International Conventions, Agreements & Treaties for the Protection of Intellectual Property

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Summary - This paper gives a broad view of the various international treaties and conventions on intellectual property rights of the numerous conventions, treaties and agreements. It also covers all the treaties, conventions and agreements administered by World Intellectual Property Organisation (WIPO), one of the specialized agencies of the United Nations. Important treaties which are not administered by WIPO are also discussed.

Conventions, Treaties and Agreements Administered by WIPO

Convention establishing WIPO

This Convention was signed at Stockholm on 14 July, 1967 and was amended in 1979. The activities of WIPO are inter-governmental cooperation in the field of industrial property and in copyrights and neighbouring rights mainly in literary, musical and artistic works in films, records etc.

WIPO has its Headquarters at 34, Chemin des Colombettes Geneva and is headed by the Director General. Till 1 January 1995, 151 countries, including India, were members of WIPO.

Paris Convention for the Protection of Industrial Property

The Paris Convention for the protection of industrial property is an international treaty signed originally by 11 countries in Paris on 20 March 1883 and revised at Brussels (1900), Washington (1911), The Hague (1925), London (1934), Lisbon (1958), Stockholm (1967) and amended in 1979. The Convention is applicable to industrial property including not only inventions, trademarks, service marks and industrial designs but also utility models, trade names, indications...
of source, appellations of origins and repression of unfair competition.

Till 1 January 1995, 129 countries were the members of the Convention. India is not a member of the Paris Convention.

**Madrid Agreement for the Repression of False or Deceptive Indication of Source of Goods**

This Agreement was signed in Madrid on 14 April 1891 and was revised at Washington on 2 June 1911, at The Hague on 6 November 1925, at London on 2 June 1934, at Lisbon on 31 October 1958 and at Stockholm on 14 July, 1967.

This Agreement provides that all goods bearing false or deceptive indication of source by which one of the countries to which the Agreement applies, or a place situated therein, is directly or indirectly indicated as being the country or place of origin, shall be seized on importation, or that such importation shall be prohibited, or that other actions and sanctions shall be applied in connection with such importation. It provides for the cases and the manner in which the seizure may be requested and effected.

The Agreement prohibits the use, in connection with the sale or display or offering for sale of any goods of all indications in the nature of publicity capable of deceiving the public as to the source of the goods. It is reserved to the courts of each country to decide what appellations other than regional appellations concerning the source of products, do not, on account of their generic character come under the stipulations of the Agreement. As on 1 January 1995 it had 31 states as members. India is not a party to this agreement.

**Madrid Agreement concerning the International Registration of Marks**

This Agreement for the International Registration of Trademarks was signed at Madrid on 14 April 1891. It was revised at Brussels on 14 December 1900, at Washington on 2 June 1911, at the Hague on 6 November 1925, at London on 2 June 1934, at Nice on 15 June 1957, Stockholm on 14 July 1967 and amended in 1979.

This Agreement provides for the registration of trademarks, including service marks. Registration effected under the Agreement are called "International" as every registration has effect in several countries, potentially in all the member countries of the Madrid Union. As on 1 January 1995 it had 43 states as members. India is not a party to this agreement.

**Hague Agreement concerning the International Deposit of Industrial Designs**

This Agreement was signed on 6 November 1925 at Hague and came into force on 1 June 1928, revised in London on 2 June 1934, at Hague on 28 November 1960, and at Stockholm on 14 July 1967, by the Protocol of Geneva 1975 and amended in 1979.

The main advantage of this Agreement is that by a single international deposit of an industrial design it can be protected in many countries thereby cost is minimized and the cost of deposit is also modest. As on 1 January 1995, it had 25 states as members. India is not a party to this agreement.

**Nice Agreement concerning the International Classification of Goods & Services for the Registration of Marks (Nice Union)**

This Agreement was signed on 15 June 1957 at Nice and was brought into force on 8 April

This Agreement provides for the classification of goods and services for the registration of trademarks and service marks. India is not a party to this agreement. As on 1 January 1995 it had 42 states as members. India is not a party to this agreement.

**Lisbon Agreement for the Protection of Appellations of Origin & their International Registration (Lisbon Union)**

This Agreement was signed at Lisbon on 31 October 1958, revised at Stockholm on 14 July 1967 and amended in 1979. This Agreement provides for the protection of Appellations of origin, that is, "geographical name of the countries, region or locality" which serve to designate a product originating therefrom, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors. As on 1 January 1995, it had 17 states as members. India is not a party to this agreement.

**Locarno Agreement Establishing an International Classification for Industrial Designs (Locarno Union)**

This Agreement was signed on 8 October 1968 and amended in 1979. It provides for a classification of goods in which industrial designs are incorporated. This classification, which comprises a list of classes and subclasses and an alphabetical list of goods, will be used by contracting states for registering national deposits.

As on 1 January 1995, 23 states were party to this agreement as well as members. India is not a party to this agreement.

**Patent Cooperation Treaty (PCT)**

PCT is a Convention which came into force in 1978. As on 1 January 1995, there were 77 countries members to the Treaty. Like many other Treaties, this Treaty is also open to the members of Paris Convention only.

The PCT is not a Convention dealing with the substantive requirements of patent law as each signatory determines the patentability of the invention under its own domestic law. The PCT is concerned with procedural requirements only so as to simplify the filing, searching for novelty and publishing of international patent applications. By filing an application for patent under PCT, multiple filing can be eliminated consequently avoiding duplicate filing costs.

PCT does not contain any definition of patentable subject matter. Therefore any invention that is patentable under the laws of the member country may be made the subject matter of an international patent application under PCT. Further the PCT does not contain any requirement regarding the deposit of microorganisms or the description of the characteristics of a deposited microorganisms. The procedural steps under the PCT are carried out in two stages, international stage and national stage.

The international stage begins when an applicant files the international patent application with one of the receiving offices, generally the national Patent Office of the country in which the applicant is resident or national. An international search is then conducted by an appropriate International Searching Authority (ISA). Following the international search the application is sent to the International Bureau, the WIPO in Geneva which then publishes the application and provides copies to each of the designated offices in the countries where protec-
tion is sought. The applicant then provides to each of the offices of the designated countries the translation as is necessary and required national fees to commence the national stage.

The application is then subjected to the national procedures in each of the designated countries. In view of the non-patentability of certain inventions such as plant and animal varieties in several member countries of PCT, International Searching Authority is not required to provide an international search report if such inventions are the subject matter of the international application.

Since India is not a member of Paris Convention, it cannot take advantages from this Treaty.

**Strasbourg Agreement concerning the International Patent Classification (IPC Union)**

This Agreement provides for an International Patent Classification. It was established on 24 March 1971. As on 1 January 1995, it had 29 states as members. India is not a party to this agreement.

**Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks (Vienna Agreement)**

This Agreement was signed on 12 June 1973 and amended in 1985. The country members of this Agreement have formed a special Union and adopted a common classification for the figurative elements of marks. The classification has no effect in respect to the extent of protection afforded to the mark. It has 5 states as members.

**Budapest Treaty on the International Recognition of the deposit of microorganisms for the purposes of patent procedure (Budapest Treaty)**

Patent laws revolve around the central concept of a written specification describing the invention to be protected. Sufficiency of disclosure is the foundation of bargain between an inventor and the patent granting authority and if it is lacking the defect cannot be normally rectified by the incorporation of the required information at the stage when the requirement is challenged.

In respect of inventions in the field of biotechnology, the patent law has to cope up with the fact that the insufficiency of the written description is inherent in these types of inventions and is not due to lack of drafting skill on the part of inventor or the good faith on the part of the applicant or the inventor.

To meet the requirement of sufficiency of description in the law in the field of inventions relating to biotechnology, particularly involving the use of biological materials such as strains, microorganisms etc. which are difficult to describe in words, the practice of required deposits of such biological materials in a depository institution has been developed. The deposit makes supplement to the details given in the written patent specification and also provide a source from which samples of the biological material can be procured by the persons wishing to make practical use of the invention by observing the prescribed procedure.

Due to rapid development taking place in the field of biotechnology interest in securing patents for the invention has gained importance. Consequently many applicants wishing to file applications for patents in this field involving the use of biological materials face many problems such as:

- a. lack of information about national law, particularly regarding requirements
governing the use of biological materials;

b. lack of uniformity of such national requirements;

c. fact that certain national laws require a deposit to be made within that country, even in the case of applications claiming priority based upon a first filed application in another country where a deposit has already been made.

To solve these difficulties, the Budapest Treaty was brought into force in 1980. The Treaty provides that member countries should recognise for their own patent procedures a deposit made in another country.

The backbone of the Treaty is provision of series of International Depository Authorities (IDA). For qualifying as an IDA, a depository institution must be located in the territory of a member country and should have assurances that the institution complies with the requirements essential for it to permanently carry out its tasks under the Treaty. As on 1 January 1995, a total of 26 Depository institutions have acquired IDA status. There are 7 such recognised depositaries in UK, 3 each in Republic of Korea and Russian Federation, two in USA and one each Australia, Belgium, Bulgaria, Czech Republic, France, Germany, Hungary, Netherlands, Spain and Slovakia.

The most important aspect of the Treaty is the provision for recognition by all members, the deposit in a single IDA. The deposit may be made in any IDA and once the deposit is made two facts are recognised viz:

a. the deposit was made on the indicated date;

b. any sample furnished by IDA is the sample which was deposited on that date.

As on 1 January 1995, there were 34 country members to the Treaty. The Treaty is administered by WIPO. Since India is not a member of the Paris Convention, it cannot become a party to the Treaty.

International Convention for the protection of new varieties of plants (UPOV Convention)

Seed and planting materials are critical inputs for agriculture. Continuous genetic upgradation of plant varieties and hybrids are very essential to meet the growing needs. It is also necessary to provide adequate incentive to the scientists/institutions and appropriate protection for the result achieved thereby. Due to the recognition of these aspects and the growing needs of improved seeds and planting materials, issues relating to plant breeders' rights, plant variety protection etc. are being raised more often now than before.

An international organization "International Association of Plant Breeders for Plant Variety Protection (ASSINSEL) was established in 1938. The main objective of the Association is to persuade the different governments to introduce legislations to protect the rights of plant breeders so as to provide them reasonable returns for the investment they have made in breeding new varieties. On 2 December 1961, an International Convention for the protection of New Varieties of Plant (UPOV) was signed in Paris by some European Countries and the Convention was revised in 1972, 1978 and 1991. The purpose of this Convention is to stimulate plant breeding to increase agricultural production by encouraging plant breeders and
to provide the plant breeders the legal rights therefor.

The Convention, accordingly, established an International Union which has 27 states as its members as on 1 January 1995. The member countries are Argentina, Australia, Austria, Belgium, Canada, Czech Republic, Denmark, Finland, France, Germany, Hungary, Ireland, Israel, Italy, Japan, Netherlands, New Zealand, Norway, Poland, Slovakia, S. Africa, Spain, Sweden and Switzerland, United Kingdom, USA and Uruguay. The national laws of these countries provide for the grant rights for plant breeders. The headquarter of the Union is at Geneva and it is administered by WIPO.

Under the Convention, each member state of the Union may recognize the rights of the breeder by the grant either of a special title of protection or of a patent. In the case of a member state of the Union whose national law admits for protection under both these forms, may provide only one of them for one and the same botanical genus or species. Further, each member state of the Union may limit the application of this Convention within a genus or species to varieties with a particular manner of reproduction or multiplication or a certain end use. The Convention may be applied to all botanical genera or species. The right granted to the breeder under the Convention is that his prior authorisation shall be required for: (a) the production for commercial marketing; (b) offering for sale; and (c) marketing of the reproductive or vegetative propagating material as such of the variety.

Vegetative propagating material shall be deemed to include whole plants. The right of the breeder shall extend to ornamental plants or parts thereof normally marketed for purposes other than propagation when they are used commercially as propagating material in the production of ornamental plants or cutflowers.

Authorisation by the breeder shall not be required either for the utilization of the variety as an initial source of variety for the purpose of creating other varieties or for the marketing of such varieties. Such authorisation shall be required, however, when the repeated use of the variety is necessary for the commercial production of another variety. The free exercise of the exclusive right accorded to the breeder may not be restricted other than for reasons of public interest. The rights conferred on the breeder may not be less than 15 years from the date of issue of the title of protection. For vines, forest trees, fruit trees and ornamental trees, including in each case, their root stocks, the period of protection may not be less than 18 years from the said date.

**Berne Conventions on Copyright (BCC)**

International Protection to literary and artistic works is regulated by two conventions namely Berne Convention (1886) and Universal Copyright Convention (1952). Nearby 111 countries are the members of the Berne Convention (BC) and 95 countries constitute the Universal Copyright Convention (UCC). Berne Convention is administered through WIPO while the Universal Copyright Convention through UNESCO.

The Convention provides for National Treatment i.e. a country must give the same treatment to the Nationals of other countries as it gives to its own and provides for certain minimum standards of protection.

India is a member of both the Conventions and therefore works first published outside India in any of the convention countries enjoy protection in India.
Nairobi Treaty on the Protection of Olympic Symbol (Nairobi Treaty)

Thirty-six states and India are the members of the Treaty.

Other Treaties administered by WIPO

- Convention for the Protection of Producers of Phonograms and against unauthorised duplication of their Phonograms (Geneva, 1971)
  
  Member states: 52 including India

  
  Member states: 47

- Convention relating to Distribution of Programme carrying signals transmitted by satellite (Brussels, 1974)
  
  Member states: 19

- Treaty on International Registration of Audiovisual Works (Geneva, 1989)
  
  Member states: 12

Treaties not yet in force

  
  Signatory states: 8 including India.

- Protocol relating to the Madrid Agreement concerning the International Registration of Marks (1989)
  
  Signatory states: 27

- Trademarks Law Treaty (Geneva, 1994)
  
  Signatory states: 29

Some Important Conventions not administered by WIPO

European Patent Convention

The European Patent Convention (EPC) was drafted in 1963 and brought into force on 7 October 1977. As on 1 January 1995, there were 17 European countries which were members of the Convention.

The EPC is administered by the European Patent Office situated one in Munich, Germany and the other in Hague, The Netherlands. The office at The Hague is responsible for conducting search for ascertaining the novelty of the invention disclosed in an European patent application. The office at Munich carries out the examination of the patent applications based on the search report issued by the office at the Hague and considers the patentability of the invention under the Convention.

The grant of a European patent does not result in the existence of a single unitary patent covering the whole of the territories of the designated countries, but rather leads to a bundle of national patents, each being governed by the same provisions of as a national patent granted directly in the countries concerned.

The advantage of filing an application under the Convention is to reduce the cost of obtaining patent protection by avoiding duplication of efforts in filing, searching to ascertain the novelty of the invention and the examination of the application, minimising thereby the number of translations required. It also helps in economising the use of professional time both on the part of the applicants, domestic patent representatives and those located in the countries where protection is desired. It requires the filing of only a single application
where the names of the countries where protection is required are designated.

There is only single examination in respect of all the countries where protection is required and there is no requirement of filing in the language of the countries concerned. The language may be English, German, or French.

Notwithstanding the provisions of the national laws of the member states designated in a European patent, the patent issued under the Convention will have a duration of 20 years from the date of filing the application, except for extension under the national laws on account of a state of war or other similar emergency conditions.

**Universal Copyright Convention (UCC)**

International Protection to literary and artistic works is regulated by two conventions namely Berne Convention (1886) and Universal Copyright Convention (1952) and revised at Paris in 1971. Ninety-five countries are members of the Universal Copyright Convention (UCC). UCC has been, mainly, formed by USA, USSR and Latin American countries and is administered through UNESCO.

The Convention provides for National Treatment i.e. a country must give the same treatment to the nationals of other countries as it gives to its own. UCC provides a minimum term of protection i.e. the life of author plus 25 years and 10 years for photographs and for works of applied art.

India is a member of both the Conventions and therefore works first published outside India in any of the convention countries enjoy protection in India. Under the provision of UCC published works, if first published outside the territory of a member state and not being the work of a national author should be given such protection without formality, without registration or deposit of copies, provided all copies of the work bear the symbol @ accompanied by the name of the owner of the copyright and the year of first publication. The convention will not apply to those works which are permanently in the public domain in the state in which protection is sought.

**The African Intellectual Property Convention (OAPI)**

It has 14 African states as members.

**The African Regional Industrial Property Organisation (ARIPO)**

It has 14 states as members. The difference between these two African Intellectual Property Organisations is that a single application in the case of OAPI should designate all the member states whereas in the case of ARIPO, it is possible to designate only selected countries.

**The Cartagena Agreement Legislation on Industrial Property**

This Agreement has been formulated for Latin American countries and is in force in Bolivia, Colombia, Ecuador, Peru and Venezuela from May, 1987. The objective of the agreement is to provide common treatment by the member states to foreign capital, trademarks, patents, licence agreements and royalties.

**List of State Members to WIPO, Paris Convention and European Patent Convention**

**World Intellectual Property Organisation (WIPO)**

Albania, Algeria, Andorra, Angola, Argentina, Armenia, Australia, Austria, Bahamas,
Bangladesh, Belarus, Barbados, Belgium, Benin, Bhutan, Bolivia, Bosnia-Herzegovina, Brazil, Brunei, Bulgaria, Burkina Faso, Burundi, Cameroon, Canada, Central African Republic, Chad, Chile, China, Colombia, Congo, Costa Rica, Cote d'Ivoire, Croatia, Cuba, Cyprus, Czech Republic, Democratic People's Republic of Korea, Denmark, Ecuador, Egypt, El Salvador, Estonia, Fiji, Finland, France, Gabon, Gambia, Georgia, Germany, Ghana, Greece, Guatemala, Guinea, Guinea-Bissau, Haiti, Holy See, Honduras, Hungary, Iceland, India, Indonesia, Iraq, Ireland, Israel, Italy, Jamaica, Japan, Jordan, Kazakhstan, Kenya, Kyrgyzstan, Laos, Latvia, Lebanon, Lesotho, Liberia, Libya, Liechtenstein, Lithuania, Luxembourg, Madagascar, Malawi, Malaysia, Mali, Malta, Mauritania, Mauritius, Mexico, Monaco, Mongolia, Morocco, Namibia, Netherlands, New Zealand, Nicaragua, Niger, Nigeria, Norway, Pakistan, Panama, Paraguay, Peru, Philippines, Poland, Portugal, Qatar, Republic of Korea, Republic of Moldova, Romania, Russia, Rwanda, St Lucia, San Marino, Saudi Arabia, Senegal, Sierra Leone, Singapore, Slovakia, Slovenia, Somalia, South Africa, Spain, Sri Lanka, Sudan, Suriname, Swaziland, Sweden, Switzerland, Tajikistan, Thailand, Macedonia, Togo, Trinidad and Tobago, Tunisia, Turkey, Uganda, Ukraine, United Arab Emirates, United Kingdom, United Republic of Tanzania, United States of America, Uruguay, Uzbekistan, Venezuela, Vietnam, Yemen, Yugoslavia, Zaire, Zambia, Zimbabwe.

**European Patent Convention**

Austria, Belgium, Denmark, France, Germany, Greece, Ireland, Italy, Liechtenstein, Luxembourg, Monaco, Netherlands, Portugal, Spain, Sweden, Switzerland, United Kingdom.