

# Violations of Paris Convention

*Objective assessment of major reported violations; a guide for dealing in 88 member countries*

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*Pacta sunt servanda* is a fundamental and universally-recognized principle of international public law. It essentially means that rights and obligations agreed upon and embodied in a bilateral or multilateral treaty must be fully observed and respected by all states bound by that treaty in accordance with their signature and ratification or by virtue of their accession.



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This vital principle must be upheld above all in a world of great violence and encroachments on human rights; it is applicable irrespective of the constitutional system by which treaty rules are incorporated into the domestic laws of individual countries.

The international obligation of countries that have approved a treaty to give internal effect to its provisions is a prerequisite for the fruitful and almost global cooperation among the 88 states of differing political and economic structures which, today, adhere to the Convention for the Protection of Industrial Property concluded in Paris in 1883 and ultimately revised in Stockholm in 1967 (hereinafter called the "Convention").

The Convention is an open and multilateral treaty of mixed content: it contains reciprocal international obligations for the states that are parties to it and sets forth certain common provisions for those who are entitled to claim rights directly or who are subject to obligations. It also lays down administrative and organizational rules and thus constitutes, under its Article 1, the framework for the Paris Union (hereinafter called "Union") embodied in successive Acts and now administered by WIPO's International Bureau.

The Convention — like its special agreements — is an open treaty, because it is accessible to all States of the world, whether or not they belong to the U.N. and/or its specialized agencies, such as WIPO.

Since January 1, 1979, 77 of the 88 member countries of the Union are bound by the Convention's 1958 Lisbon or 1967 Stockholm Acts as their latest common version. The substantive content of the Lisbon Act was

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not modified in Stockholm, except for Article 4I regarding applications for inventor's certificates as a basis for claiming Convention priority. Consequently, and except for Article 4I, the Lisbon and Stockholm Acts are identical as to substantive provisions. The remaining 11 member countries of the Union are still bound by the earlier London (1934) and/or the Hague (1925) Acts.<sup>1</sup>

In these circumstances, and in the context of this publication, the problems regarding the applicability of differing Convention Acts — dealt with in Article 27 of the Stockholm version — to certain countries of the Union are of limited impact. For our purpose, it is sufficient to emphasize that a member state of the Union which has ratified or acceded to the Stockholm Act, may apply this Act also to member states that are still bound only by the earlier Lisbon, London or the Hague Acts; however, such a state may alternatively apply the most recent common Act (namely Lisbon, London or the Hague) to the other state, and at all events, the latter state has to accept this applicability.<sup>2</sup>

## Unilateral Denunciation

It perhaps also should be mentioned that, according to Article 26 of the Convention, which is a treaty of indefinite duration, any unilateral denunciation of an Act extends automatically to all earlier Acts, so that a denouncing country necessarily leaves the Union as a whole.

In order to secure compliance with the Convention, Article 25 of the Stockholm version states that any country party to it undertakes to adopt, in accordance with its Constitution, the measures necessary to ensure the application of the Convention on the understanding that, at the time a country deposits its instrument of ratification or accession, it will be in a position under its domestic law to give effect to the provisions of the Convention. This clause corresponds to Article 17 of the Lisbon Act, which is more stringent than earlier Acts, in order to ensure national compliance without undue delay.

Subject to the optional, jurisdictional clause, which was introduced in Article 28 of the Convention's Stockholm version, the instrument of ratification or accession cannot be rejected by any other country or any organ of the Union on the ground that the obligations stipulated in Article 25 have not been fulfilled by a country ratifying the Stockholm Act signed by it or entering the Union by accession to such Act. Moreover, no organ of the Union or WIPO is authorized to intervene with a member state that violates the Convention after its ratification or accession.

In all these circumstances, it is unfortunate, but probably unavoidable, that those who are involved in

international industrial property matters have been, or still are, confronted from time to time with specific and harmful violations of the Convention's applicable Act, committed in countries of the Union either intentionally (e.g. as a legislative anticipation of advocated revision proposals for the Convention) or through negligence or perhaps simply through ignorance. Breaches may be caused by legislative, executive or judicial bodies; they may be transitional or permanent. Most encroachments are due to a discrepancy between an applicable Convention provision and a prior or late domestic rule of law or practice.

However, it should be pointed out that the evaluation of alleged breaches is frequently a complex and delicate task, especially when the interpretation of the Convention's applicable Act and/or of the relevant domestic provision or practice is open to genuine controversy. It must also be considered that attempts to rearrange the Convention text have failed in the past, so that the rationale of a specific clause may be difficult to clarify.

Moreover, it must be stressed that the purpose of this study is to draw attention, in as objective a manner as possible, to major reported violations of the Convention committed by, or in, a country of the Union. There is, consequently, no intention to create animosity or antagonism in a legal and economic area that needs so much mutual understanding, clarification, certainty and cooperation through frank international discussion. Nevertheless, one should always bear in mind that, almost inevitably, the Convention leaves wide legislative freedom and sovereignty to its member countries as regards domestic laws on the acquisition, protection and limitation of industrial property. It is, therefore, legitimate to insist on a strict and fair observance of at least those few obligations and common provisions which have, after all, been approved under the Revision Conferences' traditional rule of unanimity, and which constitute the core of the assumed, albeit limited, reciprocity of applicable protection standards within the Union linked to the basic "national treatment" principle of Articles 2 and 3.

During the past decade, international and regional treaty-making, above all in the field of patents and trademarks, has in my view, reached a certain stage of saturation, calling for a period of consolidation during which it behooves us to ensure that harmonized and adequate international protection of immaterial rights is achieved by multilateral observance of minimum Convention provisions for the sake of legal certainty and the avoidance of genuine abuses.

In this connection, we should draw attention to the inscription on the cupola's entrance hall of the new WIPO building in Geneva which says:

Human genius is the source of all works of art and invention. These works are the guarantee of a life worthy of men. It is the duty of the state to ensure with diligence the protection of the arts and invention.

Perhaps we may add that the defense of the principle *pacta sunt servanda* will contribute to these proclaimed aims.

Within the confines of this article, I shall abstain from commenting on the extensive current debates

relative to the alleged usefulness or harmfulness of certain proposals to be submitted to the Convention's next Revision Conference scheduled for February 1980. I shall simply express doubts that major curtailments of basic Convention principles such as national treatment, priority, territoriality of rights and limitations on sanctions for non-worked patents, would cure certain regrettable de facto inequalities prevailing among industrialized and developing member states of the Union, for these inequalities arise from historical and infrastructural circumstances on which the Convention has no bearing.

Nevertheless, it should be pointed out that, in my view, various provisional rules of procedure established for the 1980 Diplomatic Revision Conference, if adopted, would conflict with Article 18 of the Convention insofar as countries which are not members of the Union and possibly not even of WIPO, may widely participate in the revision debates in Geneva by virtue of rights that — although they exclude voting — go beyond privileges attached to an observer status.

In fact, Article 18 of the Convention states that revision conferences shall be held successively in one of the countries of the Union among the delegates of said countries. Although WIPO has become a specialized U.N. agency, the relevant provision of the Treaty (Article 18) has never been modified and thus cannot be disregarded.

Finally, two comments of a general nature have to be made: First, I wish to emphasize that, from the outset, the Convention has abolished earlier bilateral concepts of express reciprocity of rights, although the degree of domestic protection equally assured to nationals and foreign *ressortissants* (assimilation or nondiscrimination), still differs among member states. Consequently, a breach of the Convention prevailing in one country can never be justified or legitimized by any similar infringement committed by, or in, any other member country of the Union.

In order to avoid such trends, the WIPO Coordination Committee and the Paris Union Executive Committee were, therefore, well advised when they decided in 1978 that Part I, on patents, of the revised Model Law for Developing Countries on Inventions and Know-How should only be published if its text is in complete conformity with the Convention's Stockholm Act, and that information on possible revisions should only be furnished in the form of footnotes or the like.<sup>3</sup>

Secondly, I shall generally refrain from dealing with domestic measures taken by countries of the Union which may be interpreted as a deviation from the general spirit of the Convention, e.g. by causing a de facto discrimination of foreign *ressortissants*, namely of nationals or of residents in other Union countries. I also leave open the debatable question whether a violation prevails if, e.g., a member country excludes from patentable subject matter nearly all important fields of innovation or restricts the maximum life of all available patents to only a few years. There is admittedly a gray zone within which it is difficult to draw a clear borderline between legislative sovereignty of member countries reserved by the Convention, and a liberal construction of Convention provisions to give

effect to the purpose which animates them and thereby avoid possible conflicts with state legislation.

### DISTINCTION OF THREE CLASSES OF CONVENTION PROVISIONS

In order to evaluate violations of the Convention and determine whether direct claims for redress are available to affected private parties on national levels, we have to make a distinction between three categories of substantive provisions, leaving aside purely administrative or organizational clauses.

My comments are based on two outstanding works, namely Bodenhausen's "Guide to the Application of the Paris Convention," published by BIRPI in 1968, and Ladas' book (vols. I and III) on "Patents, Trademarks and Related Rights," published in 1975 by Harvard University Press. We may thus rely on the careful analysis by these two authors of the history and meaning of Convention stipulations as seen against the background of the records of the successive Revision Conferences and in the light of domestic jurisprudence prevailing in various countries of the Union. The views expressed by both authors undoubtedly carry great weight, although they are of a private nature; by and large their interpretations and opinions coincide as regards the distinction between Convention clauses and their legal impact.

1. The Convention contains provisions which require member states to legislate in a prescribed manner on certain issues of industrial property. Such international treaty obligations exclusively bind states to take legislative action in order to implement Convention provisions in conformity with their own legal system. Failure to act accordingly may constitute a violation of an international obligation, but private parties affected have no direct claim against the executive or in the courts to secure the introduction or maintenance of national rules in line with such provision of the applicable Convention's Act.

Besides the above-mentioned general obligation under Article 25, the following obligations, for example, fall in this category of Convention stipulations:

Article 4 D on certain mandatory details concerning the right of priority;

Article 10<sup>bis</sup>(1) involving an obligation to assure *ressortissants* of the Union-effective protection against unfair competition;

Article 10<sup>ter</sup>, making it obligatory to provide legal remedies for effective repression of certain unlawful acts concerning trademarks, false indications and unfair competition;

Article 11, requiring states to grant temporary protection to patentable inventions, trademarks, etc., in respect of goods exhibited at officially recognized international exhibitions held in their territory.

Within this category of Convention provisions, there are also those which permit, enable or invite states to enact national laws, as, e.g. Article 5A(2), implying the authorization to legislate against abuses which might result from the exercise of exclusive rights conferred by a patent. If a country, like the U.S.A., abstains *in casu* from doing so, it obviously does not violate Article 5A(2); whereas the majority of states that do legislate

on this matter must respect the mandatory conditions and limitations which the remaining part of Article 5A provides regarding prerequisites and types of sanctions prescriptible by domestic laws.

### Second Category

2. Within a second category of Convention provisions, I cite those which merely refer to national law, making it applicable to the *ressortissants* of member states.

Under the basic principle embodied in Article 2 and 3 on "national treatment" (assimilation, nondiscrimination), *ressortissants* of Union countries enjoy in all other member states, as regards the protection of industrial property, the advantages that their respective laws, now or later, grant to nationals; any reference to domestic laws belongs to this category of Convention provisions which, as a result of Treaty obligations or common provisions, define local industrial property rights applicable, without reciprocity and discrimination, to all those who are entitled thereto under the Convention.

Other more special provisions by which the Convention requires the enactment and application of domestic legislation are Articles 9(3), 9(6) and 10(1).

3. The third category of Convention provisions are those which establish substantive common legislation regarding the rights and obligations of private parties in all member states of the Union on which *ressortissants* and, if so specified by national law, also nationals themselves may directly rely by virtue of the Convention. Such rules do not merely establish international duties of states or refer to domestic laws; they are worded so as to govern directly a situation at issue, and are self-sufficient legal rules susceptible of immediate application in favor of persons invoking legitimately the protection of the Convention even against differing domestic provisions enacted before or after the ratification of the applicable Convention Act.

It is with respect to these provisions that the question arises whether, under the constitutional system of a particular member country, they are in fact immediately applicable upon that country's ratification or accession to the Convention, or whether they must still be incorporated into the national legal system by special effectuating legislation.

In the context of this article, I have to restrict my comments on the constitutional issue as follows:

In the great majority of member states of the Union, the Constitution compels administrative and judicial authorities to apply directly to private parties the self-sufficient provisions of international treaties and thus of the duly ratified Paris Convention text. The clauses of this category are "self-executing" and require no further intervention by the national legislature. Such a situation prevails in most countries of the European continent and in the U.S.A. In fact, Article VI, Section 2, of the Federal Constitution of the U.S.A., states that: "This Constitution, and the laws of the United States which shall be made in pursuance thereof; and all treaties made, or which shall be made, under the authority of the U.S. shall be the supreme law of the land; and the judges in every state shall be bound thereby, anything in the Constitution or the laws of

any state to the contrary notwithstanding.”

In line with the U.S. Supreme Court's decisions, a treaty ratified and proclaimed by the President with the consent of the Senate becomes binding on the citizens and the courts. Consequently, private parties may directly and immediately invoke self-operating provisions of the Paris Convention before the Patent Office and in court, possibly against differing prior or later domestic statutes.

The position is different in the U.K. and countries in which British law prevails as well as in Scandinavia. Treaties approved in these countries by Parliament bind only the State and consequently require implementing national laws so that their provisions are not “self-executing.” Therefore, private parties cannot claim a disconformity between the Convention and domestic legislation; such a disconformity may, nevertheless, be a violation of treaty stipulations which another member state can, at most, bring before the International Court of Justice in accordance with the conditions stipulated in Article 28 of the Stockholm Act.

Nevertheless, in the U.K. and other countries where Convention provisions are not “self-executing,” they may influence administrative or judicial decisions concerning domestic law. In Section 53(5) of the British Patents Act, 1977, there is, in analogy to the 1949 Act, even a specific reference to the Convention: “No order or entry shall be made in pursuance of an application under Sections 48-51 above, which would be at variance with any treaty or international convention to which the United Kingdom is a party,” meaning that a court may apply national rules on compulsory licenses only to the extent compatible with Article 5 A of the Convention when duly interpreted.

Stipulations of the Convention establishing common legislation and having, under most constitutions, direct internal (“self-executing”) effect, are especially the following:

Article 2 on the claim for national treatment as such  
Article 4 (with some exceptions) on the right of priority  
Article 4<sup>bis</sup>

Article 5A on the importation of patented products which, as such, shall not entail forfeiture; the right not to have an unworked patent forfeited or subjected to compulsory license upon the conditions prescribed, whereby it is mandatory that forfeiture by a subsidiary sanction in case of unjustified failure or insufficiency of patent working.  
Article 5<sup>quarter</sup> on the rights of the owner of a process patent.  
Article 6 on the independence of trademarks

as well as Articles 6<sup>quarter</sup>, 6<sup>quinquies</sup>, 6<sup>septies</sup>, 7, 8, 10(2) and 10<sup>bis</sup> (2) and (3).

Whether a national of a Union country that accepts the principle of “self-execution,” may under Art. 2, enjoy in his own country the advantages granted by the common rules of the Convention when they have not been expressly incorporated into national law, de-

pends upon a possible entitlement established by such law. Swiss nationals, for example, under Article 16 of the 1978 Swiss Patent Act, may rely on the Convention's Stockholm Act (ratified by Switzerland in 1968) where its provisions are more favorable than the national law.

## CONCRETE VIOLATIONS OF THE PARIS CONVENTION BY COUNTRIES OF THE UNION

### SWITZERLAND

As we Swiss are, often rightly, criticized for a tendency to preach our views on conduct and morality to other nations, it will be appropriate to begin this survey on major treaty violations by citing Section 38 of the 1978 Patent Act of Switzerland, which is worded as follows:

If the grant of (compulsory) licenses does not suffice to meet the demand of the Swiss market, any person proving an interest may take action for the revocation of the patent after a period of two years from the grant of the first license under Section 37(1).

If the law of the country of which the owner of the patent is a national, or in which he is a resident, allows action for revocation of the patent for failure to work the invention in that country as early as three years after the grant of the patent, such action shall be allowed in place of the action for the grant of a license, subject to the conditions specified in Section 37 for the grant of license.

Section 37 provides for compulsory licenses, if, after expiry of the Convention grace periods, a patented invention is not worked or is insufficiently worked in Switzerland without justification.

Article 5 A(3) of the Convention's Lisbon or Stockholm texts constitutes in Switzerland a directly applicable (“self-executing”) and mandatory prohibition of patent forfeiture on account of nonworking as a primary sanction, so that this sanction can be applied only if one or more prior compulsory licenses have been insufficient to prevent the unjustified abuse, and if proceedings for forfeiture have been instituted after the expiration of two years from the grant of the first and unsuccessful compulsory license. A Swiss court would clearly violate the Convention if it applied Section 38(2) to *ressortissants* of another country of the Union bound by the London, Lisbon or Stockholm texts, even if that country would itself violate Article 5 A and thus provoke a trend toward “reciprocity” or “retaliation.”

However, a Swiss court may, without violation, apply Section 38(2) to *ressortissants* of a country still bound as regards substantive clauses by the Hague Act 1925, Article 5 of which apparently allows, as an immediate alternative sanction to a compulsory license deemed insufficient, patent forfeiture on account of unjustified nonworking within three years from grant.<sup>4</sup> Consequently, e.g. a nonworked Swiss patent owned by an Indonesian could not be revoked under the terms of Section 28(2), although Indonesia, having ratified the London Act, still lacks a patent law, whereas such patent, when owned by a Brazilian national, could be forfeited, as Brazil is still bound by the Hague version of the Convention. A Swiss court may, under Article 27(2)(c) of the Stockholm Act, apply to a Brazilian the Hague text without violating Article 2, but it could not rely on Section 38(2) of its law in rela-

tion to all foreigners belonging to a country of the Union that has adhered to later versions of the Convention. Neither Section 38(2) of the Swiss law nor its former provision of the 1956 law has ever been challenged in court; this Section involves only a risk or possibility of violating Article 5 A of the Convention. As far as admissible under the Convention, Article 38(2) is a reservation of an exceptional nature. *Ressortissants* of all other states of the Union may otherwise and directly invoke Articles 2 and 3 of the Convention to obtain the advantages which Swiss law affords its own nationals in the area of industrial property. Such *ressortissants* could and can also rely on other "self-executing" Convention provisions and, moreover, Swiss law has now been fully adjusted to the Stockholm Act as ratified. Article 38(2) can, of course, always be legitimately applied to a patentee from a nonmember country of the Union which admits patent forfeiture as a primary sanction for nonworking.

I shall now turn to specific violations of the Convention by other countries of the Union in alphabetical order.<sup>5</sup>

### AFRICA

Various African countries bound by the Convention's Lisbon or Stockholm Act have maintained certain boycott measures against *ressortissants* of specific other Union member states by denying them access to the registration or protection of domestic industrial property rights. Such discrimination violates the basic national treatment principle embodied in Articles 2 and 3 of the Convention.

Similarly, Nigeria, Uganda and Kenya fully or partly disregard Article 4 of the Convention on the recognition of priority in their respective Convention countries' regulations. In a few instances such attitude is due to a refusal to acknowledge the status of a state to an entity that acceded to the Union.

### ARGENTINA

Article 47 of the Argentine Patent Act No. 111 of 1865 essentially provides that patents validly issued shall lapse if two years have expired from grant without local working of the invention performed within the country, except for a case in which inaction can be justified due to *force majeure* or a fortuitous event.

As recently as 1977, courts have decided that Article 47 of the Law has not been modified by Article 5(3) of the Lisbon Act ratified by Argentina in 1967; they have held that the Convention provision is not self-operative and that domestic legislation has not yet adopted the sanction of mandatory licenses due to nonworking as prescribed by the Convention.<sup>6</sup>

Although the issue is controversial among experts in Argentina, it should be stressed (concurring with the views of Bodenhausen and Ladas) that forfeiture of patents cannot, under the Lisbon and subsequent texts, be decreed as a primary sanction for nonworking or insufficient working so that no proceedings for forfeiture may be instituted before the expiration of two years from the grant of the first compulsory license. Moreover, Article 5(3), or Article 5 A(3), of the London, Lisbon and Stockholm Acts is clearly mandatory and

self-sufficient; if so prescribed by a country's constitution, such as Article 31 of the Argentine Constitution, this Convention rule is, moreover, internally self-executing for the benefit of private parties when a court litigation concerns the Conventions's predominance over a diverging national law in a country of the Union. Should Argentine courts continue to reject the self-executing character of the cited provision, then Argentina as a Union country cannot escape its Treaty obligation by abstaining from a legislative revision in order to admit patent forfeiture due to nonworking at most as a subsidiary sanction. Thus, it was held in 1966 in a decision of the United Chamber of the French *Cour de cassation*, that, in the absence of a compulsory license provision in the national law of countries bound by the London or any subsequent Act, forfeiture cannot be decreed.<sup>7</sup>

Admittedly, efforts — up to now unsuccessful — to modernize the 1865 Patent Law have been made covering also proposed adjustments of the old Law to Article 5(3) of the Lisbon Convention text as ratified by Argentina in 1967. Meanwhile, we have to conclude that Argentina, by applying Article 47 of its law, continues to violate the Convention's Article 5(3), irrespective of the interpretation placed by its courts on the impact of this clause and of the country's Constitution.

The incompatibility would prevail even if Article 47 embodied the longer grace periods of Article 5(4) of the Convention and recognized as a justification for inaction by the patentee "legitimate reasons" beyond *force majeure*.

In the context of Articles 5 or 5 A of the Convention, a general clarifying comment may be added: Although paragraph 1 of the clause prescribes that importation as such by a patentee shall not entail patent forfeiture, sanctions including forfeiture as a subsidiary measure are nevertheless permissible under the conditions of this provision, namely if the patented article is exclusively imported from abroad (absence of local working) after expiry of the stipulated grace periods. Compulsory licenses, possibly of exclusive nature, may immediately be granted by Union countries in cases where insufficient working or nonworking does not prevail, but where public interest, other abuses or the dependency of patents are involved, because in such cases legislative freedom is reserved on domestic levels.<sup>8</sup> This also applies, e.g. to Canada, which maintains in its law a special compulsory license system for drug patents — a system that has recently been repealed in England.

### BRAZIL

Article 5 of the Hague text of the Convention applicable to Brazil since 1929, prescribes that, after the expiration of three years from patent grant and in the absence of proven legitimate excuses, a patent not worked locally may be forfeited if the issue of compulsory licenses is insufficient to prevent such abuse. This wording is somewhat ambiguous because it leaves open the question whether the effect of a compulsory license must be tried out, in order to determine its insufficiency to cure nonworking, before forfeiture can be decreed.<sup>9</sup> The question has, in the past, been re-

solved differently by courts in other countries of the Union which had not introduced compulsory license systems into their laws. A clarification could only be achieved at the London Revision Conference of 1934 which provided in Article 5 that forfeiture is a subsidiary sanction for nonworking.

The Brazilian Code of Industrial Property No. 5772 of 1971, provides for an option between compulsory licenses and forfeiture on account of nonworking for three years from patent grant, or when, subsequently, exploitation is discontinued for more than one year. Article 5 of the Hague text is interpreted by the Administration and by most courts in the sense that cancellation, if requested, must not be preceded by a compulsory license previously demanded on account of failure to work a patented invention. It is, however, admitted that forfeiture is prohibited if a prior compulsory or voluntary license leads to working, possibly pursuant to a public offer. We thus have to conclude that the Brazilian Code's Article 33 on compulsory licenses for nonworking and Article 49 on cancellation for nonworking (both available after expiry of certain grace periods) are — perhaps subject to the exclusion of cases involving legitimate reasons justifying a patentee's inaction — compatible with Article 5 of the Convention's Hague version. However, it should be noted that the question of compatibility of a decreed and judicially confirmed cancellation of a nonworked Brazilian patent is pending before the Supreme Court, brought on by a foreign patentee's appeal. The Supreme Court will have to decide how the international stipulation of Article 5, which itself is probably self-executing in Brazil, has to be interpreted and whether Article 49 of the Code is in conformity with that interpretation. Should the Court affirm a violation of the Convention and declare Article 49 inapplicable as a primary sanction, and should this decision be respected, this would eliminate a possible breach. Should the Supreme Court, however, declare Article 49 to be compatible with Article 5 of the Hague text, a violation by Brazil, although arguable, could hardly be alleged again.

Perhaps a general comment should be added in the context of Article 5 A of the London and more recent texts which clearly exclude patent forfeiture as a primary sanction for nonworking: the definition of the concept "working," if at all required, is left to domestic law and practice, although usually it means serious domestic industrial manufacture of the patented invention. Should a national law prohibit a nonworking patentee from suing infringers, then such a measure is, in my view, nearly equivalent to patent forfeiture and constitutes a violation of the Convention and, simultaneously, a radical erosion of the patent exclusivity, causing a partial expropriation without indemnification as an internationally recognized principle.

The Brazilian Antitrust Law No. 4137 of 1962, provided in Article 4 that a Brazilian patent shall automatically be cancelled when it is proven that a corresponding patent granted in another country of the Union had lapsed for any reason. This was a clear violation of Article 4<sup>bis</sup> (Hague text) on the absolute independence of "normal" parallel patents granted in various Union countries, above all as to their validity,

maintenance and duration. However, this clause has been superseded by the 1969 and 1971 Industrial Property Codes, so that the breach of the self-executing Convention Article 4<sup>bis</sup> has been eliminated. In this context, it is appropriate to mention in a more general way that, in the past, various European countries have — at times — infringed Articles 5 or 5 A of the then applicable Convention texts. However, I shall not refer to such issues which have involved conflicting decisions, and shall only cite those violations which, by virtue of enacted laws, still prevail today. If by now the great majority of Union countries has adopted various Convention rules in full, and particularly Article 5 A with its limitations, this is probably due to the conviction that genuine and simultaneous working of numerous parallel patents places an unreasonable burden on inventors and innovative industry, and that, at any rate, early forfeiture of nonworked patents in a disincentive in the area of productive investments and technology transfer.

### GREAT BRITAIN

As mentioned in Chapter II, even those Convention rules that permit direct application are never self-executing in the United Kingdom, so that, generally, English courts do not interpret them and compare them with national law except for a specific reference in the latter, such as Section 53(5) of the British Patents Act 1977, which states that "no order or entry shall be made in pursuance of an application under Sections 48-51 above, which would be at variance with any treaty or international convention to which the United Kingdom is a party."

Sections 48-51 concern compulsory licenses on account of abuse, including nonworking or insufficient working of a patented invention.

Section 49(5) of the 1977 Act empowers the Comptroller to grant even an exclusive compulsory license under Section 48<sup>bis</sup>, depriving the proprietor of the patent of any right to exploit the invention concerned and revoking existing licenses granted under the patent. If the Comptroller decided to apply Section 49(5) to a patentee who does not (sufficiently) work his invention and who is a *ressortissant* of a Union country which has ratified the London or any more recent Act, and if this decision were confirmed on appeal in court, then I believe that a violation of paragraph 4 of Article 5 A of the Convention would occur, because the non-exclusivity of compulsory licenses on the grounds of nonworking or insufficient working as prescribed in paragraph 4 is a self-sufficient and mandatory provision to be respected by virtue of Section 53(5) of the British Patent Act.

A situation similar to the one described for the United Kingdom prevails under the Irish Patent Act.

### INDONESIA

When Indonesia acquired its independence from the Netherlands in December 1949, it declared that the Convention (London Act) remained in force in its territory as from December 27, 1949, onward. The Dutch patent law previously applicable was repealed, but — despite repeated efforts — no autonomous patent legis-

lation could be enacted during the past 30 years, although, by virtue of a 1953 Decree, patent applications could be filed in Jakarta, possibly to secure future priority rights. The total absence of patent protection constitutes, without doubt, a permanent violation of the Convention's London Act and particularly of its Articles 1 and 17, because the multilateral reciprocity of the protection of inventions which is supposed to exist under the national treatment principle will not prevail with respect to an important subject of industrial property. There exists also domestic noncompliance with various treaty obligations of an administrative character.

### IRAQ

This country is bound by the Convention's Stockholm Act as ratified in January 1976.

Article 4 D(3) of that Act allows any country of the Union to require, i. a., any applicant of a patent making a declaration of priority to produce a copy of the original patent application certified as correct by the authority which received such application; no further authentication of such document may, however, be required.

During the summer of 1976, the Iraqi Patent Authorities started to request legalization by the Iraqi Consul of the officially certified priority document to be submitted with its translation in Bagdad. Such request for legalization constitutes a breach of Article 4 D(3) of the Convention containing a mandatory limitation of formalities in order to facilitate the claiming of priority rights.

### JAPAN

Various authors have dealt extensively with complex issues relating to the recognition by courts in Japan (and in the U.S.A.) of Convention priorities when applied through domestic legislation, so that my comments will be restricted to the 1977 Tokyo High Court's final decision in *Hoechat v. Director of the Patent Office* which, in analogy to the famous U.S. *Kawai* ruling, aroused great concern among international patent applicants.<sup>10</sup> Hoechst's German priority application was filed in Japan after a competitor's similar application, so that, if Hoechst were awarded Convention priority, the "double patenting" rejection would have been overcome. In affirming denial of priority the Court essentially held that the disclosure of the Japanese application was sufficient, but that the invention had not, under Japanese law, been completely disclosed on the German filing date (lack of a working example for the claimed process), so that there was no identity of invention as prescribed by Article 4 of the Stockholm Act ratified by Japan in 1975.

Under Article 4 A(2) and (3) of the Convention, a first and regular national filing which establishes a date in accordance with domestic law creates a right of priority in any other country of the Union, whatever may be the subsequent fate of the original application. Article 4 H of the London and subsequent Acts state that this priority may not be refused on the ground that certain elements of the invention do not appear

among the claims formulated in the country of origin, provided the application documents as a whole specifically disclose such elements. The rationale of this self-executing provision is to allow adjustments of subsequent applications to national requirements, so that, necessarily, some liberal flexibility as regards the evaluation of identity of subject between the first and subsequent applications is required to preserve the Union priority. The addition of a specific working example by Hoechst in Japan did not affect the sufficiency of the original disclosure under German or Japanese standards or the identity of the claimed invention.

It is indisputable that Article 36 of the Japanese Patent Law, according to its Article 26, cannot be applied in a manner that conflicts with Article 4 of the prevailing Paris Convention providing for a 12-month-period to permit translation of the "home country" application into a foreign filing compatible with respective local rules, provided substantial identity is preserved.

I thus conclude that the *Hoechst* decision rendered in 1977 by the Tokyo High Court violates the wording and obvious spirit of Article 4 of the Convention, and I hope that the Japanese Supreme Court will confirm an earlier differing High Court judgment involving a similar case, in order to eliminate the violation in the *Hoechst* ruling of 1977. Otherwise, priorities will frequently and unfairly be lost in Japan and possibly in other countries of the Union by bona fide patent applicants, as a result of formalistic approaches.

### MALAGASY REPUBLIC

A situation similar to Indonesia now prevails in Madagascar, which ratified the Convention's Stockholm Act in 1972, but recently withdrew from the 1963 Libreville Accord on the African Intellectual Property Organization without introducing autonomous provisions on patents and trademarks. This is undoubtedly a violation of the Convention.

### MEXICO

On December 30, 1975, Congress adopted a new law on inventions and trademarks which came into force on February 11, 1976, and replaced the 1942 Code of Industrial Property. Several provisions of the new Law, if applied, would violate the Convention's Lisbon and Stockholm Acts ratified by Mexico:<sup>11</sup>

As an exception of the exclusive right to exploit a patented invention set forth in Article 37(1), Article 37(2) of the new Law provides that a patent does not confer upon its owner the right to import a product patented in Mexico or a product manufactured abroad by a process patented in Mexico. Such a rule is equally applicable to invention certificates under Article 77. Article 211 declares as patent infringement not only the unauthorized manufacture, but also the sale within Mexico, of a product patented per se or a product directly made by a patented process. This definition is applied equally to invention certificates. Article 37(2) is, nevertheless, interpreted at present in Mexico as a bar to stop, on the basis of Mexican titles, the infringement by imports as well as by sales of imported

products protected by Mexican patents or certificates. Under these circumstances, I conclude that Article 37-(2) (2) violates, at least with respect to process patents, Article 5<sup>quarter</sup> of the Convention which is self-executing under the Mexican Constitution and may thus be invoked through court proceedings (*amparo*) by affected patentees. In fact, Convention Article 5<sup>quarter</sup> extends the domestic effect of process patents in *casu* defined by Article 211 of the Mexican Law) to the importation of products manufactured abroad according to the patent granted in the country of importation.

A violation would, however, not occur, should Mexican courts interpret Article 37(1) as follows: unauthorized importation of a patented product or a product made abroad by a patented process (or alternatively covered by a Mexican certificate) constitutes a patent infringement, whereas, a patent or certificate does not allow any imports by a patentee or a licensed third party if another law prohibits *in casu* such importation. It must be borne in mind that the word "exclusive" contained in the Government Bill of 1975, has been eliminated from Article 37(2) by the Congress, so that the provision's impact is now somewhat ambiguous.

Under Article 48 of the new Law, patents will be declared forfeited if not industrially worked in Mexico within three years from grant, and if no application for a compulsory license has been filed within the fourth year after grant. This provision is a nonsupplementary (primary) sanction for inaction and, if applied, violates the self-executing Article 5 A(3) of the Convention as ratified by Mexico, because cancellation may be declared before a compulsory license under Article 50 is granted on account of nonworking or insufficient working within three years from patent issue; inaction may, moreover, not be justified by legitimate reasons under Article 5A(4) of the Convention. Patents issued before February 11, 1976, in conformity with the prior law, may also be cancelled by virtue of Article 48 of the 1976 Act, provided their working is not evidenced and a compulsory license request has not been filed before February 11, 1980. Article 48 of the 1976 Act violates the Convention. In order to avoid forfeiture of non-worked Mexican patents, many declarations of "legal excuses" have recently been filed with the Patent Office in reliance on Article 5 A(4) of the Convention to be perhaps implemented in the forthcoming Rules.

Article 36.I of the new law provides that a Union priority must be rejected if the Mexican patent application seeks greater rights than those derived from the corresponding first filing abroad. This clause may possibly be applied in a manner which is incompatible with Article 4 F of the Convention. Moreover, I have been advised that the Mexican Patent Office recently refused to admit the priority of a regular first filing abroad, although the applicant had submitted all relevant documents within the twelve months period, on the ground that the power of attorney did not comply with domestic rules. Such practice appears to violate Article 4 D(3) and (4) of the Convention which, *inter alia*, states in a mandatory way that, at the filing date, no formalities other than the cited ones must be complied with to secure a Union priority.

In the area of trademarks the 1976 law provides that, on account of public interest, certain prohibitions and restrictions may be placed on the use of Mexican trademarks.<sup>12</sup> Such measures, if decreed, are probably compatible with Article 7 of the Convention.

On the other hand, Articles 127 and 128 prescribe, *inter alia*, that a Mexican trademark owned by a foreigner and licensed to any Mexican firm to identify

products manufactured in the country, must, in the future, be linked to a national trademark originally registered in Mexico and owned by the licensee; both associated trademarks have to be displayed with equal prominence. The compulsory linkage, as stipulated, violates the national treatment provision of Article 2 of the Convention, as it clearly discriminates against a foreign owner of a licensed Mexican trademark in its protection and use. However, mainly for reasons of impracticality, the application of Articles 127 and 128 to trademark license agreements, originally effective from February 11, 1978, onward, has been twice postponed for one year by Presidential decrees in accordance with the law's traditional rules. Consequently, we may conclude that the aforementioned violation will never be effectuated or, at least, will not commence before February 11, 1980.

## PHILIPPINES

Presidential Decree No. 1263, published and enacted in January 1978, amended certain portions of the 1947 Patent Act No. 165. Under Section 34 of Article 2, a compulsory license may be granted if a patent is not worked within two years from grant. This provision violates Article 5(4) of the Convention's Lisbon text ratified by the Philippines in 1965, insofar as the grace period has been reduced by the Decree from three to two years.

Under Section 75 of the Decree, the Director of Patents is authorized to prescribe, by rules, annual and other fees for patents which are higher than those fixed in this clause, to the extent that they are payable by nationals from developed countries. This provision, if applied, would violate the equal treatment principle of Article 2 of the Convention.

The violations as stated above, have not been eliminated by Presidential Decree No. 1250 of June 1978, which relaxed certain other clauses of the earlier Patent and License Decree.

## POLAND

The 1972 Polish Patent Act provides *i.a.*, in its Article 46 that a patent which has not been domestically worked within the conventional grace periods may be subjected to compulsory licensing by decision of the Polish Patent Office to be published in the Official Gazette. Should no request for a license be filed within one year from such publication, the Patent Office may declare the nonworked patent forfeited in conformity with Article 66(2) of the Act. Such cancellation, if decreed, violates Article 5 A(3) of the Convention's Stockholm version as ratified by Poland in 1975.

## SOUTH AFRICA

South Africa, which is bound by the Convention's Stockholm version, recently revised its Patent Act effective January 1, 1979.

Section 56 of the new Act deals with compulsory licenses on account of patent abuse. It applies the Convention grace periods only to strict nonworking as defined in subsection (2)(a). Although the time limits prescribed in Article 5 A (4) of the Convention refer exclusively to failure or insufficiency of local patent working and not to other abuses, there is a certain risk that compulsory licenses may be granted by the South African Commissioner (and confirmed by courts upon appeal) immediately after patent sealing by reliance

on subsections (2) (b) (c) and (e) of Section 56 which refer, *i.a.*, to patent exploitation by way of importation but may, in effect, simply involve lack of domestic working. In such circumstances, there could be a breach of the Convention. In order to avoid any risk of Convention violations, the 1977 British Patent Act applies in its Section 48 the Convention time limits to all defined cases of patent abuse.

In analogy to the British Act, Section 56(6) of the South African Law empowers the Commissioner to grant, in certain cases, an exclusive compulsory license under a nonworked patent: such provision, if applied, would clearly infringe Article 5 A(4) of the Convention which prescribes nonexclusiveness to mandatory licenses issued under nonworked patents.

## SPAIN

The Industrial Property Law of 1929, repeatedly revised later, provides in Articles 84-90 and 116 that a patent which has not been industrially worked or for which license offers (yearly renewable nominal working) have not been published, may be declared forfeited after the expiration of a three year grace period calculated from grant. This provision is not compatible with Article 5 A(3) of the Convention's Stockholm Act, ratified by Spain in 1972, in which a mandatory requirement to permit forfeiture on account of unjustified inaction, is — in analogy to the Lisbon text — a prior and unsuccessful grant of a compulsory license, namely a condition not to be fulfilled by a rule that permits patentees to offer by publication voluntary licenses (nominal working).

On June 17, 1971, the Spanish Supreme Court held that Articles 5(3) and (4) of the Paris Convention take precedence over conflicting stipulations of the domestic patent law, so that patents belonging to *ressortissants* of the Union cannot be declared forfeited on the grounds of nonworking and failure to offer a license during the three years' grace period. The Court apparently by application of the Spanish constitutional system, allowed the patentee to invoke the self-sufficient and self-executing Article 5(3) and (4) of the Convention, which it declared to have been violated by domestic law and pertinent administrative decisions.<sup>13</sup>

The Supreme Court reaffirmed its 1971 decision in 1974. These rulings may, however, not be a guarantee of a permanent affirmation of the incompatibility of the national law with the direct or indirect application of Article 5 A of the Convention in Spain. As the issue remains controversial in Spanish circles, only a revision of the domestic law can secure a clear adjustment to the Convention.<sup>14</sup> Otherwise, a violation could occur again (as it did before 1971) by virtue of a future and modified Supreme Court decision.

## TURKEY

The 1897 Patent Law of Turkey, a country which ratified the Convention's London Act in 1957, provides in its Article 38 that a patent can be declared forfeited if it has not been worked within three years from grant or if working is subsequently interrupted during two years without legitimate reasons; the importation by the patentee of patented products into Turkey may, moreover, entail forfeiture. Article 38, if applied against *ressortissants* of the Union, clearly violates Article 5(1), (3), and (4) of the London version, al-

though Turkey never introduced a system of compulsory licenses.

The Turkish Council of State, however, has repeatedly decided, in appellate cases that patents, which after the expiration of the grace period (London text of Article 5) have not been locally worked, may be declared forfeited in the absence of proven legitimate excuses. One of these relevant decisions, issued on March 31, 1975, held that forfeiture for nonworking is compatible with Article 5(2) of the Convention and that, apparently, paragraphs (3) and (4) of this clause are not self-executing in Turkey. Diplomatic interventions to persuade Turkey to adapt its legislation to the ratified Convention texts have been of no avail. One can conclude that a permanent violation prevails irrespective of the internal constitutional aspect.

There exists another, but less important infringement of the relevant Convention Act, namely Article 4D(3). Recently the Turkish Patent Office started to require legalization by the Turkish consulate of the priority document certified as correct by the authority receiving the patent application which establishes the Union priority right. A consular authorization of an official document containing all the elements prescribed by Turkish law and by Article 4 D of the Convention, is a formality which must be considered to be incompatible with the Convention as regards recognition of priority in the Turkish Patent Office before or after the filing date in Turkey.

Finally, I have been advised that, the Turkish Patent Office recently rejected patent applications based on multiple priorities permissible under Article 4 F of the Convention's London text.

## UNITED STATES

When referring to the Japanese case law on Union priority, I mentioned *Kawai v. Metlesics*, decided in 1973 by the CCPA and subsequently relied upon in other decisions.<sup>15</sup>

The 1973 decision concluded, *inter alia*, that a foreign patent application on which the U.S. priority is to be based, must contain a disclosure adequate under U.S. law. When this is considered with the two earlier *Hilmer* judgments, the question to be answered is whether present U.S. court practice pursuant to 35 USC Sections 102, 112 and 119, is compatible with Article 4 of the Convention's Stockholm Act ratified by the U.S.A. in 1973.

At the outset it is apparent that 35 USC Section 104 does not distinguish between U.S. and foreign citizens, but simply bars any applicant or patentee from establishing in the U.S. a date of invention by reference to knowledge or use or other activity in a foreign country. This rule may lead *de facto* to a discrimination against foreign inventors, but is *de jure* not a clear violation of Convention Article 4, particularly when applied in interference proceedings.

However, by virtue of Section 112 in conjunction with Section 119, as applied in *Kawai*, the regular Union priority from abroad is recognized for the later U.S. application only if the relevant foreign filing fulfills the U.S. disclosure requirements, although it constitutes prior art exclusively as of the U.S. filing date. This rule itself is, under the *Hilmer* doctrine, of doubt-

ful compatibility with Article 4 of the Convention.

Looking at the history, spirit, and wording of the Convention's Article 4, especially its Sections A(2) and (3), as well as H, which states that it suffices to disclose the elements of invention in the "home country" application documents as a whole to secure Union priority for subsequent applications on the same invention abroad, one must conclude that *Kawai* and similar more recent rulings have violated Article 4. Whereas it is evident that the subsequent U.S. application must conform to U.S. requirements as regards disclosure, it is incompatible with the Convention to argue that, by backdating the U.S. filing to the "home country" filing for priority purposes ("reduction to practice"), the latter must contain exactly all the requirements of substantive disclosure prescribed in the U.S. Consequently, U.S. legislation or case law must be revised to ensure compliance with the pertinent Convention rules as almost universally interpreted in the interests of genuine reciprocity and Union treatment.

The loss of priority in U.S. conflicts becomes particularly unfair when the best mode contemplated by the inventor for carrying out his invention is described in the U.S. specification, but — although known — has not been included in the disclosure of the "home country" filing, because the foreign law did not require it.

Another question relates to the right of priority based upon an application for an inventor's certificate or invention certificate available, e.g. in the U.S.S.R. or Mexico.

Article 4 I(1) of the Convention's Stockholm Act provides as follows:

Applications for inventors' certificates filed in a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate shall give rise to the right of priority provided for by this Article, under the same conditions and with the same effects as applications for patents.

After ratification of Articles 1-12 (Stockholm Act) by the U.S.A. in 1973, the procedure in the Patent Office requires submission of an affidavit or specific declaration by an applicant (basing his priority on a certificate) that, when filing his original application, he had the option either for a patent or an inventor's certificate as to the subject matter of the identified claim(s) forming the basis for priority.

In the U.S.S.R. chemicals and pharmaceuticals are unpatentable per se and can only be protected by certificates; the free choice between the two titles is limited to the manufacturing processes for such products. Consequently, the U.S. Patent Office and the U.S. courts may refuse recognition of priority for product per se claims covered by U.S. applications (patents), if reliance is placed upon applications for Soviet certificates, in conformity with Article 4 I of the Convention, which as a special rule stipulates as a condition for the recognition of priority the free choice between the two titles which is not admitted in the U.S.S.R. *A fortiori*, an application for an invention certificate in Mexico covering a process for the manufacture of a pharmaceutical or agrochemical product can be rejected as a right to priority in another country of the Union including the U.S.A., without violation of the Convention, because under the 1976 Mexican Law, no patents at all are available for drug or agrochemical

inventions, whereas in other areas applicants have a free choice between the two titles.

Although Article 4 I of the Stockholm Act is somewhat ambiguous and conference records give no guidance for its interpretation, I feel that the applicant's option in a country providing for two titles must refer concretely to available claims as a prerequisite for the recognition of priority in other Union countries. This is true although the U.S., for example, does not reject a priority for chemical and pharmaceutical product claims if the "home country" application is restricted to process claims only admitted under the relevant law, or if it contains product claims which will be refused under that law.

## YUGOSLAVIA

This country ratified the Convention's Stockholm Act in 1973, Article 27(5) of a new Drug Law, effective January 8, 1978, prescribes, *inter alia*, that approval for marketing a new medicine or renewal of such authorization by the competent Federal Authorities depends upon evidence submitted by the domestic manufacturer that he is the exclusive owner of the rights to the drug's trademark. This provision is officially interpreted as involving the obligation by the owner of a registered Yugoslavian drug trademark to assign it irrevocably to the licensed domestic manufacturer. Such obligation goes beyond the usual type of exclusive license agreements concluded in Yugoslavia and amounts to an unjustified expropriation of pharmaceutical trademarks with possible future conflicts and confusions in the country and abroad. Efforts to modify Article 27(5) have been unsuccessful thus far.

The question has been raised whether Article 27(5) of the 1978 Drug Law violates Articles 2 and/or 7 of the Convention. Undoubtedly, the provision amounts to a severe de facto discrimination against foreign drug trademark owners who cooperate with Yugoslavian partners. However, I believe that it does not constitute *de jure* a breach of Article 2 because, at least theoretically, the assignment obligation, as a prerequisite for marketing permits, extends to national owners of trademarks as well. Moreover, Article 7 is not infringed, as under its narrow scope the stipulation refers exclusively to trademark registration and not to the use of marks.

Consequently, the provision prohibiting future drug trademark licensing, although erosive, unfair and contrary to the legitimate interests of all concerned, is at most a deviation from the Convention's general spirit.

It is to be noted that a similar drug trademark problem exists in Portugal by virtue of Decree No. 41.448, issued in 1957.

## INTERNATIONAL REMEDIAL MEASURES

It would go beyond the terms of reference of this article if I attempted to deal with the complex issue of existing or future remedial measures to secure compliance with the Convention by the countries bound by it.

At any rate, such measures, if available and effective at all, can be applied only if the affected private party or its country has patiently exhausted, without

success, all domestic steps or bilateral diplomatic representations.

Moreover, our survey has shown that Article 25 of the Convention's Stockholm Act, designed to ensure without delay the correct application of the Treaty by all countries of the Union in conformity with their constitutional systems, is only of limited impact.

Admittedly, Article 28 of the Stockholm Act binds those states which have made no reservation regarding the jurisdictional clause, but disputes over the interpretation or application of the Convention before the International Court of Justice — in the absence of other methods of settlement such as negotiated agreement or arbitration — may only be brought in the Hague by states of the Union and not by aggrieved private parties. For reasons of international politics and diplomacy, no case has ever been submitted to the Hague Court claiming a Convention violation.

Finally, it should be mentioned that, unless previously approved by two or more states of the Union involved, no organ of the Union or of WIPO is competent to interpret the Convention authentically and to determine whether it is violated by, or in, a country of the Union.

The extensive efforts of WIPO to explain, among other things, the impact of the Paris Convention at regional seminars on international intellectual property, are most commendable. The clarifications and conclusions of these and other meetings, however, do not necessarily reach those who ultimately draft or interpret domestic bills on patents and trademarks. Above all, local politicians may be influenced directly or indirectly by unilateral evaluations of industrial property protection systems in UNCTAD circles.

Under these circumstances, WIPO, intergovernmental and private organizations should perhaps review the question of how — beyond Articles 25 and 28 of the Stockholm Act — countries and private parties interested in industrial property protection could (e.g., by international arbitration) secure full compliance by Union states with the relevant Convention Acts. The current extensive debates on possible revisions of the

Paris Convention make sense only if the principle *pacta sunt servanda* is universally observed by all partner states with regard to existing and future versions of this important treaty.

Ed. Note: For further discussion of this issue, see WEGNER, "Patent Protection for Novel Microorganisms Useful for the Preparation of Known Products," 5 IIC 285 *et seq.* (1974). PAGENBERG, "Paris Convention Priority: A Unique Viewpoint Denying 'The Same Effect' to the Foreign Filing," 5 IIC 362. *et seq.* (1974), and CHISUM, "Foreign Activity: Its Effect on Patentability Under United State Law." *see below.*

#### NOTES

1. Table of member states as of January 1, 1979, see 1979 Ind. Prop. No. 1, at 6.
2. BODENHAUSEN, "Guide to the Application of the Paris Convention for the Protection of Industrial Property" 214 (Geneva, 1968).
3. See 1978 Ind. Prop. 280, 282.
4. Cf. OSTERRIETH, "Die Haager Konferenz zur Revision der Pariser Verbandsvereinbarung" 41 (Leipzig, Berlin, 1929).
5. For an overview see MARCHANT, "The Paris Convention — Decline and Fall?" 1978 Revue et Bulletin de la FICPI No. 29, at 15 *et seq.*
6. See *Junkers & Co. GmbH v. Fanal S.A.C.I.* National Court of Appeals for Federal and Administrative Issues, March 18, 1977, 10IIC 77 (1979), with note by KUNZ-HALLSTEIN.
7. *Cour de cassation (Chambres Reunies)*, November 16, 1967, 1967 Ann. 117; 1968 GRUR Int. 935.
8. *Actes de la Conference de Lisbonne 1958*, at 407, *et seq.*
9. For an overview see SIEMSEN, "La Obligacion de Explotar las Patentes en Brasil" in BERCOVITZ (ed.), "La Obligacion de Explotar las Patentes en espana y en Iberoamerica" 16 *et seq.* (Madrid, 1978).
10. 1977 GRUR Int. 453, with note by KUWATA; 8 IIC 566 (1977), with note by L. WALTER.
11. See KUNZ-HALLSTEIN, "Die Neuregelung des Erfinderschutzes in Mexiko." 1968 GRUR Int. 14, 16, with further references.
12. See FERNANCEZ-NOVOA, "Die Erosion des Markenrechts im mexikanischen Gesetz uber Erfindungen und Marken," 1977 GRUR Int. 400 *et seq.*
13. The decision of the Spanish Supreme Court is published in 1972 GRUR Int. 246, with note by WIECZOREK.
14. See BERCOVITZ, "Probleme der Reform des spanischen Patentrechts," 1978 GRUR Int. 150 *et seq.*
15. 1978USPQ 158; GRUR Int. 139, with note by WIECZOREK. On the questions discussed in the following: WIECZOREK, "Convention Applications as Patent-Defeating Prior Rights," 6 IIC 135 (1975).