

WIPO/IP/UNI/DUB/04/1

ORIGINAL: English

DATE: April 2004



AJMAN UNIVERSITY
OF SCIENCE AND
TECHNOLOGY



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WORLD INTELLECTUAL
PROPERTY ORGANIZATION

WIPO NATIONAL SEMINAR ON INTELLECTUAL PROPERTY FOR FACULTY MEMBERS AND STUDENTS OF AJMAN UNIVERSITY

organized by
the World Intellectual Property Organization (WIPO)
in cooperation with
Ajman University of Science and Technology (AUST),
the Association of Arab Universities
and
the Association of Arab Private Institutions for Higher Education

Ajman, May 5 and 6, 2004

**THE INTERNATIONAL PROTECTION OF INDUSTRIAL PROPERTY: FROM THE
PARIS CONVENTION TO THE AGREEMENT ON TRADE-RELATED ASPECTS OF
INTELLECTUAL PROPERTY RIGHTS (THE TRIPS AGREEMENT)**

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BACKGROUND

Prior to the existence of an international industrial property regime it was difficult to obtain protection for industrial property rights in the various countries of the world because of the diversity of their laws. In the field of patents, applications had to be made roughly at the same time in all countries in order to avoid the publication of an application in one country destroying the novelty of the invention in the other countries. During the second half of the nineteenth century, the growth of industrial production, the increase in international trade and the development of a more internationally oriented flow of technology and made the harmonization of industrial property laws urgent in the fields of patents, trade marks and industrial designs.

The origins of proposals for an international convention on the protection of industrial property were traced by Carl Pieper and Paul Schmid, in their history of the 1883 Paris Convention¹, to a suggestion of Prince Albert, the Consort of Queen Victoria, made at the time of the Great Exhibition of 1851, that there should be some form of international protection for inventions.²

The Vienna Congress 1873

The first international conference, which addressed the possibility of an international industrial property regime, was a conference on patent law, which was convened on the occasion of the 1873 Vienna International Exposition. At the time that plans for the Vienna Exposition were announced, US inventors and manufacturers had threatened a boycott of the event unless the Austrian Patent Law of 15 August 1852 could be improved to provide more satisfactory protection to foreign inventors. The particular complaint which was made about the Austrian law, was the requirement that the manufacture of a patented article should commence within the Austro-Hungarian Empire within one year from the grant of a patent. Bureaucratic delays within the Empire were identified as a significant obstacle to this working requirement.³ As a consequence of US expressions of concern, discussions were held in Vienna between the Austro-Hungarian Minister for Foreign Affairs and the US legate, John Jay, resulting in the enactment by the Austro-Hungarian Government of a special law “for the provisional protection of articles introduced at the Vienna Exposition”.⁴ This law was based on those which had been enacted by the UK and French Governments in connection with the International Expositions in London in 1851 and 1862 and Paris in 1855 and 1867.

Although convened at the invitation of the Austro-Hungarian Government, the Vienna Congress was an unofficial meeting. Funding for the meeting was secured by private individuals, the most influential of which was Carl Pieper, a founding member of the Deutsche Patentschutz-Verien who sold subscriptions to the 47 Germans who attended the Congress. Other countries which sent delegates were: Austria (35) Belgium (1), Brazil (1), Canada (1) Denmark (1) France (3), Greece (1), Hungary (6), India (1), Italy (2), Japan (1), Russia (4), Netherlands (1), Sweden (2), Switzerland (3), UK (14), USA (36).⁵

The Preparatory Committee sent to delegates a series of questions concerning

...the international rights of inventors; the boundaries of those rights; whether such boundaries should be international or territorial; the granting, cost, lapsing, and duration of patents; the administration of the Patent Office, and the securing of international arrangements somewhat analogous to those existing in the case of copyright.⁷

The answers received to these questions formed the basis for a number of resolutions which were presented for discussion at the Congress which met between 4 and 8 August 1873. The first Resolution which was adopted by the Congress was that “The protection of inventions should be guaranteed by the laws of all civilized nations”.⁸ Seven “reasons” were advanced to justify this Resolution. These were:

- (i) The sense of right among civilized nations demands the legal protection of intellectual work.
- (ii) This protection affords, under the condition of a complete specification and publication of the invention, the only practical and effective means of introducing new technical methods without loss of time, and in a reliable manner, to the general knowledge of the public.
- (iii) The protection of invention renders the labour of the inventor remunerative and induces thereby competent men to devote time and means to the introduction and practical application of new and useful technical methods and improvements, and attracts capital from abroad, which, in the absence of patent protection, will find means of secure investment elsewhere.
- (iv) By the obligatory complete publication of the patented invention, the great sacrifice of time and of money, which the technical application would otherwise impose upon the industry of all countries, will be considerably lessened.
- (v) By the protection of inventions, secrecy of manufacture, which is one of the greatest enemies of industrial progress, will lose its chief support.
- (vi) Great injury will be inflicted upon countries which have no rational patent laws, by the native inventive talent emigrating to more congenial countries, where their labour is legally protected.
- (vii) Experience shows that the holder of a patent will make the most effectual exertions for a speedy introduction of his invention.⁹

The second Resolution listed the principles upon which an “effective and useful patent law should be based”. These included the principles that only the inventor or his legal representative should be entitled to a patent and that “a patent should not be refused to a foreigner”.¹⁰ A patent term of 15 years was proposed, together with the complete publication of a patent at the time of grant, as well as the principle of the independence of national .¹¹ Probably, the most controversial of these principles was that which allowed patented inventions to be used “by all suitable applicants for an adequate compensation”.¹² The acceptance of this principle of compulsory licensing, reflected the strong influence of the German delegates in Vienna, who saw some advantage in debates about the patent system in their country in demonstrating how abusive patent monopolies might be mitigated.¹³

A Permanent Executive committee was established to continue the work of the Congress and to publicise the Recommendations.

The Paris Conference 1878

Although of limited influence, largely because of its unofficial nature, the Vienna Congress placed patent protection on the international diplomatic agenda and provided a negotiating basis for the more influential Paris Conferences of 1878, 1880 and 1883.

In Decrees of 4 and 13 April 1876, the French President announced the decision of the French Government to convene the “Paris Universal Exposition” in 1878. In addition to the display of “works of art and industry”, the Consultative Committee of the Exposition proposed the holding of some 31 conferences on a range of diverse subjects, which included the protection of artistic and industrial property.[†] A Preparatory Committee was established and it took the decision to go beyond the Vienna Congress’s concern with patents and to discuss all aspects of industrial property rights. Three Sections were established to consider patents, trade marks and industrial designs and models. The Preparatory Committee sought views from interested persons on the issues to be raised in the various conferences.[‡] From the responses which were received, reports were prepared by the three Sections for submission to the delegates at the first general session of the Paris Conference, which was scheduled for 5 September 1878.

Some 484 delegates attended the Paris Conference, of whom 390 were French nationals. Official representatives were sent by France, Germany, Hungary, Italy, Luxemburg, Norway, Russia, Spain, Sweden, Switzerland and the USA.[‡] Additionally, representatives were sent by a number of trade and professional associations. According to a number of contemporary reports, much of the Conference’s time was taken up with the discussion of abstract issues, particularly the theoretical justifications for intellectual property protection.[‡] The most significant resolutions of the 1878 conference was the resolve to secure from a government, sponsorship of an official conference to “determine the bases of uniform legislation” and to establish a Permanent Committee “to give effect to the propositions adopted by the Congress of Industrial Property”.[‡]

On 18 and 19 September 1878, the Permanent Committee met to determine its mandate and functions. It considered a draft treaty “concernant la Création de l’Union Générale pour la protection de la Propriété Industrielle”, which was prepared by its Swiss member, Bodenheimer.[‡] This draft treaty, which sought to incorporate all the matters which had been raised during the 1878 conference, was adopted by the Permanent Committee.

The draft treaty was not considered by the French Government to be capable of adoption in the form in which it was transmitted and the French Section of the Permanent Committee, produced a second draft, which was divided into two parts. Part A included those articles which could be put into operation without requiring major modifications to domestic law. Part

B comprised Recommendations suggesting ways in which national laws could be modified in the interest of international uniformity in industrial property matters.³ The second draft dropped the theoretical content of the first and in Part A, confined itself to enunciating the principle of national treatment for industrial property rights and providing for the rights of priority for patents, trade marks and designs.

Notwithstanding the relatively modest requirements of this draft, a third draft was requested by the French Government and this in August 1880 was submitted to those foreign governments, who had made known their assent to participate in a Conference to be scheduled for later that year.⁴ The third draft comprised eleven Articles, divided into five Sections: General Questions, Patents of Invention, Designs and Industrial Models, Trade Marks and Commercial Names.

The Paris Conference 1880

The 1880 Paris Conference was the first diplomatic conference concerned solely with the international protection of industrial property rights. It was attended by 35 official delegates from Argentine Confederation, Austria, Belgium, Brazil, France, Guatemala, Hungary, Italy, Luxemburg, Netherlands, Norway, Portugal, Russia, Salvador, Sweden, Switzerland, Turkey, UK, Uruguay, USA, Venezuela. With the exception of Belgium, France, Italy and the UK, which were represented by the respective heads of their industrial property offices⁵, the delegates were drawn largely from diplomatic backgrounds. This was a contrast with the previous conferences, where most participants came from industrial property backgrounds. There was no German participation in the 1880 Conference, because of fears that adherence to a convention would require modification of the German patent law which had been enacted in 1877.⁶

The first act of the 1880 Conference was to reject the third draft treaty in favour of an alternative draft, prepared by Charles Jagerschmidt, of the French Ministry of Foreign Affairs.⁷ The Conference accepted Jagerschmidt's suggestion in Article 1 of this draft that the Conference establish a "Union for the Protection of Industrial Property". The term "Industrial Property" was defined in Paragraph 1 of the Final Protocol as being "understood in the broadest sense" and relating "not only to the products of industry in the strict sense, but also to agricultural products (wines, grain, fruit cattle, etc), and mineral products which are put into trade (mineral waters, etc)".

The proposal for a "Union" followed the initiatives of the International Telegraph Union (1865) and the Universal Postal Union (1874), particularly in relation to the establishment and funding of the International Bureau.⁸

The Jagerschmidt draft, like its predecessors, proposed the right of national treatment as a fundamental principle. This was defined in Article 2 of the final draft in the following terms:

The subjects or citizens of each of the contracting States of the Union, shall enjoy in all other States of the Union, in the matter of patents, industrial designs or models, trademarks, and commercial names, the advantages that their respective laws now

accord or may hereafter accord to nationals. In consequence, they shall have the same protection as the latter and the same legal remedy against injury to their rights, upon the only condition that they accomplish the formalities imposed upon nationals by the domestic legislation of each State.

Finally, the Jagerschmidt draft contained in Article 11, temporary protection for patentable inventions, industrial designs and trade marks in respect of goods exhibited at official or officially recognised exhibitions. This Article was adopted by the Conference in substantially the form in which it was proposed.

The 1878 Conference had been particularly critical of national legislation, such as the French law of 5 July 1844, which provided for the forfeiture of patents on the ground of the importation of goods of a similar nature to those covered by the patent. Article 4 of the Jagerschmidt draft also sought to proscribe such forfeitures, but a number of the delegates to the 1880 Conference advocated the obligation that a patent be worked in those countries where it was granted.³ To make the Article acceptable to all delegates, including those opposed to a compulsory working requirement, the Conference adopted a proviso which required that “the patentee shall remain under the obligation to exploit his patent, in conformity with the laws of the country into which he introduces the patented articles.”⁴

The Paris Conference 1883

In March 1883, the French Minister of Foreign Affairs, convened a second diplomatic conference, observing that sufficient time had elapsed for Governments to have studied the draft text.⁵

On 6 March 1883, delegates from 20 countries met at the invitation of the French Government to consider the 1880 draft Convention and to sign this text, if appropriate.⁶ The States represented at the 1883 Conference were Argentina, Belgium, Brazil, France, Guatemala, Italy, Luxemburg, the Netherlands, Portugal, Romania, Russia, Salvador, Serbia, Spain, Sweden and Norway, Switzerland, UK, USA and Uruguay.

The Paris Convention of 1883 was obviously significant as the first multilateral intellectual property convention. Although it had declined to address the important theoretical issues which were discussed in the 1878 Conference, the 1883 Convention contained a number of important substantive features: the requirement of national treatment, priority rights and the concept of an “Open Union”, with the possibility of revision and the extension of membership. The Paris Convention was to serve as a model for the subsequent international intellectual property agreements which are described in this book. Indeed these were contemplated as Special Agreements by Article 15 of the Paris Convention, which provided:

It is understood that the High Contracting Parties reserve the right to make separately between themselves special arrangements for the protection of industrial property, in so far as these arrangements do not contravene the provisions of the present Convention.

As Jean-François Bozérian had prophetically told the 1880 Paris Conference, their work would amount only to "la préface d'un livre qui va s'ouvrir et qui ne sera peut-être fermé que dans de longues années".^{ff}

Revisions

The Paris Convention provided in Article 14 for periodic conferences of revision, with a view to amending the Convention informed by its practical application.

First Conference of Revision at Rome 1886

The First Conference of Revision, held in Rome from April 29 to May 11, 1886. The Italian Government, together with the International Bureau of the Paris Union, taking the view that it was too early to make substantive changes to the Convention, intended merely to settle the interpretation of some of its terms.^{bb} However, there was considerable discussion about the extent of the obligation to exploit a patent, referred to in Article 5, this was left to the signatories' own interpretation.^{cc} Also Article 10 was amended by the addition of the element of fraudulent intent in relation to the appending of false indications of origin.^{dd} The practical effect of this revision conference was minimal as the acts signed at the Rome Conference failed to secure ratification in any country.

Second Conference of Revision at Madrid, 1890-91

Following an unofficial industrial property congress held in Paris in August 1889 at which a general harmonization of industrial property laws was canvassed, four texts were prepared by the International Bureau and the Spanish Government for a revision conference to be held in Madrid. The first was a protocol of interpretation and execution of the Convention, which had been submitted to the Rome Conference. The second concerned the administration of the International Bureau. The third was proposed as a special agreement under the Paris Convention for the international registration of trade marks and the fourth concerned a special agreement for the repression of false indications of origin.^{ee}

The Protocol of Interpretation and Execution again addressed the issue of exploitation of patents in Article 5 and again left it to each country to interpret this according to their own law.^{ff} The Conference unanimously adopted the proposition, contained in the Protocol, of the independence of patents.^{gg}

The arrangements concerning the international registration of trade marks were adopted by nine countries^{hh} and for the repression of false indications of origin were adopted by ten countries.ⁱⁱ

On April 14, 1891, the delegates of the countries of the Union, met to sign the texts adopted at Madrid and on June 12 1892, the ratifications were exchanged with the exception of the Protocol for the Interpretation of the Convention.^{٤٤}

Third Conference of Revision, Brussels, 1897

In May 1897 a meeting of manufacturers, businessmen, engineers and lawyers had met in Brussels and established the Association Internationale pour la Protection de la Propriété Industrielle (AIPPI), to conduct research and to propagandise for industrial property. The association was modeled upon Association littéraire et artistique internationale (ALAI), which had been established in 1878 to perform similar functions in relation to copyright. The first congress of AIPPI, held in Vienna in October 1897, pressed for the introduction of uniform industrial property laws in all countries.

The Third Conference of Revision met in Brussels in December 1897 and adopted two protocols. The first was an Additional Act, which contained amendments to Articles, 3, 4, 9, 10, 11, 14 and 16 of the Convention and inserted Article 4bis, which provided for the independent status of patents for the same invention obtained in more than one country.^{٤٥} The Second Protocol contained a number of modifications to the 1891 Act concerning the international registration of trade marks. These Additional Acts were ratified by most of the participants at the Brussels conference within 18 months.^{٤٦}

Fourth Conference of Revision, Washington 1911

The Washington Conference, which met on May 15, 1911, had no additional texts to consider, but incorporated the amendments to the Paris Convention made at the previous conferences into the original text as separate articles, which attempted to preserve the original numbering of the Convention. This was achieved by the addition of *bis* and *ter* to the original Article numbers.

The national treatment principle in Article 2 was extended to include indications of origin, utility models and acts of unfair competition. The principle of the independent status of patents, provided in Article 4*bis*, was clarified by an indication that independence included grounds for refusal, revocation and duration.

The International Bureau was directed to undertake studies on four matters on which agreement could not be reached: simplification of the formalities relating to patent applications; an agreement for the international deposit of designs and models; a system for the uniform classification of trade marks; and the creation of a system for the recording of trade marks in countries, such as China, which did not have a registration system. These studies were to be presented at the next conference, which was scheduled for the Hague

The deposit of ratifications took place at Washington on April 1, 1913, some countries were not able to meet this dead-line and their ratifications were delayed until after the First World War.^{٤٧}

Fifth Conference of Revision, The Hague, 1925.

The Fifth Revision Conference met in the context of the creation of a number of new states, as a consequence of the Peace Treaties and the creation of the League of Nations and the International Chamber of Commerce (ICC).

One obvious consequence was that the agitation by some countries for an obligation to work a patent in all countries of the Union was replaced by the suggestion of the UK and US delegations that a patentee who had not worked an invention for three years, could be compelled to grant a licence to others to work that invention.

A separate text was put forward for the creation of a separate Union for the international deposit of designs and models.

The Convention was signed on November 6, 1925 by all participating states, excluding Turkey and Bulgaria.^{٥٥}

Sixth Conference of Revision, London, 1934

The London Conference met on May 1, 1934. The preparatory work included the receipt of revision proposals from AIPPI and the ICC, as well as from member countries. Amendments considered included: the independence of patents sought during the priority period; and the right of an inventor to be named in a patent. The Conference also considered the issue of the independence of trade marks and their assignability.^{٥٦}

The revised texts of the Convention were signed on June 2, 1935.

Seventh Revision Conference, Lisbon, 1958

The Lisbon Conference met from October 6-31, 1958. The large number of delegations participating and the operation of the unanimity principle in relation to voting,^{٥٧} prevented significant progress.^{٥٨} However, amendments were achieved in relation to the priority period for patents and Article 5^{quater}, was inserted concerning the effect of importation upon process patents. A number of amendments were made to the trade mark provisions: the introduction of the *telle quelle* principle in new Article 6^{quinquies}; the term for canceling the registration of well-known marks in Article 6^{bis}, was extended from three to five years.

The revised text was signed on October 31, 1958 and a new Agreement for the International Registration of Appellations of Origin was also adopted.^{٥٩}

Eighth Conference of Revision, Stockholm, 1967

The Stockholm Revision Conference was concerned largely with the rearrangement of the administration of the Paris Convention. The administration of the Paris Union and also of the Berne Union had been combined by the Swiss Government in an administrative Bureau of the Swiss Government, the Bureaux Internationaux Réunis pour la Protection de la Propriété Intellectuelle (BIRPI). From 1952, BIRPI began to assume a greater administrative independence and to move in the direction of becoming a specialized agency of the United

Nations.^ق This evolutionary process was consummated at the Stockholm Revision conference, which on July 14, 1967, adopted the WIPO Convention, which came into effect on April 26, 1970.^ر New Articles 13-17 were inserted into the Stockholm text of the Paris Convention to effect this administrative change, which included the creation of new organs for the Paris Union: the Assembly, the executive committee and a reorganized International Bureau.^ش

The Stockholm Conference also adopted an Additional act to the Madrid agreement for the Repression of False Indications of Origin and the text of the Madrid Arrangement for International Registration of Trademarks was revised. A Complementary act of Stockholm for the Hague Arrangement for the International Deposit of Designs, created a Special assembly for the Hague Union.

The Nice Agreement for International Classification of Goods and services and the Lisbon Agreement for Protection of Appellations of Origin were also revised at Stockholm.

The majority of Paris Union countries are now party to the Stockholm Act of 1967. It is the Stockholm Act which is incorporated by reference into the World Trade Organization Agreement on Trade Related Aspects of Intellectual Property Rights.^ت

The Road to TRIPS: Intellectual Property as a World Trade Issue

From the late 1970's there was a growing realisation, particularly in the USA, that the counterfeiting of trade marked products was having a considerable impact adverse impact upon trade revenues. In 1979 the USA and the European Community had reached agreement on a draft 'Agreement on Measures to Discourage the Importation of Counterfeit Goods'.^ث Between 1980 and 1982 informal meetings with a number of industrialised countries^ج resulted in a revised draft Anti-counterfeiting Code.^ذ

This US initiative was carried forward into the ministerial meeting of 1982 for the preparations for the forthcoming GATT Round.^ض In the face of a US suggestion that the Draft Code be adopted as part of the GATT, the developing countries led by Brazil and India argued that intellectual property issues were the exclusive territory of WIPO and that, in any event, the GATT was concerned with trade in tangible goods and therefore, that the GATT had no jurisdiction over trade mark counterfeiting.^غ The Resultant Ministerial Declaration requested the Director General of GATT to hold consultations with his counterpart at WIPO in order to clarify the appropriateness of joint action in relation to counterfeiting.^ظ During 1982 an Expert Group produced a report on the effects of trade mark counterfeiting on international trade.^م Discussions within the GATT Council renewed the questioning of the relevance of intellectual property rights to the GATT and, additionally, raised the question of whether the allegations of the trade impacts of trade mark counterfeiting could be quantified. This challenge was taken up in the United States, both through Congressional hearings and through studies conducted by trade associations submitting to those hearings.^{ب ب ب}

Between 1982 and 1986 a Preparatory Committee of the GATT identified the issues which would be the concern of the forthcoming GATT Round.^{ccc} The U.S. proposed that the Round consider all intellectual property rights, affirming that the GATT was the appropriate forum to seek the enforcement of intellectual property rights. Subsequent negotiations led by the Swiss and Columbian Ambassadors sought a compromise between the opposing views on the jurisdiction of GATT in these matters. and produced a proposal which served as the basis for the Ministerial Declaration of 20 September 1986 which launched the Uruguay Round^{ddd}.

The Uruguay Round

Identifying the subjects for negotiation in the Round, the Ministerial Declaration explained that

In order to reduce the distortions and impediments to international trade, and taking into account the need to promote effective and adequate protection of intellectual property rights, and to ensure that measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade, the negotiations shall aim to clarify GATT provisions and elaborate as appropriate new rules and disciplines.

Negotiations shall aim to develop a multi lateral framework of principles, rules and disciplines dealing with international trade in counterfeit goods, taking into account work already undertaken in the GATT.^{eee}

This initiative was expressed to be without prejudice to complementary initiatives which might be taken by WIPO or elsewhere.^{fff}

The Negotiating Plan settled by a Decision of 28 January 1987^{ggg} under the heading "Trade-Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods" , identified that the initial phase of the negotiating process would be taken up with gathering relevant factual material and with the tabling of the texts of interested participants. In response to this invitation, the Office of the United States Trade Representative in Geneva on 19 October 1987 submitted a substantive proposal for the interdiction of the trade in infringing products through the implementation of Customs controls and through the promulgation and implementation of legislative norms for the protection of intellectual property rights.^{hhh} Further suggestions were tabled by Switzerland, Japan and the European Community. The E.C. proposal was the most far reaching in that it suggested that a TRIPS Agreement should adhere to the basic GATT principles of national treatment, non-discrimination, reciprocity and transparency, as well as applying to the new categories of intellectual property right, such as semi-conductor layouts, and plant varieties as well as to the traditional categories, including utility models and appellations of origin.^{ttt}

The subsequent negotiations of the Round were dominated and almost frustrated by a deadlock over agricultural policies. By the mid-term review, scheduled for December 1988, agreement had been reached or was close in the eleven other negotiating areas. An exception

to this wide-ranging concord was intellectual property, where led by India and Brazil, the developing countries continued to question the relevance of intellectual property for the GATT, particularly because of the existence and availability of WIPO^{١١١}

A key factor in the ultimate success in securing the GATT TRIPS Agreement was the preparedness of the United States to define its negotiating objectives through domestic trade legislation. The impasse at the GATT, as well as the increasing cacophony of agitation from trade lobbyists had resulted in the introduction in 1984 of an amendment to s.301 of the Trade Act of 1974, which permitted the President to seek the elimination of “unjustifiable or unreasonable” trade practices. The 1984 Trade and Tariff Act made intellectual property protection explicitly actionable under s.301.^{١١٢} The Omnibus Trade and Competitiveness Act of 1988^{١١٣} introduced “Special 301”, which required an annual review by the U.S. Trade Representative (USTR) of the intellectual property practices of the country’s trading partners. The USTR was required to identify “priority foreign countries” which deny “adequate and effective protection of intellectual property rights” or which “deny fair and equitable market access” to U.S. traders. The USTR is then obliged to place those countries on either a watch list or a priority watch list, with a view to a fast track investigation, followed by trade retaliation in the form of increased duties or import restrictions.^{١١٤} Special 301 was explicitly introduced as a supplement to the U.S. TRIPS negotiating strategy.^{١١٥}

The Mid-Term Review, held in Montreal at the end of 1988 had produced only a small convergence in the positions of the industrialised and the developing groups of countries. However, a decisive breakthrough was achieved at the April 1989 meeting of the Trade Negotiations Committee at which a Framework Agreement on the future direction of negotiations on intellectual property rights was settled. The Framework Agreement included acceptance of (a) the applicability of the basic principles of the GATT and of relevant intellectual property agreements and conventions; (b) the provision of adequate standards and principles concerning the availability, scope and use of trade-related intellectual property rights; (c) the provision of effective means for the enforcement of trade-related intellectual property rights; and the provision of effective and appropriate procedures for the prevention and settlement of disputes between governments, including the applicability of GATT procedures.^{١١٦}

Throughout 1989 the TRIPS negotiating group received submissions from a number of countries and by the beginning of 1990 these had been reduced to five texts. Texts were proposed by The E.C., Japan, Switzerland and the U.S. and a text was proposed by a group of developing countries. Further revisions during 1990 culminated in the presentation of a Draft TRIPS Agreement, dated 22 November 1990 to the Ministerial Meeting in Brussels scheduled for 3 December 1990.^{١١٧} Differences remained over some of the detail of patent and copyright law principles, as well as the more important issues of incorporating intellectual property into the GATT and the applicability of dispute resolution procedures for intellectual property. In any event, these concerns were rendered nugatory by the collapse of the Brussels meeting due to the impasse over agriculture.

The Round was restarted the following year, with concerted attempts by the GATT Director General to identify the issues for resolution. Further draft texts were received by the TRIPS

negotiating group during 1991 and in November 1991 the Director General, Arthur Dunkel issued a progress report which identified some twenty intellectual property issues which required resolution.^{ففف} In a dramatic development the following month, the Director General of the GATT attempted to precipitate a conclusion of the Uruguay Round by tabling a Draft Final Act Embodying the Results of the Uruguay Round of Multilateral Trade Negotiations, which included a new TRIPS text which attempted to settle outstanding difficulties by proposing compromise formulae.^{صصص}

Negotiations were resumed in Geneva in late 1992 following the resolution of differences between the E.C. and the U.S. on agricultural policies and both India and the U.S. proposed revisions of the Dunkel Draft. In the result the final draft of the TRIPS Agreement, which was adopted when the Uruguay round was brought to a close at the Ministerial meeting at Marrakesh, April 12-15, 1994, was very close in form and content to the Dunkel Draft.^{ققق}

General Provisions, Basic Principles and Final Provisions (WIPO Intellectual Property Materials)

Definition of Intellectual Property

5.670 The TRIPS Agreement states that, for the purposes of the Agreement, the term “intellectual property” refers to all categories of intellectual property that are the subject of Sections 1 through 7 of Part II of the TRIPS Agreement, namely, copyright and related rights, trademarks, geographical indications, industrial designs, patents, layout-designs (topographies) of integrated circuits, and undisclosed information (Article 1.2).

Incorporation by Reference of the Paris and Berne Conventions

5.671 The TRIPS Agreement is built on principles more than a century old, embodied in the Paris Convention for the Protection of Industrial Property and the Berne Convention for the Protection of Literary and Artistic Works. In fact, almost all the substantive provisions of these two Conventions are incorporated by reference directly into the TRIPS Agreement.

5.672 Concerning industrial property, the TRIPS Agreement requires that Members comply with Articles 1 through 12, and Article 19, of the Paris Convention, in respect of Parts II, III and IV of the Agreement (Article 2.1). This includes all of the substantive provisions of the Paris Convention.

5.673 In the field of copyright, Members are required to comply with Articles 1 through 21 of the Berne Convention and its Appendix. However, Members do not have rights or obligations in respect of Article 6bis of the Berne Convention concerning moral rights, or of the rights derived therefrom (Article 9.1).

5.674 The TRIPS Agreement, however, stipulates that nothing in Parts I to IV of the Agreement shall derogate from existing obligations that Members may have to each other under the Paris or Berne Conventions (Article 2.2).

The Principle of National Treatment

5.675 TRIPS provides for the principle of national treatment, requiring that Members accord the treatment provided for in the Agreement to the nationals of other Members, the latter defined in terms, for the corresponding rights, of the relevant provisions of the Paris, Berne and Rome Conventions, and the IPIC Treaty. Exceptions provided for under the relevant conventions are respected within the context of the TRIPS Agreement. As regards industrial property and copyright, this principle applies to all rights. As regards rights in respect of

performers, producers of phonograms and broadcasting organizations, the obligation only applies in respect of the rights provided under the Agreement. Also exempted from this principle are procedures provided in multilateral agreements concluded under the auspices of WIPO relating to the acquisition or maintenance of intellectual property rights.

The Most-Favored-Nation Principle (MFN)

5.676 The TRIPS Agreement contains the most-favoured-nation principle, which has not traditionally been provided for in the context of intellectual property rights on the multilateral level. This principle provides that any advantage, favor, privilege or immunity granted by a Member to the nationals of any other country (whether a Member or not) shall be accorded immediately and unconditionally to the nationals of all other Members, with certain specified exemptions. As is the case for national treatment, procedures provided in multilateral agreements concluded under the auspices of WIPO relating to the acquisition or maintenance of intellectual property rights are exempted from this principle.

Protection of Existing Subject Matter

5.677 The TRIPS Agreement contains specific provisions regarding the effect of the Agreement on the subject matter of intellectual property rights that exists, on the date of application of the Agreement, in a Member. While the Agreement does not give rise to obligations in respect of acts which occurred before the date of application of the Agreement for the Member in question (Article 70.1), the Agreement does give rise to obligations in respect of all subject matter existing and protected at the date of application of the Agreement, or which meets or comes subsequently to meet the criteria for protection under the terms of the Agreement (Article 70.2). However, copyright obligations with respect to existing works and obligations in connection with the rights of producers of phonograms and performers in existing phonograms are determined solely under Article 18 of the Berne Convention (Article 70.2).

5.678 A Member may provide for limited remedies for acts which become infringing as a result of the implementation of the Agreement and which were commenced, or in respect of which a significant investment was made, before the date of acceptance of the Agreement. These must include at least the payment of equitable remuneration (Article 70.4).

5.679 There are certain exceptions to these general rules. In particular, there is no obligation to restore protection to subject matter which has fallen into the public domain (Article 70.3). In addition, certain obligations concerning computer programs, cinematographic works and phonograms (Articles 11 and 14(4)) need not be applied with respect to originals or copies purchased prior to the date of application of this Agreement (Article 70.5). Further, provisions concerning guidelines for use without authorization (Article 31) and non-discrimination as to the field of technology (Article 27.1) need not be applied to use without the authorization of the right-holder where authorization for such use had been granted by the government before the date the Agreement became known (Article 70.6).

5.680 Applications for protection of intellectual property rights which are pending on the date of application of the Agreement may be amended to claim any enhanced protection provided under the Agreement, but such amendments may not include new matter (Article 70.7).

Standards Concerning the Availability, Scope and Use of Intellectual Property

Rights (Part II)

5.683 Part II of the TRIPS Agreement provides minimum standards concerning the availability, scope and use of intellectual property rights. This Part contains eight sections

relating, respectively, to copyright and related rights, trademarks, geographical indications, industrial designs, patents, layout-designs (topographies) of integrated circuits, protection of undisclosed information and control of anti-competitive practices in contractual licenses (the latter subject is not contained in the definition of intellectual property of Article 1.2).

Copyright and Related Rights (Section 1)

5.684 The essential elements of the standards concerning the availability, scope and use of copyright and related rights include the following:

- Members must comply with Articles 1-21 of the 1971 Paris Act of the Berne Convention and, where applicable, with the Appendix to that Act (containing special provisions for developing countries). However, Members do not have rights or obligations under the Agreement concerning the subject matter of Article 6bis of the Berne Convention (concerning moral rights), or of the rights derived therefrom (Article 9.1);
- copyright protection shall extend to the expression and not to ideas, procedures, methods of operation or mathematical concepts as such (Article 9.2);
- computer programs, whether in source or object code, must be protected as literary works under the Berne Convention (Article 10.1);
- compilations of data or other material, whether in machine readable or other form, which by reason of the selection or arrangement of their contents constitute intellectual creations shall be protected "as such." The protection does not extend to, but is without prejudice to any copyright subsisting in, the data or material itself (Article 10.2);
- a commercial rental right is provided in respect of at least computer programs except where the program itself is not the essential object of the rental, and to cinematographic works; however, Members are excepted from the latter obligation unless such rental has led to widespread copying which materially impairs the exclusive right of reproduction in a Member (Article 11);
- the term of protection for works other than photographic works or works of applied art, where the term is calculated on a basis other than the life of a natural person, shall be no less than 50 years from the end of the calendar year of authorized publication or, if publication has not taken place within 50 years from the making of the work, 50 years from the end of the calendar year of the making of the work (Article 12);
- limitations or exceptions to exclusive rights are confined to cases which do not conflict with normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right-holder (Article 13);
- with respect to related rights, performing artists shall have the right to prevent the fixation and reproduction of their unfixed performances on phonograms, and the wireless broadcasting and communication to the public of their live performances (Article 14.1);
- producers of phonograms shall have the right to authorize or prohibit the direct or indirect reproduction of their phonograms (Article 14.2);
- broadcasting organizations (or, if such rights are not granted to broadcasting organizations, the owners of copyright in the subject matter of broadcasts) shall have the right to prohibit the fixation, reproduction, wireless rebroadcasting and communication to the public by television broadcast (Article 14.3);
- a rental right is provided for producers of, and certain other right-holders in, phonograms; Members may maintain systems, in existence on April 15, 1994, of equitable remuneration in respect of the rental of phonograms, provided such system does not materially impair exclusive rights of reproduction (Article 14.4);
- the term of protection for performers and producers of phonograms is at least 50 years from the end of the calendar year of fixation or performance, and for broadcasters at least 20 years from the end of the calendar year of broadcast (Article 14.5);

- the conditions, limitations, exceptions and reservations permitted by the Rome Convention may be applied to certain related rights (under paragraphs 14.1 to 14.3) granted in the Agreement; however, the provisions of Article 18 of the Berne Convention apply, mutatis mutandis, to the rights of performers and producers of phonograms in phonograms (Article 14.6).

Trademarks (Section 2)

5.685 The essential elements of the standards concerning the availability, scope and use of trademark rights include the following:

- any sign capable of distinguishing the goods or services of one undertaking from those of other undertakings (thus including service marks) shall be eligible for registration as a trademark (Article 15.1);
- registrability may be conditional upon visual perceptibility and, for signs which are not inherently distinctive, on distinctiveness acquired through use (Article 15.1);
- registrability may be conditional upon use (Article 15.2), but use may not be a condition for filing and an application may not be refused solely on the ground that intended use has not taken place within three years of the filing date (Article 15.3);
- the nature of the goods or services to which a trademark is to be applied may not be an obstacle to the registration of the mark (Article 15.4);
- Members shall publish each trademark and afford a reasonable opportunity for petitions to cancel the registration, and may afford an opportunity to oppose the registration (Article 15.5);
- the rights conferred by registration shall include the exclusive right to prevent third parties from using identical or similar signs for identical or similar goods or services, where such use would result in a likelihood of confusion, the latter to be presumed where the goods or services are identical (Article 16.1), subject to certain allowable exceptions such as the fair use of descriptive terms (Article 17);
- certain rights are provided for the owners of well-known trademarks and service marks (Article 16.2 and 16.3);
- the term of initial registration and renewals shall be no less than seven years, renewable indefinitely (Article 18);
- if a showing of use is required for the maintenance of a registration, the registration may be cancelled only after an uninterrupted period of at least three years of non-use, unless valid reasons for non-use are shown (Article 19.1);
- certain restrictions on use are not permitted (Article 20);
- compulsory licensing of trademarks is not permitted (Article 21);
- trademarks may be assigned with or without the transfer of the business to which the trademark belongs (Article 21).

Geographical Indications (Section 3)

5.686 The essential elements of the standards concerning the availability, scope and use of rights involving geographical indications include the following:

- “geographical indications” are defined as indications which identify a product as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the product is essentially attributable to its geographical origin (Article 22.1);
- Members must provide the legal means for interested parties to prevent the use of indications that misleadingly indicate or suggest that a good originates in a geographical area other than the true place of origin (Article 22.2(a));

- Members shall refuse or invalidate the registration of a trademark which consists of a misleading indication (Article 22.3), and provide means to prevent any use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention (Article 22.2(b));
- protection shall be applicable against a geographical indication which is literally true but misleading (Article 22.4) and, in the case of wines or spirits, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as 'kind', 'type', 'style', 'imitation' or the like (Article 23.1);
- protection is not required in respect of a geographical indication of another Member which is identical with the common name for goods or services, or, for products of the vine, which is identical with the customary name of a grape variety existing in the territory of that Member as of the date of entry into force of the WTO Agreement (Article 24.6);
- there is no obligation to protect geographical indications which are not or cease to be protected in their country of origin, or which have fallen into disuse in that country (Article 24.9);
- guidelines are provided for additional protection for geographical indications for wines and spirits (Article 23), including concurrent protection of homonymous geographical indications for wines (Article 23.3), certain exceptions to substantive rights such as prior rights (Article 24.4) and the right to use personal names (Article 24.8), and time limits for registration in certain cases (Article 24.7);
- in order to facilitate the protection of geographical indications for wines, negotiations are to be undertaken in the TRIPS Council, concerning the establishment of a multilateral system of notification and registration of geographical indications for wines, which would be effective for those Members participating in the system (Article 23.4).

Industrial Designs (Section 4)

5.687 The essential elements of the standards concerning the availability, scope and use of industrial design rights include the following:

- Members shall provide protection for independently created industrial designs that are original or new, certain standards for determining protectability being allowed (Article 25.1);
- requirements for protection of textile designs, which may be provided through industrial design or copyright law, shall not unreasonably impair the opportunity to obtain protection, particularly in regard to any cost, examination or publication (Article 25.2);
- exclusive rights shall include the right to prevent third parties from making, selling or importing, for commercial purposes, articles bearing or embodying a protected industrial design (Article 26.1), subject to certain allowable exceptions (Article 26.2);
- the duration of protection shall amount to at least 10 years (Article 26.3).

Patents (Section 5)

5.688 The essential elements of the standards concerning the availability, scope and use of patent rights include the following:

- patents shall be available for products and processes in all fields of technology, provided they are new, involve an inventive step and are capable of industrial application (Article 27.1), except that Members may exclude inventions, the prevention within their territory of the commercial exploitation of which is necessary to protect ordre public (public safety), including to protect human, animal or plant life or health or to avoid serious prejudice to the environment, provided that such exclusion is not made merely because the exploitation is prohibited by their law (Article 27.2); and Members may further exclude diagnostic,

therapeutic and surgical methods for the treatment of humans or animals, plants and animals other than microorganisms, and essentially biological processes for the production of plants or animals other than non-biological and microbiological processes (Article 27.3); however, Members shall provide for the protection of plant varieties either by patents or by an effective sui generis system or by any combination thereof (Article 27.3);

- patents shall be available and patent rights enjoyable without discrimination as to the place of invention, the field of technology and whether products are imported or locally produced (Article 27.1);

- exclusive rights shall include, for products, the right to prevent third parties from making, using, offering for sale, selling or importing the patented product, and for processes, the right to prevent third parties from using the process and from using, offering for sale, selling or importing for those purposes the product obtained directly by that process (Article 28.1), subject to certain allowable exceptions (Article 30);

- patents shall be assignable, transferable and shall be available for licensing (Article 28.2);

- certain conditions are imposed concerning the disclosure of the invention in a patent application (Article 29);

- any use allowed without the authorization of the right-owner (commonly known as a compulsory license), and such use by the government, is made subject to certain enumerated conditions (Article 31); such use in the case of semi-conductor technology is limited to certain enumerated purposes (Article 31(c));

- judicial review shall be available for any decision to revoke or forfeit a patent (Article 32);

- the term of protection shall be at least 20 years from the date of the filing of the application (Article 33);

- the burden of proof concerning whether a product was made by a patented process shall in certain cases be placed on the alleged infringer (Article 34).

5.689 In addition to the foregoing obligations, where a Member had not made available, as of the date of entry into force of the WTO Agreement (that is, January 1, 1995), patent protection for pharmaceutical and agricultural chemical products commensurate with its obligations under Article 27, that Member must provide as from that date a means by which applications for patents for such inventions can be filed. The Member must, as of the date of application of the Agreement, apply to such applications the criteria for patentability as if those criteria were being applied on the filing date or priority date of the application. If the subject matter of the application meets the criteria for protection, the Member must provide patent protection for the remainder of the patent term counted from the filing date (Article 70.8).

5.690 Where such an application is filed, exclusive marketing rights must be granted for a period of five years after the obtaining of marketing approval or until a product patent is granted or rejected in that Member, whichever period is shorter, provided that, subsequent to the entry into force of the WTO Agreement, a patent application has been filed and a patent granted for that product in another Member and marketing approval obtained in that other Member (Article 70.9).

Layout-Designs (Topographies) of Integrated Circuits (Section 6)

5.691 The TRIPS Agreement incorporates nearly all the substantive provisions, with a few exceptions, of the Treaty. The Treaty provides for a regime of legal protection for layout designs

(topographies) of integrated circuits, and includes provisions on, inter alia, protectable subject matter, the legal form of protection, national treatment, scope of protection, exploitation, registration, disclosure and duration of protection. The requirements of the TRIPS Agreement are as follows:

- Members must provide protection for the layout-designs (topographies) of integrated circuits in accordance with Articles 2 through 7 (other than Article 6(3), which contains provisions on compulsory licenses), Article 12 and Article 16(3) of the IPIC Treaty (Article 35);
- the TRIPS Agreement substitutes a minimum term of ten to 15 years instead of the minimum term of eight years provided in Article 8 of the IPIC Treaty (Article 38);
- the TRIPS Agreement restricts the circumstances in which layout-designs may be used without the consent of right-holders (Article 37.2);
- the TRIPS Agreement contains an additional prohibited act to those listed in the IPIC Treaty, namely any act relating to an article incorporating an integrated circuit, but only in so far as it continues to contain an unlawfully reproduced layout-design (Article 36);
- the TRIPS Agreement provides that certain acts engaged in unknowingly will not constitute infringement (Article 6(4) of the IPIC Treaty explicitly allows such exclusions), but that a reasonable royalty shall be payable with respect to stock on hand after notice is given (Article 37.1).

Protection of Undisclosed Information (Section 7)

5.692 The TRIPS Agreement provides that, in the course of ensuring effective protection against unfair competition as provided in Article 10bis of the Paris Convention, Members shall protect undisclosed information and data submitted to governments or governmental agencies in accordance with the following provisions (Article 39.1):

- natural and legal persons shall have the possibility of preventing information lawfully within their control from being disclosed to, acquired by, or used by others without their consent in a manner contrary to honest commercial practices (Article 39.2);
- such protection is required for information which is secret (that is, not generally known among or readily accessible within the circles that normally deal with such information), which has commercial value because it is secret, and which has been subject to reasonable steps to keep it secret (Article 39.2);
- certain undisclosed test or other data submitted as a condition of approving the marketing of pharmaceutical or agricultural chemical products which utilize new chemical entities, shall be protected against unfair commercial use and, under certain circumstances, against disclosure (Article 39.3).

Control of Anti-Competitive Practices in Contractual Licenses (Section 8)

5.693 Recognizing that some licensing practices or conditions pertaining to intellectual property rights which restrain competition may have adverse effects on trade and may impede the transfer and dissemination of technology (Article 39.1), the TRIPS Agreement provides that Members may specify in their national laws licensing practices or conditions which may, in particular cases, constitute an abuse of intellectual property rights with an adverse effect on the competition in the relevant market, and that they may adopt appropriate measures to control or prevent such practices (Article 40.2).

5.694 Members agree to enter into consultations with each other, upon request, to secure compliance with laws in this regard (Article 40.3) or where their nationals are subject to such proceedings in the territory of other Members (Article 40.4).

Enforcement of Intellectual Property Rights (Part III)

General Obligations (Section 1)

5.695 The TRIPS Agreement requires that specified enforcement procedures be available to permit effective action against any act of infringement of intellectual property rights covered

by the Agreement, including expeditious remedies to prevent infringements and remedies which constitute a deterrent to further infringements. The procedures must be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse (Article 41.1).

5.696 Enforcement procedures are to be fair and equitable, not unnecessarily complicated or costly, nor entail unreasonable time-limits or unwarranted delays (Article 41.2). Decisions on the merits of a case shall preferably be in writing and reasoned, shall be made available at least to the parties to the proceeding without undue delay, and shall be based only on evidence in respect of which parties were offered the opportunity to be heard (Article 41.3). Parties to a proceeding shall have an opportunity for review of final administrative decisions and of at least the legal aspects of initial judicial decisions on the merits of a case, except for acquittals in criminal cases (Article 41.4).

5.697 However, Members have no obligation to put in place a judicial system for intellectual property enforcement distinct from that for the enforcement of law in general, nor for the distribution of resources as between enforcement of intellectual property rights and the enforcement of law in general (Article 41.5).

Civil and Administrative Procedures and Remedies (Section 2)

5.698 The TRIPS Agreement establishes guidelines concerning civil and administrative procedures which must be followed with respect to enforcement of intellectual property rights. These include provisions on fair and equitable procedures (Article 42), evidence (Article 43), injunctions (Article 44), damages (Article 45), and other remedies, such as the authority to order disposal of infringing goods or materials and implements used in the creation of infringing goods (Article 46); these provisions also deal with right of information, for example the authority to order that the infringer inform the right-owner of the identity of third persons involved in the production and distribution of infringing goods or services and of their channels of distribution (Article 47), indemnification of the defendant (Article 48), and application of the above guidelines to administrative procedures (Article 49).

Provisional Measures (Section 3)

5.699 The TRIPS Agreement establishes guidelines concerning provisional measures to prevent an infringement of any intellectual property right from occurring, and in particular to prevent the entry of goods into the channels of commerce in their jurisdiction, including imported goods immediately after customs clearance. These measures cover also the preservation of relevant evidence in regard to the alleged infringement, and the adoption of provisional measures *inaudita altera parte*, where delay is likely to cause irreparable harm or where there is a risk of evidence being destroyed (Article 50).

Special Requirements Related to Border Measures (Section 4)

5.700 The TRIPS Agreement provides for certain enforcement procedures related to border measures, to enable a right-holder who has valid grounds for suspecting that the importation of counterfeit trademark or pirated copyright goods may take place, to lodge an application for the suspension by the customs authorities of the release into free circulation of such goods. Guidelines are established with respect to suspension of release by customs authorities (Article 51), application for such procedures (Article 42), security or equivalent assurance (Article 53), notice of suspension (Article 54), duration of suspension (Article 55), indemnification of the importer and of the owner of the goods (Article 56), right of inspection and information (Article 57), *ex officio* action (Article 58), remedies (Article 59) and *de minimis* imports (Article 60).

Criminal Procedures (Section 5)

5.701 The TRIPS Agreement requires that Members provide for criminal procedures and penalties to be applied at least in cases of willful trademark counterfeiting or copyright piracy on a commercial scale. They also have to provide for remedies such as imprisonment, monetary fines, and seizure, forfeiture and destruction of the infringing goods and of any materials and implements predominantly used for the commission of the offense.

Acquisition and Maintenance of Intellectual Property Rights and Related Procedures (Part IV)

5.702 The TRIPS Agreement contains general provisions on principles concerning procedures for acquisition and maintenance of industrial property rights. Members may require, as a condition of the acquisition or maintenance of the industrial property rights covered by the Agreement (except protection of undisclosed information), compliance with reasonable procedures and formalities consistent with the Agreement (Article 62.1). Any procedures for grant or registration must permit a reasonable period of time to avoid unwarranted curtailment of the period of protection (Article 62.2). Procedures concerning acquisition, maintenance, administrative revocation and inter partes procedures are to be governed by the guidelines applicable to enforcement (Article 62.4, referring to Article 41.2 and 41.3), and most final administrative decisions are subject to judicial or quasi-judicial review (Article 62.5).

5.703 The Agreement also stipulates that Article 4 of the Paris Convention concerning the right of priority shall apply, *mutatis mutandis*, to service marks.

Dispute Prevention and Settlement (Part V)

Transparency

5.704 The TRIPS Agreement requires that laws and regulations, final judicial decisions, administrative rulings of general application and bilateral agreements pertaining to the subject matter of the Agreement be published or made publicly available by Members (Article 63.1).

5.705 Members are further required to notify such laws and regulations to the TRIPS Council. The Council, in turn, is to attempt to reduce this burden on Members by engaging in consultations with WIPO on the possible establishment of a common register containing these laws and regulations (Article 63.2).

5.706 The TRIPS Council will also consider, in this connection, any action on notifications pursuant to the obligations under the Agreement which arise from Article 6ter of the Paris Convention.

Dispute Settlement

5.707 A particularly important element of the TRIPS Agreement is the system of dispute settlement established under the WTO Agreement. The TRIPS Agreement itself invokes the provisions of Articles XXII and XXIII of GATT 1994 (the WTO Agreement), as elaborated by the WTO Understanding on Rules and Procedures Governing the Settlement of Disputes (included as an Annex to the WTO Agreement), which applies to consultations and the settlement of disputes under the TRIPS Agreement (Article 64.1).

5.708 However, subparagraphs 1(b) and 1(c) of Article XXIII of GATT 1994, which refer to so-called “non-violation” dispute settlement cases, are not to apply to the settlement of disputes under the TRIPS Agreement for at least five years from the date of entry into force of

the WTO Agreement (i.e., at least until January 1, 2000). Any extensions of that period are to be decided in the Ministerial Conference by consensus (Article 64.2 and 64.3).

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- أ C. Pieper and P. Schmid, *Gesichte der internationalen Union für den Schutz des gewerblichen Eigentums sammt Konvention und Staatsverträgen* (Berlin: Deutschen Vereins für den Schutz des gewerblichen Eigentums, 1884).
- ب *Ibid.*, at 6-7. This view of the genesis of proposals for the international protection of industrial property was accepted by Y. Plasseraud and F. Savignon, *Paris 1883: Genèse du droit Unioniste des Brevets* (Paris: Litec, 1883) at 121.
- ج Eg see article in *Scientific American* dated 23 December 1871, reproduced in USA, Congressional Papers, *Papers Relating to the Foreign Relations of the United States, 1872, 42nd Cong., 3rd Sess., H of R, Ex Docs VI, part 1* at 48-49.
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- ه List of attendees contained in C.Pieper, *Der Erfinderschutz und die Reform der Patentgesetze etc.* quoted in L.J.Duncan, *From Privileges to the Paris Convention*, Unpublished PhD Thesis, Monash University, July 1997, 396.
- و See Webster, n.6 *supra* at 342.
- ز *Ibid.*, at 343.
- ح *Ibid.* at 343-344.
- ط *Ibid.* at 350.
- ي *Ibid.* at 350-51.
- ك *Ibid.* at 351.
- ل See Duncan, n.3 *supra* at 405-406.
- م USA, Congressional papers, *Paris Universal Exposition 1878*, 46th Cong., 3rd Sess., H of R, Ex Docs, vol.20, No 42, Pt 1 at 455.
- ن See Duncan, n.8 *supra* at 439-440.
- س *Ibid.* at 448-449.
- ع Eg the view of F.A Seeley and A. Pollock, the US representatives, quoted *ibid.* at 452-453.
- ف Quoted in Duncan, n.8 *supra* at 482 and 493.
- ص The draft treaty is reproduced in France, Ministère de L'agriculture et du Commerce, *Comptes rendus Sténographiques publiés sous les auspices du Comité Centrale des Congrès et Conférences et la direction de M. Ch. Thirion, Secrétaire du Comité, avec le concours des Bureaux des Congrès et des auteurs de Conférences: Congrès Internationale de la Propriété Industrielle, tenu á Paris du 5 au 17 Septembre 1878* (Paris 1879), 712-718.
- ق *Ibid.*, 721-732.
- ر France, Ministère des Affaires étrangères, *Conférence Internationale pour la protection de la propriété industrielle* (Paris 1880), Appendix VII.
- ش *Ibid.*, at 6-7.
- ت See Duncan, n.8 *supra* at 514.

[Endnote continued on next page]

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- ث See France, *Conférence Internationale (1880)*, n.27 *supra*, Appendix VIII.
- خ *Ibid.* at 46.
- ذ See France, *Conférence Internationale (1880)*, n.27 *supra*, 56-69.
- ض *Ibid.* at 69.
- غ France, Ministère des Affaires étrangères, *Conférence Internationale pour la protection de la propriété industrielle* (Paris 1883), at 15.
- ظ See Y. Plasseraud and F. Savignon, *Paris 1883; Genèse du droit Unionistes des Brevets* (Paris, Litec, 1983) at 189-192.
- ﻫ See France, *Conférence Internationale (1880)*, n.27 *supra*, at 20, quoted by Duncan, n.8 *supra*, at 586.
- بب See Italy, *Conférence de l'Union pour la Protection de la Propriété Industrielle* (Rome, 1886), at 15.
- جج *Ibid.*, at 99-114.
- دد *Ibid.*, at 115-122.
- ﻩﻩ See chs. *Infra*.
- وو Spain, *Procès-Verbaux de la Conférence de Madrid de 1890* (1890) 135-139.
- زز *Ibid.*, 135.
- حح Belgium, Guatemala, Italy, Netherlands, Norway, Portugal, Spain, Sweden and Switzerland.
- طط Brazil, France, Great Britain, Guatemala, Norway, Portugal, Spain, Switzerland and Tunis.
- يي See *Procès-Verbaux*, n.59 *supra*, at 189ff.
- لك See *Actes de la Conférence de Bruxelles* (1897-1900).
- لل Excluding, the Dominican Republic and Serbia, see *Actes de la Conférence de Washington* (1911) 14-15.
- ﻡﻡ See *Actes de la Conférence de La Haye*, (Berne, 1926), 15.
- نن See *Ibid.*
- سس See *Actes de la Conférence de Londres*, (Berne, 1935).
- غغ See S.P. Ladas, *Patents, Trademarks and Related Rights. National and International Protection*, Cambridge Mass., Harvard University Press, 1975, 135-138.
- فف See S.P. Ladas, 'The Lisbon Conference for the Revision of the International Convention for the Protection of Industrial Property', (1958) 48 *Trademark Rep.* 1291.
- صص See ch. *infra*
- قق See S.P. Ladas, 'Proposed Reorganization of the Paris Union' (1966) 56 *Trademark Rep.* 817.
- رر See ch. *infra*
- شش See *Records of the Intellectual Property of Stockholm* (Geneva, 1971).
- تت See ch. *infra*.
- ثث GATT Doc. No. L/4817 (July 31, 1979).

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- خخ Viz. Canada, Japan and Switzerland.
- دذ *Agreement on Measures to Discourage the Importation of Counterfeit Goods*, GATT Doc. No. L/5382 (Oct 18, 1982).
- ضض See Bradley, 'Intellectual Property Rights, Investment and Trade in Services in the Uruguay Round; Laying the Foundations' (1987) 23 *Stanford J. Int'l Law* 57.
- غغ *Ibid.*, 66-67.
- ظظ *Ministerial Declaration GATT, BISD* 30th Supp.,9 (1983).
- ٲٲ *Trade in Counterfeit Goods*, GATT Doc. No. L/5758 (1982).
- ببب Eg *Possible Renewal of the Generalised System of Preferences- Hearing Before the Subcommittee on Trade of the U.S. House of Rep. Comm. on Ways and Means*, 98th Cong., 1st Sess. (1983); *Unfair Foreign Trade Practices, Stealing American Intellectual Property: Imitation is Not Flattery*, 98th Cong., 2d Sess.1-3 (1984).
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- ٲٲٲ *Ministerial Declaration on the Uruguay Round*, reproduced *ibid.*, vol. III, 7-8.
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- ييي For a comprehensive survey of the competing positions see F. Beier and G. Schricker, eds, *GATT or WIPO? New Ways in the International Protection of Intellectual Property* (Munich: VCH, 1989).
- ككك 98 Stat. 2948 (1984).
- للل 19 U.S.C. §2242 (1990).
- ممم See generally, Bello and Holmer, ' "Special 301": Its Requirements Implementation and Significance' (1989-1990) 13 *Fordham Int'l L.J.* 259.
- ننن H.R. Conf. Rep. No. 576, 100th Cong. 2d sess. 580 (1988)
- سسس Framework Agreement, text in (1989) 3 *World Intell. Prop. Rep.* 109.
- غغغ GATT Doc. No. MTN.TNC/W/35/Rev.1 (Dec.3, 1990).
- ففف *Progress of Work in Negotiating Groups: Stock Taking*, GATT Doc. No. MTN.TNC/W/89/Add.1 (Nov.7, 1991).
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