



NALSAR
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International IP Treaties

Focus on Paris Convention, Berne Convention, Budapest Treaty, Madrid Agreement and Working of WIPO

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Directorate of Distance Education, NALSAR
One Year Advanced Diploma in Patents Law

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WIPO

- World Intellectual Property Organization
 - Specialized Agency of the UN
 - Administers International IP Treaties
- 1) Basic Protection
 - 2) Foreign Registration Protection
 - 3) Classification Systems

Paris Convention (India Acceded in 1998)

- Paris Convention for Protection of Industrial Property

Scope of Industrial Property (Art.1)

- Art. 1(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.
- Art. 1(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.

National Treatment (Art. 2)

National of country X -- shall enjoy -- Y's IP rights for its Nationals -- without prejudice to PC rights



National of country X need not have domicile or establishment in country Y



Country Y judicial and administrative procedures will be applicable on National of country X



National of Country Z (outside the Union) with domicile/establishment in Country Y shall be treated as National of Y in X

(Art.3)

Right to Priority; Division of Application (Art.4)

National of Country X files patent application in Country X on 27 November 2023



28 November 2023 - 27 November 2024 (12 Months) : Right of Priority to file in Country Y [If 27 November 2024 was is not a working day, then the next working day]

i.e.

During 12 Months, publication of invention cannot be ground for invalidation on subsequent filing

Multiple Priority/Addition of New Element: Country Y may or may not validate the subsequent filing --> Depends on Unity of Invention

If more than one invention: Division of application --> Priority of initial application

Certain elements in subsequent filing are not present in claims of initial application: Priority may or may not be denied --> Provided the elements are disclosed in patent documents

Patent obtained by National of Country X in Country L, M, N and O are all **independent of each other** in terms of all factors, including nullity and forfeiture [eg. If fee is not paid in Country L]

(Art. 4bis)

Inventor has **right to be mentioned (moral right)** in the patent [can be waived if permitted by national legislation] (Art. 4ter)

Manufacture/production of patented product might sometimes:

- not meet a country's quality standard; or
- an entity may have been granted monopoly to deal in such products;

Thereby placing a **restriction on sale by law**.

Based on the above, a country cannot deny grant of patent or invalidate a patent.

i.e. opportunity should be provided to consider whether the quality standard is obsolete or a CL may be granted, respectively. (Art. 4quater)

Importation of Articles and Insufficient Working; Marking (Art. 5)

Patentee may import articles



Forfeiture may result if working is insufficient, particularly if CL is not a sufficient solution



CL to be granted only 4 years after date of filing/3 years after grant --> whichever is later

CL shall be refused if patentee has legitimate reasons

CL shall be non-exclusive and non-transferable



Forfeiture application --> 2 years after grant of 1st CL

Marking of Patent on Goods is **not a condition** for recognition of patent protection

Period of Grace; Restoration (Art. 5bis)

Mandatory 6 months (minimum) duration period of grace for payment of fees for maintenance of patent --> with possibility of surcharge

Countries **can restore** patents that have lapsed due to non-payment of fees

Patented Device forming part of Vessels (Art. 5ter)

Exclusive use in vessels which enter temporarily or accidentally enter country: not an infringement.

Importation of Products Manufactured by a Process Patented in Importing Country (Art. 5quater)

Patentee shall have all such rights over the product as are granted by the importing country

Art. 11 Temporary Protection at Certain International Exhibitions

Duration of protection cannot exceed 12 months (Art. 4)

If priority is claimed, then the date of exhibition may be considered as priority date

Budapest Treaty (India acceded in 2001)

- Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure
- [Art. 2\(ii\)](#) "deposit of a microorganism" means, according to the context in which these words appear, the following acts effected in accordance with this Treaty and the Regulations; the transmittal of a microorganism to an international depository authority, which receives and accepts it, or the storage of such a microorganism by the international depository authority, or both the said transmittal and the said storage;
- [Art. 3](#) Recognition and Effect of Deposit of Micro-organisms
 - With any International Depository Authority –
 - Any Contracting State may require a receipt of deposit from IDA –
 - The Treaty and Regulations provide complete compliance format and contracting states may not add any further requirement

Art. 6 : Status of International Depository Authority

States must ensure IDA complies with all requirements under Art. 6(2)

(i) have a continuous existence; (ii) have the necessary staff and facilities, as prescribed in the Regulations, to perform its scientific and administrative tasks under this Treaty; (iii) be impartial and objective; (iv) be available, for the purposes of deposit, to any depositor under the same conditions; (v) accept for deposit any or certain kinds of microorganisms, examine their viability and store them, as prescribed in the Regulations; (vi) issue a receipt to the depositor, and any required viability statement, as prescribed in the Regulations; (vii) comply, in respect of the deposited microorganisms, with the requirement of secrecy, as prescribed in the Regulations; (viii) furnish samples of any deposited microorganism under the conditions and in conformity with the procedure prescribed in the Regulations

Budapest Regulations

Rule 2: Legal Status

Any international depository authority may be a government agency, including any public institution attached to a public administration other than the central government, or a private entity.

Rule 3: Acquisition of Status of IDA

[Communication to Director General]

Rule 3(1)(b)(iii) where the said depository institution intends to accept for deposit only certain kinds of microorganisms, specify such kinds;

Rule 3(3) Extension (Later) of the List of Kinds of Microorganisms Accepted

Rule 6.1: Original Deposit

- Indication of Deposit under the Treaty + Undertaking to not remove it for 5 years to 30 years (Rule 9.1)
- name and address of the depositor
- details of the conditions necessary for the cultivation of the microorganism, for its storage and for testing its viability and also, where a mixture of microorganisms is deposited, descriptions of the components of the mixture and at least one of the methods permitting the checking of their presence;
- an **identification reference** (number, symbols, etc.) given by the depositor to the microorganism;
- an indication of the properties of the microorganism which are or may be dangerous to health or the environment, or an indication that the depositor is not aware of such properties.

Rule 6.4:

- (i) where the microorganism is not of a kind of microorganism to which the assurances furnished under Rule 3.1(b) (iii) or 3.3 extend;
- (ii) where the properties of the microorganism are so exceptional that the international depositary authority is technically not in a position to perform the tasks in relation to it that it must perform under the Treaty and these Regulations;
- (iii) where the deposit is received in a condition which clearly indicates that the microorganism is missing or which precludes for scientific reasons the acceptance of the microorganism.

Rule 9(2): Storage of Microorganisms

No international depositary authority shall give information to anyone whether a microorganism has been deposited with it under the Treaty. Furthermore, it shall not give any information to anyone concerning any microorganism deposited with it under the Treaty except to an authority, natural person or legal entity which is entitled to obtain a sample.

Rule 10: Viability Test

Rule 11(1): Furnishing of Samples to Interested Industrial Property Offices

Any international depositary authority shall furnish a sample of any deposited microorganism to the industrial property office of any Contracting State or of any intergovernmental industrial property organization, on the request of such office, provided that the request shall be accompanied by a declaration to the effect that: (i) an application referring to the deposit of that microorganism has been filed with that office for the grant of a patent and that the subject matter of that application involves the said microorganism or the use thereof; (ii) such application is pending before that office or has led to the grant of a patent; (iii) the sample is needed for the purposes of a patent procedure having effect in the said Contracting State or in the said organization or its member States; (iv) the said sample and any information accompanying or resulting from it will be used only for the purposes of the said patent procedure.

Berne Convention (India Ratified in 1974)

Art. 2(1) Literary and Artistic Works:

The expression “literary and artistic works” shall include every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression, such as books, pamphlets and other writings; lectures, addresses, sermons and other works of the same nature; dramatic or dramaticomusical works; choreographic works and entertainments in dumb show; musical compositions with or without words; cinematographic works to which are assimilated works expressed by a process analogous to cinematography; works of drawing, painting, architecture, sculpture, engraving and lithography; photographic works to which are assimilated works expressed by a process analogous to photography; works of applied art; illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography, architecture or science.

Art. 2(3) Translations and adaptations:

Translations, adaptations, arrangements of music and other alterations of a literary or artistic work shall be protected as original works without prejudice to the copyright in the original work.

Art. 3 – Criteria of Eligibility for Protection

- (1) The protection of this Convention shall apply to: (a) authors who are nationals of one of the countries of the Union, for their works, whether published or not; (b) authors who are not nationals of one of the countries of the Union, for their works first published in one of those countries, or simultaneously in a country outside the Union and in a country of the Union.
- (2) Authors who are not nationals of one of the countries of the Union but who have their habitual residence in one of them shall, for the purposes of this Convention, be assimilated to nationals of that country.

(3) The expression “published works” means works published with the consent of their authors, whatever may be the means of manufacture of the copies, provided that the availability of such copies has been such as to satisfy the reasonable requirements of the public, having regard to the nature of the work. The performance of a dramatic, dramatico-musical, cinematographic or musical work, the public recitation of a literary work, the communication by wire or the broadcasting of literary or artistic works, the exhibition of a work of art and the construction of a work of architecture shall not constitute publication.

(4) A work shall be considered as having been published simultaneously in several countries if it has been published in two or more countries within thirty days of its first publication.

Art. 5 Rights Guaranteed

- (1) Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin, the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention.
- (2) The enjoyment and the exercise of these rights shall not be subject to any formality; such enjoyment and such exercise shall be independent of the existence of protection in the country of origin of the work. Consequently, apart from the provisions of this Convention, the extent of protection, as well as the means of redress afforded to the author to protect his rights, shall be governed exclusively by the laws of the country where protection is claimed.
- (3) Protection in the country of origin is governed by domestic law. However, when the author is not a national of the country of origin of the work for which he is protected under this Convention, he shall enjoy in that country the same rights as national authors.

- (4) The country of origin shall be considered to be:
- (a) in the case of works first published in a country of the Union, that country; in the case of works published simultaneously in several countries of the Union which grant different terms of protection, the country whose legislation grants the shortest term of protection;
 - (b) in the case of works published simultaneously in a country outside the Union and in a country of the Union, the latter country;
 - (c) in the case of unpublished works or of works first published in a country outside the Union, without simultaneous publication in a country of the Union, the country of the Union of which the author is a national, provided that: (i) when these are cinematographic works the maker of which has his headquarters or his habitual residence in a country of the Union, the country of origin shall be that country, and (ii) when these are works of architecture erected in a country of the Union or other artistic works incorporated in a building or other structure located in a country of the Union, the country of origin shall be that country.

PC on Trademark

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 6bis [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 6quinquies [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...

(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.

Madrid Agreement and Protocol (India Party to Protocol – 2013)

Madrid Agreement Concerning the International Registration of Marks of 1891

Protocol Relating to the same Agreement of 1989

Any Member of Paris Convention can become party to Agreement/Protocol

The Agreement requires international application to be filed based on home country registration, while Protocol can be based on home application/registration with any Contracting State of Protocol

Role of WIPO

- Complements WTO
- Advancement of IP Globally

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