

**CHAPTER 68:03**  
**INDUSTRIAL PROPERTY**  
ARRANGEMENT OF SECTIONS

SECTION

PART I  
*Preliminary*

1. Short title
2. Interpretation
3. Establishment of Marks, Patents and Designs Office
4. Registrar, Deputy Registrar and Assistant Registrars of Marks, Patents and Designs
5. Powers and functions of Registrar
6. Seal of office
7. Registers for patents, etc.

PART II  
*Patents*

8. Patentable inventions
9. Matter excluded from patent protection
10. Who may apply for a patent
11. Right to patent
12. Transfer of rights to a patent
13. Application for a patent
14. Amendment of application
15. Unity of invention
16. Division of application
17. Joint applicants
18. Right of priority
19. Conversion of patent application into application for utility model certificate
20. Information concerning corresponding foreign applications for patents
21. Filing date of application for a patent
22. Examination of applications
23. Grant of patent
24. Rights conferred by patent
25. Proceedings for infringement
26. Restriction on recovery of damages for infringement
27. Duration and maintenance of patent
28. ARIPO Protocol patents
29. Joint ownership of patent
30. Exploitation by Government or person thereby authorized
31. Compulsory licences
32. Termination of contracts relating to licences
33. Invalidation of patent

PART III  
*Utility Model Certificates*

34. Applicability of provisions relating to patents
35. Qualification of invention for utility model certificate
36. Duration of utility model certificate
37. Invalidation of utility model certificate
38. Conversion of application for utility model certificate into application for patent

PART IV  
*Industrial Designs*

39. Registrable industrial design

40. Right to industrial design
41. Transfer of right to a design
42. Application for registration of design
43. Right of priority
44. Filing date of application
45. Examination of application
46. Registration of design
47. Rights conferred by registration
48. Proceedings for infringement
49. Duration and renewal of registered of design
50. ARIPO Protocol designs
51. Inspection of registered design
52. Invalidation of registration of design

#### PART V

##### *Marks, Collective Marks and Trade Names*

53. Acquisition of exclusive right to a mark
54. Application for registration of a mark
55. Examination of application for registration of a mark
56. Opposition to registration of a mark
57. Registration of mark
58. Rights conferred by registration of mark
59. Transfer of rights in marks
60. Proceedings for infringement
61. Duration and renewal of registration of mark
62. Banjul Protocol on marks
63. Invalidation of registration of mark
64. Removal of mark on grounds of non-use
65. Collective marks
66. Invalidation of registration of collective mark
67. Licensing of marks and collective marks
68. Trade names

#### PART VI

##### *Acts of Unfair Competition*

69. Acts of unfair competition

#### PART VII

##### *Miscellaneous Provisions*

70. Changes in ownership
71. Licence contracts
72. Agents
73. Correction of errors
74. Exercise of discretionary powers
75. Extension of time for applications
76. Offences
77. Appeals
78. Regulations
79. Repeal
80. Transitional

First Schedule - Paris Convention for the Protection of Industrial Property  
Second Schedule - Agreement on Trade-Related Aspects of Intellectual Property Rights

**An Act to provide for the protection of industrial property in Botswana, and for matters related thereto.**

[Date of Commencement: 27th August, 1996]

**PART I**  
**Preliminary (ss 1-7)**

**1. Short title**

This Act may be cited as the Industrial Property Act.

**2. Interpretation**

In this Act, unless the context otherwise requires-

"**ARIPO**" means the African Regional Industrial Property Organization;

"**ARIPO Protocol**" means the Protocol on Patents and Industrial Designs Within the Framework of ARIPO of 10th December, 1982;

"**Banjul Protocol**" means the Banjul Protocol on Marks of 27th April, 1994;

"**collective mark**" means any visible sign designated as such in the application for registration and capable of distinguishing the origin or other common characteristic, including the quality, of goods or services of different enterprises which use the sign subject to the control of the registered owner thereof;

"**convention country**" means a country which is a party to the Paris Convention;

"**foreign application**" means any application for a patent or other title of protection filed by that applicant outside Botswana;

"**industrial design**" means any composition of lines or colours or any three dimensional form, whether or not associated with lines or colours, which composition or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft, provided that it does not consist of anything which serves to obtain a technical result and leaves no freedom as regards arbitrary features of appearance;

"**integrated circuit**" means a circuit, in its final or an intermediate form, in which the elements, at least one of which is an active element, and some or all of the interconnections are integrally formed in or on a piece of material and that is intended to perform an electronic function;

"**International Classification**" means, unless otherwise indicated, the classification according to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, of June 15, 1957, as last revised;

"**International Patent Classification**" means the classification according to the Strasbourg Agreement of March 24, 1971;

"**invention**" means an idea of an inventor which permits in practice the solution to a specific problem in the field of technology;

"**journal**" means the journal of marks, patents and designs referred to in section 5(e);

"**mark**" means any visible sign capable of distinguishing the goods or services of an enterprise;

"**Master**" means the Master of the High Court;

"**Minister**" means the Minister of Commerce and Industry;

"**Paris Convention**" means the Paris Convention for the Protection of Industrial Property of March 20, 1883, as last revised;

"**patent**" means a title granted to protect an invention under this Act;

"**patentee**" means the person to whom a patent has been granted under this Act;

"**priority date**" means the date of the earlier application that serves as the basis for the right of priority provided for by Article 4 of the Paris Convention set out in the First Schedule

hereto;

**"Registrar"** means the Registrar of Marks, Patents and Designs appointed under section 4;

**"right of priority"** means the right of priority provided for in Article 4 of the Paris Convention;

**"trade name"** means the name or designation by which a business or enterprise is distinguished; and

**"utility model certificate"** means a certificate granted for an invention in accordance with section 35.

### **3. Establishment of Marks, Patents and Designs Office**

There shall be established, at such place as the Minister may determine, a Marks, Patents and Designs Office.

### **4. Registrar, Deputy Registrar and Assistant Registrars of Marks, Patents and Designs**

(1) There shall be a Registrar of Marks, Patents and Designs (referred to in this Act as "the Registrar") who shall be a public officer, and who shall, subject to the control of the Minister, be responsible for the administration of this Act, and who shall perform such functions and exercise such powers as may be conferred on him by this Act or any other enactment.

(2) The Registrar shall be appointed in accordance with the provisions of the Public Service Act.

(3) There shall also be a Deputy Registrar of Marks, Patents and Designs, and such number of Assistant Registrars as it may be considered necessary to appoint, who shall also be public officers and who shall, likewise, be appointed in accordance with the provisions of the Public Service Act.

(4) The Deputy Registrar and Assistant Registrars shall perform such functions and exercise such powers as the Registrar may lawfully perform or exercise under this Act or any other enactment.

### **5. Powers and functions of Registrar**

Without derogating from the generality of the provisions of section 4, the Registrar shall have the following functions and powers, namely to-

- (a) process all applications made in terms of this Act;
- (b) grant patents and utility model certificates;
- (c) register industrial designs, marks and collective marks;
- (d) administer granted patents and utility model certificates and registered industrial designs, marks and collective marks;
- (e) establish and maintain a journal of marks, patents and designs in which he shall publish all matters that are required to be published under this Act.

### **6. Seal of office**

The Registrar shall have a seal of office which shall be affixed to every document issued or granted by him, and to any copy of a document issued by him in lieu of the original document.

### **7. Registers for patents, etc.**

(1) The Registrar shall maintain separate registers for patents, utility model certificates, industrial designs and marks and shall, in a section of the register of marks created for that purpose, also register collective marks.

(2) In the registers referred to in subsection (1) shall be entered such particulars as are required by this Act or such further particulars as the Minister may, by regulations, prescribe.

(3) Any person may, upon payment of the prescribed fee, and in accordance with any conditions which may be prescribed, consult, inspect or make a copy of, or obtain an extract from, any register referred to in subsection (1).

## **PART II**

### ***Patents (ss 8-33)***

### **8. Patentable inventions**

(1) An invention shall be patentable if it is new, involves an inventive step, and is industrially applicable.

(2) An invention may be, or may relate to, a product or a process.

(3) An invention is considered to be new if it does not form part of prior art.

(4) (a) For the purposes of this Act, prior art, in relation to an invention, means anything which has been disclosed to the public, whether in Botswana or elsewhere, in a tangible form or orally, or by use or in any other way, prior to the filing or priority date of the application claiming the invention.

(b) Disclosure of information which would otherwise affect the patentability of an invention claimed in the application shall not affect the patentability of that invention where the information was disclosed during the twelve months preceding the filing date or, where priority is claimed, the priority date of the application-

(i) by the inventor; or

(ii) by a third party which obtained the information directly or indirectly from the inventor.

(5) An invention shall be considered as involving an inventive step if, having regard to the prior art relevant to the application claiming the invention as defined in subsection 4(a), it would not have been obvious to a person having ordinary skill in the art.

(6) An invention shall be considered as being industrially applicable if it can be used in trade, or in any kind of industry including handicraft, agriculture, fishery and services.

(7) An invention which is contrary to public order or morality shall not be patentable.

## **9. Matter excluded from patent protection**

(1) For the purposes of this Act, the following shall, even if they are inventions, not be protected as patents-

(a) a discovery;

(b) a scientific theory or mathematical method;

(c) a literary, dramatic, musical or artistic work or other aesthetic creation;

(d) a scheme, rule or method for doing business, performing a mental act or playing a game;

(e) a program for a computer;

(f) diagnostic, therapeutic and surgical methods for the treatment of humans and animals.

(2) The provisions of subsections (1)(f) and (g) shall not apply to any product for use in the methods referred to therein.

## **10. Who may apply for a patent**

(1) An application for a patent in respect of an invention may be made by the inventor or by any other person who has acquired from the inventor the right to apply.

(2) Unless otherwise agreed, joint inventors may apply for a patent in equal undivided shares.

## **11. Right to patent**

(1) The right to a patent shall belong to the inventor.

(2) If two or more persons have made an invention jointly, the right to the patent shall belong to them jointly.

(3) Where two or more persons have made the same invention but independently of each other, the person whose application bears the earliest filing date, or, if priority is claimed, the person whose application bears the earliest validly claimed priority date shall, unless that application is abandoned or withdrawn by the applicant, or rejected by the Registrar, have the right to the patent.

(4) Where an invention is made in execution of a contract of employment, the right to the patent shall, in the absence of any agreement to the contrary, belong to the employer.

(5) The inventor shall be named as such in the patent, unless, in a special declaration in writing signed by him and addressed to the Registrar, he indicates that he wishes not to be

named, and any promise or undertaking by the inventor made to any person to the effect that he will make such a declaration shall be without legal effect.

#### **12. Transfer of rights to a patent**

The right to a patent may be transferred by cession, assignment, testamentary disposition or by operation of law.

**13. Application for a patent** (1) Every application for a patent shall be filed with the Registrar and shall contain a request, a description, one or more claims, drawings (where required by the Registrar in terms of subsection (5)) and an abstract in the prescribed form, and shall be accompanied by such fee as may be prescribed.

(2)(a) The request shall contain a petition that a patent be granted, the name of and other prescribed information concerning the applicant, the inventor and the agent, if any, and the title of the invention.

(b) Where the applicant is not the inventor, the request shall be accompanied by a statement justifying the applicant's right to the patent.

(3) The description shall disclose the invention in a manner which is sufficiently clear and complete to permit a person having ordinary skill in the art to carry out the invention, and shall indicate at least one mode known to the applicant in which the invention can be performed.

(4)(a) The claim or claims shall define the matter for which protection is sought, and the description and any drawings filed may be used to interpret such claim or claims.

(b) The claims shall be clear and concise and shall be fully supported by the description.

(5) The Registrar may require an applicant to file drawings where these are necessary for the understanding of the invention.

(6) The abstract shall not be taken into account for the purpose of interpreting the scope of the protection; it shall merely serve as technical information.

(7) An applicant may, at any time before the patent is granted, withdraw his application.

#### **14. Amendment of application**

(1) The applicant may, of his own initiative at any time before the grant of a patent, amend or correct his application.

(2) The applicant shall not, in amending his application under this section, include any material matter which was not disclosed in the initial application as filed.

#### **15. Unity of invention**

(1) An application for a patent shall be in respect of a single invention or, where it is in respect of a group of inventions, the inventions shall be so linked as to form a single general inventive concept.

(2) The fact that a patent has been granted on an application that did not comply with the requirement of unity of invention shall not be a ground for the invalidation or revocation of the patent.

#### **16. Division of application**

(1) The applicant may, at any time before the grant of a patent, divide his application into two or more applications (hereinafter referred to as "divisional applications"), but each divisional application shall not include any matter which was not disclosed in the initial application as filed.

(2) Each divisional application shall be accorded the same filing date and, where applicable, the same priority date, as the initial application.

#### **17. Joint applicants**

Where two or more persons apply jointly for a patent, they shall, in the absence of an agreement to the contrary, have equal undivided shares in the application and none of them shall deal with the application in any way without the consent of the other applicant or applicants:

Provided that if any steps are required to be taken to save the application from being abandoned, any applicant may, on his own behalf as well as on behalf of any other joint applicant, take such steps without recourse to the other applicant or applicants.

## **18. Right of priority**

(1) An application made under this Part may contain a declaration, in writing, claiming the priority, as provided for in Article 4 of the Paris Convention set out in the First Schedule hereto, of one or more earlier national, regional or international applications filed by the applicant or his predecessor in title in any convention country.

(2) Any person who makes a declaration of priority under subsection (1) shall, within such time as may be prescribed, furnish the Registrar with a copy of the application earlier filed which copy shall be certified as correct by the patent office with which it was so earlier filed.

(3) Where an applicant does not satisfy the requirements of subsection (2) and any regulations pertaining thereto, the declaration shall be considered as having not been made.

(4) The effect of the declaration referred to in subsection (1) shall be as provided in Article 4 of the Paris Convention.

## **19. Conversion of patent application into application for utility model certificate**

(1) At any time before the grant or refusal of a patent, an applicant for a patent may, upon payment of the prescribed fee, convert his application for a patent into an application for a utility model certificate.

(2) No person may convert an application under subsection (1) more than once.

## **20. Information concerning corresponding foreign applications for patents**

(1) The applicant shall, if requested by the Registrar, furnish him with the date and number of any applications filed by him outside Botswana relating to the same or essentially the same invention as that claimed in the application filed with the Registrar.

(2) That applicant shall also, if requested by the Registrar, furnish him with the following documents relating to one of the applications referred to in subsection (1)-

- (a) a copy of any communication received by the applicant concerning the results of any search or examination carried out in respect of the said application;
- (b) a copy of the patent or other title of protection granted in respect of that application;
- (c) a copy of any final decision rejecting the application or refusing the grant requested in respect of the application; and
- (d) a copy of any final decision revoking or invalidating the patent or other title of protection granted in respect of that application.

## **21. Filing date of application for a patent**

(1) The filing date of an application for a patent shall be the date on which the application is received by the Registrar:

Provided that at the time of its receipt, the application contains-

- (i) an express or implicit indication that the grant of a patent is sought;
- (ii) information which will enable the Registrar to establish the identity of the applicant; and
- (iii) information which, on the face of it, appears to be a description of the invention.

(2) Where the application does not comply with the requirements of subsection (1), the Registrar shall, in writing, request the applicant to supply him with information lacking in the application and shall accord to the application, as the filing date, the date on which the further information required is received by him.

(3) If an applicant fails to comply with any request made by the Registrar under subsection (2), his application shall be treated as though it had never been filed.

(4) Where the application makes reference to drawings which are not included in the application, the Registrar shall request the applicant to furnish him with the drawings within such time as may be prescribed, and shall accord to the application, as the filing date, the date on which such drawings are received by him.

(5) If the applicant fails to comply with any request made by the Registrar under subsection (4), the Registrar shall accord to the application, as the filing date, the date on which the application was received by him, and shall treat any reference to the said drawings as being

non-existent.

**22. Examination of applications** (1) After according a filing date, the Registrar shall examine whether the application complies with the requirements of section 13(1) and (2) and the regulations pertaining thereto, and with those requirements of this Act and the regulations which are designated by the regulations as formal requirements for the purposes of this Act, and whether the information requested under section 20, if any, has been provided.

(2) Where the Registrar is of the opinion that the application complies with the requirements indicated in subsection (1), he shall cause the application to be examined to determine whether the claimed subject matter constitutes an invention in terms of section 2 and whether the requirements of sections 8, 9, 13(3), 13(4), 13(5) and 15, and the regulations pertaining thereto have been satisfied.

(3) The Minister may, by regulations, prescribe the categories of inventions in respect of which an examination under this section shall not cover the requirements of novelty and inventive step.

### **23. Grant of patent**

(1) Where the Registrar is satisfied that the requirements of section 22 have been fulfilled, he shall grant the applicant a patent; otherwise he shall refuse the application and notify the applicant of that decision.

(2) Where he grants a patent, the Registrar shall-

- (a) issue a certificate of the grant of the patent and a copy of the patent to the applicant;
- (b) record the said patent in the patent register; and
- (c) publish, in the Journal, a reference to the grant of the patent.

(3) The Registrar shall, on payment of such fee as may be prescribed, make a copy of any patent granted in terms of this section available to any person who requests such copy.

(4) The Registrar shall, upon the request of the owner of the patent, make changes in the text or drawings of the patent in order to limit the extent of the protection conferred thereby.

### **24. Rights conferred by patent**

(1) No person shall exploit, in Botswana, an invention patented in Botswana unless he has been authorised, in writing, to do so by the owner of that patent.

(2) For the purposes of this section, exploitation of a patented invention means-

- (a) where the patent has been granted in respect of a product-
  - (i) making, importing into Botswana, offering for sale, selling and using that product;
  - (ii) stocking such product for the purposes of offering it for sale or selling or using it; and
- (b) where the patent has been granted in respect of a process-
  - (i) using that process; and
  - (ii) doing any act referred to in paragraph (a) in respect of a product obtained directly by means of that process.

(3) (a) The rights under the patent shall not extend to-

- (i) acts in respect of articles which have been put on the market in Botswana by the owner of the patent or with his consent;
- (ii) the use of articles on aircraft, land vehicles or vessels of other countries which temporarily or accidentally enter the airspace, territory or waters of Botswana,
- (iii) acts done only for experimental purposes relating to a patented invention; or
- (iv) acts performed by any person who in good faith, before the filing or, where priority is claimed, the priority date of the application on which the patent is granted and in Botswana, was using the invention or was making effective and serious preparations for such use.

(b) The right of prior user referred to in paragraph (a)(iv) may be transferred or may devolve only together with the enterprise or business, or with that part of the enterprise or business, in which the use of preparations for use have been made.



## **25. Proceedings for infringement**

(1) The owner of the patent shall, in addition to any other rights, remedies or actions available to him, have the right, subject to sections 26, 30 and 31, to institute court proceedings against any person who infringes the patent by performing, without his agreement or authorization, any of the acts referred to in section 24(2), or who performs any act which makes it likely that infringement will occur.

(2) A plaintiff in proceedings for infringement shall be entitled to relief by way of-

- (a) an interdict;
- (b) delivery up or destruction of any infringing product, article or product of which the infringing product forms an inseparable part;
- (c) damages; or
- (d) an account of the profits derived from the infringement.

(3) The court shall not, in awarding damages under this section, also order, in respect of the same infringement, that the plaintiff be given an account of the profits derived by him from the infringement.

(4) In any proceedings for infringement, the defendant may counterclaim for the invalidation of the patent and, by way of defence, rely upon any ground on which a patent may be invalidated.

(5) In any proceedings under this section, the plaintiff shall, before he institutes the proceedings, give notice thereof to every licensee under the patent in question whose name is recorded in the patent register, and any such licensee shall be entitled to intervene as co-plaintiff.

(6)(a) In any proceedings for infringement, other than criminal proceedings, where the subject matter of the patent is a process for obtaining a product, the burden of establishing that the product was not made by the process shall rest on the defendant if-

- (i) the product is new; or
- (ii) a substantial likelihood exists that the product was made by the process and the owner of the patent has been unable, through reasonable efforts, to determine the process used.

(b) In requiring the production of evidence, the court shall take into account the legitimate interests of the defendant in not disclosing his manufacturing secrets.

(7) The court shall, in awarding damages under this section, calculate such damages taking into account the amount of a reasonable royalty which would have been payable by a licensee or sublicensee in respect of the patent concerned.

## **26. Restriction on recovery of damages for infringement**

A patentee shall not be entitled to recover damages or to obtain an account of profits in respect of a patent, from a defendant who proves that at the date of the infringement he was not aware, and had no reason to be aware, of the existence of the patent, and the marking of an article with the word "patent" or "patented" or any word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed on or otherwise applied to the article, shall not be deemed to constitute notice of the existence of the patent unless such word or words are accompanied by the number of the patent:

Provided that nothing in this section shall affect any proceedings for an interdict in respect of the patent in question.

## **27. Duration and maintenance of patent**

(1) Subject to subsection (2), a patent shall expire 20 years after the filing date thereof.

(2) In order to maintain a patent or patent application, the owner of a patent or the applicant shall pay in advance to the Registrar for each year starting one year after the filing date of the application for the grant of the patent, such annual maintenance fee as may be prescribed.

(3) A patent shall lapse or a patent application shall be deemed to have been withdrawn

if the owner thereof fails to comply with the provisions of subsection (2):

Provided that where the owner of the patent is late paying the annual maintenance fee, the Registrar shall, upon the payment by such owner of such surcharge as may be prescribed, give him a period of grace not exceeding six months, within which he must pay the said late annual maintenance fee.

## **28. ARIPO Protocol patents**

A patent in respect of which Botswana is a designated State, granted by ARIPO by virtue of the ARIPO Protocol, shall have the same effect and enjoy the same protection in Botswana as a patent granted under this Act unless the Registrar communicates, to ARIPO, in respect of the application therefor, a decision, in accordance with the provisions of the Protocol, that if a patent is granted by ARIPO, that patent shall have no effect in Botswana.

## **29. Joint ownership of patent**

(1) Where a patent is granted to two or more persons jointly, each of the joint patentees shall, in the absence of an agreement to the contrary, be entitled to an equal undivided share in the patent.

(2) Subject to the provisions of subsection (4), a joint patentee shall not be entitled, in the absence of an agreement to the contrary, and in the absence of the consent of the joint patentee or patentees, to-

- (a) make, use, exercise or dispose of the patented invention;
- (b) grant a licence or assign the whole or any part of his interest in the patent; or
- (c) take any steps or institute any proceedings relating to the patent:

Provided that he may pay any annual maintenance fee which is payable without recourse to any other patentee.

(3) Where a patented article is disposed of by a joint patentee, the person who acquires the patent, or any person making a claim through him shall be entitled to deal with that article in the same manner as though the article had been disposed of by the patentees jointly.

(4) Any joint patentee may institute proceedings for infringement and shall give notice thereof to any other joint patentee, and any such other patentee may intervene as co-plaintiff and recover any damages in respect of any damage he may have suffered as a result of the infringement.

(5) If, in any proceedings under subsection (4), damages are awarded to a plaintiff, he shall be awarded damages as if he were the sole patentee, and the defendant shall not be obliged to compensate any other patentee in respect of the infringement in question.

## **30. Exploitation by Government or person thereby authorized**

(1) Where-

- (a) the public interest, in particular national security, nutrition, health or the development of other vital sectors of the national economy so requires; or
- (b) a court or administrative body has determined that the manner of exploitation of an invention by the owner of the patent or of his licensee is anti-competitive and the Minister is satisfied that the exploitation of the patented invention in accordance with this section would remedy such practice,

the Minister may decide that, even without the agreement or authorization of the owner of a patent, a government agency or a third person designated by him may, subject to the payment of an equitable remuneration to the owner of that patent, and taking into account the economic value of the Minister's decision, exploit the invention:

Provided that the Minister shall make his decision after hearing the owner of the patent and any interested person if they wish to be heard.

(2) The exploitation of the invention by the Government agency or third person designated by the Minister shall be predominantly for the supply of the domestic market in Botswana.

(3) Upon the request of the owner of the patent, of the Government agency or the third

person authorized by the Minister to exploit the patented invention, the Minister may, after hearing the parties, if they wish to be heard, vary the terms of the decision authorizing the exploitation of the patented invention to the extent that changed circumstances justify such variation.

(4)(a) Upon the request of the owner of the patent to do so, the Minister shall revoke his decision if he is satisfied, after hearing the parties, if they wish to be heard, that the circumstances which led to his decision have ceased to exist and are unlikely to recur, or that the Government agency or third person designated by him has failed to comply with the terms of the decision.

(4)(b) Notwithstanding the provisions of paragraph (a), the Minister shall not terminate the authorization to exploit the patented invention if he is satisfied that the need for the adequate protection of the legitimate interest of the Government agency or third person designated by him justifies the maintenance of his decision.

(5) Where a third person has been designated by the Minister under this section, the authorization to exploit the patented invention may be transferred only with the enterprise or business within which the patented invention is being exploited.

(6) The authorization to exploit a patented invention shall not exclude-

- (a) the conclusion of licence contracts by the owner of the patent; or
- (b) the continued exercise, by the owner of the patent, of his rights under section 24(2).

(7)(a) A request for the Minister's authorization to exploit a patented invention shall be accompanied by evidence that the owner of the patent has received, from the person seeking that authorization, a request for a contractual licence, but that person has been unable, within a reasonable time, to obtain such a licence on reasonable commercial terms and conditions.

(b) Paragraph (a) of this subsection shall not apply in cases of national emergency or other circumstances of extreme urgency:

Provided that in such cases the Minister shall notify the owner of the patent of his decision as soon as is reasonably practicable.

(8) The exploitation of a patented invention in the field of semi-conductor technology shall be authorized by the Minister only where a court or administrative body has determined that the manner of exploitation of the patented invention, by the owner of the patent or of his licensee, is anti-competitive, and if the Minister is satisfied that the issuance of the non-voluntary licence would remedy such practice.

(9) Any person who is aggrieved by a decision of the Minister under subsection (1), (2) or (3) may appeal to the High Court against that decision.

### **31. Compulsory licences**

(1) At any time after the expiration of three years from the date of the grant of a patent or four years from the date of the application therefor, whichever happens later, any interested party may apply to the High Court for the grant of a licence under the patent upon any of the grounds specified in subsection (2) of this section.

(2) The grounds upon which a licence may be granted under this section are that a market for the patented invention is not being supplied, or is not being supplied on reasonable terms, in Botswana.

(3) Subject to the provisions of subsections (4), (5), (6) and (7) of this section, if the High Court is satisfied that either of the grounds specified in subsection (2) of the section have been established, the Court may make an order for the grant of a licence in accordance with the application upon such terms as the Court thinks fit.

(4) A licence granted under this section-

- (a) shall not be exclusive;
- (b) shall not be assigned otherwise than in connection with the goodwill of the business in which the patented invention is used; and
- (c) shall be authorized by the court for the supply of the patented invention predominantly

in Botswana.

(5) A licence granted under this section may, on the application of any interested party, be terminated by the Court where the Court is satisfied that the grounds on which the licence was granted have ceased to exist and are unlikely to recur.

(6) Where a licence is granted under this section to any person, that person shall pay, to the patentee, such remuneration as may be agreed, or as may be determined by a method agreed, between that person and the patentee, or, in default of the agreement, as is determined by the Court on the application of that person or the patentee.

(7) No licence shall be granted under this section unless the person applying for the licence, having taken all reasonable steps to do so, has been unable to obtain a licence, or to obtain a licence on reasonable terms, from the owner of the patent.

(8) No licence shall be granted under this section in respect of a patent relating to an integrated circuit.

### **32. Termination of contracts relating to licences**

Any contract relating to a licence under a patent to make, use, exercise or dispose of a patented invention shall terminate on the date on which the patent under which the licence was granted expires, is revoked or otherwise ceases to protect such invention.

### **33. Invalidation of patent**

(1) Subject to the provisions of this Act, the High Court may, on the application of any interested party, invalidate a patent on any of the following grounds-

- (a) that the invention is not an invention within the meaning of the term as defined under this Act;
- (b) that the patentee is not a person entitled, under section 10, to apply for a patent;
- (c) that the patent concerned is not patentable under section 8;
- (d) that the invention is a matter which should, in accordance with section 9, have been excluded from patent protection;
- (e) that the patentee's application did not satisfy the requirements of section 13(a), (b) and (c);
- (f) that the applicant for the patent has failed to inform the Registrar about any corresponding international application filed or has furnished information which in any material particular was false; or
- (g) that the patent was obtained on a misrepresentation.

(2) Any invalidated patent, claim or part of a claim shall be regarded as being null and void from the date of the grant of the patent.

(3) An application for the invalidation of a patent shall be served on the patentee and lodged with the Court in the manner and within the time prescribed.

(4) The Master shall notify the Registrar of any decision of the Court to invalidate a patent and the Registrar shall, within such time and such manner as may be prescribed, publish a reference thereto in the Journal.

## **PART III**

### ***Utility Model Certificates (ss 34-38)***

#### **34. Applicability of provisions relating to patents**

Save as provided under the provisions of this Part, the provisions of Part II shall apply, *mutatis mutandis*, to utility model certificates or applications therefor.

#### **35. Qualification of invention for utility model certificate**

(1) An invention shall qualify for a utility model certificate if it is new and industrially applicable.

(2) Section 22(3) shall not apply to any application for a utility model certificate.

#### **36. Duration of utility model certificate**

A utility model certificate shall expire seven years after the filing date of the application therefor.

### **37. Invalidation of utility model certificate**

(1) Subject to the provisions of this Act, the High Court may, on the application of any interested person, invalidate a utility model certificate on any of the following grounds-

- (a) that the invention relating to the certificate-
  - (i) is not new or industrially applicable; or
  - (ii) is contrary to public order or morality;
- (b) that the description and claim or claims do not disclose the invention in a manner sufficiently clear and complete to permit a person having ordinary skill in the art to carry out the invention and do not indicate at least one mode known to the applicant for carrying out the invention;
- (c) that the claim or claims do not define the matter for which protection is sought;
- (d) that the claims are not clear or concise and are not fully supported by the description;
- (e) that such drawings as are necessary for the understanding of the invention have not been filed as provided under this Act; and
- (f) that the person to whom the utility model certificate has been granted is not the inventor or his successor in title.

(2) An application for the invalidation of a utility model certificate shall be served on the person to whom the certificate has been issued and lodged with the Court in the manner and within the time prescribed.

(3) The Master shall notify the Registrar of any decision of the Court to invalidate a utility model certificate and the Registrar shall, within such time as may be prescribed, publish a reference thereto in the Journal.

### **38. Conversion of application for utility model certificate into application for patent**

(1) At any time before the grant or refusal of a utility model certificate, an applicant may, upon payment of the prescribed fee, convert his application for a utility model certificate into an application for a patent, and the latter application shall be accorded the filing date of the initial application.

(2) No person may convert an application under subsection (1) more than once.

## **PART IV**

### **Industrial Designs (ss 39-52)**

### **39. Registrable industrial design**

(1) An industrial design (hereinafter referred to as "a design") shall be capable of being registered if it is new.

(2) A design shall be deemed to be new if it has not been disclosed to the public anywhere in the world by publication in a tangible form, or by use or in any other way, prior to the filing date or, where applicable, the priority date of the application for registration.

(3) Disclosure of information which would otherwise affect the registrability of a design claimed in the application shall not affect the registrability of that design where the information was disclosed, during the twelve months preceding the filing date of the application or, where priority is claimed, the priority date of the application-

- (i) by the inventor; or
- (ii) by a third party which obtained the information directly or indirectly from the inventor.

(4) A design which is contrary to public order or morality shall not be registered.

### **40. Right to industrial design**

The provisions of section 11 shall apply *mutatis mutandis* in relation to a design.

### **41. Transfer of right to a design**

The right to a design may be transferred by cession, assignment, testamentary disposition or by operation of law.

### **42. Application for registration of design**

(1) An application for the registration of a design shall be made to the Registrar in the

prescribed manner and shall be accompanied by the following-

- (a) a request, in writing, that the design be registered;
- (b) drawings, photographs or other graphic representations of the article embodying the design;
- (c) a statement, in writing, indicating the kind of products for which the design is to be used; and
- (d) such application fee as may be prescribed.

(2) Where the design is two dimensional, the application may be accompanied by a specimen of the article embodying the design.

(3) Any person who makes an application to the Registrar for the registration of a design but is not the creator of the design shall furnish to the Registrar, in writing, such proof of his title or authority to apply for registration as may be prescribed.

(4) An application under this section may be in respect of two or more designs:

Provided that the designs relate to the same class of International Classification or to the same set or composition of articles.

(5) For the purposes of this section, "International Classification" means the classification according to the Locarno Agreement of 8th October, 1968, establishing an International Classification for Industrial Designs.

(6) The application, at the time of filing, may contain a request that the publication of the industrial design, upon registration, be deferred for a period not exceeding twelve months from the date of filing or, if priority is claimed, from the date of priority, of the application.

(7) The applicant may, at any time before the registration of a design, withdraw his application.

#### **43. Right of priority**

The provisions of section 18 shall apply *mutatis mutandis* in relation to a design.

#### **44. Filing date of application**

(1) The Registrar shall accord, as the filing date of an application, the date on which such application is received by him:

Provided that at the time of its receipt, the application contains information allowing the identity of the applicant to be established and the required graphic representation of the article embodying the design.

(2) Where the application does not comply with the requirements of subsection (1), the Registrar shall, in writing, request the applicant to supply him with the information lacking in the application and shall accord to the application, as the filing date, the date on which the further information was filed with him.

(3) If an applicant fails to comply with any request made by the Registrar under subsection (2), his application shall be treated as though it had never been filed.

#### **45. Examination of application**

After according a filing date to an application, the Registrar shall examine the application to determine whether-

- (a) it complies with the requirements of section 42(1) and (3) and the regulations pertaining thereto;
- (b) it complies with the definition of a design under this Act;
- (c) it complies with such appropriate regulations as may have been made in pursuance of this Part; and
- (d) the design is not contrary to public order or morality.

#### **46. Registration of design**

(1) Where, following the examination referred to in section 45, the Registrar is satisfied that the requirements of this Act have been fulfilled, he shall register the design.

(2) Where the Registrar registers a design, he shall, within such time as may be prescribed-

- (a) issue, to the applicant, a certificate of registration of the design;
- (b) record such registration in the register; and
- (c) publish, in the Journal, a reference to the registration of the design.

(3)(a) Notwithstanding the provisions of subsection (2), where a request has been made under section 42(6) for deferment of publication, neither the representation of the design nor any file relating to the application shall, upon registration of the design, be open to public inspection; and in this case, the Registrar shall publish, in the Journal, a mention of the deferment of the publication of the industrial design and information identifying the registered owner of the design, and indicating the filing date of the application, the length of the period for which deferment has been requested, and such other particulars as may be prescribed.

(b) At the expiry of the period of deferment, the Registrar shall publish, in the Journal, the registered design.

(4) The institution of legal proceedings on the basis of a registered design during the period of deferment of publication shall be subject to the condition that the information contained in the Register and in the file relating to the application has been communicated to the person against whom the action is brought.

(5) An application which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable the registration to be effected within the prescribed period shall be deemed to have been abandoned.

#### **47. Rights conferred by registration**

(1) No person shall exploit, in Botswana, a design registered in Botswana unless he has been authorized, in writing, to do so by the owner of that registered design.

(2) The person registered as the owner of a design shall, subject to the provisions of this Act, and to any rights appearing from the register of designs to be vested in any other person, have the exclusive right, in Botswana, to make, import or sell any article bearing or embodying the registered design or a design not substantially different from the registered design, when such acts are undertaken for commercial purposes.

(3) For the purposes of this section, exploitation of a registered design means the doing of any act specified in subsection (2).

(4) The rights of the owner of a registered design shall not extend to acts in respect of which articles which have been put on the market in Botswana by such owner, or with his consent.

#### **48. Proceedings for infringement**

(1) The owner of a registered design shall, in addition to any other rights, remedies or actions available to him, have the right to institute court proceedings against any person who infringes the design by performing, without his agreement or authorization, any of the acts referred to in section 47, or who performs acts which make it likely that infringement will occur.

(2) In any proceedings under this section, the court may grant relief by way of damages, interdict, delivery up or destruction of any infringing product, article or product of which the infringing product forms an inseparable part, or account of profits derived from the infringement or otherwise as it may deem fit.

(3) The court shall not, in awarding damages under this section, also order, in respect of the same infringement, that the plaintiff be given an account of the profits derived by him from the infringement.

(4) In any proceedings under this section, the court shall have jurisdiction to order the revocation of the registration of a design on any of the grounds specified in section 52, and any such grounds may be relied upon by way of defence.

#### **49. Duration and renewal of registered design**

(1) The registration in respect of a design shall expire five years after the filing date of the application for its registration, but may, upon payment of such renewal fee as may be prescribed, be renewed for two further consecutive periods of five years each.

(2) Where the owner of the design is late paying the renewal fee, the Registrar shall, upon payment by the said owner of such surcharge as may be prescribed, give him a period of grace not exceeding six months within which he must pay the said late renewal fee.

#### **50. ARIPO Protocol designs**

An industrial design in respect of which Botswana is a designated State, registered by ARIPO by virtue of the ARIPO Protocol, shall have the same effect in Botswana as a design registered under this Act unless the Registrar communicates, to ARIPO, in respect of the application therefor, a decision, in accordance with the provisions of the Protocol, that if a design is registered by ARIPO, that registration shall have no effect in Botswana.

#### **51. Inspection of registered design**

(1) Subject to the provisions of section 42(6), the representations, specimens and drawings of a registered design, including all documents lodged in relation thereto shall, upon payment of such fees as may be prescribed, be open to inspection by any person on and after the day on which the certificate of registration is issued:

Provided that the right of inspection shall not include the right to make a copy of any such representation, drawing or document by mechanical means.

(2) Any person may, upon payment of such fees as may be prescribed, obtain, from the Registrar, a copy of such representations, drawings or documents.

(3) When an application for the registration of a design has been abandoned or refused, the representations, drawings or other documents shall not, at any time, be open to inspection at the designs office, but shall, after the expiration of 12 months from the date of application for such registration, be returned to the applicant if he requests that they be so returned to him.

#### **52. Invalidation of registration of design**

(1) Subject to the provisions of this Act, the High Court may, on the application of any interested person, invalidate the registration of a design either wholly or in part or in respect of any particular article in connection with which the design is registered on any of the following grounds-

- (a) that the design was not new;
- (b) that the applicant for registration was not the owner thereof;
- (c) that the application was made with the intention of defrauding the owner of the design;
- or
- (d) on any ground on which the Registrar could have refused to register the design.

(3) An application for the invalidation of a design shall be served on the person in whose name the design is registered and lodged with the Court in the manner and within the time prescribed.

(4) The Master shall notify the Registrar of any decision of the Court to invalidate a design and the Registrar shall, within such time as may be prescribed, publish a reference thereto in the Journal.

### **PART V**

#### ***Marks, Collective Marks and Trade Names (ss 53-68)***

#### **53. Acquisition of exclusive right to a mark**

(1) The exclusive right to a mark under this Act shall be acquired by registration in accordance with the provisions hereof.

(2) A mark shall not be registered if it is-

- (a) incapable of distinguishing the goods or services of one enterprise or business from those of another enterprise or business;
- (b) contrary to public order or morality;
- (c) likely to mislead the public or trade circles, in particular as regards the geographical origin of the goods or services concerned, or their nature or characteristics;
- (d) identical to, or is an imitation of, or contains, as an element, an armorial bearing, flag or other emblem, a name, abbreviation or initials of, or official sign or hallmark adopted



- by, any State, intergovernmental organization or organization created by an international convention, unless the competent authority of that State or organization has given his authorization for such bearing, flag, emblem, name, abbreviation or initials, official sign or hallmark to be used by an applicant for a registered mark;
- (e) identical to, or confusingly similar to, or constitutes a translation of, a mark or trade name which is well known in Botswana for identical or similar goods or services of another enterprise, or if it is well known, and registered in Botswana for goods or services which are not identical or similar to those in respect of which registration is applied for:  
Provided, in the latter case, that-
    - (i) the use of that mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the well known mark; and
    - (ii) the interests of the owner of the well known mark are likely to be prejudiced by such use; or
  - (f) identical to a mark belonging to a different owner of a registered mark and already on the register, or with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it so nearly resembles such a mark as to be likely to deceive or cause confusion.

#### **54. Application for registration of a mark**

(1) An application for the registration of a mark, accompanied by such fee as may be prescribed, shall be made to the Registrar in the prescribed manner and shall contain the following-

- (a) a request, in writing, that the mark be registered;
- (b) a reproduction of the mark;
- (c) a list of the goods or services for which registration of the mark is requested, listed under the applicable class or classes of the International Classification.

(2) The provisions of section 18 in respect of the right of priority shall apply *mutatis mutandis*.

(3) The applicant may, at any time before his mark is registered, withdraw his application.

#### **55. Examination of application for registration of a mark**

(1) The Registrar shall examine the application to determine whether it complies with the requirements of section 54(1) and any other requirements as may be prescribed.

(2) The Registrar shall also determine whether the mark complies with the definition of a mark under this Act, and whether it complies with the requirements of paragraphs (a) to (d) of section 53(2).

(3) The Registrar shall, if he is satisfied that the application complies with the requirements of the provisions of this section, accept that application and shall, within such time and in such manner as may be prescribed, publish that application in the Journal.

#### **56. Opposition to registration of a mark**

(1) Any interested person may, on the ground that the requirements of section 53(2) have not been satisfied, or that the mark does not comply with the definition of a mark as specified in this Act, give, to the Registrar within such period and in such manner as may be prescribed, notice of his opposition to the registration of a mark.

(2) The Registrar shall, as soon as he receives such notice, send a copy thereof to the applicant who shall, within such period and in such manner as may be prescribed, send, to the Registrar, his written response thereto (referred to in this section as a "counter-statement") specifying the grounds on which he relies for his application.

(3) The applicant shall be deemed to have abandoned his application if he fails to comply with the provisions of subsection (2).

(4) Where the applicant files his counter-statement, the Registrar shall forthwith furnish a copy thereof to the person opposing and shall, after hearing the parties, if either wishes to be heard, and considering the merits of the case, decide whether the mark should be registered.

(5) Following the publication of an application, and until the registration of the mark, the applicant shall have the same rights and privileges as he would have if the mark had been registered, but it shall be a valid defence to an action brought hereunder in respect of an act done after the application was published, if the defendant establishes that the mark could not have been validly registered at the time the act was done.

#### **57. Registration of mark**

(1) Where the Registrar is satisfied that the application for the registration of a mark satisfies the requirements of this Act, and the registration of the mark has not been opposed within the period prescribed, or the registration of the mark has been opposed but he has decided in the applicant's favour, the Registrar shall-

- (a) register the mark in the appropriate register;
- (b) issue, to the applicant, a certificate of registration; and
- (c) publish, in the Journal, a reference to the registration of the mark.

(2) Where the requirements for the registration of a mark are not satisfied, or an application for the registration of a mark has been successfully opposed, the Registrar shall refuse to register that mark.

#### **58. Rights conferred by registration of mark**

(1) No person shall use a registered mark unless he has been authorized, in writing, to do so by the owner thereof.

(2) The rights conferred by registration of a mark shall not extend to acts in respect of articles which have been put on the market in Botswana by the registered owner or with his consent.

#### **59. Transfer of rights in marks**

The rights in a mark may be transferred by cession, assignment, testamentary disposition or by operation of law.

#### **60. Proceedings for infringement**

(1) The owner of a mark shall, in addition to any other rights, remedies or actions available to him, have the right to institute court proceedings against any person who infringes the mark by using that mark without his authorization or by performing acts which make it likely that infringement will occur.

(2) The right conferred under this section shall extend to the use of a sign similar to the registered mark in relation to goods and services similar to those for which the mark has been registered, where confusion may arise in the public.

(3) The right conferred under this section shall extend to the use of a sign which constitutes a reproduction, an imitation or a translation of a registered mark which is well known in Botswana in relation to goods or services which are not similar to those in respect of which a trade mark is registered:

Provided that such use of the mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered mark, and the interests of the owner of the registered mark are likely to be prejudiced by such use.

(4) A plaintiff in proceedings for infringement shall be entitled to relief by way of an interdict, delivery up or destruction of any infringing product, article or product of which the infringing product forms an inseparable part, damages or an account of the profits derived from the infringement.

(5) The court shall not, in awarding damages, also order, in respect of the same infringement, that the plaintiff be given an account of the profits derived by him from the infringement.

#### **61. Duration and renewal of registration of mark**

(1) The registration in respect of a mark shall expire ten years after the filing date of the application for its registration, but may, upon the written request and payment of the prescribed renewal fee by the registered owner, be renewed for consecutive periods of ten years.

(2) Where the owner of a registered mark is late paying the renewal fee, the Registrar shall, upon payment by the said owner of such surcharge as may be prescribed, give him a period of grace not exceeding six months within which he must pay the late renewal fee.

#### **62. Banjul Protocol on marks**

A mark in respect of which Botswana is a designated State, registered by ARIPO by virtue of the Banjul Protocol, shall have the same effect and enjoy the same protection in Botswana as a mark registered under this Act unless the Registrar communicates, to ARIPO, in respect of the application therefor, a decision, in accordance with the provisions of that protocol, that if a mark is registered by ARIPO, that mark shall have no effect in Botswana.

#### **63. Invalidation of registration of mark**

(1) Any interested person may apply to the Registrar for the invalidation of the registration of a mark on the ground that the requirements of section 53(2) and the definition of a mark as specified under this Act, have not been satisfied.

(2) An application for the invalidation of a registration of a mark shall be served on the owner of the mark in the manner prescribed.

(3) Any invalidation of the registration of a mark shall be deemed to have been effective from the date of registration of the mark and a reference thereto shall be published by the Registrar in the Journal as soon as possible.

#### **64. Removal of mark on grounds of non-use**

(1) Any interested person may make application to the Registrar to remove, from the register, a mark in respect of any of the goods or services in respect of which it is registered on the ground that up to one month prior to filing the application, the mark had, after its registration, not been used by the registered owner or a licensee during a continuous period of three or more years.

(2) The Registrar shall not remove a mark from the register if the owner thereof can show that circumstances existed which prevented the use of the mark and that there was no intention not to use the mark in respect of those goods or services, or that there was no intention to abandon the use of the mark in respect of the said goods or services.

(3) An application for the removal of a mark from the register of marks shall be served on the owner thereof and filed with the Registrar in the manner and within the time prescribed.

#### **65. Collective marks**

(1) Subject to subsections (2) and (3), sections 53 to 64 of this Act shall apply to collective marks, save that references therein to a mark shall be read as being references to a collective mark.

(2) An application for the registration of a collective mark shall designate the mark as a collective mark and shall be accompanied by a copy of the rules governing the use of the collective mark.

(3) For purposes of subsection (2), "rules" means the rules made by the person under whose control the collective mark may be used.

(4) The registered owner of a collective mark shall notify the Registrar, in writing, of any changes made in respect of the rules referred to in subsection (2).

#### **66. Invalidation of registration of collective mark**

(1) In addition to the grounds set out in section 63(1), the Registrar shall invalidate the registration of a collective mark if the person requesting the invalidation proves that only the registered owner uses the mark, or that he uses or permits its use in contravention of the rules referred to in section 65(2), or that he uses or permits its use in a manner which is liable to deceive trade circles or the public as to the origin or any other common characteristics of the goods or services concerned.

(2) An application for the invalidation of a collective mark shall be served on the owner of the mark in the manner and within the time prescribed.

#### **67. Licensing of marks and collective marks**

(1) Any licence contract made in relation to the registration of a mark or an application therefor shall provide for the effective control, by the licensor, of the quality of the goods or services of the licensee in connection with which the mark is used.

(2) If the licence contract does not provide for such quality control or if such quality control is not effectively carried out, the licence contract shall not be valid.

(3) The registration of a collective mark, or an application therefor, may not be the subject of a licence contract.

#### **68. Trade names**

(1) A name or designation may not be used as a trade name if by its nature or the use to which it may be put, it is contrary to public order or morality and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

(2)(a) Notwithstanding any law providing for any obligation to register a trade name, such name shall be protected, even prior to or without registration, against any unlawful act committed by a third party.

(b) Any subsequent use of the trade name by a third party, whether as a trade name, a mark or a collective mark, or any such use of a similar trade name or mark, which is likely to mislead the public, shall be deemed to be unlawful.

### **PART VI**

#### ***Acts of Unfair Competition (s 69)***

#### **69. Acts of unfair competition**

(1) On the request of the owner of a title of protection under this Act, or of any competent authority or any interested person, association or syndicate (in particular of producers, manufacturers or traders), the court may grant an interdict to prevent an act of unfair competition, award damages or grant any other remedy as the court may deem appropriate.

(2) For the purposes of this Act, any act of competition which is contrary to honest practices in industrial or commercial matters shall constitute an act of unfair competition, and shall be unlawful.

(3) The following, in particular, shall be deemed to constitute acts of unfair competition-

- (a) any act of such a nature as to create confusion by any means whatever with the establishment, the goods or the industrial or commercial activities of, a competitor;
- (b) the making of a false allegation in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities of, a competitor; and
- (c) the making of allegations which, in the course of trade, is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity of the goods of, a competitor.

### **PART VII**

#### ***Miscellaneous Provisions (ss 70-80)***

#### **70. Changes in ownership**

(1) Any change in the ownership of a patent, a utility model certificate, the registration of an industrial design, mark or collective mark, or in the ownership of an application therefor, shall be in writing and shall, at the request, to the Registrar, of any interested party, be recorded by the Registrar in the appropriate register, and except in the case of an application, be published by notice in the Journal by the Registrar.

(2) Any change in the ownership of a patent, a utility model certificate, the registration of a design, mark or collective mark or in the ownership of an application therefor, shall have no effect against third parties unless it has been recorded by the Registrar in the appropriate register.

(3) Any change in the ownership of the registration of a collective mark, or in the ownership of an application therefor, shall require the prior approval, in writing, of the Minister.

(4) A change in ownership of the registration of a mark or a collective mark shall be invalid if it is likely to deceive or cause confusion particularly in regard to the nature, origin, manufacturing process, characteristics or suitability for their purpose, of the goods or services in relation to which the mark or collective mark is intended to be used or is being used.

#### **71. Licence contracts**

Any licence contract concerning a patent, a utility model certificate, a registered design or registered mark, or an application therefor shall have no effect against third parties unless it has been recorded by the Registrar in the appropriate register.

#### **72. Agents**

Every person who makes an application under this Act for the grant or registration of a patent, utility model certificate, design, mark, or collective mark, or of any other thing which may be applied for under this Act, and whose ordinary residence or principal place of business is outside Botswana, shall be represented by a legal practitioner who has been enrolled to practise in the courts of Botswana in accordance with the provisions of the Legal Practitioners' Act or such other person as the Minister may prescribe.

#### **73. Correction of errors**

(1) The Registrar may correct any clerical error or error in translation or transcription in any application filed under this Act, or in any document filed or lodged in pursuance of such application, and the Registrar may also correct any clerical error in any register maintained in pursuance of this Act.

(2) Subsection (1) shall not be construed as giving the Registrar any power to correct or amend any application, document or register in any material manner.

(3) A correction made in pursuance of this section shall be made by the Registrar of his own accord or upon the request of any person.

(4) Where any person requests the Registrar to correct any application or other document filed under this Act, that person shall pay, to the Registrar, such fee as may be prescribed.

#### **74. Exercise of discretionary powers**

The Registrar shall give any party to a proceeding before him the opportunity of being heard before making any decision which he is empowered to make under this Act or the regulations thereto if that decision might adversely affect or prejudice that party.

#### **75. Extension of time for applications**

(1) Where anything is required to be done within a prescribed time and, by reason of a delay in the Marks, Patents and Designs Office, that thing is not done, the Registrar may extend the time for the doing of that thing for such period as may be prescribed, and no fees shall be payable in respect of any such extension.

(2) Notwithstanding the provisions of subsection (1), the Registrar may, upon the written request of an interested person, and upon payment of such fee as may be prescribed, extend, for such period as may be prescribed, the time specified for the doing of any act if that person shows good cause as to why he did not do that act within the prescribed time.

#### **76. Offences**

(1) Any person who, knowing the same to be false-

- (a) makes or causes to be made a false entry in any register kept in terms of this Act;
- (b) makes or causes to be made any document falsely purporting to be a copy of an entry in any such register;
- (c) produces, tenders or causes to be produced as evidence any such entry or copy thereof,

shall be guilty of an offence and shall be liable, on conviction, to a fine of not less than P5 000,00 but not more than P10 000,00, or to imprisonment for a term of not less than one year

but not more than three years, or to both such fine and such imprisonment.

(2) Any person who-

- (a) for the purpose of deceiving the Registrar or any other officer in the execution of his duties under this Act; or
- (b) for the purpose of procuring or influencing the doing or omission of any act under this Act,

makes a false statement or representation knowing the same to be false, shall be guilty of an offence and shall be liable, on conviction, to a fine of not less than P5 000,00 but not more than P10 000,00, or to imprisonment for a term of not less than one year but not more than three years, or to both such fine and such imprisonment.

(3) Any person who, knowing the same to be false, makes a false statement or representation that-

- (a) a patent has been granted to him or to any other person in respect of any invention;
- (b) he or any other person is the owner of any registered design, mark, collective mark or trade name; or
- (c) he has been granted an exclusive or compulsory licence to use any patent, registered design, registered mark or collective mark or trade name,

which statement or representation induces another person to act thereon, shall be guilty of an offence and shall be liable, on conviction, to a fine of not less than P2 000 00 but not more than P5 000 00, or to imprisonment for a term of not less than six months but more than two years, or to both such fine and imprisonment.

(4) Subject to the provisions of sections 24(3)(a), 30, 31, 47(4) and 58(2), the performance of any act referred to in section 24, 47 and 58 by a person other than the owner of the title of protection and without the agreement of such owner shall constitute an infringement.

(5) The court may, on the application to it by the owner of the title of protection, or by a licensee if he has requested the owner to institute court proceedings for a specific relief and the owner has refused or failed to do so, grant an interdict to prevent an infringement or unlawful act referred to in sections 68(2)(b) and 69(2).

(6) Any person who intentionally or wilfully performs any act which constitutes an infringement as defined in subsection (4) of this section, or an unlawful act as defined in sections 67(2)(b) and 68(2) shall be guilty of an offence and shall be liable, on conviction, to a fine of not less than P2 000 00 but not more than P5 000 00, or to imprisonment for a term of not less than six months but not more than two years, or to both such fine and imprisonment.

(7) Any person who commits an offence or unlawful act for which no specific penalty has been specified shall be liable to a fine of not less than P2 000 00 but not more than P5 000 00 or to imprisonment for a term of not less than six months but not more than two years, or to both such fine and imprisonment.

## **77. Appeals**

A person who is aggrieved by any decision of the Registrar under this Act may appeal to the Minister in the manner prescribed, and within the time prescribed, and, if he is aggrieved by a decision of the Minister, may, within such time as may be prescribed, appeal to the High Court against that decision.

## **78. Regulations**

The Minister may, by statutory instrument, make regulations providing for any matter which is to be provided for under this Act, or which otherwise relates to the administration of this Act.

## **79. Repeal**

The Patents and Designs Protection Act, the Trademarks Act and the United Kingdom Trade Marks Act, are hereby repealed.

## **80. Transitional**

- (1) Notwithstanding the repeal of the enactments referred to in section 79, patents

granted, and designs and trade marks registered thereunder shall remain in force but shall, subject to subsections (2) and (3), be deemed to have been granted under this Act.

(2) Patents thus granted and industrial designs thus registered shall remain in force for the unexpired portion of the period of protection provided thereunder subject, respectively, to the payment of annual maintenance fees or renewal fees provided for under this Act.

(3) Trademarks thus registered shall be due for renewal within the same period as under Part I of the Trade Marks Act and the United Kingdom Trade Marks Act, or ten years from the entry into force of this Act, whichever period expires first, and, upon renewal, shall be reclassified in accordance with the International Classification.

(4) For the purposes of the payment of annual maintenance fees for patents and patent applications, and of renewal fees for registered industrial designs under subsection (2) hereof, the reference to "the filing date" in sections 27(2) and 49(1) respectively, shall be construed as being a reference to the date of registration in Botswana.

(5) A person who, on the coming into entry of this Act-

(a) is the owner of a patent granted in the United Kingdom or the Republic of South Africa or has filed an application for the grant of a patent in the United Kingdom or the Republic of South Africa; or

(b) is the owner of an industrial design registered in the United Kingdom or the Republic of South Africa or has filed an application for registration of an industrial design in the United Kingdom or the Republic of South Africa,

may, within 20 months of the entry into force of this Act, file an application for the grant of a patent for the same invention or for the registration of the same industrial design under this Act and such application shall be accorded the filing date or priority date accorded to the application, grant or registration in the United Kingdom or the Republic of South Africa.

#### **FIRST SCHEDULE**

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

*Official English Text established*

*under Article 29(1)(b)*

of March 20, 1883,

as revised

at BRUSSELS on December 14, 1900,

at WASHINGTON on June 2, 1911,

at THE HAGUE on November 6, 1925,

at LONDON on June 2, 1934,

at LISBON on October 31, 1958,

and at STOCKHOLM on July 14, 1967,

and as amended on September 28, 1979

#### **ARTICLE 1**

#### ***Establishment of the Union; Scope of Industrial Property*<sup>1</sup>**

(1) The countries to which this Convention applies constitute a Union for the protection of industrial property.

(2) The protection of industrial property has as its object patents, utility models, industrial designs, trademarks, service marks, trade names, indications of source or appellations of origin, and the repression of unfair competition.

(3) Industrial property shall be understood in the broadest sense and shall apply not only to industry and commerce proper, but likewise to agricultural and extractive industries and to all manufactured or natural products, for example, wines, grain, tobacco leaf, fruit, cattle, minerals, mineral waters, beer, flowers, and flour.

(4) Patents shall include the various kinds of industrial patents recognized by the laws of the countries of the Union, such as patents of importation, patents of improvement, patents and certificates of addition, etc.

#### **ARTICLE 2**

### ***National Treatment for Nationals of Countries of the Union***

(1) Nationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals; all without prejudice to the rights specially provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with.

(2) However, no requirement as to domicile or establishment in the country where protection is claimed may be imposed upon nationals of countries of the Union for the enjoyment of any industrial property rights.

(3) The provisions of the laws of each of the countries of the Union relating to judicial and administrative procedure and to jurisdiction, and to the designation of an address for service or the appointment of an agent, which may be required by the laws on industrial property are expressly reserved.

### **ARTICLE 3**

#### ***Same Treatment for Certain Categories of Persons as for Nationals of Countries of the Union***

Nationals of countries outside the Union who are domiciled or who have real and effective industrial or commercial establishments in the territory of one of the countries of the Union shall be treated in the same manner as nationals of the countries of the Union.

### **ARTICLE 4**

#### ***A to I. Patents, Utility Models, Industrial Designs, Marks, Inventors' Certificates: Right of Priority. - G. Patents: Division of the Application***

A. - (1) Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

(2) Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority.

(3) By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application.

B. - Consequently, any subsequent filing in any of the other countries of the Union before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, the putting on sale of copies of the design, or the use of the mark, and such acts cannot give rise to any third-party right or any right of personal possession. Rights acquired by third parties before the date of the first application that serves as the basis for the right of priority are reserved in accordance with the domestic legislation of each country of the Union.

C. - (1) The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks.

(2) These periods shall start from the date of filing of the first application; the day of filing shall not be included in the period.

(3) If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

(4) A subsequent application concerning the same subject as a previous first application within the meaning of paragraph (2), above, filed in the same country of the Union, shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, if, at the time of filing the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

D. - (1) Any person desiring to take advantage of the priority of a previous filing shall be required to make a declaration indicating the date of such filing and the country in which it was made. Each country



shall determine the latest date on which such declaration must be made.

(2) These particulars shall be mentioned in the publications issued by the competent authority, and in particular in the patents and the specifications relating thereto.

(3) The countries of the Union may require any person making a declaration of priority to produce a copy of the application (description, drawings, etc.) previously filed. The copy, certified as correct by the authority which received such application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation.

(4) No other formalities may be required for the declaration of priority at the time of filing the application. Each country of the Union shall determine the consequences of failure to comply with the formalities prescribed by this Article, but such consequences shall in no case go beyond the loss of the right of priority.

(5) Subsequently, further proof may be required.

Any person who avails himself of the priority of a previous application shall be required to specify the number of that application; this number shall be published as provided for by paragraph (2) above.

E. - (1) Where an industrial design is filed in a country by virtue of a right of priority based on the filing of a utility model, the period of priority shall be the same as that fixed for industrial designs.

(2) Furthermore, it is permissible to file a utility model in a country by virtue of a right of priority based on the filing of a patent application, and vice versa.

F. - No country of the Union may refuse a priority or a patent application on the ground that the applicant claims multiple priorities, even if they originate in different countries, or on the ground that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed, provided that, in both cases, there is unity of invention within the meaning of the law of the country.

With respect to the elements not included in the application or applications whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions.

G. - (1) If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.

(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized.

H. - Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements.

I. - (1) 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.

(2) 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, an applicant for an inventor's certificate shall, in accordance with the provisions of this Article relating to patent applications, enjoy a right of priority based on an application for a patent, a utility model, or an inventor's certificate.

#### **ARTICLE 4 bis**

##### **Patents: Independence of Patents Obtained for the Same Invention in Different Countries**

(1) Patents applied for in the various countries of the Union by nationals of countries of the Union shall be independent of patents obtained for the same invention in other countries, whether members of the Union or not.

(2) The foregoing provision is to be understood in an unrestricted sense, in particular, in the sense that patents applied for during the period of priority are independent, both as regards the grounds for nullity and forfeiture, and as regards their normal duration.

(3) The provision shall apply to all patents existing at the time when it comes into effect.

(4) Similarly, it shall apply, in the case of the accession of new countries, to patents in existence on either side at the time of accession.

(5) Patents obtained with the benefit of priority shall, in the various countries of the Union, have a duration equal to that which they would have, had they been applied for or granted without the benefit of priority.

#### **ARTICLE 4 ter**

##### **Patents: Mention of the Inventor in the Patent**

The inventor shall have the right to be mentioned as such in the patent.

#### **ARTICLE 4 quater**

##### **Patents: Patentability in Case of Restrictions of Sale by Law**

The grant of a patent shall not be refused and a patent shall not be invalidated on the ground that the sale of the patented product or of a product obtained by means of a patented process is subject to restrictions or limitations resulting from the domestic law.

#### **ARTICLE 5**

##### **A. Patents: Importation of Articles; Failure to Work or Insufficient Working; Compulsory Licences. - B. Industrial Designs: Failure to Work; Importation of Articles. - C. Marks: Failure to Use; Different Forms; Use by Co-proprietors. - D. Patents, Utility Models, Marks, Industrial Designs: Marking**

A. - (1) Importation by the patentee into the country where the patent has been granted of articles manufactured in any of the countries of the Union shall not entail forfeiture of the patent.

(2) Each country of the Union shall have the right to take legislative measures providing for the grant of compulsory licences to prevent the abuses which might result from the exercise of the exclusive rights conferred by the patent, for example, failure to work.

(3) Forfeiture of the patent shall not be provided for except in cases where the grant of compulsory licences would not have been sufficient to prevent the said abuses. No proceedings for the forfeiture or revocation of a patent may be instituted before the expiration of two years from the grant of the first compulsory licence.

(4) A compulsory licence may not be applied for on the ground of failure to work or insufficient working before the expiration of a period of four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period expires last; it shall be refused if the patentee justifies his inaction by legitimate reasons. Such a compulsory licence shall be non-exclusive and shall not be transferable, even in the form of the grant of a sub-licence, except with that part of the enterprise or goodwill which exploits such licence.

(5) The foregoing provisions shall be applicable, *mutatis mutandis*, to utility models.

B. - The protection of industrial designs shall not, under any circumstance, be subject to any forfeiture, either by reason of failure to work or by reason of the importation of articles corresponding to those which are protected.

C. - (1) If, in any country, use of the registered mark is compulsory, the registration may be cancelled only after a reasonable period, and then only if the person concerned does not justify his inaction.

(2) Use of a trademark by the proprietor in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered in one of the countries of the Union shall not entail invalidation of the registration and shall not diminish the protection granted to the mark.

(3) Concurrent use of the same mark on identical or similar goods by industrial or commercial establishments considered as co-proprietors of the mark according to the provisions of the domestic law of the country where protection is claimed shall not prevent registration or diminish in any way the protection granted to the said mark in any country of the Union, provided that such use does not result in misleading the public and is not contrary to the public interest.

D. - No indication or mention of the patent, of the utility model, of the registration of the trademark, or of the deposit of the industrial design, shall be required upon the goods as a condition of recognition of the right to protection.

#### **ARTICLE 5 bis**

##### **All Industrial Property Rights: Period of Grace for the Payment of Fees for the Maintenance of Rights; Patents: Restoration**

(1) A period of grace of not less than six months shall be allowed for the payment of the fees prescribed for the maintenance of industrial property rights, subject, if the domestic legislation so provides, to the payment of a surcharge.

(2) The countries of the Union shall have the right to provide for the restoration of patents which have

lapsed by reason of non-payment of fees.

#### **ARTICLE 5 *ter***

##### ***Patents: Patented Devices Forming Part of Vessels, Aircraft, or Land Vehicles***

In any country of the Union the following shall not be considered as infringements of the rights of a patentee:

1. the use on board vessels of other countries of the Union of devices forming the subject of his patent in the body of the vessel, in the machinery, tackle, gear and other accessories, when such vessels temporarily or accidentally enter the waters of the said country, provided that such devices are used there exclusively for the needs of the vessel;
2. the use of devices forming the subject of the patent in the construction or operation of aircraft or land vehicles of other countries of the Union, or of accessories of such aircraft or land vehicles, when those aircraft or land vehicles temporarily or accidentally enter the said country.

#### **ARTICLE 5 *quarter***

##### ***Patents: Importation of Products Manufactured by a Process Patented in the Importing Country***

When a product is imported into a country of the Union where there exists a patent protecting a process of manufacture of the said product, the patentee shall have all the rights, with regard to the imported product, that are accorded to him by the legislation of the country of importation, on the basis of the process patent, with respect to products manufactured in that country.

#### **ARTICLE 5 *quinquies***

##### ***Industrial Designs***

Industrial designs shall be protected in all the countries of the Union.

#### **ARTICLE 6**

##### ***Marks: Conditions of Registration; Independence of Protection of Same Mark in Different Countries***

(1) The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation.

(2) However, an application for the registration of a mark filed by a national of a country of the Union in any country of the Union may not be refused, nor may a registration be invalidated, on the ground that filing, registration, or renewal, has not been effected in the country of origin.

(3) A mark duly registered in a country of the Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin.

#### **ARTICLE 6 *bis***

##### ***Marks: Well-Known Marks***

(1) The countries of the Union undertake, *ex officio* if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

(2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

(3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.

#### **ARTICLE 6 *ter***

##### ***Marks: Prohibitions concerning State Emblems, Official Hallmarks, and Emblems of Intergovernmental Organizations***

(1) (a) The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.

(b) The provisions of subparagraph (a), above, shall apply equally to armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations of which one or more countries of the Union are members, with the exception of armorial bearings, flags, other emblems, abbreviations, and names, that are already the subject of international agreements in force, intended to ensure their protection.

(c) No country of the Union shall be required to apply the provisions of subparagraph (b), above, to the prejudice of the owners of rights acquired in good faith before the entry into force, in that country, of this Convention. The countries of the Union shall not be required to apply the said provisions when the use or registration referred to in subparagraph (a), above, is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization.

(2) Prohibition of the use of official signs and hallmarks indicating control and warranty shall apply solely in cases where the marks in which they are incorporated are intended to be used on goods of the same or a similar kind.

(3) (a) For the application of these provisions, the countries of the Union agree to communicate reciprocally, through the intermediary of the International Bureau, the list of State emblems, and official signs and hallmarks indicating control and warranty, which they desire, or may hereafter desire, to place wholly or within certain limits under the protection of this Article, and all subsequent modifications of such list. Each country of the Union shall in due course make available to the public the lists so communicated.

Nevertheless such communication is not obligatory in respect of flags of States.

(b) The provisions of subparagraph (1) of paragraph (1) this Article shall apply only to such armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations as the latter have communicated to the countries of the Union through the intermediary of the International Bureau.

(4) Any country of the Union may, within a period of twelve months from the receipt of the notification, transmit its objections, if any, through the intermediary of the International Bureau, to the country or international intergovernmental organization concerned.

(5) In the case of State flags, the measures prescribed by paragraph (1) above, shall apply solely to marks registered after November 6, 1925.

(6) In the case of State emblems other than flags, and of official signs and hallmarks of the countries of the Union, and in the case of armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations, these provisions shall apply only to marks registered more than two months after receipt of the communication provided for in paragraph (3), above.

(7) In cases of bad faith, the countries shall have the right to cancel even those marks incorporating State emblems, signs and hallmarks, which were registered before November 6, 1925.

(8) Nationals of any country who are authorized to make use of the State emblems, signs, and hallmarks, of their country may use them even if they are similar to those of another country.

(9) The countries of the Union undertake to prohibit the unauthorized use in trade of the State armorial bearings of the other countries of the Union, when the use is of such a nature as to be misleading as to the origin of the goods.

(10) The above provisions shall not prevent the countries from exercising the right given in paragraph (3) of Article 6 *quinquies*, Section B, to refuse or to invalidate the registration of marks incorporating, without authorization, armorial bearings, flags, other State emblems, or official signs and hallmarks adopted by a country of the Union, as well as the distinctive signs of international intergovernmental organizations referred to in paragraph (1), above.

#### **ARTICLE 6 *quater***

##### **Marks: Assignment of Marks**

(1) When, in accordance with the law of a country of the Union, the assignment of a mark is valid only if it takes place at the same time as the transfer of the business or goodwill to which the mark belongs, it shall suffice for the recognition of such validity that the portion of the business or goodwill located in that country be transferred to the assignee, together with the exclusive right to manufacture in the said country, or to sell therein, the goods bearing the mark assigned.

(2) The foregoing provision does not impose upon the countries of the Union any obligation to regard as valid the assignment of any mark the use of which by the assignee would, in fact, be of such a nature as to mislead the public, particularly as regards the origin, nature, or essential qualities, of the goods to

which the mark is applied.

#### **ARTICLE 6 *quinquies***

##### **Marks: Protection of Marks Registered in One Country of the Union in the Other Countries of the Union**

A. - (1) Every trademark duly registered in the country of origin shall be accepted for filing and protected as is in the other countries of the Union, subject to the reservations indicated in this Article. Such countries may, before proceeding to final registration, require the production of a certificate of registration in the country of origin, issued by the competent authority. No authentication shall be required for this certificate.

(2) Shall be considered the country of origin the country of the Union where the applicant has a real and effective industrial or commercial establishment, or, if he has no such establishment within the Union, the country of the Union where he has his domicile, or, if he has no domicile within the Union but is a national of a country of the Union, the country of which he is a national.

B. - Trademarks covered by this Article may be neither denied registration nor invalidated except in the following cases:

1. when they are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed;
2. when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the *bona fide* and established practices of the trade of the country where protection is claimed;
3. when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public. It is understood that a mark may not be considered contrary to public order for the sole reason that it does not conform to a provision of the legislation on marks, except if such provision itself relates to public order.

This provision is subject, however, to the application of Article 10 *bis*.

C. - (1) In determining whether a mark is eligible for protection, all the factual circumstances must be taken into consideration, particularly the length of time the mark has been in use.

(2) No trademark shall be refused in the other countries of the Union for the sole reason that it differs from the mark protected in the country of origin only in respect of elements that do not alter its distinctive character and do not affect its identity in the form in which it has been registered in the said country of origin.

D. - No person may benefit from the provisions of this Article if the mark for which he claims protection is not registered in the country of origin.

E. - However, in no case shall the renewal of the registration of the mark in the country of origin involve an obligation to renew the registration in the other countries of the Union in which the mark has been registered.

F. - The benefit of priority shall remain unaffected for applications for the registration of marks filed within the period fixed by Article 4, even if registration in the country of origin is effected after the expiration of such period.

#### **ARTICLE 6 *sexies***

##### **Marks: Service Marks**

The countries of the Union undertake to protect service marks. They shall not be required to provide for the registration of such marks.

#### **ARTICLE 6 *septies***

##### **Marks: Registration in the Name of the Agent or Representative of the Proprietor Without the Latter's Authorization**

(1) If the agent or representative of the person who is the proprietor of a mark in one of the countries of the Union applies, without such proprietor's authorization, for the registration of the mark in his own name, in one or more countries of the Union, the proprietor shall be entitled to oppose the registration applied for or demand its cancellation or, if the law of the country so allows, the assignment in his favour of the said registration, unless such agent or representative justifies his action.

(2) The proprietor of the mark shall, subject to the provisions of paragraph (1), above, be entitled to oppose the use of his mark by his agent or representative if he has not authorized such use.

(3) Domestic legislation may provide an equitable time limit within which the proprietor of a mark must exercise the rights provided for in this Article.

#### **ARTICLE 7**

##### ***Marks: Nature of the Goods to which the Mark is Applied***

The nature of the goods to which a trademark is to be applied shall in no case form an obstacle to the registration of the mark.

#### **ARTICLE 7 bis**

##### ***Marks: Collective Marks***

(1) The countries of the Union undertake to accept for filing and to protect collective marks belonging to associations the existence of which is not contrary to the law of the country of origin, even if such associations do not possess an industrial or commercial establishment.

(2) Each country shall be the judge of the particular conditions under which a collective mark shall be the judge of the particular conditions under which a collective mark shall be protected and may refuse protection if the mark is contrary to the public interest.

(3) Nevertheless, the protection of these marks shall not be refused to any association the existence of which is not contrary to the law of the country of origin, on the ground that such association is not established in the country where protection is sought or is not constituted according to the law of the latter country.

#### **ARTICLE 8**

##### ***Trade Names***

A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark.

#### **ARTICLE 9**

##### ***Marks: Trade Names: Seizure, on Importation, etc., of Goods Unlawfully Bearing a Mark or Trade Name***

(1) All goods unlawfully bearing a trademark or trade name shall be seized on importation into those countries of the Union where such mark or trade name is entitled to legal protection.

(2) Seizure shall likewise be effected in the country where the unlawful affixation occurred or in the country into which the goods were imported.

(3) Seizure shall take place at the request of the public prosecutor, or any other competent authority, or any interested party, whether a natural person or a legal entity, in conformity with the domestic legislation of each country.

(4) The authorities shall not be bound to effect seizure of goods in transit.

(5) If the legislation of a country does not permit seizure on importation, seizure shall be replaced by prohibition of importation or by seizure inside the country.

(6) If the legislation of a country permits neither seizure on importation nor prohibition of importation nor seizure inside the country, then, until such time as the legislation is modified accordingly, these measures shall be replaced by the actions and remedies available in such cases to nationals under the law of such country.

#### **ARTICLE 10**

##### ***False Indications: Seizure, on Importation, etc., of Goods Bearing False Indications as to their Source or the Identity of the Producer***

(1) The provisions of the preceding Article shall apply in cases of direct or indirect use of a false indication of the source of the goods or the identity of the producer, manufacturer, or merchant.

(2) Any producer, manufacturer, or merchant, whether a natural person or a legal entity, engaged in the production or manufacture of or trade in such goods and established either in the locality falsely indicated as the source, or in the region where such locality is situated, or in the country falsely indicated, or in the country where the false indication of source is used, shall in any case be deemed an interested party.

#### **ARTICLE 10 bis**

##### ***Unfair Competition***

(1) The countries of the Union are bound to assure to nationals of such countries effective protection against unfair competition.

(2) Any act of competition contrary to honest practices in industrial or commercial matters constitutes

an act of unfair competition.

(3) The following in particular shall be prohibited:

1. all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;
2. false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor;
3. indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.

#### **ARTICLE 10 ter**

##### ***Marks, Trade Names, False Indications, Unfair Competition: Remedies, Right to Sue***

(1) The countries of the Union undertake to assure to nationals of the other countries of the Union appropriate legal remedies effectively to repress all the acts referred to in Articles 9, 10, and 10 bis.

(2) They undertake, further, to provide measures to permit federations and associations representing interested industrialists, producers, or merchants, provided that the existence of such federations and associations is not contrary to the laws of their countries, to take action in the courts or before the administrative authorities, with a view to the repression of the acts referred to in Articles 9, 10, and 10 bis, in so far as the law of the country in which protection is claimed allows such action by federations and associations of that country.

#### **ARTICLE 11**

##### ***Inventions, Utility Models, Industrial Designs, Marks: Temporary Protection at Certain International Exhibitions***

(1) The countries of the Union shall, in conformity with their domestic legislation, grant temporary protection to patentable inventions, utility models, industrial designs, and trademarks, in respect of goods exhibited at official or officially recognized international exhibitions held in the territory of any of them.

(2) Such temporary protection shall not extend the periods provided by Article 4. If, later, the right of priority is invoked, the authorities of any country may provide that the period shall start from the date of introduction of the goods into the exhibition.

(3) Each country may require, as proof of the identity of the article exhibited and of the date of its introduction, such documentary evidence as it considers necessary.

#### **ARTICLE 12**

##### ***Special National Industrial Property Services***

(1) Each country of the Union undertakes to establish a special industrial property service and a central office for the communication to the public of patents, utility models, industrial designs, and trademarks.

(2) This service shall publish an official periodical journal. It shall publish regularly:

- (a) the names of the proprietors of patents granted, with a brief designation of the inventions patented;
- (b) the reproductions of registered trademarks.

#### **ARTICLE 13**

##### ***Assembly of the Union***

(1)(a) The Union shall have an Assembly consisting of those countries of the Union which are bound by Articles 13 to 17.

(b) The Government of each country shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.

(c) The expenses of each delegation shall be borne by the Government which has appointed it.

(2)(a) The Assembly shall:

- (i) deal with all matters concerning the maintenance and development of the Union and the implementation of this Convention;
- (ii) give directions concerning the preparation for conferences of revision to the International Bureau of Intellectual Property (hereinafter designated as "the International Bureau") referred to in the Convention establishing the World Intellectual Property Organization (hereinafter designated as "the Organization"), due account being taken of any comments made by those countries of the Union which are not bound by Articles 13 to 17;
- (iii) review and approve the reports and activities of the Director-General of the Organization

- concerning the Union, and give him all necessary instructions concerning matters within the competence of the Union;
- (iv) elect the members of the Executive Committee of the Assembly;
  - (v) review and approve the reports and activities of its Executive Committee, and give instructions to such Committee;
  - (vi) determine the program and adopt the biennial budget of the Union, and approve its final accounts;
  - (vii) adopt the financial regulations of the Union;
  - (viii) establish such committees of experts and working groups as it deems appropriate to achieve the objectives of the Union;
  - (ix) determine which countries not members of the Union and which intergovernmental and international non-governmental organizations shall be admitted to its meetings as observers;
  - (x) adopt amendments to Articles 13 to 17;
  - (xi) take any other appropriate action designed to further the objectives of the Union;
  - (xii) perform such other functions as are appropriate under this Convention;
  - (xiii) subject to its acceptance, exercise such rights as are given to it in the Convention establishing the Organization.

(b) With respect to matters which are of interest also to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization.

(3)(a) Subject to the provisions of subparagraph (b), a delegate may represent one country only.

(b) Countries of the Union grouped under the terms of a special agreement in a common office possessing for each of them the character of a special national service of industrial property as referred to in Article 12 may be jointly represented during discussions by one of their number.

(4) (a) Each country member of the Assembly shall have one vote.

(b) One-half of the countries members of the Assembly shall constitute a quorum.

(c) Notwithstanding the provisions of subparagraph (b), if, in any session, the number of countries represented is less than one-half but equal to or more than one-third of the countries members of the Assembly, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the countries members of the Assembly which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiration of this period, the number of countries having thus expressed their vote or abstention attains the number of countries which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

(d) Subject to the provisions of Articles 17(2), the decisions of the Assembly shall require two-thirds of the votes cast.

(e) Abstentions shall not be considered as votes.

(5) (a) Subject to the provisions of subparagraph (b), a delegate may vote in the name of one country only.

(b) The countries of the Union referred to in paragraph (3)(b) shall, as a general rule, endeavour to send their own delegations to the sessions of the Assembly. If, however, for exceptional reasons, any such country cannot send its own delegation, it may give to the delegation of another such country the power to vote in its name, provided that each delegation may vote by proxy for one country only. Such power to vote shall be granted in a document signed by the Head of State or the competent Minister.

(6) Countries of the Union not members of the Assembly shall be admitted to the meetings of the latter as observers.

(7)(a) The Assembly shall meet once in every second calendar year in ordinary session upon convocation by the Director-General and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization.

(b) The Assembly shall meet in extraordinary session upon convocation by the Director-General, at the request of the Executive Committee or at the request of one-fourth of the countries members of the Assembly.

(8) The Assembly shall adopt its own rules of procedure.



## **ARTICLE 14**

### **Executive Committee**

(1) The Assembly shall have an Executive Committee.

(2)(a) The Executive Committee shall consist of countries elected by the Assembly from among countries members of the Assembly. Furthermore, the country on whose territory the Organization has its headquarters shall, subject to the provisions of Article 16 (7) (b), have an *ex officio* seat on the Committee.

(b) The Government of each country member of the Executive Committee shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.

(c) The expenses of each delegation shall be borne by the Government which has appointed it.

(3) The number of countries members of the Executive Committee shall correspond to one-fourth of the number of countries members of the Assembly. In establishing the number of seats to be filled, remainders after division by four shall be disregarded.

(4) In electing the members of the Executive committee, the Assembly shall have due regard to an equitable geographical distribution and to the need for countries party to the Special Agreements established in relation with the Union to be among the countries constituting the Executive Committee.

(5)(a) Each member of the Executive Committee shall serve from the close of the session of the Assembly which elected it to the close of the next ordinary session of the Assembly.

(b) Members of the Executive Committee may be re-elected, but only up to a maximum of two-thirds of such members.

(c) The Assembly shall establish the details of the rules governing the election and possible re-election of the members of the Executive Committee.

(6)(a) The Executive Committee shall:

- (i) prepare the draft agenda of the Assembly;
- (ii) submit proposals to the Assembly in respect of the draft program and biennial budget of the Union prepared by the Director-General;
- (iii) [*deleted*]
- (iv) submit, with appropriate comments, to the Assembly the periodical reports of the Director-General and the yearly audit reports on the accounts;
- (v) take all necessary measures to ensure the execution of the program of the Union by the Director-General, in accordance with the decisions of the Assembly and having regard to circumstances arising between two ordinary sessions of the Assembly;
- (vi) perform such other functions as are allocated to it under this Convention.

(b) With respect to matters which are of interest also to other Unions administered by the Organization, the Executive Committee shall make its decisions after having heard the advice of the Coordination Committee of the Organization.

(7)(a) The Executive Committee shall meet once a year in ordinary session upon convocation by the Director-General, preferably during the same period and at the same place as the Coordination Committee of the Organization.

(b) The Executive Committee shall meet in extraordinary session upon convocation by the Director-General, either on his own initiative, or at the request of its Chairman or one-fourth of its members.

(8) (a) Each country member of the Executive Committee shall have one vote.

(b) One-half of the members of the Executive Committee shall constitute a quorum.

(c) Decisions shall be made by a simple majority of the votes cast.

(d) Abstentions shall not be considered as votes.

(e) A delegate may represent, and vote in the name of, one country only.

(9) Countries of the Union not members of the Executive Committee shall be admitted to its meetings as observers.

(10) The Executive Committee shall adopt its own rules of procedure.

## **ARTICLE 15**

### **International Bureau**

(1) (a) Administrative tasks concerning the Union shall be performed by the International Bureau, which is a continuation of the Bureau of the Union united with the Bureau of the Union established by the International Convention for the Protection of Literary and Artistic Works.

(b) In particular, the International Bureau shall provide the secretariat of the various organs of the Union.

(c) The Director-General of the Organization shall be the chief executive of the Union and shall represent the Union.

(2) The International Bureau shall assemble and publish information concerning the protection of industrial property. Each country of the Union shall promptly communicate to the International Bureau all new laws and official texts concerning the protection of industrial property. Furthermore, it shall furnish the International Bureau with all the publications of its industrial property service of direct concern to the protection of industrial property which the International Bureau may find useful in its work.

(3) The International Bureau shall publish a monthly periodical.

(4) The International Bureau shall, on request, furnish any country of the Union with information on matters concerning the protection of industrial property.

(5) The International Bureau shall conduct studies, and shall provide services, designed to facilitate the protection of industrial property.

(6) The Director-General and any staff member designated by him shall participate, without the right to vote, in all meetings of the Assembly, the Executive Committee, and any other committee of experts or working group. The Director-General, or a staff member designated by him, shall be *ex officio* secretary of these bodies.

(7)(a) The International Bureau shall, in accordance with the directions of the Assembly and in co-operation with the Executive Committee, make the preparations for the conferences of revision of the provisions of the Convention other than Articles 13 to 17.

(b) The International Bureau may consult with intergovernmental and international non-governmental organizations concerning preparations for conferences of revision.

(c) The Director-General and persons designated by him shall take part, without the right to vote, in the discussions at these conferences.

(8) The International Bureau shall carry out any other tasks assigned to it.

## **ARTICLE 16**

### ***Finances***

(1)(a) The Union shall have a budget.

(b) The budget of the Union shall include the income and expenses proper to the Union, its contribution to the budget of expenses common to the Unions, and, where applicable, the sum made available to the budget of the Conference of the Organization.

(c) Expenses not attributable exclusively to the Union but also to one or more other Unions administered by the Organization shall be considered as expenses common to the Unions. The share of the Union in such common expenses shall be in proportion to the interest the Union has in them.

(2) The budget of the Union shall be established with due regard to the requirements of coordination with the budgets of the other Unions administered by the Organization.

(3) The budget of the Union shall be financed from the following sources:

(i) contributions of the countries of the Union;

(ii) fees and charges due for services rendered by the International Bureau in relation to the Union;

(iii) sale of, or royalties on, the publications of the International Bureau concerning the Union;

(iv) gifts, bequests, and subventions;

(v) rents, interests, and other miscellaneous income.

(4) (a) For the purpose of establishing its contribution towards the budget, each country of the Union shall belong to a class, and shall pay its annual contributions on the basis of a number of units fixed as follows:

Class	I	.....	25
Class	II	.....	20
Class	III	.....	15
Class	IV	.....	10
Class	V	.....	5
Class	VI	.....	3
Class	VII	.....	1

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

(c) The annual contribution of each country shall be an amount in the same proportion to the total sum to be contributed to the budget of the Union by all countries as the number of its units is to the total of the units of all contributing countries.

(d) Contributions shall become due on the first of January of each year.

(e) A country which is in arrears in the payment of its contributions may not exercise its right to vote in any of the organs of the Union of which it is a member if the amount of its arrears equals or exceeds the amount of the contributions due from it for the preceding two full years. However, any organ of the Union may allow such a country to continue to exercise its right to vote in that organ if, and as long as, it is satisfied that the delay in payment is due to exceptional and unavoidable circumstances.

(f) If the budget is not adopted before the beginning of a new financial period, it shall be at the same level as the budget of the previous year, as provided in the financial regulations.

(5) The amount of the fees and charges due for services rendered by the International Bureau in relation to the Union shall be established, and shall be reported to the Assembly and the Executive Committee, by the Director-General.

(6) (a) The Union shall have a working capital fund which shall be constituted by a single payment made by each country of the Union. If the fund becomes insufficient, the Assembly shall decide to increase it.

(b) The amount of the initial payment of each country to the said fund or of its participation in the increase thereof shall be a proportion of the contribution of that country for the year in which the fund is established or the decision to increase it is made.

(c) The proportion and the terms of payment shall be fixed by the Assembly on the proposal of the Director-General and after it has heard the advice of the Coordination Committee of the Organization.

(7)(a) In the headquarters agreement concluded with the country on the territory of which the Organization has its headquarters, it shall be provided that, whenever the working capital fund is insufficient, such country shall grant advances. The amount of these advances and the conditions on which they are granted shall be the subject of separate agreements, in each case, between such country and the Organization. As long as it remains under the obligation to grant advances, such country shall have an *ex officio* seat on the Executive Committee.

(b) The country referred to in subparagraph (a) and the Organization shall each have the right to denounce the obligation to grant advances, by written notification. Denunciation shall take effect three years after the end of the year in which it has been notified.

(8) The auditing of the accounts shall be effected by one or more of the countries of the Union or by external auditors, as provided in the financial regulations. They shall be designated, with their agreement, by the Assembly.

## **ARTICLE 17**

### **Amendment of Articles 13 to 17**

(1) Proposals for the amendment of Articles 13, 14, 15, 16, and the present Article, may be initiated by any country member of the Assembly, by the Executive Committee, or by the Director-General. Such proposals shall be communicated by the Director-General to the member countries of the Assembly at least six months in advance of their consideration by the Assembly.

(2) Amendments to the Articles referred to in paragraph (1) shall be adopted by the Assembly. Adoption shall require three-fourths of the votes cast, provided that any amendment to Article 13, and to the present paragraph, shall require four-fifths of the votes cast.

(3) Any amendment to the Articles referred to in paragraph (1) shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director-General from three-fourths of the countries members of the Assembly at the time it adopted the amendment. Any amendment to the said Articles thus accepted shall bind all the countries which are members of the Assembly at the time the amendment enters into force, or which become members thereof at a subsequent date, provided that any amendment increasing the financial obligations of countries of the Union shall bind only those countries which have notified their acceptance of such amendment.

## **ARTICLE 18**

### **Revision of Articles 1 to 12 and 18 to 30**

(1) This Convention shall be submitted to revision with a view to the introduction of amendments designed to improve the system of the Union.

(2) For that purpose, conferences shall be held successively in one of the countries of the Union among the delegates of the said countries.

(3) Amendments to Articles 13 to 17 are governed by the provisions of Article 17.

## **ARTICLE 19**

### **Special Agreements**

It is understood that the countries of the Union reserve the right to make separately between themselves special agreements for the protection of industrial property, in so far as these agreements do not contravene the provisions of this Convention.

## **ARTICLE 20**

### **Ratification or Accession by Countries of the Union; Entry into Force**

(1) (a) Any country of the Union which has signed this Act may ratify it, or if it has not signed it, may accede to it. Instruments of ratification and accession shall be deposited with the Director-General.

(b) Any country of the Union may declare in its instrument of ratification or accession that its ratification or accession shall not apply:

(i) to Articles 1 to 12; or

(ii) to Articles 13 to 17.

(c) Any country of the Union which, in accordance with subparagraph (b), has excluded from the effects of its ratification or accession one of the two groups of Articles referred to in that subparagraph may at any later time declare that it extends the effects of its ratification or accession to that group of Articles. Such declaration shall be deposited with the Director-General.

(2)(a) Articles 1 to 12 shall enter into force, with respect to the first ten countries of the Union which have deposited instruments of ratification or accession without making the declaration permitted under paragraph (1)(b)(i), three months after the deposit of the tenth such instrument of ratification or accession.

(b) Articles 13 to 17 shall enter into force, with respect to the first ten countries of the Union which have deposited instruments of ratification or accession without making the declaration permitted under paragraph (1)(b)(ii), three months after the deposit of the tenth such instrument of ratification or accession.

(c) Subject to the initial entry into force, pursuant to the provisions of subparagraphs (a) and (b), of each of the two groups of Articles referred to in paragraphs (1)(b)(i) and (ii), and subject to the provisions of paragraph (1)(b), Articles 1 to 17 shall, with respect to any country of the Union, other than those referred to in subparagraphs (a) and (b), which deposits an instrument of ratification or accession or any country of the Union which deposits a declaration pursuant to paragraph (1)(c), enter into force three months after the date of notification by the Director-General of such deposit, unless a subsequent date has been indicated in the instrument or declaration deposited. In the latter case, this Act shall enter into force with respect to that country on the date thus indicated.

(3) With respect to any country of the Union which deposits an instrument of ratification or accession, Articles 18 to 30 shall enter into force on the earlier of the dates on which any of the groups of Articles referred to in paragraph (1)(b) enters into force with respect to that country pursuant to paragraph (2)(a), (b), or (c).

## **ARTICLE 21**

### **Accession by Countries outside the Union; Entry into Force**

(1) Any country outside the Union may accede to this Act and thereby become a member of the Union. Instruments of accession shall be deposited with the Director-General.

(2)(a) With respect to any country outside the Union which deposits its instrument of accession one month or more before the date of entry into force of any provisions of the present Act, this Act shall enter into force, unless a subsequent date has been indicated in the instrument of accession, on the date upon which provisions first enter into force pursuant to Article 20(2)(a) or (b);

Provided that:

(i) if Articles 1 to 12 do not enter into force on that date, such country shall, during the interim period before the entry into force of such provisions, and in substitution therefor, be bound by Articles 1 to 12 of the Lisbon Act;

- (ii) if Articles 13 to 17 do not enter into force on that date, such country shall, during the interim period before the entry into force of such provisions, and in substitution therefor, be bound by Articles 13 and 14(3), (4), and (5), of the Lisbon Act.

If a country indicates a subsequent date in its instrument of accession, this Act shall enter into force with respect to that country on the date thus indicated.

(b) With respect to any country outside the Union which deposits its instrument of accession on a date which is subsequent to, or precedes by less than one month, the entry into force of one group of Articles of the present Act, this Act shall, subject to the proviso of subparagraph (a), enter into force three months after the date on which its accession has been notified by the Director-General, unless a subsequent date has been indicated in the instrument of accession. In the latter case, this Act shall enter into force with respect to that country on the date thus indicated.

(3) With respect to any country outside the Union which deposits its instrument of accession after the date of entry into force of the present Act in its entirety, or less than one month before such date, this Act shall enter into force three months after the date on which its accession has been notified by the Director-General, unless a subsequent date has been indicated in the instrument of accession. In the latter case, this Act shall enter into force with respect to that country on the date thus indicated.

#### **ARTICLE 22**

##### **Consequences of Ratification or Accession**

Subject to the possibilities of exceptions provided for in Articles 20(1)(b) and 28(2), ratification or accession shall automatically entail acceptance of all the clauses and admission to all the advantages of this Act.

#### **ARTICLE 23**

##### **Accession to Earlier Acts**

After the entry into force of this Act in its entirety, a country may not accede to earlier Acts of this Convention.

#### **ARTICLE 24**

##### **Territories**

(1) Any country may declare in its instrument of ratification or accession, or may inform the Director-General by written notification any time thereafter, that this Convention shall be applicable to all or part of those territories, designated in the declaration or notification, for the external relations of which it is responsible.

(2) Any country which has made such a declaration or given such a notification may, at any time, notify the Director-General that this Convention shall cease to be applicable to all or part of such territories.

(3)(a) Any declaration made under paragraph (1) shall take effect on the same date as the ratification or accession in the instrument of which it was included, and any notification given under such paragraph shall take effect three months after its notification by the Director-General.

(b) Any notification given under paragraph (2) shall take effect twelve months after its receipt by the Director-General.

#### **ARTICLE 25**

##### **Implementation of the Convention on the Domestic Level**

(1) Any country party to this Convention undertakes to adopt, in accordance with its constitution, the measures necessary to ensure the application of this Convention.

(2) It is understood 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 this Convention.

#### **ARTICLE 26**

##### **Denunciation**

(1) This Convention shall remain in force without limitation as to time.

(2) Any country may denounce this Act by notification addressed to the Director-General. Such denunciation shall constitute also denunciation of all earlier Acts and shall affect only the country making it, the Convention remaining in full force and effect as regards the other countries of the Union.

(3) Denunciation shall take effect one year after the day on which the Director-General has received the notification.

(4) The right of denunciation provided by this Article shall not be exercised by any country before the expiration of five years from the date upon which it becomes a member of the Union.

#### **ARTICLE 27**

### **Application of Earlier Acts**

(1) The present Act shall, as regards the relations between the countries to which it applies, and to the extent that it applies, replace the Convention of Paris of March 20, 1883, and the subsequent Acts of revision.

(2) (a) As regards the countries to which the present Act does not apply, or does not apply in its entirety, but to which the Lisbon Act of October 31, 1958, applies, the latter shall remain in force in its entirety or to the extent that the present Act does not replace it by virtue of paragraph (1).

(b) Similarly, as regards the countries to which neither the present Act, nor portions thereof, nor the Lisbon Act applies, the London Act of June 2, 1934, shall remain in force in its entirety or to the extent that the present Act does not replace it by virtue of paragraph (1).

(c) Similarly, as regards the countries to which neither the present Act, nor portions thereof, nor the Lisbon Act, nor the London Act applies, the Hague Act of November 6, 1925, shall remain in force in its entirety or to the extent that the present Act does not replace it by virtue of paragraph (1).

(3) Countries outside the Union which become party to this Act shall apply it with respect to any country of the Union not party to this Act or which, although party to this Act, has made a declaration pursuant to Article 20(1)(b)(i). Such countries recognize that the said country of the Union may apply, in its relations with them, the provisions of the most recent Act to which it is party.

### **ARTICLE 28**

#### **Disputes**

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

(2) Each country may, at the time it signs this Act or deposits its instrument of ratification or accession, declare that it does not consider itself bound by the provisions of paragraph (1). With regard to any dispute between such country and any other country of the Union, the provisions of paragraph (1) shall not apply.

(3) Any country having made a declaration in accordance with the provisions of paragraph (2) may, at any time, withdraw its declaration by notification addressed to the Director-General.

### **ARTICLE 29**

#### **Signature, Languages, Depositary Functions**

(1) (a) This Act shall be signed in a single copy in the French language and shall be deposited with the Government of Sweden.

(b) Official texts shall be established by the Director-General, after consultation with the interested Governments, in the English, German, Italian, Portuguese, Russian and Spanish languages, and such other languages as the Assembly may designate.

(c) In case of differences of opinion on the interpretation of the various texts, the French text shall prevail.

(2) This Act shall remain open for signature at Stockholm until January 13, 1968.

(3) The Director-General shall transmit two copies, certified by the Government of Sweden, of the signed text of this Act to the Governments of all countries of the Union and, on request, to the Government of any other country.

(4) The Director-General shall register this Act with the Secretariat of the United Nations.

(5) The Director-General shall notify the Governments of all countries of the Union of signatures, deposits of instruments of ratification or accession and any declarations included in such instruments or made pursuant to Article 20(1)(c), entry into force of any provisions of this Act, notifications of denunciation, and notifications pursuant to Article 24.

### **ARTICLE 30**

#### **Transitional Provisions**

(1) Until the first Director-General assumes office, references in this Act to the International Bureau of the Organization or to the Director-General shall be deemed to be references to the Bureau of the Union or its Director, respectively.

(2) Countries of the Union not bound by Articles 13 to 17 may, until five years after the entry into force

of the Convention establishing the Organization, exercise, if they so desire, the rights provided under Articles 13 to 17 of this Act as if they were bound by those Articles. Any country desiring to exercise such rights shall give written notification to that effect to the Director-General; such notification shall be effective from the date of its receipt. Such countries shall be deemed to be members of the Assembly until the expiration of the said period.

(3) As long as all the countries of the Union have not become Members of the Organization, the International Bureau of the Organization shall also function as the Bureau of the Union, and the Director-General as the Director of the said Bureau.

(4) Once all the countries of the Union have become Members of the Organization, the rights, obligations, and property, of the Bureau of the Union shall devolve on the International Bureau of the Organization.

## **SECOND SCHEDULE**

### **AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS**

#### PART I

#### GENERAL PROVISIONS AND BASIC PRINCIPLES

#### PART II

#### STANDARDS CONCERNING THE AVAILABILITY, SCOPE AND USE OF INTELLECTUAL PROPERTY RIGHTS

1. Copyright and Related Rights
2. Trademarks
3. Geographical Indications
4. Industrial Designs
5. Patents
6. Layout-Designs (Topographies) of Integrated Circuits
7. Protection of Undisclosed Information
8. Control of Anti-Competitive Practices in Contractual Licences

#### PART III

#### ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS

1. General Obligations
2. Civil and Administrative Procedures and Remedies
3. Provisional Measures
4. Special Requirements related to Border Measures
5. Criminal Procedures

#### PART IV

#### ACQUISITION AND MAINTENANCE OF INTELLECTUAL PROPERTY RIGHTS AND RELATED *INTER PARTES* PROCEDURES

#### PART V

#### DISPUTE PREVENTION AND SETTLEMENT

#### PART VI

#### TRANSITIONAL ARRANGEMENTS

#### PART VII

#### INSTITUTIONAL ARRANGEMENTS; FINAL PROVISIONS

### **AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS**

*Members,*

*Desiring* to reduce 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;

*Recognizing*, to this end, the need for new rules and disciplines concerning:

- (a) the applicability of the basic principles of GATT 1994 and of relevant international intellectual property agreements or 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 and appropriate means for the enforcement of trade-related intellectual property rights, taking into account differences in national legal systems;
  - (d) the provision of effective and expeditious procedures for the multilateral prevention and settlement of disputes between governments; and
  - (e) transitional arrangements aiming at the fullest participation in the results of the negotiations;
- Recognizing* the need for a multilateral framework of principles, rules and disciplines dealing with international trade in counterfeit goods;
- Recognizing* that intellectual property rights are private rights;
- Recognizing* the underlying public policy objectives of national systems for the protection of intellectual property, including developmental and technological objectives;
- Recognizing* also the special needs of the least-developed country Members in respect of maximum flexibility in the domestic implementation of laws and regulations in order to enable them to create a sound and viable technological base;
- Emphasizing* the importance of reducing tensions by reaching strengthened commitments to resolve disputes on trade-related intellectual property issues through multilateral procedures;
- Desiring* to establish a mutually supportive relationship between the WTO and the World Intellectual Property Organization (referred to in this Agreement as "WIPO") as well as other relevant international organizations;
- Hereby agree* as follows:

## **PART I GENERAL PROVISIONS AND BASIC PRINCIPLES**

### **ARTICLE 1**

#### ***Nature and Scope of Obligations***

1. Members shall give effect to the provisions of this Agreement. Members may, but shall not be obliged to, implement in their law more extensive protection than is required by this Agreement, provided that such protection does not contravene the provisions of this Agreement. Members shall be free to determine the appropriate method of implementing the provisions of this Agreement within their own legal system and practice.
2. For the purposes of this Agreement, the term "intellectual property" refers to all categories of intellectual property that are the subject of Sections 1 through 7 of Part II.
3. Members shall accord the treatment provided for in this Agreement to the nationals of other Members. <sup>i</sup>1 In respect of the relevant intellectual property right, the nationals of other Members shall be understood as those natural or legal persons that would meet the criteria for eligibility for protection provided for in the Paris Convention (1967), the Berne Convention (1971), the Rome Convention and the Treaty on Intellectual Property in Respect of Integrated Circuits, were all Members of the WTO members of those conventions. <sup>ii</sup>2 Any Member availing itself of the possibilities provided in paragraph 3 of Article 5 or paragraph 2 of Article 6 of the Rome Convention shall make a notification as foreseen in those provisions to the Council for Trade-Related Aspects of Intellectual Property Rights (the "Council for TRIPS").

### **ARTICLE 2**

#### ***Intellectual Property Conventions***

1. In respect of Parts II, III and IV of this Agreement, Members shall comply with Articles 1 through 12, and Article 19, of the Paris Convention (1967).
2. Nothing in Parts I to IV of this Agreement shall derogate from existing obligations that Members may have to each other under the Paris Convention, the Berne Convention, the Rome Convention and the Treaty on Intellectual Property in Respect of Integrated Circuits.

### **ARTICLE 3**

#### ***National Treatment***

1. Each Member shall accord to the nationals of other Members treatment no less favourable than that it accords to its own nationals with regard to the protection <sup>iv</sup>3 of intellectual property, subject to the exceptions already provided in, respectively, the Paris Convention (1967), the Berne Convention (1971), the Rome Convention or the Treaty on Intellectual Property in Respect of Integrated Circuits. In respect of performers, producers of phonograms and broadcasting organizations, this obligation only applies in



respect of the rights provided under this Agreement. Any Member availing itself of the possibilities provided in Article 6 of the Berne Convention (1971) or paragraph 1(b) of Article 16 of the Rome Convention shall make a notification as foreseen in those provisions to the Council for TRIPS.

2. Members may avail themselves of the exceptions permitted under paragraph 1 in relation to judicial and administrative procedures, including the designation of an address for service or the appointment of an agent within the jurisdiction of a Member, only where such exceptions are necessary to secure compliance with laws and regulations which are not inconsistent with the provisions of this Agreement and where such practices are not applied in a manner which would constitute a disguised restriction on trade.

#### **ARTICLE 4**

##### ***Most-Favoured-Nation Treatment***

With regard to the protection of intellectual property, any advantage, favour, privilege or immunity granted by a Member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other Members. Exempted from this obligation are any advantage, favour, privilege or immunity accorded by a Member:

- (a) deriving from international agreements on judicial assistance or law enforcement of a general nature and not particularly confined to the protection of intellectual property;
- (b) granted in accordance with the provisions of the Berne Convention (1971) or the Rome Convention authorizing that the treatment accorded be a function not of national treatment but of the treatment accorded in another country;
- (c) in respect of the rights of performers, producers of phonograms and broadcasting organizations not provided under this Agreement;
- (d) deriving from international agreements related to the protection of intellectual property which entered into force prior to the entry into force of the WTO Agreement, provided that such agreements are notified to the Council for TRIPS and do not constitute an arbitrary or unjustifiable discrimination against nationals of other Members.

#### **ARTICLE 5**

##### ***Multilateral Agreements on Acquisition or Maintenance of Protection***

The obligations under Articles 3 and 4 do not apply to procedures provided in multilateral agreements concluded under the auspices of WIPO relating to the acquisition or maintenance of intellectual property rights.

#### **ARTICLE 6**

##### ***Exhaustion***

For the purposes of dispute settlement under this Agreement, subject to the provisions of Articles 3 and 4 nothing in this Agreement shall be used to address the issue of the exhaustion of intellectual property rights.

#### **ARTICLE 7**

##### ***Objectives***

The protection and enforcement of intellectual property rights should contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations.

#### **ARTICLE 8**

##### ***Principles***

1. Members may, in formulating or amending their laws and regulations, adopt measures necessary to protect public health and nutrition, and to promote the public interest in sectors of vital importance to their socio-economic and technological development, provided that such measures are consistent with the provisions of this Agreement.

2. Appropriate measures, provided that they are consistent with the provisions of this Agreement, may be needed to prevent the abuse of intellectual property rights by right holders or the resort to practices which unreasonably restrain trade or adversely affect the international transfer of technology.

#### **PART II**

### **STANDARDS CONCERNING THE AVAILABILITY, SCOPE AND USE OF INTELLECTUAL PROPERTY RIGHTS**

**SECTION 1**  
**COPYRIGHT AND RELATED RIGHTS**  
**ARTICLE 9**

***Relation to the Berne Convention***

1. Members shall comply with Articles 1 through 21 of the Berne Convention (1971) and the Appendix thereto. However, Members shall not have rights or obligations under this Agreement in respect of the rights conferred under Article 6*bis* of that Convention or of the rights derived therefrom.
2. Copyright protection shall extend to expressions and not to ideas, procedures, methods of operation or mathematical concepts as such.

**ARTICLE 10**

***Computer Programs and Compilations of Data***

1. Computer programs, whether in source or object code, shall be protected as literary works under the Berne Convention (1971).
2. 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. Such protection, which shall not extend to the data or material itself, shall be without prejudice to any copyright subsisting in the data or material itself.

**ARTICLE 11**

***Rental Rights***

In respect of at least computer programs and cinematographic works, a Member shall provide authors and their successors in title the right to authorize or to prohibit the commercial rental to the public of originals or copies of their copyright works. A Member shall be excepted from this obligation in respect of cinematographic works unless such rental has led to widespread copying of such works which is materially impairing the exclusive right of reproduction conferred in that Member on authors and their successors in title. In respect of computer programs, this obligation does not apply to rentals where the program itself is not the essential object of the rental.

**ARTICLE 12**

***Term of Protection***

Whenever the term of protection of a work, other than a photographic work or a work of applied art, is calculated on a basis other than the life of a natural person, such term shall be no less than 50 years from the end of the calendar year of authorized publication, or, failing such authorized publication within 50 years from the making of the work, 50 years from the end of the calendar year of making.

**ARTICLE 13**

***Limitations and Exceptions***

Members shall confine limitations or exceptions to exclusive rights to certain special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder.

**ARTICLE 14**

***Protection of Performers, Producers of Phonograms (Sound Recordings) and Broadcasting Organizations***

1. In respect of a fixation of their performance on a phonogram, performers shall have the possibility of preventing the following acts when undertaken without their authorization: the fixation of their unfixed performance and the reproduction of such fixation. Performers shall also have the possibility of preventing the following acts when undertaken without their authorization: the broadcasting by wireless means and the communication to the public of their live performance.
2. Producers of phonograms shall enjoy the right to authorize or prohibit the direct or indirect reproduction of their phonograms.
3. Broadcasting organizations shall have the right to prohibit the following acts when undertaken without their authorization: the fixation, the reproduction of fixations, and the rebroadcasting by wireless means of broadcasts, as well as the communication to the public of television broadcasts of the same. Where Members do not grant such rights to broadcasting organizations, they shall provide owners of copyright in the subject matter of broadcasts with the possibility of preventing the above acts, subject to the provisions of the Berne Convention (1971).
4. The provisions of Article 11 in respect of computer programs shall apply *mutatis mutandis* to

producers of phonograms and any other right holders in phonograms as determined in a Member's law. If on 15 April, 1994 a Member has in force a system of equitable remuneration of right holders in respect of the rental of phonograms, it may maintain such system provided that the commercial rental of phonograms is not giving rise to the material impairment of the exclusive rights of reproduction of right holders.

5. The term of the protection available under this Agreement to performers and producers of phonograms shall last at least until the end of a period of 50 years computed from the end of the calendar year in which the fixation was made or the performance took place. The term of protection granted pursuant to paragraph 3 shall last for at least 20 years from the end of the calendar year in which the broadcast took place.

6. Any Member may, in relation to the rights conferred under paragraphs 1, 2 and 3, provide for conditions, limitations, exceptions and reservations to the extent permitted by the Rome Convention. However, the provisions of Article 18 of the Berne Convention (1971) shall also apply, *mutatis mutandis*, to the rights of performers and producers of phonograms in phonograms.

## **SECTION 2 TRADEMARKS ARTICLE 15**

### ***Protectable Subject Matter***

1. Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.

2. Paragraph 1 shall not be understood to prevent a Member from denying registration of a trademark on other grounds, provided that they do not derogate from the provisions of the Paris Convention (1967).

3. Members may make registrability depend on use. However, actual use of a trademark shall not be a condition for filing an application for registration. An application shall not be refused solely on the ground that intended use has not taken place before the expiry of a period of three years from the date of application.

4. The nature of the goods or services to which a trademark is to be applied shall in no case form an obstacle to registration of the trademark.

5. Members shall publish each trademark either before it is registered or promptly after it is registered and shall afford a reasonable opportunity for petitions to cancel the registration. In addition, Members may afford an opportunity for the registration of a trademark to be opposed.

## **ARTICLE 16 *Rights Conferred***

1. The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.

2. Article 6*bis* of the Paris Convention (1967) shall apply, *mutatis mutandis*, to services. In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the trademark.

3. Article 6*bis* of the Paris Convention (1967) shall apply, *mutatis mutandis*, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.

## **ARTICLE 17**

### ***Exceptions***

Members may provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided that such exceptions take account of the legitimate interests of the owner of the trademark and of third parties.

### **ARTICLE 18**

#### ***Term of Protection***

Initial registration, and each renewal of registration, of a trademark shall be for a term of no less than seven years. The registration of a trademark shall be renewable indefinitely.

### **ARTICLE 19**

#### ***Requirement of Use***

1. If use is required to maintain a registration, the registration may be cancelled only after an uninterrupted period of at least three years of non-use, unless valid reasons based on the existence of obstacles to such use are shown by the trademark owner. Circumstances arising independently of the will of the owner of the trademark which constitute an obstacle to the use of the trademark, such as import restrictions on or other government requirements for goods or services protected by the trademark, shall be recognized as valid reasons for non-use.

2. When subject to the control of its owner, use of a trademark by another person shall be recognized as use of the trademark for the purpose of maintaining the registration.

### **ARTICLE 20**

#### ***Other Requirements***

The use of a trademark in the course of trade shall not be unjustifiably encumbered by special requirements, such as use with another trademark, use in a special form or use in a manner detrimental to its capability to distinguish the goods or services of one undertaking from those of other undertakings. This will not preclude a requirement prescribing the use of the trademark identifying the undertaking producing the goods or services along with, but without linking it to, the trademark distinguishing the specific goods or services in question of that undertaking

### **ARTICLE 21**

#### ***Licensing and Assignment***

Members may determine conditions on the licensing and assignment of trademarks, it being understood that the compulsory licensing of trademarks shall not be permitted and that the owner of a registered trademark shall have the right to assign the trademark with or without the transfer of the business to which the trademark belongs.

## **SECTION 3**

## **GEOGRAPHICAL INDICATIONS**

### **ARTICLE 22**

#### ***Protection of Geographical Indications***

1. Geographical indications are, for the purposes of this Agreement, indications which identify a good 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 good is essentially attributable to its geographical origin.

2. In respect of geographical indications, Members shall provide the legal means for interested parties to prevent:

- (a) the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good;
- (b) any use which constitutes an act of unfair competition within the meaning of Article 10*bis* of the Paris Convention (1967).

3. A Member shall, *ex officio* if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in that Member is of such a nature as to mislead the public as to the true place of origin.

4. The protection under paragraphs 1, 2 and 3 shall be applicable against a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory.

### **ARTICLE 23**

### ***Additional Protection for Geographical Indications for Wines and Spirits***

1. Each Member shall provide the legal means for interested parties to prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, 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.<sup>v4</sup>

2. The registration of a trademark for wines which contains or consists of a geographical indication identifying wines or for spirits which contains or consists of a geographical indication identifying spirits shall be refused or invalidated, *ex officio* if a Member's legislation so permits or at the request of an interested party, with respect to such wines or spirits not having this origin.

3. In the case of homonymous geographical indications for wines, protection shall be accorded to each indication, subject to the provisions of paragraph 4 of Article 22. Each Member shall determine the practical conditions under which the homonymous indications in question will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled.

4. In order to facilitate the protection of geographical indications for wines, negotiations shall be undertaken in the Council for TRIPS concerning the establishment of a multilateral system of notification and registration of geographical indications for wines eligible for protection in those Members participating in the system.

### **ARTICLE 24**

#### ***International Negotiations; Exceptions***

1. Members agree to enter into negotiations aimed at increasing the protection of individual geographical indications under Article 23. The provisions of paragraphs 4 through 8 below shall not be used by a Member to refuse to conduct negotiations or to conclude bilateral or multilateral agreements. In the context of such negotiations, Members shall be willing to consider the continued applicability of these provisions to individual geographical indications whose use was the subject of such negotiations.

2. The Council for TRIPS shall keep under review the application of the provisions of this Section; the first such review shall take place within two years of the entry into force of the WTO Agreement. Any matter affecting the compliance with the obligations under these provisions may be drawn to the attention of the Council, which, at the request of a Member, shall consult with any Member or Members in respect of such matter in respect of which it has not been possible to find a satisfactory solution through bilateral or plurilateral consultations between the Members concerned. The Council shall take such action as may be agreed to facilitate the operation and further the objectives of this Section.

3. In implementing this Section, a Member shall not diminish the protection of geographical indications that existed in that Member immediately prior to the date of entry into force of the WTO Agreement.

4. Nothing in this Section shall require a Member to prevent continued and similar use of a particular geographical indication of another Member identifying wines or spirits in connection with goods or services by any of its nationals or domiciliaries who have used that geographical indication in a continuous manner with regard to the same or related goods or services in the territory of that Member either (a) for at least 10 years preceding 15 April, 1994 or (b) in good faith preceding that date.

5. Where a trademark has been applied for or registered in good faith, or where rights to a trademark have been acquired through use in good faith either:

- (a) before the date of application of these provisions in that Member as defined in Part VI; or
- (b) before the geographical indication is protected in its country of origin,

measures adopted to implement this Section shall not prejudice eligibility for or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication.

6. Nothing in this Section shall require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to goods or services for which the relevant indication is identical with the term customary in common language as the common name for such goods or services in the territory of that Member. Nothing in this Section shall require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to products of the vine for which the relevant indication 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.

7. A Member may provide that any request made under this Section in connection with the use or

registration of a trademark must be presented within five years after the adverse use of the protected indication has become generally known in that Member or after the date of registration of the trademark in that Member provided that the trademark has been published by that date, if such date is earlier than the date on which the adverse use became generally known in that Member, provided that the geographical indication is not used or registered in bad faith.

8. The provisions of this Section shall in no way prejudice the right of any person to use, in the course of trade, that person's name or the name of that person's predecessor in business, except where such name is used in such a manner as to mislead the public.

9. There shall be no obligation under this Agreement 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.

## **SECTION 4 INDUSTRIAL DESIGNS ARTICLE 25**

### ***Requirements for Protection***

1. Members shall provide for the protection of independently created industrial designs that are new or original. Members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features. Members may provide that such protection shall not extend to designs dictated essentially by technical or functional considerations.

2. Each Member shall ensure that requirements for securing protection for textile designs, in particular in regard to any cost, examination or publication, do not unreasonably impair the opportunity to seek and obtain such protection. Members shall be free to meet this obligation through industrial design law or through copyright law.

## **ARTICLE 26 *Protection***

1. The owner of a protected industrial design shall have the right to prevent third parties not having the owner's consent from making, selling or importing articles bearing or embodying a design which is a copy, or substantially a copy, of the protected design, when such acts are undertaken for commercial purposes.

2. Members may provide limited exceptions to the protection of industrial designs, provided that such exceptions do not unreasonably conflict with the normal exploitation of protected industrial designs and do not unreasonably prejudice the legitimate interests of the owner of the protected design, taking account of the legitimate interests of third parties.

3. The duration of protection available shall amount to a least 10 years.

## **SECTION 5 PATENTS ARTICLE 27**

### ***Patentable Subject Matter***

1. Subject to the provisions of paragraphs 2 and 3, patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application. <sup>v</sup>5 Subject to paragraph 4 of Article 65, paragraph 8 of Article 70 and paragraph 3 of this Article, 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.

2. Members may exclude from patentability inventions, the prevention within their territory of the commercial exploitation of which is necessary to protect *ordre public* or morality, 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.

3. Members may also exclude from patentability:

- (a) diagnostic, therapeutic and surgical methods for the treatment of humans or animals;
  - (b) plants and animals other than micro-organisms, and essentially biological processes for the production of plants or animals other than non-biological and microbiological processes.
- 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. The provisions of this subparagraph shall be reviewed four years after the date of entry into force of the WTO Agreement.

## **ARTICLE 28 *Rights Conferred***

1. A patent shall confer on its owner the following exclusive rights:
  - (a) where the subject matter of a patent is a product, to prevent third parties not having the owner's consent from the acts of: making, using, offering for sale, selling, or importing <sup>vii</sup>6 for these purposes that product;
  - (b) where the subject matter of a patent is a process, to prevent third parties not having the owner's consent from the act of using the process, and from the acts of: using, offering for sale, selling, or importing for these purposes at least the product obtained directly by that process.
2. Patent owners shall also have the right to assign, or transfer by succession, the patent and to conclude licensing contracts.

## **ARTICLE 29**

### ***Conditions on Patent Applicants***

1. Members shall require that an applicant for a patent shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art and may require the applicant to indicate the best mode for carrying out the invention known to the inventor at the filing date or, where priority is claimed, at the priority date of the application.
2. Members may require an applicant for a patent to provide information concerning the applicant's corresponding foreign applications and grants.

## **ARTICLE 30**

### ***Exceptions to Rights Conferred***

Members may provide limited exceptions to the exclusive rights conferred by a patent, provided that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties.

## **ARTICLE 31**

### ***Other Use Without Authorization of the Right Holder***

Where the law of a Member allows for other use <sup>viii</sup>7 of the subject matter of a patent without the authorization of the right holder, including use by the government or third parties authorized by the government, the following provisions shall be respected:

- (a) authorization of such use shall be considered on its individual merits;
- (b) such use may only be permitted if, prior to such use, the proposed user has made efforts to obtain authorization from the right holder on reasonable commercial terms and conditions and that such efforts have not been successful within a reasonable period of time. This requirement may be waived by a Member in the case of a national emergency or other circumstances of extreme urgency or in cases of public non-commercial use. In situations of national emergency or other circumstances of extreme urgency, the right holder shall, nevertheless, be notified as soon as reasonably practicable. In the case of public non-commercial use, where the government or contractor, without making a patent search, knows or has demonstrable grounds to know that a valid patent is or will be used by or for the government, the right holder shall be informed promptly;
- (c) the scope and duration of such use shall be limited to the purpose for which it was authorized, and in the case of semi-conductor technology shall only be for public non-commercial use or to remedy a practice determined after judicial or administrative process to be anti-competitive;
- (d) such use shall be non-exclusive;
- (e) such use shall be non-assignable, except with that part of the enterprise or goodwill which enjoys such use;
- (f) any such use shall be authorized predominantly for the supply of the domestic market of the Member authorizing such use;
- (g) authorization for such use shall be liable, subject to adequate protection of the legitimate interests of the persons so authorized, to be terminated if and when the circumstances which led to it cease to exist and are unlikely to recur. The competent authority shall have the authority to review, upon motivated request, the continued existence of these circumstances;
- (h) the right holder shall be paid adequate remuneration in the circumstances of each case, taking into account the economic value of the authorization;
- (i) the legal validity of any decision relating to the authorization of such use shall be subject to judicial review or other independent review by a distinct higher authority in that Member;

- (j) any decision relating to the remuneration provided in respect of such use shall be subject to judicial review or other independent review by a distinct higher authority in that Member
- (k) Members are not obliged to apply the conditions set forth in subparagraphs (b) and (f) where such use is permitted to remedy a practice determined after judicial or administrative process to be anti-competitive. The need to correct anti-competitive practices may be taken into account in determining the amount of remuneration in such cases. Competent authorities shall have the authority to refuse termination of authorization if and when the conditions which led to such authorization are likely to recur;
- (l) where such use is authorized to permit the exploitation of a patent ("the second patent") which cannot be exploited without infringing another patent ("the first patent"), the following additional conditions shall apply:
  - (i) the invention claimed in the second patent shall involve an important technical advance of considerable economic significance in relation to the invention claimed in the first patent;
  - (ii) the owner of the first patent shall be entitled to a cross-licence on reasonable terms to use the invention claimed in the second patent; and
  - (iii) the use authorized in respect of the first patent shall be non-assignable except with the assignment of the second patent.

#### **ARTICLE 32**

#### ***Revocation/Forfeiture***

An opportunity for judicial review of any decision to revoke or forfeit a patent shall be available.

#### **ARTICLE 33**

#### ***Term of Protection***

The term of protection available shall not end before the expiration of a period of twenty years counted from the filing date.<sup>ix8</sup>

#### **ARTICLE 34**

#### ***Process Patents: Burden of Proof***

1. For the purposes of civil proceedings in respect of the infringement of the rights of the owner referred to in paragraph 1(b) of Article 28, if the subject matter of a patent is a process for obtaining a product, the judicial authorities shall have the authority to order the defendant to prove that the process to obtain an identical product is different from the patented process. Therefore, Members shall provide, in at least one of the following circumstances, that any identical product when produced without the consent of the patent owner shall, in the absence of proof to the contrary, be deemed to have been obtained by the patented process:

- (a) if the product obtained by the patented process is new;
- (b) if there is a substantial likelihood that the identical product was made by the process and the owner of the patent has been unable through reasonable efforts to determine the process actually used.

2. Any member shall be free to provide that the burden of proof indicated in paragraph 1 shall be on the alleged infringer only if the condition referred to in subparagraph (a) is fulfilled or only if the condition referred to in subparagraph (b) is fulfilled.

3. In the adduction of proof to the contrary, the legitimate interests of defendants in protecting their manufacturing and business secrets shall be taken into account.

#### **SECTION 6**

### **LAYOUT-DESIGNS (TOPOGRAPHIES) OF INTEGRATED CIRCUITS**

#### **ARTICLE 35**

#### ***Relation to the IPIC Treaty***

Members agree to provide protection to the layout-designs (topographies) of integrated circuits (referred to in this Agreement as "layout-designs") in accordance with Articles 2 through 7 (other than paragraph 3 of Article 6), Article 12 and paragraph 3 of Article 16 of the Treaty on Intellectual Property in Respect of Integrated Circuits and, in addition, to comply with the following provisions.

#### **ARTICLE 36**

#### ***Scope of the Protection***

Subject to provisions of paragraph 1 of Article 37, Members shall consider unlawful the following acts if performed without the authorization of the right holder:<sup>x9</sup> importing, selling, or otherwise distributing for commercial purposes a protected layout-design, an integrated circuit in which a protected layout-design is



incorporated, or an article incorporating such an integrated circuit only in so far as it continues to contain an unlawfully reproduced layout-design.

#### **ARTICLE 37**

##### ***Acts Not Requiring the Authorization of the Right Holder***

1. Notwithstanding Article 36, no Member shall consider unlawful the performance of any of the acts referred to in that Article in respect of an integrated circuit incorporating an unlawfully reproduced layout-design or any article incorporating such an integrated circuit where the person performing or ordering such acts did not know and had no reasonable ground to know, when acquiring the integrated circuit or article incorporating such an integrated circuit, that it incorporated an unlawfully reproduced layout-design. Members shall provide that, after the time that such person has received sufficient notice that the layout-design was unlawfully reproduced, that person may perform any of the acts with respect to the stock on hand or ordered before such time, but shall be liable to pay to the right holder a sum equivalent to a reasonable royalty such as would be payable under a freely negotiated licence in respect of such a layout-design.

2. The conditions set out in subparagraphs (a) through (k) of Article 31 shall apply *mutatis mutandis* in the event of any non-voluntary licensing of a layout-design or of its use by or for the government without the authorization of the right holder.

#### **ARTICLE 38**

##### ***Term of Protection***

1. In Members requiring registration as a condition of protection, the term of protection of layout-designs shall not end before the expiration of a period of 10 years counted from the date of filing an application for registration or from the first commercial exploitation wherever in the world it occurs.

2. In Members not requiring registration as a condition for protection, layout-designs shall be protected for a term of no less than 10 years from the date of the first commercial exploitation wherever in the world it occurs.

3. Notwithstanding paragraphs 1 and 2, a Member may provide that protection shall lapse 15 years after the creation of the layout-design.

#### **SECTION 7**

#### **PROTECTION OF UNDISCLOSED INFORMATION**

##### **ARTICLE 39**

1. In the course of ensuring effective protection against unfair competition as provided in Article 10bis of the Paris Convention (1967), Members shall protect undisclosed information in accordance with paragraph 2 and data submitted to governments or governmental agencies in accordance with paragraph 3.

2. 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<sup>xi</sup> so long as such information:

- (a) is secret in the sense that it is not, as a body or in the precise configuration and assembly of its components, generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question;
- (b) has commercial value because it is secret; and
- (c) has been subject to reasonable steps under the circumstances, by the person lawfully in control of the information, to keep it secret.

3. Members, when requiring, as a condition of approving the marketing of pharmaceutical or of agricultural chemical products which utilize new chemical entities, the submission of undisclosed test or other data, the origination of which involves a considerable effort, shall protect such data against unfair commercial use. In addition, members shall protect such data against disclosure, except where necessary to protect the public, or unless steps are taken to ensure that the data are protected against unfair commercial use.

#### **SECTION 8**

#### **CONTROL OF ANTI-COMPETITIVE PRACTICES IN CONTRACTUAL LICENCES**

##### **ARTICLE 40**

1. Members agree 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.

2. Nothing in this Agreement shall prevent Members from specifying in their legislation licensing practices or conditions that may in particular cases constitute an abuse of intellectual property rights having an adverse effect on competition in the relevant market. As provided above, a Member may adopt, consistently with the other provisions of this Agreement, appropriate measures to prevent or control such practices, which may include for example exclusive grantback conditions, conditions preventing challenges to validity and coercive package licensing, in the light of the relevant laws and regulations of that member.

3. Each Member shall enter, upon request, into consultations with any other Member which has cause to believe that an intellectual property right owner that is a national or domiciliary of the Member to which the request for consultations has been addressed is undertaking practices in violation of the requesting Member's laws and regulations on the subject matter of this section, and which wishes to secure compliance with such legislation, without prejudice to any action under the law and to the full freedom of an ultimate decision of either Member. The Member addressed shall accord full and sympathetic consideration to, and shall afford adequate opportunity for, consultations with the requesting Member, and shall co-operate through supply of publicly available non-confidential information of relevance to the matter in question and of other information available to the Member, subject to domestic law and to the conclusion of mutually satisfactory agreements concerning the safeguarding of its confidentiality by the requesting Member.

4. A Member whose nationals or domiciliaries are subject to proceedings in another Member concerning alleged violation of that other Member's laws and regulations on the subject matter of this section shall, upon request, be granted an opportunity for consultations by the other Member under the same conditions as those foreseen in paragraph 3.

**PART III**  
**ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS**  
**SECTION 1**  
**GENERAL OBLIGATIONS**  
**ARTICLE 41**

1. Members shall ensure that enforcement procedures as specified in this Part are available under their law so as to permit effective action against any act of infringement of intellectual property rights covered by this Agreement, including expeditious remedies to prevent infringements and remedies which constitute a deterrent to further infringements. These procedures shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.

2. Procedures concerning the enforcement of intellectual property rights shall be fair and equitable. They shall not be unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays.

3. Decisions on the merits of a case shall preferably be in writing and reasoned. They shall be made available at least to the parties to the proceeding without undue delay. Decisions on the merits of a case shall be based only on evidence in respect of which parties were offered the opportunity to be heard.

4. Parties to a proceeding shall have an opportunity for review by a judicial authority of final administrative decisions and, subject to jurisdictional provisions in a Member's law concerning the importance of a case, of at least the legal aspects of initial judicial decisions on the merits of a case. However, there shall be no obligation to provide an opportunity for review of acquittals in criminal cases.

5. It is understood that this Part does not create any obligation to put in place a judicial system for the enforcement of intellectual property rights distinct from that for the enforcement of law in general, nor does it affect the capacity of Members to enforce their law in general. Nothing in this Part creates any obligation with respect to the distribution of resources as between enforcement of intellectual property rights and the enforcement of law in general.

**SECTION 2**  
**CIVIL AND ADMINISTRATIVE PROCEDURES AND REMEDIES**  
**ARTICLE 42**

***Fair and Equitable Procedures***

Members shall make available to right holders<sup>xii</sup> 11 civil judicial procedures concerning the enforcement of any intellectual property right covered by this Agreement. Defendants shall have the right to written notice which is timely and contains sufficient detail, including the basis of the claims. Parties shall be allowed to be represented by independent legal counsel, and procedures shall not impose overly

burdensome requirements concerning mandatory personal appearances. All parties to such procedures shall be duly entitled to substantiate their claims and to present all relevant evidence. The procedure shall provide a means to identify and protect confidential information, unless this would be contrary to existing constitutional requirements.

#### **ARTICLE 43**

##### ***Evidence***

1. The judicial authorities shall have the authority, where a party has presented reasonably available evidence sufficient to support its claims and has specified evidence relevant to substantiation of its claims which lies in the control of the opposing party, to order that this evidence be produced by the opposing party, subject in appropriate cases to conditions which ensure the protection of confidential information.

2. In cases in which a party to a proceeding voluntarily and without good reason refuses access to, or otherwise does not provide necessary information within a reasonable period, or significantly impedes a procedure relating to an enforcement action, a Member may accord judicial authorities the authority to make preliminary and final determinations, affirmative or negative, on the basis of the information presented to them, including the complaint or the allegation presented by the party adversely affected by the denial of access to information, subject to providing the parties an opportunity to be heard on the allegations or evidence.

#### **ARTICLE 44**

##### ***Injunctions***

1. The judicial authorities shall have the authority to order a party to desist from an infringement, *inter alia* to prevent the entry into the channels of commerce in their jurisdiction of imported goods that involve the infringement of an intellectual property right, immediately after customs clearance of such goods. Members are not obliged to accord such authority in respect of protected subject matter acquired or ordered by a person prior to knowing or having reasonable grounds to know that dealing in such subject matter would entail the infringement of an intellectual property right.

2. Notwithstanding the other provisions of this Part and provided that the provisions of Part II specifically addressing use by governments, or by third parties authorized by a government, without the authorization of the right holder are complied with, members may limit the remedies available against such use to payment of remuneration in accordance with subparagraph (h) of Article 31. In other cases, the remedies under this Part shall apply or, where these remedies are inconsistent with a Member's law, declaratory judgments and adequate compensation shall be available.

#### **ARTICLE 45**

##### ***Damages***

1. The judicial authorities shall have the authority to order the infringer to pay the right holder damages adequate to compensate for the injury the right holder has suffered because of an infringement of that person's intellectual property right by an infringer who knowingly, or with reasonable grounds to know, engaged in infringing activity.

2. The judicial authorities shall also have the authority to order the infringer to pay the right holder expenses, which may include appropriate attorney's fees. In appropriate cases, Members may authorize the judicial authorities to order recovery of profits and/or payment of pre-established damages even where the infringer did not knowingly, or with reasonable grounds to know, engage in infringing activity.

#### **ARTICLE 46**

##### ***Other Remedies***

In order to create an effective deterrent to infringement, the judicial authorities shall have the authority to order that goods that they have found to be infringing be, without compensation of any sort, disposed of outside the channels of commerce in such a manner as to avoid any harm caused to the right holder, or, unless this would be contrary to existing constitutional requirements, destroyed. The judicial authorities shall also have the authority to order that materials and implements the predominant use of which has been in the creation of the infringing goods be, without compensation of any sort, disposed of outside the channels of commerce in such a manner as to minimize the risks of further infringements. In considering such requests, the need for proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties shall be taken into account. In regard to counterfeit trademark goods, the simple removal of the trademark unlawfully affixed shall not be sufficient, other than in exceptional cases, to permit release of the goods into the channels of commerce.

#### **ARTICLE 47**

### ***Right of Information***

Members may provide that the judicial authorities shall have the authority, unless this would be out of proportion to the seriousness of the infringement, to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the infringing goods or services and of their channels of distribution.

### **ARTICLE 48**

#### ***Indemnification of the Defendant***

1. The judicial authorities shall have the authority to order a party at whose request measures were taken and who has abused enforcement procedures to provide to a party wrongfully enjoined or restrained adequate compensation for the injury suffered because of such abuse. The judicial authorities shall also have the authority to order the applicant to pay the defendant's expenses, which may include appropriate attorney's fees.

2. In respect of the administration of any law pertaining to the protection or enforcement of intellectual property rights, Members shall only exempt both public authorities and officials from liability to appropriate remedial measures where actions are taken or intended in good faith in the course of the administration of that law.

### **ARTICLE 49**

#### ***Administrative Procedures***

To the extent that any civil remedy can be ordered as a result of administrative procedures on the merits of a case, such procedures shall conform to principles equivalent in substance to those set forth in this Section.

### **SECTION 3**

### **PROVISIONAL MEASURES**

### **ARTICLE 50**

1. The judicial authorities shall have the authority to order prompt and effective provisional measures:

- (a) to prevent an infringement of any intellectual property right from occurring, and in particular to prevent the entry into the channels of commerce in their jurisdiction of goods, including imported goods immediately after customs clearance;
- (b) to preserve relevant evidence in regard to the alleged infringement.

2. The judicial authorities shall have the authority to adopt provisional measures *inaudita altera parte* where appropriate, in particular where any delay is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk of evidence being destroyed.

3. The judicial authorities shall have the authority to require the applicant to provide any reasonably available evidence in order to satisfy themselves with a sufficient degree of certainty that the applicant is the right holder and that the applicant's right is being infringed or that such infringement is imminent, and to order the applicant to provide a security or equivalent assurance sufficient to protect the defendant and to prevent abuse.

4. Where provisional measures have been adopted *inaudita altera parte*, the parties affected shall be given notice, without delay after the execution of the measures at the latest. A review, including a right to be heard, shall take place upon request of the defendant with a view to deciding, within a reasonable period after the notification of the measures, whether these measures shall be modified, revoked or confirmed.

5. The applicant may be required to supply other information necessary for the identification of the goods concerned by the authority that will execute the provisional measures.

6. Without prejudice to paragraph 4, provisional measures taken on the basis of paragraphs 1 and 2 shall, upon request by the defendant, be revoked or otherwise cease to have effect, if proceedings leading to a decision on the merits of the case are not initiated within a reasonable period, to be determined by the judicial authority ordering the measures where a Member's law so permits or, in the absence of such a determination, not to exceed 20 working days or 31 calendar days, whichever is the longer.

7. Where the provisional measures are revoked or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of an intellectual property right, the judicial authorities shall have the authority to order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by these measures.

8. To the extent that any provisional measure can be ordered as a result of administrative procedures, such procedures shall conform to principles equivalent in substance to those set forth in this Section.

#### **SECTION 4**

### **SPECIAL REQUIREMENTS RELATED TO BORDER MEASURES <sup>xiii</sup>12**

#### **ARTICLE 51**

##### ***Suspension of Release by Customs Authorities***

Members shall, in conformity with the provisions set out below, adopt procedures <sup>xiv</sup>13 to enable a right holder, who has valid grounds for suspecting that the importation of counterfeit trademark or pirated copyright goods <sup>xv</sup>14 may take place, to lodge an application in writing with competent authorities, administrative or judicial, for the suspension by the customs authorities of the release into free circulation of such goods. Members may enable such an application to be made in respect of goods which involve other infringements of intellectual property rights, provided that the requirements of this Section are met. Members may also provide for corresponding procedures concerning the suspension by the customs authorities of the release of infringing goods destined for exportation from their territories.

#### **ARTICLE 52**

##### ***Application***

Any right holder initiating the procedures under Article 51 shall be required to provide adequate evidence to satisfy the competent authorities that, under the laws of the country of importation, there is *prima facie* an infringement of the right holder's intellectual property right and to supply a sufficiently detailed description of the goods to make them readily recognizable by the customs authorities. The competent authorities shall inform the applicant within a reasonable period whether they have accepted the application and, where determined by the competent authorities, the period for which the customs authorities will take action.

#### **ARTICLE 53**

##### ***Security or Equivalent Assurance***

1. The competent authorities shall have the authority to require an applicant to provide a security or equivalent assurance sufficient to protect the defendant and the competent authorities and to prevent abuse. Such security or equivalent assurance shall not unreasonably deter recourse to these procedures.

2. Where pursuant to an application under this Section the release of goods involving industrial designs, patents, layout-designs or undisclosed information into free circulation has been suspended by customs authorities on the basis of a decision other than by a judicial or other independent authority, and the period provided for in Article 55 has expired without the granting of provisional relief by the duly empowered authority, and provided that all other conditions for importation have been complied with, the owner, importer, or consignee of such goods shall be entitled to their release on the posting of a security in an amount sufficient to protect the right holder for any infringement. Payment of such security shall not prejudice any other remedy available to the right holder, it being understood that the security shall be released if the right holder fails to pursue the right of action within a reasonable period of time.

#### **ARTICLE 54**

##### ***Notice of Suspension***

The importer and the applicant shall be promptly notified of the suspension of the release of goods according to Article 51.

#### **ARTICLE 55**

##### ***Duration of Suspension***

If, within a period not exceeding 10 working days after the applicant has been served notice of the suspension, the customs authorities have not been informed that proceedings leading to a decision on the merits of the case have been initiated by a party other than the defendant, or that the duly empowered authority has taken provisional measures prolonging the suspension of the release of the goods, the goods shall be released, provided that all other conditions for importation or exportation have been complied with; in appropriate cases, this time-limit may be extended by another 10 working days. If proceedings leading to a decision on the merits of the case have been initiated, a review, including a right to be heard, shall take place upon request of the defendant with a view to deciding, within a reasonable period, whether these measures shall be modified, revoked or confirmed. Notwithstanding the above, where the suspension of the release of goods is carried out or continued in accordance with a provisional judicial measure, the provisions of paragraph 6 of Article 50 shall apply.

## **ARTICLE 56**

### ***Indemnification of the Importer and of the Owner of the Goods***

Relevant authorities shall have the authority to order the applicant to pay the importer, the consignee and the owner of the goods appropriate compensation for any injury caused to them through the wrongful detention of goods or through the detention of goods released pursuant to Article 55.

## **ARTICLE 57**

### ***Right of Inspection and Information***

Without prejudice to the protection of confidential information, Members shall provide the competent authorities the authority to give the right holder sufficient opportunity to have any goods detained by the customs authorities inspected in order to substantiate the right holder's claims. The competent authorities shall also have authority to give the importer an equivalent opportunity to have any such goods inspected. Where a positive determination has been made on the merits of a case, Members may provide the competent authorities the authority to inform the right holder of the names and addresses of the consignor, the importer and the consignee and of the quantity of the goods in question.

## **ARTICLE 58**

### ***Ex Officio Action***

Where Members require competent authorities to act upon their own initiative and to suspend the release of goods in respect of which they have acquired *prima facie* evidence that an intellectual property right is being infringed:

- (a) the competent authorities may at any time seek from the right holder any information that may assist them to exercise these powers;
- (b) the importer and the right holder shall be promptly notified of the suspension. Where the importer has lodged an appeal against the suspension with the competent authorities, the suspension shall be subject to the conditions, *mutatis mutandis*, set out at Article 55;
- (c) Members shall only exempt both public authorities and officials from liability to appropriate remedial measures where actions are taken or intended in good faith.

## **ARTICLE 59**

### ***Remedies***

Without prejudice to other rights of action open to the right holder and subject to the right of the defendant to seek review by a judicial authority, competent authorities shall have the authority to order the destruction or disposal of infringing goods in accordance with the principles set out in Article 46. In regard to counterfeit trademark goods, the authorities shall not allow the re-exportation of the infringing goods in an unaltered state or subject them to a different customs procedure, other than in exceptional circumstances.

## **ARTICLE 60**

### ***De Minimis Imports***

Members may exclude from the application of the above provisions small quantities of goods of a non-commercial nature contained in travellers' personal luggage or sent in small consignments.

## **SECTION 5**

### **CRIMINAL PROCEDURES**

## **ARTICLE 61**

Members shall provide for criminal procedures and penalties to be applied at least in cases of wilful trademark counterfeiting or copyright piracy on a commercial scale. Remedies available shall include imprisonment and/or monetary fines sufficient to provide a deterrent, consistently with the level of penalties applied for crimes of a corresponding gravity. In appropriate cases, remedies available shall also include the seizure, forfeiture and destruction of the infringing goods and of any materials and implements the predominant use of which has been in the commission of the offence. Members may provide for criminal procedures and penalties to be applied in other cases of infringement of intellectual property rights, in particular where they are committed wilfully and on a commercial scale.

## **PART IV**

### **ACQUISITION AND MAINTENANCE OF INTELLECTUAL PROPERTY RIGHTS AND RELATED *INTER PARTES* PROCEDURES**

## **ARTICLE 62**

1. Members may require, as a condition of the acquisition or maintenance of the intellectual property

rights provided for under Sections 2 through 6 of Part II, compliance with reasonable procedures and formalities. Such procedures and formalities shall be consistent with the provisions of this Agreement.

2. Where the acquisition of an intellectual property right is subject to the right being granted or registered, Members shall ensure that the procedures for grant or registration, subject to compliance with the substantive conditions for acquisition of the right, permit the granting or registration of the right within a reasonable period of time so as to avoid unwarranted curtailment of the period of protection.

3. Article 4 of the Paris Convention (1967) shall apply *mutatis mutandis* to service marks.

4. Procedures concerning the acquisition or maintenance of intellectual property rights and, where a Member's law provides for such procedures, administrative revocation and *inter partes* procedures such as opposition, revocation, cancellation, shall be governed by the general principles set out in paragraphs 2 and 3 of Article 41.

5. Final administrative decisions in any of the procedures referred to under paragraph 4 shall be subject to review by a judicial or quasi-judicial authority. However, there shall be no obligation to provide an opportunity for such review of decisions in cases of unsuccessful opposition or administrative revocation, provided that the grounds for such procedures can be the subject of invalidation procedures.

## **PART V**

### **DISPUTE PREVENTION AND SETTLEMENT**

#### **ARTICLE 63**

##### ***Transparency***

1. Laws and regulations, and final judicial decisions and administrative rulings of general application, made effective by a Member pertaining to the subject matter of this Agreement (the availability, scope, acquisition, enforcement and prevention of the abuse of intellectual property rights) shall be published, or where such publication is not practicable made publicly available, in a national language, in such a manner as to enable governments and right holders to become acquainted with them. Agreements concerning the subject matter of this Agreement which are in force between the government or a governmental agency of a Member and the government or a governmental agency of another Member shall also be published.

2. Members shall notify the laws and regulations referred to in paragraph 1 to the Council for TRIPS in order to assist that Council in its review of the operation of this Agreement. The Council shall attempt to minimize the burden on Members in carrying out this obligation and may decide to waive the obligation to notify such laws and regulations directly to the Council if consultations with WIPO on the establishment of a common register containing these laws and regulations are successful. The Council shall also consider in this connection any action required regarding notifications pursuant to the obligations under this Agreement stemming from the provisions of Article 6*ter* of the Paris Convention (1967).

3. Each Member shall be prepared to supply, in response to a written request from another Member, information of the sort referred to in paragraph 1. A Member, having reason to believe that a specific judicial decision or administrative ruling or bilateral agreement in the area of intellectual property rights affects its right under this Agreement, may also request in writing to be given access to or be informed in sufficient detail of such specific judicial decisions or administrative rulings or bilateral agreements.

4. Nothing in paragraph 1, 2 and 3 shall require Members to disclose confidential information which would impede law enforcement or otherwise be contrary to the public interest or would prejudice the legitimate commercial interests of particular enterprises, public or private.

#### **ARTICLE 64**

##### ***Dispute Settlement***

1. The provisions of Articles XXII and XXIII of GATT 1994 as elaborated and applied by the Dispute Settlement Understanding shall apply to consultations and the settlement of disputes under this Agreement except as otherwise specifically provided herein.

2. Subparagraphs 1(b) and 1(c) of Article XXIII of GATT 1994 shall not apply to the settlement of disputes under this Agreement for a period of five years from the date of entry into force of the WTO Agreement.

3. During the time period referred to in paragraph 2, the Council for TRIPS shall examine the scope and modalities for complaints of the type provided for under subparagraphs 1(b) and 1(c) of Article XXIII of GATT 1994 made pursuant to this Agreement, and submit its recommendations to the Ministerial Conference for approval. Any decision of the Ministerial Conference to approve such recommendations or to extend the period in paragraph 2 shall be made only by consensus, and approved recommendations

shall be effective for all Members without further formal acceptance process.

**PART VI**  
**TRANSITIONAL ARRANGEMENTS**  
**ARTICLE 65**

***Transitional Arrangements***

1. Subject to the provisions of paragraphs 2, 3 and 4, no Member shall be obliged to apply the provisions of this Agreement before the expiry of a general period of one year following the date of entry into force of the WTO Agreement.

2. A developing country Member is entitled to delay for a further period of four years the date of application, as defined in paragraph 1, of the provisions of this Agreement other than Articles 3, 4 and 5.

3. Any other Member which is in the process of transformation from a centrally-planned into a market, free-enterprise economy and which is undertaking structural reform of its intellectual property system and facing special problems in the preparation and implementation of intellectual property laws and regulations, may also benefit from a period of delay as foreseen in paragraph 2.

4. To the extent that a developing country Member is obliged by this Agreement to extend product patent protection to areas of technology not so protectable in its territory on the general date of application of this Agreement for that Member, as defined in paragraph 2, it may delay the application of the provisions on product patents of Section 5 of Part II to such areas of technology for an additional period of five years.

5. A Member availing itself of a transitional period under paragraphs 1, 2, 3 or 4 shall ensure that any changes in its laws, regulations and practice made during that period do not result in a lesser degree of consistency with the provisions of this Agreement.

**ARTICLE 66**

***Least-Developed Country Members***

1. In view of the special needs and requirements of least-developed country Members, their economic, financial and administrative constraints, and their need for flexibility to create a viable technological base, such Members shall not be required to apply the provisions of this Agreement, other than Articles 3, 4 and 5, for a period of 10 years from the date of application as defined under paragraph 1 of Article 65. The Council for TRIPS shall, upon duly motivated request by a least-developed country Member, accord extensions of this period.

2. Developed country Members, shall provide incentives to enterprises and institutions in their territories for the purpose of promoting and encouraging technology transfer to least-developed country Members in order to enable them to create a sound and viable technological base.

**ARTICLE 67**

***Technical Co-operation***

In order to facilitate the implementation of this Agreement, developed country Members shall provide, on request and on mutually agreed terms and conditions, technical and financial co-operation in favour of developing and least-developed country Members. Such co-operation shall include assistance in the preparation of laws and regulations on the protection and enforcement of intellectual property rights as well as on the prevention of their abuse, and shall include support regarding the establishment or reinforcement of domestic offices and agencies relevant to these matters, including the training of personnel.

**PART VII**  
**INSTITUTIONAL ARRANGEMENTS; FINAL PROVISIONS**  
**ARTICLE 68**

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

The Council for TRIPS shall monitor the operation of this Agreement and, in particular, Members' compliance with their obligations hereunder, and shall afford Members the opportunity of consulting on matters relating to the trade-related aspects of intellectual property rights. It shall carry out such other responsibilities as assigned to it by the Members, and it shall, in particular, provide any assistance requested by them in the context of dispute settlement procedures. In carrying out its functions, the Council for TRIPS may consult with and seek information from any source it deems appropriate. In consultation with WIPO, the Council shall seek to establish, within one year of its first meeting, appropriate arrangements for co-operation with bodies of that Organization.

**ARTICLE 69**



### ***International Co-operation***

Members agree to co-operate with each other with a view to eliminating international trade in goods infringing intellectual property rights. For this purpose, they shall establish and notify contact points in their administrations and be ready to exchange information on trade in infringing goods. They shall in particular, promote the exchange of information and co-operation between customs authorities with regard to trade in counterfeit trademark goods and pirated copyright goods.

### **ARTICLE 70**

#### ***Protection of Existing Subject Matter***

1. This 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.

2. Except as otherwise provided for in this Agreement, this Agreement gives rise to obligations in respect of all subject matter existing at the date of application of this Agreement for the Member in question, and which is protected in that Member on the said date, or which meets or comes subsequently to meet the criteria for protection under the terms of this Agreement. In respect of this paragraph and paragraphs 3 and 4, copyright obligations with respect to existing works shall be solely determined under Article 18 of the Berne Convention (1971), and obligations with respect to the rights of producers of phonograms and performers in existing phonograms shall be determined solely under Article 18 of the Berne Convention (1971) as made applicable under paragraph 6 of Article 14 of this Agreement.

3. There shall be no obligation to restore protection to subject matter which on the date of application of this Agreement for the Member in question has fallen into the public domain.

4. In respect of any acts in respect of specific objects embodying protected subject matter which become infringing under the terms of legislation in conformity with this Agreement, and which were commenced, or in respect of which a significant investment was made, before the date of acceptance of the WTO Agreement by that Member, any Member may provide for a limitation of the remedies available to the right holder as to the continued performance of such acts after the date of application of the Agreement for that Member. In such cases the Member shall, however, at least provide for the payment of equitable remuneration.

5. A Member is not obliged to apply the provisions of Article 11 and of paragraph 4 of Article 14 with respect to originals or copies purchased prior to the date of application of the Agreement for that Member.

6. Members shall not be required to apply Article 31, or the requirement in paragraph 1 of Article 27 that patent rights shall be enjoyable without discrimination as to the field of technology, to use without the authorization of the right holder where authorization for such use was granted by the government before the date this Agreement became known.

7. In the case of intellectual property rights for which protection is conditional upon registration, applications for protection which are pending on the date of application of this Agreement for the Member in question shall be permitted to be amended to claim any enhanced protection provided under the provisions of this Agreement. Such amendments shall not include new matter.

8. Where a Member does not make available as of the date of entry into force of the WTO Agreement patent protection for pharmaceutical and agricultural chemical products commensurate with its obligations under Article 27, that Member shall:

- (a) notwithstanding the provisions of Part VI, provide as from the date of entry into force of the WTO Agreement a means by which applications for patents for such inventions can be filed;
- (b) apply to these applications, as of the date of application of this Agreement, the criteria for patentability as laid down in this Agreement as if those criteria were being applied on the date of filing in that Member or, where priority is available and claimed, the priority date of the application; and
- (c) provide patent protection in accordance with this Agreement as from the grant of the patent and for the remainder of the patent term, counted from the filing date in accordance with Article 33 of this Agreement, for those of these applications that meet the criteria for protection referred to in subparagraph (b).

9. Where a product is the subject of a patent application in a Member in accordance with paragraph 8(a), exclusive marketing rights shall be granted, notwithstanding the provisions of Part VI, for a period of five years after obtaining marketing approval in that Member 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 such other Member.

## **ARTICLE 71**

### ***Review and Amendment***

1. The Council for TRIPS shall review the implementation of this Agreement after the expiration of the transitional period referred to in paragraph 2 of Article 65. The Council shall, having regard to the experience gained in its implementation, review it two years after that date, and at identical intervals thereafter. The Council may also undertake reviews in the light of any relevant new developments which might warrant modification or amendment of this Agreement.

2. Amendments merely serving the purpose of adjusting to higher levels of protection of intellectual property rights achieved, and in force, in other multilateral agreements and accepted under those agreements by all Members of the WTO may be referred to the Ministerial Conference for action in accordance with paragraph 6 of Article X of the WTO Agreement on the basis of a consensus proposal from the Council for TRIPS.

## **ARTICLE 72**

### ***Reservations***

Reservations may not be entered in respect of any of the provisions of this Agreement without the consent of the other Members.

## **ARTICLE 73**

### ***Security Exceptions***

Nothing in this Agreement shall be construed:

- (a) to require a Member to furnish any information the disclosure of which it considers contrary to its essential security interests; or
- (b) to prevent a Member from taking any action which it considers necessary for the protection of its essential security interests; or
  - (i) relating to fissionable materials or the materials from which they are derived;
  - (ii) relating to the traffic in arms, ammunition and implements of war and to such traffic in other goods and materials as is carried on directly or indirectly for the purpose of supplying a military establishment;
  - (iii) taken in time of war or other emergency in international relations; or
- (c) to prevent a Member from taking any action in pursuance of its obligations under the United Nations Charter for the maintenance of international peace and security.

---

<sup>i</sup>Articles have been given titles to facilitate their identification. There are no titles in the signed (French) text.

<sup>ii</sup>When "nationals" are referred to in this Agreement, they shall be deemed, in the case of a separate customs territory Member of the WTO, to mean persons, natural or legal, who are domiciled or who have a real and effective industrial or commercial establishment in that customs territory.

<sup>iii</sup>In this Agreement, "Paris Convention" refers to the Paris Convention for the Protection of Industrial Property; "Paris Convention (1967)" refers to the Stockholm Act of this Convention of 14 July 1967. "Berne Convention" refers to the Berne Convention for the Protection of Literary and Artistic Works; "Berne Convention (1971)" refers to the Paris Act of this Convention of 24 July 1971. "Rome Convention" refers to the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations, adopted at Rome on 26 October 1961. "Treaty on Intellectual Property in Respect of Integrated Circuits" (IPIC Treaty) refers to the Treaty on Intellectual Property in Respect of Integrated Circuits, Adopted at Washington on 26 May 1989. "WTO Agreement" refers to the Agreement Establishing the WTO.

<sup>iv</sup>For the purposes of Articles 3 and 4, "protection" shall include matters affecting the availability, acquisition, scope, maintenance and enforcement of intellectual property rights as well as those matters affecting the use of intellectual property rights specifically addressed in this Agreement.

<sup>v</sup>Notwithstanding the first sentence of Article 42, Members may, with respect to these obligations, instead provide for enforcement by administrative action.

<sup>vi</sup>For the purposes of this Article, the terms "inventive step" and "capable of industrial application" may be deemed by a Member to be synonymous with the terms "non-obvious"

---

and "useful" respectively.

<sup>vii</sup>This right, like all other rights conferred under this Agreement in respect of the use, sale, importation or other distribution of goods, is subject to the provisions of Article 6.

<sup>viii</sup>"other use" refers to use other than that allowed under Article 30.

<sup>ix</sup>It is understood that those Members which do not have a system of original grant may provide that the term of protection shall be computed from the filing date in the system of original grant.

<sup>x</sup>The term "right holder" in this Section shall be understood as having the same meaning as the term "holder of the right" in the IPIC Treaty.

<sup>xi</sup>For the purpose of this provision, "a manner contrary to honest commercial practices" shall mean at least practices such as breach of contract, breach of confidence and inducement to breach, and includes the acquisition of undisclosed information by third parties who knew, or were grossly negligent in failing to know, that such practices were involved in the acquisition.

<sup>xii</sup>For the purpose of this Part, the term "right holder" includes federations and associations having legal standing to assert such rights.

<sup>xiii</sup>Where a Member has dismantled a substantially all controls over movement of goods across its border with another Member with which it forms part of a customs union, it shall not be required to apply the provisions of this Section at that border.

<sup>xiv</sup>It is understood that there shall be no obligation to apply such procedures to imports of goods put on the market in another country by or with the consent of the right holder, or to goods in transit.

<sup>xv</sup>For the purposes of this Agreement:

- (a) "**counterfeit trademark goods**" shall mean any goods, including packaging, bearing without authorization a trademark which is identical to the trademark validly registered in respect of such goods, or which cannot be distinguished in its essential aspects from such a trademark, and which thereby infringes the rights of the owner of the trademark in question under the law of the country of importation;
- (b) "**pirated copyright goods**" shall mean any goods which are copies made without the consent of the right holder or person duly authorized by the right holder in the country of production and which are made directly or indirectly from an article where the making of that copy would have constituted an infringement of a copyright or a related right under the law of the country of importation.