

**Council for Trade-Related Aspects  
of Intellectual Property Rights  
Special Session**

**MULTILATERAL NOTIFICATION AND REGISTRATION SYSTEMS**

Note by the Secretariat

*This document has been prepared under the Secretariat's own responsibility and without prejudice to the positions of Members and to their rights and obligations under the WTO.*

1. The second Special Session of the Council for TRIPS, held on 28 June 2002, agreed to ask the WTO Secretariat, with the assistance of the International Bureau of the World Intellectual Property Organization (WIPO), to prepare a factual background paper on existing international systems of notification and registration at the multilateral level (TN/IP/M/2, paragraphs 118-119). This paper attempts to respond to this request. While it has been prepared with the assistance of the International Bureau of WIPO, it is circulated on the responsibility of the WTO Secretariat only.
2. With regard to notification systems, this paper focuses, for reasons of practicality, on those multilateral systems in place in the WTO and in the intellectual property field. With regard to WTO notification systems, an overview of such systems was prepared by the Secretariat in 1994 and circulated as document COM.TD/W/515. Annex 1 of this note reproduces the main elements of the listing of these notification requirements under the various WTO agreements and decisions. Annex 2 contains a somewhat more detailed description of the various notification requirements under the TRIPS Agreement. With regard to multilateral notification systems relating to intellectual property rights outside the WTO, this note focuses on notification systems within the framework of WIPO. A summary of such systems, provided by the International Bureau of WIPO, is contained in Annex 3.
3. The WTO notification requirements serve a variety of purposes, which can be categorized as follows (of course, some may have more than one of the characteristics listed below):
  - (i) Where the main purpose is to provide information or, put differently, to ensure transparency. In some cases, this is to facilitate the task of various WTO bodies in reviewing implementation of the agreements for which they are responsible and, in particular, monitoring compliance with the obligations under those agreements. Examples include the requirements under most WTO agreements, including the TRIPS Agreement, to notify national implementing legislation. In some cases, notifications are aimed at forestalling possible trade problems by facilitating bilateral consultations; examples can be found under the Agreement on Technical Barriers to Trade and the Agreement on the Application of Sanitary and Phytosanitary Measures.

In some cases, notifications are required of the results of the use of procedures under the WTO, for example consultations under the Safeguard Agreement or in the area of dispute settlement. A particular type of notification that might be noted are so-called "reverse" notifications by affected countries about the measures taken by other Members; examples can be found in the Decision of the Council for Trade in Goods on the Reverse Notification of Non-Tariff Measures and in the Understanding on Balance-of-Payments Provisions.

- (ii) Where the notification is required in connection with the invocation of certain exceptions, transition periods or other benefits under WTO agreements. Examples in relation to the use of exceptions can be found in the TRIPS Agreement under Articles 3.1 and 4(d) and in the Safeguards Agreement. Examples regarding transition periods and other benefits can be found in the Agreement on Subsidies and Countervailing Measures and the Agreement on Article VII of the GATT (the Customs Valuation Agreement).
- (iii) Where the main purpose is to facilitate further contacts and cooperation between Members, for example through the notification of enquiry or contact points. An example can be found in Article 69 of the TRIPS Agreement.
- (iv) Where a notification is part of the process of initiating a procedure under the WTO, for example the renegotiation of tariff concessions or the use of the dispute settlement mechanism.

4. A procedure which deserves special mention is that concerning the communication of state emblems, official hallmarks, and names, abbreviations and emblems of intergovernmental organizations under Article 6*ter* of the Paris Convention. Article 6*ter* is also a requirement under the TRIPS Agreement by virtue of its Article 2.1.<sup>1</sup> The effect of notifications under this provision is to require Member States to provide protection against the registration of such subject-matter or its use as trademarks or elements of trademarks as provided for in Article 6*ter* of the Paris Convention, unless they transmit objections within a 12-month period. Further details of how this procedure works in the TRIPS context can be found in Annexes 2 and 3 of this note.

5. With regard to existing multilateral registration systems, WIPO administers a number of systems aimed at facilitating the acquisition of industrial property protection in more than one country or group of countries through a single application. These systems are often referred to as international registration systems. The treaties upon which they are based are the following:

- Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (1958);
- Madrid Agreement Concerning the International Registration of Marks (1891) and Madrid Protocol Relating to that Agreement (1989);
- The Hague Agreement Concerning the International Deposit of Industrial Designs (1934 Act; 1960 Act; Geneva Act (1999))<sup>2</sup>;

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<sup>1</sup> Under Article 3 of the WIPO-WTO Agreement, the procedures relating to communication of emblems and transmittal of objections under the TRIPS Agreement are administered by the International Bureau of WIPO.

<sup>2</sup> The last revision of the Hague Agreement, the Geneva Act of 1999, has not yet entered into force. In view of the fact that the vast majority of international deposits made under the Hague Agreement are governed by the 1960 Act, all references in the present document to that Agreement are references to the 1960 Act, unless otherwise indicated.

- Patent Cooperation Treaty (PCT) (1970).

6. In addition, the Treaty on the International Registration of Audiovisual Works (Film Register Treaty "FRT") was concluded in 1989 under the aegis of WIPO. The operation of the system established by this Treaty has been, however, suspended *sine die* the Assembly of the FRT Union in 1993, and subsequently by the WIPO General Assembly in 2000. In spite of this, information on the FRT is included in this note since it is an example of a multilateral registration system.

7. WIPO also administers the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure. The main feature of the Treaty is that a contracting State which allows or requires the deposit of microorganisms for the purposes of patent procedure must recognize, for such purposes, the deposit of a microorganism with any "international depositary authority", irrespective of whether such authority is on or outside the territory of the said State.

8. The multilateral registration systems mentioned in paragraph 5 can be put into a number of categories from the perspective of their legal effects in the contracting parties at the national level:

- (i) Where the legal effect of an international application<sup>3</sup> is the same as if a national application has been made in each of the designated contracting parties, i.e., the effect is to set in motion national procedures for considering whether national rights should be granted and the system does not provide for the grant of an international title of protection. (Patent Cooperation Treaty)
- (ii) Where the effect of an international application is to require each of the designated contracting parties to protect the subject-matter in accordance with national or regional law, unless it has lodged a refusal to protect within a certain period (6, 12, 18 or more months). The system provides for the grant of an international title of protection, which provides for protection in each contracting party as if a national title had been granted in that jurisdiction. However, the office of each designated contracting party can refuse to grant the protection. In case of refusal, the holder of the international registration or deposit has the same remedies as if the mark or industrial design had been deposited by him directly with the refusing office. (Madrid Agreement, Madrid Protocol and The Hague Agreement)
- (iii) Where the effect of an application is similar to that under (ii), except that the agreement also specifies substantive protection that must flow from international registration, rather than leaving this entirely to national legislation. (Lisbon Agreement)
- (iv) Where the effect of an application is to require each contracting party to presume the validity of statements recorded in an international register, notably about claimed rights, unless the contrary is proved. (Film Register Treaty)

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<sup>3</sup> In each case in this paragraph, what is said relates to applications that meet the formal requirements set out in the treaty in question.

9. A table summarizing the main features of the treaties referred to above follows. It also enumerates the main features of the only other multilateral system of this nature, namely the Stresa Convention for the Use of Appellations d'Origine and Denominations of Cheeses. It should be noted that the information on the Madrid Agreement also applies to the Madrid Protocol, except where otherwise indicated. More detailed summaries of the WIPO systems, provided by the International Bureau of the WIPO, can be found in Annex 4. In addition, attention is drawn to the notes prepared by the WTO Secretariat on existing national and international notification and registration systems for geographical indications (IP/C/W/85 of 17 November 1997 and IP/C/W/85/Add.1 of 2 July 1999).

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**TREATIES ADMINISTERED BY WIPO AND IN FORCE:  
Lisbon Agreement, Madrid Agreement and Madrid Protocol**

	<b>Lisbon Agreement for the Protection of Appellations of Origin and their International Registration</b>	<b>Madrid Agreement Concerning the International Registration of Marks</b>	<b>Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks</b>
<b>Protection facilitated</b>	Protection of appellations of origin for products.	Registration of marks for goods and/or services, including collective, certification and guarantee marks.	
<b>How is the application filed?</b>	By the offices of the contracting parties in the name of any natural persons or legal entities, public or private, having, according to their national legislation, a right to use the appellation, directly with the International Bureau.	By a national or domiciliary of one of the contracting parties or a person with real and effective industrial or commercial establishment in one such contracting party, with the International Bureau of WIPO, through the office of origin.	
<b>Main conditions for application</b>	Protection of the appellation of origin in the contracting party of origin.	The applicant must first have the mark registered in the national office of origin.	Same as for the Madrid Agreement, except that the applicant may also base his international application on a mark registered in the regional office of origin or on an application for national or regional registration filed in the national or regional office of origin.
<b>Coverage of application</b>	All contracting parties other than the contracting party of origin.	Contracting parties designated by the applicant other than the contracting party of origin. <sup>4</sup>	

<sup>4</sup> The designation in a given international registration of the contracting parties where protection is sought may take place at the stage of the international application or subsequently. In this latter case, the procedure concerning recording, notification, publication and refusal of protection applies *mutatis mutandis* to the contracting parties designated subsequently.

	<b>Lisbon Agreement for the Protection of Appellations of Origin and their International Registration</b>	<b>Madrid Agreement Concerning the International Registration of Marks</b>	<b>Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks</b>
<b>Procedure following application</b>	<p>Once the application is in conformity with formal requirements, the registration is made by the International Bureau in the International Register of Appellations of Origin. The International Bureau communicates the registration to the other contracting parties and publishes it in <i>Les Appellations d'origine</i>. Each such contracting party may, within one year, notify, together with an indication of the grounds, the International Bureau that they cannot ensure the protection of the registered appellation.</p>	<p>Once the application is in conformity with formal requirements, the International Bureau records the mark in an International Register, publishes the registration in the <i>Gazette of International Marks</i> and notifies it to the designated contracting parties. Each such contracting party may, within one year, declare, together with an indication of the grounds of its decision, that protection cannot be granted to the mark in its territory (refusal).</p>	<p>Same as for the Madrid Agreement, except that the time-limit for refusal may be longer than one year (18 months or even more in some cases).</p>
<b>Legal effect</b>	<p>Except where such a declaration has been made, all contracting parties must protect the name as long as it continues to be protected in the contracting of origin. The substantive protection to be accorded is specified in the Agreement.</p>	<p>If such a declaration is not made, the international registration has the effect of a national registration in each of the designated contracting parties. If such a declaration is made, the holder of the international registration has the same remedies as if the mark had been deposited by him directly with the refusing office. For a period of five years from the date of registration, an international registration remains dependent on the protection of the mark in the contracting party of origin (principle of dependency).</p>	<p>Same as for Madrid Agreement, except that an international registration which is cancelled because protection has ceased in the contracting party of origin as the result of the principle of dependency may be transformed into a national or regional application benefiting from the filing date, and, where applicable, the priority date, of the international registration.</p>

	<b>Lisbon Agreement for the Protection of Appellations of Origin and their International Registration</b>	<b>Madrid Agreement Concerning the International Registration of Marks</b>	<b>Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks</b>
<b>Period of validity/renewals</b>	Protection ensured as long as the appellation of origin is protected in the contracting party of origin (no renewal).	Ten years, renewable for further periods of ten years each.	
<b>Costs<sup>5</sup></b>	500 Swiss francs.	At the stage of the international application: Basic fee (653 Swiss francs for a mark in black and white; 903 Swiss francs for a colour mark) plus standard designation fees (73 Swiss francs or individual fee fixed by the contracting party concerned) plus supplementary fee (73 Swiss francs for each class of goods and services beyond the third). At the stage of a subsequent designation: Basic fee (300 Swiss francs) plus standard designation fees (73 Swiss francs or individual fee fixed by the contracting party concerned). At the stage of renewal: Basic fee (653 Swiss francs) plus standard designation fees (73 Swiss francs or individual fee fixed by the contracting party concerned) plus supplementary fee (73 Swiss francs for each class of goods and services beyond the third).	
<b>Membership/use of the system</b>	20 States are party to the Lisbon Agreement. 5 international registrations in 2001. 842 appellations of origin have been recorded, of which 772 are currently in force.	52 States are party to the Madrid Agreement and 56 States are parties to the Madrid Protocol. 23,985 international registrations were effected under the Madrid Agreement and the Madrid Protocol in 2001.	

<sup>5</sup> It should be noted that the figures given concern main fees only and do not include other costs such as those involved for representatives.

**TREATIES ADMINISTERED BY WIPO AND IN FORCE:  
The Hague Agreement (1960 and 1999 Acts) and Patent Cooperation Treaty**

	<b>The Hague Agreement Concerning the International Deposit of Industrial Designs</b>	<b>The 1999 Act of the Hague Agreement Concerning the International Registration of Industrial Designs (not yet in force)</b>	<b>Patent Cooperation Treaty</b>
<b>Protection facilitated</b>	Industrial designs.	Industrial designs.	Patents for inventions.
<b>How is the application filed?</b>	By a national or domiciliary of one of the contracting parties or a person with real and effective industrial or commercial establishment in one such party, with the International Bureau of WIPO, either directly or through the national office of the contracting party of origin if the law of that party so permits. A contracting party may require that, when it is considered to be the contracting party of origin, the deposit be made through its office.	By a national or domiciliary of one of the contracting parties or a person with habitual residence or real and effective industrial or commercial establishment in one such contracting party, with the International Bureau of WIPO, either directly or through the office of the applicant's contracting party if the law of that party so permits.	By a national or resident of one of the contracting parties with the national patent office <sup>6</sup> of that party or, at the applicant's option, directly with the International Bureau of WIPO.
<b>Main conditions for application</b>	No prior national deposit is required.	No prior national deposit/registration is required.	No prior national or regional application is required. Restrictions as to national security may apply.
<b>Coverage of application</b>	Contracting parties designated by the applicant. An international deposit has no effect in the contracting party of origin if the law of that party so provides.	Contracting parties designated by the applicant. An international registration has no effect in the applicant's contracting party if that contracting party has made a corresponding declaration to the International Bureau.	Contracting parties designated by the applicant.

<sup>6</sup> Or a regional patent office if the applicant is a national or resident of one of the contracting parties to a treaty establishing such a regional patent office (European Patent Office (EPO), the African Regional Industrial Property Organization (ARIPO), the Eurasian Patent Office (EAPO) and the African Intellectual Property Organization (OAPI).



	<b>The Hague Agreement Concerning the International Deposit of Industrial Designs</b>	<b>The 1999 Act of the Hague Agreement Concerning the International Registration of Industrial Designs (not yet in force)</b>	<b>Patent Cooperation Treaty</b>
<b>Procedure following application</b>	<p>Once the international deposit is in conformity with formal requirements, the International Bureau records it in the International Register and publishes it in the <i>International Designs Bulletin</i>, with copies sent to the national office of each contracting party. The applicant may request that the publication be deferred for a period of up to twelve months from the international deposit date or, where priority is claimed, from the priority date.</p> <p>Each designated contracting party having an examination or opposition procedure may refuse protection - with the indication of the grounds of its decision - within six months from the date of receipt of the publication.</p>	<p>Once the international application is in conformity with formal requirements, the International Bureau records it in the International Register and publishes it in the <i>International Designs Bulletin</i>, with copies sent to the national office of each designated contracting party. The applicant may request that the publication be deferred for a period of up to thirty months from the filing date or, where priority is claimed, from the priority date.</p> <p>Each designated contracting party may refuse protection - with the indication of the grounds of its decision - within six months from the date of receipt of the publication. This time-limit may be extended to 12 months by contracting parties whose office is an examining office.</p>	<p>Preparation of an "international search report" by one of the major patent offices, serving as a PCT International Searching Authority. If the application is not withdrawn by the applicant, it is published as a PCT "pamphlet" together with the search report, and a specific entry in relation to that publication appears in the <i>PCT Gazette</i>. Pamphlets are communicated by the International Bureau to the offices of or acting for each designated contracting party. The applicant can wait until the end of the thirtieth month - with respect to some contracting parties until the end of the twentieth month - from the priority date to commence the national or regional procedure before each designated office. Where he has opted within the expiration of 19 months from the priority date to ask for an "international preliminary examination report", the applicant can in any case wait until the end of the thirtieth month from the priority date to commence the national or regional procedure. This report, which is prepared by one of the major patent offices, serving as a PCT International Preliminary Examining Authority, gives a preliminary and non-binding opinion on the patentability of the claimed invention.</p>

	<b>The Hague Agreement Concerning the International Deposit of Industrial Designs</b>	<b>The 1999 Act of the Hague Agreement Concerning the International Registration of Industrial Designs (not yet in force)</b>	<b>Patent Cooperation Treaty</b>
<b>Legal effect</b>	<p>Except where a refusal has been notified, the international deposit has, in each of the designated contracting parties, the same effect as if all the formalities required by the domestic law for the grant of protection have been complied with and as if all administrative acts required to that end have been accomplished by the office of that party.</p> <p>In case of such refusal, the holder of the international deposit has the same remedies as if the industrial design had been deposited by him directly with the refusing office.</p>	<p>Except where a refusal has been notified, the international registration has the same effect as a grant of protection for the industrial design, at the latest from the date of expiration of the refusal period or, where a Contracting Party has made a corresponding declaration under the Regulations, at the latest at the time specified in that declaration.</p> <p>In case of refusal, the holder of the international deposit has the same remedies as if the industrial design had been deposited by him directly with the refusing office.</p>	<p>The effect of the application in each designated contracting party is the same as if a patent application had been filed with the national patent office of that contracting party (or in certain cases with a regional patent office<sup>7</sup>).</p>

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<sup>7</sup> EPO, ARIPO, EAPO and OAPI. In the case of EAPO and OAPI, the designation of any State party both to the PCT, and respectively the Eurasian Patent Convention or the OAPI Agreement, automatically has the effect of the designation of all other such States for the purposes of the corresponding regional patent.

	<b>The Hague Agreement Concerning the International Deposit of Industrial Designs</b>	<b>The 1999 Act of the Hague Agreement Concerning the International Registration of Industrial Designs (not yet in force)</b>	<b>Patent Cooperation Treaty</b>
<b>Period of validity/renewals</b>	Subject to renewal after five years, the minimum duration of protection is ten years.	Subject to renewal after five years, the minimum duration of protection is 15 years.	[Not covered by the Treaty. The law of each contracting party is applicable.]
<b>Costs<sup>8</sup></b>	International deposit fee (397 Swiss francs); international renewal fee (200 Swiss francs).	Not fixed at present.	See PCT Rule 96 and Schedule of Fees annexed to the PCT Regulations. Additional fees are payable directly to receiving Offices, International Searching Authorities, International Preliminary Examining Authorities and designated/elected Offices. Certain fee reductions may apply in relation to fees payable to the International Bureau of WIPO and/or to certain Authorities. For indications of amounts payable to all PCT Authorities except designated/elected Offices, see <a href="http://www.wipo.int/pct/en/fees.pdf">http://www.wipo.int/pct/en/fees.pdf</a> . Amounts of fees payable to designated/elected Offices are available in Volume II of the <i>PCT Applicant's Guide</i> ( <a href="http://www.wipo.int/pct/guide/en/index.html">http://www.wipo.int/pct/guide/en/index.html</a> ).
<b>Membership/use of the system</b>	30 States are party to the Agreement. 4,183 international deposits were made in 2001.	7 States have deposited their instrument of ratification or accession. This Act is however not yet in force.	As of 1 September 2002, 117 States are party to the Treaty. 103,947 international applications were received by the International Bureau in 2001.

<sup>8</sup> See footnote 5 above.

**OTHER WIPO TREATY AND OTHER MULTILATERAL TREATY OF NOTIFICATION AND REGISTRATION:  
Film Registration Treaty and Stresa Convention**

	<b>WIPO Treaty on the International Registration of Audiovisual Works (Film Register Treaty) (Operation suspended <i>sine die</i>)</b>	<b>International Convention for the Use of Appellations d'Origine and Denominations of Cheeses (Stresa Convention)<sup>9</sup></b>	
<b>Protection facilitated</b>	Rights in audiovisual works, through the registration of statements concerning such works and rights in such works, including, in particular, rights relating to their exploitation.	<i>Appellations d'origine</i> and denominations for cheese.	
<b>How is the application filed?</b>	By any natural person who is a national of, is domiciled in, has his habitual residence in, or has real and effective industrial or commercial establishment, in a contracting party, and any legal entity which is organized under the laws of, or has a real and effective industrial or commercial establishment in, a contracting party, directly with the International Bureau of WIPO.  If the application concerns a registration already effected, it may also be filed by a natural person or legal entity not satisfying the above conditions.	Any contracting party may request the inclusion of an <i>appellation d'origine</i> in Annex A or a denomination of cheese in Annex B. Requests are addressed to the Italian Government.	
<b>Main conditions for application</b>	--	Protection in the requesting contracting party.	
<b>Coverage of application</b>	Contracting parties.	All other contracting parties.	

<sup>9</sup> This table is based on information given in WTO document IP/C/W/85/Add.1.

	<b>WIPO Treaty on the International Registration of Audiovisual Works (Film Register Treaty) (Operation suspended <i>sine die</i>)</b>	<b>International Convention for the Use of Appellations d'Origine and Denominations of Cheeses (Stresa Convention)<sup>9</sup></b>	
<b>Procedure following application</b>	<p>In the application, the applicant shall indicate his interest in the work or works in question, whether existing or future, including in regard to the exploitation of the work in different territories. For a work-related application, the applicant shall indicate whether the right is originally vested in him or is derived from another natural person or legal entity. Where the right is derived from another person or legal entity, he shall indicate such person or entity and the legal cause of the derivation.</p> <p>After the processing of the application by the International Registry, the statement shall be registered in the International Register and published, unless the application is rejected.</p>	<p>Requests will be examined by a Permanent Council, composed of one representative of each contracting party. The Council decides for inclusion within a maximum period of six months from the date of receipt of the request. Decisions on inclusions are taken by vote, either by a simple majority (Annex A) or by a <math>\frac{3}{4}</math> majority (Annex B) and are notified by the Italian Government to all contracting parties.</p>	
<b>Legal effect</b>	<p>Each contracting party undertakes to recognize that a statement recorded in the International Register shall be considered as true until the contrary is proved (except where the statement cannot be valid under the relevant intellectual property laws of that party or where the statement is contradicted by another statement recorded in the International Register).</p>	<p>Contracting parties have a maximum period of two years from the date of inclusion to comply with additional obligations resulting from inclusions. Disputes with respect to interpretation of the convention or its application that cannot be resolved through direct negotiations are brought before the Permanent Council.</p>	
<b>Period of validity/renewals</b>	[Not covered by the Treaty.]	--	

	<b>WIPO Treaty on the International Registration of Audiovisual Works (Film Register Treaty) (Operation suspended <i>sine die</i>)</b>	<b>International Convention for the Use of Appellations d'Origine and Denominations of Cheeses (Stresa Convention)<sup>9</sup></b>	
<b>Costs</b>		No information available.	
<b>Membership/use of the system</b>	13 States are party to the Treaty. Just under 400 statements were registered in total.	7 States are party to the Convention. 36 inclusions (four in Annex A and 32 in Annex B). <sup>10</sup>	

<sup>10</sup> Information available to the Secretariat as on 2 July 1999 (see document IP/C/W/85/Add.1).

ANNEX 1

NOTIFICATION REQUIREMENTS UNDER WTO AGREEMENTS AND DECISIONS

The following text reproduces the main elements of the listing of notifications contained in document COM.TD/W/515 of 21 November 1994.

<u>Subject</u>	<u>Notification requirement</u>	<u>Type of measure</u>
<b>Agreement on Agriculture</b>		
Agriculture	Agreement on Agriculture 5.7	Safeguard measures - agriculture
Agriculture	Agreement on Agriculture 12.1(b)	Export restrictions
Agriculture	Agreement on Agriculture 18.2 – AMS	Aggregate Measurement of Support
Agriculture	Agreement on Agriculture 18.2 - export subsidies 9:1	Export subsidies - agriculture
Agriculture	Agreement on Agriculture 18.2 - tariff quota imports	Market access - agriculture
Agriculture	Agreement on Agriculture 16.2 - ad hoc Decision on Measures Concerning the Possible Negative Effects of the Reform Programme on Least-Developed and Net-Food Importing Developing Countries	Any
Agriculture	Agreement on Agriculture 18.2 - safeguards (annual)	Safeguard measures - agriculture
Agriculture	Agreement on Agriculture 18.2 - tariff quota administration	Market access - agriculture
Agriculture	Agreement on Agriculture 18.3	Domestic support measures

<b><u>Subject</u></b>	<b><u>Notification requirement</u></b>	<b><u>Type of measure</u></b>
Agriculture ((Decision on Measures Concerning the Possible Negative Effects of the Reform Programme on Least-Developed and Net-Food Importing Developing Countries)	Agreement on Agriculture 16.2 - annual	Food aid
<b>Agreement on Government Procurement</b>		
Government procurement	Agreement on Government Procurement 1994 XIX:5	Statistics
Government procurement	Agreement on Government Procurement 1994 XXIV:5(b)	Laws / regulations (changes thereto or changes in the administration thereof)
Government procurement	Agreement on Government Procurement 1994 XXIV:6	Modification of lists (rectifications or modifications to lists of entities or services or of publications (Appendices I - IV of the AGP 1994)
<b>Agreement on Implementation of Article VI</b>		
Anti-dumping	Agreement on Implementation of Article VI of the GATT 1994 16.4 - ad hoc	Anti-dumping actions (preliminary and final)
Anti-dumping	Agreement on Implementation of Article VI of the GATT 1994 16.4 - semi-annual	Anti-dumping actions (taken within the preceding 6 months)
Anti-dumping	Agreement on Implementation of Article VI of the GATT 1994 16.5	Investigations (authorities competent to initiate and conduct investigations referred to in AIA VI 16.5, and domestic procedures governing the initiation and conduct of such investigations)



<b><u>Subject</u></b>	<b><u>Notification requirement</u></b>	<b><u>Type of measure</u></b>
Anti-dumping	Agreement on Implementation of Article VI of the GATT 1994 18.5	Laws / regulations (and changes thereto, including changes in the administration of such laws)
<b>Agreement on Implementation of Article VII</b>		
Customs valuation	Agreement on Implementation of Article VII of GATT 1994, Annex III, paragraphs 3 and 4 [Protocol to the Agreement on Implementation of Article VII of the GATT, paragraphs 4 and 5]	Reservations (in respect of certain provisions of the Customs Valuation Agreement)
Customs valuation	Agreement on Implementation of Article VII of GATT 1994, Annex III, paragraph 2 [Protocol to the Agreement on Implementation of Article VII of the GATT, paragraph 3]	Reservations; minimum values
Customs valuation	Agreement on Implementation of Article VII of the GATT 1994 20.1	Implementation / non-implementation (deferred application of CV Agreement)
Customs valuation	Agreement on Implementation of Article VII of the GATT 1994 20.2	Implementation / non-implementation (deferred application of CV Agreement 1.2(b)(iii) and 6)
Customs valuation	Agreement on Implementation of Article VII of the GATT 1994 22.2	Changes in its laws / regulations
<b>Agreement on Import Licensing Procedures</b>		
Import licensing procedures	Agreement on Import Licensing Procedures 1.4(a)	Laws / regulations (copies of publications in which rules and information relevant to the ILP Agreement are published)
Import licensing procedures	Agreement on Import Licensing Procedures 2.2 (footnote 5)	Implementation / non-implementation (deferred application of the provisions Articles 2.2(a)(ii) and (iii) of the ILP Agreement)

<b><u>Subject</u></b>	<b><u>Notification requirement</u></b>	<b><u>Type of measure</u></b>
Import licensing procedures	Agreement on Import Licensing Procedures 5.1	Import licensing procedures (or changes thereto)
Import licensing procedures	Agreement on Import Licensing Procedures 5.2	Import licensing procedures
Import licensing procedures	Agreement on Import Licensing Procedures 5.3	Import licensing procedures (changes thereto)
Import licensing procedures	Agreement on Import Licensing Procedures 5.4	Names of publications in which rules and procedures relevant to the ILP Agreement are published)
Import licensing procedures	Agreement on Import Licensing Procedures 5.5	Non-notified import licensing procedures or changes thereto (reverse notification)
Import licensing procedures	Agreement on Import Licensing Procedures 7.3	Replies to questionnaire on import licensing procedures
Import licensing procedures	Agreement on Import Licensing Procedures 8.1	Reservations (in respect of any provision of the Agreement)
Import licensing procedures	Agreement on Import Licensing Procedures 8.2(b)	Changes in laws / regulations and in the administration thereof
<b>Agreement on Preshipment Inspection</b>		
Preshipment inspection	Agreement on Preshipment Inspection 5 - first time	Laws / regulations (including those by which the Agreement is out into force)
Preshipment inspection	Agreement on Preshipment Inspection 5 - ad hoc	Laws / regulations (changes thereto)
<b>Agreement on Rules of Origin</b>		
Rules of origin	Agreement on Rules of Origin 5.1	Laws / regulations (existing rules of origin, judicial decisions and administrative rulings of general application relating to rules of origin)

<u>Subject</u>	<u>Notification requirement</u>	<u>Type of measure</u>
<b>Agreement on Safeguards</b>		
Safeguards	Agreement on Safeguards 8.2	Implementation / non-implementation (suspension of concessions or other obligations under GATT 1994)
Safeguards	Agreement on Safeguards 9.1, footnote 2	Implementation / non-implementation (non-application of safeguard measures against a product originating in a developing country Member for reasons specified in AS 9.1)
Safeguards	Agreement on Safeguards 11.2 - first time	Implementation / non-implementation (timetables for the phasing out of measures referred to in AS 11:1(b))
Safeguards	Agreement on Safeguards 11.2 - 90 days	Implementation / non-implementation (exceptions to the general phase-out rule in AS 11:2)
Safeguards	Agreement on Safeguards 12.1 - decision	Safeguard measures (making a finding of serious injury or threat thereof, taking a decision to apply or extend a safeguard measure. AS 12.2 provides the required content of the notification)
Safeguards	Agreement on Safeguards 12.1 - initiation	Safeguard measures (initiating an investigation, AS 12.2 provides the required content of the notification)
Safeguards	Agreement on Safeguards 12.4	Safeguard measures (provisional)
Safeguards	Agreement on Safeguards 12.5 - compensation	Implementation / non-implementation (any form of compensation referred to in AS 8.1)

<b><u>Subject</u></b>	<b><u>Notification requirement</u></b>	<b><u>Type of measure</u></b>
Safeguards	Agreement on Safeguards 12.5 - consultations	Implementation / non-implementation (results of consultations among Members on the application or extension of safeguard measures, including provisional safeguard measures)
Safeguards	Agreement on Safeguards 12.5 - mid-term review	Implementation / non-implementation (results of mid-term reviews referred to in AS 7.4)
Safeguards	Agreement on Safeguards 12.5 - suspension	Implementation / non-implementation (proposed suspensions of concessions and other obligations referred to in AS 8.2)
Safeguards	Agreement on Safeguards 12.6	Administrative arrangements; Laws / regulations (and changes thereto)
Safeguards	Agreement on Safeguards 12.7 - AS 11.1 measures	AS 11.1 measures (described in AS 11:1 which exist on the date of entry into force of the WTO Agreement)
Safeguards	Agreement on Safeguards 12.7 - pre-existing	Pre-existing article XIX measures (described in AS 10 which exist on the date of entry into force of the WTO Agreement)
Safeguards	Agreement on Safeguards 12.8	Administrative arrangements; Laws / regulations (and administrative procedures and any measures covered by the AS that have not been notified as required by another Member)
Safeguards	Agreement on Safeguards 12.9	Grey area measures (non-governmental measures referred to in AS 11.3)

<u>Subject</u>	<u>Notification requirement</u>	<u>Type of measure</u>
<b>Agreement on Subsidies and Countervailing Measures</b>		
Countervailing measures	Agreement on Subsidies and Countervailing Measures 25.11 - ad hoc	Countervailing duty actions (preliminary and final)
Countervailing measures	Agreement on Subsidies and Countervailing Measures 25.11 - semi-annual	Countervailing duty actions (taken within the preceding 6 months)
Countervailing measures	Agreement on Subsidies and Countervailing Measures 25.12	Investigations (authorities competent to initiate and conduct countervailing duty investigations referred to in ASCM 11, and domestic procedures governing the initiation and conduct of such investigations)
Countervailing measures; Subsidies	Agreement on Subsidies and Countervailing Measures 32.6	Laws / regulations (and changes thereto, including changes in the administration of such laws)
Subsidies	Agreement on Subsidies and Countervailing Measures 8.3 - ad hoc	Subsidies (any subsidy programme for which the provisions of ASCM 8.2 are invoked)
Subsidies	Agreement on Subsidies and Countervailing Measures 8.3 - annual	Subsidies (any subsidy programme for which the provisions of ASCM 8.2 are invoked)
Subsidies	Agreement on Subsidies and Countervailing Measures 25.1 - annual GATT 1994 XVI:1 - annual	Subsidies (any subsidy as defined in ASCM 1:1 which is specific within the meaning of ASCM 2)
Subsidies	Agreement on Subsidies and Countervailing Measures 25.1 - triennial GATT 1994 XVI:1 - triennial	Subsidies (any subsidy as defined in ASCM 1.1 which is specific within the meaning of ASCM 2)

<b><u>Subject</u></b>	<b><u>Notification requirement</u></b>	<b><u>Type of measure</u></b>
Subsidies	Agreement on Subsidies and Countervailing Measures 25.10	Subsidies (measures having the effect of a subsidy that have not been notified as required by another Member under ASCM 25.1 and GATT 1994 XVI:1)
Subsidies	Agreement on Subsidies and Countervailing Measures 27.11	Subsidies (elimination of export subsidies)
Subsidies	Agreement on Subsidies and Countervailing Measures 27.13	Debt relief (direct forgiveness of debt); Subsidies (to cover social costs, in whatever form, including relinquishment of government revenue and other transfer of liabilities when such subsidies are granted within and directly linked to a privatization programme of a developing country Member)
Subsidies	Agreement on Subsidies and Countervailing Measures 28.1	Subsidies (subsidy programmes which are inconsistent with the provisions of the ASCM)
Subsidies	Agreement on Subsidies and Countervailing Measures 29.3	Subsidies (subsidy programmes falling within the scope of ASCM 3)
<b>Agreement on Technical Barriers to Trade</b>		
Technical barriers to trade	Agreement on Technical Barriers to Trade 2.9	Technical regulations
Technical barriers to trade	Agreement on Technical Barriers to Trade 2.10	Technical regulations (urgent)
Technical barriers to trade	Agreement on Technical Barriers to Trade 3.2	Technical regulations (local government)
Technical barriers to trade	Agreement on Technical Barriers to Trade 5.6	Conformity assessment procedures
Technical barriers to trade	Agreement on Technical Barriers to Trade 5.7	Conformity assessment procedures (urgent)

<b><u>Subject</u></b>	<b><u>Notification requirement</u></b>	<b><u>Type of measure</u></b>
Technical barriers to trade	Agreement on Technical Barriers to Trade 7.2	Conformity assessment procedures (local government)
Technical barriers to trade	Agreement on Technical Barriers to Trade 10.7	Bilateral agreements; Conformity assessment procedures; Standards; Technical regulations
Technical barriers to trade	Agreement on Technical Barriers to Trade 15.2	Administrative arrangements; Laws / regulations (measures in existence or taken to ensure the implementation and administration of ATBT)
Technical barriers to trade	Agreement on Technical Barriers to Trade Annex 3C	Acceptance of/withdrawal from a code (Code of Good Practice for the Preparation, Adoption and Application of Standards)
Technical barriers to trade	Agreement on Technical Barriers to Trade Annex 3J	Work programmes (on standardization activities)
<b>Agreement on Textiles and Clothing</b>		
Textiles / Clothing	Agreement on Textiles and Clothing 2:1	Quantitative restrictions (all within bilateral agreements under MFA 4 or notified under MFA 7 and 8, in force on 31 December 1994)
Textiles / Clothing	Agreement on Textiles and Clothing 2:2	Quantitative restrictions (comments on ATC 2:1 notifications)
Textiles / Clothing	Agreement on Textiles and Clothing 2:3	Administrative arrangements
Textiles / Clothing	Agreement on Textiles and Clothing 2:7	Integration programmes (first stage)
Textiles / Clothing	Agreement on Textiles and Clothing 2:10	Integration programmes (integration earlier than provided for in ATC 2:6 and 2:8)
Textiles / Clothing	Agreement on Textiles and Clothing 2:11	Integration programmes (for next stage)

<b><u>Subject</u></b>	<b><u>Notification requirement</u></b>	<b><u>Type of measure</u></b>
Textiles / Clothing	Agreement on Textiles and Clothing 2:15	Quantitative restrictions (early elimination of restrictions)
Textiles / Clothing	Agreement on Textiles and Clothing 2:17	Administrative arrangements
Textiles / Clothing	Agreement on Textiles and Clothing 2:18	Market access (improvement in access for certain countries)
Textiles / Clothing	Agreement on Textiles and Clothing 3:1	Quantitative restrictions (whether consistent or not with GATT, other than MFA restrictions)
Textiles / Clothing	Agreement on Textiles and Clothing 3:2(a)	Quantitative restrictions (notified under ATC 3:1 and conforming with GATT 1994)
Textiles / Clothing	Agreement on Textiles and Clothing 3:2(b)	Quantitative restrictions (programme of phase-out restrictions notified under ATC 3:1)
Textiles / Clothing	Agreement on Textiles and Clothing 3:4	Quantitative restrictions (falling under ATC 3 : reverse notifications)
Textiles / Clothing	Agreement on Textiles and Clothing 4:4	Quantitative restrictions (changes in the implementation or administration of restrictions notified)
Textiles / Clothing	Agreement on Textiles and Clothing 5:2	Circumvention (dispute with respect to circumvention)
Textiles / Clothing	Agreement on Textiles and Clothing 5:4	Circumvention (actions taken in case of circumvention)
Textiles / Clothing	Agreement on Textiles and Clothing 5:5	Circumvention (dispute with respect to circumvention)
Textiles / Clothing	Agreement on Textiles and Clothing 6:1	Safeguard measures - ATC (whether or not the notifying member wishes to retain the right to use the provisions of ATC 6)



<b><u>Subject</u></b>	<b><u>Notification requirement</u></b>	<b><u>Type of measure</u></b>
Textiles / Clothing	Agreement on Textiles and Clothing 6:7	Safeguard measures - ATC (request for consultation on safeguard or any action taken or agreed under the provisions of ATC 6)
Textiles / Clothing	Agreement on Textiles and Clothing 6:9	Safeguard measures - ATC (details of agreed solution resulting from an ATC 6 action)
Textiles / Clothing	Agreement on Textiles and Clothing 6:10	Safeguard measures - ATC (any action taken under the provisions of ATC 6)
Textiles / Clothing	Agreement on Textiles and Clothing 6:11	Safeguard measures - ATC (provisional action taken or agreed under the provisions of ATC 6)
Textiles / Clothing	Agreement on Textiles and Clothing 7:2	Implementation / non-implementation (actions necessary to abide by GATT rules taken under ATC 7:1 which have a bearing on the implementation of the ATC)
Textiles / Clothing	Agreement on Textiles and Clothing 7:3	Implementation / non-implementation (no action taken under ATC 7:1 which upsets the balance of rights and obligations under the ATC)
Textiles / Clothing	Agreement on Textiles and Clothing 8:6	Complaints (any particular matter that is detrimental to the interests of a WTO Member under the ATC, following consultations)
Textiles / Clothing	Agreement on Textiles and Clothing 8:10	Implementation / non-implementation (Member unable to conform to a TMB recommendation)
Textiles / Clothing	Agreement on Textiles and Clothing 8:10 - unresolved	Implementation / non-implementation (Member unable to accept a further TMB recommendation - the matter remains unresolved)

<u>Subject</u>	<u>Notification requirement</u>	<u>Type of measure</u>
<b>Agreement on the Application of Sanitary and Phytosanitary Measures</b>		
Agriculture; Sanitary / phytosanitary measures	Agreement on the Application of Sanitary and Phytosanitary Measures 7	Sanitary / phytosanitary regulations
<b>Agreement on Trade in Civil Aircraft</b>		
Trade in civil aircraft	Agreement on Trade in Civil Aircraft 1.2	National entities operating military aircraft
Trade in civil aircraft	Agreement on Trade in Civil Aircraft 2.2	Administrative arrangements (end-use systems of customs administration)
Trade in civil aircraft	Agreement on Trade in Civil Aircraft 8.6	Subsidies (investigation)
Trade in civil aircraft	Agreement on Trade in Civil Aircraft 9.4.2	Laws / regulations (changes thereto and changes in the administration thereof)
<b>Agreement on Trade-Related Aspects of Intellectual Property Rights</b>		
Intellectual property	Agreement on Trade-Related Aspects of Intellectual Property Rights 1.3 - broadcasting organizations	Eligibility criteria (limitation of broadcasting organizations eligible for protection under the Agreement to those having their headquarters in a Member of the WTO and transmitting a broadcast from the same Member [in accordance with the provisions under Article 6, paragraph 2 of the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations [the Rome Convention])

<b><u>Subject</u></b>	<b><u>Notification requirement</u></b>	<b><u>Type of measure</u></b>
Intellectual property	Agreement on Trade-Related Aspects of Intellectual Property Rights 1.3 - producers of phonograms	Eligibility criteria (exclusion of either the criterion of fixation or the criterion of publication from the eligibility criteria for the protection of producers of phonograms under the TRIPS Agreement [in accordance with the provisions of Article 5, paragraph 3 of the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations [the Rome Convention]])
Intellectual property	Agreement on Trade-Related Aspects of Intellectual Property Rights 2.1 (Article 6ter, paragraph 3 of the Paris Convention for the Protection of Industrial Property (Stockholm Act of 1967))	Protection against registration or use as a trademark (of State emblems, and official signs and hallmarks indicating control and warranty, or armorial bearings, flags, other emblems, abbreviations, and names of intergovernmental organizations)
Intellectual property	Agreement on Trade-Related Aspects of Intellectual Property Rights 3.1 – broadcasting rights	Limitation of rights (in the Member of the WTO in question, excluding from the rights to be provided under Article 14.3 of the TRIPS Agreement the right as stipulated in Article 13(d) of the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations [the Rome Convention], as a result of which eligibility for national treatment in respect of this right may be limited in other WTO Members)

<b><u>Subject</u></b>	<b><u>Notification requirement</u></b>	<b><u>Type of measure</u></b>
Intellectual property	Agreement on Trade-Related Aspects of Intellectual Property Rights 3.1 – copyrighted works	Eligibility criteria (limitation of the eligibility for national treatment in respect of copyrighted works first published in the Member of the WTO in question, or in another Member of the WTO, whose authors are not nationals of a Member of the WTO nor habitually resident therein [in accordance with the provisions of Article 6, paragraph 3 of the Berne Convention for the Protection of Literary and Artistic Works - Paris Act, 1971])
Intellectual property	Agreement on Trade-Related Aspects of Intellectual Property Rights 4(d)	International agreements (related to intellectual property which entered into force prior to the date of entry into force of the WTO Agreement, from which a Member derives an exception to the obligation under the provision in question to provide MFN treatment to the nationals of other Members of the WTO)
Intellectual property	Agreement on Trade-Related Aspects of Intellectual Property Rights 63.2 ( <i>this requirement may be waived upon the establishment of a common register with WIPO for laws and regulations in the field of intellectual property</i> )	Laws / regulations (pertaining to the availability, scope, acquisition, enforcement and prevention of the abuse of intellectual property rights)
Intellectual property	Agreement on Trade-Related Aspects of Intellectual Property Rights 69	Contact points (in Members' administrations for, among other things, exchanging information on trade in goods infringing intellectual property rights)

<u>Subject</u>	<u>Notification requirement</u>	<u>Type of measure</u>
<b>Agreement on Trade-Related Investment Measures</b>		
Investment measures (TRIMs)	Agreement on Trade-Related Investment Measures 5.1	Investment measures (related to trade in goods ['TRIMs'] introduced 180 days or more before the date of entry into force of the WTO Agreement and inconsistent with the provisions of Article III or Article XI of GATT 1994)
Investment measures (TRIMs)	Agreement on Trade-Related Investment Measures 5.5	Investment measures (related to trade in goods ['TRIMs'] with respect to new investments, which are inconsistent with the provisions of Article III or Article XI of GATT 1994 but which are already maintained with respect to established enterprises)
Investment measures (TRIMs)	Agreement on Trade-Related Investment Measures 6.2	Publications (in which investment measures related to goods ['TRIMs'] may be found)
<b>Decisions</b>		
Government procurement	Decision of the Committee on Government Procurement	Procurement thresholds (equivalent in national currency of the thresholds laid down in the Annexes of AGP 1994 Appendix I)
Import restrictions	Decision on Examination of Protective Measures Affecting Imports from Developing Countries	Any (protective measures affecting imports from LDCs)
Quantitative restrictions	Decisions of the CONTRACTING PARTIES (BISD 31S/12, BISD 31S/22, BISD 32S/12, BISD 32S/93) - biennial	Quantitative restrictions (complete notification)

<b><u>Subject</u></b>	<b><u>Notification requirement</u></b>	<b><u>Type of measure</u></b>
Quantitative restrictions	Decisions of the CONTRACTING PARTIES (BISD 31S/12, BISD 31S/222, BISD 32S/12, BISD 32S/93) - ad hoc	Quantitative restrictions (changes thereto)
Trade and development (Part IV of GATT 1994: implementation)	Decision on GATT Rules and Activities Relating to Developing Countries	Any
<b>Enabling clause</b>		
Trade preferences (arrangements)	Enabling clause - integration	Preferential arrangements among developing countries
Trade preferences (treatment)	Enabling clause - gsp	GSP schemes
Trade preferences (treatment)	Enabling clause - ldc's	Special treatment for least-developed countries
Trade preferences (treatment)	Enabling clause - ntms	Non-tariff measures (favourable treatment with respect to non-tariff measures governed by GATT Codes)
<b>GATS</b>		
Balance of payments measures	GATS XII:4	Balance of payment restrictions (any restrictions on trade in services on which specific commitments have been taken)
Trade in services	GATS Annex on Article II exemptions:7	Article II exemptions (termination of exemptions granted under the Annex)
Trade in services	GATS III:3	Laws / regulations (transparency; new or changes to existing laws, regulations or administrative guidelines which significantly affect trade in services)

<b><u>Subject</u></b>	<b><u>Notification requirement</u></b>	<b><u>Type of measure</u></b>
Trade in services	GATS V:7	Economic integration agreements (any enlargement or significant modification)
Trade in services	GATS V bis(b)	Labour markets integration agreements
Trade in services	GATS VII:4	Recognition agreements / arrangements ; autonomous recognition measures (agreements, arrangements or autonomous measures recognizing education, experience, licences or certification granted in a particular country)
Trade in services	GATS VIII:4	Monopolies / Exclusive service suppliers (introduction of monopolies for the supply of a service covered by specific commitments)
Trade in services	GATS VIII:5	Monopolies / Exclusive service suppliers (introduction of monopolies for the supply of a service covered by specific commitments)
Trade in services	GATS XIV:2	Security exceptions (measures that are necessary for the protection of essential security interests or taken in pursuance of obligations under the United Nations Charter)
Trade in services	GATS XXI:1(b)	Modification of schedules (modification or withdrawal of specific commitments)
<b>GATT 1994</b>		
Infant industry protection (developing countries)	GATT 1994 XVIII:C (paragraph 14)	Non-tariff measures

<b><u>Subject</u></b>	<b><u>Notification requirement</u></b>	<b><u>Type of measure</u></b>
Infant industry protection (developing countries); Tariffs	GATT 1994 XVIII:A (paragraph 7a)	Modification of schedules (modification of a concession - LDCs)
Regional arrangements	GATT 1994 XXIV:7(a) - customs unions	Customs unions
Regional arrangements	GATT 1994 XXIV:7(a) - free trade areas	Free trade areas
Regional arrangements	GATT 1994 XXIV:7(a) - interim agreement (customs unions)	Interim agreements leading to customs unions
Regional arrangements	GATT 1994 XXIV:7(a) - interim agreement (free trade areas)	Interim agreements leading to free trade areas
State trading	GATT 1994 XVII:4(a) - annual	State trading activities (changes)
State trading	GATT 1994 XVII:4(a) - triennial	State trading activities (complete notification)
Tariffs	GATT 1994 II:6(a)	Modification of schedules (adjustment of a concession - specific duties)
Tariffs	GATT 1994 XXVIII:1	Modification of schedules (modification or withdrawal of a concession)
Tariffs	GATT 1994 XXVIII:3	Modification of schedules (modification or withdrawal of a concession)
Tariffs	GATT 1994 XXVIII:4	Modification of schedules (modification or withdrawal of a concession - request for authorization)
Tariffs	GATT 1994 XXVIII:5	Modification of schedules (reserve the right to modify schedules for a 3 year period)
Tariffs - waivers	GATT 1994 XXV:5	Any



<u>Subject</u>	<u>Notification requirement</u>	<u>Type of measure</u>
<b>International Bovine Meat Agreement</b>		
Agriculture; Trade in bovine meat	International Bovine Meat Agreement III:1 - market data	Any (meat market data)
Agriculture; Trade in dairy products	International Bovine Meat Agreement III:1 - policies	Domestic policies; Domestic support measures
<b>International Dairy Arrangement</b>		
Agriculture; Trade in dairy products	International Dairy Arrangement III:1- market data	Any (dairy market data)
Agriculture; Trade in dairy products	International Dairy Arrangement III:3 - market data	Any (dairy market data)
Agriculture; Trade in dairy products	International Dairy Arrangement III:3 - policies	Domestic policies; Domestic support measures
<b>Procedures adopted by the CONTRACTING PARTIES</b>		
	[Procedures adopted by the CONTRACTING PARTIES in 1972 (SR 28/6 AND L/3756, para.76) and by the Council in 1980 (C/M/139, page 12)]	
Non-tariff measures (industrial products) - reverse notification	Procedures adopted by the CONTRACTING PARTIES (BISD 27S/18, BISD 32S/12, BISD 32S/93)	Non-tariff measures

<u>Subject</u>	<u>Notification requirement</u>	<u>Type of measure</u>
<b>Trade Policy Review Mechanism</b>		
Trade policy	Trade Policy Mechanism - ad hoc	Review Any (between reviews, Members shall provide brief reports when there are significant changes in their trade policies. Information contained in reports should to the greatest extent possible be coordinated with notifications made under provisions of the Multilateral, and where applicable, Plurilateral Trade Agreements)
Trade policy	Trade Policy Review Mechanism – annual	Statistics (annual update of statistical information according to the agreed format. Information contained in reports should to the greatest extent possible be coordinated with notifications made under provisions of the Multilateral, and where applicable, Plurilateral Trade Agreements)
<b>Understandings</b>		
Balance of payments measures	Understanding on Balance-of-Payments Provisions of the GATT 1994 - ad hoc	Balance of payment restrictions (introduction of or any changes in the application of restrictive import measures taken for balance-of-payments purposes, as well as any modifications in time-schedules for the removal of such measures as announced under paragraph 1)
Balance of payments measures	Understanding on Balance-of-Payments Provisions of the GATT 1994 - annual	Balance of payment restrictions; Laws / regulations (consolidated notification, including all changes in laws, regulations, policy statements or public notices, for examination by Members)
Regional arrangements	Understanding on the Interpretation of Article XXIV of GATT 1994, 9	Interim agreements (changes in plan and schedule)

<b><u>Subject</u></b>	<b><u>Notification requirement</u></b>	<b><u>Type of measure</u></b>
Regional arrangements	Understanding on the Interpretation of Article XXIV of GATT 1994, 11	Customs unions (operation of customs unions and regional arrangements)
State trading	Understanding on the Interpretation of Article XVII of GATT 1994	State trading activities (not notified as required by another Member)
Tariffs	Understanding on the Interpretation of Article II:1(b) of GATT 1994	Modification of schedules; other duties and charges (correction of other duties and charges recorded in the schedule of concessions)

## ANNEX 2

### NOTIFICATION PROCEDURES UNDER THE TRIPS AGREEMENT

#### Provisions of the TRIPS Agreement laying down notification requirements:

(a) **Article 63.2**

Notification of laws and regulations.

(b) **Articles 1.3 and 3.1**

Notification of certain options in regard to :

- the definition of beneficiary persons (Art. 1.3);
- national treatment (Art. 3.1).

(c) **Article 4(d)**

Notification of international agreements to justify certain MFN exemptions.

(d) **Article 69**

Notification of contact points.

(e) **Other notification requirements**

(i) Pursuant to the obligations under Article 2 of the TRIPS Agreement stemming from the provisions of **Article 6ter of the Paris Convention for the Protection of Industrial Property, Stockholm Act (1967) ("Paris Convention")**;

(ii) Pursuant to the obligations under notification provisions of intellectual property conventions incorporated by reference into the TRIPS Agreement but not explicitly referred to in it, notably those stemming from the Berne Convention for the Protection of Literary and Artistic Works ("**Berne Convention**") or the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations ("**Rome Convention**"):

- **Article 14bis(2)(c) of the Berne Convention**
- **Article 14bis(3) of the Berne Convention**
- **Article 15(4) of the Berne Convention**
- **Article I of the Appendix to the Berne Convention**
- **Article II(3)(b) of the Appendix to the Berne Convention**
- **Article IV(2) of the Appendix to the Berne Convention**
- **Article IV(4)(c)(iv) of the Appendix to the Berne Convention**
- **Article V of the Appendix to the Berne Convention**
- **Article 17 of the Rome Convention**
- **Article 18 of the Rome Convention**

- (iii) As agreed by the TRIPS Council *in relation to Article 67* of the Agreement on technical cooperation.

## ARTICLE 63.2

1. The TRIPS Council has adopted procedures for the notification of laws and regulations pertaining to the subject-matter of the TRIPS Agreement under Article 63.2 (documents IP/C/2, 3, 4 and 5). The basic procedures are contained in document IP/C/2. The Agreement Between WIPO and the WTO is also relevant with regard to these procedures.

2. Article 63.2 of the TRIPS Agreement in conjunction with Article 63.1 lays down that "Members shall notify the laws and regulations made effective pertaining to the subject matter of the Agreement (the availability, scope, acquisition, enforcement and prevention of the abuse of intellectual property rights)"<sup>11</sup>.

3. According to the procedures referred to in paragraph 1 above, notifications of laws and regulations need to comprise the following elements:

- the texts of all relevant laws and regulations in their original language;
- translations into one WTO language of main dedicated laws and regulations, if the original language is not a WTO language;
- a listing of "other laws and regulations" in accordance with a specific format;
- responses to a checklist of questions on law and practice in the area of enforcement, in addition to the notification of the texts of enforcement laws and regulations<sup>12</sup>.

## ARTICLES 1.3 and 3.1

4. Article 1.3 of the Agreement defines the persons that must be eligible for the protection to be made available by Members under the Agreement. The Article does so by referring to the criteria for eligibility as laid down in the Paris Convention, the Berne Convention, the Rome Convention and the Washington Treaty for the relevant areas of intellectual property. Thus, the same criteria have to be applied among WTO Members as well, whether or not they are member States to any of the Conventions or Treaty themselves. Certain of the exceptions allowed under these criteria, notably those of the Berne Convention or the Rome Convention, are allowed on condition that they are notified to the TRIPS Council, whether or not they have been notified to the Secretary General of the United Nations under the Berne Convention or the Rome Convention themselves.

5. Article 3.1 of the Agreement requires national treatment to be given to persons eligible for protection under Article 1.3, subject to the exceptions allowed under the Conventions and Treaty mentioned above. Equally as under Article 1.3, certain of these exceptions under Article 3.1 are allowed on condition that they are notified to the TRIPS Council.

6. For further details concerning these notification requirements, reference is made to the background note prepared by the Secretariat circulated in document IP/C/W/5.

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<sup>11</sup> These notifications are being distributed in the IP/N/1/- series of documents. Texts of main dedicated intellectual property laws and regulations are being distributed in special law series of documents (see document IP/C/W/20).

<sup>12</sup> Responses to this Checklist are being distributed in the IP/N/6/- series of documents.

7. Under the MFN provisions of Article 4 of the Agreement, each Member has to ensure that any advantage, favour, privilege or immunity that is available in its territory to certain foreign right holders is accorded to persons eligible under Article 1.3 for protection under the Agreement.

8. Article 4 specifies the exemptions to such MFN treatment allowed by the Agreement. One of these exceptions, that in sub-paragraph (d), requires a notification, namely where the advantage in question derives from an international agreement related to the protection of intellectual property which entered into force prior to the entry into force of the WTO Agreement. The conditions for such exemptions are that the agreement in question is notified to the TRIPS Council and does not constitute an arbitrary or unjustifiable discrimination against persons eligible under Article 1.3 from other WTO Members.<sup>13</sup>

#### **ARTICLE 69**

9. Article 69 of the Agreement requires Members to establish and notify contact points in their administrations for the purposes of cooperation with each other aimed at the elimination of trade in infringing goods.

#### **ARTICLE 6ter OF THE PARIS CONVENTION**

10. Article 6ter of the Paris Convention concerns the protection of state emblems, official hallmarks, and names, abbreviations and emblems of intergovernmental organizations against the registration or use as trademarks. Article 6ter applies in the TRIPS context by virtue of Article 2.1 of the TRIPS Agreement and lays down notification procedures for the communication by Members (and intergovernmental organizations) to other Members of such emblems that they do not wish to be capable of constituting valid trademarks and for the transmittal of objections to the protection claimed for an emblem.

11. The application of the provisions of Article 6ter for the purposes of the TRIPS Agreement is addressed in the Agreement Between WIPO and the WTO and in the Decision of the TRIPS Council of 11 December 1995 (document IP/C/7). Accordingly, communications under Article 6ter for the purposes of the TRIPS Agreement should be communicated through the intermediary of the International Bureau of WIPO.

12. As regards the practical effects for WTO Members, the following points should be noted:

- In respect of WTO Members that are also Member States of the Paris Convention (1967), all notifications made under Article 6ter of the Paris Convention itself will automatically apply under the TRIPS Agreement, whether they were made in the past or will be made in the future. This applies both to the communication of emblems and of objections to the protection claimed for an emblem.
- The same will apply in respect of WTO Members that are Member States of the Paris Convention but not of the 1967 version of that Convention, except if they are not obliged under the earlier version of the Paris Convention to protect emblems of intergovernmental organizations. In regard to these emblems, the procedures outlined below in respect of WTO Members that are not Member States of any version of the Paris Convention will apply.

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<sup>13</sup> These notifications are being distributed in the IP/N/4/- series of documents.

- The International Bureau of WIPO has communicated, in January 1996, all emblems communicated before January 1996 under Article 6ter of the Paris Convention to those WTO Members which are not Member States of the Paris Convention. After January 1996, a new WTO Member that is not a Member State of the Paris Convention is to receive a set of emblems as communicated to the International Bureau under the provisions of Article 6ter before the date that the WTO Agreement enters into force for the new Member in question.
- WTO Members that are not Member States of the Paris Convention are entitled to communicate emblems and to transmit objections through the International Bureau of WIPO in accordance with the procedures as administered by the International Bureau in the context of the Paris Convention (1967).
- WTO Members that are not Member States of the Paris Convention can, thus, transmit objections under Article 6ter(4)
  - (i) within a time-limit of 12 months from receipt of the communication; or
  - (ii) if they still benefit from a transitional period under Article 65 or 66 of the Agreement, within 12 months from the date on which their TRIPS obligations in respect of Article 6ter start applying.

If such a WTO Member becomes a Member State of the Paris Convention before the date referred to under (ii), the time-limit for the transmittal of objections will be 12 months from the date of becoming Member of the Paris Convention.

#### **OTHER NOTIFICATION REQUIREMENTS UNDER THE BERNE CONVENTION OR THE ROME CONVENTION INCORPORATED BY REFERENCE INTO THE TRIPS AGREEMENT**

13. Articles 14bis(2)(c) and 14bis(3) of the Berne Convention: Article 14bis(2)(b) of the Berne Convention as incorporated into the TRIPS Agreement applies to a WTO Member which in its legislation includes among the owners of copyright in a cinematographic work authors who have brought contributions to the making of the work. In such a Member it must be presumed that these authors have consented, in the absence of any contract to the contrary, to certain ways in which the film may be exploited. If such Member's legislation requires that the consent of the authors must have been in writing, Article 14bis(2)(c) requires that Member to inform other Members of this requirement by means of a notification. Article 14bis(3) requires that a Member the law of which does not make the presumption binding on the principal director of the film must similarly make a notification. The purpose of these notification requirements is to allow those concerned to know the Members the legislation of which applies the presumption in such a restricted way and to make their arrangements accordingly.

14. Article 15(4) of the Berne Convention: Article 15(4) of the Berne Convention as incorporated into the TRIPS Agreement is mainly directed at the protection of folklore. It deals with unpublished works where the identity of the author is unknown, but where there is every ground to presume that he or she is a national of a given WTO Member. In such a situation the Member concerned may designate a competent authority to protect the interests of the author. Other Members should be informed about this authority by means of a notification giving full information.

15. Appendix to the Berne Convention: Article 9.1 of the TRIPS Agreement requires Members to comply with the Appendix to the Berne Convention (1971), which contains special provisions for

developing countries. The Appendix contains a number of notification procedures which are discussed below.

- (a) Article I of the Appendix: Paragraph 1 requires a developing country Member wishing to avail itself of the possibilities provided in the Appendix to declare that it will avail itself of the faculty provided in Article II and/or Article III of the Appendix (compulsory licenses for, respectively, translations and reproductions) by means of a notification. According to paragraph 2 such declarations can be made for renewable periods of ten years. Such declaration may be renewed by means of a notification. Paragraph 5 deals with the possibility for a country to make notifications in respect of territories for which it has international responsibility.
- (b) Article II(3)(b) of the Appendix: This provision deals with the situation where a developing country Member secures the agreement of all developed Members, in which the same language is in general use as in that developing country Member, to provide for a shorter period than the usual three years after publication for the application of compulsory licences to substitute for the exclusive right of translation. The provision requires that any such agreement shall be notified.
- (c) Article IV(2) of the Appendix : This provision deals with the situation where an applicant for a compulsory licence of the types provided for in Articles II and III cannot find the owner of the right in question. In such a situation, he or she must send a copy of the application to any national or international information centre which may have been designated by the Member in which the publisher of the work concerned is believed to have his principal place of business. The paragraph provides that such information centres must have been designated in a notification by the Member concerned.
- (d) Article IV(4)(c)(iv) of the Appendix: This provision allows developing country Members to export copies of translations made under compulsory licence, provided that a number of conditions are met: the language of the translation must not be English, French or Spanish; the recipients are individuals who are nationals of the Member whose competent authority has granted the license, or organizations grouping such individuals; the copies must be sent for teaching, scholarship or research purposes; there must be no commercial purpose; and there must be an agreement between the Member granting the licence and that to which the copies are sent. The provision requires that such an agreement shall be notified by the Member in which the license has been granted.
- (e) Article V of the Appendix: This Article provides that a developing country Member may choose, by way of a declaration made at the time of ratification or accession, the "ten-year régime" which appeared in the 1896 Act of the Berne Convention for translations instead of the compulsory licensing system provided for in Article II of the Appendix.

16. Article 17 of the Rome Convention: Article 14.6 of the TRIPS Agreement allows a WTO Member to avail itself of exceptions permitted under the Rome Convention. Article 17 of the Rome Convention allows a state which, on 26 October 1961 granted protection to producers of phonograms solely on the basis of the criterion of fixation to continue to do so, provided it makes a notification to this effect at the time of ratification, acceptance or accession.



17. Article 18 of the Rome Convention: Articles 1.3, 3.1 and 14.6 of the TRIPS Agreement relate to certain exceptions under the Rome Convention the invocation of which require notification. Article 18 of the Rome Convention provides that any state which has invoked such an exception by means of notifications under Articles 5(3), 6(2), 16(1) or 17 of the Rome Convention may, by a further notification, reduce the scope of or withdraw the notification in question.

Notifications under these provisions are only required if a Member wishes to take advantage of the provisions in question.

Articles 14bis(2)(c) and 14bis(3): WTO Members to which these notification requirements apply should make necessary notifications as of the relevant date referred to in paragraph 3 above. If a Member subsequently changes its legislation in a way that would require notification under these provisions, it should notify as of the time of the change.

Article 15(4) of the Berne Convention: The purpose of Article 15(4) of the Berne Convention is to facilitate benefitting from the protection available in other WTO Members. Therefore, it would be in the interest of a Member wishing to avail itself of the possibility stemming from the incorporation of the provisions of Article 15(4) of the Berne Convention into the TRIPS Agreement in relation to other WTO Members to notify the authority designated without delay, while being free to do so at any time.

The Appendix to the Berne Convention: Notification under Article I(1) of the Appendix may be deposited at the time of depositing the instrument of ratification or accession, or any time thereafter.

As far as the calculation of renewable periods of ten years is concerned (Article I(2) of the Appendix), this is a question that the Council would need to look into if any Member were to invoke any of the provisions of the Appendix as incorporated into the TRIPS Agreement.

Other notifications stemming from the incorporation of the provisions of the Appendix into the TRIPS Agreement can be made at any time. The only exception in this regard is Article V(1) as incorporated into the TRIPS Agreement which requires that the choice provided in that paragraph has to be made at the time of ratification or accession.

Articles 17 and 18 of the Rome Convention: A notification under Article 17 of the Rome Convention has to be made at the time of ratification, acceptance or accession. A further notification under Article 18 of the Rome Convention as incorporated into the TRIPS Agreement can be made at any time.

18. At its meeting of 22 February 1996, the TRIPS Council invited each Member wishing to make notifications under any of these provisions to make them to the TRIPS Council, even if the Member in question had already made a notification under the Berne Convention or the Rome Convention in regard to the same issue.<sup>14</sup>

#### **NOTIFICATION REQUIREMENT FOR DEVELOPED COUNTRY MEMBERS AS AGREED BY THE TRIPS COUNCIL IN THE CONTEXT OF ARTICLE 67**

19. At its meeting of 22 to 25 July 1996, the Council for TRIPS agreed that each developed country Member should notify a contact point for technical cooperation on TRIPS, in particular for the exchange of information between donors and recipients of technical assistance.

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<sup>14</sup> These notifications are being distributed in the IP/N/5/- series of documents.

20. Developed country Members have been requested to notify their contact point(s) by 1 September 1996 (see WTO/AIR/388).<sup>15</sup>

21. Developed country Members have been requested to notify, in particular, the following information concerning their contact point(s):

- (i) the name of the authority in question;
- (ii) its address;
- (iii) its telephone and telefax numbers and, where appropriate, E-mail reference; and
- (iv) where appropriate, to identify at each contact point a contact official.

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<sup>15</sup> These notifications are being distributed in the IP/N/7 series of documents.

### ANNEX 3

#### NOTIFICATION AND COMMUNICATION REQUIREMENTS UNDER TREATIES ADMINISTERED BY WIPO

##### Information supplied by the International Bureau of WIPO

- Berne Convention for the Protection of Literary and Artistic Works (Berne Convention), Paris Act, 1971
- International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations (Rome Convention)
- WIPO Copyright Treaty (WCT)
- WIPO Performances and Phonograms Treaty (WPPT)
- Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of their Phonograms (Geneva Convention)
- Convention Relating to the Distribution of Programme-Carrying Signals Transmitted by Satellites (Brussels Convention)
- Paris Convention for the Protection of Industrial Property, Stockholm Act, 1967
  - Notifications/communications other than those under Article 6ter
  - Article 6ter of the Paris Convention for the Protection of Industrial Property – Marks: Prohibitions concerning State Emblems, Official Hallmarks, and Emblems of Intergovernmental Organizations

**I. BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS (BERNE CONVENTION) PARIS ACT, 1971**

Article 6(3): Possible Restriction of Protection in Respect of Certain Works of Nationals of Certain Countries Outside the Union

Where any country outside the Berne Union fails to protect in an adequate manner the works of authors who are nationals of one of the countries of the Union, the latter country may restrict the protection given to the works of authors who are, at the date of the first publication thereof, nationals of the other country and are not habitually resident in one of the countries of the Union. If the country of first publication avails itself of this right, the other countries of the Union shall not be required to grant to works thus subjected to special treatment a wider protection than that granted to them in the country of first publication. The countries of the Union which restrict the grant of copyright accordingly shall give notice thereof to the Director General of the World Intellectual Property Organization (hereinafter designated as "the Director General") by a written declaration specifying the countries in regard to which protection is restricted, and the restrictions to which rights of authors who are nationals of those countries are subjected. The Director General shall immediately communicate this declaration to all the countries of the Union.

Article 14bis(2) and (3): Special Provisions Concerning Cinematographic Works

Ownership of copyright in a cinematographic work shall be a matter for legislation in the country where protection is claimed. However, in the countries of the Union which, by legislation, include among the owners of copyright in a cinematographic work authors who have brought contributions to the making of the work, such authors, if they have undertaken to bring such contributions, may not, in the absence of any contrary or special stipulation, object to the reproduction, distribution, public performance, communication to the public by wire, broadcasting or any other communication to the public, or to the subtitling or dubbing of texts, of the work. The question whether or not the form of the undertaking referred to above should be in a written agreement or a written act of the same effect shall be a matter for the legislation of the country where the maker of the cinematographic work has his headquarters or habitual residence. However, it shall be a matter for the legislation of the country of the Union where protection is claimed to provide that the said undertaking shall be in a written agreement or a written act of the same effect. The countries whose legislation so provides shall notify the Director General by means of a written declaration, which will be immediately communicated by him to all the other countries of the Union.

Unless the national legislation provides to the contrary, the above provisions shall not be applicable to authors of scenarios, dialogues and musical works created for the making of the cinematographic work, or to the principal director thereof. However, those countries of the Union whose legislation does not contain rules applying the above provisions to the principal director shall notify the Director General by means of a written declaration, which will be immediately communicated by him to all the other countries of the Union.

Article 15(4): Right to Enforce Protected Rights - in the case of certain unpublished works of unknown authorship

In the case of unpublished works where the identity of the author is unknown, but where there is every ground to presume that he is a national of a country of the Union, it shall be a matter for legislation in that country to designate the competent authority which shall represent the author and shall be entitled to protect and enforce his rights in the countries of the Union. Countries of the Union which make such designation shall notify the Director General by means of a written declaration

giving full information concerning the authority thus designated. The Director General shall at once communicate this declaration to all other countries of the Union.

Article 24(2): International Bureau: General information

The International Bureau shall assemble and publish information concerning the protection of copyright. Each country of the Union shall promptly communicate to the International Bureau all new laws and official texts concerning the protection of copyright.

Article 25(4): Contributions

Unless it has already done so, each country shall indicate, concurrently with depositing its instrument of ratification or accession, the class for the purpose of establishing its contribution towards the budget to which it wishes to belong. Any country may change class. If it chooses a lower class, the country must announce it to the Assembly at one of its ordinary sessions. Any such change shall take effect at the beginning of the calendar year following the session.

Article 28(1): Acceptance and Entry Into Force of Act for Countries of the Union

Any country of the Union may declare in its instrument of ratification or accession that its ratification or accession shall not apply to Articles 1 to 21 and the Appendix, that is, substantive provisions of the Convention. Those countries may at any later time declare that it extends the effects of its ratification or accession to those provisions. Such declaration shall be deposited with the Director General.

Article 30(2): Reservations

Any country of the Union ratifying or acceding to this Act may retain the benefit of the reservations it has previously formulated on condition that it makes a declaration to that effect at the time of the deposit of its instrument of ratification or accession.

Any country outside the Union may declare, in acceding to this Convention, that it intends to substitute, temporarily at least, for Article 8<sup>16</sup> of this Act concerning the right of translation, the provisions of Article 5<sup>17</sup> of the Union Convention of 1886, as completed at Paris in 1896, on the clear

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<sup>16</sup> Article 8 [Right of Translation] of the Paris Act of the Berne Convention reads as follows:  
"Authors of literary and artistic works protected by this Convention shall enjoy the exclusive right of making and of authorizing the translation of their works throughout the term of protection of their rights in the original works."

<sup>17</sup> Article 5 of the Union Convention of 1886, as completed at Paris in 1896, reads as follows:  
"1. Authors who are nationals of any of the countries of the Union, or their successors in title, shall enjoy in the other countries the exclusive right of making or authorizing the translation of their works throughout the term of their right in the original work. Nevertheless, the exclusive right of translation shall cease to exist if the author shall not have availed himself of it, during a term of ten years from the date of first publication of the original work, by publishing or causing to be published, in one of the countries of the Union, a translation in the language for which protection is to be claimed.  
2. For works published in incomplete parts (*livraisons*), the period of ten years shall commence from the date of publication of the last part of the original work.  
3. For works composed of several volumes published at intervals, as well as for bulletins or collections (*cahiers*) published by literary or scientific societies, or by private persons, each volume, bulletin or collection shall be, with regard to the period of ten years, considered as a separate work."

understanding that the said provisions are applicable only to translations into a language in general use in the said country.

Any country may withdraw such reservations at any time by notification addressed to the Director General.

Article 31(1), (2) and (3): Applicability to Certain Territories

Any country may declare in its instrument of ratification or accession, or may inform the Director General by written notification at any time thereafter, that this Convention shall be applicable to all or part of those territories, designated in the declaration or notification, for the external relations of which it is responsible. Such declaration shall take effect on the same date as the ratification or accession in which it was included, and such notification shall take effect three months after its notification by the Director General.

Any country which has made such a declaration or given such a notification may, at any time, notify the Director General that this Convention shall cease to be applicable to all or part of such territories. Any such notification shall take effect twelve months after its receipt by the Director General.

Article 33: Disputes

Any dispute between two or more countries of the Union concerning the interpretation or application of this Convention, not settled by negotiation, may, by any one of the countries concerned, be brought before the International Court of Justice by application in conformity with the Statute of the Court, unless the countries concerned agree on some other method of settlement. The country bringing the dispute before the Court shall inform the International Bureau; the International Bureau shall bring the matter to the attention of the other countries of the Union.

Each country may, at the time it signs this Act or deposits its instrument of ratification or accession, declare that it does not consider itself bound by the above provisions.

Any country having made such a declaration may, at any time, withdraw its declaration by notification addressed to the Director General.

Article 35(2), (3) and (4): Duration of the Convention; Denunciation

Any country may denounce this Act by notification addressed to the Director General. Such denunciation shall constitute also denunciation of all earlier Acts and shall affect only the country making it, the Convention remaining in full force and effect as regards the other countries of the Union. Denunciation shall take effect one year after the day on which the Director General has received the notification. The right of denunciation provided by this Article shall not be exercised by any country before the expiration of five years from the date upon which it becomes a member of the Union.

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4. In the cases provided for by this Article, and for the calculation of the terms of protection, December 31 of the year in which the work was published shall be regarded as the date of publication."

## **APPENDIX: SPECIAL PROVISIONS REGARDING DEVELOPING COUNTRIES**

### Article I(1), (2) and (5): Faculties Open to Developing Countries

Any country regarded as a developing country in conformity with the established practice of the General Assembly of the United Nations which ratifies or accedes to this Act, and which, having regard to its economic situation and its social or cultural needs, does not consider itself immediately in a position to make provision for the protection of all the rights as provided for in this Act, may, by a notification deposited with the Director General at the time of depositing its instrument of ratification or accession or, subject to Article V(1)(c), at any time thereafter, declare that it will avail itself of the faculty provided for in Appendix, namely the possibility of granting non-voluntary licenses in respect of (i) translation for the purpose of teaching, scholarship or research, and (ii) reproduction for use in connection with systematic instructional activities, of works protected under the Convention.

Any such declaration notified before the expiration of the period of ten years from the entry into force of Articles 1 to 21 and this Appendix shall be effective until the expiration of the said period. Such declaration may be renewed in whole or in part for periods of ten years each by a notification deposited with the Director General not more than fifteen months and not less than three months before the expiration of the ten-year period then running.

Any such declaration notified after the expiration of the period of ten years from the entry into force of Articles 1 to 21 and this Appendix shall be effective until the expiration of the ten-year period then running. Such declaration may be renewed as indicated in the above paragraph.

A country may make such declaration and the notification of renewal in respect of certain territories.

### Article II(3)(b): Limitations on the Right of Translation: Conditions allowing the grant of such licenses

If, after the expiration of a period of three years, or of any longer period determined by the national legislation of the country which has declared that it will avail itself of the faculty of granting non-voluntary licenses in respect of translation for the purpose of teaching, scholarship or research, commencing on the date of the first publication of the work, a translation of such work has not been published in a language in general use in that country by the owner of the right of translation, or with his authorization, any national of such country may obtain a license to make a translation of the work in the said language and publish the translation in printed or analogous forms of reproduction.

Any such country may, with the unanimous agreement of the developed countries which are members of the Union and in which the same language is in general use, substitute, in the case of translations into that language, for the period of three years referred to above a shorter period as determined by such agreement but not less than one year. However, the provisions of the foregoing sentence shall not apply where the language in question is English, French or Spanish. The Director General shall be notified of any such agreement by the Governments which have concluded it.

### Article IV(2) and (4): Provisions Common to Licenses Under Articles II and III: Procedure: Exportation of copies

If the owner of the right cannot be found, the applicant for a license shall send, by registered airmail, copies of his application, submitted to the authority competent to grant the license, to the publisher whose name appears on the work and to any national or international information center which may have been designated, in a notification to that effect deposited with the Director General, by the Government of the country in which the publisher is believed to have his principal place of business.

No license granted under Article II or Article III shall extend to the export of copies, and any such license shall be valid only for publication of the translation or of the reproduction, as the case may be, in the territory of the country in which it has been applied for.

For that purpose, where a governmental or other public entity of a country which has granted a license to make a translation under Article II into a language other than English, French or Spanish sends copies of a translation published under such license to another country, such sending of copies shall not be considered to constitute export if all of the following conditions are met:

- (i) the recipients are individuals who are nationals of the country whose competent authority has granted the license, or organizations grouping such individuals;
- (ii) the copies are to be used only for the purpose of teaching, scholarship or research;
- (iii) the sending of the copies and their subsequent distribution to recipients is without any commercial purpose; and
- (iv) the country to which the copies have been sent has agreed with the country whose competent authority has granted the license to allow the receipt, or distribution, or both, and the Director General has been notified of the agreement by the Government of the country in which the license has been granted.

Article V(3): Alternative Possibility for Limitation of the Right of Translation: Time limit for choosing the alternative possibility

Any country which has ceased to be regarded as a developing country may make a declaration to the effect provided for in Article 30(2)(b), namely that it intends to substitute, temporarily at least, for Article 8<sup>16</sup> of this Act concerning the right of translation, the provisions of Article 5<sup>17</sup> of the Union Convention of 1886, as completed at Paris in 1896, on the clear understanding that the said provisions are applicable only to translations into a language in general use in the said country notwithstanding the fact that it is not a country outside the Union. Such declaration shall take effect at the date on which the period applicable under Article I(3)<sup>18</sup> expires.

Article VI: Possibilities of applying, or admitting the application of, certain provisions of the Appendix before becoming bound by it: 1. Declaration; 2. Depository and effective date of declaration

- (1) Any country of the Union may declare, as from the date of this Act, and at any time before becoming bound by Articles 1 to 21 and this Appendix:

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<sup>18</sup> Article I (2) and (3) of Appendix to the Paris Act of the Berne Convention read as follows:  
"(2)(a) Any declaration under paragraph (1) notified before the expiration of the period of ten years from the entry into force of Articles 1 to 21 and this Appendix according to Article 28(2) shall be effective until the expiration of the said period. Any such declaration may be renewed in whole or in part for periods of ten years each by a notification deposited with the Director General not more than fifteen months and not less than three months before the expiration of the ten-year period then running.  
(b) Any declaration under paragraph (1) notified after the expiration of the period of ten years from the entry into force of Articles 1 to 21 and this Appendix according to Article 28(2) shall be effective until the expiration of the ten-year period then running. Any such declaration may be renewed as provided for in the second sentence of subparagraph (a).  
(3) Any country of the Union which has ceased to be regarded as a developing country as referred to in paragraph (1) shall no longer be entitled to renew its declaration as provided in paragraph (2), and, whether or not it formally withdraws its declaration, such country shall be precluded from availing itself of the faculties referred to in paragraph (1) from the expiration of the ten-year period then running or from the expiration of a period of three years after it has ceased to be regarded as a developing country, whichever period expires later."



- (i) if it is a country which, were it bound by Articles 1 to 21 and this Appendix, would be entitled to avail itself of the faculties referred to in Article I(1), that it will apply the provisions of Article II or of Article III or of both to works whose country of origin is a country which, pursuant to (ii) below, admits the application of those Articles to such works, or which is bound by Articles 1 to 21 and this Appendix; such declaration may, instead of referring to Article II, refer to Article V;
  - (ii) that it admits the application of this Appendix to works of which it is the country of origin by countries which have made a declaration under (i) above or a notification under Article I.
- (2) Any declaration made under paragraph (1) shall be in writing and shall be deposited with the Director General. The declaration shall become effective from the date of its deposit.

## **II. INTERNATIONAL CONVENTION FOR THE PROTECTION OF PERFORMERS, PRODUCERS OF PHONOGRAMS AND BROADCASTING ORGANISATIONS (ROME CONVENTION)**

### Article 5(3): Protected Phonograms: Power to exclude certain Criteria

Each Contracting State shall grant national treatment to producers of phonograms if any of the following conditions is met: (a) the producer of the phonogram is a national of another Contracting State (criterion of nationality); (b) the first fixation of the sound was made in another Contracting State (criterion of fixation); (c) the phonogram was first published in another Contracting State (criterion of publication). By means of a notification deposited with the Secretary-General of the United Nations, any Contracting State may declare that it will not apply the criterion of publication or, alternatively, the criterion of fixation. Such notification may be deposited at the time of ratification, acceptance or accession, or at any time thereafter; in the last case, it shall become effective six months after it has been deposited.

### Article 6(2): Protected Broadcasts: Power to Reserve

Each Contracting State shall grant national treatment to broadcasting organisations if either of the following conditions is met: (a) the headquarters of the broadcasting organisation is situated in another Contracting State; (b) the broadcast was transmitted from a transmitter situated in another Contracting State. By means of a notification deposited with the Secretary-General of the United Nations, any Contracting State may declare that it will protect broadcasts only if the headquarters of the broadcasting organisation is situated in another Contracting State and the broadcast was transmitted from a transmitter situated in the same Contracting State. Such notification may be deposited at the time of ratification, acceptance or accession, or at any time thereafter; in the last case, it shall become effective six months after it has been deposited.

### Article 16: Reservations

A State may at any time, in a notification deposited with the Secretary-General of the United Nations, declare that:

- (a) as regards Article 12 which provides that 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, a single equitable remuneration shall be paid by the user to the performers, or to the producers of the phonograms, or to both:
  - (i) it will not apply the provisions of that Article;
  - (ii) it will not apply the provisions of that Article in respect of certain uses;

- (iii) as regards phonograms the producer of which is not a national of another Contracting State, it will not apply that Article;
  - (iv) as regards phonograms the producer of which is a national of another Contracting State, it will limit the protection provided for by that Article to the extent to which, and to the term for which, the latter State grants protection to phonograms first fixed by a national of the State making the declaration; however, the fact that the Contracting State of which the producer is a national does not grant the protection to the same beneficiary or beneficiaries as the State making the declaration shall not be considered as a difference in the extent of the protection;
- (b) as regards Article 13 item (d) which provides that broadcasting organisations shall enjoy the right to authorize or prohibit 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: it will not apply that item; if a Contracting State makes such a declaration, the other Contracting States shall not be obliged to grant the right referred to in Article 13, item (d), to broadcasting organisations whose headquarters are in that State.

If the notification is made after the date of the deposit of the instrument of ratification, acceptance or accession, the declaration will become effective six months after it has been deposited.

#### Article 17: Certain countries applying only the "fixation" criterion

Any State which, on October 26, 1961, grants protection to producers of phonograms solely on the basis of the criterion of fixation may, by a notification deposited with the Secretary-General of the United Nations at the time of ratification, acceptance or accession, declare that it will apply, for the purposes of determining the point of attachment for protected phonograms as provided in Article 5, the criterion of fixation alone and, for the purposes of reservations as provided in Article 16, the criterion of fixation instead of the criterion of nationality.

#### Article 18: Withdrawal of reservations

Any State which has deposited a notification under Articles 5, 6, 16 or 17, may, by a further notification deposited with the Secretary-General of the United Nations, reduce its scope or withdraw it.

#### Article 27: Applicability of the Convention to Certain Territories

Any State may, at the time of ratification, acceptance or accession, or at any time thereafter, declare by notification addressed to the Secretary-General of the United Nations that this Convention shall extend to all or any of the territories for whose international relations it is responsible, provided that the Universal Copyright Convention or the International Convention for the Protection of Literary and Artistic Works applies to the territory or territories concerned. This notification shall take effect three months after the date of its receipt. The notifications referred to in Articles 5, 6, 16, 17 and 18, may be extended to cover all or any of those territories.

#### Article 28(2) and (3): Denunciation of the Convention

Any Contracting State may denounce this Convention, on its own behalf or on behalf of all or any of the territories for whose international relations it is responsible. The denunciation shall be effected by a notification addressed to the Secretary-General of the United Nations and shall take effect twelve months after the date of receipt of the notification. The right of denunciation shall not be exercised by a Contracting State before the expiry of a period of five years from the date on which the Convention came into force with respect to that State.

Article 29(1): Revision of the Convention

After this Convention has been in force for five years, any Contracting State may, by notification addressed to the Secretary-General of the United Nations, request that a conference be convened for the purpose of revising the Convention. The Secretary-General shall notify all Contracting States of this request. If, within a period of six months following the date of notification by the Secretary-General of the United Nations, not less than one half of the Contracting States notify him of their concurrence with the request, the Secretary-General shall inform the Director-General of the International Labor Office, the Director-General of the United Nations Educational, Scientific and Cultural Organization and the Director of the Bureau of the International Union for the Protection of Literary and Artistic Works, who shall convene a revision conference in co-operation with the Intergovernmental Committee.

**III. WIPO COPYRIGHT TREATY (WCT)**

Article 23: Denunciation of the Treaty

This Treaty may be denounced by any Contracting Party by notification addressed to the Director General of WIPO. Any denunciation shall take effect one year from the date on which the Director General of WIPO received the notification.

**IV. WIPO PERFORMANCES AND PHONOGRAMS TREATY (WPPT)**

Article 3(3): Beneficiaries of Protection under this Treaty

Any Contracting Party availing itself of the possibilities provided in Article 5 of the Rome Convention or, for the purposes of Article 5 of the same Convention, Article 17 thereof shall make a notification as foreseen in those provisions to the Director General of the World Intellectual Property Organization (WIPO).

Article 15(3): Right to Remuneration for Broadcasting and Communication to the Public

Any Contracting Party may in a notification deposited with the Director General of WIPO, declare that it will apply the provisions of paragraph (1), which state that performers and producers of phonograms shall enjoy the right to a single equitable remuneration for the direct or indirect use of phonograms published for commercial purposes for broadcasting or for any communication to the public, only in respect of certain uses, or that it will limit their application in some other way, or that it will not apply these provisions at all.

Article 31: Denunciation of the Treaty

This Treaty may be denounced by any Contracting Party by notification addressed to the Director General of WIPO. Any denunciation shall take effect one year from the date on which the Director General of WIPO received the notification.

**V. CONVENTION FOR THE PROTECTION OF PRODUCERS OF PHONOGRAMS AGAINST UNAUTHORIZED DUPLICATION OF THEIR PHONOGRAMS (GENEVA CONVENTION)**

Article 7(4): Savings: Substitution of the Criterion of Fixation

Any Contracting State which, on October 29, 1971, affords protection to producers of phonograms solely on the basis of the place of first fixation may, by a notification deposited with the

Director General of the World Intellectual Property Organization, declare that it will apply this criterion instead of the criterion of the nationality of the producer.

Article 8(1): Secretariat

The International Bureau of the World Intellectual Property Organization shall assemble and publish information concerning the protection of phonograms. Each Contracting State shall promptly communicate to the International Bureau all new laws and official texts on this subject.

Article 11(3): Applicability of the Convention to Certain Territories

Any State may, at the time of ratification, acceptance or accession or at any later date, declare by notification addressed to the Secretary-General of the United Nations that this Convention shall apply to all or any one of the territories for whose international affairs it is responsible. This notification will take effect three months after the date on which it is received.

Article 12: Denunciation of the Convention

Any Contracting State may denounce this Convention, on its own behalf or on behalf of any of the territories for whose international affairs it is responsible, by written notification addressed to the Secretary-General of the United Nations. Denunciation shall take effect twelve months after the date on which the Secretary-General of the United Nations has received the notification.

**VI. CONVENTION RELATING TO THE DISTRIBUTION OF PROGRAMME-CARRYING SIGNALS TRANSMITTED BY SATELLITE (BRUSSELS CONVENTION)**

Article 2(2)

In any Contracting State in which the application of the measures to prevent the distribution on or from its territory of any programme-carrying signal by any distributor for whom the signal emitted to or passing through the satellite is not intended is limited in time, the duration thereof shall be fixed by its domestic law. The Secretary-General of the United Nations shall be notified in writing of such duration at the time of ratification, acceptance or accession, or if the domestic law comes into force or is changed thereafter, within six months of the coming into force of that law or of its modification.

Article 8(2) and (3)

Article 2 (1) of this Convention provides that "[e]ach Contracting State undertakes to take adequate measures to prevent the distribution on or from its territory of any programme-carrying signal by any distributor for whom the signal emitted to or passing through the satellite is not intended. This obligation shall apply where the originating organization is a national of another Contracting State and where the signal distributed is a derived signal". Any Contracting State whose domestic law, on May 21, 1974, so provides may, by a written notification deposited with the Secretary-General of the United Nations, declare that, for its purposes, the words "where the originating organization is a national of another Contracting State" appearing in Article 2(1) shall be considered as if they were replaced by the words "where the signal is emitted from the territory of another Contracting State".

Any Contracting State which, on May 21, 1974, limits or denies protection with respect to the distribution of programme-carrying signals by means of wires, cable or other similar communications channels to subscribing members of the public may, by a written notification deposited with the Secretary-General of the United Nations, declare that, to the extent that and as long as its domestic law limits or denies protection, it will not apply this Convention to such distributions. Any State that

has deposited such a notification shall notify the Secretary-General of the United Nations in writing, within six months of their coming into force, of any changes in its domestic law whereby such reservation becomes inapplicable or more limited in scope.

#### Article 11

Any Contracting State may denounce this Convention by written notification deposited with the Secretary-General of the United Nations. Denunciation shall take effect twelve months after the date on which the notification is received.

### **VII. PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY**

#### Article 13(4)(c): Assembly of the Union

Communication by the International Bureau of decisions made by the Assembly to the countries members of the Assembly which were not represented inviting them to express in writing their vote or abstention within a period of three months from the date of the communication.

#### Article 15(2): International Bureau

Communication by each country of the Union to the International Bureau of all new laws and official texts concerning the protection of industrial property. The International Bureau has the duty to assemble and publish information concerning the protection of industrial property.

#### Article 16(7)(b): Finances

Notification by the country on the territory of which the Organization has its headquarters denouncing its obligation to grant advances.

#### Article 17(1) and (3): Amendment of Articles 13 to 17

Communication by the Director General of proposals for the amendment of Articles 13 to 17, initiated by any country of the Assembly, to the member countries of the Assembly at least six months in advance of their consideration by the Assembly. Notification of acceptance of an amendment to Articles 13 to 17 by countries that are members of the Assembly at the time it adopted the amendment.

#### Article 20(2)(c): Ratification or Accession by Countries of the Union; Entry Into Force

Notification by the Director General of the deposit of an instrument of ratification or accession.

#### Article 24(1): Territories

Notification by a country that the Paris Convention shall be applicable to all or part of the territories specified in the notification.

#### Article 26(2): Denunciation

Notification of denunciation by a country.

#### Article 28(3): Disputes

Notification of withdrawal of declaration that a country considers itself bound by Article 28(1) relating to the resolution of disputes.

Article 29(5): Signature, Languages, Depositary Functions

Notifications by the Director General to the Governments of all countries of the Union of

- ratification or accession according to Art. 20(1)(c);
- denunciation (Art. 26(2));
- relating to extension of applicability of the Convention to certain territories (Art. 24).

Article 30(2): Transitional Provisions

Notification by countries which are not bound by Articles 13 to 17 that they will exercise the rights provided under Articles 13 to 17 as if they were bound by those Articles.

Article 6ter: Marks: Prohibitions concerning State Emblems, Official Hallmarks, and Emblems of Intergovernmental Organizations

*I. Introduction*

1. Article 6ter of the Paris Convention for the Protection of Industrial Property of 1883 (1967 Stockholm Act) was introduced into the Paris Convention by the Revision Conference of The Hague in 1925. It underwent some minor modifications as to form at the Revision Conference of London in 1934, and was more thoroughly revised by the Revision Conference of Lisbon in 1958.

*II. Objective*

2. The purpose of Article 6ter is to protect armorial bearings, flags and other State emblems of the States party to the Paris Convention as well as official signs and hallmarks indicating control and warranty adopted by them.

3. This protection was extended to armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organizations by the Revision Conference of Lisbon in 1958.

*III. Communication procedure and requirements*

4. Any emblem or other official sign mentioned in paragraphs 2 and 3 above for which a State party to the Paris Convention or an international intergovernmental organization wishes to obtain protection has to be communicated to the International Bureau of WIPO, which will then transmit the communication to the other States party to the Paris Convention. Nevertheless, such a communication is not obligatory in respect of flags of States.

5. Any State receiving the communication of an emblem or other official sign may, within a period of 12 months from the receipt of that communication, transmit its objections, if any, through the intermediary of the International Bureau, to the State or international intergovernmental organization at the request of which the communication was made.

6. The protection offered by Article 6ter to any emblem or other official signs mentioned in paragraphs 2 and 3 above, communicated as indicated in paragraph 4, and which has not been the subject of an objection as indicated in paragraph 5, is not of a general nature. The purpose of Article 6ter is only to prohibit the registration and use of trademarks which are identical to, or present a certain similarity with the above-mentioned emblems or official signs.

7. Article 6ter is only applicable to *trademarks* and does not oblige States party to the Paris Convention to refuse or to invalidate the registration, and to prohibit use of State emblems or other

officials signs as a *service mark* or as an element of a service mark. States are nevertheless free to do so, and under Article 16 of the Trademark Law Treaty (TLT), member States of that Treaty are obliged to extend protection with respect to service marks.

8. The list of the items which can be the subject of a communication under Article 6*ter* of the Paris Convention, *at the request of a State* party to that Convention comprises: armorial bearings, flags and other State emblems, as well as official signs and hallmarks indicating control and warranty adopted by the State itself. The expression "other State emblems" is rather vague. It is generally understood as referring to any emblems constituting the symbol of the sovereignty of a State.

9. It is to be noted that the intention of the Revision Conference of The Hague, in 1925, was to include in the protection of State emblems the escutcheons of reigning Houses, as well as emblems of States included in a Federative State which is party to the Paris Convention. However, it was not intended to include emblems of lower public bodies.

10. The purpose of official signs and hallmarks indicating control and warranty is to certify that a State or an organization duly appointed by a State to that effect has checked that certain goods meet specific standards or have a given level of quality. Official signs and hallmarks indicating control and warranty exist in several States with respect to precious metals or products such as butter, cheese, meat, electrical equipment, etc. In principle, official signs and hallmarks indicating control and warranty may also apply to services, for instance those relating to education, tourism, etc.

#### IV. *Protection*

11. The protection as an official sign indicating control and warranty is more limited than a protection as a State emblem. Article 6*ter*(2) provides that such protection "shall apply solely in cases where the marks in which they are incorporated are intended to be used on goods of the same or similar kind". Under Article 16 of the TLT, this provision extends to services.

12. The protection afforded by Article 6*ter* was extended by the Revision Conference of Lisbon in 1958, not only to armorial bearings, flags and other emblems, but also to names, and abbreviations of such names of *intergovernmental organizations* of which one or more States party to the Paris Convention are members. However, the protection under Article 6*ter* did not extend to armorial bearings, flags, other emblems, names and abbreviations of intergovernmental organizations which are already the subject of international agreements in force, intended to ensure their protection, such as the Geneva Convention for the amelioration of the condition of the wounded and sick in armed forces, of August 12, 1949, Article 44 of which protects the emblems of the Red Cross on a white ground, the words "Red Cross" or "Geneva Cross, and analogous emblems".

13. States party to the Paris Convention are free not to grant protection to armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organizations to the prejudice of the owners of rights acquired in good faith before the entry into force, in that State, of the Paris Convention.

14. States party to the Paris Convention are also free not to grant protection where the use or registration of a trademark against which the protection is invoked does not suggest a connection with the intergovernmental organization concerned, or where such use or registration is probably not of such a nature to mislead the public as to the existence of a connection between the user and the organization.

15. A distinction has to be made between, on the one hand, flags of States and, on the other hand, State emblems other than flags, official signs and hallmarks, and emblems, including flags, names and abbreviations of intergovernmental organizations. In the case of the first category, the protection under this provision will apply only to marks registered after November 6, 1925, that is, the date of

the signature of the text of the Convention as revised at The Hague. In the case of the second category, the protection will apply only to marks registered more than two months after receipt of the communication made by the International Bureau of WIPO.

V. *General exception*

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

VI. *WTO Members and Article 6ter*

17. *WTO Members bound by the TRIPS Agreement to comply with Article 6ter.* Where a WTO Member, which is not party to the Paris Convention but *is bound by* the TRIPS Agreement to comply with the provisions of Article 6ter of the Paris Convention (1967):

- receives communication of an emblem of a State party to the Paris Convention which is a WTO Member, it is obliged to protect that emblem, subject to the objection procedure of Article 6ter(4);
- receives communication of an emblem of a State party to the Paris Convention which is not a WTO Member, it is not obliged to protect that emblem until (i) it becomes party to the Paris Convention, or (ii) the State which communicated the emblem becomes a WTO Member;
- receives communication of an emblem of an international intergovernmental organization, it is obliged to protect that emblem, subject to the objection procedure of Article 6ter(4) (This situation also applies to WTO Members which are party to the London or The Hague Acts of the Paris Convention).

18. *WTO Members not bound by the TRIPS Agreement to comply with Article 6ter.* Where a WTO Member, which is not party to the Paris Convention and *is not bound by* the TRIPS Agreement to comply with the provisions of Article 6ter of the Paris Convention (1967):

- receives communication of an emblem of a State party to the Paris Convention which is a WTO Member, it is not obliged to protect that emblem until (i) it becomes party to the Paris Convention, or (ii) it becomes bound under the TRIPS Agreement to comply with the provisions of Article 6ter of the Paris Convention (1967);
- receives communication of an emblem of a State party to the Paris Convention which is not a WTO Member, it is not obliged to protect that emblem until (i) it becomes party to the Paris Convention, or (ii) it becomes bound under the TRIPS Agreement to comply with the provisions of Article 6ter of the Paris Convention (1967) *and* the State which communicated the emblem becomes a WTO Member;
- receives communication of an emblem of an international intergovernmental organization, it is not obliged to protect that emblem until (i) it becomes party to the Paris Convention, or (ii) it becomes bound under the TRIPS Agreement to comply with the provisions of Article 6ter of the Paris Convention (1967).

**ANNEX 4**

**INTERNATIONAL REGISTRATION SYSTEMS ADMINISTERED BY WIPO**



Summaries

Information supplied by the International Bureau of WIPO

- Basic facts about the Patent Cooperation Treaty (PCT): the worldwide system for simplified multiple filing of patent applications
- The Madrid Agreement Concerning the International registration of Marks and the Protocol Relating to that Agreement: Objectives, Main Features, Advantages
- The Hague Agreement Concerning the International Deposit of Industrial Designs: Objectives, Main Features, Advantages
- The Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs: Main Innovations Compared with the Present system Provided for in the 1934 and 1960 Acts of the Agreement
- Lisbon Agreement for the Protection of Appellations of Origin and their International Registration
- Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure

## **THE PATENT COOPERATION TREATY (PCT) BASIC FACTS**

### **Do you want to protect your invention in several countries?**

If so, you should consider the advantages that are offered by filing an "international" patent application under the Patent Cooperation Treaty (the "PCT"). By filing one international patent application under the PCT, and designating any or all of the PCT Contracting States, you can simultaneously seek patent protection for an invention in each of a large number of countries.

### **Do you want to evaluate your chances of protecting your invention before incurring major costs in foreign countries?**

If your answer is yes, you should consider that the "international search report", which you will normally receive a few months after filing your PCT application, contains a list of relevant "prior art" documents which you can evaluate. You also have the option of obtaining an "international preliminary examination report" which gives you more detailed information about the patentability of your invention before you incur the high costs of the patent granting procedure in each of the countries you designated.

### **Do you want to keep all of your options open for protecting your invention while still investigating its commercial possibilities abroad?**

If you do, you should consider the extra time you gain when you file a PCT application: in relation to most designated Offices, 18 months more than under the traditional patent system (based on the Paris Convention for the Protection of Industrial Property).

### **Do you want to obtain more reliable patents abroad?**

If so, you should take into account the benefits of the international standards which are applied by the "International Searching Authorities" and the "International Preliminary Examining Authorities" when carrying out the international search and the international preliminary examination of your application. Any patents subsequently granted by the national or regional Offices on the international application can be relied on by the applicant to a greater extent than would have been the case without the benefit of the international search report and the international preliminary examination report.

### **What are the basic facts about filing patent applications under the PCT?**

Set out below are the basic facts which you should know about the PCT. For further information and contact points, refer to the end of this brochure. A significant amount of important information is available on the PCT website: [www.wipo.int/pct/en/](http://www.wipo.int/pct/en/).

#### **(1) Your right to file an international patent application**

You are entitled to file an international patent application if you are a national or resident of one of the PCT Contracting States which are listed at the end of this brochure.

#### **(2) Where to file an international patent application**

You can file an international patent application with your national Patent Office which will act as a PCT "receiving Office" or, unless not permitted by national security provisions in your

national law, with the International Bureau of WIPO, at the address indicated at the end of this brochure. If you are a national or resident of a country which is party to one of certain regional patent treaties (the ARIPO Harare Protocol, the OAPI Agreement, the Eurasian Patent Convention and the European Patent Convention), you may alternatively file your international patent application with the regional Patent Office concerned, if permitted by the applicable national law.

(3) Effect of an international patent application

Provided it complies with the minimum requirements for obtaining an international filing date, your international application has the effect of a national patent application in those PCT Contracting States which you have "designated" in your application. It has the effect of a regional patent application in those PCT Contracting States which are also party to a regional patent treaty (the ARIPO Harare Protocol, the Eurasian Patent Convention, the European Patent Convention and the OAPI Agreement), provided they are designated for the regional patent concerned. (It should be noted that, for some of these States, only a regional patent can be obtained via the PCT.) Because an international patent application must be prepared in accordance with certain requirements set out in the Treaty and Regulations, which have become international standards effective in all of the PCT Contracting States, subsequent adaptation to varying national (or regional) formal requirements (and the cost associated therewith) will not be necessary. The granting of a patent remains the responsibility of the national or regional Offices but the start of the processing of the application before those Offices (the "national phase" or "regional phase"), including examination as to substance, is generally delayed until after the end of the 30th month from the priority date (see (13), below).

(4) Cost of filing an international patent application

Because an international patent application is effective in all designated PCT Contracting States, you do not have to incur the costs that would arise if you prepared and filed separate applications for all of those States, and you have to pay only a single set of fees for filing the international patent application with the PCT receiving Office. Information about these fees can be obtained from the receiving Offices (see (2), above) or in the *PCT Applicant's Guide* and the *PCT Newsletter* (see the end of this brochure). They cover the filing, searching and publication of the international patent application, and are payable in the currency, or one of the currencies accepted by your Office (the receiving Office). For fees payable when you request international preliminary examination, refer to (10), below. National fees in the designated States become payable much later because national processing is delayed if the PCT is used (see (13), below). In several Offices, national fees are also lower for international patent applications than they would be if direct national applications had been filed. An applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 is entitled to a reduction of 75 per cent of certain fees, including the international fee (basic fee and designation fees). If there are several applicants, each must satisfy those criteria. For more details, including the list of the PCT Contracting States the nationals and residents of which are eligible for such fee reductions, please refer to the *PCT Applicant's Guide* or contact the PCT Information Line (see back page).

(5) Language of the international patent application

In general, an international patent application can be filed in any language which your receiving Office is prepared to accept. Receiving Offices are, however, obliged to accept filings in at least one language which is both a language accepted by the competent International Searching Authority that is to carry out the international search (see (7), below) and a "publication language", that is, one of the languages in which international patent applications are published (Chinese, English, French, German, Japanese, Russian and Spanish). You therefore always have the option of filing your international patent application in a language from which no translation is required for either search or publication purposes. If you file your application in a language which is not accepted by the

International Searching Authority that is to carry out the international search, you will be required to furnish a translation of the application for the purposes of international search.

(6) Claiming the priority of an earlier application

In an international patent application, you may claim the priority, under the Paris Convention — and to a certain extent within the framework of the World Trade Organization —, of an earlier patent application for the same invention, whether it was a national, a regional (for example, European) or an international (PCT) application, for up to 12 months after the filing of that earlier application. If you do not claim priority from an earlier application, the priority date will be the international filing date of the international application.

(7) Quality of the international search

International patent applications are subjected to an "international search" by an International Searching Authority. International search is a high-quality search of the patent documents and other technical literature in those languages in which most patent applications are filed (English, French and German, and in certain cases, Chinese, Japanese, Russian and Spanish). The high quality of the search is assured by the standards prescribed in the PCT for the documentation to be consulted, and by the qualified staff and effective search methods of the International Searching Authorities, which are experienced patent Offices that have been specially appointed to carry out international searches. The following are the International Searching Authorities: the national Offices of Australia, Austria, China, Japan, the Republic of Korea, the Russian Federation, Spain, Sweden and the United States of America, and the European Patent Office. For a given international patent application, there may be one or more competent International Searching Authorities (your PCT receiving Office can supply details or you may consult the *PCT Applicant's Guide* and *PCT Newsletter* (see the end of this brochure)).

(8) Value of the international search report

The results of the international search are set out in an "international search report" which is generally made available to you by the fourth or fifth month after the international patent application is filed. The international search report contains no comments on the value of your invention but lists prior art documents relevant to the claims of your international patent application and gives an indication of the possible relevance of the citations to the questions of novelty and inventive step (non-obviousness). This enables you to evaluate your chances of obtaining patents in the countries you have designated. An international search report which is favorable, that is, in which the citations of prior art would appear not to prevent the grant of a patent, assists you in the subsequent prosecution of your application in those countries in which you wish to obtain protection. If a search report is unfavourable (for example, if it lists prior art documents questioning the novelty and/or inventive step of your invention), you have the opportunity to centrally amend the claims in your international patent application (to better distinguish your invention from the prior art) or to withdraw the application before it is published. The high quality of the international search assures you that any patent granted is less likely to be successfully challenged, and thus provides valuable input to investment decisions.

(9) Publication of the international application

If the international application has not been withdrawn earlier, it is published by the International Bureau shortly after 18 months from the priority date, together with the international search report, and communicated by the International Bureau to each designated Office.

(10) Option of international preliminary examination

Under the PCT system, you have the option to have an international preliminary examination of your application carried out, on payment of the relevant fees. This preliminary examination is made, on the basis of the international search report, according to internationally accepted criteria for patentability (novelty, inventive step and industrial applicability). It is carried out by an International Preliminary Examining Authority having qualifications similar to those of the International Searching Authorities mentioned above. As an applicant, you may participate actively in the international preliminary examination, submitting amendments and arguments. The International Preliminary Examining Authorities are the International Searching Authorities mentioned above, except the national Office of Spain. For a given international patent application, there may be one or more competent International Preliminary Examining Authorities (your PCT receiving Office can supply details or you may consult the *PCT Applicant's Guide* and the *PCT Newsletter*).

(11) Value of the international preliminary examination report

The results of the international preliminary examination are set out in an "international preliminary examination report" which is provided to you; copies are also sent by the International Bureau to the Offices concerned. The report consists of an opinion on the compliance with the international criteria mentioned above (see (10)) of each of the claims which has been searched. It provides you with an even stronger basis on which to evaluate your chances of obtaining patents, and, if the report is favorable, a stronger basis on which to prosecute your application before the national and regional patent Offices. The decision on the granting of a patent remains the responsibility of each of the national or regional Offices designated in the international patent application; the international preliminary examination report is authoritative but is not binding on those Offices.

(12) Access by third parties to documents contained in the file of the international patent application

Until international publication (18 months after the priority date), no third person is allowed access to your international patent application unless so requested or authorized by you. If you wish to withdraw your application (and you do so in time before international publication), international publication does not take place and, as a consequence, no access by third parties is permitted. Upon international publication, third parties can request copies of documents contained in the file of the international application; such requests may be made either to the International Bureau or the national or regional Offices, depending on the document concerned.

(13) Delaying the procedure before the national or regional Offices

When an international patent application has been filed, the national procedures in relation to the majority of the designated Offices are delayed until the end of the 30th month from the priority date (there are some exceptions; for details, see the *PCT Newsletter* and the *PCT Applicant's Guide* — even longer delays are available before some Offices). The delay normally gives you 18 months more before you have to fulfill the national requirements (see (14), below) than if you do not use the PCT. This additional time can be very useful for evaluating the chances of obtaining patents and of exploiting your invention commercially in the various designated countries, and for assessing both the technical value of your invention as well as the continued need for protection in those countries.

In making such an evaluation, you have the benefit of the international search report and if you so requested, also the international preliminary examination report.

(14) Start of the procedure before the national or regional Offices

It is only after you have decided whether, and in respect of which States, you wish to proceed further with your application that you must fulfill the various national requirements for entry into the national phase. These requirements include paying national fees and, in some cases, filing translations of the application as filed and/or as amended. These steps must be taken, in relation to the majority of PCT designated Offices, before the end of the 30th month from the priority date (see (13), above). There may also be other requirements in connection with the national phase — for example, the appointment of local agents.

(15) Examination and further processing before the national or regional Offices

The substantive examination and other processing of your international patent application before the national and regional Offices is made easier by the international search, which enables you to make necessary amendments to the claims in the application even before the national or regional procedure starts (see (8), above). It is facilitated even more by the international preliminary examination procedure during which further amendments are possible. You also achieve other savings in communications, postage and translations as the work done during the international processing is generally not repeated before each designated Office (for example, you submit only one copy of the priority document instead of having to submit several copies).

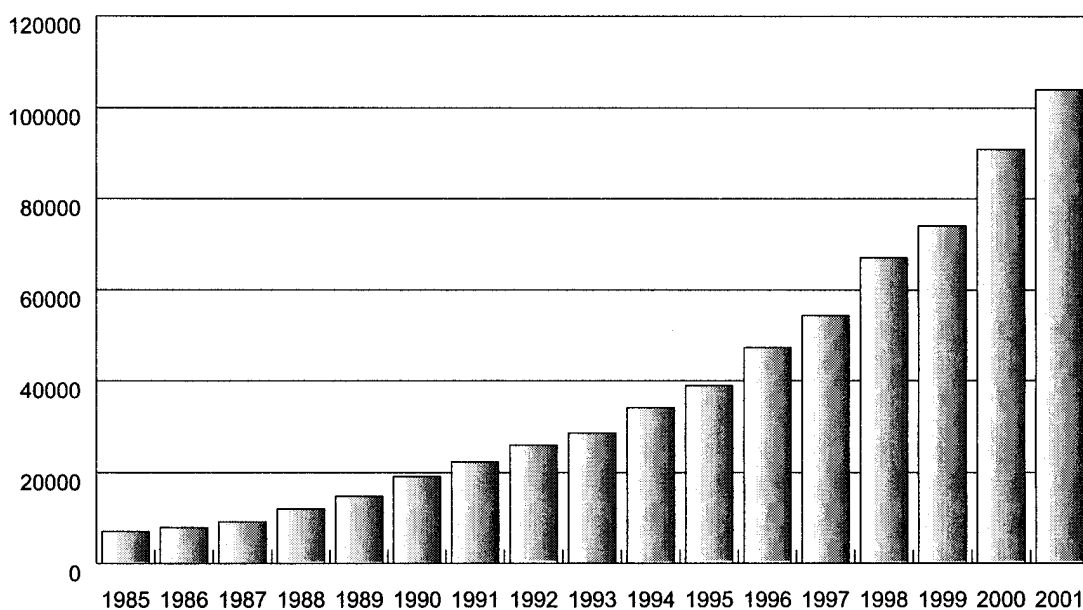
(16) Basic facts about the PCT itself

The PCT was concluded in 1970, amended in 1979 and modified in 1984 and 2001. It is open to States party to the Paris Convention for the Protection of Industrial Property. Instruments of ratification or accession must be deposited with the Director General of WIPO. The PCT created a Union. The Union has an Assembly. Every State party to the PCT is a member of the Assembly.

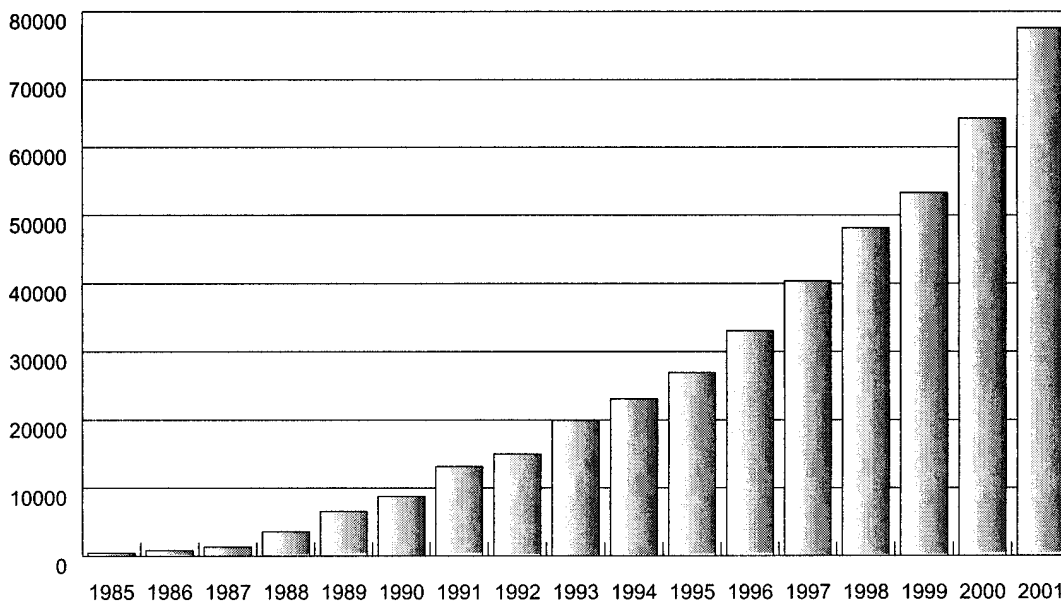
(17) Statistics

The following charts illustrate the growth of the PCT in terms of Contracting States and its increasing use by applicants. They show annual figures for international applications and for demands for international preliminary examination since 1985.

**NUMBER OF INTERNATIONAL APPLICATIONS**



**NUMBER OF DEMANDS FOR INTERNATIONAL  
PRELIMINARY EXAMINATION**



**PCT CONTRACTING STATES**  
**(TOTAL: 115 ON 1 APRIL 2002)**

Albania	Germany	Republic of Moldova
Algeria	Ghana	Romania
Antigua and Barbuda	Greece	Russian Federation
Armenia	Grenada	Saint Lucia
Australia	Guinea	Senegal
Austria	Guinea-Bissau	Sierra Leone
Azerbaijan	Hungary	Singapore
Barbados	Iceland	Slovakia
Belarus	India	Slovenia
Belgium	Indonesia	South Africa
Belize	Ireland	Spain
Benin	Israel	Sri Lanka
Bosnia and Herzegovina	Italy	Sudan
Brazil	Japan	Swaziland
Bulgaria	Kazakhstan	Sweden
Burkina Faso	Kenya	Switzerland
Cameroon	Kyrgyzstan	Tajikistan
Canada	Latvia	The former Yugoslav Republic of Macedonia
Central African Republic	Lesotho	Togo
Chad	Liberia	Trinidad and Tobago
China	Liechtenstein	Tunisia
Colombia	Lithuania	Turkey
Congo	Luxembourg	Turkmenistan
Costa Rica	Madagascar	Uganda
Côte d'Ivoire	Malawi	Ukraine
Croatia	Mali	United Arab Emirates
Cuba	Mauritania	United Kingdom
Cyprus	Mexico	United Republic of Tanzania
Czech Republic	Monaco	United States of America
Democratic People's Republic of Korea	Mongolia	Uzbekistan
Denmark	Morocco	Viet Nam
Dominica	Mozambique	Yugoslavia
Ecuador	Netherlands	Zambia
Equatorial Guinea	New Zealand	Zimbabwe
Estonia	Niger	
Finland	Norway	
France	Oman	
Gabon	Philippines	
Gambia	Poland	
Georgia	Portugal	
	Republic of Korea	

\* This list includes all States that have acceded to the PCT by the date shown in the heading. Applicants intending to file international applications under the PCT should ask the receiving Office or the International Bureau about accessions by any further States.



### **Further information**

If, after having familiarized yourself with these basic facts, you are considering filing an international patent application or would like to have more detailed information, you should consult the PCT website ([www.wipo.int/pct/en/](http://www.wipo.int/pct/en/)), in particular the *PCT Newsletter* and the *PCT Applicant's Guide* which provide extensive information on the PCT procedure as well as a complete set of instructions for filing international patent applications, consult a patent attorney or agent in your country, or your national Patent Office.

The forms required for the filing of an international application may be obtained free of charge in various electronic formats from the PCT website, and in paper form from the International Bureau and your national Office.

### **PCT Information Line**

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## **THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE PROTOCOL RELATING TO THAT AGREEMENT**

### **OBJECTIVES, MAIN FEATURES, ADVANTAGES**

#### **Introduction**

1. The system of international registration of marks is governed by two treaties: the Madrid Agreement Concerning the International Registration of Marks, which dates from 1891, and the Protocol Relating to the Madrid Agreement, which was adopted in 1989, entered into force on December 1, 1995, and came into operation on April 1, 1996. Common Regulations under the Agreement and Protocol also came into force on that date. The system is administered by the International Bureau of WIPO, which maintains the International Register and publishes the *WIPO Gazette of International Marks*.

2. Any State which is a party to the Paris Convention for the Protection of Industrial Property may become a party to the Agreement or the Protocol or both. In addition, an intergovernmental organization may become a party to the Protocol (but not the Agreement) where the following conditions are fulfilled: at least one of the Member States of the organization is a party to the Paris Convention and the organization maintains a regional office for the purposes of registering marks with effect in the territory of the organization.

3. States party to the Agreement and/or the Protocol and organizations party to the Protocol are referred to collectively as Contracting Parties. A list of the Contracting Parties is given on a separate sheet. Together, they constitute the Madrid Union, which is a Special Union under Article 19 of the Paris Convention.

4. Every member of the Madrid Union is a member of its Assembly. Among the most important tasks of the Assembly are the adoption of the program and budget of the Union and the adoption and modification of the implementing regulations, including the fixing of fees connected with the use of the Madrid system.

#### **Objectives**

5. The objectives of the system are two-fold. Firstly, it facilitates the obtaining of protection for marks (trademarks and service marks). The registration of a mark in the International Register produces, in the Contracting Parties designated by the applicant, the effects described in paragraph 28, below. Further Contracting Parties may be designated subsequently. Secondly, since an international registration is equivalent to a bundle of national registrations, the subsequent management of that protection is made much easier. There is only one registration to renew, and changes such as a change in ownership or in the name or address of the holder, or a limitation of the list of goods and services, can be recorded in the International Register through a single simple procedural step. On the other hand, if it is desired to transfer the registration for only some of the designated Contracting Parties, or for only some of the goods or services, or to limit the list of goods and services with respect to only some of the designated Contracting Parties, the system is flexible enough to accommodate this.

#### **Who May Use the System?**

6. An application for international registration (an "international application") may be filed only by a natural person or a legal entity which has a real and effective industrial or commercial

establishment in, or is domiciled in, or is a national of, a country which is party to the Madrid Agreement or the Madrid Protocol, or who has such an establishment in, or is domiciled in, the territory of an intergovernmental organization which is a party to the Protocol, or is a national of a Member State of such an organization.

7. The Madrid system of international registration cannot be used by a person or legal entity which does not have the necessary connection, through establishment, domicile or nationality, with a member of the Madrid Union. Nor can it be used to protect a mark outside the Madrid Union.

### **The International Application**

8. A mark may be the subject of an international application only if it has already been registered (or, where the international application is governed exclusively by the Protocol, if registration has been applied for) in the Trademark Office of the Contracting Party with which the applicant has the necessary connection, as described in paragraph 6, above, to be able to file an international application. This Office is referred to as the Office of origin.

9. An international application must be presented to the International Bureau through the Office of origin. An international application which is presented direct to the International Bureau by the applicant will not be considered as such and will be returned to the sender.

10. The international application must contain, *inter alia*, a reproduction of the mark (which must be identical with that in the basic registration or basic application) and a list of the goods and services for which protection is sought, classified in accordance with the International Classification of Goods and Services (Nice Classification).

11. An international application may claim priority under Article 4 of the Paris Convention, whether from the application with the Office of origin or from a prior application filed with the Office of another country party to the Paris Convention or with the Office of a Member of the World Trade Organization.

12. An international application must designate the Contracting Parties in which the mark is to be protected. Where the Contracting Party whose Office is the Office of origin is a party to the Agreement but not the Protocol, only other States which are also party to the Agreement may be designated. Where the Contracting Party whose Office is the Office of origin is a party to the Protocol but not the Agreement, only other Contracting Parties which are also party to the Protocol may be designated. Where the Contracting Party whose Office is the Office of origin is a party to both the Agreement and the Protocol, any other Contracting Party may be designated.

13. The Contracting Party whose Office is the Office of origin cannot be designated in an international application; nor can it be designated subsequently.

14. The designation of a given Contracting Party is made under that treaty (Agreement or Protocol) which is common to the designated Contracting Party and the Contracting Party whose Office is the Office of origin. Where both Contracting Parties are party to both the Agreement and the Protocol, it is the Agreement which governs the designation; this follows from the so-called "safeguard" clause, Article 9*sexies* of the Protocol.

15. There are therefore three kinds of international application:

- an international application *governed exclusively by the Agreement*; this means that all the designations are made under the Agreement;

- an international application *governed exclusively by the Protocol*; this means that all the designations are made under the Protocol;
- an international application *governed by both the Agreement and the Protocol*; this means that some of the designations are made under the Agreement and some under the Protocol.

16. If the international application is governed exclusively by the Agreement, it must be in French. If it is governed exclusively by the Protocol or by both the Agreement and the Protocol, it may be in either English or French; the Office of origin may however restrict the applicant's choice to one of these languages.

17. The international application is subject to the payment of the following fees:

- a basic fee;
- a complementary fee in respect of each designated Contracting Party for which no individual fee is payable;
- an individual fee in respect of any Contracting Party which is designated under the Protocol and has declared that it wishes to receive such a fee; (the amount of the individual fee is determined by each Contracting Party; it may not be higher than the amount that would be payable for the registration of a mark in the Office of that Contracting Party; the amounts of the respective individual fees are published in the Gazette);
- a supplementary fee in respect of each class of goods and services beyond the third; no supplementary fee is payable however where *all* the designations are ones in respect of which an individual fee has to be paid.

18. These fees may be paid direct to the International Bureau or, where the Office of origin accepts to collect and forward such fees, through that Office.

19. The Office of origin must certify that the mark is the same as that in the basic registration or basic application, that any indications such as a description of the mark or a claim to color as a distinctive feature of the mark are the same as those contained in the basic registration or basic application, and that the goods and services indicated in the international application are covered by the list of goods and services in the basic registration or basic application.

20. The Office of origin must also certify the date on which it received the request to present the international application. This date is important; provided the application is received by the International Bureau within two months of that date (and provided that certain crucial elements are not missing), it is that date that will be the date of the international registration.

21. The International Bureau checks that the international application complies with the requirements of the Agreement or Protocol and the Common Regulations, including requirements relating to the indication of goods and services and their classification, and that the required fees have been paid. The Office of origin and the applicant are informed of any irregularities; these must be remedied within three months, otherwise the application will be considered abandoned.

22. Where the international application complies with the applicable requirements, the mark is recorded in the International Register and published in the Gazette. The International Bureau then notifies each Contracting Party in which protection has been requested.

### **Examination by the Office of a Designated Contracting Party; Refusal of Protection**

23. The Office of a designated Contracting Party examines the international registration in exactly the same way as an application filed directly. If grounds for objection are found during the *ex officio* examination, or if an opposition is filed, the Office has the right to declare that protection cannot be granted to the mark in that Contracting Party.

24. Any provisional refusal must be notified to the International Bureau by the Office of the Contracting Party concerned within the time limit specified in the Agreement or Protocol. This time-limit is generally 12 months. A Contracting Party may however declare that, when it is designated under the Protocol, this time limit shall be replaced by 18 months. A Contracting Party that has made this declaration may further declare that a provisional refusal based on an opposition may be notified even after the expiry of this 18-month period.

25. The provisional refusal is recorded in the International Register and published in the Gazette and a copy is transmitted to the holder of the international registration.

26. Any procedure subsequent to the refusal, such as review, appeal or response to an opposition, is carried out directly between the holder and the Office concerned, without any involvement on the part of the International Bureau. The Office must however send a statement to the International Bureau once all the procedures before that Office have been completed, indicating that the provisional refusal is confirmed or is totally or partially withdrawn. This statement is also recorded in the International Register and published in the Gazette.

27. Where an Office finds no reason for refusing protection, it may, before the expiry of the applicable time limit for provisional refusal, issue a statement of grant of protection. Such statement is recorded in the International Register and published in the Gazette and a copy is transmitted to the holder of the international registration. An Office is however not obliged to issue a positive decision on registration and no legal consequences result if it does not do so.

### **Effects of the International Registration**

28. From the date of the international registration (or, in the case of a Contracting Party designated subsequently, from the date of that designation), the protection of the mark in each of the designated Contracting Parties is the same as if the mark had been the subject of an application for registration filed direct with the Office of that Contracting Party. If no provisional refusal is notified to the International Bureau within the relevant time limit, or if any such refusal is subsequently withdrawn, the protection of the mark in each designated Contracting Party is the same as if it had been registered by the Office of that Contracting Party.

29. An international registration is therefore equivalent to a bundle of national registrations. Although it is a single registration, protection may be refused by some of the designated Contracting Parties, or the protection may be limited or renounced with respect to only some of the designated Contracting Parties. Likewise an international registration may be transferred to a new owner with respect to only some of the designated Contracting Parties. An international registration may also be invalidated (for example, for non-use) with respect to one or more of the designated Contracting Parties. Moreover, any action for infringement of an international registration must be brought separately in each of the Contracting Parties concerned.

30. This is in contrast to a unitary regional right such as the Community trademark, which cannot be refused, limited or transferred with effect for only a part of the territory covered by the right, and which may be enforced by a single legal action covering infringement occurring anywhere in that territory.

### **Dependence on the Basic Mark**

31. For a period of five years from the date of its registration, an international registration remains dependent on the mark registered or applied for in the Office of origin. If, and to the extent that, the basic registration ceases to have effect, whether through cancellation following a decision of the Office of origin or a court, through voluntary cancellation or through non-renewal, within this five-year period, the international registration will no longer be protected. Similarly, where the international registration was based on an application in the Office of origin, it will be cancelled if, and to the extent that, that application is refused or withdrawn within the five-year period, or if, and to the extent that, the registration resulting from that application ceases to have effect within that period.

32. The Office of origin is required to notify the International Bureau of facts and decisions concerning such ceasing of effect or refusal and, where appropriate, to request the cancellation (to the extent applicable) of the international registration. The cancellation is published in the Gazette and notified to the designated Contracting Parties. Such cancellations are relatively infrequent; only about 190 were recorded during 2001, many of which related to only some of the goods and services covered by the international registration.

33. If, within three months of such cancellation, the holder files an application for registration with the Office of a Contracting Party that had been designated under the Protocol, that application will be treated as if it had been filed on the date of the international registration or (as the case may be) the subsequent designation of the Contracting Party concerned. This option is not available in the case of a Contracting Party designated under the Agreement.

34. After the expiry of the period of five years mentioned in paragraph 31, the international registration becomes independent of the basic registration or basic application.

### **Replacement of a National or Regional Registration by an International Registration**

35. An international registration is deemed to replace a national or regional registration for the same mark and the same goods and services recorded in the name of the same person in a designated Contracting Party. The effect of replacement is that, if the national or regional registration is not renewed, the holder of the international registration may continue to benefit from the earlier rights acquired by reason of that national or regional registration. Although replacement takes place automatically, the holder of the international registration may request the Office of the Contracting Party in which the national or regional registration is recorded to take note in its register of the international registration.

### **Subsequent Designation**

36. The effects of an international registration can be extended to a Contracting Party not covered by the international application by filing a subsequent designation. Thus the holder of an international registration can expand the geographical scope of the protection of his mark in line with his business needs. Moreover a subsequent designation may be made in order to extend the protection of the mark to a Contracting Party which was not a party to the Agreement or Protocol at the time of the international application. The principles that determine whether such a designation can be made, and whether it is governed by the Agreement or by the Protocol, are as described in paragraphs 14 and 15, above.

### **Changes in the International Register; Cancellation; Licenses**

37. A change in the name or address of the holder or his representative may be recorded in the International Register on request.

38. Likewise a change in the ownership of an international registration may be recorded, in respect of all or some of the goods and services and all or some of the designated Contracting Parties. A person may not however be recorded as the holder of an international registration in respect of a given Contracting Party if he would not be entitled (in accordance with the principles set out in paragraphs 14 and 15, above), to designate that Contracting Party in an international application. Thus, for example, a person who does not have a connection with a country which is a party to the Agreement may not be recorded as the holder of an international registration in respect of a designated Contracting Party which is a party only to the Agreement.

39. The following may also be recorded in the International Register:

- a *limitation* of the list of goods and services in respect of **all or some** of the designated Contracting Parties;
- a *renunciation* in respect of **some** of the designated Contracting Parties for **all** the goods and services;
- a *cancellation* of the international registration in respect of **all** the designated Contracting Parties for **all or some** of the goods and services;
- a *license* granted in respect of **all or some** of the designated Contracting Parties, and for **all or some** of the goods and services.

40. Information concerning such changes, cancellation and licenses is published in the Gazette and notified to the designated Contracting Parties.

41. No change may be made in the mark that is the subject of an international registration, either on renewal or at any other time. Nor may the list of goods and services be changed in a way that would extend the scope of protection.

#### **Duration of Registration; Renewal**

42. An international registration is effective for 10 years. It may be renewed for further periods of 10 years on payment of the prescribed fees. The International Bureau sends a reminder to the holder and to his representative (if any) six months before renewal is due.

43. The international registration may be renewed in respect of all the designated Contracting Parties or in respect of only some of them. It may not however be renewed in respect of only some of the goods and services recorded in the International Register; if therefore the holder wishes, at the time of renewal, to remove some of the goods and services from the international registration, he must separately request cancellation in respect of those goods and services.

#### **Advantages of the System**

44. International registration has several advantages for the owner of the mark. After registering the mark, or filing an application for registration, with the Office of origin, he has only to file one application, in one language, and pay one fee instead of filing separately in the trademark Offices of the various Contracting Parties in different languages and paying a separate fee in each Office. Moreover, the holder does not have to wait for the Office of each Contracting Party in which protection is sought to take a positive decision to register the mark; if no refusal is notified by an Office within the applicable time limit, the mark is protected in the Contracting Party concerned. In some cases, the holder does not even have to wait the expiry of this time limit in order to know that

the mark is protected in a Contracting Party, since he may, before the expiry of the time limit, receive a statement of grant of protection from the Office of that Contracting Party.

45. A further important advantage is that changes subsequent to registration, such as a change in the name or address of the holder, or a change (total or partial) in ownership or a limitation of the list of goods and services may be recorded with effect for several designated Contracting Parties through a single simple procedural step and the payment of a single fee. Moreover, there is only one expiry date and only one registration to renew.

46. International registration is also to the advantage of Trademark Offices. They do not need to examine for compliance with formal requirements, or classify the goods or services, or publish the marks. Moreover, they are compensated for the work that they perform; the individual fees collected by the International Bureau are transferred to the Contracting Parties in respect of which they have been paid, while the complementary and supplementary fees are distributed annually among the Contracting Parties not receiving individual fees, in proportion of the number of designations made of each of them. For the year 2000, the International Bureau distributed a total of 24.9 million Swiss francs resulting from the complementary and supplementary fees and 33.8 million Swiss francs resulting from individual fees. In addition, if the International Registration Service closes its biennial accounts with a profit, the proceeds are divided among the Contracting Parties.

47. At the end of 2001, 381,684 international registrations were in force. During that year, 23,985 new international registrations were effected, containing 290,633 designations, an average of 12.1 designations per registration. In addition, 27,282 new designations were recorded in respect of existing international registrations. In other words, the designations effected in 2001 were equivalent to nearly 318,000 national applications.



August 2002

### MEMBERS OF THE MADRID UNION

Albania (A)	Liberia (A)
Algeria (A)	Liechtenstein (A&P)
Antigua and Barbuda (P)	Lithuania (P)
Armenia (A&P)	Luxembourg* (A&P)
Australia (P)	Monaco (A&P)
Austria (A&P)	Mongolia (A&P)
Azerbaijan (A)	Morocco (A&P)
Belarus (A&P)	Mozambique (A&P)
Belgium* (A&P)	Netherlands* (A&P)
Bhutan (A&P)	Norway (P)
Bosnia and Herzegovina (A)	Poland (A&P)
Bulgaria (A&P)	Portugal (A&P)
China (A&P)	Republic of Moldova (A&P)
Croatia (A)	Romania (A&P)
Cuba (A&P)	Russian Federation (A&P)
Czech Republic (A&P)	San Marino (A)
Democratic People's Republic of Korea (A&P)	Sierra Leone (A&P)
Denmark (P)	Singapore (P)
Egypt (A)	Slovakia (A&P)
Estonia (P)	Slovenia (A&P)
Finland (P)	Spain (A&P)
France (A&P)	Sudan (A)
Georgia (P)	Swaziland (A&P)
Germany (A&P)	Sweden (P)
Greece (P)	Switzerland (A&P)
Hungary (A&P)	Tajikistan (A)
Iceland (P)	The former Yugoslav Republic of Macedonia (A&P)
Ireland (P)	Turkey (P)
Italy (A&P)	Turkmenistan (P)
Japan (P)	Ukraine (A&P)
Kazakhstan (A)	United Kingdom (P)
Kenya (A&P)	Uzbekistan (A)
Kyrgyzstan (A)	Viet Nam (A)
Latvia (A&P)	Yugoslavia (A&P)
Lesotho (A&P)	Zambia (P)

(70)

(A): indicates a State party only to the Agreement (14)

(P): indicates a State party only to the Protocol (18)

(A&P): indicates a State party to both the Agreement and Protocol (38)

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\* Protection may not be requested separately for Belgium, Luxembourg or the Netherlands, but only for all three countries as a whole (Benelux), subject to payment of a single complementary or individual fee.

## THE HAGUE AGREEMENT CONCERNING THE INTERNATIONAL DEPOSIT OF INDUSTRIAL DESIGNS

### OBJECTIVES, MAIN FEATURES, ADVANTAGES

#### Introduction

1. The system of international deposit of industrial designs is governed by the Hague Agreement Concerning the International Deposit of Industrial Designs, which dates from 1925, entered into force in 1928, and has been revised at various times, in particular at London (1934 Act) and at The Hague (1960 Act)<sup>19</sup>. The system is administered by the International Bureau of WIPO, which maintains the International Register and publishes the *Bulletin des dessins et modèles internationaux/International Designs Bulletin*.

2. An international deposit may be governed by the provisions of the 1934 Act or those of the 1960 Act or both. The vast majority of international deposits are governed exclusively or partly by the 1960 Act; out of the 4334 international deposits made in 2000, only 210 were governed exclusively by the 1934 Act. Unless otherwise specified, this paper reflects the provisions of the 1960 Act.

3. The States party to the Agreement constitute a special union, called the Hague Union. Accession to the Hague Agreement<sup>20</sup> and participation in the Hague Union do not entail any financial obligation for the acceding State since the Union is financed by the fees paid by depositors and owners of international deposits. A list of the member countries of the Hague Union, together with an indication of whether they are party to the 1934 Act, the 1960 Act or both, is given on a separate sheet.

#### Objectives

4. The objectives of the system are two-fold. Firstly, it offers the possibility of obtaining protection for industrial designs in a number of States through a single deposit made with the International Bureau of WIPO. Secondly, by having a single deposit with effect in several countries, the subsequent management of the protection obtained is also made much easier. For instance, there is only one deposit to renew, and changes such as a change in ownership or in the name or address of the owner can be recorded in the International Register through a single simple procedural step.

#### Who May Use the System?

5. International deposits may be made only by a natural person or legal entity having a real and effective industrial or commercial establishment or a domicile in, or being a national of, one of the States party to the Hague Agreement.

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<sup>19</sup> A new Act of the Hague Agreement, which is not yet in force, was adopted in Geneva on July 2, 1999 (see paragraphs 31 to 36).

<sup>20</sup> Accession to the Hague Agreement is open, in respect of the 1934 and 1960 Acts, to any State party to the Paris Convention and, in respect of the Geneva Act (see note 1, above), to any State party to the Convention Establishing WIPO and to certain intergovernmental organizations.

## Where Can Protection be Obtained?

6. Protection can be obtained only in those States which are party to the same Act as the State with which the applicant has a necessary connection to make an international deposit. In other words, if the applicant has a connection with a State bound only by the 1934 Act, he will obtain protection only in those States which are bound by the 1934 Act, whether they are also bound by the 1960 Act or not. If the applicant has a connection with a State bound only by the 1960 Act, he will be able to obtain protection, by designating them, in those States which are bound by the 1960 Act, whether they are also bound by the 1934 Act or not. If the applicant has a connection with a State bound by both Acts, he will be able to obtain protection in all member States of the Hague Union.

7. Protection may also be obtained in the State of origin<sup>21</sup> by means of an international deposit, unless the domestic legislation of that State does not permit it.<sup>22</sup>

8. It should be added that, if the applicant has more than one connection in respect of States party to different Acts of the Agreement, he can cumulate the possibilities offered by each Act in the same international deposit. For example, an applicant having the nationality of a State party only to the 1934 Act, but whose domicile is in a State party only to the 1960 Act, could obtain protection in all States of the Hague Union.

9. In order to protect a design in countries which are not party to the Hague Agreement, it is necessary to effect a national deposit with the competent Office of each of those countries.

## The International Deposit

10. An international deposit does not require any prior national deposit. An industrial design can therefore be deposited and protected for the first time at the international level through the Hague Agreement.

11. The international deposit is normally made directly with the International Bureau of WIPO, by the depositor or his representative, on a form provided by the International Bureau. The deposit may also be made through the national Office of a Contracting State if such State so permits<sup>23</sup>. However, a State may require that, where it is considered to be the State of origin, the deposit be made through its national Office<sup>24</sup>.

12. An application for international deposit must contain, *inter alia*, the exact designation of the article or articles in which it is intended to incorporate the designs, and a reproduction (photograph or graphic representation) of each design or each article deposited.

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<sup>21</sup> "State of origin" means the Contracting State in which the applicant has a real and effective industrial or commercial establishment or, if the applicant has such establishments in several States, the Contracting State which he has indicated in his application; if the applicant has no such establishment in any Contracting State, the Contracting State in which he has his domicile; if he has no domicile in a Contracting State, the Contracting State of which he is a national.

<sup>22</sup> According to the information available to the International Bureau, Hungary is the only country that does not allow itself to be designated in an international deposit for which it is the State of origin.

<sup>23</sup> According to the information available to the International Bureau, Benin, Bulgaria, Greece, Hungary, Italy, Liechtenstein, Mongolia and Switzerland allow an international deposit to be made through their national Offices.

<sup>24</sup> According to the information available to the International Bureau, the Republic of Moldova and Yugoslavia require that, where they are considered to be the State of origin, the international deposit be made through their national Offices.

13. An international deposit may include up to 100 designs. All the designs in a deposit must be intended to be incorporated in articles included in the same class of the International Classification of Industrial Designs (Locarno Classification).

14. Priority under Article 4 of the Paris Convention for the Protection of Industrial Property may be claimed in an international deposit if the said international deposit is made within six months of a first regular national deposit made in a State party to the Paris Convention or a Member of the World Trade Organization or of a regional or international deposit having the same effect as such a national deposit. Conversely, an international deposit made under the Hague Agreement may serve as basis for priority in a national or regional design application in a State party to the Paris Convention, or a Member of the World Trade Organization even if that State is not a member of the Hague Union.

15. The working languages of the Hague Agreement (1960 Act) are English and French. An international deposit may thus be made in either of these languages.

16. An international deposit is subject to the payment of fees, in Swiss francs. The fees for a deposit governed exclusively or partially by the 1960 Act consist of:

- an international deposit fee (comprising a basic fee for one industrial design and a further fee for each additional design included in the same deposit) which covers the costs of the International Bureau in administering the Designs Registry;
- a publication fee (which is greater where the reproductions of the design are in color);
- fees for each Contracting State designated (State fees).

The Agreement provides for two State fees—the ordinary State fee and an additional State fee which is payable for a designated Contracting State that has a novelty examination<sup>25</sup>. The State fees are distributed each year amongst the Contracting States. For the year 2000, 2.3 million Swiss francs were collected and distributed by the International Bureau.

17. The International Bureau checks that the application for international deposits complies with the requirements of the Agreement and the Regulations, including requirements relating to the photographs or graphic representations, and that the required fees have been paid. The depositor is informed of any defects; these must be corrected within three months, otherwise the international deposit will be declined. This is solely a formal examination; the International Bureau of WIPO does not appraise in any way the novelty of the designs and it is therefore not entitled to reject a deposit on this or any other substantive ground.

18. Where the international deposit complies with the applicable requirements, it will be recorded in the International Register and published in the *International Designs Bulletin*. This publication, which is made on CD-ROM only, comprises a reproduction of the deposited photographs or graphic representations. Copies of the Bulletin are sent to the national Office of each Contracting State.

19. The applicant may request that the publication be deferred for a period which may not exceed 12 months as from the date of the international deposit or (where priority is claimed) from the priority date.

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<sup>25</sup> At present, the State novelty examination fee is payable in respect of a designation of Bulgaria, Hungary, the Republic of Moldova or Romania.

### **Possibility of Refusal**

20. Under the 1960 Act, the Office of a Contracting State whose domestic legislation provides for an administrative examination *ex officio* or for opposition by third parties may notify the International Bureau that it refuses to grant protection to an industrial design on the ground that it does not meet the requirements of that domestic law. However, protection may not be refused on the grounds of non-compliance of the international deposit with formal requirements, since all such requirements must be considered by each Contracting State as having been complied with in the international procedure.

21. Any refusal of protection must be notified to the International Bureau within six months of the date on which the national Office receives the Bulletin in which the international deposit is published. The depositor has the same remedies against the decision of refusal as he would have had if he had deposited the design concerned directly with the national Office that issued the refusal. The ensuing procedure takes place solely at the national level; the International Bureau of WIPO is not to any extent involved in this procedure. An appeal against a refusal must be submitted to the competent authority of the country concerned within the time-limit and in accordance with the conditions set out by the corresponding national legislation. In fact, refusals are extremely infrequent. Only approximately fifteen are received each year by the International Bureau.

### **Effects of the International Deposit**

22. If no refusal is notified within the prescribed time limit, the international deposit will have effect in that Contracting State as from the date of deposit (however, in the States in which the national legislation provides for a novelty examination, the starting point of the protection may, according to the national legislation, be later than the date of deposit).

23. An industrial design that is the subject of an international deposit enjoys, in each of the States concerned which has not refused protection, the same protection as is conferred on industrial designs by the law of that State.

### **Changes in the International Register; Renunciation**

24. A change in the name or address of the owner or his representative may be recorded in the International Register.

25. Likewise a change in the ownership of an international deposit may be recorded, in respect of all or only some of the States in which the international deposit has effect, and in respect of all or some of the designs included in the deposit. A person may not however be recorded as the owner of an international deposit in respect of a given Contracting State if that person would not be entitled (in accordance with the principles set out in paragraphs 5 to 8, above) to own international deposits. Thus, for example, a person who does not have a connection with a State which is a party to the 1960 Act may not be recorded as the new owner of an international deposit in respect of a State which is a party only to that Act.

26. A renunciation of the international deposit, in respect of all or some of the Contracting States and in respect of all or some of the designs, may also be recorded in the International Register.

27. Information concerning such changes and renunciation is recorded in the International Register and (except for changes in the name or address of representatives) is published in the Bulletin.

### **Term of Protection**

28. International deposits governed by the 1960 Act are made for an initial period of five years. They can be renewed for an additional period of five years, for all or some of the designs included in the deposit and for all or only some of the States in which it has effect (the minimum period of protection is therefore 10 years). Furthermore, if the domestic legislation of a Contracting State provides for a term of protection of more than 10 years for industrial designs that have been the subject of a national deposit, the international deposit may be renewed in respect of that State for additional periods of five years and up to the expiry of the total term of protection allowed for national deposits.

### **International Deposits Governed Exclusively by the 1934 Act**

29. The main differences between an international deposit governed exclusively by the 1934 Act and an international deposit governed exclusively or partially by the 1960 Act can be summarized as follows:

- as regards the *language*, a deposit governed exclusively by the 1934 Act can only be made in French;
- the deposit *extends automatically* to all States party to the 1934 Act, unless protection in any of those States is expressly renounced;
- the deposit may be *opened* or *sealed*;
- *deferment of publication* may not be requested;
- the *publication* does not comprise a reproduction of the designs; it merely states the article or articles in which the designs are to be incorporated;
- the *term of protection* is 15 years, divided into an initial period of five years and, subject to renewal, a second period of 10 years;
- there is no provision for the *notification of a refusal* of protection;
- different *fees* are to be paid.

### **Advantages of the System**

30. The international deposit of industrial designs arose from a need for simplicity and economy. Nationals and residents of, or companies established in a State party to the Hague Agreement are able to obtain protection for their designs in a number of States with a minimum of formalities and expense. In particular, they are relieved of the need to make a separate national deposit in each of the States in which they require protection, thus avoiding the complications arising from procedures which differ from State to State. They do not have to submit the required documents in various languages nor keep a watch on the deadline for renewal of a whole series of national deposits, varying from one State to the other. They also avoid the need to pay a series of fees in various currencies. Under the Hague Agreement, the same result can be obtained by means of a single international deposit, made in one language, on payment of a single set of fees, in one currency and with one Office (i.e., the International Bureau).

### **Development of the Hague Agreement: the Geneva Act of 1999**

31. Although the facilities offered by the Hague Agreement have been used for more than 70 years to the satisfaction of design owners, the number of countries party to that Agreement has remained low and their geographical spread limited, mainly because certain States whose laws provide for an examination of deposited industrial designs as to novelty consider that the Agreement as it is does not meet their requirements.

32. For this reason, a Committee of Experts on the Development of the Hague Agreement held a series of meetings since 1991. On July 2, 1999, a Diplomatic Conference which met in Geneva adopted by consensus a new Act of the Hague Agreement. On July 6, 1999, at the closing of the Diplomatic Conference, the Geneva Act of the Hague Agreement was signed by the plenipotentiaries of 24 States.

33. The purpose of the Geneva Act of 1999 is two-fold:

- on the one hand, to extend the Hague System to new members, particularly those whose Office carries out a novelty examination of industrial designs. For that purpose, the Geneva Act introduced in the Hague System a number of elements aiming at facilitating accession by potential Contracting Parties, such as the possibility of extending the refusal period to 12 months or fixing a higher designation fee;
- on the other hand, to maintain the fundamental simplicity of the Hague System and to render it more attractive to users.

34. The new Act also permits the establishment of a link between the international deposit system and regional systems such as the future European Community design system or the African Intellectual Property Organization (OAPI) system since it provides for certain intergovernmental organizations to become party to the Act.

35. The new Act of the Hague Agreement has not yet entered into force. The Geneva Act will enter into force three months after six States have deposited their instruments of ratification or accession, provided that at least three of those States have a certain level of activity in the field of industrial designs, as defined in Article 28 of the treaty. This provision aims to ensure that the international registration procedure provided by the 1999 Act will be used to a large extent from its entry into force.

36. The main innovations introduced by the Geneva Act of 1999 in respect of the current system, as it results from the 1934 Act and the 1960 Act, are the subject of a WIPO publication (No. 453 (E)).

## MEMBER COUNTRIES OF THE HAGUE UNION

Belgium (60)	Mongolia (60)
Benin (34 & 60)	Morocco (34 & 60)
Bulgaria (60)	Netherlands (60)
Côte d'Ivoire (34 & 60)	Republic of Macedonia (60)
Democratic People's Republic of Korea (60)	Republic of Moldova (60)
Egypt (34)	Romania (60)
France (34 & 60)	Senegal (34 & 60)
Germany (34 & 60)	Slovenia (60)
Greece (60)	Spain (34)
Holy See (34)	Suriname (34 & 60)
Hungary (34 & 60)	Switzerland (34 & 60)
Indonesia (34)	Tunisia (34)
Italy (60)	Ukraine (60)
Liechtenstein (34 & 60)	Yugoslavia (60)
Luxembourg (60)	(Total 30)
Monaco (34 & 60)	

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(60) Indicates a State party to the 1960 Act.

(34) Indicates a State party to the 1934 Act.



## **THE GENEVA ACT (1999) OF THE HAGUE AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS**

### **MAIN INNOVATIONS COMPARED WITH THE PRESENT SYSTEM PROVIDED FOR IN THE 1934 AND 1960 ACTS OF THE AGREEMENT**

#### **Introduction**

1. On July 2, 1999, a Diplomatic Conference meeting in Geneva adopted a new Act of the Hague Agreement and Regulations thereunder.<sup>26</sup> On July 6, at the end of the Diplomatic Conference, the Geneva Act of the Hague Agreement was signed by the plenipotentiaries of 24 States.

2. Today therefore there are three separate Acts of the Hague Agreement, namely the London Act (1934), the Hague Act (1960) and the Geneva Act (1999), which coexist with respect to their substantive provisions on the international registration of industrial designs.

3. The Geneva Act is not yet in force, however; it will enter into force three months after six States have deposited their instruments of ratification or accession, provided that at least three of those States have a certain volume of activity in the field of industrial designs, as specified in the treaty. The purpose of that provision is to ensure that the international registration procedure provided for in the 1999 Act is widely used as soon as it enters into force. So for the time being the Hague system continues to be governed solely by the 1934 and 1960 Acts of the Hague Agreement.<sup>27</sup>

#### **Why a New Act of the Hague Agreement?**

4. Even though the international registration system provided for in the 1934 and 1960 Acts is being used to the satisfaction of owners of industrial designs in countries party to those Acts, the countries themselves are still relatively few in number, and their geographical spread is small. At present, only 29 States are members of the Hague Union. Missing from those are a certain number of countries that are very active in the deposit of industrial designs and yet consider that the 1934 and 1960 Acts, as they stand, do not meet their needs (they are mainly the countries whose legislation requires deposited designs to undergo examination for novelty).

5. The Geneva Act of 1999 has a twofold objective, namely:

- on the one hand, to extend the Hague system to new members; to do that, the Geneva Act has introduced a certain number of features into the Hague system with a view to allowing or facilitating the accession of States whose legislation provides for a novelty examination;
- on the other hand, to preserve the fundamental simplicity of the Hague system and make it more attractive to applicants.

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<sup>26</sup> The new Regulations are not intended to apply to the 1934 and 1960 Acts of the Agreement. They concern only the new Act. It was considered unnecessary to have a set of uniform rules for the various Acts of the Hague Agreement, as the expectation was that the Geneva Act would be very widely accepted, causing the earlier Acts of the Hague Agreement to fall into disuse.

<sup>27</sup> See WIPO Publication No. 419, "The Hague Agreement Concerning the International Deposit of Industrial Designs: Objectives, Main Features, Advantages".

6. The Geneva Act also provides for the establishment of a link between the international registration system and regional systems, such as the future designs system of the European Community or that of the African Intellectual Property Organization (OAPI), by providing that intergovernmental organizations may become party to the Act (see paragraphs 9 and 10 below).

7. The main innovations made by the Geneva Act of 1999 as compared with the present system provided for in the 1934 and 1960 Acts may be summarized as follows.

### **The Name of the Hague Agreement**

8. The Geneva Act changes the name of the Hague Agreement, which in future will be The Hague Agreement Concerning the International *Registration* (replacing International *Deposit*) of Industrial Designs. Also, throughout the Geneva Act (and the Regulations under it), the words "application" and "registration" are used instead of the word "deposit" of the 1934 and 1960 Acts. This new terminology corresponds more closely to that to be found in existing national and regional legislation and more accurately reflects the procedure leading to international registration under the new Act.

### **Who Can Accede to the Geneva Act?**

9. The possibility of acceding to the Geneva Act is available not only to States but also to certain intergovernmental organizations. Contracting States and contracting intergovernmental organizations are collectively known as Contracting Parties.

10. In order to become party to the Geneva Act:

- a *State* has to meet just one condition, namely membership of WIPO;<sup>28</sup>
- an *intergovernmental organization* has to maintain an Office authorized to grant protection to industrial designs with effect in the territory to which its constituting treaty applies. Moreover, at least one of the member States of the intergovernmental organization has to be a member of WIPO.

11. The Contracting Parties of the new Act will be members of the same Union (the Hague Union) as the States party to the 1934 and 1960 Acts.

### **Entitlement to File an International Application**

12. Any person who is a national of a State that is a Contracting Party or of a member State of an intergovernmental organization that is a Contracting Party, or has a domicile, a *habitual residence* or a real and effective industrial or commercial establishment in the territory of a Contracting Party, is entitled to file an international application.

13. The right to file an international application on the express basis of habitual residence (being located in the territory of a Contracting Party) is new. The term "habitual residence", borrowed from the Berne Convention for the Protection of Literary and Artistic Works, has been introduced in order to offset any too-narrow interpretation that might be put on the concept of "domicile" in certain national or regional legislation.

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<sup>28</sup> Unlike the 1934 and 1960 Acts, the Geneva Act does not require a Contracting State to be party to the Paris Convention. Every Contracting Party is, however, under Article 2(2) of the Geneva Act, obliged to respect the provisions of the Paris Convention that concern industrial designs.

### **Definition, Identification and Designation of "the Applicant's Contracting Party"**

14. The Contracting Party from which the applicant derives his right to file an international application (by fulfilling, in relation to that Contracting Party, at least one of the conditions set forth in paragraph 12 above) is called "the applicant's Contracting Party". Where the applicant can derive his right to file an international application from two or more Contracting Parties, "the applicant's Contracting Party" is the one which, among those Contracting Parties, is indicated as such by the applicant in the international application.

15. The applicant's Contracting Party may in principle be designated in an international application. However, any Contracting Party whose Office is an Examining Office<sup>29</sup> may notify the Director General that designating it in the international application has no effect when it is the applicant's Contracting Party.

### **International Application Procedure**

16. The international application may be filed, at the option of the applicant, either directly with the International Bureau or through the Office of the applicant's Contracting Party. It is possible for Contracting Parties to prohibit the indirect route, but they are not allowed to impose it.

### **Filing Date of the International Application**

17. For the allocation of a filing date to an international application, the Geneva Act makes a distinction between applications filed directly with the International Bureau by the applicant and those filed through the Office of the applicant's Contracting Party. The principles are the following:

- in the case of direct filing, the filing date is the date on which the International Bureau receives the international application;
- in the case of indirect filing, it is the date on which the intermediary Office receives the international application, provided that the application is received by the International Bureau within one month thereafter. A Contracting Party whose legislation requires security clearance has the option of giving notice of the replacement of the one-month period by six months.

18. Moreover, where the international application has an irregularity which is prescribed as an irregularity entailing a postponement of the filing date of the international application, the filing date shall be the date on which the correction of such irregularity is received by the International Bureau. The irregularities which entail the postponement of the filing date of the international application are indications whose importance is such that no date can be assigned as long as they have not been provided (for example failure to indicate the identity of the applicant, the absence of reproductions or specimens of the designs or failure to designate at least one Contracting Party).

### **Contents of the International Application**

19. The Geneva Act makes a distinction between three categories in the contents of the international application, namely the mandatory contents, the additional mandatory contents where certain Contracting Parties are designated and the optional contents.

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<sup>29</sup> The expression "Examining Office" is defined in Article 1(xvii) of the Geneva Act as meaning an Office that examines *ex officio* applications for industrial design protection filed with it at least to determine whether the designs satisfy the condition of novelty.

20. The *mandatory contents* consist of the information that has to be contained in every international application or accompany it (such as the prescribed particulars concerning the applicant, a reproduction<sup>30</sup> of the designs for which protection is sought, an indication of the product or products constituting the industrial design or in relation to which the design is to be used, an indication of the designated Contracting Parties and the prescribed fees.

21. The *additional mandatory contents* have to be included in an international application where one or more particular Contracting Parties have been designated. They are additional elements that may be notified by a Contracting Party whose Office is an Examining Office. Where that Contracting Party is designated, the elements that it has notified have to be included in the international application (failing which, if the applicant does not act on an invitation sent him by the International Bureau within the prescribed period of three months, the international application is regarded as not containing the designation of the Contracting Party concerned). The elements that may be notified in that way are limited to three, namely (i) information concerning the identity of the creator; (ii) a brief description of the reproduction or of the characteristic features of the industrial design in respect of which the application is filed; (iii) a claim. Those three additional elements correspond to the requirements that certain potential Contracting Parties have declared essential to the grant of a filing date under their national legislation.<sup>31</sup>

22. Finally, certain *optional elements* may be provided by the applicant (for instance a declaration claiming the priority of an earlier application, or a statement identifying information known by the applicant to be material to the eligibility for protection of the design concerned), but their absence would not constitute an irregularity in the international application. Those optional elements may be provided by applicants as a means of avoiding refusal on the part of a designated Contracting Party.

### **Special Requirements**

23. The Geneva Act provides for two types of special requirements that may be notified by a Contracting Party and with which the applicant has to comply if he designates that Contracting Party in the international application.

#### *Special Requirements Concerning the Applicant*

24. Any Contracting Party whose legislation requires the application for the registration of an industrial design to be filed in the name of the creator of the design may notify that fact to the Director General. If that Contracting Party is designated in the international application, the identity of the creator of the industrial design has to be given and that person is deemed to be the applicant for the purposes of the Contracting Party concerned, whether or not the international application was filed in his name. Furthermore, if the person mentioned in the international application as the creator is not the same as the person named as the applicant, the international application has to be accompanied by a statement or document, depending on what the Contracting Party concerned may require, to the effect that the international application has been assigned by the person identified in the international application as the creator to the person named as the applicant.

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<sup>30</sup> If deferment of the publication of a two-dimensional design is requested, the reproduction of the industrial design (which is needed for publication) does not have to be submitted before the time of publication. Consequently, it is provided that a prescribed number of *specimens* of the industrial design may be submitted with the international application in place of reproductions. That option offers great advantages to certain applicants, for instance in the textile industry.

<sup>31</sup> At present, according to the information available to the International Bureau, the element mentioned in item (i) is required in Brazil, Romania and the Russian Federation, that mentioned in item (ii) is required in the Russian Federation, the Republic of Korea and Romania and that mentioned in item (iii) is required in the United States of America.

### *Special Requirements Concerning the Unity of the Design*

25. Any Contracting Party whose laws, at the time of its becoming party to the Geneva Act, contain a requirement of unity of design (according to which, generally speaking, two or more industrial designs included in the same application have to conform to the same creative concept) may notify that fact to the Director General. The purpose of the notification is to enable the Contracting Party that has made it to refuse the effects of an international registration if the requirement in question has not been met. In that case, the Office that has issued the refusal may ask the holder of the international registration to divide it solely for the designated Contracting Party concerned. The Office may charge the holder of that registration as many additional fees as divisions prove necessary (over and above the fee for the initial international registration). The mode of payment of additional fees of this type is not governed by the Geneva Act or by the Regulations under it; they will be specified by each Contracting Party concerned, which will collect them directly from the owner.

26. It is understood that such a notification does not affect the applicant's right, even if he designates the Contracting Party that made the notification, to include two or more industrial designs in the international application.

### **Standard and Individual Designation Fees**

27. The Geneva Act provides that the prescribed fees shall include a designation fee that has to be paid for each designated Contracting Party (the amount of the fee, which will appear in a schedule of fees forming part of the Regulations, has not yet been determined).

28. However, any Contracting Party whose Office is an Examining Office and any Contracting Party that is an intergovernmental organization may declare that, for each international application in which it is designated, and for the renewal of each international registration resulting from such an international application, the standard designation fee is replaced by an individual designation fee, the amount of which is specified in the declaration. That amount, although set by the Contracting Party itself, may not exceed the amount equivalent to what the Contracting Party in question would be entitled to receive from the applicant in the case of an application filed directly with its Office (for the same term of protection and for the same number of industrial designs), that amount being reduced by the amount of the savings resulting from the international procedure.

29. The declaration concerning the individual designation fee may also specify that the fee is to be paid in two parts, the first on the filing of the international application and the second at a later date fixed in accordance with the legislation of the Contracting Party concerned (in practice when the Office considers that the industrial design concerned may be granted protection on its territory).

### **Date of the International Registration**

30. The date of the international registration is normally the filing date of the international application (see paragraphs 17 and 18). However, where the international application has an irregularity relating to one of the additional elements notified by a designated Contracting Party (see paragraph 21), the date of the international registration is the date on which the correction of such irregularity is received by the International Bureau.

### **Publication**

31. The international registration is in principle published six months after the date on which it took place. That six-month delay is intended to allow the holder of an international registration to benefit from the *de facto* deferment that he would have had if he had filed a national application (namely the time that elapses before national publication, due account being taken of the time

required for examination—both substantive and as to form—and for the technical preparations for publication).

32. An applicant may, however, ask for the international registration to be published immediately after the entry of the industrial design registration in the International Register. He may also ask for publication of the international registration to be deferred.

### **Deferment of Publication**

33. Where the international application contains a request for deferment of publication, the international registration will be published on the expiry of a period of 30 months from the filing date or, if priority has been claimed, from the priority date. However:

- where one or more of the designated Contracting Parties have declared that their legislation authorizes deferment of publication for a period shorter than 30 months, publication will occur on the expiry of the shortest of the periods mentioned in their declarations;
- where one of the designated Contracting Parties has declared that deferment is not possible under its legislation, the applicant (in so far as his international application is accompanied by reproductions rather than specimens<sup>32</sup>) will be invited to withdraw the designation of that Contracting Party within a period of one month following the date of the notification sent by the International Bureau to that end. Failing that, no account will be taken of the request for deferment of publication.

### **Confidential Copy of an International Registration**

34. Where the publication of an international registration is deferred, a designated Office may receive a confidential copy of the registration provided that it uses that copy only for the purposes of examination or in conflict proceedings. The sending of the confidential copy is intended in particular to enable the Offices concerned to establish the state of the art if need be. The sending of a confidential copy should not be confused with the sending of a copy of the publication of the international registration, which starts the period for the notification of refusal of protection to the International Bureau.

### **Period for Refusal**

35. The prescribed period for the notification of a refusal of the effects of an international registration is six months from the date on which the International Bureau sends a copy of the publication of the international registration to the Office concerned.

36. However, any Contracting Party whose Office is an Examining Office or whose legislation provides for the possibility of filing opposition to the grant of protection may notify the Director General that a twelve-month period is substituted for the six-month period.

37. At any time during the period for refusal, an Office may send the owner a statement to the effect that it has decided to accept the effects of international registration, even where it has not communicated a notification of refusal.<sup>33</sup>

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<sup>32</sup> Where the international application is accompanied by *specimens* of the design, the International Bureau will not take account of the designation of the Contracting Party concerned and will notify the applicant accordingly.

<sup>33</sup> This point is reflected in an Agreed Statement adopted by the Diplomatic Conference.

### **Effects of International Registration**

38. Under the Geneva Act, the international registration has the same effects, in each designated Contracting Party as from the date of international registration, as an application for protection regularly filed with the Office of that Contracting Party.

39. Thereafter, in every designated Contracting Party that has not notified refusal of protection, or has notified refusal and subsequently withdrawn it, the international registration enjoys the same protection as would have been obtained by means of an application accepted by that Contracting Party.

40. As a general rule, the international registration produces its effects at the latest on the expiry date of the applicable refusal period. The words "at the latest" indicate that any Contracting Party is entitled to grant protection as from an earlier date, for instance from the date of international registration. Where the international registration has been the subject of a refusal of protection that has been subsequently withdrawn, the international registration produces its effects as from the withdrawal of the refusal of protection.

41. Nevertheless, the effects of the international registration may be delayed with respect to a Contracting Party in two situations. It is possible for a Contracting Party whose Office is an Examining Office or whose legislation provides for an opposition procedure to declare that the international registration will produce its effects:

- at a time that may be later than the expiry of the applicable refusal period, but not by more than six months, or
- at the time of the grant of protection under the legislation of that Contracting Party where the communication of a decision regarding the grant of protection has been unintentionally omitted.

### **Term of Protection**

42. International registration is effected for an initial period of five years following the date of international registration and may be renewed for two additional five-year periods before each of those periods expires. Subject to renewal, the minimum duration of protection in each designated Contracting Party is thus 15 years following the date of international registration.

43. Moreover, if the national legislation of a Contracting Party provides for a duration of protection in excess of 15 years for designs filed for registration by the national route, the international registration may be renewed with respect to that Contracting Party for additional periods of five years up to the expiry of the total duration of protection provided for in its national legislation.

44. Contracting Parties must notify the International Bureau of the maximum duration of protection granted to designs by their legislation. Information received by the International Bureau in that way will be published for the benefit of owners.

### **Relations Between the Contracting Parties and States Party to the 1934 or the 1960 Act**

45. The Geneva Act has no effect between a Contracting Party bound solely by the new Act and States party to the 1934 or the 1960 Act but not to the new Act.

46. In the case of States that are party *both* to the Geneva Act *and* to the 1934 or the 1960 Act, there arises the question of which of those Acts will be applicable in their mutual relations. The principle is that only the Geneva Act (the most recent) will bind those States in their mutual relations.

47. Consequently the 1934 and 1960 Acts will eventually fall into disuse as the States currently party to the 1934 or the 1960 Act ratify or accede to the new Act.

### **Conclusion**

48. The Geneva Act, which is the result of more than eight years of preparatory work, strikes a delicate and subtle balance. It makes allowance for the specific features of legislation that provides for a novelty examination, and at the same time retains the essential simplicity of the Hague system. This latter point is very important to users, as is the prospect of a broadening of the geographical scope of the Hague system. It remains to be hoped that such broadening will rapidly become a reality.



## **LISBON AGREEMENT FOR THE PROTECTION OF APPELLATIONS OF ORIGIN AND THEIR INTERNATIONAL REGISTRATION**

### **I. INTRODUCTION**

1. The Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration (hereinafter referred to as "the Lisbon Agreement") was adopted in 1958 and revised at Stockholm in 1967. It entered into force on September 25, 1966, and is administered by the International Bureau of WIPO, which keeps the International Register of Appellations of Origin and publishes a bulletin entitled "*Les Appellations d'origine*".

2. The Agreement is supplemented by Regulations. The last version of these Regulations was adopted in September 2001, with a date of entry into force of April 1, 2002.

3. The Lisbon Agreement is a *Special Agreement* under Article 19 of the Paris Convention for the Protection of Industrial Property. Any country party to the Convention may accede to the Agreement.

4. The countries party to the Lisbon Agreement constitute the Lisbon Union. Every member of the Lisbon Union is also a member of its Assembly, which among other things adopts the program and budget of the Union and modifies the Regulations.

### **II. OBJECTIVE**

5. The Lisbon Agreement was concluded in response to the need for a system that would facilitate the recognition and protection of appellations of origin in various countries. Protection is obtained by the registration of appellations at the International Bureau of WIPO.

### **III. DEFINITION**

6. Article 2(1) of the Lisbon Agreement defines "appellation of origin" as:

"the geographical name of a country, region or locality which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors."

### **IV. REGISTRATION PROCEDURE AND POSSIBILITY OF REFUSAL**

7. In order to qualify for registration at the International Bureau of WIPO, an appellation of origin has to be recognized and protected *as such* in the country of origin. According to Article 2(2) of the Lisbon Agreement, country of origin means "the country whose name, or the country in which is situated the region or locality whose name, constitutes the appellation of origin that has given the product its reputation".

8. Recognition and protection of the appellation of origin in the country of origin may take place by virtue of legislative or administrative provisions or by virtue of a judicial decision or by registration, as determined by the domestic legislation of the country of origin.

9. When an appellation of origin has been recognized and protected as such in the country of origin, it is possible to seek its registration with the International Bureau of WIPO. The application for registration has to be filed by the competent national authority of the country of origin (each

contracting country having notified to the International Bureau the name and address of its authority competent to submit an international application). If the international application is not presented to the International Bureau by the competent authority of the country of origin, it will not be considered as such by the International Bureau and is returned to the sender.

10. Registration is in the name of the natural persons or legal entities, public or private, having, according to their national legislation, the right to use the appellation in the country of origin. The international application must also indicate the product to which the appellation applies, the area of production of the product and an indication of the legal basis for the protection in the country of origin.

11. The application has to be filed in English, French or Spanish and be accompanied by the registration fee (500 Swiss francs). The International Bureau does not carry out a substantive examination of the application for registration, but it does undertake an examination as to form. If the application meets all the requirements as to form, the International Bureau records the appellation of origin in the International Register of Appellations of Origin and notifies the registration to the national authorities of the countries of the Lisbon Union. The notification of the international registration is addressed by the International Bureau to the competent authority of each contracting country by registered mail with acknowledgement of receipt (enabling the International Bureau to establish the date on which the notification was received). The registration is also published in the Bulletin. If the application contains a defect of form, a period of three months is allowed for the defect to be remedied. If these defects are not remedied within this time-limit, the application is rejected.

12. The international registration bears the date on which the international application was received by the International Bureau, except where such international application does not contain any of the following particulars: the country of origin; the holders of the right to use the appellation of origin; the appellation of origin for which registration is sought, and the product to which the appellation applies. In this case, the international registration bears the date on which the last of the missing elements was received by the International Bureau.

13. The competent authorities of the member countries notified by the International Bureau of the registration of an appellation of origin have the right to refuse to protect it in their territory. Their declaration of refusal has to be notified to the International Bureau within a period of *one year* from the date of receipt of the notification of registration, and must specify in particular the grounds for refusal. For instance, protection may be refused because the competent authorities in question consider that the appellation has already acquired a generic character in their territory in relation to the product to which it refers or that the geographical denomination does not conform to the definition of an appellation of origin in the Lisbon Agreement or because the appellation would conflict with a trademark or other right already protected in the country concerned.

14. When the International Bureau receives a declaration of refusal within the prescribed period, it notifies it to the competent authority of the country of origin, enters it in the International Register and publishes it in the Bulletin. The date on which a declaration of refusal has been notified to the International Bureau is, where it has been communicated through a postal service, determined by the postmark. (If the postmark is illegible or missing, the International Bureau treats the declaration as if it had been sent 20 days before the date on which it was received). Where such declarations or such notice are sent through a delivery service, the date of dispatch shall be determined by the information provided by such delivery service on the basis of the details of the mailing as recorded by it.

15. If protection is not refused, the competent authority of the country in question has the option of giving notice to the International Bureau that a period has been granted, not exceeding two years, to third parties that were using the appellation of origin on its territory prior to the date of notification of the international registration to terminate such use. In that case, the competent authority of the

country in question has to inform the International Bureau accordingly within the three months following the expiry of the period of one year provided for the refusal of protection.

## **V. PROTECTION**

16. Article 3 of the Lisbon Agreement provides that protection is ensured against any usurpation or imitation of the appellation of origin, even if the true origin of the product is stated or if the appellation is used in translated form or accompanied by terms such as "kind", "type", "make", "imitation" and the like.

17. Legal action required for ensuring the protection of appellations of origin may be taken in each of the contracting countries under the provision of the national legislation. Such legal actions may be proceeded at the instance of the competent Office or at the request of the public prosecutor, by any interested party, whether a natural person or a legal entity, whether public or private.

## **VI. EFFECTS OF REGISTRATION**

18. An appellation of origin which has been the subject of an international registration is to be ensured protection as from the date of the international registration in each contracting country which has not issued a refusal. However, a contracting country may declare that protection is ensured in that country from a different date, which may not be later than the date of expiry of the one-year refusal period.

19. The international registration of an appellation of origin assures it of protection, without any need for renewal, for as long as the appellation is protected as such in the country of origin.

20. Where the effects of an international registration are invalidated in a contracting country and the invalidation is no longer subject to appeal, the competent authority of the country concerned shall notify accordingly the International Bureau, which will enter the invalidation in the International Register and send a copy of the notification to the competent authority of the country of origin. An appellation which has been granted protection in a contracting country may not however be deemed to have become generic in that country as long as it is protected as an appellation of origin in the country of origin.

## **VII. CANCELLATION AND AMENDMENT OF REGISTRATION**

21. The international registration of an appellation of origin may be cancelled at any time at the request of the competent authority of the country of origin. That authority may likewise renounce protection in one or more countries party to the Lisbon Agreement, either in the actual application for registration or in a request filed later. The competent authority of the country of origin may also request the entry in the International Register of one or more of the following: a change in the holder of the right to use the appellation of origin, a modification to the names or addresses of the holders of the right to use the appellation of origin, a modification to the limits of the area of production of the product to which the appellation of origin applies, a modification relating to the titles and dates of legislative or administrative provisions or of court decisions recognizing protection in the country of origin and a modification relating to the country of origin that does not affect the area of production of the product to which the appellation of origin applies. On the other hand, the appellation of origin itself and the product to which it relates may not be amended in the International Register; if these have changed, it will be necessary to file a new application for international registration. The fee for entering a modification of a registration is currently fixed at 200 Swiss francs.

### **VIII. PRESENT STATUS OF THE LISBON SYSTEM**

22. As of September 1, 2002, 20 States are party to the Lisbon Agreement. 842 appellations of origin have been recorded in the International Register, of which 772 are currently in force.

## **BUDAPEST TREATY ON THE INTERNATIONAL RECOGNITION OF THE DEPOSIT OF MICROORGANISMS FOR THE PURPOSES OF PATENT PROCEDURE\***

### **I. INTRODUCTION**

1. The Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure (hereinafter referred to as the "Treaty") was adopted by the Budapest Diplomatic Conference on April 28, 1977, and it entered into force on August 19, 1980. The Conference also adopted Regulations under the Treaty.

2. On February 1, 2002, the following 54 States were party to the Treaty: Australia, Austria, Belarus, Belgium, Bulgaria, Canada, China, Croatia, Cuba, Czech Republic, Democratic People's Republic of Korea, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Iceland, India, Ireland, Israel, Italy, Japan, Kazakhstan, Latvia, Liechtenstein, Lithuania, Mexico, Monaco, Netherlands, Norway, Philippines, Poland, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Singapore, Slovakia, Slovenia, South Africa, Spain, Sweden, Switzerland, Tajikistan, Trinidad and Tobago, Turkey, Ukraine, United Kingdom, United States of America, Uzbekistan, Yugoslavia.

### **II. SUMMARY AND MAIN ADVANTAGES OF THE TREATY**

#### Background

3. Disclosure of the invention is a generally recognized requirement, as a quid pro quo to the public, for the grant of patents. Normally, an invention is disclosed by means of a written description. Where an invention involves a microorganism or other biological material (hereinafter referred to as "microorganisms"), or the use of it (in particular in agriculture, food and pharmaceutical industries), which is not available to the public, such a description is not sufficient for disclosure. That is why in the patent procedure of an increasing number of countries it is necessary not only to file a written description but also to deposit, with a specialized institution, a sample of the microorganism. Patent offices are not equipped to handle microorganisms, whose preservation requires special expertise and equipment to keep them viable, to protect them from contamination and to protect health or the environment from contamination. Such preservation is costly. The furnishing of samples also requires specialized expertise and equipment.

4. When protection is sought in several countries for an invention involving a microorganism or the use of a microorganism, the complex and costly procedures of the deposit of the microorganism would have to be repeated in each of those countries. It was in order to eliminate or reduce such multiplication, in order to enable one deposit to serve the purpose of all the deposits which would otherwise be necessary, that the Treaty was concluded.

#### Summary of the Treaty and the Regulations

5. Substantive Provisions. The main feature of the Treaty is that a Contracting State which allows or requires the deposit of microorganisms for the purposes of patent procedure must recognize, for such purposes, the deposit of a microorganism with any "international depositary authority" (Article 3(1)(a)), irrespective of whether such authority is on or outside the territory of the said State. In other words, one deposit, with one international depositary authority, will suffice for the purposes of patent procedure before the national patent offices (called "industrial property offices" in

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\* The following text can be found in document WO/INF/12 Rev.9.

the Treaty) of all of the Contracting States and before any regional patent organization if such a regional organization declares that it recognizes the effects of the Treaty (Article 9(1)). The European Patent Organisation (EPO), the African Regional Industrial Property Organization (ARIPO) and the Eurasian Patent Organization (EAPO) have made such a declaration.

6. What the Treaty calls an "international depositary authority" is a scientific institution — typically a "culture collection"—which is capable of storing microorganisms. Such an institution acquires the status of "international depositary authority" through the furnishing, by one of the Contracting States, of assurances to the Director General of WIPO to the effect that the said institution complies and will continue to comply with certain requirements (Article 6(1)), including, in particular, that it will be available, for the purposes of the deposit of microorganisms, to any "depositor" (person, firm, etc.), that it will accept and store the deposited microorganisms and that it will furnish samples thereof to anyone entitled to such samples but to no one else. The said assurances may be furnished also by certain intergovernmental industrial property organizations (see Article 9(1)(a)). The European Patent Organisation has furnished the said assurances. To date, 33 depositary institutions have acquired the status of international depositary authority.\*

7. The Regulations contain detailed provision (Rule 11) on who is entitled — and when — to receive samples of the deposited microorganism. The depositor himself has a right to a sample at any time (Rule 11.2(i)). He may authorize any third party (authority, natural person, legal entity) to ask for a sample and such a third party will receive a sample upon producing such an authorization (Rule 11.2(ii)). Any "interested" industrial property office to which the Treaty applies may ask for a sample and will receive one; an industrial property office will mainly be regarded as "interested" where the microorganism is needed for the purposes of patent procedure before the said office (Rule 11.1). Any other party may obtain a sample if an industrial property office to which the Treaty applies certifies that, under the applicable law, such a party has the right to a sample of the given

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\* Australia: Australian Government Analytical Laboratories (AGAL);  
Belgium: Belgian Coordinated Collections of Microorganisms (BCCM™);  
Bulgaria: National Bank for Industrial Microorganisms and Cell Cultures (NBIMCC);  
Canada: National Microbiological Laboratory, Health Canada (NMLHC);  
China: China Center for Type Culture Collection (CCTCC); China General Microbiological Culture Collection Center (CGMCC);  
Czech Republic: Czech Collection of Microorganisms (CCM);  
France: Collection nationale de cultures de micro-organismes (CNCM);  
Germany: Deutsche Sammlung von Mikroorganismen und Zellkulturen GmbH (DSMZ);  
Hungary: National Collection of Agricultural and Industrial Microorganisms (NCAIM);  
Italy: Advanced Biotechnology Center (ABC); Collection of Industrial Yeasts DBVPG;  
Japan: International Patent Organisms Depository (IPOD);  
Latvia: Microbial Strain Collection of Latvia (MSCL);  
Netherlands: Centraalbureau voor Schimmelcultures (CBS);  
Poland: IAFB Collection of Industrial Microorganisms; Polish Collection of Microorganisms (PCM);  
Republic of Korea: Korean Cell Line Research Foundation (KCLRF); Korean Collection for Type Cultures (KCTC); Korean Culture Center of Microorganisms (KCCM);  
Russian Federation: National Research Center of Antibiotics (NRCA); Russian Collection of Microorganisms (VKM); Russian National Collection of Industrial Microorganisms (VKPM), GNII Genetika;  
Slovakia: Culture Collection of Yeasts (CCY);  
Spain: Colección Española de Cultivos Tipo (CECT);  
United Kingdom: CABI Bioscience, UK Centre (IMI); Culture Collection of Algae and Protozoa (CCAP); European Collection of Cell Cultures (ECACC); National Collection of Type Cultures (NCTC); National Collection of Yeast Cultures (NCYC); National Collections of Industrial, Food and Marine Bacteria (NCIMB);  
United States of America: Agricultural Research Service Culture Collection (NRRL); American Type Culture Collection (ATCC).

microorganism; the elements of the certification are provided for in detail to ensure that the maximum extent of caution will be exercised by the industrial property office before it issues a certification (Rule 11.3(a)).

8. The Treaty and the Regulations also contain provisions allowing for what is called a "new" deposit where samples of the originally deposited microorganisms can no longer be furnished (Article 4); permitting the termination or limitation of the status of international depositary authority where the said authority does not or does no longer fully comply with its assumed duties (Article 8); requiring that all microorganisms deposited with an international depositary authority be transferred to another such authority if the former is about to cease functioning as such (Rule 5.1); regulating the content of the receipt that each international depositary authority is required to give to the depositor for the deposited microorganism (Rule 7); providing for the testing of the viability of the deposited microorganisms and the issuance of viability statements (Rule 10); allowing the international depositary authority to charge a fee for each deposit, that fee covering the minimum 30 years during which the deposited microorganism must be stored (Rules 9 and 12); providing for a special status and a special role for certain intergovernmental organizations (Article 9).

9. Administrative Provisions. The States party to the Treaty constitute a Union ("the Budapest Union") (Article 1). The Budapest Union has an Assembly consisting of the States members of the said Union, the main tasks of the Assembly being to deal with all matters concerning the maintenance and development of the Union and the implementation of the Treaty (Article 10(2)), including the powers to amend certain provisions of the Treaty (Article 14), to amend the Regulations (Article 12(3)) and to take away or limit the status of any given international depositary authority (Article 8(1)). Certain administrative tasks are entrusted to the International Bureau of WIPO (Article 11). The possibility of amending the Treaty in revision conferences is also provided for (Article 13).

10. Guide to the Deposit of Microorganisms under the Budapest Treaty. The Guide presents in a systematic manner information on the procedures and requirements concerning the deposit of microorganisms and gives practical advice to persons depositing microorganisms for patent purposes, on the one hand, and to anyone wishing to obtain samples of such microorganisms, on the other hand. It is regularly updated and could be consulted on the WIPO Internet website (<http://www.wipo.int/treaties/registration/budapest/guide/index.html>).

#### Main Advantages of the Treaty

11. By acknowledging the multiple legal effect of a single deposit, the Treaty makes the patent procedure simpler and patenting more attractive in the States party to the Treaty and reduces the biosafety risk of transferring microorganisms into several countries. The Treaty is primarily advantageous to the depositor who is an applicant for patents in several countries; the deposit of a microorganism under the procedures provided for in the Treaty will save him money and strengthen his security. It will save him money because, instead of depositing the microorganism in each and every country in which he files a patent application referring to that microorganism, he can deposit it only once, with one depositary, with the consequence that in all but one of the countries in which he seeks protection he will save the fees and costs that deposits would otherwise have entailed. In most cases, there will be at least one international depositary authority in the country of the depositor, which means that he will deal with an authority which is close to him, with which he can deal in his own language, to which he can pay the fees in his own currency and which he may even know from personal experience; in other words, he will be able to avoid dealing with distant authorities, in foreign currencies and in foreign languages. He will probably have a natural trust in the authority carefully preserving the viability of the deposited microorganism and furnishing samples only to those who are entitled to receive them under the applicable rules concerning public access to deposited microorganisms.

12. The security of the depositor is increased by the fact that, for an institution to become an international depositary authority, solemn assurances as to the seriousness and continued existence of that institution must be given; such assurances must be given by a State or by an intergovernmental organization and they are addressed to all the Contracting States of the Budapest Union. Consequently, it may be expected that the assurances will be strictly respected, all the more so since, if they are not so respected, the Contracting States may take away from the defaulting institution the status of international depositary authority.

13. It is to be noted that the Treaty does not require the establishment of an International Depositary Authority in a Contracting State.

14. The Treaty contains no financial provisions. No State can be requested to pay contributions to the International Bureau of WIPO on account of its membership in the Budapest Union.

### **III. RATIFICATION OF AND ACCESSION TO THE TREATY**

15. Conditions. Any State member of the International (Paris) Union for the Protection of Industrial Property may become party to the Budapest Treaty (Article 15(1)).

16. The States that have signed the Treaty may become party to it by depositing an instrument of ratification. Those that have not signed it may become party to it by depositing an instrument of accession.

17. Instruments of ratification or accession are to be deposited with the Director General of WIPO (Article 15).

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