works.
(8/39; 8/46; 14/23.1 and 3)

India (W/37)

The Berne Convention for the Protection of Literary and Artistic Works is more than adequate to deal with copyright protection.

New Zealand (W/46)

Literary and artistic works should be protected in accordance with the rights conferred under the relevant International Conventions, including the Berne Convention for the Protection of Literary and Artistic Works.

It is considered that the standards and norms in these Conventions are sufficient for the purposes of the agreement.
(16/3; 16/17)

Hong Kong (W/51)

The Paris text of the Berne Convention for the Protection of Literary and Artistic Works (1971) provides an adequate level of protection of copyright.
(17/36)

(2) SUBJECT MATTER FOR PROTECTION

Existing International Standards

The Berne Convention obliges the countries which are party to it to protect all literary and artistic works. The Convention contains a non-exhaustive list of such works which includes, inter alia, books and other writings; dramatic or dramatico-musical works; choreographic works; musical compositions with or without words; cinematographic works and works expressed by a process analogous to cinematography; works of drawing, painting, architecture and sculpture; photographic works. The obligation of the countries party to the Convention also extends to the protection of so-called derivative works (translations, adaptations, arrangements of music) (Article 2).

The word "work" is not defined separately. The records of the diplomatic conferences adopting and revising the Convention indicate, however, that it has always been considered evident that "works" are original, intellectual creations. That meaning of "works" is made clear also in the text of the Convention in respect of collections such as encyclopaedias and anthologies, where it is stated that the condition of protection is that such collections should be "intellectual creations".

The Berne Convention provides that it is a matter for legislation in countries party to the Convention to determine the extent of the application of their laws to works of applied art and industrial designs, as well as the conditions under which such works and designs are protected. The Convention makes it clear, however, that such productions should always be protected, either by copyright or by special industrial design law or by both (Article 2).

(II (1))
(7/17)

Under the Universal Copyright Convention, each Contracting State undertakes to provide for the adequate and effective protection of the rights of authors and other copyright proprietors in literary, scientific and artistic works, including writings, musical, dramatic and cinematographic works, and paintings, engravings and sculpture (Article I).

United States (W/14 Rev.1)

Copyright protection shall extend to all forms of original expression regardless of the medium in which the work is created, expressed, or embodied or the method by which it is communicated or utilized. Such works include literary works (including all types of computer programs expressed in any language, whether application programs or operating systems, and whether in source or object code); musical works (including accompanying lyrics); dramatic works, cinematographic and audiovisual works; sound recordings; pictorial, graphic and sculptural works; choreography and pantomime; compilations (whether of protected or unprotected materials and whether in print, in a machine-readable data base or other medium); derivative works (without prejudice to any rights in pre-existing material upon which they are based); and works created with the use of computers, as well as works in forms yet to be developed.

(14/24.1)

Australia (W/35)

(14/24.4)

Switzerland (W/38)

"Work" means any original intellectual creation, of literary or artistic character, irrespective of its value or purpose.

Computer software shall be considered to be a work within the meaning of the preceding definition.

(14/24.3)

Hong Kong (W/51)

Any agreement should make clear that computer programs should be considered to be literary works under works under Article 2(1) of the Berne Convention.

Brazil (W/57)

Japan (W/17 and Adds.1-2)

A production in which thoughts or sentiments are expressed in a creative way and which falls within the literary, scientific, artistic or musical domain is "work" that is entitled to copyright protection.

Computer data bases which, by reason of the selection or systematic construction of information contained therein, constitute intellectual creations shall be protected as independent works. Participants may provide for the copyright protection of data base works under the category of "compilations" or "collections".

The copyright protection of computer program works shall be given appropriate considerations in accordance with their nature which include the following: The protection shall not extend to any programming language, rule or algorithm used for making such works.

(9/12-14; 14/24.2; 16/39))

Nordics (W/36)

An author of literary or artistic works, a work being an original intellectual creation or an expression thereof, shall enjoy copyright protection.

The expression "literary and artistic work" shall include every production in the literary, scientific and artistic domain

expression such as works in writing, including computer programs, works consisting of words and expressed orally, musical works with or without words, dramatic or dramatico-musical works, audiovisual works, including cinematographic works, pantomimes and choreographic works, works of fine and applied art.

In no case copyright protection shall extend to ideas, procedures, systems or methods.

(14/4; 14/24.3; 16/39)

European Communities (W/26)

(14/24.4)

India (W/37)

Peru (W/45)

Peru considers that software needs to be protected; however, it is necessary to draw up a set of special provisions and rules that are in keeping with the specific features of this technology. A number of studies that have been carried out by international organizations could be most useful for the elaboration of a novel system of protection for this technology.

(16/20)

New Zealand (W/46)

(16/4)

Canada (W/47)

In addition to the subject matter covered by the Berne Convention, computer programs should be protected.

(16/19; 16/39)

Republic of Korea (W/48)

whatever may be the mode or form of its
All original literary, artistic and scholastic expressions should be protected.

Copyright protection should extend to computer programs and databases in addition to traditional creative works.

(16/21)

Austria (W/55)

Protection for computer programs modelled after the protection of literary works under the Berne Convention should be provided. The possibility of protecting computer programs incorporated in hardware through patents should be maintained.

(17/41)

(3) CONDITIONS FOR OBTAINING PROTECTION

Existing International Standards

Under the Berne Convention, the enjoyment and exercise of copyright must not be subject to a formality (Article 5). The Convention leaves it to the legislation of member States to determine whether protection of works, in general, or any specified categories of works, should be conditional on those works having been fixed in some material form. (Article 2(2)).
(II (2))

As a general principle, when the Berne Convention enters into force for a country, its provisions must be applied to all works, except those that have already fallen into the public domain through the expiry of the term of protection. (Article 18(1)&(2)). However, the application of this principle is subject to any provisions contained in special conventions between countries of the Union and in their absence, each country shall determine the conditions of its application. (Article 18(3)).

Under the Universal Copyright Convention, all formalities with which compliance is required as a condition of copyright must be regarded as satisfied if from the time of the first publication all the copies of the work published with the authority of the author or other copyright proprietor bear the symbol c accompanied by the name of the copyright proprietor and the year of first publication placed in such manner and location as to give reasonable notice of claim of copyright. (These provisions do preclude any Contracting State from requiring formalities or other conditions for the acquisition and enjoyment of copyright in respect of works first published outside its territory and the author of which is not one of its nationals (Article III.1). However, they do not preclude any Contracting State from requiring formalities in respect of works first published in its territory or works of its nationals wherever published) (Article III.2).

Each Contracting State is also required to provide legal means of protecting without formalities the unpublished works of nationals of other Contracting States (Article III.4).

United States (W/14/Rev.1)

Copyright protection shall vest automatically upon the creation of a work and shall subsist whether or not the work is published, communicated, or disseminated. The enjoyment and exercise of rights under copyright shall not be subject to any formality.

Parties that have afforded no effective copyright protection to foreign works shall provide copyright protection for pre-existing works that are not in the public domain in the country of origin of the work.
(14/25)

Australia (W/35)

Switzerland (W/38)

Copyright protection shall begin automatically, upon the creation of the work.

The exercise of the exclusive right shall not be subject to any formality.

Hong Kong (W/51)

Japan (W/17 and Add.1)

Copyright protection shall attach automatically upon creation of the work and the exercise of the rights shall not be subject to any formality.

Nordics (W/36)

The protection shall commence upon creation of the work and the exercise of the rights shall not be subject to any formality.
(14/25)

Peru (W/45)

Canada (W/47)

The requirement in the Berne Convention that protection arises automatically upon creation is adequate.

Austria (W/55)

The protection of a work shall begin upon creation and shall not be subject to any formality.

European Communities (W/26)

India (W/37)

New Zealand (W/46)

Republic of Korea (W/48)

A copyright should originate from the time a work of authorship is completed and does not require a fulfilment of any procedures or formalities. Whether copyright protection is allowed when the protection of a work is requested in a country where the work is in the public domain, but not in the public domain in the country of origin, should be decided by each country, as under clause 18, item 3 of the Berne Convention.

Brazil (W/57)

(4) RIGHTS CONFERRED

Existing International Standards

The exclusive rights to authorize certain uses of works that must be granted by countries party to the Berne Convention are the following:

- the right of reproduction of works in any manner or form (Article 9(1));

- the right of public performance of dramatic, dramatico-musical and musical works, the right of recitation of literary works and the right of communication to the public of works performed or recited (Article 11(1) and 12(1));

- the right of broadcasting of works or communication thereof to the public by other wireless means, and the right of communication to the public by wire (e.g., by cable) or by rebroadcasting of works broadcast as well as the right of public communication by loudspeaker and similar means of works broadcast (Article 11bis(1));

- the right of translation of works (Article 8);

- the right of adaptation, arrangement or other alteration of works, (Article 12);

- the right of authorizing cinematographic adaptation of works and of authorizing the reproduction and distribution to the public of the works thus adapted or reproduced and the cinematographic works - as original works - themselves, as well as the right of authorizing the public performance and communication to the public of the works thus adapted or reproduced and of the cinematographic works themselves (Article 14(1) and 14bis(1)).

The recognition of the "droit de suite", which is a right to an interest in the sale of original works of art and of original manuscripts, is not an obligation under the Convention; it is only optional and can be made conditional on reciprocity (Article 14ter).

United States (W/14/Rev.1)

A. Parties shall extend to copyright owners at a minimum, the exclusive rights to do or to authorize doing of the following:

(a) to copy or to reproduce the work by any means or process, in whole or in part, and whether identically or in substantially similar fashion;

(b) to translate, revise, and otherwise adapt and prepare derivative works based on the protected work;

(c) to distribute copies of the work by sale, rental, or otherwise, and to import copies; and,

(d) except in the case of sound recordings, to communicate publicly the work, directly or indirectly (e.g., perform, display, exhibit, broadcast, transmit and retransmit) whether "live" or from a fixation, by any means or process, (.e.g. by electronic network, by terrestrial links, broadcast signals, satellites, or otherwise) and regardless of whether the signal emanates from beyond national borders.

B. Restrictions of exclusive rights to "public" activity (e.g., the right of public performance) shall not apply to the reproduction or adaptation right; and with respect to the communication right, "public" or "publicly" shall mean:

(a) places open to the public of any place where a substantial number of persons outside of a normal circle of a family and its social acquaintances is gathered; and

(b) communications of works in any form or by means of any device or process, regardless of whether the members of the public capable of receiving such communications receive them in the same or separate places and at the same time or at different times.

(continued on next page)

Japan (W/17 and Adds.1-2)

The author shall enjoy the moral rights and the economic rights to his work as stipulated in the Berne Convention.

Data base works shall be considered as having been "made public", when such works have been put, by a person having the right of wire transmission or with the authorization of such person, in a state such that they may be made available to the public by means of wire transmission in response to a request from the public.

Australia (W/35)

Nordics (W/36)

The author of a work shall have the exclusive rights to do and to authorize:

- the reproduction of his work in any manner or form;

- the translation, adaptation or other alterations of his work;

- the communication of his work to the public.

The author of a work shall enjoy the moral rights conferred upon him by the Berne Convention (1971).
(14/26)

India (W/37)

Peru (W/45)

New Zealand (W/46)

European Communities (W/26)

Creators of computer programs and their successors in title shall at least have the exclusive right of reproduction, adaptation and translation. (The Community considers that account should be taken of the legitimate interests of users, the promotion of international standardization, the development of compatible and inter-working systems and maintaining the conditions of competition)
(8/39)

Switzerland (W/38)

The author shall enjoy the rights to his work as stipulated in the Berne Convention for the Protection of Literary and Artistic Works as revised in 1971.

The copyright shall confer the right on its owner to prevent third parties not having his consent from:

- copying or reproducing the work in any form, such as printed matter, phonograms, videograms, or data carriers;

- offering to the public, selling, or otherwise distributing copies of the work;

- performing publicly the work, directly or indirectly by any means or process, live or in a place other than that of the performance;

- broadcasting the work by radio wave, by cable or other devices;

- retransmitting the transmitted work by technical means or processes, including cables or other devices, the exploitation of which is not made by the initial broadcaster;

- communicating broadcasts or retransmitted broadcasts.

The rights under copyright shall be assignable and transferable.

(4) RIGHTS CONFERRED (contd.)

Existing International Standards

The Berne Convention also contains provisions on the protection of the so-called moral rights; it provides that the author, independently of his economic rights, shall have the right to claim authorship of his work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the work which would be prejudicial to his honour or reputation (Article 6bis).

(II (4))

Under the Universal Copyright Convention, each Contracting State must provide for the adequate and effective protection of the rights of authors and other copyright proprietors. These rights must include the basic rights ensuring the author's economic interests, including the exclusive right to authorize reproduction by any means, public performance and broadcasting. This requirement extends to works protected under the Convention either in their original form or in any form recognizably derived from the original. The rights shall also include the exclusive right of the author to make, publish and authorize the making and publication of translations of works protected under this Convention (Articles IVbis.1, V.1).

United States (W/14/Rev.1)

C. Economic rights under copyright shall be freely and separately exploitable and transferrable; transferees (assignees and exclusive licensees) shall be entitled to full enforcement of their acquired rights in their own name.

(14/26)

Hong Kong (W/51)

Brazil (W/57)

Canada (W/47)

In the case of computer programs, the protection should be essentially equivalent to that provided to literary works under the Berne Convention, except that protection should not extend to the "look and feel" or "structure, sequence, and organization" of a program, or to algorithms, ideas, systems, and the like.

Further, national laws may allow for adaptation, arrangement, conversion or alteration of the program for an entity's own use as well as the making of a single copy for strictly back-up or archival purposes.

Otherwise, the Berne Convention deals adequately with rights conferred.

(16/19)

Republic of Korea (W/48)

Rental rights which are not prescribed in the Berne Convention should be decided by each country.

Austria (W/55)

Authors and their successors in title shall enjoy the economic and moral rights provided for in the Berne Convention.

The normal use of original computer programs already implies their copying for saving (on the hard disk or on a floppy disk as a back up copy). Copies for the personal use of individuals should be allowed, whereas the copying of programs for commercial use, including use by an employee in the interests of his company, shall be prohibited.

(5) LIMITATIONS/EXEMPTIONS/COMPULSORY LICENSING

Existing International Standards

The Berne Convention allows, in some restricted and precisely determined cases, certain limitations to the exclusive rights of authors. Such limitations are of two types: free uses (that is, uses of protected works without the obligation to ask for authorization and to pay any remuneration) and compulsory licences. Free uses are only allowed for some strictly defined purposes, such as for quotations, illustration for teaching purposes, reporting current events and, in respect of the right of reproduction, in certain special cases, provided that such a limitation does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of authors (Articles 9(2), 10, 10bis).

Compulsory or legal licences (non-voluntary licences) are allowed in the following cases and under the following conditions:

- in respect of the right of broadcasting of works and the communication to the public of works broadcast (Article 11bis(2));

- in respect of the right of recording but only of musical works and any words pertaining thereto, if the copyright owner has already authorized a previous recording (Article 13);

- in respect of the right of reproduction of works, in certain special cases, provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interest of the copyright owner (Article 9(2));

- exclusively in developing countries, in respect of the rights of translation of works published in printed or analogous forms of reproduction and the right of reproduction of works published in printed or analogous forms of reproduction and of audiovisual fixations prepared and published for the sole purpose of being used in connection with systematic instructional activities, for teaching, scholarship or research, under several conditions; the copies produced under such licences must not be exported (Appendix).

United States (W/14/Rev.1)

Any limitations and exemptions to exclusive economic rights shall be permitted only to the extent allowed and in full conformity with the requirements of the Berne Convention (1971) and in any event shall be confined to clearly and carefully defined special cases which do not impair actual or potential markets for, or the value of, copyrighted works.

Compulsory licences shall not be adopted where legitimate local needs can be met by voluntary actions of copyright owners. Implementation, where necessary, of compulsory licences shall be strictly limited to those works and those uses permitted in the Berne Convention (1971); shall be implemented in accordance with relevant treaty standards; shall preserve all material interests of authors and copyright owners; and shall be accompanied by detailed laws and regulations that provide strong safeguards, including notification of the copyright owner and effective opportunity to be heard, mechanisms to ensure prompt payment and remittance of royalties consistent with those that would be negotiated on a voluntary basis, and workable systems to prevent exports.
(14/27.1)

Australia (W/35)

Switzerland (W/38)

Limitations and exemptions to rights, including compulsory licensing, may be made in accordance with the Berne Convention.

Limitations made to the rights in favour of private use shall not apply to computer software.
(14/27.2)

Brazil (W/57)

Japan (W/17 and Adds.1-2)

Limitations on copyright shall follow the line of the Berne Convention.

The owner of a copy of a computer program work may make copies or adaptations of that work if and to the extent deemed necessary for the purpose of exploiting that work in a computer by himself.
(14/27.2)

Nordics (W/36)

Any limitations and exemptions to the economic rights shall be restricted to those allowed under the Berne Convention (1971).

Canada (W/47)

The Berne Convention contains acceptable limitations. In respect of computer programs, see item (4) "RIGHTS CONFERRED", above.

Hong Kong (W/51)

Compulsory licences should be permitted to the extent that limitations of the rights of authors are permitted as licences and exceptions within the terms of the Berne Convention. Parties to the agreement should remain free to promulgate any legislation that they think necessary in the public interest to prevent or remedy any abuse of the exclusive rights belonging to a copyright owner by virtue of its municipal laws.
(17/37)

European Communities (W/26)

Limited exceptions to the exclusive rights for computer programs should follow the line of the Berne Convention.

India (W/37)

Peru (W/45)

New Zealand (W/46)

Republic of Korea (W/48)

Restrictions on copyright should be confined to those of the Berne Convention.
(16/21)

Austria (W/55)

Any limitations and exemptions to the exclusive rights of authors shall only be those provided for in the Berne Convention. In applying any of these limitations or exemptions, authors shall be guaranteed due process of law.

In respect of computer programs, see item (4) "RIGHTS CONFERRED" above.

(5) LIMITATIONS/EXEMPTIONS/COMPULSORY LICENSING(contd.)

Existing International Standards

In addition to the limitations explicitly mentioned in the text of the Convention, there is one more possibility for certain exceptions about which there was express agreement at various revision conferences, namely the possibility of "minor exceptions" to the right of public performance (a concept which is close to the notion of "fair use" or "fair dealing".

(II (4) and (7))
(7/17)

Under the Universal Copyright Convention, any Contracting State may, by its domestic legislation, make exceptions, that do not conflict with the spirit and provisions of the Convention, to the basic rights ensuring the author's economic interest referred to in (4) above. Any State whose legislation so provides, must nevertheless accord a reasonable degree of effective protection to each of the rights to which exception has been made (Article IVbis.2). Under the Universal Copyright Convention, any Contracting State may, subject to several conditions, restrict the right of translation of writings referred to in (4) above by making provision for non-exclusive compulsory licences to translate if, after the expiration of a period of 7 years from the date of first publication, a translation has not been published in a language in general use in that State. (Article V.2). The Universal Copyright Convention also contains special provisions for developing countries allowing (i) greater flexibility to grant compulsory licences, for the purpose of teaching, scholarship or research, in respect of the rights of translation of works published in printed or analogous forms of reproduction and (ii), subject to a number of conditions, allowing the grant of compulsory licences in respect of the right of reproduction of works published in printed or analogous forms of reproduction and the right of reproduction of audio-visual fixations prepared and published for the sole purpose of being used in connection with systematic instructional activities; the copies produced under such licences must not be exported (Articles Vter, Vquater).

(6) TERM OF PROTECTION

Existing International Standards

The Berne Convention obliges the countries party to it to protect literary and artistic works for the lifetime of the author and for 50 years after his death.

The protection of anonymous and pseudonymous works expires, as a rule, 50 years after the work has been lawfully made available to the public. In respect of cinematographic works, it may be provided that the 50-year term of protection be calculated from making the work available to the public or, failing such an event, from the making of the work (Articles 7, 7bis).

There are only two categories of works, namely photographic works and works of applied art, in respect of which the minimum term of protection prescribed by the Berne Convention is shorter: 25 years from the making of such works (Article 7(4)).

Countries of the Union may grant a term of protection in excess of those provided in the Berne Convention (Paris Act) (Article 7(6)).

Countries of the Union bound by the Rome Act of the Berne Convention which grant, in their national legislation in force at the time of signature of the Paris Act, shorter terms of protection than those provided in the Berne Convention (Paris Act), are allowed to maintain such terms when ratifying or acceding to that Act (Article 7(7)).

The Berne Convention exempts the term of protection from the obligation of extending national treatment to foreigners. The term is governed by the legislation of the country where protection is claimed; however, unless the legislation of that country otherwise provides, the term does not exceed the term fixed in the country of origin of the work (Article 7(8)).

(II (5))
(5/21; 7/17)

(continued on next page)

United States (W/14/Rev.1)

The minimum term of copyright protection shall be the life of the author plus 50 years; and for anonymous and pseudonymous works and works of juridical entities (works made for hire), shall be at least 50 years from publication with the consent of the author, or, failing such an event within 50 years from the making of a work, 50 years after the making.

(14/28)

Australia (W/35)

Switzerland (W/38)

The duration of protection shall amount to the life-span of the author and 50 years in addition. Other terms of protection may be granted to certain categories of works in conformity with the Berne Convention.

The term of protection of computer software shall be 50 years from the date of creation.

Hong Kong (W/51)

Japan (W/17 and Add.1)

The term of protection of works shall be in principle, the life of the author and 50 years after his death in accordance with the Berne Convention.

(14/28)

Nordics (W/36)

The term of protection shall be the life of the author and 50 years after his death or, in the case of anonymous or pseudonymous authors, 50 years after the work has been lawfully made available to the public.

Peru (W/45)

Canada (W/47)

In the case of computer programs, the minimum term should be 50 years.

Otherwise, the Berne Convention deals adequately with the term of protection.

(16/19)

Austria (W/55)

A shorter term of protection for computer programs compared to other works could be envisaged, e.g. 25 years (or even shorter) from the time of creation.

European Communities (W/26)

Without prejudice to the provisions of the international conventions in the field of copyright, the term of protection of computer programs shall in no event be shorter than the minimum term provided for in the Berne Convention for certain categories of works, i.e. 25 years from the date of creation.

(8/39)

India (W/37)

New Zealand (W/46)

Republic of Korea (W/48)

The term of copyright protection should be, in principle, the life of the author plus 50 years.

(16/21)

Brazil (W/57)

(6) TERM OF PROTECTION (contd.)

Existing International Standards

Under the Universal Copyright Convention, the basic requirement is that the term of protection should not be less than the life of the author and 25 years after his death. However, exceptions are provided for Contracting States which at the time of accession computed the duration of protection from the date of first publications of a work or from the date of its registration prior to publication; these States must provide a term of no less than 25 years from the date in question (Article IV).

In all Contracting States that protect photographic works or works of applied art as artistic works, the term of protection must not be less than 10 years for these classes of works (Article IV.3).

With regard to the term of protection, the Universal Copyright Convention exempts Contracting States from the obligation of extending national treatment to foreigners: Contracting States are not obliged to provide for a term in excess of that fixed in the country of which the author is a national in the case of unpublished works and in the country of the first publication in the case of published works (Article IV.4).

TABLE II: NEIGHBOURING RIGHTS

(1) RELATION TO ROME AND GENEVA CONVENTIONS

Existing International Standards

United States (W/14/Rev.1)

(14/30)

Australia (W/35)

Neighbouring rights should be protected in accordance with the existing provisions of the Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations (1961) and the Geneva Convention for the Protection of Producers of Phonograms Against Unauthorised Duplication of their Phonograms (1971).
(14/6)

Switzerland (W/38)

(14/29; 14/32)

Canada (W/47)

Austria (W/55)

Further deliberation should be based on the Rome Convention. Broader adherence to this Convention would help to establish internationally accepted standards which still seem to be lacking.

Japan (W/17 and Adds.1-2)

Participants shall accede to and frame national laws based upon the Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations.
(9/13; 14/29)

Nordics (W/36)

(14/4; 14/32)

Peru (W/45)

Republic of Korea (W/48)

See items (3) and (4) below.
(16/21)

Brazil (W/57)

(17/42)

European Communities (W/26)

Signatories should be invited to adhere to the Rome Convention.
(14/31)

India (W/37)

New Zealand (W/46)

Neighbouring rights should be protected in accordance with the provisions of the Geneva Convention for the Protection of Producers of Phonograms against Unauthorised Duplication of Their Phonograms.
(16/3; 16/17)

Hong Kong (W/51)

Neighbouring rights should be protected in accordance with the text of the Geneva Convention for the Protection of Producers of Phonograms Against Unauthorised Duplication of Their Phonograms.
(17/36; 17/37)

(2) RIGHTS CONFERRED

- PERFORMERS

Existing International Standards

Under the Rome Convention, the protection provided for performers must include the possibility of preventing

- the broadcasting and the communication to the public, without their consent, of their live performance, except where the performance used in the broadcasting or the public communication is itself already a broadcast performance or is made from a fixation;

- the fixation, without their consent, of their unfixed performance;

- the reproduction, without their consent, of a fixation of their performance, if the original fixation itself was made without their consent, if the reproduction is made for purposes different from those for which the performers gave their consent, or if the original fixation was made in accordance with those provisions of the Convention which allow exceptions to neighbouring rights (see (4) below) and the reproduction is made for purposes different from those referred to in those provisions (Article 7).

(VII (A) (4))

United States (W/14/Rev.1)

Australia (W/35)

Switzerland (W/38)

The performer shall have the right to prevent all third parties not having his consent from:

- producing his performance in a place other than that of the performance;

- broadcasting the performance by any technical means or process, such as by radio wave, or by cable;

- affixing his performance on phonograms, videograms or data carriers, and from reproducing such fixations;

- offering to the public, selling, or otherwise distributing copies of the fixation containing his performance.

Hong Kong (W/51)

Japan (W/17 and Add.1)

The protection provided for performers shall include the possibility of preventing the broadcasting of their performance, the fixation of their unfixed performance, and the reproduction of a fixation of their performance, without their consent.

Nordics (W/36)

The protection provided for performers shall include the possibility of preventing:

- the broadcasting and the communication to the public of their live performance;

- the fixation of their unfixed performance;

- the reproduction of a fixation of their performance.

Performers shall enjoy protection including moral rights.

(14/32)

Canada (W/47)

Austria (W/55)

European Communities (W/26)

The protection provided for performers shall include the possibility of preventing:

(a) the broadcasting and the communication to the public of their live performance;

(b) the fixation of their unfixed performance; and

(c) the reproduction of a fixation of their performance.

India (W/37)

Peru (W/45)

New Zealand (W/46)

Republic of Korea (W/48)

Protection should be granted to live performers.

Brazil (W/57)

(2) RIGHTS CONFERRED (contd.)

- PRODUCERS OF PHONOGRAMS

Existing International Standards

Under the Rome Convention, the producers of phonograms have the right to authorize or prohibit the direct or indirect reproduction of their phonograms (Article 10).

Under the Phonograms Convention, each member State must protect producers of phonograms who are nationals of other member States against the making of duplicates without the consent of the producer and against the importation of such duplicates, provided that any such making or importation is for the purpose of distribution to the public, and against the distribution of such duplicates to the public (Article 2).

The means by which the Phonograms Convention is implemented is a matter for the domestic law of each Contracting State but it must include one or more of the following: protection by means of the grant of a copyright or other specific right; protection by means of the law relating to unfair competition; protection by means of penal sanctions (Article 3).
(VII (B) (4))

United States (W/14/Rev.1)

Australia (W/35)

Switzerland (W/38)

The producer of a phonogram or a videogram shall have the right to reproduce it, and to put on the market, to sell, or to otherwise distribute copies thereof and to prevent all third parties not having his consent from undertaking such acts.
(14/32)

Canada (W/47)

Phonograms should be protected, the obligation to protect being limited to the right of reproduction.
(16/19)

Austria (W/55)

Some states protect phonograms under copyright, neighbouring rights, or under unfair competition laws. Clarification should be sought on an international level. Austria favours the protection of phonograms as a neighbouring right.
(17/41)

Japan (W/17 and Add.1)

Producers of phonograms shall enjoy the right to authorize or prohibit the direct or indirect reproduction of their phonograms.
(9/13-14)

Nordics (W/36)

Producers of phonograms shall have the right to authorize or prohibit the direct or indirect reproduction of their phonograms.

Producers shall enjoy protection including moral rights.
(14/32)

Peru (W/45)

Republic of Korea (W/48)

Protection shall be granted to record companies.

Brazil (W/57)

European Communities (W/26)

Producers of phonograms shall enjoy the right to authorize or prohibit the direct or indirect reproduction of their phonograms.

India (W/37)

New Zealand (W/46)

Hong Kong (W/51)

(2) RIGHTS CONFERRED (contd.)

- BROADCASTING ORGANIZATIONS

Existing International Standards

Under the Rome Convention, broadcasting organizations have the right to authorise or prohibit:

- the rebroadcasting of their broadcasts;

- the fixation of their broadcasts;

- the reproduction of fixations, made without their consent, of their broadcasts or of fixations of their broadcasts made for purposes in respect of which the Convention permits exceptions, if the reproduction is made for other purposes;
- affixing it on phonograms, videograms or
- the communication to the public of their television broadcasts if such communication is made in places accessible to the public against payment of an entrance fee (Article 13).
(VII (C) (4))

United States (W/14/Rev.1)

Australia (W/35)

Switzerland (W/38)

The broadcaster shall have the right to prevent all third parties not having his consent from:

- retransmitting his broadcast;

- communicating it;

- the reproduction of fixations; data carriers, and from reproducing such fixations;

- putting on the market, selling, or otherwise distributing copies of the broadcast.

Canada (W/47)

Austria (W/55)

Japan (W/17 and Add.1)

Broadcasting organizations shall enjoy the right to authorize or prohibit the rebroadcasting and the fixation of their broadcasts, and the reproduction of fixations of their broadcasts.

Nordics (W/36)

Broadcasting organizations shall have the right to authorize or prohibit:

- the fixation of their broadcasts;

New Zealand (W/46)

- the rebroadcasting of their broadcasts and the communication to the public of their television broadcasts.

Broadcasting organizations shall enjoy protection including moral rights.
(14/32)

Peru (W/45)

Republic of Korea (W/48)

Protection shall be granted to broadcasting businesses.

European Communities (W/26)

Broadcasting organisations shall enjoy the right to authorize or prohibit:

(a) the fixation of their broadcasts;

(b) the reproduction of fixations; and

(c) the communication to the public of their television broadcasts.

India (W/37)

Hong Kong (W/51)

Brazil (W/57)

(3) TERM OF PROTECTION

Existing International Standards

The Rome Convention obliges countries party to it to protect performers, phonograms and broadcasts for at least twenty years computed from the end of the year in which:

(a) the fixation was made - for phonograms and for performances incorporated therein;

(b) the performance took place - for performances not incorporated in phonograms;

(c) the broadcast took place - for broadcasts (Article 14).
(VII (A) (5), (B) (5) and (C) (5))
(8/39)

United States (W/14/Rev.1)

Australia (W/35)

Switzerland (W/38)

The term of protection shall be no less than 20 years from the date of the performance, of the production of the phonogram or videogram, and of the broadcast.
(14/32)

Canada (W/47)

The minimum term of protection of phonograms should be 50 years.
(16/19)

Austria (W/55)

The term of protection should be at least 50 years after fixation or 50 years after performance or broadcast took place.

Japan (W/17 and Add.1)

The term of protection for performances, phonograms and broadcasts shall last at least until the end of a period of 20 years computed from the end of the year in which the fixation was made or the performance or broadcast took place.

Nordics (W/36)

The term of protection granted to producers of phonograms, performers and broadcasting organizations shall last until the end of a period of 50 years computed from the end of the year in which the fixation was made or the performance or broadcast took place.
(14/4; 14/32)

Peru (W/45)

Republic of Korea (W/48)

The protection of certain neighbouring rights concerning rights of access to the original work should be granted only to live performers, record companies and broadcasting businesses for 20 years, as under the Rome Convention.
(16/21)

European Communities (W/26)

The term of protection granted to producers of phonograms, performers and broadcasting organisations shall last at least until the end of a period of 20 years computed from the end of the year in which the fixation was made or the performance or broadcast took place.

India (W/37)

New Zealand (W/46)

Hong Kong (W/51)

Brazil (W/57)

(4) EXCEPTIONS TO RIGHTS CONFERRED

Existing International Standards

The Rome Convention provides for possible exceptions to the protection guaranteed to neighbouring rights owners. Exceptions are permitted as regards:

- private use,

- use of short excerpts in connection with the reporting of current events,

- ephemeral fixation by a broadcasting organization by means of its own facilities and for its own broadcasts,

- use solely for the purposes of teaching or scientific research (Article 15(1)).

In addition, any member State may, in its domestic law, provide for the same kinds of limitations with regard to the protection of neighbouring rights as it provides for, in its domestic law, in connection with the protection of copyright in literary and artistic works. However, compulsory licences may be provided for only to the extent to which they are compatible with the Rome Convention (Article 15(2)).

The right of broadcasting organizations under the Rome Conventions to authorize or prohibit the communication to the public of their television broadcasts in certain cases is restricted in two ways. First, it is a matter for the domestic law of the State where protection of this right is claimed to determine the conditions under which it may be exercised (a term which is generally interpreted as a possible basis also for compulsory licences). Second, member States may make a declaration that they do not recognize that right (Articles 13 and 16). Under a provision of the Rome Convention concerning both the rights of performers and the rights of producers of phonograms, if a phonogram published for commercial purposes, or a reproduction of such phonogram, is used directly for broadcasting or for any communication to the public (what are called "secondary uses" of phonograms), an equitable remuneration in the form of one single sum must be paid by the user to the performers, or to the producers of phonograms, or to both. (This is equivalent to compulsory licensing.)

United States (W/14/Rev.1)

Australia (W/35)

Switzerland (W/38)

Canada (W/47)

Austria (W/55)

Japan (W/17 and Add.1)

Exceptions to the protection of the neighbouring rights shall follow the line of the Rome Convention.

Nordics (W/36)

Any limitations and exemptions to the protection by these neighbouring rights shall be restricted to those allowed under the Rome Convention.

Peru (W/45)

Republic of Korea (W/48)

Exceptional measures on neighbouring rights should follow the provisions in the Rome Convention.

European Communities (W/26)

Limited exceptions to the exclusive rights conferred by these neighbouring rights should follow the line of the Rome Convention. (14/31)

India (W/37)

New Zealand (W/46)

Hong Kong (W/51)

Brazil (W/57)

(4) EXCEPTIONS TO RIGHTS CONFERRED (Contd.)

Existing International Standards

Domestic law may, in the absence of agreement between these parties, lay down the conditions as to the sharing of this remuneration (Article 12). The Convention, however, allows various reservations in respect of that right to equitable remuneration (Article 16).

Under the Phonograms Convention, any member State which affords protection by means of copyright or other specific right, or protection by means of penal sanctions may, in its domestic law, provide with regard to the protection of producers of phonograms the same kinds of limitations as are permitted with respect to the protection of authors of literary and artistic works. However, no compulsory licences may be permitted unless all of the following conditions are met:

- the duplication is for use solely for the purpose of teaching or scientific research;

- the licence is valid for duplication only within the territory of the member State whose competent authority has granted the licence and does not extend to the export of duplicates;

- the duplication made under the licence gives rise to an equitable remuneration fixed by the said authority taking into account, inter alia, the number of duplicates which be made (Article 6).

(VII (A) (4) and (7), (B) (4) and (7), and (C) (4) and (7)).

TABLE III: TRADEMARKS

(1) RELATION TO PARIS CONVENTION

Existing International Standards	United States (W/14/Rev.1)	Japan (W/17 and Add.1)	European Communities (W/26)
(14/36)	Participants shall accede to the Stockholm Act of the Paris Convention. (14/6)	Parties should be obliged to adhere to the Paris Convention in its latest version. (14/36)	Australia (W/35)
	Peru (W/45)	India (W/37)	Nordics (W/36)
	Switzerland (W/38)		New Zealand (W/46)
	Canada (W/47)	Republic of Korea (W/48)	Parties should accord intellectual property rights protection at least as adequate and effective as the standards contained in the Paris Convention for the Protection of Industrial Property. (16/3; 16/17)
	All countries should comply with the substantive obligations in the Stockholm text of the Paris Convention for the Protection of Industrial Property.	Austria (W/55)	Hong Kong (W/51)
	The substantive obligations imposed by the Paris Convention in respect of trademarks should be expanded to cover service marks wherever possible, e.g. in respect of the right to priority (Article 4), the period of grace (Article 5 bis), well-known marks (Article 6 bis) and the nature of the services (Article 7).	Contracting parties shall adhere to the Paris Convention in its most widely subscribed version. (16/21)	Brazil (W/57)

(2) DEFINITION

Existing International Standards

The Paris Convention obliges its member States to protect trademarks, service marks and collective marks (Articles 6sexies, 7bis). Paris Union member States are free to deter mine which kind of signs (visible, audible, three-dimensional, etc.) may serve as trade marks. The Paris Convention, however, indi cates that registration of a trademark in a Paris Union member State may always be refused on certain grounds, namely infringement of existing rights, lack of distinctive cha racter, violation of morality or public order or deceptive character of the mark (Article 6quinquies). The Paris Convention prohibits the registration and use of State emblems and official hallmarks as trademarks (Article 6ter). According to the Paris Convention, the nature of the goods to which a trademark is to be applied may not form an obstacle to the registration of the mark (Article 7).

The Nairobi Treaty on the Protection of the Olympic Symbol of 1981 obliges its member States to protect the Olympic symbol (five interlaced rings) against registration and use as a mark.
(Part III, (1))
(7/18-19; 14/36-37)

United States (W/14/Rev.1)

A trademark may consist of any sign, word, design, letter, number, colour, shapes of goods or of their packaging, or any combination thereof, capable of distinguishing the goods of one undertaking from those of other undertakings.

The term "trademark" shall include service mark and certification mark.

The nature of the goods or services to which a trademark is to be applied shall in no case form an obstacle to the registration of the trademark.
(14/43.2-3)

Australia (W/35)

Protection should be available for all marks for goods and services.

A mark is any visible sign serving to distinguish goods or services and should include any device, brand, heading, label, ticket, name, signature, word, letter or numeral, or any combination thereof.

Only marks capable of distinguishing the goods or services of one undertaking from those of another undertaking should be registered.

Registration should be denied to trade marks which are:

- incapable of ever having any distinctive character;

- contrary to law or which contain scandalous matter;

- of such a nature as to deceive or cause confusion to the public as to the nature, quality or origin of the goods or services;
or

- in conflict with earlier existing exclusive rights.
(14/43.1)

Japan (W/17 and Add.1)

A trademark shall include at least such that consists of letters, figures, signs or any combination thereof, or any of their combination with colours, and that is capable of distinguishing the goods of one undertaking from those of other undertakings.

Service marks shall be protected at least to the extent that business interests of the user are not harmed.
(14/43.1, 14/43.3)

Nordics (W/36)

A trademark may consist of any sign, word, design, letter, number, shapes of goods or of their packaging, or any combination thereof, capable of distinguishing the goods of one undertaking from those of other undertakings.

The term "trademark" shall include service marks and collective marks.
(14/43.1-2)

Switzerland (W/38)

A trademark is a sign capable of distinguishing the products of one enterprise from those of another enterprise.

It may in particular consist of words, letters, numerals, graphical representations, three-dimensional shapes, colours, or any combination of these elements.

The term "trademark" shall include service marks, collective and certification marks.

A system for the registration of trademarks without exclusion of any product shall be provided.
(14/43.2)

European Communities (W/26)

Protection shall be granted for any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

Protection shall, in particular, be denied to marks which are (i) devoid of any distinctive character, (ii) contrary to public policy or to accepted principles of morality, (iii) of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services, and (iv) in conflict with earlier rights.

The term "trademark" shall include service marks and collective marks.
(8/38; 14/43.1)

India (W/37)

Whether service marks should be protected under the trade mark law by extending the definition of trademark to cover both goods and services or whether there should be a separate legislation for service marks or whether service marks should be protected in any other manner under the legal sysem of the country should be left to the free choice of the country concerned.
(14/43.3; 17/48)

Brazil (W/57)

Protection should be granted to distinctive signs, such as names, words, denominations, monograms, emblems, and symbols which allow the differentiation of goods and services for commercial purposes. A trademark should also enable the distinction between the goods or services of two undertakings and assure quality to the consumer. Those signs which contain some elements that form part of an existing registration or conflicts there-with or are prohibited by law or by the Paris Convention shall not be registerable as trademarks.

Existing International Standards

Peru (W/45)

A trademark may consist of any sign, word, design, letter, number or any combination thereof capable of distinguishing the products or services of one undertaking from those of other undertakings.

New, visible and sufficiently distinctive signs may be registered as marks of products or ser vices. Any group or legal entity may register collective trademarks to distinguish its pro ducts or services. Among others, marks which are contrary to "ordre public" or morality or which may deceive the trade intermediaries or the consumer public as to the nature of origin of the product or service in question may not be registered as trademarks.

(16/20)

Republic of Korea (W/48)

Companies should be permitted the freedom to choose the nature of their trademarks to the degree that the claimed distinguishing feature of the concerned trademark is necessary to dis tinguish similar products. Although trademark rights should be strongly protected, too broad an interpretation of the distinguishing shape and features of a trademark would limit the freedom of other competitors, and therefore all claims of distinguishing feature should be carefully scrutinized.

A trademark may consist of sign, word, design or combination thereof, that are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

The term trademark should include service mark, collective mark, and business emblem.

Generic names of products may not be recognised as a trademark, because such recognition would restrict the freedom of businesses.

Trademark rights should not be granted for the marks which are contrary to public order or to morality.

(16/21)

New Zealand (W/46)

The term "trademark" shall include service and goods marks and certification marks. A mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, three dimensional shape or any combination thereof. A mark is any of the above when used or proposed to be used for the purpose of indicating a connection in the course of trade between the goods or service and the owner. The following trademarks are not capable of being registered:

(a) Marks which lack "distinctive"character";
(b) Marks which contain scandalous matter or which would be contrary to law or morality;
(c) Marks which would be likely to deceive or cause confusion;
(d) Marks which are in conflict with earlier rights.

(16/17)

Hong Kong (W/51)

The term "trademark" shall include service marks and certification marks. A mark shall include any sign capable of being represent- ed graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings. Protection shall be denied to marks which are:

(a) lacking in distinctive character;
(b) contrary to law or morality or are scandalous;
(c) likely to deceive or cause confusion;
(d) in conflict with earlier rights.

(17/37)

Canada (W/47)

Trademark protection (the term trademark being used to include service marks and certification marks or collective marks) should be provided for all marks capable of being represented graphically including any sign, word, design, letter, numeral, colour, shape of goods or of their packaging, or any combination thereof provided that such marks are capable of distinguishing the goods or services of one undertaking from those of other undertakings. Protection should not be provided to marks which are in conflict with earlier trademark or trade name rights.

(16/19)

Austria (W/55)

"Mark" should mean any distinctive sign which may serve to distinguish in the course of trade the goods or services of an enterprise from similar goods or services of other enterprises.

Letters, numerals, colours, three dimensional forms (including packaging, non-functional shapes) should only be protectable if acquired distinctiveness (secondary meaning) can be established.

Collective marks shall be included in the protection of marks.

(17/41)

(3) DERIVATION OF RIGHTS

Existing International Standards

The Paris Convention leaves the conditions for the filing and registration of trademarks to be determined in each member State by its domestic legislation. However, an application for the registration of a mark filed by a national of another member State 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. The Paris Convention requires that a mark duly registered in a member State shall be regarded as independent of marks registered in the other member States, including the country of origin (Article 6).

Nevertheless, the Paris Convention provides that the registration of a trademark in a member State establishes a right in all other member States to the effect that the registration of the trademark in other member States can be refused only on certain grounds specified in the Paris Convention (see (2) above) (Article 6quinquies).

The Paris Convention requires that trademarks that are well known in a member State be protected in that State even if not registered there (Article 6bis).

(III (1) and (2))
(7/18-20)

United States (W/14/Rev.1)

Use of the trademark may be a prerequisite to registration. Trademark rights may derive from use or registration or a combination thereof.

(14/44; 16/46)

Australia (W/35)

Protection should be available for all marks for goods and services on the basis either of registration or local use resulting in a reputation of the mark.

Where national legislation provides for registration use of a mark should not be required before it may be validly registered.

Protection or the right to use a mark should not be denied on the ground that the mark is used in another country or is rendered in a foreign language.

Switzerland (W/38)

Trademark rights may derive from registration or from use. Actual use of the trademark prior to the application for registration shall not be required.

Protection shall be denied to signs which are in conflict with rights acquired by third parties on trademarks, or in conflict with well-known trademarks.

Peru (W/45)

Austria (W/55)

The use of a trademark shall not be a prerequisite to registration.

Japan (W/17 and Add.1)

Exclusive rights of trademarks shall derive from either registration or use. Use of a trademark prior to registration shall not be a condition for registration.

(9/12)

Nordics (W/36)

Protection of a trademark may be acquired by registration or by use. Use of a trademark prior to registration shall not be a condition for registration.

(14/4)

New Zealand (W/46)

Actual use should not be a pre-requisite for registration.

Canada (W/47)

Trademark rights may derive from use or registration or a combination thereof. Use of the trademark in the contracting country may be a prerequisite to registration other than in circumstances where this is prohibited by Article 6quinquies of the Paris Convention for marks registered in the country of origin.

(16/19)

Brazil (W/57)

Protection for trademarks should derive from registration. The use of a trademark should not be a prerequisite for registration.

European Communities (W/26)

A trademark right may be acquired by registration or by use, in particular by use resulting in a reputation of the trademark. Use of a trademark prior to registration shall not be a condition for registration.

(8/38; 14/44)

India (W/37)

The exclusive rights under the trademark law can be derived only from registration of the trademark in accordance with the provisions of the law. It cannot be derived merely on the basis of the use of the trademark. An unregistered trademark may at best be entitled to such right as may be available under the common law system of the country.

Republic of Korea (W/48)

Trademark rights should come into existence upon their registration and prior use of trademarks should not be a pre-requisite to registration.

Hong Kong (W/51)

Protection should be available for all marks for goods and services based on registration or local use or reputation.

Use should not be a prerequisite for registration.

(4) RIGHTS CONFERRED

Existing International Standards

(III (4))
(7/18-19)

United States (W/14/Rev.1)

The owner of a trademark shall have the exclusive right to use that mark and to prevent others from using the same or a similar mark for the same or similar goods or services where such use would result in a likelihood of confusion.

Australia (W/35)

The registration of a mark should confer on the owner of the mark the right to prevent third parties, not having the owner's consent, from using in the course of trade the same or a confusingly similar mark in respect of the same goods or services.
(14/45)

Switzerland (W/38)

The registered trademark shall confer the right on its owner to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trademark in relation with the same or similar products where such use would result in a likelihood of confusion.

Peru (W/45)

The owner or licensee of a trademark shall have the exclusive right to use it and may request the protective measures to enforce his rights provided for in the respective national legislations.

Republic of Korea (W/48)

Japan (W/17 and Add.1)

The owner of a trademark shall have the exclusive right to use the registered trademark for goods for which the trademark is registered, and to prevent third parties not having his consent from using identical or similar trademarks for identical or similar goods.
(14/25)

Nordics (W/36)

The owner of a protected trademark shall have the right to prevent third parties not having his consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those for which the trademark is registered where such use would result in a likelihood of confusion.

New Zealand (W/46)

Trademark registration should give the registered proprietor the exclusive right to the use of the trademark in respect of the goods and services for which it is registered, and to prevent others from using the same or similar goods or services where such use would result in a likelihood of confusion.

Hong Kong (W/51)

The registration of a mark shall confer on the owner the right to prevent third parties, not having the owner's consent, from using in the course of trade the same or a confusingly similar mark in respect of the same goods or services.

European Communities (W/26)

The registration of a trademark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those for which the trademark is registered. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall not be required.

India(W/37)

Canada (W/47)

The owner of a trademark should have the right to exclude others from using any mark in association with any goods or services including distributing or advertising if such use would be likely to cause confusion.

Austria (W/55)

The registration of a trademark grants the owner the right to prevent any third party from any unauthorized use of the trademark.

Brazil (W/57)

The registration of a trademark shall confer on the owner exclusive rights therein.

The use, reproduction, manufacturing and non-authorised imitation by third parties, which would result in error or confusion, should be considered as a violation of the rights conferred to trademark owners.

(5) PROTECTION OF WELL-KNOWN MARKS/MARKS WITH A REPUTATION

Existing International Standards

Member States of the Paris Convention 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 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. A period of at least five years from the date of registration must be allowed for requesting the cancellation of such a mark. Member States may provide for a period within which the prohibition of use must be requested. 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 6bis).

(7/20)

United States (W/14/Rev.1)

A country shall refuse or cancel the registration and prohibit the use of a trademark likely to cause confusion with a trademark of another which is considered to be well known either in that country or internationally well known. A period of at least five years from the date of registration shall be allowed for requesting the cancellation or prohibition of use of such a trademark. No time limit shall be fixed for requesting the cancellation or the prohibition of the use of trademarks registered or used in bad faith.

(14/46.1; 16/47)

Australia (W/35)

Switzerland (W/38)

Protection shall be denied to signs which are in conflict with well-known trademarks.

(14/46.2)

Peru (W/45)

Republic of Korea (W/48)

Well-known trademarks should be protected regardless of whether they are registered in the concerned country. In order to be protected, whether the trademarks are well-known in that country also should be considered.

(16/21)

Hong Kong (W/51)

The paris Convention requires protection of well-known marks for goods. This obligation should be extended to cover well-known marks for services.

Austria (W/55)

The concept of "well-known trademark", allow ing denial of protection, will need further elaboration to become operational.

(17/41)

Japan (W/17/ and Add.1)

Protection shall be provided for well-known marks. Protection shall be extended inter alia against the use of a well-known mark for goods which are dissimilar to original goods, where the use of the mark for such dissimilar goods is liable to create confusion as to the origin of the goods.

(9/12)

Nordics (W/36)

Such protection shall be extended to prevent third parties from using, without due cause, a trademark which has a reputation in a way which takes advantage of or is detrimental to that reputation, even where the goods or services for which the trademark is registered are not identical or similar.

(14/46.2)

New Zealand (W/46)

Protection shall be provided for well-known marks. There should be protection for marks which are so well-known that the use of another identical or similar mark would cause confusion or public deception.

(16/17)

Brazil (W/57)

Protection should be provided for trademarks which are well-known in the country where such protection is granted. For that purpose, countries should examine the adoption of internal rules of protection, according to their interests and needs. Such rules may establish, for example, that well-known trademarks should be given protection in all classes and be kept on a special register so as to prevent the registration of another mark which reproduces or imitates the well-known mark, when confusion may arise as to the origin of the goods or services or when the reputation of the well-known mark is damaged. It is incumbent on the owner of the mark to have recourse to means provided in domestic legislation against violation of well-known marks.

European Communities (W/26)

Protection shall, as far as possible, also extend under trademark law or other law to the use in the course of trade of any sign which is identical with, or similar to, the trademark in relation to goods or services which are not similar to those for which the trademark is registered, where the latter has a reputation and where use of that sign without due cause takes unfair advantage of or is detrimental to the distinctive character or the repute of the trademark.

India (W/37)

The concept of well-known trademarks can apply only to a given country and it cannot be applied internationally. Whether a trademark must be regarded as a well-known mark in a given country should be left to be determined by that country in each case on the basis of the facts.

As regards the question of protection of such trademarks, it is the responsibility of the owner of a well-known trademark to apply for defensive registration of his trademark in accordance with the trademark law of the host country. It is not possible for the host country government either to cancel the registration of a trademark already given (except where there is a contravention of the law) or to prohibit the use of a trademark that has not been registered. Usually, both statutory and common law protection is available for trademarks. It is for the owner of a trademark to take appropriate legal action against any infringement of the trademark by taking recourse to such statutory or common law rights as may be available to him under the national legal system.

(14/46.1; 16/17; 16/47)

Canada (W/47)

No specific provisions proposed because Article 6bis of the Paris Convention requires protection of well-known marks for goods and as noted above, Canada proposes that this obligation be expanded to cover well-known marks for services.

(6) EXCEPTIONS TO RIGHTS CONFERRED

Existing International Standards

United States (W/14/Rev.1)

Rights shall be subject to exhaustion only in the country or customs union where granted.
(14/45)

Australia (W/35)

Switzerland (W/38)

Canada (W/47)

Austria (W/55)

Limited exceptions to exclusive rights such as fair use of descriptive terms and exhaustion of rights should be allowed.

Japan (W/17 and Add.1)

Nordics (W/36)

Peru (W/45)

(8/38)
Republic of Korea (W/48)

Brazil (W/57)

Exceptions to rights conferred by a mark, which take account of rights of third parties as well as of public interest, should be allowed. The principle of international exhaustion of rights should be applied in the case of parallel imports.

European Communities (W/26)

Limited exceptions to the exclusive rights conferred by a trademark, which take account of the legitimate interests of the proprietor of the trademark and of third parties, may be made, such as fair use of descriptive terms and exhaustion of rights.

India (W/37)

The exhaustion of the exclusive rights of the trademark owner should not be limited to the same country or the same free trade area, but should extend globally.
(14/37)

New Zealand (W/46)

Hong Kong (W/51)

(7) NATIONAL REGISTRATION SYSTEMS

Existing International Standards

In regard, to the registration of trademarks see (2) above. Member States of the Paris Convention are not required to provide for the registration of service marks (Article 6sexies).

The Paris Convention requires that, if the agent or representative of the person who is the proprietor of a mark in a member State applies, without such proprietor's authorization, for the registration of the mark in his own name, in one or more member State, 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 favour of the said registration, unless such agent or representative justifies his action. Under the same conditions, the proprietor of the mark shall also be entitled to oppose the use of his mark by his agent or representative if he has not authorized such use (Article 6septies).

(III (1) and (3))
(7/18-19)

United States (W/14/Rev.1)

A system for the registration of trademarks shall be provided. Regulations and procedures shall be transparent and shall include provisions for written notice of reasons for refusal to register and access to records of registered trademarks. Each trademark shall be published within 6 months after it is approved for registration or is registered and owners of the same or similar trademarks and other interested parties shall be afforded a reasonable opportunity to challenge such registration.

(14.47)

Australia (W/35)

Switzerland (W/38)

A system for the registration of trademarks shall be provided.

Republic of Korea (W/48)

Trademark rights should come into existence upon their registration.

Other interested parties can file against the registration within 30 days from the announcement of the registration application.

(16/21)

Brazil (W/57)

Countries should maintain a system for the registration of marks, with a view to administering existing trademark rights under conditions of fullest possible transparency. Such system should include provisions allowing third parties to raise objections to the granting of a registration, among other procedures which permit the safeguarding of rights of third parties in the country, the enforcement of law, as well as facilitate the administrative control by interested third parties of the local use of marks, including well-known marks.

Japan (W/17 and Add.1)

Opposition shall be institutionalised against the grant of the registration or the registration of the trademark.

Administrative procedures related to the opposition shall at least ensure that all parties concerned be given an opportunity to present their views and that rulings be made, on the basis of equal and clear criteria, as to grounds pleaded by the opponent.

Nordics (W/36)

A system for the registration of trademarks shall be maintained.

New Zealand (W/46)

Trademarks may be protected through a system of registration.

Hong Kong (W/51)

A system for the registration of trademarks shall be maintained.

European Communities (W/26)

A system for the registration of trademarks shall be maintained.

India (W/37)

Peru (W/45)

Canada (W/47)

A system for the registration of trademarks should be provided. A reasonable opportunity should be provided to oppose or challenge a registration.

Austria (W/55)

The procedure for registration of trademarks should include: application, examination of formal requirements, registration and examination as to substance.

The registration procedure should be speedy and all costs and fees involved should be reasonable. Whenever multiple registration requirements have to be met, fees should be degressive.

(17/41)

(8) TERM OF PROTECTION

Existing International Standards

(III(5))
(7/18-19)

United States (W/14/Rev.1)

A trademark shall be registered for no less than 10 years and shall be renewable indefinitely for further terms of no less than 10 years when conditions for renewal have been set.
(14/48)

Australia (W/35)

The registration of a mark should be allowed to be renewed indefinitely.
(14/48)

Switzerland (W/38)

Trademarks shall be registered for no less than 10 years from the filing date and may be renewed indefinitely for further terms each of them of no less than 10 years.

Peru (W/45)

The term of registration of a trademark shall be in accordance with existing national legislation and may be renewed indefinitely for a similar period.

Republic of Korea (W/48)

The term of trademark right should be 10 years from the date of its registration and renewable indefinitely in 10 year increments when conditions for renewal have been met.

Japan (W/17 and Add.1)

A trademark shall be registered for no less than 10 years and shall be renewable indefinitely where conditions for renewal are met.
(14/48)

Nordics (W/36)

The terms of registration shall be no less than 10 years and shall be renewable indefinitely for further terms of no less than 10 years.

New Zealand (W/46)

A system of registration should provide for a defined term.
(16/17)

Hong Kong (W/51)

A registered trademark should be capable of renewal indefinitely.

European Communities (W/26)

Registration of a trademark may be renewed indefinitely.
(14/48; 16/49))

India (W/37)

There should be no uniform standard for the initial period of registration of a trademark and its subsequent renewal. Each country should be free to decide the appropriate period.
(14/48)

Canada (W/47)

A trademark should be registered for no less than 10 years and should be renewable indefinitely for further terms of no less than 10 years.

Austria (W/55)

The term of protection should be at least 10 years and should be indefinitely renewable for further such terms.

There should not be any other conditions attached to the renwal of a trademark than the payment of an appropriate non-discriminatory fee.

Brazil (W/57)

The term of protection as well as the conditions for renewal of registration should be defined by national legislations.

(9) USE REQUIREMENTS

(i) FOR MAINTENANCE OF PROTECTION

Existing International Standards

The Paris Convention provides that if, in any country, use of a registered mark is compulsory the registration may be cancelled on the grounds of failure to use only after, a reasonable period and then only if the person concerned does not justify failure to use (Article 5C).

(III (2))
(7/18-19)

United States (W/14/Rev.1)

Where use of a registered trademark is required, the registration may be cancelled only after five years of continuous non-use, and then only if the person concerned does not justify the non-use. Justified non-use shall include non-use due to import prohibitions or other government laws, regulations, policies, or practices. Authorized use of a trademark by a third party shall be considered use by the trademark owner for purposes of meeting use requirements.

(14/49.1 and 3)

Australia W/35)

The registration should be capable of being cancelled if, at any time after registration, and immediately prior to the commencement of any action for cancellation, an uninterrupted period of at least three years has occurred during which there had been no use in good faith of the mark and no legitimate reasons for the non-use exist.

(14/49.3)

Switzerland (W/38)

If use of the registered trademark is compulsory, the registration may be cancelled only after the trademark has not been used during an uninterrupted period of not less than 5 years, and provided that such non-use cannot be justified. Justified non-use shall include non-use due to import restrictions on products protected by the trademark or other governmental laws, regulations, policies or practices.

Peru (W/45)

Japan (W/17 and Add.1)

In a country where use of a registered trademark is required to maintain trademark rights, the registration may be cancelled only after an uninterrupted period of at least three years of non-use, unless legitimate reasons for non-use exist.

Nordics (W/36)

If use of a registered mark is required, the registration may be cancelled only after an uninterrupted period of at least five years of non-use, unless legitimate reasons for non-use exist. Circumstances arising independently of the will of the owner of a trademark which constitute a serious obstacle to the use of the mark, such as e.g. import restrictions on products protected by the trademark, are sufficient to constitute legitimate reasons for non-use.

New Zealand (W/46)

Non-use of a registered trademark over an uninterrupted period of at least five years may be grounds for revocation.

(16/17)

Hong Kong (W/51)

The registration of a mark may be cancelled if, immediately prior to the commencement of action for cancellation, an uninterrupted period of at least five years has occurred during which there has been no use in good faith of the mark and no legitimate reasons for the non-use exist.

(17/37)

Republic of Korea (W/48)

The registration of a trademark should be cancelled after one to three years of non-use. Non-use due to import prohibitions or other government laws and regulations should be considered justified non-use.

(16/21)

European Communities (W/26)

If use of a registered mark is required to maintain trademark rights, the registration may be cancelled only after an uninterrupted period of at least five years of non-use, unless legitimate reasons for non-use exist. Circumstances arising independently of the will of the proprietor of a trademark which constitute a serious obstacle to the use of the mark (such as e.g. import restrictions on products protected by the trademark) are sufficient to constitute legitimate reasons for non-use.

(8/38; 14/49.1)

India (W/37)

Each country should be free to cancel the registration of a trademark for non-use after a reasonable period, unless valid reasons are shown for such non-use. A trademark should also be liable for cancellation if it has been registered by the owner without any bonafide intention to use it in the host country.

The use of a trademark by a third party shall be considered as use by the trademark owner only if the third party is registered as a "Registered User" by the competent authority in accordance with the provisions of the trademark law of the country. The mere authorisation of the use of the trademark by a third party through a private sanction, without the third party being registered as a "Registered User", shall not constitute use by the trademark owner for the purpose of "use" requirements.

(14/49.1 and 3)

Austria (W/55)

The period of unjustified non-use before a trademark registration can be cancelled should be at least five years; each case should be decided on its own merits.

(9) USE REQUIREMENTS (Cont.)

(i) FOR MAINTENANCE OF PROTECTION

Existing International Standards

Canada (W/37)

If use of a registered mark is required to maintain trademark rights, the registration may be cancelled only after an uninterrupted period of at least three years of non-use, unless legitimate reasons for non-use exist. Circumstances arising independently of the will of the proprietor of a trademark which constitute a serious obstacle to the use of the mark (such as import restrictions on products protected by the trademark) should be sufficient to constitute legitimate reasons for non-use. Authorized use of a trademark by a third party should be considered use by the trademark owner for purposes of meeting use requirements.

Brazil (W/57)

In order to avoid abuse trademark owners should have the obligation to use a mark in the host country lest the registration of the mark be declared forfeited.

National legislations which establish compulsory use of a mark should include provisions for forfeiture of a mark due to non-use or interrupted-use, after a reasonable period of time and in cases where the owner does not present valid justifications.

National legislations could establish the following criteria for the use of a mark: (i) a licensing agreement per se is not an evidence of the use of a mark; (ii) evidence of use by third parties requires the registration with the relevant government authority of the licence granted by the owner of the mark.

(17/43)

(9) USE REQUIREMENTS (continued)

(ii) OTHER USE REQUIREMENTS

Existing International Standards

The Paris Convention provides that trademarks, duly registered in the country of origin, shall be accepted in the other Paris Union member States for filing and protected there as is ("telle quelle"). Registration of the trademark in those other member States may only be refused on certain grounds which are specified in the Paris Convention, namely infringement of existing rights, lack of distinctive character, violation of morality or public order or deceptive character of the mark (Article 6quinquies). The obligation lasts as long as the corresponding trademark in the country of origin will be registered.

United States (W/14/Rev.1)

A country shall not impose any special requirements for the use of a trademark such as size or use in combination with another trademark.

(14/49.2; 16/46)

Australia (W/35)

Registration should not be dependent upon any special requirements for the use of a mark in combination with another mark.

Switzerland (W/38)

The use of a trademark shall not be encumbered by any special requirements, such as use in a special form or use which reduces the indication of source or use with another trademark.

New Zealand (W/46)

Japan (W/17 and Add.1)

Nordics (W/36)

Peru (W/45)

Canada (W/47)

No requirements should be imposed on the use of a trademark, that would inhibit recognition of the mark or that would inhibit the mark from serving to distinguish a good or service.

Hong Kong (W/51)

Registration should not be dependent on any special requirements for the use of a mark in combination with another mark.

Republic of Korea (W/48)

Austria (W/55)

Brazil (W/57)

In order to avoid abuse, trademark owners should have the following obligations: to avoid anti-competitive use of a mark; to avoid engaging in restrictive business practices in connection with licensing agreements, such as tied purchases of inputs, prohibition or restrictions on exports from the host country, restrictions on the use after the expiry of an agreement and others and con tribute to the transfer of technology to the host country through transparent and more favourable licensing agreement conditions.

Participants assume the obligation to control and punish national trademark owners which engage in restrictive business practices adversely affecting the rights of third parties.

(17/43)

European Communities (W/26)

(16/51)

India (W/37)

The freedom of developing countries to regulate the use of foreign trademarks in their domestic markets, in accordance with their national development objectives, should not be curtailed.

Each country should be free to stipulate any special requirements for the use of a trademark such as the size (as for example, in connection with the display of the generic name on a drug in conjunction with a brand name) or use in combination with another trademark (as for example, the use of a foreign trademark in conjunction with a domestic trademark).

The trademark law should have a clear stipulation that the foreign trademark owner should give a categorical assurance that the quality of the product bearing his trademark is identical to the product manufactured by the licensor himself in his own country and that in any litigation or proceeding concerning the quality of the product, he will give an assurance to that effect. In particular developing countries should have the freedom to regulate the quality assurance aspect of the use of trademarks which may extend not only to the quality control responsibilities of the trademark licensor but also to quality certification vis-à-vis products bearing the same trademarks in other countries.

(14/38; 14/45; 14/49.2)

(10) LICENSING AND ASSIGNMENT

Existing International Standards

The Paris Convention requires that if the law of a member State considers, the assignment of a mark valid only if it takes place at the same time as the transfer of the business or a 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, togetherwith the exclusive right to manufacture in the said country, or to sell therein, the goods bearing the mark assigned (Article 6quater).

(III (7))
(7/18-19)

United States (W/14/Rev.1)

No compulsory licensing of trademarks shall be imposed and assignment of trademarks shall be permitted.

(16/52)

Australia (W/35)

The compulsory licensing of a mark should not be permitted. Voluntary licensing should be permitted without restrictions, other than those necessary for the preservation of a connection with the owner of the mark. Assignment of marks should be available with or without the transfer of goodwill of the business concerned.

(14/50)

Nordics (W/36)

Compulsory licensing of a trademark shall not be permitted.

(14/4)

Switzerland (W/38)

The compulsory licensing of a trademark shall not be permitted.

Trademarks may be assigned with or without the transfer of the enterprise to which they belong.

(14/50)

Canada (W/47)

Licensing of trademarks should be permitted. No compulsory licensing of trademarks should be imposed. Countries should not impose unreasonable or discriminatory terms or conditions on parties negotiating voluntary licences. Trademarks should be transferable with or without the transfer of the undertaking to which they belong.

Hong Kong (W/51)

Japan (W/17 and Add.1)

A state shall not impose undue or discriminatory restrictions on a voluntary licence of a trademark owner. No non-voluntary licensing of a trademark shall be imposed. Assignment of trademarks shall be permitted.

Peru (W/45)

In order to limit the impact of restrictive business practices on trade, a trademark owner should be prohibited from imposing conditions on the licensee. The following cases are among those that should be considered: that the trademark licence should be accompanied by the obligation for the host country or undertaking to acquire goods or services from a specified source; that the owner should reserve the right to fix the sales price of the products manufactured using the trademark; the imposition of restrictions on the volume or structure of output and the prohibition or limitation of exports to specific countries of the products manufactured using the trademark; the payment of royalties for unused trademarks; the imposition of a purchase option for the supplier of the trademark.

Brazil (W/57)

National legislations should be able to establish the terms and conditions for the assignment of a mark. In order to avoid abuse trademark owners should have the following obligations: to avoid anti-competition use of a mark; to avoid engaging in restrictive business practices in connection with licensing agreements, such as tied purchases of inputs, prohibition or restrictions on exports from the host country, restrictions on the use after the expiry of an agreement, and others and contribute to the transfer of technology to the host country through transparent and more favourable licensing agreement conditions.

Participants assume the obligation to control and punish national trademark owners which engage in restrictive business practices adversely affecting the rights of third parties.

(17/43)

European Communities (W/16)

The compulsory licensing of trademarks shall not be permitted. Trademarks may be transferred with or without the transfer of the undertaking to which they belong.

(14/50; 16/52)

India (W/37)

Assignment of a trademark shall be subject to such terms and conditions as the national law may lay down to ensure that the assignment does not circumvent the basic provisions of the law.

Trademark licensing agreements containing restrictive and anti-competitive conditions should be declared by law to be null and void.

(14/39; 14/50; 16/52)

New Zealand (W/46)

There should be no provisions for compulsory licensing of a trademark. Voluntary licensing is permitted.

Republic of Korea (W/48)

No compulsory licensing of trademarks should be imposed, and the transfer of trademarks shall not be restricted.

Austria (W/55)

Compulsory licensing of trademarks shall not be permitted.

Trademarks should be transferrable without the enterprise to which they belong.

(11) NON-DISCRIMINATORY TREATMENT

Existing International Standards

The Paris Convention obliges each of its member States to grant to nationals and residents of the other member States, under the national treatment principle, the rights it grants to its own nationals (Articles 2-3). (III (2) and (4))

United States (W/14/Rev.1)

The United States proposal calls for general questions of national and mfn treatment to be addressed.

Australia (W/35)

Formal procedures should not be imposed which are, whether by direct or indirect legal or practical effect, such as to render the obtaining or maintaining of registration of a mark more difficult for foreign applicants or owners than is the case for local applicants or owners.

Australia also suggests that a TRIPS agreement should embody the basic GATT principles of non-discrimination and national treatment.

Switzerland (W/38)

The application of basic principles of GATT, in particular non-discrimination in terms both of mfn and national treatment, is essential.
(14/3)

Canada (W/47)

Procedures of the parties for the acquisition or revocation of intellectual property rights should be non-discriminatory.

Canada also advocates general mfn and national treatment obligations.
(16/22)

Japan (W/17 and Add.1)

Equal and non-discriminatory treatment shall be guaranteed in the requirements for filing a trademark application, and obtaining or maintaining the registration.

The Japanese proposal also includes suggestions for the application of general national treatment and mfn principles.
(14/4)

Nordics (W/36)

The Nordic countries advocate the inclusion in a TRIPS agreement of key GATT principles and call for particular attention in this context to inter alia the non-discrimination and national treatment principles (NG11/W/22).

Peru (W/45)

Republic of Korea (W/48)

Austria (W/55)

Parties to a future TRIPS instrument shall subscribe to international standards and principles which will eliminate any discriminatory treatment of nationals and assure a sufficient and internationally agreed level of protection.

European Communities (W/26)

The proposals of the European Communities (NG11/W/49) include suggestions for the application of general national treatment and mfn principles.

India (W/37)

See (9)(ii) above.

New Zealand (W/46)

Advocates general mfn and national treatment obligations.

Hong Kong (W/51)

Advocates general mfn, non-discrimination and national treatment obligations.

Brazil (W/57)

The principle of national treatment, as contained in the Paris Convention, should be strictly observed by national legislations.

Brazil also states that the basic principles of GATT and of intellectual property agreements or conventions would be applicable where appropriate.

(12) INTERNATIONAL REGISTRATION SYSTEMS

Existing International Standards

The Madrid Agreement (Marks) provides for the possibility of international registration of trademarks and service marks on the basis of a registration in the country of origin. The international registration has effect in the member States according to the request of the applicant, unless such effect is refused by a designated State within a certain time limit.
(III (3))

The Madrid Protocol provides for a similar system, in which the basis can be an application for registration in the country of origin, and the time-limit for refusal is longer.

United States (W/14/Rev.1)

Australia (W/35)

Switzerland (W/48)

Canada (W/47)

Austria (W/55)

Japan (W/17 and Add.1)

Nordics (W/36)

Peru (W/45)

Republic of Korea (W/48)

Brazil (W/57)

European Communities (W/26)

The establishment of or adherence to other international mechanisms relating, inter alia, to systems for the international registration of trademarks should be encouraged.
(14/52)

India (W/37)

New Zealand (W/46)

Hong Kong (W/51)

TABLE IV: GEOGRAPHICAL INDICATIONS INCLUDING APPELLATIONS OF ORIGIN

(1) PROTECTABLE SUBJECT MATTER

Existing International Standards

The Paris Convention provides that indications of source of appellations of origin are among the objects of industrial property. In one of its provisions the Paris Convention obliges member States to apply certain remedies and sanctions in cases of direct or indirect use of a false indication of the source of goods. (Member States which are not bound by Acts subsequent to 1934 are obliged to apply the said remedies and sanctions in cases where goods falsely bear as an indication of source the name of a specified locality or country, when such indication is joined to a trade name of a fictitious character or used with fraudulent intention.) (Articles 1,10)

The Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods obliges its member States to apply certain remedies and sanctions, in cases where goods bear a false - or, in the case of member States bound by Acts subsequent to 1925, a false or deceptive - indication by which one of the member States, or a place situated therein, is directly or indirectly indicated as being the country or place or origin (Article 1).

The Lisbon Agreement for the Protection of Appellations of Origin and their International Registration obliges its member States to protect appellations of origin of products of the other member States, recognized and protected as such in the country of origin and registered at the International Bureau of WIPO.
(VI (1))

Article IX:6 of the GATT requires contracting parties to cooperate with each other with a view to preventing the use of trade names in such manner as to misrepresent the true origin of a product, to the detriment of such distinctive regional or geographical names of products of a territory of a contracting party as are protected by its legislation.
(14/53-57)

United States (W/14/Rev.1

(14/56)

Australia (W/35)

Geographical indications including appellations of origin.

Switzerland (W/38)

A geographical indication is any designation, expression or sign which aims at indicating that a product is originating from a country, a region or a locality.

The norms on geographical indications also relate to services.
(14/59; 16/54)

Hong Kong (W/51)

Appellations of origin and geographical indications.

Japan (W/17 and Add.1)

(14/56)

Nordics (W/36)

Peru (W/45)

Geographical indications, including appellations of origin, are any designation, expression or sign which aims at indicating that a product originates from a country, region or locality.
(16/20)

Canada (W/47)

Protection of geographical indications, i.e. indications of source and appellations of origin, should be ensured.

Austria (W/55)

(17/40)

European Communities (W/26)

Geographical indications are, for the purpose of this agreement, those which designate a product as originating from a country, region or locality where a given quality, reputation or other characteristic of the product is attributable to its geographical origin, including natural and human factors.

Where appropriate, protection should be accorded to appellations of origin, in particular for products of the vine, to the extent that it is accorded in the country of origin.
(14/59; 16/53)

India (W/37)

New Zealand (W/46)

Geographical indications.

Republic of Korea (W/48)

Geographical indications.

Brazil (W/57)

(2) PROTECTION AGAINST UNFAIR USE

Existing International Standards

As regards the Paris Convention, see item (1) above.

As regards the Madrid Agreement (Indications of Source), see item (1) above. In addition, a provision of that Agreement obliges member States bound by Acts subsequent to 1925 to prohibit the use, in connection with the sale or display or offering for sale of any goods, of all indications in the nature of publicity capable of deceiving the public as to the source of goods, and appearing on signs, advertisements, invoices, wine lists, business letters or papers or any other commercial communication (Article 3bis). Furthermore, under the said Agreement the vendor is not prevented from indicating his name or address upon goods coming from a country other than that in which the sale takes place; but in such case the address or the name must be accompanied by an exact indication in clear characters of the country or place of manufacture or production, or by some other indication sufficient to avoid any errors as to the true source of the wares (Article 3).

The Lisbon Agreement obliges its member States to protect internationally registered appellations of origin against any usurpation or imitation, even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as "kind", "type", "make", "imitation", or the like (Article 3).

(VI (4))

United States (W/14/Rev.1)

(14/56)

Australia (W/35)

Geographical indications including appellations of origin should be protected at least to the extent necessary to ensure consumer protection and to avoid consumers being misled, confused or deceived.

Switzerland (W/38)

Geographical indications shall be protected against use which is likely to mislead the public as to the true origin of the products. Shall notably be considered to constitute such use:

- any direct or indirect use in trade in respect of products not originating from the place indicated or evoked in the geographical indication in question;
- any evocation, even where the true origin of the product is indicated or the designation is used in translation or accompanied by expressions such as "kind", "type", "style" or "imitation";
- the use of any means in the designation or presentation of the product likely to suggest a link between the product and any geographical area other than the true place of origin.

Hong Kong (W/51)

Appellations of origin and geographical indications should be protected to the extent necessary to ensure that consumers are not misled or deceived.

Japan (W/17 and Add.1)

Nordics (W/36)

Peru (W/45)

Geographical indications, including appellations of origin, shall be protected against use which is likely to confuse or mislead the public as to the true origin of the product.

New Zealand (W/46)

In order to avoid consumers being confused or deceived as to the place of origin of goods there should be a provision to prohibit false or misleading use of geographical indications.

Republic of Korea (W/48)

The use of false indications of geographical origin shall be prohibited.

Austria (W/55)

Brazil (W/57)

(16/19)

European Communities (W/26)

Geographical indications shall be protected against any use which constitutes an act of unfair competition, including use which is susceptible to mislead the public as to the true origin of the product. Shall notably be considered to constitute such use:

- any direct or indirect use in trade in respect of products not coming from the place indicated or evoked by the geographical indication in question;
- any usurpation, imitation or evocation, even where the true origin of the product is indicated or the appellation or designation is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like;
- The use of any means in the designation or presentation of the product likely to suggest a link between the product and any geographical area other than the true place of origin.

(8/42; 14/60; 16/53)

India (W/37)

Canada (W/47)

All countries should be required to provide protection for geographical indications by complying with the substantive obligations in the Paris Convention and the Canadian proposals for trademark standards.

(3) PROTECTION AGAINST USE AS A GENERIC TERM

Existing International Standards

The Madrid Agreement (Indications of Source) obliges its member States to protect indications of source but the courts of a member State can decide that an indication of source is to be considered on the territory of that State as a generic term. However, regional appellations concerning the source of products of the vine cannot be considered as generic terms (Article 4).
(VI (2))

United States (W/14/Rev.1)

(14/61)

Australia (W/35)

The standards in both the Madrid and Lisbon Agreements are considered excessive because they require protection to be afforded to names that have truly become generic and thus no significant consumer confusion or deception is involved in the use of the name.
(14/61)

Switzerland (W/38)

Appropriate measures shall be taken so as to prevent a geographical indication from developing into a designation of a generic character as a result of the use in trade for products of a different origin.
(14/61)

Hong Kong (W/51)

Japan (W/17 and Add.1)

Nordics (W/36)

Peru (W/45)

In connection with the protection to be accorded against use likely to confuse or deceive the public as to the true origin of the product, suitable measures should be taken to ensure that a geographical indication does not become a generic designation as a result of its use in the trade in products having a different origin.

Canada (W/47)

Austria (W/55)

European Communities (W/26)

Appropriate measures shall be taken under national law for interested parties to prevent a geographical indication from developing into a designation of generic character as a result of the use in trade for products from a different origin, it being understood that appellations of origin for products of the vine shall not be susceptible to develop into generic designations.
(8/42; 9/9; 14/61)

India (W/37)

New Zealand (W/46)

Republic of Korea (W/48)

Brazil (W/57)

(4) PROTECTION AGAINST USE AS A TRADEMARK

Existing International Standards

(VI (1))

United States (W/14/Rev.1)

Australia (W/35)

See (2) above.

Switzerland (W/38)

The registration of a trademark which contains or consists of a geographical or other indication designating or suggesting a country, region or locality with respect to products not having this origin shall be refused or invalidated, if the use of such indication is likely to mislead the public as to the true geographical origin of the product.

(14/62)

Republic of Korea (W/48)

The registration of trademarks using well-known geographical names shall be disapproved.

Japan (W/17 and Add.1)

Nordics (W/36)

Peru (W/45)

New Zealand (W/46)

Hong Kong (W/51)

Brazil (W/57)

European Communities (W/26)

The registration of a trademark which contains or consists of a geographical or other indication denominating or suggesting a country, region or locality with respect to goods not having this origin shall be refused or invalidated. National laws shall provide the possibility for interested parties to oppose the use of such a trademark.

(14/62)

India (W/37)

Canada (W/47)

Countries should comply, inter alia with the Canadian proposals for trademark standards.

Austria (W/55)

(5) INTERNATIONAL REGISTRATION

Existing International Standards

The Lisbon Agreement obliges its member States to protect appellations of origin which have been internationally registered. Appellations of origin which are protected as such in a member State can be registered internationally (by WIPO) at the request of the member State concerned, and such registration has effect in other member States except in any State which, within one year after registration, notifies WIPO of its refusal of the said effect.

(VI (2))

United States (W/14/Rev.1)

Australia (W/35)

See (3) above.

Switzerland (W/38)

New Zealand (W/46)

Hong Kong (W/51)

Japan (W/17 and Add.1)

Nordics (W/36)

India (W/37)

Peru (W/45)

Canada (W/47)

Austria (W/55)

European Communities (W/26)

In order to facilitate the protection of geographical indications including appellations of origin, the establishment of an international register for protected indications should be provided for. In appropriate cases the use of documents certifying the right to use the relevant geographical indication should be provided for.

(8/42)

Republic of Korea (W/48)

Brazil (W/57)

TABLE V: INDUSTRIAL DESIGNS

(1) SUBJECT MATTER AND CONDITIONS FOR PROTECTION
RELATION TO PARIS AND BERNE CONVENTIONS

Existing International Standards

The Paris Convention provides that industrial designs are one of the objects of industrial property (Article 1). In one of its provisions, which binds member States parties to Acts subsequent to 1934, the Paris Convention obliges member States to protect industrial designs. Nothing is said in that provision about the means of providing such protection, so that countries may comply with the provision not only through special legislation for the protection of industrial designs, but also through the grant of such protection, for example, in their laws on copyright or their provisions against unfair competition (Article 5 quinquies).

The Paris Convention provides that the protection of industrial designs shall not, under any circumstances, 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 (Article 5B).

See also Table I(2) on Copyright.
((V) (1) and (2))

United States (W/14/Rev.1)

(14/63)

Australia (W/35)

Industrial designs should be protected in accordance with the existing provisions of the Paris Convention.

Protection should not be denied solely on the ground that the design has a functional effect.

Switzerland (W/38)

Protection of designs shall be granted upon registration, if they are new.

The system of registration of designs shall be efficient, expeditious and available at reasonable cost.

Protection shall not extend to features required by technical reasons.

Such protection shall be granted without prejudice to the protection under the copyright law or other laws.

Canada (W/47)

Protection should be available for designs which are original or novel, a design being a two or three dimensional external appearance of an article that is not solely dictated by the utilitarian purpose of the article.

Republic of Korea (W/48)

Industrial designs which are new, original, aesthetic, and capable of industrial application should be protected upon registration.
(16/21)

Brazil (W/57)

Japan (W/17 and Add.1)

Designs which are novel and original.

Austria (W/55)

Industrial designs which are novel or original shall be protected.

Protection should be granted upon application for registration. The procedure for registration shall include deposit and examination of formal requirements. The procedure shall be speedy and all costs and fees involved should be reasonable. Whenever multiple deposit requirements have to be met, fees should be degressive.

Designs in the field of fashion and textiles have not only a short life cycle, but due to the technological progress information is spread repidly and copying can start nearly immediately. Therefore a special régime to protect designs in this field should be studied. (17/41)

Nordics (W/36)

An industrial design is the model for the appearance of an article or an ornament.

Industrial designs which are novel or original shall be protected.

Protection of an industrial design may be acquired by registration. In such a case, a system for the registration of industrial designs should be maintained.
(16/55)

New Zealand (W/46)

The provisions of the Paris Convention are considered sufficient for the purposes of protecting industrial designs.

An industrial design may be granted a right if the design is new or original.
(16/3; 16/17)

European Communities (W/26)

Industrial models and designs which are original or novel shall be protected in accordance with Articles 5B and 5 quinquies of the Paris Convention, without prejudice to the protection under copyright law.
(8/40)

India (W/37)

Hong Kong (W/51)

Design protection shall be available for the external appearance of two or three dimensional articles which are original or novel, so long as the design is not solely dictated by the functional purpose or the article. This protection should be in addition and without prejudice to Articles 5 quinquies and 10 bis of the Paris Convention as revised at Stockholm in 1967 and the protection to works of applied arts within the terms of the Paris text of the Berne Convention.
(17/36; 17/37)

Peru (W/45)

New industrial designs and models may be registered. A design will be considered to be any pattern of lines or combination of colours incorporated in an industrial or handicraft product to give it a particular appearance without changing the purpose of the produce; and a model shall be considered to be any plastic form which serves as a type for the production of industrial or handi craft products which gives them a particular appearance and does not involve any technical effects.

Designs or models relating to apparel may not be registered. Designs or models contrary to morality or "ordre public" are likewise excluded from protection.
(16/20)

(2) RIGHTS CONFERRED

Existing International Standards

See (1) above.
((V) (4) and (7))

United States (W/14/Rev.1)

Australia (W/35)

Switzerland (W/38)

The owner of the design right is entitled to prevent third parties not having his consent from manufacturing, offering, putting on the market or importing for these purposes, goods which infringe his design right.

Canada (W/47)

The owner of an industrial design right should, at a minimum, have the right to prevent others from manufacturing or selling articles bearing a design which has been copied or has been substantially copied.
(16/19)

Austria (W/55)

Any future agreement on industrial design should be a tool to prevent identical reproduction of the appearance of products which differs only in immaterial details or features from that of the protected design.

The right owner should have the right to prevent others from illegal use of his design. This right shall include the possibility to prevent the import of products which infringe the rights of the right holder.

Japan (W/17 and Add.1)

A design right shall confer on its owner the right to prevent third parties not having his consent from at least the following acts:

- acts of manufacturing, using, assigning, leasing or importing the article which is the subject matter of the registered design;

- acts of displaying, for the purpose of assignment or lease, the article.

Nordics (W/36)

The owner of a protected industrial design shall have the right to prevent third parties not having his consent from exploiting the design in the course of trade by producing, importing, offering, assigning or hiring out articles the appearance of which does not differ substantially from that of the protected design.
(14/64; 16/55)

Peru (W/45)

The registration of industrial designs or models shall confer upon the owner the exclusive right to their use.

Republic of Korea (W/48)

Brazil (W/57)

European Communities (W/26)

The protection conferred shall permit the creator and his successor in title to prevent at least the manufacture, the sale, or the importation for these purposes, of an object which infringes the model or design right.

India (W/37)

New Zealand (W/46)

An industrial design right should give the owner "the exclusive right" to make or import for sale or for use for the purposes of any trade or business, or to sell, hire or offer for sale or hire, any article in respect of which the design is registered.

Hong Kong (W/51)

The industrial design right owner shall, as a minimum, have the right to prevent third parties not having the owner's consent, from manufacturing or selling articles bearing a design that has been copied or has been substantially copied.

(3) TERM OF PROTECTION

Existing International Standards

((V) (5))

United States (W/14/Rev.1)

Australia (W/35)

The total duration of protection, including any renewal period, should be not less than 10 years.

Switzerland (W/38)

The term of registration shall be 5 years from the date of application with a possibility of renewal for two consecutive periods of 5 years each.
(14/64)

Canada (W/47)

The term of protection should be at least 10 years.
(16/19)

Brazil (W/57)

Japan (W/17 and Add.1)

The term of protection shall be at least 10 years.

Nordics (W/36)

The term of registration shall be 5 years from the date of application with a possibility of renewal for two consecutive periods of 5 years each.
(14/64)

Peru (W/45)

Republic of Korea (W/48)

The term of protection should be less than 8 years because the life cycle of industrial designs is short and longer protection of designs which are easily made may hinder free economic activities.
(16/21)

Brazil (W/57)

European Communities (W/26)

The term of protection shall be at least 10 years.

India (W/37)

New Zealand (W/46)

Initial protection should be for a minimum of 5 years with provisions for limited renewals.

Hong Kong (W/51)

The minimum term of protection shall be 10 years.
(17/37)

Austria (W/55)

The term of protection shall be five years, renewable for two consecutive periods of 5 years each; i.e. maximum protection of 15 years.

(4) COMPULSORY LICENSING/FORFEITURE

Existing International Standards

The Paris Convention provides that the protection of industrial designs shall not, under any circumstances, 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 (Article 5B).

United States (W/14/Rev.1)

Australia (W/35)

Switzerland (W/38)

The compulsory licensing of a design shall not be permitted.

The protection of designs shall not be subject to any forfeiture by reason of failure to exploit.
(14/64)

Canada (W/47)

Japan (W/17 and Add.1)

Nordics (W/36)

Peru (W/45)

Republic of Korea (W/48)

Austria (W/55)

Compulsory licensing shall not be permitted.

Brazil (W/57)

European Communities (W/26)

India (W/37)

New Zealand (W/46)

Hong Kong (W/51)

Compulsory licences shall not be permitted in respect of a design that is limited to the appeal of the appearance of an article.
(17/37)

(5) NON-DISCRIMINATORY TREATMENT

Existing International Standards

The Paris Convention obliges each of its member States to grant to nationals and residents of the other member States, under the national treatment principle, the rights it grants to its own nationals (Articles 2-3).
((V) (2) and (4))

United States (W/14/Rev.1)

The United States proposal calls for general questions of national and mfn treatment to be addressed.

Australia (W/35)

Australia suggests that a TRIPS agreement should embody the basic GATT principles of non-discrimination and national treatment.

Switzerland (W/38)

The application of basic principles of GATT, in particular non-discrimination in terms both of mfn and national treatment, is essential.
(14/3)

Canada (W/47)

Procedures of the parties for the acquisition or revocation of intellectual property rights should be non-discriminatory.

Canada also advocates general mfn and national treatment obligations.
(16/22)

Austria (W/55)

Parties to a future TRIPS instrument shall subscribe to international standards and principles which will eliminate any discriminatory treatment of nationals and assure a sufficient and internationally agreed level of protection.

Japan (W/17 and Add.1)

Equal and non-discriminatory treatment shall be guaranteed in the requirements for filing a design application, and obtaining or maintaining the registration.

The Japanese proposal also includes suggestions for the application of general national treatment and mfn principles.

Nordics (W/36)

The Nordic countries advocate the inclusion in a TRIPS agreement of key GATT principles and call for particular attention in this context to inter alia the non-discrimination and national treatment principles (NG11/W/22).

Peru (W/45)

Republic of Korea (W/48)

Brazil (W/57)

The principle of national treatment, as contained in the Paris Convention, should be strictly observed by national legislations.

Brazil also states the basic principles of GATT and of intellectual property agreements or conventions would be applicable where appropriate.

European Communities (W/26)

The proposal of the European Communities (NG11/W/49) includes suggestions for the application of general national treatment and mfn principles.

India (W/37)

New Zealand (W/46)

Advocates general mfn and national treatment obligations.

Hong Kong (W/51)

Advocates general mfn, non-discrimination and national treatment obligations.

TABLE VI: PATENTS

(1) PATENTABLE SUBJECT MATTER

Existing International Standards

The Paris Convention obliges its member States to protect inventions by patents; this obligation flows from a number of provisions of the Paris Convention, for example, those dealing with the right of priority . (Article 4). In one of its provisions, the Paris Convention prevents a member State from refusing the grant of a patent or invalidating a patent 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 4quater). The Paris Convention does not prevent member States from excluding from patentability particular classes of subject matter.
(I(1) and Annex II)
(7/9)

United States (W/14/Rev.1)

Patents shall be granted for all products and processes which satisfy the criteria or conditions for patentability. Examples of items which do not meet these criteria are: materials consisting solely of printed matter, scientific principles, methods of doing business, and algorithms and mathematical formulas per se, including those incorporated in computer programs. A patent application or a patent, however, may be withheld from publication if disclosure of the information contained therein would be detrimental to the national security.
(16/28)

Australia (W/35)

Patents should be available for inventions in all fields of technology. However, inventions which could be described as:

- discoveries, scientific theory or mathematical methods to the extent that they do not constitute industrially applicable products or processes;
- aesthetic creations;
- schemes, rules or methods of performing a mental act, playing a game or doing business;
- the presentation of information; or
- contrary to public order or morality;

may be excluded from patent protection.

Switzerland (W/38)

A patent shall be granted for any invention which meets the conditions of patentability.

An invention may relate to a product or a process.

Patents shall be available for inventions in all fields of technology.
(14/79.4)

Japan (W/17 and Add.1)

Patents shall be granted for inventions with the exceptions of inventions contrary to public order, morality or public health, and of inventions of substances manufactured through nuclear transformation.
(9/13-14; 14/79.6; 16/28)

Nordics (W/36)

Patents shall be available for inventions in all fields of technology, except for:

- inventions the publication or exploitation of which would be contrary to "ordre public" or morality;
- plant or animal varieties or essentially biological processes for the production of plants or animals; this provision does not apply to microbiological processes or the products thereof;
- human beings.

As regards biotechnological inventions, further limitations should be allowed under national law.
(14/4; 14/79.7; 16/28)

India (W/37)

Every country should be free to determine both the general categories as well as the specific products or sectors that it wishes to exclude from patentability under its national law taking into consideration its own socio-economic, developmental, technological and public interest needs. It would not be rational to stipulate any uniform criteria for non-patentable inventions applicable alike both to industrialised and developing countries or to restrict the freedom of developing countries to exclude any specific sector or product from patentability.

Developing countries should be free to provide for process patents only in sectors of critical importance to them such as food, pharmaceutical and chemical sectors.
(14/71 and 79.1)
(17/43)

European Communities (W/26)

Patents shall be available for inventions in all fields of technology, except for:

- inventions the publication or exploitation of which would be contrary to "ordre public" or morality;

- plant or animal varieties or essentially biological processes for the production of plants or animals; this does not apply to microbiological processes or the products thereof.
(8/37; 8/46; 14/79.7)

Peru (W/45)

Patents shall be granted for inventions in all fields of technology except in the following cases: inventions the publiciationor exploitation of which would be contrary to "ordre public" or morality; plant or animal varieties, or essentially biological processes for the production of plants or animals; pharmaceutical products, medicaments, active therapeutical substances, beverages or foods for human, animal or plant use; inventions which affect national development, or the processes, products or groups of products whose patentability is excluded by governments.

Biotechnology is a new science which will have applications in various fields, such as agriculture and chemical and pharmaceutical products, which are all essential sectors for manking. It is therefore necessary to carry out a thorough assessment of the consequences of granting protection for this technological field.

Brazil (W/57)

Patents should be granted to those inventions which satisfy the criteria of patentability, exception made to inventions that are contrary to morality, religion, public order, public health and bearing in mind public interest and technological and economic development considerations.

Existing International Standards

Canada (W/47)

Patents should be available for all products and processes in all fields of technology. National laws, however, may provide that the following are not patentable:

i) multicellular life forms or processes for producing new multicellular life forms;

ii) methods of medical treatment for humans or animals;

iii) mere scientific principles;

iv) schemes, plans or systems for doing business, accounting, playing games and the like;

v) printed or design material having intellectual connotations only; and

vi) algorithms and computer programs per se.

(16/19)

Austria (W/55)

The patentability of micro-organisms, pharmaceuticals and chemicals shall explicitly be provided for. For the sake of clarity, human beings shall be explicitly excluded from patentability. Further studies are required concerning the patentability of plant and animal varieties or essential biological processes for the production of plants and animals.

Republic of Korea (W/48)

Patents should be granted for products and processes which meet the conditions for patentability. They include chemical and pharmaceutical products and micro-organisms.

The following inventions, however, should not be patentable:

i) inventions liable to contravene public order or morality or to injure public health;

ii) inventions of substances manufactured by nuclear atomic transformation process.

(16/21)

New Zealand (W/46)

A patent shall be granted for an invention. However, some subject matter may be regarded as unpatentable; for example:

(a) the mere presentation of information;

(b) mere discoveries;

(c) schemes, rules or methods of performing a mental act, playing a game or doing business; and

(d) inventions the use of which would be contrary to public order or morality.

(16/17)

Hong Kong (W/51)

Patents shall be available for inventions in all fields of technology but the following may be excluded:

(a) discoveries, scientific theories or mathematical methods to the extent that they do not constitute industrially applicable products or processes;

(b) aesthetic creations, including literary, dramatic, musical or artistic works;

(c) schemes, rules or methods of performing a mental act, playing a game or doing business;

(d) inventions which would be contrary to public order or morality.

(2) CONDITIONS FOR PATENTABILITY

Existing International Standards

The Patent Cooperation Treaty (PCT) contains definitions of novelty, inventive step (or non-obviousness) and industrial applic--ability (Article 33). A claimed invention shall be considered novel if it is not anticipated by the prior art (which is defined in the Regulations to the PCT); it shall be considered to involve an inventive step if, having regard to the prior art, it is not, at the prescribed relevant (priority or application) date, obvious to a person skilled in the art; it shall be considered industrially applicable if, according to its nature, it can be made or used) in the technological sense) in any kind of industry (to be understood in its broadest sense, as in the Paris Convention). The criteria described merely serve the purposes of international preliminary examination; any Contracting State may apply additional or different criteria for purposes of determining whether, in that State, the claimed invention is patentable or not.

The Patent Cooperation Treaty (PCT) provides that the description of the international application shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art (Article 5).

United States (W/14/Rev.1)

A patent shall be granted for any patentable subject matter that is new, useful and unobvious. In this regard the terms "useful" and "unobvious" encompass or are synonymous with the terms "capable of industrial application" and "inventive step."

Australia (W/35)

Patents should be available under the first to file principle.

Patents should be available for inventions which are novel and which involve an inventive step (be non-obvious).

Novelty should be judged against a prior art base which takes into account publication in a document anywhere in the world prior to the invention. The prior art base should also take into account at least local use.

An invention shall be considered to involve an inventive step if having regard to the prior art base it is not obvious to a person skilled in the art.

(14/80.1)

Switzerland (W/38)

A patent shall be granted for any invention if it is new, involves an inventive step and is industrially applicable.

Austria (W/55)

The procedure for the grant of patents should include: application, examination of formal requirements, examination as to substance, opposition and registration.

The granting procedure should be speedy and all costs and fees involved should be reasonable. Whenever multiple registration requirements have to be met, fees should be degressive.

(17/41)

Japan (W/17 and Add.1)

Patents shall be granted for inventions of products and processes which are industrially applicable and novel and which involve an inventive step.

(9/12)

Nordics (W/36)

Patents shall be granted for inventions which are susceptible of industrial application, which are new and which involve an inventive step.

Peru (W/45)

Patents shall be granted for new creations that are capable of industrial application and involve an inventive step as well as as for those which improve upon such creations. An invention is considered capable of industrial application if its object can be manufactured or used in any kind of industry. The following shall not be considered inventions: principles or discoveries of a scientific nature; discovery of naturally-occurring substances; commercial, financial, accounting or other plans or systems to the extent that they are purely abstract in nature; therapeutical or surgical methods of human or animal treatment and diagnostic methods; and purely aesthetic creations.

(16/20)

Brazil (W/57)

Patents should be granted according to the principle of "first to file", with the possibility of pre-grant opposition by third parties. The following criteria should be respected:

(i) novelty;
(ii) industrial applicability;
(iii) inventive step; and
(iv) full disclosure of the invention, including the best mode of its working.

(16/29)

European Communities (W/26)

Patents shall be granted for any inventions, whether products or processes, which are susceptible of industrial application, which are new and which involve an inventive step.

(8/37; 8/46)

India (W/37)

New Zealand (W/46)

Conditions for the granting of a valid patent are that the invention must possess:

- novelty
- non-obviousness
- utility

(16/17)

Hong Kong (W/51)

Patents shall be granted if:

(a) the invention is new;

(b) it involves an inventive step; and

(c) it is useful or capable of industrial application.

Participants may provide for registration of petty patents or utility models.

(17/37)

Republic of Korea (W/48)

Patents should be granted for products and processes which are new, progressive and capable of industrial application.

(16/21)

Canada (W/47)

Patents should be available under the first to file principle.

Patents should be available for inventions that are new, useful and unobvious.

(3) TERM OF PROTECTION

Existing International Standards

Under the Paris Convention, patents applied for during the period of priority are independent as regards their normal duration (Article 4bis (1)-(2). Under another provision of that Convention, patents obtained with the benefit of priority must have a duration equal to that which they would have, had they been applied for or granted without the benefit of priority (Article 4bis(5)).
(I (5) and Annex VI)
(7/11)

United States (W/14/Rev.1)

A patent shall have a term of at least 20 years from filing. Extension of patent terms to compensate for delays in marketing occasioned by regulatory approval processes is encouraged.
(14/81.1)

Australia (W/35)

The term of a patent should be a minimum of 15 years from the date of filing of the application.
(14/81.2)

Switzerland (W/38)

The term of a patent shall be for no less than 20 years from the filing date of the application.

An extension of the patent term should be provided for in order to compensate for delays regarding the exploitation of the patented invention due to regulatory approval procedures.

Canada (W/47)

The term of a patent should be 20 years from the filing date of the application.

Austria (W/55)

The harmonisation of the various terms of protection should be achieved as the different length of protection in different states creates different markets which is in itself an obstacle to trade. The term of effective protection should be 20 years.

In cases where administrative authorisation for the marketing of patented pharmaceuticals by the competent authority exceeds (x) years after the filing of the application, the possibility of an extension of the term of protection of (x) years should be studied (patent term restoration).
(17/41)

Japan (W/17 and Add.1)

The term of a patent shall be 20 years from the filing date of the patent application. In the case of a divisional or continuing application, the term shall be calculated from the filing date of the earliest application. Extension may be granted to the term of a patent provided that it is not unduly long, where and to the extent that the patented invention is deterred from working by the government's regulatory review.
(9/13; 14/81.3)

Nordics (W/36)

The term of patent shall be 20 years from the date of filing of the patent application.
(14/4; 14/81.6)

Peru (W/45)

The patent shall be granted for a period considered suitable in accordance with national development interests.
(16/20)

New Zealand (W/46)

The term of patent shall be a minimum of 16 years. Extensions of term for prescribed reasons may be available.
(16/17)

Brazil (W/57)

Countries have the right to establish a term of protection in accordance with their national interests, provided that the following criteria of the Paris Convention are met; priority, independence of patents and national treatment.
(17/43)

European Communities (W/26)

The term of the patent shall be generally 20 years from the date of filing of the application.
(8/37; 9/9; 14/81.5)

India (W/37)

Developing countries should be free to set the duration at a level significantly lower than that of the industrialised countries in accordance with their own developmental, technological and public interest needs.

Developing countries should also be free to set a shorter duration of patents in sectors of critical importance to them, such as the food, pharmaceutical and chemical sectors, or to even exclude such sectors from patentability.

Considering the fact that the working of the patent - and not market reservation or importation by the patent owner - must be a fundamental objective of the patent system of developing countries, they should be free to link duration of a patent to its actual working in the host country, failing which the patent should be subject to revocation.
(14/81.4; 16/31)

Hong Kong (W/51)

Protection shall be available for 20 years from the date of filing.
(17/37)

Republic of Korea (W/48)

The term of a patent should not exceed 20 years from filing.
(16/21)

(4) RIGHTS CONFERRED

Existing International Standards

A provision of the Paris Convention provides that, where the law of a member State confers rights with respect to a product manufactured by a patented process, that State is obliged to grant to the owner of the patent the same rights if such a product is imported into it as those it grants in the case where such a product is manufactured on its territory (Article 5quater).

The Paris Convention provides that the rights under a patent do not extend to the use of the patented invention on vessels, aircraft or land vehicles temporarily or accidentally entering the waters, airspace or land of a member State (Article 5ter).

(I (4) and Annexes IV-V)
(7/10)

United States (W/14/Rev.1)

A patent shall provide the right to exclude others from the manufacture, use or sale of the patented invention and, in the case of a patented process, the right to exclude others from the importation, use or sale of at least the direct product thereof, during the patent term.

(14/82)

Australia (W/35)

The owner of a patent should be entitled to prevent third parties, not having his consent, from exploiting the invention. Exploitation should cover at least the following acts:

- where the invention is a product, the making, importing, distributing, offering for sale, selling and using of the product or the stocking of the product for such purposes;

- where the invention is a process, the use of the process or the doing, in respect of a product obtained by means of the process, of any of the acts referred to above in connection with a product invention.

Switzerland (W/38)

A patent shall confer on its owner the right to prevent third parties not having his consent from making, offering, putting on the market or using a product which is the subject matter of the patent, or importing or stocking the product for these purposes.

If the subject matter of the patent is a process, the patent confers on its owner the right to prevent third parties, not having his consent, from using that process, and from offering, putting on the market, using or importing or stocking for these purposes at least the product obtained by that process.

Japan (W/17 and Add.1)

A patent shall confer on its owner the right to prevent third parties not having his consent from at least the following acts:
where the subject matter of the patent is an invention of a product,
(i) acts of manufacturing, using, assigning, leasing or importing the product,
(ii) acts of displaying, for the purpose of assignment or lease, the product;
where the subject matter of the patent is an invention of a process, acts of using the process; where the subject matter of the patent is an invention of a process of manufacturing a product,
(i) acts of using the process,
(ii) acts of using, assigning, leasing, or importing the product directly manufactured by the process,
(iii) acts of displaying, for the purpose of assignment or lease, the product directly manufactured by the process.

(9/13; 16/32)

Nordics (W/36)

The exclusive right conferred by a patent shall imply that no one but the owner of the patent may, without his consent, exploit the invention by:
- producing, offering, putting on the market or using a product protected by the patent, or by importing or possessing the product for such purposes;
- using or offering to use a process protected by the patent or, while knowing or if it is obvious under the circumstances that the use of the process is prohibited without the consent of the owner of the patent, offering the process for use;
- offering, putting on the market or using a product made by a process protected by the patent, or importing or possessing the product for such purposes.

The exclusive right shall not include:
- exploitation for non-commercial purposes;
- exploitation by experiment relating to the subject matter of the invention;
- preparation in a pharmacy in individual cases of a medicine in accordance with a prescription, or acts carried out with a medicine so prepared.

(14/82)

European Communities (W/26)

A patent shall confer on the proprietor exclusive rights. The proprietor shall be entitled to prevent third parties not having his consent from making, offering, putting on the market or using a product which is the subject matter of the patent, or importing or stocking the product for these purposes. In the case of a patented process, the patent confers on its proprietor the right to prevent others not having his consent from using that process and from offering, putting on the market, using, or importing or stocking for these purposes the product obtained directly by that process.

Limited exceptions to the exclusive rights conferred by a patent, which take account of the legitimate interests of the proprietor of the patent and of third parties, may be made for certain acts, such as acts done privately and for non-commercial purposes and acts done for experimental purposes.

(8/37)

India (W/37)

Where a patent is granted only for a process of manufacturing a product, the owner of the process patent will have exclusive right to only the use of that process, and he will not have any exclusive right to make, use, sell or import that product.

Peru (W/45)

A patent convers upon its owner the exclusive right to exploit the invention on his own account or to grant one or more licences for its use by third parties. The patent shall not grant the exclusive right to import the patented product or the product manufactured by the patented process.

(16/20)

Republic of Korea (W/48)

Existing International Standards

New Zealand (W/46)

A patent grant shall give the patentee an "exclusive right", to stop others from using the invention during the patent term.

The patentee is entitled to make, sell, use or exercise the invention protected by the patent.

(16/17)

Hong Kong (W/51)

The owner of the patent shall have the right to prevent third parties, not having his consent, from making, offering or using a product which is the subject matter of a patent. Similarly, the owner of a patented process shall have the right to prevent third parties from using the process, or from offering or selling products made by the process.

Limited exceptions to the exclusive rights conferred by a patent, which take account of the legitimate interests of the proprietor of the patent and of third parties, may be made for certain acts, such as acts done privately and for non-commercial purposes and acts done for experimental purposes.

(17/37)

Canada (W/47)

The owner of a patent should have the right to exclude others from making, using, selling or offering for sale the patented invention. In respect of process patents, the owner should in addition have the right to exclude others from using, selling or offering for sale a product directly resulting from the use of the process in any country.

National laws, however, may provide that the owner of a patent has no right to prevent third parties from performing the following acts:

i) acts done privately and on a non-commercial scale provided that they do not significantly prejudice the economic interests of the owner of the patents; and

ii) making or using for solely experimental purposes or scientific research in relation to the technology in respect of which the patent was granted, or a competing technology.

(16/19)

Republic of Korea (W/48)

Austria (W/55)

Brazil (W/57)

The patent confers on its owner exclusive and territorially limited rights to industrially exploit his invention. The granting of a patent also confers on society in general the right to benefit from the protected technology, through, inter alia, local working.

A patent confers exclusive rights on the owner with regard to certain industrial acts, in accordance with the provisions of national legislation and in conformity with the national treatment principle established in the Paris Convention.

Exceptions to the exclusive rights of owners are admitted under certain circumstances such as restrictive business practices, unfair competition and acts done privately and for non-commercial purposes.

(5) COMPULSORY LICENSING/LICENCES OF RIGHT/EXPLOITATION FOR GOVERNMENT PURPOSES/FORFEITURE

Existing International Standards

The Paris Convention allows each of its member States to take legislative measures providing for the grant of compulsory licences to prevent the abuses which might result from the exercise of the exclusive rights conferred by the patent, for example, failure to work. Under the Lisbon (1958) Act and the Stockholm (1967) Act of the Convention, a compulsory licence 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 must be refused if the patentee justifies his inaction by legitimate reasons; such a compulsory licence must be non-exclusive and is not transferable, even in the form of the grant of a sub-licence except with that part of the enterprise or goodwill which exploits such (Article 5A).

(I (7))
(5/21; 7/13)

United States (W/14/Rev.1)

A compulsory licence may be given solely to address, only during its existence, a declared national emergency or to remedy an adjudicated violation of antitrust laws. Patents may also be used non-exclusively by a government for governmental purposes. In the case of a licence to address a national emergency or in the case of use by a government for governmental purposes, a patent owner must receive compensation commensurate with the market value of a licence for the use of the patented invention. A compulsory licence must be non-exclusive. All decisions to grant compulsory licences as well as the compensation to be paid shall be subject to judicial review. A patent shall not be revoked because of non-working.
(14/83.2 and 5; 16/33)

Australia (W/35)

Compulsory licences should be available to remedy adjudicated anti-competitive practices. Such licences shall in all circumstances be non-exclusive.

Government exploitation of patents in the national interest should be permitted.

Compulsory licences and government exploitation of patents should be subject to payment of proper compensation and the grant of such licences and the payment of compensation should be capable of independent review by a distinct higher authority.

Forfeiture of a patent on the grounds of failure to work or insufficient working should occur only if the grant of a non-voluntary licence has not prevented anti-competitive behaviour.

(14/83.5 and 7)

Japan (W/17 and Adds.1-3)

In granting a non-voluntary licence, an application for the licence shall be filed with a competent authority only on the following grounds, provided that the patentee has refused to grant a voluntary licence requested by the same applicant in accordance with normal commercial practices:

(i) the public interest concerning national security, or critical peril to life of the general public or body thereof; or

(ii) failure to exploit the patented invention or insufficient exploitation to satisfy local needs after 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, unless legitimate reasons as viewed from Government's regulation or normal commercial practices exist; or

(iii) interdependence of the invention of the applicant's patent and the earlier filed invention of the said patentee's patent.

Upon the said application, the competent authority may grant a non-voluntary licence to the extent of necessity from the ground specified above.

Participants shall minimise the granting of non-voluntary licences in order not to impede adequate protection of patent rights.

Non-voluntary licences shall be non-exclusive.

In granting a non-voluntary licence, reasonable compensation shall be provided to the patentee.

Judicial review shall be available in the following cases:

(i) the granting of non-voluntary licences and compensation therefore; and

(ii) forfeiture of a patent where applicable.
(9/13-14; 14/83.5-6; 16/33; 17/38; 17/39)

European Communities (W/26)

The granting of compulsory licences for lack or insufficiency of exploitation, compulsory licences in respect of dependent patents, official licences, and any right to use patented inventions in the public interest shall, in particular in respect of compensation, be subject to review by a court of law.

See also MTN.GNG/NG11/16/22, paragraph 22.

(8/37; 8/46; 14/67; 14/83.1 and 6; 16/33)

Nordics (W/36)

The granting of compulsory licences for lack or insufficiency of exploitation, compulsory licences in respect of dependent patents, official licences, and any right to use patented inventions in the public interest shall, in particular in respect of compensation, be subject to review by a court of law.

(14/4; 14/83.1 and 6; 16/33)

India (W/37)

The patent law should have a clear stipulation that patents are granted in order to secure that the inventions are worked in the host country on a commercial scale and to the fullest extent that is reasonably practicable without undue delay. The patent law should also make it unambiguous that the mere importation of a patented product does not amount to its working in the host country. The working of a patented invention should mean:

- where the patent has been granted in respect of a product, the making of the product

- where the patent has been granted in respect of a process, the use of the process.

Taking into account its own needs and conditions, each country must be free to specify the grounds on which compulsory licences can be granted under its law and the conditions for such grant. The grant of compulsory licences may, however, be subject to judicial review in accordance with the host country's legal system.
(continued on next page)

Existing International Standards

Switzerland (W/38)

Compulsory licences shall be non-exclusive.

Compulsory licences may be given in the event that the acts of manufacturing, selling or importing of the patented product or using of the patented process and the performance of any of these acts regarding the products obtained by the process do not suffice to satisfy the basic needs of the local market before the expiration of a period of 4 years from the date of the patent application, or 3 years from the date of the grant of the patent, whichever period expires last, and provided that the owner of the patent had refused to grant a contractual licence on terms that are in line with normal commercial practices.

Where the exploitation of the patented invention is required by reason of an overriding public interest, the possibility of exploitation of the patented invention by the government, or by third persons authorised by it, may be made available by means of a compulsory licence at any time, provided that the owner of the patent had refused to grant a contractual licence on terms that are in line with normal commercial practices.

Where the invention claimed in a later patent cannot be exploited without infringing an earlier patent, a compulsory licence may be given to the extent necessary to avoid infringement of the patent, provided that the invention claimed in the later patent involves an important technical advance in relation to the invention claimed in the earlier patent or serves an entirely different purpose.

Compulsory licences shall be granted to permit local manufacture only.

Given the possibilities of compulsory licensing, there shall be no revocation of the patent, except for invalidity.

Any decision relating to the grant of a compulsory licence or to the exploitation for governmental purposes, including the amount of the payment commensurate with the value of the invention to which the owner of the patent is entitled, shall be subject to judicial review.

(14/3; 14/83.5)

Republic of Korea (W/48)

Compulsory licences should be allowed in order to facilitate technology transfer and to balance the patentee's interests and user's interests by preventing the patentee's abuse of his exclusive right. The standards and procedures for granting patents should be reasonably consistent with the Paris Convention.

Compulsory licences may be granted in the following cases:

i) if a patented invention is required for national defence or public interest, a government should be allowed to use the invention or to let other persons use the invention;

ii) if an agreement with a patentee or an exclusive licensee is not reached in the following cases, the government may grant a licence to a requestor:

- where the patented invention has not been continuously applied in the country for three or more years except in a case of natural disaster or other unavoidable circumstance;

- where the patented invention has not been continuously applied in the country on a considerable commercial scale for three or more years without any justifiable reason, or it has not satisfied the domestic demand to an adequate degree under reasonable conditions; and

- where the patented invention is of special need to the general public.

The provision (ii), however, should not apply unless four years have passed since the date of patent application for the patented invention.

iii) if an individual creates an invention of considerable technical progress that utilizes a patented invention but cannot get a licence from the patentee or the exclusive licensee to use his patent, the government may grant a licence to the individual to use the patent.

A compulsory licence should be non-exclusive, and a patent owner should receive reasonable compensation.

(16/21)

India (W/37) (continued)

Apart from compulsory licences, developing countries should be free to provide for the automatic grant of non-voluntary licences in sectors of critical importance to them, such as food, pharmaceuticals and chemicals. The grant of such "licences of right" will not be subject to any administrative scrutiny or judicial review as the patents themselves will be deemed to be endorsed with the words "licence of right". The patent owner will be entitled to compensation in accordance with the host country's law.

Where the public interest, and in particular, national security, food production, poverty alleviation, nutrition, health care or the development of other vital sectors of the national economy so requires it, the host country government or any third person designated by it should be free to work and use the patented invention in the country, including the importation of the patented product if necessary, without the consent of the patent owner on such terms and conditions as the host country government may decide.

Where the host country government finds that a patent has not been worked on a commercial scale or has been only inadequately worked in the country without any valid reason or that the patent is being used in a manner prejudicial to the public interest, the patent should be liable to revocation. Such revocation will, however, be done after giving an opportunity of hearing to the patent owner and will also be subject to judicial review.

(14/83.3; 16/34; 17/48)

(5) COMPULSORY LICENSING/LICENCES OF RIGHT/EXPLOITATION FOR GOVERNMENT PURPOSES/FORFEITURE (continued)

Existing International Standards

Hong Kong (W/51)

A compulsory licence shall be granted, only where necessary in order to remedy adjudicated anti-competitive practices such as lack or insufficiency of exploitation. Such licences should be non-exclusive, should be subject to compensation commensurate with the fair market value of the licence, and should be subject to review by a distinct higher authority. The subject of a compulsory licence should be for the local market only, and not for export.

Hong Kong considers that there should be no provision for the forfeiture of patents.

(17/37)

New Zealand (W/46)

A compulsory licence may be given to address a declared national emergency or to remedy an adjudicated anti-competitive practice or in cases where government exploitation of that is essential. In the case of a national emergency or government exploitation for national interest reasons the compulsory licence should be granted only for the duration of that emergency and payment of adequate compensation should be granted to the patentee.

A compulsory licence shall be non-exclusive and should be subject to review by a court of law.

(16/17)

Austria (W/55

Compulsory licences shall only be granted under the following conditions:

- non-exclusiveness
- grant of adequate compensation
- subject to effective judicial review
- for domestic sales only
- only after the right holder has refused to grant a licence on normal commercial terms.

The abuse of monopolies shall be dealt with under national competition law and shall not justify a compulsory licence.

(17/41)

Peru (W/45)

The patent owner shall notify within a reasonable period that he has begun working the patent. Any person may apply for the grant of a compulsory licence to work the patent after that period has expired, provided one of the following has occurred: the patented invention has not been exploited in the country; the exploitation does not satisfy local market demand on reasonable terms and conditions as regards quantity, quality or price; the exploitation of the invention has been suspended for more then one year; the patent owner has not granted contractual licences

way that the holders of such licences may satisfy local market demand on reasonable terms and conditions as regards quantity, quality or price. The owner of a compulsory licence shall pay the patent owner suitable compensation.

(16/20)

(17/43)

Canada (W/47)

Compulsory licensing should be available to parties only under certain limited conditions and in accordance with the Paris Convention.

Any compulsory licence granted should be non-exclusive and should provide for adequate compensation to the patentee for the use of the invention.

Any decision relating to the grant of a compulsory licence or the forfeiture of a patent should be subject to judicial review.

(16/19; 16/33)

Brazil (W/57)

A patent should require from its owner fulfilment of the obligation to work his patent in the host country.

Compulsory licensing is an instrument which enables society to exercise its legitimate right to benefit from patented technology. It is also a useful tool for the control of misuse, non-use or abusive use of exclusive rights conferred through patents, as well as for the promotion of public interest.

The granting of compulsory licensing should be subject to transparency requirements. on reasonable terms and conditions in such a Some of the reasons for justifiable granting of compulsory licensing would include the non-working or insufficient local working of a patent.

Forfeiture can be applied with a view to rationalizing the system of protection of intellectual property rights, as well as to encouraging industrial working of patents.

(6) VOLUNTARY LICENSING

Existing International Standards

United States (W/14/Rev.1)

Australia (W/35)

Switzerland (W/38)

Canada (W/47)

Countries should not impose unreasonable or discriminatory terms or conditions on parties negotiating voluntary licences.

Austria (W/55)

Republic of Korea (W/48)

Japan (W/17 and Add.1)

A State shall not impose undue or discriminatory restrictions on a patentee's voluntary licence.

Nordics (W/36)

Peru (W/45)

In order to limit the impact of restrictive business practices on trade, a patent owner should be prohibited from imposing conditions on the licensee. The following cases are among those that should be considered: that the supply of technology should be accompanied by the obligation for the host country or undertaking to acquire goods or services from a specified source; that the owner should reserve the right to fix the sales price of the products manufactured using the technology in question; the imposition of restrictions on the volume or structure of output and the prohibition or limitation of exports to specific countries of the products manufactured using the patent; the prohibition of the use of competing technologies; the payment of royalties for unused patents; the imposition of a purchase option for the supplier of the technology; or the requirement that any inventions or improvements obtained as a result of the use of the technology in question should be transferred to the supplier of the patent.

New Zealand (W/46)

Hong Kong (W/51)

European Communities (W/26)

(16/22)

India (W/37)

The Negotiating Group should work out a comprehensive list of restrictive and anti-competitive conditions imposed by licensors. It is essential that the laws pertaining to intellectual property rights prohibit them and declare all licences, contracts and agreements containing such conditions to be null and void.
(14/5; 14/84.1)

Brazil (W/57)

A patent should require from its owner the fulfilment of the obligation to avoid engaging in restrictive business practices in connection with agreements for the licensing of patents, such as: tied purchases of inputs; prohibition or restriction of exports from the host country; restrictions on the use of technology after the expiry of the agreement; restrictions on research, use of personnel, adaptations, marketing, publicity, price fixing, cross-licensing agreements, and others. The infringement of this rule should entail the nullification of the agreement and, according to the circumstances, such as recidivism, should justify the denial of protection in the host country. Appropriate compensation mechanisms for losses arising from anti-competitive conditions and restrictive business practices should be sought. A patent should also require from its owner fulfilment of an obligation to contribute to the transfer of technology to the host country through transparent and more favourable licensing conditions.

Participants should undertake a commitment to control and punish their national holders of intellectual property rights who have engaged in restrictive business practices, as well as imposed anti-competitive conditions which can negatively affect the interests of other parties.

(7) NON-DISCRIMINATORY TREATMENT

Existing International Standards

The Paris Convention obliges member States to grant to nationals and residents of other member States, under the national treatment principle, the rights it grants to its own nationals (Articles 2-3).
(I (2) and (4))

United States (W/14/Rev.1)

The United States proposal calls for general questions of national and mfn treatment to be addressed.

Australia (W/35)

Formal procedures should not be imposed which are, whether by direct or indirect legal or practical effect, such as to render the obtaining or maintaining of patent protection more difficult for foreign applicants or patent owners than is the case for local applicants or owners.

Australia also suggests that a TRIPS agreement should embody the basic GATT principles of non-discrimination and national treatment.

Switzerland (W/38)

The application of basic principles of GATT, in particular non-discrimination in terms both of mfn and national treatment, is essential.
(14/3)

Republic of Korea (W/48)

Japan (W/17 Add.1)

Equal and non-discriminatory treatment shall be guaranteed in the requirements for filing a patent application, and obtaining or maintaining a patent.

The Japanese proposal also includes suggestions for the application of general national treatment and mfn principles.
(16/37)

Nordics (W/36)

The Nordic countries advocate the inclusion in a TRIPS agreement of key GATT principles and call for particular attention in this context to inter alia the non-discrimination and national treatment principles (NG11/W/22).

Peru (W/45)

Hong Kong (W/51)

Advocates general mfn, non-discrimination and national treatment obligations.

Austria (W/55)

European Communities (W/26)

The proposal of the European Communities (NG11/W/49) includes suggestions for the application of general national treatment and mfn principles.
(14/85)

India (W/37)

New Zealand (W/46)

Advocates general mfn and national treatment obligations.

Canada (W/47)

Procedures of the parties for the acquisition or revocation of intellectual property rights should be non-discriminatory.

Canada also advocates general mfn and national treatment obligations.
(16/22)

Brazil (W/57)

The principle of national treatment, as contained in the Paris Convention, should be strictly observed by national legislations.

Brazil also states that the basic principles of GATT and of intellectual property agreements or conventions would be applicable where appropriate.

TABLE VII: LAYOUT-DESIGNS (TOPOGRAPHIES) OF INTEGRATED CIRCUITS

(1) RELATION TO TREATY ON INTELLECTUAL PROPERTY IN RESPECT OF INTEGRATED CIRCUITS

Existing International Standards

(IV)
(7/21; 14/86-88)

United States (W/14/Rev.1)

(14/86)

Australia (W/35)

Integrated circuit layout designs should be protected in accordance with the existing provisions of the Treaty on Intellectual Property in Respect of Integrated Circuits done in Washington, May 1989.

Switzerland (W/38)

Canada (W/47)

Austria (W/55)

(16/21)

Japan (W/17 and Add.1)

(14/86; 16/8)

Nordics (W/36)

(14/4; 14/86)

Peru (W/45)

The protection provided by the Treaty on the Protection of Intellectual Property in respect of Integrated Circuits, concluded in Washington in May 1989, is sufficient.

Republic of Korea (W/48)

The Treaty on Intellectual Property in Respect of Integrated Circuits, under the auspices of WIPO, should be fully taken into account when making the new arrangements on the protection of layout-designs for integrated circuits.

Brazil (W/57)

(17/36; 17/37)

European Communities (W/26)

The following principles will be reviewed and completed in the light of the negotiations on a Treaty on the Protection of Intellectual Property in respect of Integrated Circuits under the auspices of WIPO.
(8/41; 14/87)

India (W/37)

Now that the Treaty on Intellectual Property in Respect of Integrated Circuits has been concluded, intellectual property protection in respect of layout-designs (topographies) would be dealt with by each country accordingly.
(14/88)

New Zealand (W/46)

Hong Kong (W/51)

Protection for layout designs (topographies) of integrated circuits should follow the provisions of the Treaty on Intellectual Property in Respect of Integrated Circuits, agreed in Washington, May 1989, except as specified below.

(2) SUBJECT MATTER FOR PROTECTION

Existing International Standards

Under the Treaty on Intellectual Property in Respect of Integrated Circuits, each Contracting Party shall have the obligation to secure, throughout its territory, intellectual property protection in respect of layout-designs (topographies) in accordance with the Treaty. The right of the holder of the right in respect of an integrated circuit applies whether or not the integrated circuit is incorporated in an article. The Treaty contains a definition of the term "integrated circuit" and of the term "layout-design (topography)". Notwithstanding that definition of the term "integrated circuit", any Contracting Party whose law limits the protection of layout-designs (topographies) to layout-designs (topographies) of semi-conductor integrated circuits shall be free to apply that limitation as long as its law contains such limitation.

The obligation to ensure intellectual property protection applies to layout-designs (topographies) that are original in the sense that they are the result of their creators' own intellectual effort and are not commonplace among creators of layout-designs (topographies) and manufacturers of integrated circuits at the time of their creation. A layout-design (topography) that consists of a combination of elements and interconnections that are commonplace is protected only if the combination, taken as a whole, fulfills these conditions (Articles 2-3).

(IV (1) and (2))

United States (W/14/Rev.1)

Protection shall be granted to any original layout-design incorporated in a semi-conductor integrated circuit chip, however the layout-design may be fixed or encoded.

Protection shall not extend to layout-designs that are commonplace in the integrated circuit industry at the time of their creation or to layout-designs that are exclusively dictated by the functions of the integrated circuit to which they apply.

Australia (W/35)

Switzerland (W/38)

Protection shall be granted to any three-dimensional disposition of an integrated circuit (topography), irrespective of the manner by which such disposition is fixed or encoded, and provided that it is not commonplace.

Such protection shall not prevent protection under other laws.

Canada (W/47)

Protection should be provided for the design, however expressed, of the disposition of the elements and the interconnections for the making of an integrated circuit product, provided that it is original and not commonplace.

(16/19; 16/58)

Japan (W/17 and Add.1)

Semi-conductor integrated circuit layouts, except:

(i) layout that is not produced as the result

(ii) layout that is already commonplace in the semi-conductor integrated circuit industry at the time of its creation; and

(iii) layout that is exclusively dictated by the function of semi-conduct circuit to which it applies.

Nordics (W/36)

The original layout-design of an integrated circuit, however fixed or encoded, shall be protected by exclusive rights.

Peru (W/45)

Republic of Korea (W/48)

European Communities (W/26)

The topography of a semi-conductor product, however fixed or encoded, shall be protected by exclusive rights.

of a creator's intellectual effort;

India (W/37)

New Zealand (W/46)

(16/4)

Hong Kong (W/51)

Austria (W/55)

Protection shall be granted to topographies, defined as a three-dimensional structure of micro-electronic semi-conductor products, on the basis of originality resulting from an intellectual effort of the creator.

Concepts, processes, systems, techniques or stored information contained in the topography shall not be protectable.

Brazil (W/57)

(3) CONDITIONS FOR OBTAINING PROTECTION

Existing International Standards

Any Contracting Party of the Treaty on Intellectual Property in Respect of Integrated Circuits is free not to protect a layout-design (topography) until it has been ordinarily commercially exploited, separately or as incorporated in an integrated circuit, somewhere in the world. Any Contracting Party is also free not to protect a layout-design (topography) until the layout-design (topography) has been the subject of an application for registration, filed in due form with the competent public authority, or of a registration with that authority; it may be required that the application be accompanied by the filing of a copy or drawing of the layout-design (topography) and, where the integrated circuit has been commercially exploited, of a sample of that integrated circuit, along with information defining the electronic function which the integrated circuit is intended to perform; however, the applicant may exclude such parts of the copy or drawing that relate to the manner of manufacture of the integrated circuit, provided that the parts submitted are sufficient to allow the identification of the layout-design (topography). Where the filing of an application for registration is required, the Contracting Party may require that such filing be effected within a certain period of time from the date on which the holder of the right first exploits ordinarily commercially anywhere in the world the layout-design (topography) of an integrated circuit; such period shall not be less than two years counted from the said date. Registration may be subject to the payment of a fee (Article 7).

(IV (2))

United States (W/14/Rev.1)

Protection may be conditioned upon fixation or registration of the layout-designs. The applicant for a registration shall be given at least two years from first commercial exploitation of the layout-design to apply for registration. Also, if deposits of identifying material or other material related to the layout-design are required, the applicant for registration shall not be required to disclose sensitive or confidential information unless it is essential to allow identification of the layout-design.

Australia (W/35)

Switzerland (W(38)

Registration may be required.

New Zealand (W/46)

Hong Kong (W/51)

Japan (W/17 and Add.1)

Protection may be conditioned upon registration of layout. In the case that commercial exploitation precedes registration, the registration shall be completed within 2 years from the first date of the commercial exploitation.

Nordics (W/36)

Protection may be conditioned upon registration of the layout-design.

The applicant for registration shall be given two years from the first commercial exploitation of the layout-design to apply for registration. If deposits of identifying material are required, the applicant shall only be required to disclose information to the extent necessary to allow identification of the layout-design.

Canada (W/47)

National laws may require registration as a condition for protection.

Austria (W/55)

Protection shall be available to both nationals and residents of the state in which the topography has first been commercially exploited or filed with the competent authority and, on a reciprocal basis, to nationals and residents of states party to an international agreement to which this state is a party, or states officially identified.

European Communities (W/26)

As regards formalities, a signatory may require registration.

India (W/37)

Peru (W/45)

Republic of Korea (W/48)

Brazil (W/57)

(4) RIGHTS CONFERRED

Existing International Standards

Under the Treaty on Intellectual Property in Respect of Integrated Circuits, any Contracting Party must consider unlawful the following acts if performed without the authorization of the holder of the right:

(i) the act of reproducing, whether by incorporation in an integrated circuit or otherwise, a protected layout-design (topography) in its entirety or any part thereof, except the act of reproducing any part that does not comply with the requirement of originality;

(ii) the act of importing, selling or otherwise distributing for commercial purposes a protected layout-design (topography) or an integrated circuit in which a protected layout-design (topography) is incorporated (Article 6(1)(a)).

Contracting States are free to consider unlawful also acts other than those specified above if performed without the authorisation of the holder of the right (Article 6(1)(b)).

(IV) (4))

United States (W/14/Rev.1)

Subject to the provisions herein, and without prejudice to other intellectual property rights, the owner of a layout-design shall have the exclusive right to:

(a) reproduce the layout-design;

(b) incorporate the layout-design in a semi-conductor integrated circuit chip;

(c) import or distribute a semi-conductor integrated circuit chip incorporating the layout-design; and

(d) authorize others to perform any of the above acts.

Australia (W/35)

Switzerland (W/38)

The owner of the topography right shall have the right to prevent third parties not having his consent from:

- copying the topography by any means or in any form;

- putting on the market, offering to the public, selling, renting, lending, import-ing, or otherwise distributing the topo-graphy or copies thereof.

Canada (W/47)

Protection should be against unauthorized copying and the distribution and importation of unauthorized copies.

(16/19)

Austria (W/55)

An exclusive right to the creation of a topography should be provided for.

Japan (W/17 and Add.1)

Exclusive rights for semi-conductor integrated circuit layout shall include;

(i) the right to manufacture semi-conductor integrated circuit from such circuit layout;

(ii) the right to transfer, to lease, to exhibit for the purpose of transferring or leasing, and to import such semi-conductor integrated circuit or products containing the circuit; and

(iii) the right to authorize others to do the same as in (i) and (ii) above.

Nordics (W/36)

The owner of a layout-design shall, without prejudice to any other intellectual property rights, have the exclusive right to do or to authorize the following:

- reproduce, whether by incorporation in an integrated circuit or otherwise, the layout-design;

- import or distribute for commercial purposes a protected layout-design.

Republic of Korea (W/48)

Brazil (W/57)

European Communities (W/6)

The exclusive rights shall include the rights to authorize or prohibit the reproduction of a topography, the commercial exploitation or the importation for that purpose of a topography or of a semi-conductor product manufactured by using the topography.

India (W/37)

Peru (W/45)

New Zealand (W/46)

Hong Kong (W/51)

(5) LIMITATIONS ON RIGHTS CONFERRED

Existing International Standards

Contracting Parties of the Treaty on Intellectual Property in Respect of Integrated Circuits must not consider unlawful the performance, without the authorization of the holder of the right, of the act of reproduction referred to in paragraph (i) of (4) above where that act is performed by a third party for private purposes or for the sole purpose of evaluation, analysis, research or teaching. An original layout-design (topography) created by that third party on the basis of such evaluation or analysis must not be regarded as infringing the rights of the holder of the right in the first layout-design (Article 6(2)(a) and (b)).

The holder of the right may not exercise his right in respect of an identical original layout-design (topography) that was independently created by a third party. (Article 6(2)(c)).

Member States are not obliged to consider unlawful the performance of any of the acts referred to in paragraph (ii) of (4) above in respect of an integrated circuit incorporating an unlawfully reproduced layout-design (topography) where the person performing or ordering such acts did not know and had no reasonable ground to know, when acquiring the said integrated circuit, that it incorporates an unlawfully reproduced layout-design (topography) (Article 6(4)).

Any Contracting Party may consider lawful the performance, without the authorization of the holder of the right, of any of the acts referred to in paragraph (ii) of (4) above where the act is performed in respect of a protected layout-design (topography), or in respect of an integrated circuit in which such a layout-design (topography) is incorporated, that has been put on the market by, or with the consent of, the holder of the right (Article 6(5)).

United States (W/14/Rev.1)

A layout-design may be reproduced for the purposes of teaching, analysis or evaluation in the course of preparation of a layout-design that is itself original.

It shall not be unlawful to import or distribute semi-conductor integrated circuit chips incorporating a protected layout-design in respect of such chips that have been sold by or with the consent of the owner of the layout-design. Any Party may provide that there shall be no liability with respect to the importation or distribution of a semi-conductor integrated circuit chip incorporating a protected layout-design by a person who establishes that he or she did not know, and had no reasonable grounds to believe, that the layout-design was protected; however, there shall be a right to a reasonable royalty for such acts after notice is received.

Australia (W/35)

Switzerland (W/38)

It is lawful to reproduce topographies for the purposes of research and teaching.

Further developments of the topography may be exploited independently, provided that they are not commonplace.

Canada (W/47)

There should be an exception for reverse engineering. Rights should be exhausted in an integrated circuit once it has been put on the market anywhere in the world by, or with the consent of, the holder of the right.
(16/19)

Austria (W/55)

An exemption for reverse engineering shall be included and a special régime for innocent infringers should be provided.

Japan (W/17 and Add.1-2)

Manufacturing another semi-conductor integrated circuit utilizing the layout of original circuit for the purpose of analysis or evaluation is permitted.

Protection will not be extended in case of transfer, lending, exhibition with a purpose of transfer or lending, or importation as commercial transactions by a person who did not know, and had no fault in not knowing the fact that the semi-conductor integrated circuit chips were reproduced without authorization, of a semi-conductor integrated circuit chip reproduced without authorization or a product in which such chips are incorporated.

However, once the third party becomes aware that the semi-conductor integrated circuit chip was reproduced without authorization, the right holder may claim to the third party any loss incurred by the conduct thereafter.

Nordics (W/36)

The reproduction for private purposes or for the sole purpose of evaluation, analysis, research or teaching shall be permitted.

The reproduction shall be permitted where, on the basis of the analysis and evaluation, a new original layout-design is created ("reverse engineering").

No contracting party shall be obliged to consider unlawful the importation or distribution of an integrated circuit incorporating an unlawfully reproduced layout-design where the person performing such acts did not know and had no reasonable ground to know that it incorporates an unlawfully reproduced layout-design; however, there shall be a right to an equitable remuneration for such acts after notice is received.

Any contracting party may consider lawful the importation or distribution of a layout-design that has been put on the market by, or with the consent of, the holder of the right.

European Communities (W/26)

The reproduction for the purpose of analyzing, evaluating or teaching shall be permitted. A topography created by an own intellectual effort on the basis of an analysis and evaluation of another topography shall not be considered to infringe the rights in the analyzed topography.

India (W/37)

Peru (W/45)

New Zealand (W/46)

Republic of Korea (W/48)

Hong Kong (W/51)

No liability shall exist in respect of innocent infringement where a protected integrated circuit design is incorporated within an article, but the owner of the design shall have a right to a reasonable royalty for such acts after notice is received.
(17/37)

Brazil (W/57)

(6) COMPULSORY LICENSING

Existing International Standards

Any Contracting Party of the Treaty on Intellectual Property in Respect of Integrated Circuits may, in its legislation, provide for the possibility of its executive or judicial authority granting a non-exclusive licence, in circumstances that are not ordinary, for the performance of any of the acts referred to in (4) above by a third party without the authorization of the holder of the right ("non-voluntary licence"), after unsuccessful efforts, made by the said third party in line with normal commercial practices, to obtain such authorization, where the granting of the non-voluntary licence is found, by the granting authority, to be necessary to safeguard a national purpose deemed to be vital by that authority; the non-voluntary licence shall be available for exploitation only in the territory of that country and shall be subject to the payment of an equitable remuneration by the third party to the holder of the right. Any such non-voluntary licence shall be revoked when the conditions referred to above cease to exist.

The provisions of the Treaty do not affect the freedom of any Contracting Party to apply measures, including the granting, after a formal proceeding by its executive or judicial authority, of a non-voluntary licence, in application of its laws in order to secure free competition and to prevent abuses by the holder of the right.

The granting of any non-voluntary licence must be subject to judicial review (Article 6(3)).

(IV) (7))

United States (W14/Rev.1)

A compulsory licence may only be given to address, only during its existence, a declared national emergency or to remedy an adjudicated violation of antitrust laws. Semi-conductor integrated circuit layout-designs may also be used non-exclusively by a government for governmental purposes. In the case of a licence to address a national emergency or use by a government, a semi-conductor integrated circuit layout-design owner must receive compensation commensurate with the market value of the licence. A compulsory licence must be non-exclusive. All decisions to grant compulsory licences as well as the compensation to be paid shall be subject to judicial review.

Australia (W/35)

Switzerland (W/38)

Hong Kong (W/51)

Japan (W/17 and Add.1)

Nordics (W/36)

Peru (W/45)

Canada (W/47)

National laws may provide for compulsory licensing only for abuses under competition law.

(16/19)

Austria (W/55)

Compulsory licences shall not be permitted.

European Communities (W/26)

India (W/37)

New Zealand (W/46)

Republic of Korea (W/48)

Brazil (W/57)

(7) TERM OF PROTECTION

Existing International Standards

Under the Treaty on Intellectual Property in Respect of Integrated Circuits, protection must last at least eight years (Article 8).
(IV (5))

United States (W/14/Rev.1)

The term of protection shall be at least ten years from the date of first commercial exploitation or the date of registration, if required, whichever is earlier.

Australia (W/35)

Switzerland (W/38)

Topographies shall be protected for a term of no less than 10 years from the filing date or from the date of the first commercial exploitation, whichever is earlier.

If registration is required by law, and no application is filed, the protection of the topography shall lapse after 2 years from the date of the first commercial exploitation.

Notwithstanding the preceding, protection shall lapse 15 years after the creation of the topography.
(14/86)

Republic of Korea (W/48)

Brazil (W/57)

Japan (W/17 and Add.1)

The duration of protection shall be at least 10 years from the date of registration or from the first date of commercial exploitation.

Nordics (W/36)

The term of protection shall be ten years from the date of the first commercial exploitation or the date of the filing of the application for registration, if required, whichever is earlier.
(14/86)

New Zealand (W/46)

Hong Kong (W/51)

Protection shall be given for 10 years from the date of creation if the design has been commercially exploited, or 15 years if there has been no exploitation.
(17/37)

European Communities (W/26)

India (W/37)

Peru (W/45)

Canada (W/47)

The term of protection should be 10 years.

Austria (W/55)

The term of protection under a registration system for eligible topographies should be 10 years from the date of first commercial exploitation or the date of filing with the competent authority, whatever occurs first.

TABLE VIII: PROPRIETARY INFORMATION
TRADE SECRETS/ACTS CONTRARY
TO HONEST COMMERCIAL PRACTICES

GENERAL

Existing International Standards

United States (W/14/Rev.1)

(14/89;16/6;17/46;17/50)

Australia (W/35)

Switzerland (W/38/Add.1)

(17/44)

Canada (W/47)

Austria (W/55)

(17/41)

Japan (W/17 and Add.1)

Nordics (W/36)

(14/4)

Peru (W/45)
(14/90; 17/48)

Trade secrets do not fall within the Negotiating Group's mandate, since the basis of intellectual property rights is that they should be disclosed, published and registered, which by definition is not applicable to the notion of trade secrets. In this case protection should be governed by the relevant provisions of civil law and not by intellectual property law.
(17/37)

Republic of Korea (W/48)

Brazil (W/57)

Trade secrets are not the object of intellectual property protection since the latter deals only with disclosable subject matters. Therefore, trade secrets should not be the subject of discussion in the Negotiating Group.

The regulation of acts related to the maintenance of secrets should be left to legal provisions of national systems such as the Civil and the Criminal Codes, which are of different legal nature than that of intellectual property.

European Communities (W/26)

India (W/37)

Since trade secrets cannot be regarded as intellectual property, it is beyond the mandate of the Negotiating Group to consider this matter.

New Zealand (W/46)

(16/4)

Hong Kong (W/51)

(1) SUBJECT MATTER FOR PROTECTION

Existing International Standards

United States (W/14/Rev.1)

Trade secret protection should be broadly available and cover items such as any formula, device compilation of information, computer program, pattern, technique or process that is used in one's business or that has actual or potential economic value from not being generally known. Protection should be accorded both to technical information, such as technical drawings or operational specifications, and commercial information, such as price or customer lists or business methods, regardless of whether the trade secret is in a tangible form, such as a machine or written record, or is maintained without tangible means, for example, by memory.
(9/11;16/61;16/64;17/50)

Switzerland (W/38/Add.1)

Proprietary information consists of technical or commercial knowledge of any content and in any form, and which is not protected under other intellectual property laws, provided that:

1. such knowledge derives actual or potential commercial value from not being known to the public,

2. such knowledge is not readily accessible, and

3. the rightful proprietor has the will to keep the secrecy of such information and reasonable efforts are made under the circumstances to that effect.
(17/44; 17/45)

Japan (W/17 and Add.1)

(5/22)

Hong Kong (W/51)

Trade secrets should be protected to the extent that the information must be of a confidential nature, in that it must not be something which is public property or public knowledge and that the information the subject of the claim must have been communicated in circumstances importing an obligation of confidence.
(17/37)

Australia (W/35)

India (W/37)

Peru (W/45)

New Zealand (W/46)

Republic of Korea (W/48)

Brazil (W/57)

European Communities (W/26)

Trade and business secrets.

Nordics (W/36)

Trade and business secrets.

Canada (W/47)

Trade and business secrets.

Austria (W/55)

Information and know-how independently or accompanying the grant of patents or other IPRs.

(2) PROTECTION GRANTED

Existing International Standards

Member States of the Paris Convention must assure to nationals of other member States effective protection against unfair competition. The Paris Convention deems any act of competition contrary to honest practices in industrial or commercial matters an act of unfair competition (Article 10bis).

United States(W/14/Rev.1)

Trade secrets must be protected from actual or threatened misappropriation, and the owner shall be entitled to full compensation for misappropriation. In assessing liability for misappropriation involving use or disclosure of a trade secret disclosed by mistake or by one who had misappropriated it, authorities may take into consideration whether the recipient has in good faith paid value for the secret or changed position to his detriment as a result of its receipt.

(16/61;17/50)

Australia (W/35)

Switzerland (W/38/Add.1)

Appropriation and use of proprietary information without the consent of the proprietor shall be unlawful.

Voluntary licensing of proprietary information shall not be discouraged and impeded by disclosure of, or legal permission to disclose, such information to third parties or to the public without the consent of the proprietor. In particular, there shall be no laws, regulations and practices limiting the lifespan of a proprietary information or imposing excessive and discriminatory conditions on the use of licensed information.

There shall be no compulsory licensing of proprietary information.

(17/44)

Austria (W/55)

Information and know-how, independently or accompanying the grant of patents or other intellectual property rights, should be adequately protected under national law.

There is a limit to protection of trade secrets as know-how is often linked to a person.

(17/41)

Japan (W/17 and Add.1)

Nordics (W/36)

Trade and business secrets shall be protected by law by providing their proprietor the right to prevent these secrets from becoming available to, or being used by, others in a manner contrary to honest commercial practices.

Peru (W/45)

Canada (W/47)

Trade and business secrets should be protected.

The owners of trade and business secrets should have the right to prevent them from becoming available to or being used by others in a manner contrary to honest commercial practices.

Republic of Korea (W/48)

European Communities (W/26)

Trade and business secrets shall be protected by law at least by providing their proprietor the right to prevent these secrets from becoming available to, or being used by, others in a manner contrary to honest commercial practices.

(8/43; 8/46)

India (W/37)

New Zealand (W/46)

Hong Kong (W/51)

In addition to the obligations to refrain from unfair competition required by Article 10bis of the Paris Convention, trade secrets should be protected against unauthorized use of the information to the detriment of the proprietor of the trade secrets.

(17/37)

Brazil (W/57)

(3) TERM OF PROTECTION

Existing International Standards

United States (W/14/Rev.1)

A trade secret should be protected so long as it is not public knowledge, general knowledge in an industry, or completely disclosed by the results of a use of the trade secret.
(16/61;17/50)

Australia (W/35)

Switzerland (W/38/Add.1)

There shall be no laws, regulations and practices limiting the lifespan of a proprietary information.
(17/45)

Japan (W/17 and Add.1)

Nordics (W/36)

Peru (W/45)

Republic of Korea (W/48)

Canada (W/47)

Austria (W/55)

European Communities (W/26)

India (W/37)

New Zealand (W/46)

Hong Kong (W/51)

Brazil (W/57)

(4) MAINTENANCE OF PROTECTION

Existing International Standards

United States (W/14/Rev.1)

To maintain legal protection, the owner of a trade secret may be required to make efforts reasonable under the circumstances to maintain such secrecy but need not show that no one else possesses the trade secret. Without losing the requisite secrecy, the owner may communicate a trade secret to employees involved in its use, communicate a trade secret to others pledged to secrecy or make any other communications required by law or as a condition for marketing.
(16/61)

Switzerland (W/38/Add.1)

See (1) above.

Hong Kong (W/51)

See (1) above.

Japan (W/17 and Add.1)

Australia (W/35)

Nordics (W/36)

Peru (W/45)

Canada (W/47)

Austria (W/55)

European Communities (W/26)

India (W/37)

New Zealand (W/46)

Republic of Korea (W/48)

Brazil (W/57)

(5) DEFINITION OF MISAPPROPRIATION

Existing International Standards

United States (W/14/Rev.1)

Misappropriation means the acquisition, disclosure or use of trade secret without a privilege to acquire, disclose or use it. Misappropriation includes discovery of the trade secret by improper means; use or disclosure of a trade secret in breach of a confidence; acquisition of a trade secret from a third person with notice that it was a secret and that the third person misappropriated it; acquisition, disclosure, or use of a trade secret with notice that its disclosure was made by mistake; or use or disclosure of a trade secret after receiving notice that it was disclosed by mistake or by one who had misappropriated it.
(16/61)

Australia (W/35)

Switzerland (W/38/Add.1)

Hong Kong (W/51)

Japan (W/17 and Add.1)

Nordics (W/36)

Peru (W/45)

Canada (W/47)

Austria (W/55)

European Communities (W/26)

India (W/37)

New Zealand (W/46)

Republic of Korea (W/48)

Brazil (W/57)

(6) CONDITIONS ON GOVERNMENT USE

Existing International Standards

United States (W/14/Rev.1)

Trade secrets submitted to governments shall not be disclosed or used for the benefit of third parties except in compelling circumstances involving major national emergencies posing an imminent unreasonable risk to health or the environment, or to facilitate required health and safety registrations. Government use or disclosure on the basis of a national emergency may only be made where other reasonable means are not available to satisfy the need for which the government seeks to disclosure or use the trade secret, and the government may use it only for the duration of that emergency. Government use or disclosure to facilitate required health and safety registrations may only be made if the trade secret has not been submitted within the previous ten years and full compensation is made for the use or disclosure. In any case, a government shall not use or disclose a trade secret to an extent greater than required to achieve one of the above needs without providing the submitter with a reasonable opportunity to oppose the proposed use or disclosure, including the opportunity to secure judicial review, or without providing for the payment of full compensation as in the case of personal property.

(16/61)

Australia (W/35)

Brazil (W/57)

Japan (W/17 and Add.1)

Nordics (W/36)

Switzerland (W/38/Add.1)

Proprietary information provided to a governmental agency in order to obtain permission to produce or market a product, such as results of clinical or safety tests, shall not be disclosed without the consent of the proprietor, except to other governmental agencies if necessary to protect human, plant or animal life, health or the environment.

Governmental agencies shall not be entitled to use the information for commercial purposes. They may disclose it only to the extent indispensable to inform the general public about the actual or potential danger of a product.

Disclosure of proprietary information to a third party, or other governmental agencies, in the context of an application to obtain intellectual property protection, shall be subject to an obligation to hear the applicant and to judicial review.

Third parties and governmental agencies having obtained such information shall be prevented from further disclosure and from commercial use of it without the consent of the proprietor.

(17/44; 17/45)

Hong Kong (W/51)

European Communities (W/26)

India (W/37)

Peru (W/45)

New Zealand (W/46)

Canada (W/47)

(16/19)

Republic of Korea (W/48)

Austria (W/55)