

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION GENEVA

COMMITTEE OF EXPERTS ON MEASURES AGAINST COUNTERFEITING AND PIRACY

Geneva, April 25 to 28, 1988

AGENDA

prepared by the Director General

1. Opening of the session by the Director General of WIPO
2. Election of a Chairman and two Vice-Chairmen
3. Counterfeiting and Piracy:
 - (i) Model Provisions for National Laws (document C&P/CE/2)
 - (ii) Provisions in the Paris, Berne and Neighboring Rights Conventions (document C&P/CE/3);
4. Adoption of the report of the session
5. Closing of the session by the Chairman

[End of document]

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MODEL PROVISIONS FOR NATIONAL LAWS

Memorandum by the International Bureau

INTRODUCTION

1. The World Intellectual Property Organization (WIPO) has for several years devoted special attention to the need to combat counterfeiting and piracy.

2. For the purposes of this document, and simply stated, counterfeiting means the manufacture, sale, etc., of goods in contravention of industrial property rights (rights in a trademark, etc.), whereas piracy means the manufacture, sale, etc., of copies in contravention of rights protected by copyright. In both cases, the manufacture, sale, etc., must be on a commercial scale.

3. Among the activities of WIPO aimed at achieving increased protection against counterfeiting and piracy, the following are to be noted in particular. In the field of counterfeiting, the International Bureau of WIPO has twice convened a committee of experts in industrial property law (under the title "Committee of Experts on the Protection Against Counterfeiting"), namely in 1986 and 1987 (the relevant documents are those of the WIPO series PAC/CE/I and PAC/CE/II). In the field of piracy, it has held two world-wide forums, namely the WIPO Worldwide Forum on the Piracy of Sound and Audiovisual Recordings and the WIPO Worldwide Forum on the Piracy of Broadcasts and of the Printed Word, in 1981 and 1983, respectively (the relevant documents are those of the WIPO series PF/I and PF/II). Furthermore, two committees of experts in copyright and neighboring rights law, jointly convened by WIPO and Unesco, have given special attention to measures against piracy, namely those on "Audiovisual Works and Phonograms" (June 1986) and on "The Printed Word" (December 1987) (the relevant documents are those of the series UNESCO/WIPO/CGE/AWP and UNESCO/WIPO/CCE/PW).

4. Both kinds of committees of experts expressed their advice on draft model provisions (in the case of counterfeiting) or on draft "principles" (in the case of piracy), both intended to achieve the following two main aims: (i) to make legislators, governments and the general public aware of the need to combat counterfeiting and piracy, and (ii) to create material that should be useful to those who prepare national laws, and to those who adopt them, when they consider what provisions national laws should contain as measures for effectively and efficiently combating counterfeiting and piracy. Naturally, the model provisions and the principles, even where endorsed by the committees of experts, do not affect in any way the freedom of any government or legislative body to follow them or not, in some respects or in toto.

5. The documents presented to the said committees of experts dealt not only with model provisions or principles but also analyzed or referred to the provisions of international treaties, in particular the Paris Convention for the Protection of Industrial Property (hereinafter referred to as "the Paris Convention") and the Berne Convention for the Protection of Literary and Artistic Works (hereinafter referred to as "the Berne Convention"). Those treaties, unlike the model provisions or principles, do establish obligations for the States that are party to them.

6. It is believed that henceforth questions of counterfeiting and piracy should be considered not only separately but also together since they are germane as to their legal nature and since the measures for combating counterfeiting and piracy are similar. Furthermore, one and the same illegal act frequently violates both industrial property rights ("counterfeiting") and rights protected by copyright and neighboring rights ("piracy"). Such is the case, for example, when illegally manufactured copies of a phonogram that contains the performance of a musical work protected by copyright ("pirate copies") are offered for sale under a label that is the imitation of a protected trademark ("counterfeit trademark").

7. The present document contains the draft of model provisions for national laws on measures against counterfeiting and piracy. The text of the draft model provisions appears on odd-numbered pages (5, 7, 9, etc.), whereas explanatory observations appear on the opposite, even-numbered pages (4, 6, 8, etc.).

8. Another document (C&P/CE/3) deals with the analysis of the Paris Convention, the Berne Convention and two of the so-called neighboring rights conventions, namely the Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations and the Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms as far as relevant to counterfeiting and piracy.

Observations Concerning Article A

9. Ad Article A, in general: This article defines the acts of counterfeiting and the acts of piracy. Thereby, it defines both notions. "Counterfeiting" is an expression that, in the model provisions, covers the cases where the rights infringed are rights protected by industrial property (or rights similar to industrial property rights), whereas "piracy" is an expression that, in the model provisions, covers the cases where the rights infringed are rights protected by copyright or by the so-called neighboring rights (the former protect authors of literary and artistic works, whereas the latter protect performers, phonogram producers and broadcasting organizations). Admittedly, the terminology does not correspond to all the existing national laws or to present usage in the jurisprudence and the doctrine of all countries. Admittedly, also, it is difficult to find exact equivalents of the two terms in the various languages. Nevertheless, those terms are used in the model provisions in the hope that they would gradually receive general acceptance (as did, for example, the expression "intellectual property" that has gained general acceptance only since 1967, the year of the signature of the Convention Establishing the World Intellectual Property Organization). In any case, it seems to enhance clarity if the two types were distinguished from each other, at least at this stage of the discussions.

10. Although the model provisions use, in connection with industrial property, only the term "counterfeiting," it should be noted that in common parlance not only the expression "counterfeiting" but also the expression "piracy" is used, particularly when goods or products have been manufactured in violation of patent rights.

11. As to terminology, it is to be noted also that the objects manufactured are called "goods" in the case of counterfeiting and "copies" in the case of piracy. The choice of words seems to correspond to traditional trademark law and copyright law terminology.

12. The article is divided into three paragraphs. Paragraph (1) deals with the basic act of counterfeiting, which is the manufacturing of counterfeit goods. Paragraph (2) deals with the basic act of piracy, which is the manufacturing of pirate copies. Both paragraphs cover not only manufacturing, but also preparation of manufacturing, of counterfeit goods or pirate copies. Paragraph (3) deals with the additional acts--there are 14 distinguished--of counterfeiting and piracy.

13. According to general principles of law, counterfeiting or piracy is committed not only by the person who actually performs the prohibited acts but also by the person who orders the performance of such acts.

14. Ad paragraph (1). This paragraph deals with the manufacturing of counterfeit goods. At the same time, it defines the notion of "counterfeit goods."

15. Preparation of the manufacturing of counterfeit goods is assimilated to manufacturing. For example, if a search by the competent law enforcement authorities shows the presence, on the manufacturing premises of a manufacturer, of the blueprints for the manufacture, the tools to carry out

Article A

COUNTERFEITING AND PIRACY

(1) Manufacturing as an Act of Counterfeiting. The manufacturing, or the preparation of the manufacturing, of goods

- (i) that bear, or are accompanied by, a two-dimensional sign (word(s), letter(s), number(s), color(s), graphic representation(s), etc.), or whose form or packaging consists of three-dimensional features, that is or are a reproduction or a slavish or near-slavish imitation of a protected two-dimensional or three-dimensional trademark, provided that the goods are of the same or a similar kind as any of the goods for which the trademark is protected or, even where the goods are of a different kind, that there is a danger of confusion regarding the origin of the goods,
- (ii) that bear, or are accompanied by, a graphic representation, or whose form or packaging consists of three-dimensional features, that is or are a reproduction or a slavish or near-slavish imitation of a protected industrial design,

[continues]

[Observations concerning Article A, continuation]

the manufacture and the raw materials which are needed for the manufacture, of goods which, once actually manufactured, would be counterfeit goods, the act of "preparation" will have been committed.

16. Paragraph (1) has two sentences. The first sentence distinguishes between four kinds of rights whose infringement--provided the manufacture is on a commercial scale--would constitute counterfeiting. Three of those rights correspond to three traditional categories of industrial property rights: rights in trademarks (item (i)), rights in industrial designs (item (ii)) and rights in inventions (rights flowing from patents or inventors' certificates; item (iv)). The fourth (item (iii)) is a right which is not a traditional category, unless what in certain countries is called "passing off" is considered to be one. This item (item (iii)) protects the appearance or the packaging of goods when such appearance or packaging is protected neither as a trademark, nor as an industrial design, nor as a work under copyright protection, provided the appearance or the packaging is known in commerce as an appearance or a packaging of (the goods of) a given enterprise.

17. "Commercial scale" is a notion which will have to be applied taking into consideration the circumstances accompanying the manufacture. The quantity of the goods manufactured, the way in which they were, are or are intended to be used and the will to make profit are among the factors that the courts will have to take into consideration.

18. The second sentence of this paragraph makes it clear that, provided the licensee has the right to do so, an authorization to manufacture may come not only from the owner of the right (case covered by the first sentence) but also from the licensee. Whether the licensee has the right to give such an authorization depends on the terms of the licensing contract concluded between the owner and the licensee. In countries where the patent law provides for compulsory licenses, the question whether the compulsory licensee has the right to give the said authorization depends on the provisions of the law and the terms of the actual compulsory license granted. In respect of trademarks and industrial designs, the question does not arise, as compulsory licenses are practically unknown in trademark and industrial designs laws.

19. Ad item (i). Goods "that bear, or are accompanied by, a two-dimensional sign" should be understood as a close association of the goods and the sign. The sign may be an integral part of the goods (e.g., is painted on them or is interwoven in the texture of them) or it may be affixed to them or on their container.

20. The form or the packaging of goods may be protected (also) under items (ii) or (iii). Here (in item (i)), the form or the packaging is protected if it constitutes a protected three-dimensional trademark.

21. The sign used on, or in connection with, the counterfeit goods may, but need not, look exactly the same as the protected trademark; to be considered as a counterfeit, it is enough if it looks very similar to the protected trademark ("slavish or near-slavish imitation").

[Article A(1), continuation]

(iii) that have an appearance or a packaging which, even if not protected as a trademark, an industrial design or by copyright, is identical with or confusingly similar to the appearance or packaging of goods known in commerce as an appearance or packaging of goods of a given enterprise,

(iv) that embody the subject matter of a protected invention or were produced by using a protected invention,

shall constitute an act of counterfeiting, provided that such goods are manufactured on a commercial scale and without the authorization of the owner of the right in the trademark, industrial design, appearance, packaging or invention, as the case may be (hereinafter referred to as "counterfeit goods"). A licensee may grant the authorization, if and to the extent that he is entitled to do so pursuant to his contractual or compulsory license, as the case may be.

[continues]

[Observations concerning Article A, continuation]

22. The protection of a trademark is, in most countries, acquired through registration (with the national, a regional, or--under the Madrid Agreement Concerning the International Registration of Marks--the International register) and lasts as long as the registration remains valid and any use requirement is complied with. In some countries, the protection of a trademark is acquired through the trademark's bona fide use in commerce. Three-dimensional trademarks are not protectable in some countries. Item (i) re-states the general principle according to which the protection applies to the same or the similar kinds of goods for which the trademark has been registered, except that the protection may, in a certain case, also apply to different kinds of goods. That case is the case in which there is a danger of confusion regarding the origin of goods. The so-called well-known marks (in French, marques de haute renommée) frequently benefit from such an extended protection.

23. Ad item (ii). The protection of an industrial design is, in most countries, acquired through deposit with and/or registration in the national industrial property office. Where regional systems, or the international system under the Hague Agreement Concerning the International Deposit of Industrial Designs, apply, the deposit is effected with the regional office or with the International Bureau of WIPO, respectively.

24. Designs may be two-dimensional ("graphic representations") or three-dimensional ("three-dimensional features") depending on the form of the goods or of their packaging.

25. Ad item (iii). See the observations made in paragraph 16, above.

26. Ad item (iv). An invention is protected if, in the country in which protection is claimed, a patent or an inventor's certificate has been granted and is still in force. In any country in which a regional patent system applies (the European patent system, the OAPI system or the ARIPO system), an invention is protected if the regional patent has been granted, and is still valid, with effect (also) for that country.

27. Ad paragraph (2). This paragraph deals with the manufacturing of pirate copies. At the same time, it defines the notion of "pirate copy."

28. It assimilates the preparation of the manufacturing to the manufacturing. The observations made in this respect in connection with paragraph (1) apply here too.

29. The paragraph has two sentences. The first sentence distinguishes between four kinds of rights whose infringement--provided the manufacture is on a commercial scale--would constitute piracy. The first of those rights is copyright in literary and artistic works (item (i)). The other three are so-called neighboring rights (an expression not liked by everybody, and therefore not used in the model provisions themselves but used in these notes since the expression is in general usage and is well understood world-wide), namely, the rights of performers in their performances, the rights of phonogram producers in their phonograms and the rights of broadcasting organizations in their broadcasts.

[Article A, continuation]

(2) Manufacturing as an Act of Piracy. The manufacturing, or the preparation of manufacturing, of copies

- (i) of protected literary and artistic works,
- (ii) of fixations of protected performances,
- (iii) of protected phonograms,
- (iv) of protected broadcasts,

shall constitute an act of piracy, provided that such copies are manufactured on a commercial scale and without the authorization of the owner of the right in the protected work, performance, phonogram or broadcast, as the case may be (hereinafter referred to as "pirate copies"). A licensee may grant the authorization, if and to the extent that he is entitled to do so pursuant to his contractual, compulsory or statutory license, as the case may be.

[continues]

[Observations concerning Article A, continuation]

30. The observations made above in respect of counterfeiting concerning the notion of "commercial scale" (paragraph 17, above) and in connection with licenses (paragraph 18, above) apply here too, except that among the possible kinds of non-voluntary licenses, the second sentence of the paragraph under consideration mentions also statutory licenses, a kind of license known in some national copyright laws. The question whether the statutory licensee has the right to give an authorization to manufacture depends on the provisions of the applicable "statute," that is, the national legislation.

31. Although the model provisions use, in connection with copyright and neighboring rights, only the term "piracy," it should be noted that in common parlance not only the expression "piracy" is used--and is used in a narrower sense than in the model provisions--but also the expressions "counterfeits" and "bootlegs" are used. All three of those expressions are covered by the expression "piracy" as that expression is used in the model provisions. In common parlance, the said three expressions are generally used as follows:

(i) "Counterfeits," in common parlance, usually mean exact copies of the original sound or video disk or tape, complete with identical packaging including the trademark of the lawful producer.

(ii) "Bootlegs," in common parlance, usually mean copies of recordings of a live performance or a broadcast where the recording was made without the consent of the artist or broadcasting organization involved.

(iii) "Pirate copy," in common parlance, usually refers to an unauthorized copy of a sound recording or videotape which does not attempt to copy the get-up of the genuine product. Such copies may, for example, be cheap "in-store" copies with hand-written labels or copies which are sold under the pirate's own trademark.

32. Ad paragraph (3). This paragraph consists of two subparagraphs: subparagraphs (a) and (b). Subparagraph (a) enumerates additional acts--that is, acts additional to manufacturing (covered in paragraphs (1) and (2))--of both counterfeiting and piracy. Subparagraph (b) deals with a special case of counterfeiting in the field of trademarks.

33. Ad paragraph (3)(a). This subparagraph enumerates--grouped in five groups (items (i) to (v))--14 different kinds of acts that, if done on an commercial scale and without authorization, constitute counterfeiting or piracy.

34. Just like manufacturing, or the preparation of manufacturing, any of those 14 acts, in itself, is counterfeiting or piracy. In any given case, not only one but also several of the above-mentioned acts may be committed by the same person. Also, one or several of the acts may be committed by one person, and one or several of the same or the other acts may be committed by another person or by other persons.

[Article A, continuation]

(3) Additional Acts of Counterfeiting and Piracy. (a) In addition to the acts referred to in paragraphs (1) and (2), the following acts shall constitute acts of counterfeiting or piracy:

- (i) the packaging or the preparation of packaging,
- (ii) the exportation, importation and transit,
- (iii) the offering for sale, rental, lending or other distribution,
- (iv) the sale, rental, lending or other distribution,
- (v) the possession, with the intention of doing any of the acts referred to in items (i) to (iv), above,

of counterfeit goods or pirate copies, provided that the act is committed on a commercial scale and without the authorization of the owner of the right in the trademark, industrial design, appearance, packaging, invention, literary or artistic work, performance, phonogram or broadcast, as the case may be. A licensee may grant the authorization, if and to the extent that he is entitled to do so pursuant to his contractual, compulsory or statutory license, as the case may be.

[continues]

[Observations concerning Article A, continuation]

35. It would seem that the provisions are self-explanatory and generally non-controversial. The only act which provoked some hesitations in previous meetings is the act of transit.

36. The observations made above in connection with the notion of "commercial scale" (paragraph 11) and in connection with licenses (paragraphs 12 and 30, above) apply here too.

37. Ad paragraph (3)(b). Simply stated, this provision deals with the act of affixing of a sign on goods, which sign is the protected trademark, and doing that affixing without the authorization of the trademark owner (or his licensee). In the typical case intended to be covered by this provision, the signs are manufactured by A, the goods are manufactured by B, and the affixing is effected by C. (A, B and C may perform the acts each in a different country.) The provision is intended to clarify that C commits an act of counterfeiting although what he does--the affixing--is covered neither by paragraphs (1) or (2) nor by subparagraph (a) of paragraph (3).

[Article A(3), continuation]

(b) The affixing of a sign, being a reproduction or a slavish or near-slavish imitation of a protected trademark, on goods or on their packaging, or any preparatory step towards such affixing, by anyone who has not been authorized by the owner of the protected trademark shall also constitute an act of counterfeiting. A licensee may grant the authorization, if and to the extent that he is entitled to do so pursuant to his contractual license.

Observations Concerning Article B

38. Ad the title of the Article. The expression "conservatory" is only used in the title of this Article. It is intended to indicate that the measures provided for in this article are designed to "freeze" or "conserve" the situation as it is when the measure is ordered or taken.

39. Ad paragraph (1). The conservatory measures--whose non-exhaustive list appears in paragraph (2)--may be ordered either on request or ex officio. Subparagraph (a) deals with the first, subparagraph (b) with the second, situation.

40. Ad paragraph (1)(a). The request for a measure must, under this subparagraph, be made by the party ("natural person or legal entity") who claims to be injured, or who claims to be threatened to be injured, by an act of counterfeiting or piracy. Express claiming is required since if the requesting (claiming) party's claim proves to be groundless, he will be responsible for damages vis-à-vis the party who suffered the measure (see paragraph (8)).

41. The measure or measures must be ordered or taken ("shall") but, naturally, only if the authority or court suspects (that is, can reasonably suspect) that at least one act of counterfeiting or piracy has been committed or is likely to be committed. The term "law enforcement authority" is used in a sense that it does not cover courts. What is meant by law enforcement authorities are, typically, public prosecutors, police authorities and customs authorities.

42. Naturally, the measures can be ordered by a court too; in such a case they are usually applied by the police or customs authorities.

43. Whether an act is likely to be committed must be considered in the light of all the circumstances. There must be an actual danger. For example, goods are ready in a workshop and next to or near them there are trademarks on labels or pieces of cloth, obviously destined to be placed on the goods; or it is known that goods suspected to be counterfeit, or copies suspected to be pirate copies, have been loaded abroad on an airplane or boat scheduled to land in the country; or there are goods or copies suspected to be counterfeit goods or pirate copies in the warehouse of a wholesale firm or in the warehouse or on the floors of a retail outlet such as a shop, department store, videocassette "club" or advertising agency.

44. The measure must serve one or both of two main objectives.

45. One of them is to prevent the committing, or any continuation of committing of acts of counterfeiting or piracy; this objective is stated in item (i). The second main objective is to secure evidence; this objective is stated in item (ii).

Article B

CONSERVATORY MEASURES

(1)(a) At the request of the natural person or legal entity claiming to be injured or to be threatened to be injured by an act of counterfeiting or piracy (hereinafter referred to as "the requesting party"), any court or law enforcement authority shall, if it suspects that an act of counterfeiting or piracy has been committed or is likely to be committed, order or take the measures it deems necessary in order to:

(i) prevent the committing or the continuation of the committing of acts of counterfeiting or piracy,

(ii) secure evidence as to the nature, quantity, location, source and destination of the goods suspected to be counterfeit goods or of the copies suspected to be pirate copies, and/or as to the identity of the person suspected to have committed or to be likely to commit acts of counterfeiting or piracy.

(b) Any court or law enforcement authority may, if it suspects that an act of counterfeiting or piracy has been committed or is likely to be committed, order or take ex officio any of the measures referred to in subparagraph (a).

(c) Any of the measures referred to in subparagraph (a) shall be taken by a law enforcement authority either with the prior authorization of the court or subject to the court's subsequent ratification.

[Observations concerning Article B, continuation]

46. Examples of measures are the sealing by the police of the premises where the goods or copies are manufactured or kept; the description--in a procès-verbal drawn up by a notary public or the police--of what was found, particularly the goods or copies that were found on certain premises belonging to or otherwise under the control of certain persons or accessible to such persons; the seizure of samples of the goods or copies to be kept by the police, the notary public or the court; the taking and keeping of some or all of the accounts books. The person at whose address the goods or copies were found may be required to provide information regarding the source and destination of those goods or copies. The securing of evidence usually relates not only to the goods or copies but also to the identity of the person suspected. In the United Kingdom and some other countries, such measures are known as Anton Piller orders.

47. Ad paragraph (1)(b). Under this subparagraph, the measures may be ordered or taken ex officio. Naturally, the condition that the court or law enforcement authority must suspect that an act of counterfeiting or piracy has been or is likely to be committed, applies here too. There is a difference, however, between subparagraphs (a) and (b) in that, in the first case, the court or authority is obliged to order or take the measure, whereas, in the second case, the ordering or taking of the measure depends on the discretion of the court or authority.

48. Ad paragraph (1)(c). This subparagraph requires that, when the measure is not taken or ordered by a court but is taken by a law enforcement authority, either the prior authorization of the court or subsequent ratification by the court be obtained.

49. Ad paragraph (2). This paragraph contains a non-exhaustive list of measures (examples are given in paragraph 46, above). They are generally self-explanatory. Only items (i) and (v) are commented upon hereafter. "Seizure" (item (i)) means the placing of the goods suspected to be counterfeit goods, or of the copies suspected to be pirate copies, in a physical situation in which no one can have access to them without the authorization of the court that ordered their seizure or of the authority which seized them. Seizure is not only provided for the goods, copies and any tools that might have been used to manufacture them, but also any document, accounts or business papers likely to enlighten the court on the scope and origin of the counterfeiting or piracy.

50. Truly effective repression of counterfeiting and piracy can only exist if it is possible to find out the source of the counterfeit goods or pirate copies. Although counterfeiting and piracy are a global phenomenon that must be combated at all the levels where it is present, it is only when it is possible to find out the source of the counterfeit goods or pirate copies that the courts can make use of the civil or criminal measures contained in the law against the manufacturer and thus put an end to the counterfeiting or piracy. The question is covered by item (v).

[Article B, continuation]

(2) The possible measures shall be, inter alia, the following:

(i) seizure of the goods suspected to be counterfeit goods or of the copies suspected to be pirate copies,

(ii) sealing of the premises where the goods suspected to be counterfeit goods or the copies suspected to be pirate copies are manufactured, packaged, stored or located, in transit, or where the said goods or copies are being offered for sale, rental, lending or other distribution, or where the manufacturing or packaging of the said goods or copies is being prepared,

(iii) seizure of the tools that could be used to manufacture or package the goods suspected to be counterfeit goods or the copies suspected to be pirate copies, and of any document, accounts or business papers referring to the said goods or copies,

(iv) ordering the termination of the manufacture, packaging, exportation, importation, transit, offering for sale, rental, lending or other distribution or the sale, rental, lending, other distribution or possession, with the intention of placing them on the market, of the goods suspected to be counterfeit goods or of the copies suspected to be pirate copies,

(v) ordering disclosure of the source of the goods suspected to be counterfeit goods or of the copies suspected to be pirate copies, refusal to comply with such an order being subject to the payment of a fine.

[Observations concerning Article B, continuation]

51. Ad paragraph (3). This provision seems to be self-explanatory.

52. Ad paragraph (4). This provision seems to be self-explanatory.

53. Ad paragraph (5). Security (bond) may be required from the requesting party so as to avoid possible abuse, particularly if the potential damage to the person subject to the measure is considerable in terms of money and/or his reputation.

54. Ad paragraph (6). For the measures taken to be effective, they usually must take the person suspected to commit or to be likely to commit acts of counterfeiting or piracy by surprise. Otherwise, he could hide or conceal the goods, the copies or his activities. However, once the measure has been taken, the said person should be heard and, if his defense is convincing, the measure should be withdrawn.

55. Ad paragraph (7). Where the measure has been taken by a law enforcement authority that is not a court (see paragraph 41, above), the requesting party must ask for the court's approval, but only where no appeal has been lodged by the person who may suffer prejudice as a consequence of the measure.

56. Ad paragraph (8). If the allegation of counterfeiting or piracy proves to be wrong, the person who requested the measure and alleged counterfeiting or piracy may be held responsible for any damage caused.

[Article B, continuation]

(3) The court authorizing or ratifying the measure of the law enforcement authority must find that the acts committed or likely to be committed may reasonably be suspected of constituting acts of counterfeiting or of piracy.

(4) The court or the law enforcement authority shall cancel the measure if the requirement set forth in paragraph (3) is no longer fulfilled.

(5) The court or the law enforcement authority shall, where it deems it necessary, order that the requesting party post a bond.

(6) The court or the law enforcement authority may order or take the measure even without offering the person who may suffer prejudice as a consequence of the measure any opportunity to be heard before it is ordered or taken. Such an opportunity shall be offered as soon as practicable after the measure has been ordered or taken.

(7) Where the measure has been taken by a law enforcement authority and where no appeal has been lodged by the person who may suffer prejudice as a consequence of that measure, the requesting party must ask for the court's approval within a maximum period of [one month] [10 working days] from the date on which the measure was taken. If approval is not sought during the said period, or if it is refused by the court, the measure shall be cancelled by the authority that took it.

(8) If the court finds that there was no act of counterfeiting or of piracy, the requesting party shall be liable for the damages caused by the measure.

Observations Concerning Article C

57. Ad paragraph (1). The general law on damages shall apply. The latter may consist of compensation for damnum emergens (actual damage) or of lucrum cessans (profit not realized). They may also compensate for the harm done to the reputation of the owner of the mark.

58. Ad paragraph (2). As a rule, the paragraph provides the ordering of destruction, "unless the injured party requests otherwise." Another measure may consist of the confiscation of the goods and the transfer of the property in them to the injured party or the sale (auction or otherwise) with the income from the sale going to the injured party. It is to be noted that confiscation may not be possible under the general legal principles of some countries. According to the paragraph under consideration, there is one case in which the court may forego the ordering of destruction even where the injured party does not ask for a measure other than destruction. That is the case in which the counterfeit trademark is physically removable from the counterfeit goods. In such a case, the court may order the removal of the trademark, except where the goods are of a nature that they may involve a risk to life, health or safety.

[continues]

Article C

CIVIL REMEDIES

(1) The natural person or legal entity injured by an act of counterfeiting or of piracy (hereinafter referred to as "the injured party") shall be entitled to damages for the prejudice suffered by him or it as a consequence of the act of counterfeiting or piracy, as well as payment of his or its legal costs, including lawyer's fees. The amount of the damages shall be fixed taking into account the material and moral prejudice suffered by the injured party, as well as the profits earned as a result of the act of counterfeiting or piracy.

(2) Where the counterfeit goods or pirate copies exist, the court shall order the destruction of those goods or copies and of their packaging, unless the injured party requests otherwise. However, where the act of counterfeiting involves the violation of trademark rights, and no other rights, and where it concerns goods other than goods that may involve a risk to life, health or safety, the court may order measures other than destruction, provided that the trademark is removed from the goods or their packaging and that the person having committed the act of counterfeiting derives no benefit from the sale or other disposal of the goods.

[continues]

[Observations concerning Article C, continuation]

59. Ad paragraph (3). This provision seems to be self-explanatory.

60. Ad paragraph (4). Not all countries know the kind of measure--generally called "injunction"--provided for in this paragraph. But, where it exists, it is generally regarded as a particularly effective measure since a fine whose amount is fixed in advance is usually a persuasive deterrent.

[Article C, continuation]

(3) Where there is a danger that certain tools may, in the future, be used to continue acts of counterfeiting or piracy, the court shall order their destruction or their surrender to the injured party.

(4) Where there is a danger that any of the acts of counterfeiting or piracy may be continued, the court shall expressly order that such acts not be committed. Furthermore, the court shall fix the amount of the fine to be paid where the order is not respected.

Observations Concerning Article D

61. Ad Article D in general. Criminal law and procedure differ considerably from one country to another. Any implementation by a given country of the model provisions will therefore be determined by the traditional criminal law system of that country.

62. Ad paragraph (1). The first sentence of this paragraph states that an act of counterfeiting or piracy is an offense. Depending on the system of criminal law of the country, and the terminology of that system, the offense may be a "crime," a "felony," a "delict" or a simple "misdemeanor."

63. The rest of the paragraph is divided into two alternatives, the difference being that, whereas Alternative A prescribes different punishments according to whether the defendant acted with or without criminal intent, Alternative B makes no such distinction and would apply whether or not criminal intent was present.

64. Alternative A provides, simply stated, that where there is criminal intent, counterfeiting or piracy is a theft and has to be punished as such (item (i)). It furthermore provides for a fine (not for imprisonment) where there is no criminal intent (item (ii)).

65. Alternative B provides for fine and/or imprisonment, leaving the choice between these two punishments to the court, which, naturally, can also cumulate the two kinds of punishment. The choice and/or the severity of the punishment will, naturally, be influenced, among other things, by the presence or absence of criminal intent.

[continues]

Article D

CRIMINAL SANCTIONS

(1) Any act of counterfeiting or piracy shall constitute an offense.

Any person who has committed such an act shall be punished:

Alternative A

(i) where the said act was committed with criminal intent, by the same punishment as that provided for theft,

(ii) where the said act was committed without criminal intent, by a fine of ... to ..., the amount of the fine to be fixed by the court taking into account in particular the profits earned as a result of the act of counterfeiting or piracy.

Alternative B

by imprisonment for a period of ... to ..., or by a fine of ... to ..., or by both, the amount of the fine to be fixed by the court taking into account in particular the profits earned as a result of the act of counterfeiting or piracy.

[continues]

[Observations concerning Article D, continuation]

66. Ad paragraph (2). This paragraph is an implied invitation to the courts to be particularly severe when the counterfeit goods may represent a danger to life, health or safety. Pharmaceuticals, medical tools and implements, food products, spare parts of automobiles and other vehicles, certain sport equipments and toys are examples where such danger is likely.

67. Ad paragraph (3). This paragraph is an invitation to the courts to be more severe in the case of recidivism than in the case of a first offense.

68. Ad paragraph (4). The remedies referred to in this paragraph are destruction or disposal of goods or copies (Article C(2)) and destruction or surrender of tools (Article C(3)).

[Article D, continuation]

(2) The court shall, in the case of an act of counterfeiting, fix the punishment taking into account any risk to life, health or safety that the presence or the use of the counterfeit goods may cause.

(3) In the case of conviction, the upper limits of the penalties specified in paragraph (1) may be increased up to double where the defendant has been found guilty for an act of counterfeiting or piracy in the five years preceding the conviction.

(4) The court shall apply the remedies referred to in Article C(2) and (3) also in a criminal proceeding.

[End of model provisions]

WIPO



C&P/CE/2 Corr.

ORIGINAL: English only

DATE: April 25, 1988

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

COMMITTEE OF EXPERTS
ON MEASURES AGAINST COUNTERFEITING
AND PIRACY

Geneva, April 25 to 28, 1988

CORRIGENDUM TO DOCUMENT C&P/CE/2

prepared by the International Bureau

1. On page 12, in paragraph 36, the references between parentheses should be "paragraph 17" instead of "paragraph 11" and "paragraphs 18 and 30" instead of "paragraphs 12 and 30."
2. On page 18, in paragraph 56, last line, the word "may" should be replaced by the word "will."

[End of document]

WIPO



C&P/CE/3

ORIGINAL: English

DATE: February 18, 1988

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**COMMITTEE OF EXPERTS
ON MEASURES AGAINST COUNTERFEITING
AND PIRACY**

Geneva, April 25 to 28, 1988

PROVISIONS IN THE PARIS, BERNE AND
NEIGHBORING RIGHTS CONVENTIONS

Memorandum by the International Bureau

INTRODUCTION

1. For the history of the efforts of the World Intellectual Property Organization in the field of counterfeiting and piracy and the objectives pursued to combat the said illegal activities, see paragraphs 1 to 6 of document C&P/CE/2, a document which otherwise deals with model provisions for national laws on measures against counterfeiting and piracy.

2. The present document deals with the analysis of the Paris Convention, the Berne Convention and two of the so-called neighboring rights conventions, namely the Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations (hereinafter referred to as "the Rome Convention") and the Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms (hereinafter referred to as "the Phonograms Convention") as far as relevant to counterfeiting and piracy.

PARIS CONVENTION

3. In the following, an analysis is given of those provisions of the Paris Convention that have a bearing on the phenomenon of counterfeiting. The full text of those provisions appears in Annex I.

National Treatment in Respect of the Protection of Patents, Trademarks and Other Industrial Property Rights

4. National treatment is provided for in Articles 2 and 3 of the Paris Convention. According to those Articles, each country party to the Paris Convention must grant the same protection, in the field of industrial property (including, in particular, patents for inventions, industrial designs, trademarks, trade names and unfair competition), to nationals of other countries members of the Union as to its own nationals. Nationals of countries that are not party to the Convention are also protected under the Convention if they are domiciled or have a real and effective industrial or commercial establishment in the territory of one of the countries party to the Paris Convention.

5. This rule of national treatment or assimilation guarantees not only that foreigners shall be protected, but also that they may not be the subject of any discrimination. They have the right to request application of the national law of a country party to the Convention as it is applied to nationals of that country, whether it is the law on patents, trademarks, or any other law protecting industrial property rights. They then benefit from the same protection as the nationals and from the same legal remedies for any injury done to their rights.

6. For example, a national of a country party to the Paris Convention who has been the subject of counterfeiting in another country party to the Convention may, in respect of the counterfeiter, use the measures of protection--in the industrial property field--provided for under the national legislation of the latter country and may request application of the sanctions contained in the said legislation. This means that, when confronted with an offense of counterfeiting committed in a country party to the Paris Convention, the same basic rules regarding legal action, criminal or civil, apply, whether the injured party is a national of the country party to the Convention where the unlawful act took place or is a national of another country party to the Convention.

Trademarks and Trade Names

7. Article 10~~ter~~(1) of the Paris Convention provides that "the countries [members] of the [Paris] Union undertake to assure to nationals of the other countries of the Union appropriate legal remedies effectively to repress all acts referred to in Articles 9, 10 and 10~~bis~~."

8. The act referred to in Article 9 is that of making any goods unlawfully bearing a trademark or trade name. In other words, the unlawful presence of a protected mark on goods is an act or situation resulting from an act that the countries party to the Paris Convention must "effectively ... repress" by "appropriate legal remedies."

9. Three Types of Measures. Article 9 mentions three such legal remedies: (i) seizure (paragraphs (1) to (6)), (ii) prohibition of importation (paragraph (5)) and (iii) other "actions and remedies" (paragraph (6)), that

is to say actions and remedies other than seizure or prohibition of importation.

10. Seizure. Article 9 draws a distinction between seizure applicable to goods of the country concerned ("seizure... in the country where the unlawful fixation occurred" (paragraph (2)) and seizure applicable to foreign goods (goods which must be "seized on importation" and "imported" goods (paragraphs (1) and (2)).

11. With regard to the seizure of goods counterfeited in the country, the obligation to seize them (paragraph (2)) is compulsory where none of the exceptions provided for in paragraphs (4), (5) and (6) applies.

12. With regard to seizure of foreign counterfeit goods, paragraphs (1) and (2) provide for an obligation to seize them (i) "on importation" and (ii) (if they are not seized de facto on importation) "in the country," that is to say in the country into which these goods are imported. However, this obligation is not compulsory in either case.

13. The obligation to seize on importation is not compulsory because, as paragraph (5) shows, a country's legislation might not permit seizure on importation. If this is the case, the country in question must replace this by "prohibition of importation" or "seizure inside the country." However, the Paris Convention allows that even these replacement measures might not exist and, if this is the case, "until such time as the legislation [of a country] is modified accordingly" (paragraph 6), these replacement measures shall be substituted "by the actions and remedies available in such cases to nationals under the law of such country" (paragraph 6). Paragraph 16, below, deals with such actions and remedies.

14. The obligation to seize foreign counterfeit goods inside the country is not compulsory either because, as paragraph (6) shows, a country's legislation may not provide for such seizure. However, if it does not provide for such seizure, it must replace it "by the actions and remedies available in such cases to nationals under the law of such country" (paragraph (6)). Paragraph 16, below, deals with such actions and remedies.

15. Prohibition of Importation. As has already been stated, one of the measures by which a country party to the Paris Convention may replace seizure on importation is "prohibition of importation" (paragraph (5)). However, the Paris Convention allows that such a replacement measure may not exist and, if this is the case, "until such time as the legislation [of a country] is modified accordingly" (paragraph (6)), the said replacement measure shall be substituted "by the actions and remedies available in such cases to nationals under the law of such country" (paragraph (6)). The following paragraph deals with such actions and remedies.

16. Other Actions and Remedies. What are these "actions and remedies?" In accordance with Article 10^{ter}(1), they must be "appropriate," "legal" and able "effectively to repress" unlawful acts. The Paris Convention does not give any details concerning such actions and remedies. This does not however mean that such actions and remedies should not exist. They must exist. The usual actions and remedies are (i) prohibition (of continuation) of the sale of the counterfeit goods, (ii) destruction of the counterfeit goods, (iii) the award of damages to be paid by the counterfeiter to the rightful owner of the counterfeited trademark or trade name and (iv) punishment of the counterfeiter by a fine and/or imprisonment. All these actions and remedies are appropriate, legal and effective. Since it is difficult to envisage many

other actions or remedies that correspond to these three criteria, it is believed that a correct interpretation of the Paris Convention is that at least one of these four types of actions and remedies, if not all four, should be provided for in the legislation of each of the countries party to the Paris Convention. (Naturally, as stated above, seizure of counterfeit goods in the country, mentioned in paragraph 11, above, also constitutes an action or remedy that should be envisaged.)

17. Well-known Marks. The Paris Convention obliges countries that are party to it to assure special protection to well-known marks. This protection is of particular interest in the case of counterfeit goods when the marks usually appearing--unlawfully appearing--on such goods are well-known marks.

18. Article 6bis of the Paris Convention guarantees protection for any well-known mark in a country party to the Paris Convention, even if the said mark has not been registered in that country. The protection of a well-known mark does not depend upon its registration, if it is registered, but upon the simple fact of its reputation. Article 6bis therefore has the following implications: even if a country's legislation makes the protection of marks subject to registration, an unregistered mark used by A will prevent, or should prevent, registration of the same mark or a similar mark in the name of B, if A's mark is well-known and if B applies for registration for identical or similar goods to those for which A's mark is used, it being understood that A must fulfill the conditions required to benefit from protection under the Paris Convention.

19. According to the said provision, the protection of a well-known mark results from the obligation of any country party to the Paris Convention to

take, either automatically (if its legislation so permits), or at the request of the interested party, measures of three types, namely:

- (i) the country in question must refuse registration of any disputed mark;
- (ii) the country in question must cancel any registration of a disputed mark made by mistake; each country must allow a minimum period of five years from the date of registration during which a request for cancellation must be made; however, where the mark has been registered in bad faith, no time limit is laid down for requesting the mark's cancellation;
- (iii) the country must prohibit use of any disputed mark; it may provide for a period within which the prohibition of use must be requested; however, where the said mark was used in bad faith, there is no time limit for requesting that its use be prohibited.

False Indications of Source

20. The Paris Convention provides that Article 10(1) of that Convention "shall apply in cases of direct or indirect use of a false indication of the source of the goods..."

21. Article 10 deals with seizure, prohibition of importation and certain other "actions and remedies." These measures are analyzed in paragraphs 9 to 16, above, and that analysis applies also to false indications of source.

22. Examples of typical cases of false indications of source are that a cigar is indicated to be Brazilian or Cuban, when it is not; that a coffee is

indicated to be Colombian or Kenyan, when it is not; that a carpet is indicated to be Afghan, Iranian or Turkish, when it is not; that a tea is indicated to be Indian or Sri Lankan, when it is not; that a silk is indicated to be Chinese or Thai, when it is not; that a cheese is indicated to be Danish, French or Swiss, when it is not; that a wine is indicated to be Bordeaux, Chilean or Californian, when it is not; that a knife is indicated to be from Toledo or Solingen, when it is not.

23. It is to be noted that Article 10(2) defines who is an "interested party"—that is, a party that can bring an action in the case of false indications. That provision says that "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."

False Indications of the Identity of the Producer, Manufacturer or Merchant

24. The Paris Convention provides that Article 10(1) of that Convention "shall apply in cases of direct or indirect use of a false indication of ... the identity of the producer, manufacturer, or merchant."

25. Article 10 deals with seizure, prohibition of importation and certain other "actions and remedies." These measures are analyzed in paragraphs 9 to 16, above, and that analysis applies also to any false indication of the producer, manufacturer or merchant.

Unfair Competition

26. The Paris Convention obliges countries that are parties to it "to assure to nationals of such countries [of the Union] effective protection against unfair competition" (Article 10bis(1)). It gives examples of acts of unfair competition that must be prohibited.

27. Among such acts are "all acts of such a nature as to create confusion by any means whatever with ... the goods ... of a competitor" (Article 10bis(3)1). The expression "by any means whatever" obviously includes the reproduction or imitation of a trademark, of an industrial design or of a certain appearance of goods or their packaging.

28. Article 10bis(3) expressly provides for the prohibition of the following:

"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."

29. The provisions quoted are to be found in Article 10bis of the Convention. The Article immediately following Article 10bis, namely Article 10ter of the Paris Convention, provides that the countries party to the Convention are obliged "to assure to nationals of the other countries of the [Paris] Union appropriate legal remedies effectively to repress all the acts referred to in Articles ... 10bis" (Article 10ter(1)). For the analysis of Article 10ter, see paragraph 16, above.

BERNE CONVENTION

30. In the following, an analysis is given of those provisions of the Berne Convention that have a bearing on the phenomenon of piracy. The full text of those provisions appears in Annex II.

National Treatment

31. National treatment is principally provided in Article 5(1) of the Berne Convention. According to that provision, foreign authors enjoy the same rights in a country party to the Convention as do nationals of that country.

Piracy

32. The essence of piracy is the illegal manufacture of copies or, in the terminology of the Berne Convention, reproductions. Article 9(1) of that Convention provides that "authors of literary and artistic works ... shall have the exclusive right of authorizing the reproduction of these works, in any manner or form." Article 9(3) specifies that "any sound or visual recording shall be considered as a reproduction."

33. In other words, copies made without the authorization of the author (or whoever lawfully acts in his name) are illegal copies. It is to be noted that Article 9(2) permits exceptions to the exclusive right of authorization "in certain special cases" but only if the reproduction made without the author's authorization "does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author." The exception obviously is inapplicable to piracy—which means reproduction on a

commercial scale--since unauthorized reproduction on a commercial scale evidently is contrary to "normal exploitation" and evidently prejudices "unreasonably" the legitimate interests of the author.

34. The right of reproduction is also specially mentioned in respect of cinematographic works (Articles 14(1) and 14**bis**(1)).

Seizure

35. One of the important measures for combating piracy is provided for in Article 16 of the Berne Convention. Paragraph (1) of that Article provides that "infringing copies of a work shall be liable to seizure in any country of the Union where the work enjoys legal protection." Furthermore, paragraph (2) of that Article provides that seizure must be applied also "to reproductions coming from a country where the work is not protected, or has ceased to be protected." For example, if the copies of a work were manufactured in a country which has no copyright law or in a country in which the term of the protection of that work has already expired, such copies must be seized when they are imported in a country in which the work is (still) protected by copyright.

Presumption of Authorship

36. In an infringement proceeding, the author has generally to prove that he is the author of the work in question and that his right has been infringed by the defendant. The Berne Convention contains a rule on presumption of authorship. In order that the author of a literary or artistic work protected under the Convention shall, in the absence of proof to the contrary, be

regarded as such, and consequently be entitled to institute infringement proceedings in the countries of the Union, it shall be sufficient for his name to appear on the work in the usual manner (Article 15(1)). The Convention also contains certain special provisions on presumptions in respect of anonymous and pseudonymous works as well as in respect of cinematographic works and unpublished works where the identity of the author is unknown (Article 15(2) to (4)).

37. These provisions, to which similar provisions in a number of national laws correspond, are of particular importance in piracy cases where there might be a need for quick action and where there might be a risk for delays and other problems caused by procedural obstacles based on the fact that the defendant does not agree on the plaintiff's authorship.

ROME CONVENTION

38. In the following, an analysis is given of those provisions of the Rome Convention that have a bearing on the phenomenon of piracy. The full text of those provisions appears in Annex III.

National Treatment

39. National treatment is provided in Articles 4 to 6 of the Rome Convention. According to those provisions, foreign performers, phonogram producers and broadcasting organizations enjoy the same rights in a country party to the Convention as do nationals of that country.

Piracy

40. The Rome Convention provides protection against the illegal manufacture of copies of fixations of performances, phonograms and broadcasts or, in the terminology of the Convention, reproductions. It is an obligation on countries that are party to the Convention to guarantee to performers the possibility of preventing the fixation, without their consent, of their unfixed performances, and, subject to certain conditions, the reproduction of fixations of their performances (Article 7); to phonogram producers the right to authorize or prohibit the direct or indirect reproduction of their phonograms (Article 10); and, finally, to broadcasting organizations the right to authorize or prohibit the fixation of their broadcasts and, subject to certain conditions, the reproduction of such fixations (Article 13).

41. In other words, copies made without the consent of performers, phonogram producers or broadcasting organizations, respectively (or whoever, lawfully, acting in their name), are illegal copies.

42. Article 15 of the Convention permits exceptions--in certain precisely defined cases--to the right mentioned in paragraph 40, above (such as in the case of private use, teaching and research and in cases where exceptions are allowed also in respect of the protection of copyright in literary and artistic works). No exceptions are applicable to piracy, that is, to reproduction on a commercial scale of copies of fixations of performances, phonograms and broadcasts.

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PHONOGRAMS CONVENTION

43. In the following, an analysis is given to those provisions of the Phonograms Convention that have a bearing on the phenomenon of piracy. The full text of those provisions appears in Annex IV.

The Protection of Nationals of Other Countries Party to the Convention

44. In the Phonograms Convention, no mention is made of the principle of national treatment.

45. The lack of provisions concerning national treatment follows from the fact that the Phonograms Convention is not intended to regulate the protection of phonogram producers, in general; its only purpose is to guarantee efficient protection against piracy of phonograms. Therefore, the Convention only defines the acts against which each contracting State is obliged to grant protection to nationals of other contracting States (Article 2), and does not deal with the question of what protection, and on what basis, phonogram producers (nationals or foreigners) should be granted in other aspects.

46. Article 2 determines what certain basic acts of piracy are in respect of phonograms. Under that article, protection must be granted against the making of duplicates without the consent of the producer and against the importation of such duplicates, provided that any such making or importation is for the purpose of distribution to the public, and against the distribution of such duplicates to the public.

[The Annexes follow]

ANNEX I

PROVISIONS OF THE PARIS CONVENTION

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 5^{quinquies}

[Industrial Designs]

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

¹) Articles have been given titles to facilitate their identification. There are no titles in the signed (French) text.

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 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.

[Annex II follows]

ANNEX II

PROVISIONS OF THE BERNE CONVENTION

Article 5

[*Rights Guaranteed*: 1. and 2. Outside the country of origin; 3. In the country of origin; 4. "Country of origin"]

(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.

Article 9

[*Right of Reproduction*: 1. Generally; 2. Possible exceptions; 3. Sound and visual recordings]

(1) Authors of literary and artistic works protected by this Convention shall have the exclusive right of authorizing the reproduction of these works, in any manner or form.

(2) It shall be a matter for legislation in the countries of the Union to permit the reproduction of such works in certain special cases, provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author.

(3) Any sound or visual recording shall be considered as a reproduction for the purposes of this Convention.

Article 14

[*Cinematographic and Related Rights*: 1. Cinematographic adaptation and reproduction; distribution; public performance and public communication by wire of works thus adapted or reproduced; 2. Adaptation of cinematographic productions; 3. No compulsory licenses]

(1) Authors of literary or artistic works shall have the exclusive right of authorizing:

- (i) the cinematographic adaptation and reproduction of these works, and the distribution of the works thus adapted or reproduced;
- (ii) the public performance and communication to the public by wire of the works thus adapted or reproduced.

Article 14^{bis}

[*Special Provisions Concerning Cinematographic Works*: 1. Assimilation to "original" works; 2. Ownership; limitation of certain rights of certain contributors; 3. Certain other contributors]

(1) Without prejudice to the copyright in any work which may have been adapted or reproduced, a cinematographic work shall be protected as an original work. The owner of copyright in a cinematographic work shall enjoy the same rights as the author of an original work, including the rights referred to in the preceding Article.

Article 15

[*Right to Enforce Protected Rights*: 1. Where author's name is indicated or where pseudonym leaves no doubt as to author's identity; 2. In the case of cinematographic works; 3. In the case of anonymous and pseudonymous works; 4. In the case of certain unpublished works of unknown authorship]

(1) In order that the author of a literary or artistic work protected by this Convention shall, in the absence of proof to the contrary, be regarded as such, and consequently be entitled to institute infringement proceedings in the countries of the Union, it shall be sufficient for his name to appear on the work in the usual manner. This paragraph shall be applicable even if this name is a pseudonym, where the pseudonym adopted by the author leaves no doubt as to his identity.

(2) The person or body corporate whose name appears on a cinematographic work in the usual manner shall, in the absence of proof to the contrary, be presumed to be the maker of the said work.

(3) In the case of anonymous and pseudonymous works, other than those referred to in paragraph (1) above, the publisher whose name appears on the work shall, in the absence of proof to the contrary, be deemed to represent the author, and in this capacity he shall be entitled to protect and enforce the author's rights. The provisions of this paragraph shall cease to apply when the author reveals his identity and establishes his claim to authorship of the work.

(4) (a) In the case of unpublished works where the identity of the author is unknown, but where there is every ground to presume that he is a national of a country of the Union, it shall be a matter for legislation in that country to designate the competent authority which shall represent the author and shall be entitled to protect and enforce his rights in the countries of the Union.

(b) Countries of the Union which make such designation under the terms of this provision shall notify the Director General by means of a written declaration giving full information concerning the authority thus designated. The Director General shall at once communicate this declaration to all other countries of the Union.

Article 16

[Infringing Copies : 1. Seizure; 2. Seizure on importation; 3. Applicable law]

(1) Infringing copies of a work shall be liable to seizure in any country of the Union where the work enjoys legal protection.

(2) The provisions of the preceding paragraph shall also apply to reproductions coming from a country where the work is not protected, or has ceased to be protected.

(3) The seizure shall take place in accordance with the legislation of each country.

Article 36

*[Application of the Convention : 1. Obligation to adopt the necessary measures;
2. Time from which obligation exists]*

(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 becomes bound by this Convention, it will be in a position under its domestic law to give effect to the provisions of this Convention.

[Annex III follows]

ANNEX III

PROVISIONS OF THE ROME CONVENTION

Article 4

[Performances Protected. Points of Attachment for Performers]

Each Contracting State shall grant national treatment to performers if any of the following conditions is met:

- (a) the performance takes place in another Contracting State;
- (b) the performance is incorporated in a phonogram which is protected under Article 5 of this Convention;
- (c) the performance, not being fixed on a phonogram, is carried by a broadcast which is protected by Article 6 of this Convention.

Article 5

[Protected Phonograms: 1. Points of Attachment for Producers of Phonograms; 2. Simultaneous Publication; 3. Power to exclude certain Criteria]

1. Each Contracting State shall grant national treatment to producers of phonograms if any of the following conditions is met:

- (a) the producer of the phonogram is a national of another Contracting State (criterion of nationality);
- (b) the first fixation of the sound was made in another Contracting State (criterion of fixation);
- (c) the phonogram was first published in another Contracting State (criterion of publication).

2. If a phonogram was first published in a non-contracting State but if it was also published, within thirty days of its first publication, in a Contracting State (simultaneous publication), it shall be considered as first published in the Contracting State.

3. By means of a notification deposited with the Secretary-General of the United Nations, any Contracting State may declare that it will not apply the criterion of publication or, alternatively, the criterion of fixation. Such notification may be deposited at the time of ratification, acceptance or accession, or at any time thereafter; in the last case, it shall become effective six months after it has been deposited.

Article 6

[Protected Broadcasts: 1. Points of Attachment for Broadcasting Organizations; 2. Power to Reserve]

1. Each Contracting State shall grant national treatment to broadcasting organisations if either of the following conditions is met:

- (a) the headquarters of the broadcasting organisation is situated in another Contracting State;
- (b) the broadcast was transmitted from a transmitter situated in another Contracting State.

2. By means of a notification deposited with the Secretary-General of the United Nations, any Contracting State may declare that it will protect broadcasts only if the headquarters of the broadcasting organisation is situated in another Contracting State and the broadcast was transmitted from a transmitter situated in the same Contracting State. Such notification may be deposited at the time of ratification, acceptance or accession, or at any time thereafter; in the last case, it shall become effective six months after it has been deposited.

Article 7

[Minimum Protection for Performers: 1. Particular Rights;
2. Relations between Performers and Broadcasting Organizations]

1. The protection provided for performers by this Convention shall include the possibility of preventing:

(a) the broadcasting and the communication to the public, without their consent, of their performance, except where the performance used in the broadcasting or the public communication is itself already a broadcast performance or is made from a fixation;

(b) the fixation, without their consent, of their unfixed performance;

(c) the reproduction, without their consent, of a fixation of their performance:

- (i) if the original fixation itself was made without their consent;
- (ii) if the reproduction is made for purposes different from those for which the performers gave their consent;
- (iii) if the original fixation was made in accordance with the provisions of Article 15, and the reproduction is made for purposes different from those referred to in those provisions.

Article 10

[Right of Reproduction for Phonogram Producers]

Producers of phonograms shall enjoy the right to authorise or prohibit the direct or indirect reproduction of their phonograms.

Article 13

[Minimum Rights for Broadcasting Organizations]

Broadcasting organisations shall enjoy the right to authorise or prohibit:

(a) the rebroadcasting of their broadcasts;

(b) the fixation of their broadcasts;

(c) the reproduction:

- (i) of fixations, made without their consent, of their broadcasts;
- (ii) of fixations, made in accordance with the provisions of Article 15, of their broadcasts, if the reproduction is made for purposes different from those referred to in those provisions;

(d) the communication to the public of their television broadcasts if such communication is made in places accessible to the public against payment of an entrance fee; it shall be a matter for the domestic law of the State where protection of this right is claimed to determine the conditions under which it may be exercised.

Article 15

[Permitted Exceptions: 1. Specific Limitations;
2. Equivalents with copyright]

1. Any Contracting State may, in its domestic laws and regulations, provide for exceptions to the protection guaranteed by this Convention as regards:

- (a) private use;
- (b) use of short excerpts in connexion with the reporting of current events;
- (c) ephemeral fixation by a broadcasting organisation by means of its own facilities and for its own broadcasts;
- (d) use solely for the purposes of teaching or scientific research.

2. Irrespective of paragraph 1 of this Article, any Contracting State may, in its domestic laws and regulations, provide for the same kinds of limitations with regard to the protection of performers, producers of phonograms and broadcasting organisations, as it provides for, in its domestic laws and regulations, in connexion with the protection of copyright in literary and artistic works. However, compulsory licences may be provided for only to the extent to which they are compatible with this Convention.

[Annex IV follows]

ANNEX IV

PROVISIONS OF THE PHONOGRAMS CONVENTION

Article 2

[Obligations of Contracting States; Whom they must protect and against what]

Each Contracting State shall protect producers of phonograms who are nationals of other Contracting States against the making of duplicates without the consent of the producer and against the importation of such duplicates, provided that any such making or importation is for the purpose of distribution to the public, and against the distribution of such duplicates to the public.

Article 3

[Means of Implementation by Contracting States]

The means by which this Convention is implemented shall be a matter for the domestic law of each Contracting State and shall include one or more of the following: protection by means of the grant of a copyright or other specific right; protection by means of the law relating to unfair competition; protection by means of penal sanctions.

Article 6

[Limitations on Protection]

Any Contracting State which affords protection by means of copyright or other specific right, or protection by means of penal sanctions, may in its domestic law provide, with regard to the protection of producers of phonograms, the same kinds of limitations as are permitted with respect to the protection of authors of literary and artistic works. However, no compulsory licenses may be permitted unless all of the following conditions are met:

- (a) the duplication is for use solely for the purpose of teaching or scientific research;
- (b) the license shall be valid for duplication only within the territory of the Contracting State whose competent authority has granted the license and shall not extend to the export of duplicates;
- (c) the duplication made under the license gives rise to an equitable remuneration fixed by the said authority taking into account, inter alia, the number of duplicates which will be made.

WIPO



C&P/CE/4

ORIGINAL: English/French

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WORLD INTELLECTUAL PROPERTY ORGANIZATION GENEVA

COMMITTEE OF EXPERTS ON MEASURES AGAINST COUNTERFEITING AND PIRACY

Geneva, April 25 to 28, 1988

REPORT

adopted by the Committee of Experts

I. INTRODUCTION

1. Having been convened by the Director General of the World Intellectual Property Organization (WIPO) pursuant to a decision taken by the General Assembly of WIPO (see paragraphs 88(ii) and 140 of document AB/XVIII/14), at its ninth session (September 1987), the Committee of Experts on Measures Against Counterfeiting and Piracy (hereinafter referred to as "the Committee of Experts") met in Geneva from April 25 to 28, 1988.

2. The following States were represented at the session: Afghanistan, Algeria, Argentina, Australia, Austria, Belgium, Brazil, Bulgaria, Burundi, Canada, China, Colombia, Congo, Côte d'Ivoire, Cuba, Democratic People's Republic of Korea, Denmark, Egypt, Finland, France, Germany (Federal Republic of), Honduras, Hungary, India, Ireland, Israel, Italy, Jamaica, Japan, Mexico, Morocco, Netherlands, Norway, Pakistan, Panama, Portugal, Republic of Korea, Soviet Union, Spain, Sweden, Switzerland, Togo, Tunisia, Turkey, United Kingdom, United Republic of Tanzania, United States of America, Uruguay, Yemen, Yugoslavia, Zaire (51).

3. Representatives of the International Labour Organisation (ILO), the United Nations Educational, Scientific and Cultural Organization (UNESCO), the General Agreement on Tariffs and Trade (GATT), the Commission of the European Communities (CEC), the Customs Co-operation Council (CCC), the Organization of African Unity (OAU) and the International Criminal Police Organization (INTERPOL/ICPO) also took part in the session as observers, as did representatives of the following 30 non-governmental organizations: American Bar Association (ABA), Asian Patent Attorneys Association (APAA), Brazilian Association of Industrial Property (ABPI), Bundesverband der Deutschen Industrie (BDI), Centre for International Industrial Property Studies (CEIPI), Committee Against Counterfeiting (COLC International), Committee of National Institutes of Patent Agents (CNIPA), Deutsche Vereinigung für Gewerblichen Rechtsschutz und Urheberrecht (DVGR), European Association of Industries of Branded Products (AIM), European Broadcasting Union (EBU), European Communities Trademark Practitioners' Association (ECTA), European Council of Chemical Manufacturers' Federations (CEFIC), International Association for the Protection of Industrial Property (AIPPI), International Bureau of Societies Administering the Rights of Mechanical Recording and Reproduction (BIEM), International Chamber of Commerce (ICC), International Confederation of Societies of Authors and Composers (CISAC), International Copyright Society (INTERGU), International Federation of Associations of Films Distributors (FIAD), International Federation of Film Producers Associations (FIAPF), International Federation of Industrial Property Attorneys (FICPI), International Federation of Phonogram and Videogram Producers (IFPI), International Federation of Translators (FIT), International League for Competition Law (LIDC), International Publishers Association (IPA), International Secretariat for Arts, Mass Media and Entertainment Trade Unions (ISETU - FIET), Licensing Executives Society (International) (LES), Max-Planck Institute for Foreign and International Patent, Copyright and Competition Law, The Chartered Institute of Patent Agents (CIPA), Trade Marks, Patents and Designs Federation (TMPDF), Union of Industrial and Employers' Confederation of Europe (UNICE).

4. The list of participants appears in the Annex to this report.

5. Dr. Arpad Bogsch, Director General of WIPO, opened the session and welcomed the participants.

6. The Committee of Experts unanimously elected Mrs. Lise ØSTERBORG (Denmark) Chairman and Mr. Paulo R. DE ALMEIDA (Brazil) and Mr. LIU Minxue (China) Vice-Chairmen. Mr. L. Baeumer and Mr. M. Ficsor (both of the International Bureau of WIPO) acted as Secretaries of the Committee of Experts.

7. Discussions were based on two documents, entitled "Model Provisions for National Laws" (C&P/CE/2) and "Provisions in the Paris, Berne and Neighbouring Rights Conventions" (C&P/CE/3). The Secretariat noted the interventions made and recorded them on tape. This report summarizes the discussions and does not reflect all the observations made.

II. GENERAL OBSERVATIONS

8. The Delegation of Brazil, speaking on behalf of the Latin American countries, stressed the importance attached by the countries of the region to the work of the International Bureau and of the Committee of Experts on Counterfeiting and Piracy and their willingness to cooperate towards the successful achievements of WIPO in this field, as the results could greatly enhance the fight against counterfeiting and piracy on various levels. It also pointed out the relationship existing between the work being accomplished by this Committee and initiatives being carried out in other fora, as for instance in the negotiations of the Uruguay Round on the trade related aspects of intellectual property rights, including trade in counterfeit goods. In this regard, it expressed the desire of those countries to see the issues under examination in the Committee be transmitted to the Uruguay Round, as an example of the concern all WIPO member States attributed to the adoption of effective measures against counterfeiting and piracy. In its own name, the Delegation of Brazil emphasized the importance of the work that had been going on for three years within WIPO in support of the fight against counterfeiting, which in the meantime had been extended into the field of piracy. The Delegation recalled that its country was one of the sponsors of the decision unanimously adopted by the WIPO General Assembly in October 1985 pursuant to which the present Committee of Experts had been set up. The work in progress was an example of what could be done for the protection of intellectual property rights and rights related to them. Finally it stated that Brazil was willing to take an active part in the work of the Committee of Experts with a view to the reinforcement of the measures against counterfeiting and piracy, which were moreover extensively provided for in its national legislation.

9. The Delegation of Portugal said that it supported the work of the Committee of Experts and emphasized its great interest in the work of WIPO with respect to the fight against all forms of violation of intellectual property rights. In that connection, it wished to stress the importance of the documents that had been prepared, especially document C&P/CE/2, the purpose of which was to induce the various governments to enact provisions in their legislation to combat counterfeiting and piracy. While expressing satisfaction with the broadening of the work to cover other fields of intellectual property, it nevertheless considered that the model provisions could be extended to still more fields, notably indications of source and appellations of origin, in view of the scale of the counterfeiting practised in those fields. The Delegation indicated, moreover, that it would be useful if the model provisions were to deal also with the question of appellations of origin that could be violated even when they were used in conjunction with "delocalizing" indications.

10. The Delegation of Hungary noted the extension of the subject matter of the discussion of counterfeiting and piracy to include the appearance and packaging of products and inventions. It stated, however, that it wished to support the Delegation of Portugal in drawing attention to two very important items which it considered were missing from the model provisions in document

C&P/CE/2, namely, appellations of origin and indications of source. It noted that both appellations of origin and indications of source fell within the definition of industrial property in Article 1(2) of the Paris Convention for the Protection of Industrial Property and, on this basis, should be included within the model provisions. It pointed out that there was a difference between trademarks and industrial designs, on the one hand, and geographical indications, on the other hand, in that the former belonged to one owner only, while a number of persons were entitled to use the latter. Nevertheless, it considered that appellations of origin and indications of source were as important as trademarks and industrial designs in the field of intellectual property and in commerce. Accordingly, it would like to support an amendment to Article A of the model provisions in document C&P/CE/2 so that appellations of origin and indications of source would also be covered.

11. The Delegation of Sweden stressed the importance of the questions raised in document C&P/CE/2 and expressed its hope that the model provisions would be one of the remedies which could be used in the fight against counterfeiting and piracy. It looked forward to a constructive result from the deliberations of the Committee of Experts.

12. The Delegation of the Federal Republic of Germany welcomed the continuation of the work of WIPO in suppressing counterfeiting and piracy. The international importance which the problem of counterfeiting and piracy had attained was already evident from the fact that other international organizations had become involved in the question. At a time when the negative effects of counterfeiting and piracy were being felt throughout the world, and when various international organizations were giving attention to this economic crime of new dimensions, it was of crucial importance that WIPO should indicate ways in which counterfeiting and piracy could be effectively suppressed. Up until now, WIPO had followed the route of model provisions. The Delegation of the Federal Republic of Germany saw model provisions as providing an opportunity for creating greater international awareness of the problem of counterfeiting and piracy; of bringing together all necessary measures for the suppression of counterfeiting and piracy; and of giving the member States of WIPO concrete indications of the way in which their national laws could be framed. The model provisions suggested by WIPO should therefore be drafted in such a manner as to meet those requirements. Model provisions did not, however, provide the only solution. If WIPO were to retain its leading role in this field, it would be necessary that it give reflexion to the way in which the principles contained in the model provisions could be effectively introduced into national legal systems. The Delegation of the Federal Republic of Germany considered that the model provisions contained in document C&P/CE/2 were indispensable, but it was open for discussion as to whether those provisions could be considered complete. For example, it would welcome an additional provision directed at enabling an injured party to obtain information on the sources and distribution channels of counterfeit goods and pirated copies. It greatly welcomed the extension of the model provisions to include other intellectual property rights, such as copyright and neighbouring rights and patents. However, this extension, while welcome, had led to complexity in the model provisions which raised a number of

problems. Article A of the model provisions sought to define counterfeiting and piracy and, in so doing, proposed measures which seemed to differ from existing norms of protection, sometimes by going beyond, and sometimes by being narrower than such norms. For example, Article A(1) provided that the preparation of the manufacturing of goods which are later to be unlawfully provided with a trademark already constituted counterfeiting, thus going beyond the provisions of most laws on trademarks, which regarded neither the preparation of the manufacturing of goods, nor the actual manufacturing of the goods as such, as an infringement of a right. The Delegation of the Federal Republic of Germany also pointed out that the definition of counterfeiting in relation to industrial designs was narrower than traditional definitions of infringement. Accordingly, it suggested that consideration should be given as to whether another approach to the question of definition could be adopted. It considered that it would be more profitable and easier to have recourse to well-known and recognized definitions of infringement, such as, for example, those contained in the WIPO model laws with respect to individual titles of protection. To include definitions of infringement which were independent of those contained in these model laws within the work of this Committee of Experts seemed to be too ambitious. The Delegation of the Federal Republic of Germany also pointed out that the problem of combatting counterfeiting and piracy did not lie in the absence of titles of protection, but in the lack of adequate provisions for the defense of such titles. Thus, it was more appropriate to concentrate work on more adequate enforcement measures than on the definition of infringement. In respect of such enforcement measures, it was considered possible to develop differential provisions for different forms of infringement by, for example, more severe punishment for commercial infringement, a separate provision in respect of seizure at borders, and special rules on evidence of infringement. If, however, the Committee of Experts should come to the conclusion that it was appropriate to define infringement in respect of counterfeiting and piracy, the Delegation of the Federal Republic of Germany would not wish to remain apart from such an effort. It must, however, be made clear that such definitions were to be supplemental to existing measures and were developed with the objective of combatting counterfeiting and piracy. The Delegation pointed out also that the work of WIPO would be successful only if the Committee of Experts managed to frame provisions which constituted true models in that they were of a comprehensive and consistent nature, which could be used in practice.

13. The Delegation of China emphasized the serious nature of the problem of counterfeiting and piracy in the world and stated that it supported the consequent need for effective measures to suppress counterfeiting and piracy. It supported the initiative of the model provisions contained in document C&P/CE/2 and drew attention to the existing provisions relating to trademark infringement contained in Article 41 of the new regulations of the Trade Mark Law 1982 of China, which, amongst other things, declared the unauthorized use of marks that were identical or similar to registered trademarks, the unauthorized making or selling of representations of registered trademarks, and causing prejudice to the exclusive right to use a registered trademark, to be acts of infringement and provided for criminal sanctions.

14. The Delegation of the Netherlands fully endorsed the approach of combining counterfeiting and piracy in the model provisions contained in document C&P/CE/2. While it recognized that the model provisions were not binding, it considered that they constituted useful guidelines for national legislation which could contribute to the harmonization of national provisions. It regarded harmonization of national provisions as a very important measure since, without harmonization, it would be difficult to fight counterfeiting and piracy effectively on an international level. The Delegation of the Netherlands emphasized the seriousness with which its Government considered the problem of counterfeiting and piracy, which constituted a threat not only to the owners of intellectual property rights, but also to society. In recognition of the inadequacy of existing measures, its Government had established a working group on the subject. The working group had given priority to copyright piracy in its 1984 report, and had considered the problem of counterfeiting in its 1985 report. A number of proposals had been made in these reports for amending the civil law, in order to provide measures in respect of the seizure of infringing items and the capacity of interested organizations to bring copyright infringement actions, the redrafting of provisions of criminal law, the introduction of more severe penalties and of a provision of criminal law relating to the commercial or professional violation of intellectual property rights. A draft law concerning piracy had been introduced into Parliament, and a draft law on counterfeiting was expected to be introduced soon.

15. The Delegation of the Soviet Union noted with satisfaction the work of WIPO in the area of counterfeiting and piracy, which was important for the protection of consumers. The Delegation explained how the problems of counterfeiting were dealt with in the national law of its country, which included provisions in the Civil and Criminal Codes and in other legislative enactments. The protection of the interests of the consumer and the struggle against counterfeiting were regulated by Government Acts which dealt with the supply of goods of an industrial and commercial nature. The State Inspection for Trade and Quality Control exercised an administrative role. Claims with respect to trademarks were dealt with administratively, but this did not exclude the jurisdiction of the courts, which could give remedies through the Civil Code and Trademark Statute. The illegal infringement of trademark rights could also lead to criminal responsibility, the provisions in this regard being based on a demonstration of a clear violation and guilt. Criminal sanctions included fines, among other things. Presently, new provisions were being drafted with respect to trademarks. The Soviet Delegation also pointed out that interest in this subject, and in WIPO's efforts to produce model provisions, was growing among Soviet specialists, and that these model provisions could be the legal basis to fight against counterfeiting and piracy.

16. The Delegation of the Republic of Korea stated that the model provisions contained in document C&P/CE/2 had significant implications both for the protection of intellectual property rights and international trade. Despite the continuing efforts which were being made to increase protection of intellectual property rights and to fight counterfeiting and piracy, the

Government of the Republic of Korea recognized that counterfeiting and piracy were leading to significant losses to the owners of intellectual property rights and creating significant obstacles to legitimate trade. It considered that the problem arose from, amongst other things, differing national intellectual property rules and principles, and the lack of an international discipline in this area on which national laws could be based. In this connection, it considered that the discussions of this Committee would contribute to the harmonization of national laws and thus to the development of effective enforcement measures. It also considered that WIPO's efforts to prevent counterfeiting and piracy were helpful in producing tangible results. The fight against counterfeiting and piracy involved not only the protection of intellectual property rights, but also broader issues touching on international trade. In this respect, it considered that attention should be directed at ensuring that any actions taken in respect of counterfeiting and piracy did not create new obstacles to international trade and did not discriminate against certain countries. With this in mind, it considered that the Committee's efforts should aim at encouraging the participation of all member States of WIPO in the development of the model provisions. In respect of the model provisions contained in document C&P/CE/2, it stated that the scope of the act of counterfeiting should be limited to appearance-related matters in which the counterfeiting could be easily detected. It also stressed the need to differentiate between counterfeiting and the simple act of infringement, drawing attention to the view that, although all counterfeiting constituted infringement, not all infringement necessarily constituted counterfeiting.

17. The Delegation of Canada stated that the draft model provisions contained in document C&P/CE/2 were broad in scope and were now concerned essentially with enforcement. It supported the broadening of the scope of the provisions and, in this respect, saw the work in WIPO as being complementary to work being carried on in other international fora.

18. The Delegation of Austria expressed its great interest in the area of the suppression of counterfeiting and piracy and stated that it appreciated the enlargement of the scope of the model provisions contained in document C&P/CE/2 beyond trademarks to other intellectual property rights. While it wished to make detailed comments on the specific items in the model provisions later, it drew attention at this stage to the provisions relating to protected inventions in Article A(1)(iv), and stated that it considered that the term "invention" should be understood in the broadest possible sense, so as to cover inventors' certificates, utility models and other similar rights. It also considered that protected architectural plans should be explicitly mentioned, since architectural works not only represented a solution of a technical construction problem, but also constituted aesthetic works. In addition, it considered that intellectual property in respect of integrated circuits rights ought also to be mentioned. In respect of Articles B, C and D of the model provisions contained in document C&P/CE/2, it considered that it should be made quite clear that these measures were complementary. In this respect, it noted that paragraph 39 on page 14 of document C&P/CE/2 (English version) mentioned that the conservatory measures in Article B were

non-exhaustive, whereas no such indication was contained in respect of the measures in Articles C and D. In relation to Article B, it stated that the urgent nature of the measures therein contained should be emphasized. It also considered that it should be taken into account in Article B(2) that not only was the disclosure of the source of counterfeit goods important but also knowledge of the channels of the distribution of such goods, in order to prevent the marketing of such goods.

19. The Delegation of Australia supported the general thrust of the model provisions contained in document C&P/CE/2, but stated that some points required further discussion. It considered that the meaning of the term "counterfeiting" was generally understood, and that there was a risk of losing ground by confusing this meaning through the inclusion of acts of infringement which do not amount to counterfeiting. In this respect, it emphasized the view that, while all counterfeiting constituted infringement, not all infringement necessarily constituted counterfeiting. It considered that this, in turn, meant that all remedies for infringement should apply to counterfeiting but that not all remedies for counterfeiting ought necessarily to apply to infringement. It pointed out that the model provisions, when dealing with remedies, recognized differing degrees of culpability for the range of counterfeiting activities, which suggested to the Delegation that the meaning attributed to counterfeiting was rather artificial. While there was a problem of definition of counterfeiting, it considered that it should be made clear that innocent, unintentional infringement was not counterfeiting. Rather, it considered that counterfeiting involved a deliberate act by the infringer. It was of the view that the model provisions expanded the meaning of counterfeiting to such an extent that, if they were adopted, counterfeiting would encroach upon areas traditionally considered only as ordinary infringement. While the term "counterfeiting" was not used in Australian industrial property law, the Australian Trade Marks Act 1955 provided a range of remedies, including both civil and criminal remedies, for trademark infringement, which could be applied to the circumstances of a particular case. This approach had the advantage of flexibility, and the Delegation favored similar flexibility in the model provisions. It also noted that the inclusion of the embodying of the subject matter of a patent in a product within the meaning of counterfeiting also seemed to encroach on the area reserved for infringement as it was not understood how an invention could be counterfeited. It also expressed reservations concerning the use of the expression "protected industrial property right," noting that if "protected" referred merely to registered or granted, this could lead to inequitable results if no reference were made to validity. It stated that, if other delegations shared the concerns which it had expressed, it might be preferable to proceed first with the finalization of model provisions with respect to the counterfeiting of trademarks, since much work had already been done in this area, and then to proceed to other intellectual property rights. It might also be possible to finalize model provisions relating to piracy of works protected by copyright, since it considered that the meaning of the term "piracy" was clearly understood as the unauthorized copying of materials protected by copyright on a commercial scale, and subsequent unauthorized dealing in those materials. It sought a positive outcome from the

deliberations of the Committee, but not at the cost of measures of which the implications had not been fully explored.

20. The Delegation of Spain stated that it considered that the harmonization of national provisions dealing with counterfeiting and piracy should be as complete as possible. It considered that the model provisions contained in document C&P/CE/2 should cover all types of intellectual property dealt with in the international conventions on intellectual property. An example of this complete regulation was given by the inclusion in Article A(1)(iii) of the imitation of packaging, even if the packaging was not protected as a trademark, an industrial design or by copyright. For this reason, it stated that the model provisions should recognize geographical indications, namely, appellations of origin and indications of source, which were protected under the Paris Convention for the Protection of Industrial Property.

21. The Delegation of Japan stated that the discussions in WIPO on strengthening the protection of intellectual property were very important and timely. It noted the aims of the model provisions contained in document C&P/CE/2, set out in paragraph 4 of that document, namely, to create awareness of the need to combat counterfeiting and piracy, and to create texts which would be useful to those preparing national laws in the area. In respect of these aims, the Delegation was principally in agreement. It also noted that the model provisions were not intended to be compulsory, but rather of an advisory nature, and that the question of counterfeiting and piracy was also being discussed in other fora. It stated that the Government of Japan was actively engaged in the fight against counterfeiting and piracy.

22. The Delegation of Switzerland mentioned that it had already pointed to the importance that it attached to the fight against counterfeiting at the previous session of the Committee, and once again declared its interest in finding effective ways in which to combat counterfeiting and piracy. It also mentioned that it had already stressed the necessity of not confining the measures to marks, and was pleased to observe that the International Bureau's drafts had evolved in that direction and had thereby given the work of the Committee a new dimension.

23. The Delegation of France declared itself sympathetic with the point of view expressed by the Delegation of the Federal Republic of Germany. It said that it was wondering not about the ultimate purpose of the work in progress--as it was unnecessary to say how interested its country was in the fight against counterfeiting and piracy--but rather whether provisions of a general character contemplated for counterfeiting could apply as they stood to situations arising in connection with different types of rights. With that in mind, there was reason to wonder whether the concept of counterfeiting should not be reserved for the violation of industrial property rights, while situations giving rise to parasitic practices against which sanctions were based on other principles, particularly those concerning unfair competition, should be dealt with separately. The Delegation further declared itself in favor of the inclusion of appellations of origin in the model provisions.

24. The Delegation of Brazil took the floor again, wishing to make it clear that the purpose of the model provisions to be adopted was to offer governments suggestions regarding the enactment of certain legal provisions, but that they were not intended to be substituted for national legislation; due account had indeed to be taken of the individual characteristics of each national system. It also had to be realized that the model provisions could not form a legal basis for inter-State relations, as those relations were already governed by the Paris Convention.

25. The Delegation of Israel stated that, while the definition of counterfeiting and piracy needed to be considered, more emphasis should be placed in the model provisions on the question of enforcement, and on the provisions which applied to enforcement. In particular, emphasis should be placed on the necessity for criminal sanctions against counterfeiting and piracy. It pointed out that, in the law of its country, the offenses of counterfeiting and piracy had now been classified as felony crimes and carried penalties up to one million dollars in the case of piracy of television broadcasts. It emphasized the need for such strong penalties for intellectual property offenses, as well as the necessity to provide adequate civil remedies.

26. The Representative of the Committee Against Counterfeiting (COLC International), after having thanked the Director General for the invitation extended to his organization, which was a newcomer to the area and had only been created in its present form on March 8, 1988, indicated that the organization's objectives included that of representing the producers of goods and services in dealings with international bodies such as WIPO, GATT, the OECD, the CCC and the EEC. He mentioned that counterfeiting was harmful not only to the interests of enterprises and the national economy, but also to the public at large, which could be misled as to the origin of goods and whose safety could even be put at risk. He also stressed that counterfeiting was a plague that affected not only industrialized countries, owing to the financial damage that it caused them, but also developing countries which, when they failed to afford sufficient protection to industrial property rights, were liable to see foreign investment being diverted away from them. Referring to the fact that the problem of counterfeiting was an international phenomenon, and that the solution to it should be looked for at the international level, the representative of COLC International expressed the wish that remedies be provided for the legislative and procedural inadequacies that still persisted in a number of countries, and welcomed the International Bureau's proposal to broaden the field covered by the model provisions as much as possible.

27. The Representative of the United Nations Educational, Scientific and Cultural Organization (UNESCO) mentioned that his Organization was itself involved in the fight against piracy, and that it could not but welcome any action that might serve to block the spread of a contemporary disease. Counterfeiting and piracy, by making use of new technology, imperilled not only the economic balance of enterprises, but also, which was perhaps still more serious, threatened to dry up the sources of creativeness by violating the rights of authors, creators and inventors.

28. The Representative of the Commission of the European Communities (CEC), pointing to the growing prevalence of the counterfeiting of intellectual property rights, emphasized that technological progress had created the means whereby other people's rights could be inexpensively appropriated, and that certain intellectual property rights, which paradoxically had come into being for the purpose of protecting innovation, ran the risk of being endangered by innovation itself. She therefore declared herself in favor of the extension of the work in progress to fields other than the trademark field. She mentioned the steps that had been taken within the Community, especially the Community Regulation of December 1, 1986, designed to prevent the release of counterfeit goods for free circulation within the Community. With regard to copyright, she stated that the Commission was engaged in a process of reflection, which focused on four main conditions to which the repression of piracy should be subject: clear legislation affording adequate protection, procedures whereby action might be taken quickly and effectively, appropriate sanctions and compensatory measures and, finally, a coordinated effort by the parties concerned and the competent authorities to ensure the application of the law. Expressing satisfaction with the action taken by WIPO in its area of concern, the Representative of the CEC emphasized finally that efforts would have to be made to ensure the proper application of national laws, and that international cooperation was therefore necessary. In that connection she declared that the Commission was supporting efforts undertaken in other fora, notably within GATT.

29. The Representative of the Customs Cooperation Council (CCC) mentioned that the drafting work being done by his organization on model legislation designed to confer prerogatives on the customs that would ensure the implementation of trademark and copyright legislation was now complete, and was due to be officially approved in the coming month of June by the Customs Cooperation Council. The text of the model legislation had been made available to the delegates by the WIPO Secretariat.

30. The Representative of the International Chamber of Commerce (ICC) expressed the full support of the ICC for the work of WIPO aimed at achieving increased protection against counterfeiting and piracy, and particularly the work entrusted to the Committee of Experts to draw up model provisions for national laws to fight counterfeiting and piracy. The Representative outlined the efforts of the ICC to combat counterfeiting and piracy, which included active contribution to the work of the Customs Cooperation Council (CCC), the presentation of the views of its business members at the time of the formulation of the anti-counterfeiting regulation of the European Community and the organization of international symposia on counterfeiting. She drew attention to the magnitude of the problem of counterfeiting and piracy, which was reflected in the fact that counterfeit goods presently accounted for four to five percent of world trade, and to the dangers arising out of substandard counterfeit products being mistakenly accepted by consumers as the products of reputable manufacturers with high standards of quality control. She underlined the need of strong and effective enforcement of intellectual property rights, and referred to a statement issued by the ICC on trade-related aspects of intellectual property rights in connection with the

on-going negotiations in the Uruguay Round of multilateral trade negotiations. She further drew attention to the International Counterfeiting Bureau, a specialized division of ICC, which had been established in 1985. The Bureau's membership now numbered some 60 companies and trade organizations throughout the world. In 1987 the Bureau had carried out, with success, major investigations into commercial counterfeiting in more than 15 countries. These investigations had dealt with counterfeit goods as diverse as aircraft engine cleaning fluid, alcoholic beverages, engine turbochargers, gaskets and valves, children's toys and clothing fabrics.

31. The Representative of the International Confederation of Societies of Authors and Composers (CISAC) said that authors were very aware of the efforts that had been made by WIPO since 1981 in the search for adequate solutions in the fight against piracy and counterfeiting. By grouping both concepts in one document, WIPO had acknowledged that the action to be taken was practically the same in both cases. The Representative of CISAC considered, however, that it would be preferable to adopt principles rather than model provisions, as they would be more flexible. He pointed out finally that the determining factor in counterfeiting and piracy was good faith, and that it would have been desirable for the document to deal with that factor in depth and consider the possibility of reversing the burden of proof.

32. The Representative of the International Federation of Associations of Film Distributors (FIAD) mentioned that piracy constituted an infringement not only of the right of reproduction but also of the right of public performance, it being possible to commit violations of the latter right by using cassettes lawfully purchased or rented but intended solely for private use. Such unlawful performances were multiplying in locations open to the public other than cinemas (cafés, restaurants, discothèques), on public transport (boats, tourist coaches), in the corporate sector (performances organized by associations, enterprises or administrations), on private cable networks (entire districts, new towns connected to a control center, cable-equipped hotels) and on public cable networks that transmitted television broadcasts to their paying subscribers. Cable radio operators also engaged in the dissemination of works without the consent of the copyright owners. He further pointed out that, in such cases, there might be infringement not only of the author's economic rights but also of his moral rights, notably where the performances took place against the background noise of a café or in the atmosphere of a discothèque, as certain operators cut out the soundtrack of the film to prevent it from interfering with the dance music. If one were to reserve the term piracy for violations of the right of reproduction alone, violations of the right of public performance would be in danger of not being defined and punished as they should be in new copyright legislation, whereupon the spread of unlawful performances would be liable to result in the disappearance of all cinematographic creativeness.

33. The Representative of the European Association of Industries of Branded Products (AIM) noted that in 1982 AIM had established a Committee to deal specifically with counterfeiting covering industries from 11 countries. He stated that the fundamental question which required discussion in respect of

the model provisions was a distinction between counterfeiting, on the one hand, and infringement, on the other. He emphasized that counterfeiting was not to be considered as a synonym for infringement, since all counterfeiting constituted infringement, but not all infringement necessarily involved counterfeiting. In his view, counterfeiting involved false reproduction, the term having been borrowed from the criminal law of currencies where a counterfeit note referred to a forged note. It was not necessary to refer to intellectual property law to know that counterfeiting and piracy were wrong, but intellectual property law was needed to provide the weapons to fight the problem. He stated that there were clear practical reasons for distinguishing between counterfeiting and infringement, since counterfeiters operated in ways which were typically criminal, whereas infringers did not behave in this way. The same considerations applied to copyright pirates, and he welcomed the inclusion in the model provisions of measures directed at suppressing piracy. He considered, however, that strong measures should be reserved for cases which merited them, and that if the model provisions were cast too broadly, there was a danger that their impact would be dissipated. For this reason, he suggested that the work previously done on counterfeiting of trademarks should first be concluded, followed by work on model provisions relating to piracy, and that, then, other areas of enforcement should be addressed. He referred, as models for this, to the Trademark Counterfeiting Act 1984 of the United States of America, imposing severe criminal penalties, to the current Bill (the Copyright Designs and Patents Bill (clause 279), of the United Kingdom, introducing a criminal offence of trademark counterfeiting punishable with 10 years imprisonment, and the Israeli law (mentioned by the Israeli Delegate), making counterfeiting and piracy felonies, punishable with a fine of one million dollars.

34. The Representative of the International Federation of Film Producers Associations (FIAPF), while emphasizing the quality of the texts proposed, at the same time expressed the wish that the problems of infringement of the right of performance and broadcasting might be dealt with.

35. The Representative of the International Publishers Association (IPA), while stating that he approved of the work that had been done, said that from his point of view the discussion should not be confined to the subject matters protected by the Paris and Berne Conventions. For instance, the Committee of Experts should consider other types of creation, such as computer software and integrated circuits. With regard to the requirement that the acts in question be perpetrated on a commercial scale, which featured in the draft, the Representative of the IPA was of the opinion that acts of piracy might exist that were not perpetrated on such a scale, or were not engaged in for profit-making purposes, and that there was the possibility of a prejudice existing, for instance, where private copies were made in large numbers.

36. The Representative of the International Federation of Phonogram and Videogram Producers (IFPI) stated that IFPI welcomed the extension of WIPO's work to include piracy. She stated that piracy of phonograms continued to be a great problem to the interests of legitimate industry, to consumers, because of the low quality of many pirated copies, and to national culture, since in

many countries piracy had destroyed a legitimate industry to the detriment of national authors and performers. The size of the pirate market worldwide in terms of retail sales was at least one billion dollars per annum, and IFPI devoted the major part of its resources to the fight against piracy. The Representative of IFPI wished to express three general concerns regarding the model provisions. First, she considered that the definition of piracy should not be restricted to the serious infringements of the right of reproduction but should be extended to infringements of the rights of communication to the public and of the rights of broadcasting. Secondly, she expressed concern about the proviso to the definition of both counterfeiting and piracy that the relevant activity must be carried out on a commercial scale. IFPI considered that this introduced a new notion which was different from the definition of piracy contained in many national laws and in the Phonograms Convention, where piracy was constituted by the unauthorized reproduction of copies for commercial gain. She pointed out that disputes might arise as to how many copies constituted manufacture or reproduction on a commercial scale. Accordingly, IFPI preferred the use of the expression "for direct or indirect financial gain or advantage." Thirdly, she endorsed the caution which had been expressed about the dilution of the concepts of counterfeiting and piracy. She stated that, if loose wording introduced harsh penalties for simple, inadvertent and innocent acts, there may be a risk that public sympathy would be lost. At the moment, she considered that the public recognized that piracy was a black and white moral issue. The dilution of the meaning of the word "piracy" might also involve the risk that the model provisions might be considered inappropriate for adoption by national authorities.

37. The Representative of the International League for Competition Law (LIDC) declared himself content with the documents that had been drawn up, and indicated that his organization was always prepared to take part in the work of WIPO. He was pleased to note that the WIPO draft was not confined to the distinctive signs on goods, especially trademarks, which conformed to the resolution adopted by the International League for Competition Law at its Lucerne Congress in September 1986. The Representative of the League did however wish to see some consideration given, in the model provisions, to such matters as the right of performance, integrated circuits and geographical indications that were misleading for the consumer.

III. DISCUSSION OF SPECIFIC ISSUES

General

38. After the general discussion, the Committee of Experts considered the specific issues dealt with in document C&P/CE/2 (Model Provisions for National Laws).

[From here onwards, as is customary in summary reports, the speakers are identified only exceptionally].

Article A(1)

39. One delegation proposed that subparagraph (i) of this paragraph cover not only the case of trademarks but also that of indications of source and appellations of origin, and that the use of such indications or appellations be considered an act of counterfeiting even where they were accompanied by a delocalizing term. A number of other delegations also considered that the question of indications of source and appellations of origin should be dealt with by the model provisions. Those delegations considered, however, that the drafting submitted by the delegation that made the proposal was not adequate, and that paragraph (1)(i) was perhaps not the proper place for dealing with the question, which in various respects could not be assimilated to the case of trademarks. In that connection, the Secretariat pointed out, by way of example, that the matter of delocalizing terms was characteristic of appellations of origin, and that it could not, in principle, relate to trademarks. Another delegation drew attention to the fact that appellations of origin, unlike marks, had authorized users but not owners, and that the case of the authorization of the owner provided for at the end of paragraph (1) was not applicable to them.

40. In reply to a question from a delegation that raised the problem of appellations of origin that had become generic, it was mentioned that the model provisions were not a treaty intended to be substituted for national legislation, and that it was for the national authorities to decide whether or not a term was generic. It was also pointed out by the Secretariat that the same was true of signs that could constitute trademarks, which might vary according to the various national laws.

41. Some delegations considered that the provision according to which there was counterfeiting "even where the goods are of a different kind" (eighth and ninth lines of paragraph (1)(i)) was too broad and that, if its purpose was to cover the case of marks of high reputation, it would be better to refer expressly to such marks.

42. Another delegation considered that it was not appropriate, in the case considered in the last part of paragraph (1)(i), to require the existence of a danger of confusion. In the opinion of that delegation, there was always counterfeiting in the case considered, even where the counterfeit mark was accompanied by an expression that revealed the true origin of the product.

43. With regard to Article A(1)(ii), one delegation proposed that the wording of that provision be amended by substitution of the words "that incorporate" for the words "that bear, or are accompanied by."

44. In reply to a question from a delegation on the subject of Article A(1)(iii), the Director General explained that the protection of the appearance of the product was a new concept that it was necessary to take into account, in view of the fact that the existing categories of intellectual property rights did not permit all cases to be covered.

45. A number of delegations and representatives of non-governmental organizations declared themselves in favor of the adoption of a provision such as that appearing in Article A(1)(iii), since the protection of the appearance of the product was necessary to combat all forms of counterfeiting. Some delegations were, however, of the opinion that the case considered did not constitute an act of counterfeiting in the strict sense, and that it should be included in a special provision that grouped all the cases in which there were no protected rights. It was mentioned in that connection that there were a number of countries in which such cases could be covered by unfair competition law, which consequently required the existence of misconduct on the part of the perpetrator of the act, which in turn would establish his liability.
46. Other delegations considered it premature to introduce a provision such as that proposed in paragraph (1)(iii), and that there were not yet enough elements to define the new concept. Those delegations considered that the paragraph was drafted in too broad terms; for instance, misgivings were expressed regarding the fact that a right could be created by the sole fact of the appearance of a product being known in commerce, and that there were not enough elements available for the definition of the new concept.
47. It was emphasized in that connection that it was a question above all of agreeing on the principle and of establishing whether there was a desire to go beyond the recognized categories of industrial property. It would be unfair not to regard as coming under the heading of counterfeiting those cases that were not covered by industrial property rights, and so it would be necessary to consider the question of the element of intent in greater depth.
48. Some delegations also asked for explanations on points of terminology, while two delegations, supported by others, asked for amendments to be made to paragraph (1)(iii).
49. One delegation asked that the proviso at the beginning of the subparagraph ("even if not protected as a trademark, an industrial design or by copyright") be placed at the end of that subparagraph. In support of the request it was mentioned that the proviso was intended to apply not to the appearance or packaging of the counterfeiter's goods, but to the appearance or packaging of the goods that had been counterfeited.
50. Another delegation pointed out that, if paragraph (1)(iii) was retained, its wording should be aligned on that of paragraph (1)(i) and (ii), particularly with respect to the use of the expression "a reproduction or a slavish or near-slavish imitation."
51. Paragraph (1)(iv) gave rise to a protracted discussion on the question of whether it was appropriate to deal with the case of inventions in the context of model provisions on counterfeiting. It was pointed out in that connection that there was a difference between the infringement of a patent and the problem of counterfeiting as contemplated in the model provisions, and that one could not envisage the counterfeiting of patents in the same sense as that in which the term was used in the provisions; for instance, a patent could be

infringed (for which the French term was also "contrefait") where the appearance of the product to which the infringing patent related was completely different. In that particular case, therefore, it was not a question of comparing goods.

52. A number of delegations and representatives of non-governmental organizations declared themselves in favor, for the reasons given, of the deletion of paragraph (1)(iv) and of any reference to protected inventions.

53. However, several other delegations and representatives of non-governmental organizations declared themselves in favor of the retention of paragraph (1)(iv), and pointed out in particular that the model provisions merely offered solutions, and that each country was free to accept them or not. One of the delegations asked for confirmation to be given that the term "protected invention" covered not only the case of inventions protected by patents but also that of inventions protected by inventors' certificates; it also asked for paragraph (1)(iv) to be completed with the words "or protected plant variety." That request was supported by another delegation, which asked for account to be taken also of the case of the topographies of semiconductors, and by the representative of one non-governmental organization. One delegation on the other hand declared its opposition to the inclusion of protected plant varieties, considering that any enumeration would be bound to be incomplete, and that it was preferable to retain solely the general term "protected invention."

54. Another delegation proposed that the word "embody" in paragraph (1)(iv) be preceded by the words "wholly or partly."

55. The Chairman concluded by noting that a majority had emerged in favor of the retention of paragraph (1)(iv), and that each country would naturally be free to draw inspiration from the provision or to ignore it.

56. With regard to the last part of Article A(1), there was some discussion as to whether or not the definition of counterfeiting should embody the condition that the goods be manufactured on a commercial scale.

57. One delegation pointed out that the condition certainly raised a number of questions. Should one therefore deduce that all activities of a craft nature were excluded from the purview of counterfeiting? The same delegation also pointed out that, if the quantity produced really had to be taken into consideration, the same quantity did not have the same meaning depending on the type of activity contemplated.

58. One delegation expressed the opinion that the concept of commercial scale should be interpreted in a broad sense, and that occasional acts, such as the distribution free of charge and the putting into circulation of small quantities of counterfeit goods, also constituted counterfeiting. The same opinion was held by other delegations and representatives of non-governmental organizations.

59. Several delegations were of the opinion that the expression "on a commercial scale" should be replaced with "for commercial purposes."
60. However, one delegation pointed out that the criminal law of its country did not allow it to subscribe to that proposal, as it did not recognize purposes of an act as being capable of constituting an offense, and that under such circumstances it was preferable to say nothing at all.
61. The representative of a non-governmental organization pointed out on the other hand that, in the great majority of national laws, the expression "for commercial purposes" was the most widely used.
62. One delegation, for its part, considered that there could be counterfeiting even where the manufacture was not on a commercial scale and even if there was no direct financial gain.
63. One delegation, supported by several other delegations, proposed that counterfeiting should not presuppose production on a commercial scale, but rather that it be made subject to the existence of direct or indirect commercial advantages or for a personal financial gain.
64. The Secretariat pointed out that the question under discussion was the crucial point in the Article concerned, that the concept of "commercial scale" was an objective criterion, whereas intent, on the contrary, was a subjective criterion that was difficult to evaluate, and that reference to financial gain did not seem very appropriate. In any event, what was necessary was that one find a criterion whereby the difference could be established between a mere violation of industrial property rights on the one hand and counterfeiting on the other.
65. The Chairman concluded the discussions on this question by pointing out that they had revealed a certain tendency to prefer a wording somewhat different from that proposed in the draft, and that all the observations that had been made would be taken into consideration when a new version of the model provisions and of the accompanying observations was drafted.
66. With regard to the provision according to which the existence of an act of counterfeiting was subject to the fact of the goods being manufactured without the authorization of the owner, one delegation wondered in what country the authorization concerned had to have been given, and whether one should consider it to be the country in which the act had been committed.
67. In that connection one delegation mentioned that, in terms of its national legislation, there was no unlawful use where there was authorization.
68. Another delegation expressed the fear that the last sentence of Article A(1), which provides that in certain cases a licensee may grant the authorization, might have the effect of authorizing parallel imports. That delegation consequently expressed the wish that all reference to licenses be omitted.

69. At the end of the discussions, the Secretariat stated that it considered not to retain the last sentences of Article A(1), (3)(a) and (3)(b) and that it would explain its reasons in the observations. It further stated that the model provisions had no effect on parallel imports and that it was up to each country to decide how to treat parallel imports.

Article A(2)

70. Some delegations and representatives of observer organizations proposed that, in the opening lines of Article A(2), the word "manufacturing" should be replaced by the word "reproduction" and/or "duplication," because the latter words corresponded better to the terminology of copyright and so-called neighboring rights. One delegation, however, was in favor of retaining the word "manufacturing" which, in its view, was a correct expression in the context of the definition of piracy.

71. One delegation suggested that architectural plans should be mentioned separately in Article A(2). Another delegation proposed the same in respect of protected works fixed on sound and visual supports and, still another delegation, in respect of photographs. In answer to those proposals, it was stated that all those productions were covered by the definition of literary and artistic works under the Berne Convention and, consequently, were covered by point (i) of Article A(2).

72. Some delegations proposed that computer programs should be considered to be covered by Article A(2) as a category of literary and artistic works and that this should be made clear, at least, in the comments to the article.

73. Another delegation expressed the view that it would be premature to include any such statements in the model provisions or in the comments because the question of the appropriate kind of protection for computer programs had not been answered definitely at the international level and the final results of the discussions on the protection of integrated circuits would also have to be taken into account.

74. One delegation informed the Committee that, in its country, phonograms were considered to be the results of creative efforts and, therefore, were protected as works by the Copyright Act.

75. Another delegation suggested that the list contained in Article A(2) should be presented without being divided into four points; thus, the repetition of the word "protected" could be avoided.

76. Several comments were made concerning the notion of manufacture on a "commercial scale" as one of the elements of the definition of piracy. Some delegations and representatives of observer organizations were in favor of retaining that element, while other delegations and representatives of observer organizations suggested that it should be replaced by a condition according to which manufacturing (or reproduction or duplication) should be

made for commercial purposes or, according to a more detailed proposal, for indirect or direct commercial or financial advantages.

77. Finally, one delegation proposed that unauthorized manufacturing of copies should be considered piracy whether it was done on a commercial scale or for commercial purposes. Several delegations and representatives of observer organizations supported this proposal.

78. Several delegations and representatives of observer organizations were in favor of an extensive interpretation of "commercial scale" and/or "commercial purposes." Some of them stressed that the avoidance of the obligation of payment should also be considered a commercial or financial advantage.

79. One delegation added that not only commercial or financial advantages, but also other advantages, should be recognized as a significant condition.

80. Representatives of some international non-governmental organizations expressed the view that, although isolated personal and private copying might not have to be qualified as piracy, widespread internal copying (for example, in public institutions or private companies) should be covered by the definition of piracy.

81. Several other delegations and representatives of observer organizations stressed that the definition of piracy should be restricted to the most serious infringements and, thus, any excessive interpretation of "commercial scale" and/or "commercial purposes" should be avoided.

82. One delegation underlined that not only the interests of the owners of rights but also public interests should be taken into account when defining piracy. The delegation added that, in that respect, the special interests of developing countries should also be considered.

83. Some delegations and representatives of several international non-governmental organizations suggested that the definition of piracy should not be restricted to the most serious infringements of the right of reproduction but be extended to such infringements of the right of broadcasting, the right of communication to the public and the right of public performance. In this connection, reference was made to certain types of infringements--such as, the unauthorized interception and distribution of programs transmitted by satellites, the widespread distribution and use of unauthorized decoders for the reception of encrypted programs, the unauthorized use of works in cable-originated programs, the unauthorized public performance of works included in videocassettes--which were considered serious enough to be covered by the definition of piracy.

84. The Director General stated that, in view of the general wish that the next draft should also deal with piracy in case of broadcasting and other public communications, the Secretariat would prepare draft provisions to that effect.

Article A(3)

85. With regard to the additional acts of counterfeiting and piracy, which are listed in paragraph (3)(a), one delegation asked whether one should not introduce the concept of intent, and lay down the principle according to which the acts concerned could not constitute acts of counterfeiting or piracy unless they were committed deliberately.

86. One delegation considered that such other acts should be limited and that no account should be taken of them unless there was violation of a right, whereas another delegation wished to have broadcasting, reproduction and performance without the authorization of the owners of rights included among those acts.

87. The question of transit gave rise to a long exchange. Some delegations were of the opinion that it was preferable to delete any reference to transit. They pointed to the fact that goods that could not be regarded as counterfeit goods, either in the exporting country or in the importing country, might, according to the proposed provision, give rise in the country of transit to measures that were directed against counterfeit goods if the conditions for them to be considered such were fulfilled in that country.

88. It was considered, moreover, that it was going too far to involve transport firms in matters of counterfeiting, whereas one delegation pointed out that its criminal code provided for a presumption of bad faith on the part of the transporter of counterfeit goods.

89. Another delegation recalled that it had already laid emphasis at the previous year's session on the practical difficulties associated with controlling the transit of counterfeit goods.

90. It was indicated that the model law being drawn up by the Customs Cooperation Council did not deal expressly with the problem of transit, but that the experts regarded the provisions of that law as referring to transit by implication.

91. Other delegations, supported by the representatives of several non-governmental organizations, spoke in favor of retaining the reference to transit, which could provide the possibility of taking action in a country of transit against goods that were not considered counterfeit goods either in the country in which they had been manufactured or in the country to which they were being exported.

92. The Director General stated that the next draft, if there was one, would probably make it clear that seizure and possible other conservatory measures could be applied not only in the country in which the counterfeit goods or pirate copies had been manufactured or were being sold or otherwise exploited, but also in the country in which those goods were in transit, provided that, under the laws of the latter country, the goods would have been considered counterfeit or the copies would have been considered pirate copies had they

been manufactured there (namely, in the country of transit). The person responsible for the transit would have to submit to such conservatory measures even if he did not know or would have no reason to know that the goods were counterfeit or the copies pirate copies; on the other hand, he would be liable for damages or to penalties only if he knew or should have known that the goods were counterfeit or the copies pirate copies.

93. With regard to Article A(3)(b), one delegation was of the opinion that the paragraph should cover not only the case of the affixing of a sign on goods or on their packaging, but also the case of the manufacture of the sign and of the packaging. That opinion was shared by the representative of one non-governmental organization, who wished to draw attention to the fact that the manufacture of a set of labels was in itself an act of counterfeiting, as labels could be sold individually. Another delegation also supported that view, but pointed out at the same time that one could regard the expression "any preparatory step towards such affixing" as including the manufacture of the sign and the packaging. In that connection it was noted that the manufacture of the packaging corresponded exactly to the expression "preparation of the packaging" which appeared in paragraph (3)(a)(i).

94. Some delegations wondered why the condition that the act be committed on a commercial scale, which appeared in the previous paragraphs, did not appear in paragraph (3)(b). The Secretariat replied that the affixing was unlikely to be done in any connection other than a commercial one, but that one could naturally consider introducing the commercial scale concept, which incidentally was a controversial point, in that paragraph also.

95. It was discussed whether, in the case contemplated in paragraph (3)(b), there existed an act of counterfeiting regardless of the goods on which the affixing of the sign occurred.

96. One delegation stated its opinion that identical or similar goods had to be involved; other delegations on the other hand considered that, in the case in point, protection should exist irrespective of the nature of the product.

97. It was pointed out that the principle of protection for identical or similar goods was correct, but that it was necessary to set aside the case of marks of high reputation. In that connection one delegation pointed out that the text of paragraph (3)(b) should therefore be brought into line with that of the last five lines of paragraph (1)(i).

Article B

98. A number of delegations underlined the essential importance of the conservatory measures provided for in Article B. It was pointed out that these measures were indispensable in order to effectively suppress acts of counterfeiting and piracy.

99. Several delegations sought clarification on whether the conservatory measures contained in Article B were intended to be available in both civil and criminal proceedings. It was pointed out that the wording of some of the provisions of Article B would be inappropriate under the criminal law and procedure of certain countries; for example, the criminal procedure of certain national legal systems would only permit the use of conservatory measures in respect of crimes that had actually been committed, and not in respect of imminent criminal action. In certain legal systems, it would also be difficult to secure the sealing of premises (Article B(2)(ii)) in respect of criminal actions. In some countries there was also a privilege against self-incrimination which would render it difficult to enforce an order to secure evidence against an accused person (Article B(1)(a)(ii)). Likewise, it might be inappropriate to use the word "suspects" in respect of a court in a criminal proceeding (Article B(1)(a)), since a court acted on the basis of prima facie evidence, and it was the prosecuting party who suspected.

100. A number of delegations stated that some difficulties arose with respect to Article B as a result of the attempt to include in it provisions covering differing sorts of administrative and legal proceedings, such as civil actions, criminal prosecutions, and customs and other administrative proceedings. One delegation pointed out that this raised the fundamental question of what was sought to be achieved in Article B. On the one hand, the attempt to cover differing sorts of legal and administrative proceedings had the advantage of flexibility. On the other hand, this flexibility was gained at the expense of ambiguity in the interpretation of some of the provisions. Another delegation stated that Article B should be considered as listing all appropriate conservatory measures which should be available in the fight against counterfeiting and piracy, and that the distribution of responsibilities for making orders with respect to, or taking, the measures in question between various agencies and organs of the State was best left for each State to decide.

101. One delegation and several representatives expressed the desire to have included in Article B a provision to safeguard the interests of an accused or a defendant, since the measures contained in Article B were properly harsh and effective but might implicate an innocent accused or defendant. It was pointed out that some measures directed at providing a balance in favor of an accused or a defendant were already contained in Article B(5), (6) and (8) and that further measures in this direction could be mentioned in a revised draft or in the relevant notes.

102. One delegation also stated that it was necessary to include a provision in Article B to ensure that the conservatory measures contained therein could not be used to block or obstruct international trade.

103. In respect of Article B(1)(a), several delegations and representatives of observer organizations sought clarification as to the meaning of the expression "the natural person or legal entity" who was entitled to request conservatory measures. In particular, it was pointed out that licensees, assignees, successors-in-title, associations of consumers, societies of

authors, and so forth, all had legitimate reason to be included as parties entitled to request conservatory measures. It was stated that all those who drew their title legitimately from the original owner of the industrial property right in question, or who received the authority to represent such owner, were intended to be included within the expression "the natural person or legal entity claiming to be injured or to be threatened to be injured." However, it was not intended that this expression should extend to entitle a single consumer to request conservatory measures.

104. One delegation pointed out that the wording of Article B(1)(a) obligated a court to order or take the measures in question in certain circumstances, and that such an obligation on the part of a court was not in accordance with its national law, according to which such measures were left to the discretion of the court.

105. One representative suggested that the word "immediately" should be inserted in the opening paragraph of Article B(1)(a) before the words "order or take the measures" to emphasize the urgency with which conservatory measures needed to be taken.

106. One representative stated that a provision should be added in respect of Article B(1)(a)(ii) to indicate that evidence secured as a result of conservatory measures should be able to be exchanged with the appropriate authorities in another country in order to enable the injured party to effectively suppress the act of counterfeiting and piracy in question, since counterfeiting and piracy was often organized on an international basis. The same applied to the exchange of information among various authorities of a given country.

107. In respect of Article B(1)(b), a number of delegations drew attention to the impossibility in the national laws of their countries for a court to order or take measures ex officio in civil proceedings.

108. In respect of Article B(1)(c), a number of delegations and representatives stated that the word "court" should be replaced by the words "competent authority." In this respect, it was pointed out that the requirement of court authorization or ratification may, in many cases, be unnecessary, since the nature of the case may be such that an administrative agency would be empowered to grant the requisite authority or ratification.

109. Several delegations and representatives were in favor of removing the alternative of prior authorization by the court or competent authority for a law enforcement authority to take the conservatory measures referred to in Article B(1)(a). In this regard, it was pointed out that the requirement of prior authorization might delay the taking of effective action, and that the need for rapid measures was paramount to effectively fight counterfeiting and piracy.

110. It was also suggested by some delegations that, in addition to the removal of the requirement of prior authorization, there may be no need for

subsequent ratification by a court. Rather, the interests of an accused or a defendant could be adequately safeguarded by the provision of a right of appeal.

111. In respect of Article B(2), one delegation stated that it should be made clear that the measures contained in this paragraph applied to goods or other relevant items in transit. Another delegation recalled its reservation with respect to the inclusion of the act of transit.

112. One representative suggested that a new subparagraph should be added to permit as a conservatory measure an order freezing the bank accounts and assets of the defendant within the jurisdiction in order to ensure that an eventual remedy in damages was not frustrated.

113. In respect of Article B(2)(i) one delegation emphasized the importance of seizure, stating that over 50% of all anti-counterfeiting and anti-piracy operations conducted in its country were solved by seizure. After the counterfeit goods or pirate copies had been seized, experience had shown that the parties to the dispute normally arrived at some understanding, without the necessity of further action.

114. It was pointed out by one delegation that the seizure of goods required court approval in the national laws of some countries.

115. It was suggested by the representative of an observer organization that forged labels and packaging ought also to be subject to seizure.

116. In respect of Article B(2)(ii), it was pointed out by one delegation that the provision should extend to the sealing of premises where goods or copies were sold, as well as to premises where goods or copies were being offered for sale.

117. One delegation stated that paragraph (2)(ii), as presently worded, was too harsh, and that the alternative of the sealing of part of the relevant premises should be provided, as well as the possibility of removing infringing goods or copies to a bonded storehouse.

118. In respect of Article B(2)(iii) one delegation and a number of representatives stated that the concept of "tools" should be enlarged to include all electronic, mechanical and other materials used to manufacture, produce, assemble or package goods or copies suspected of being counterfeit or pirate, so as to cover all of the stages involved in the acts of counterfeiting and piracy.

119. One delegation expressed concern at the seizure of tools which could be put to a legitimate use, and suggested that seizure should only apply to tools which had been specifically adapted for use in counterfeiting or piracy, or which had actually been used in counterfeiting or piracy. Another delegation considered such an approach to be too narrow, and that the present provision ought not to be limited.

120. In respect of Article B(2)(iv) one delegation suggested that provision should be added to empower a court to nominate a person or official to supervise the implementation of the order in question.

121. With regard to Article B(2)(v) several delegations and representatives stated that the provision on order of disclosure should be broadened to include disclosure of the channels of distribution of suspected goods or copies, as well as the quantity of suspected goods or copies manufactured or traded. It was pointed out that it was necessary to cut off the act of counterfeiting or piracy both upstream, at the source, and downstream, at the various commercial outlets.

122. Several representatives stated that the source of forged labels and packaging should also be subject to an order of disclosure.

123. One representative suggested that it should be made clear that information obtained pursuant to an order of disclosure should be available for exchange between the competent authorities of different countries in order to effectively fight counterfeiting and piracy involving international dimensions.

124. Some delegations expressed difficulty with the notion of a fine being imposed in respect of civil proceedings. Other delegations pointed out that the laws of their countries provided for the possibility of both fines and prison sentences in respect of disobedience of a court order in civil proceedings, since such disobedience would constitute contempt of court. A number of delegations and representatives of observer organizations, accordingly, favored the inclusion of the alternative of imprisonment or a fine for disobedience with the relevant order. Other delegations considered that the question of the appropriate penalty should be left to national laws, rather than enumerated.

125. A number of delegations considered that the order of disclosure should not be available in respect of criminal proceedings, since such an order would be incompatible with the privilege against self-incrimination. It was pointed out by another delegation, however, that the disclosure of the source of suspected goods or copies, and of their channels of distribution, might not necessarily be incriminating. It was stated that the interests of the defendant could be safeguarded by providing that information obtained through such an order could not be used against the defendant in any criminal proceedings.

126. With regard to Article B(3) it was pointed out by some delegations that, in conformity with the suggestion made in respect of Article B(1)(c), the word "court" should be replaced by the words "competent authority."

127. A number of delegations expressed concern at the use of the word "suspected" in the provision, and preferred the use of another expression, such as "presumed."

128. With regard to Article B(4), one delegation sought clarification as to the person on whose initiative a measure would be cancelled by a court or law enforcement authority. It was replied that anyone involved in the relevant proceedings would be able to request the cancellation of the measure in question.

129. With regard to Article B(5), it was suggested by several representatives that a cross-undertaking in damages should be available as an alternative to posting a bond.

130. It was pointed out that the quantum of the bond required should be reasonably related to the commercial value of the goods or copies subject to seizure.

131. Several delegations stated that the requirement of a bond should not be mandatory. It was pointed out that the use of the words "where it deems it necessary" seemed to remove any mandatory requirement of a bond.

132. With regard to Article B(6), a number of delegations emphasized the fundamental nature of the right of an accused party to be heard and stated that this right should not be lightly removed. On the other hand, one representative pointed out that ex parte proceedings, which contained an element of surprise, had proven to be very effective in some countries, and that measures were ordered following ex parte proceedings only when there was evidence that the accused or defendant was behaving dishonestly.

133. With regard to Article B(7) a number of delegations stated that they did not consider it necessary that a requesting party should be required to ask for the court's approval in respect of measures which had been taken. The interests of an accused or a defendant were adequately safeguarded by the possibility of appeal in respect of any measure ordered or taken, thus obviating the need for the requesting party to seek the court's approval.

134. One representative pointed out that the provision did not contain any time period in respect of the bringing of an appeal by a person who may suffer prejudice as a consequence of a measure taken. He stated that, if the provision in Article B(7) were retained, care should be taken to ensure that a requesting party need not seek the court's approval until after the expiration of any relevant period allowed for an appeal by a prejudiced party.

135. A number of delegations and representatives favored the specification of a short period (either seven or ten working days) for the time during which a requesting party must ask for the court's approval of the conservatory measures taken.

136. One delegation stated that Article B(7) was not in conformity with its national law. When a law enforcement authority had taken a measure, the alleged infringer could, according to that national law, request the cancellation of this measure in a summary proceeding.

137. With regard to Article B(8), some delegations favored the replacement of the word "shall" by the word "may." In contrast, a number of other delegations considered that it was essential that a requesting party be liable for damages caused by any measure which had been taken. In this respect, one delegation stated that it was necessary to ensure that the provisions concerning conservatory measures could not be abused by a requesting party and that, therefore, a specific penalty should be provided against a requesting party in Article B(8) if it was found by a court that there had been no act of counterfeiting or of piracy and damages had been caused by the conservatory measure taken.

Article C

138. It was suggested that it should be specifically mentioned that the remedies under Article C were non-exhaustive.

139. Several delegations and representatives supported the extension of the remedies set out in Article C to include an additional measure whereby the successful party in proceedings could request the court to order the publication of the judgement. It was pointed out that such a publication would reduce the detrimental impact of counterfeiting and piracy on the public, since the public would be informed of the fact that counterfeit goods and pirate copies had been in circulation. In addition, the publication would have serious implications for the reputation of the infringer, and would alert all concerned trade and business circles of the infringer's illicit activities. In this respect, it was also suggested that the order of publication should include provision for the judgement to be communicated to the local Chamber of Commerce. Publication would also constitute an effective measure of dissuasion and deterrence for other potential counterfeiters or pirates.

140. One delegation and one representative stated that the remedies available in Article C should also be extended to include an order requiring an infringer to provide information concerning the sources of supply and channels of distribution, as well as the quantity of goods or copies manufactured or traded. It was considered necessary that such an order of disclosure be available amongst the civil remedies in Article C, in addition to being available as a conservatory measure in Article B, since there may be cases where no conservatory measures were taken in respect of counterfeiting or piracy prior to the final action in court which led to the award of civil remedies.

141. One delegation and a number of representatives also suggested the inclusion of a further civil remedy directed at facilitating the establishment of proof, particularly in cases involving foreign right-holders and licensees. In these cases, the problem of proof of title often arose, and the requirement of bringing witnesses into the jurisdiction could be extremely onerous. The delegation urged that a number of options be considered in this respect. First, the introduction of presumptions of title, such as the

presumptions of authorship contained in Article 15 of the Berne Convention, could be considered. Secondly, legal presumptions of title, which shifted the burden of proving the absence of title to a defendant, could also be considered. Thirdly, it might be considered appropriate to include a provision whereby properly executed affidavits concerning authorship, title or the transfer of rights could be accepted in the place of live testimony, except in cases where it was proved by a defendant that the affidavits were false.

142. One delegation stated that it should be made clear in Articles B, C and D that the same procedures for determining acts of counterfeiting and piracy should be applied to both domestic and foreign acts in order to ensure that none of the measures could be used to discriminate against imports. Another delegation pointed out that customs procedures would not be applicable to wholly domestic acts; it therefore considered that the same standards, rather than procedures, should be applied for determining counterfeiting and piracy in respect of both domestic acts and acts involving foreign parties.

143. In reply to the general observations concerning Article C, the Director General stated that the next draft of the model provisions would take into account all of the new remedies which it was suggested to be included in order that the model provisions provide a pattern of legislation which might operate as the most effective deterrent to counterfeiting and piracy.

144. In respect of Article C(1), a number of different aspects of the calculation of damages for the prejudice suffered by an injured party were discussed.

145. The first aspect concerned the question of damages in respect of moral prejudice suffered by the injured party. Some delegations sought clarification as to the meaning of moral prejudice and indicated that, if moral prejudice were to be considered as relating to injury to authors' moral rights, they did not agree with its application to counterfeiting and piracy. Some representatives pointed out, however, that the term "moral prejudice" should be considered to include damage to the reputation of the injured party, and that such damage was extensive and grave in the case of counterfeiting and piracy. It was indicated, nevertheless, that the quantification of damages in this respect posed difficult questions.

146. The method of calculation of damages in general was discussed by many delegations and representatives. Several delegations favored the replacement of the words "as well as" in the second last line of the provision by the words "and/or." The intent of this modification would be to make it clear that the quantum of damages should not necessarily include both the loss suffered by the injured party and the profits gained by the infringer. Other delegations favored the possibility of a discretionary statement of the basis on which damages should be assessed by the court, preferring a method by which the court would take into account all material and moral damage caused by the act of counterfeiting or piracy, with consideration specifically being given to both the loss suffered by the injured party and the profits gained by the infringer.

147. It was also pointed out by some delegations that, if the act of counterfeiting or piracy were stopped in its early stages, the amount of damage suffered might be relatively small. In such circumstances, it was stated that exemplary damages should be imposed to remove the economic benefits to the infringer.

148. A number of delegations and representatives also expressed concern about the difficulty of proving itemized damages. In this respect, attention was drawn to the distinction between counterfeiting and piracy, on the one hand, and infringement, on the other. Where counterfeiting or piracy had been established, it was suggested that the jurisdiction of the court should extend to imposing damages within a specified range without a requirement of proof of actual damage. The injured party should then have an option of either proving actual damage or accepting damages in a lesser sum without proof of actual damage.

149. Extensive discussion also took place concerning the inclusion of lawyer's fees to be paid by the infringer. Some delegations expressed concern about the possible lack of a limit to such fees, and suggested that the infringer should be required to pay such fees only when they were necessarily incurred by the injured party. On the other hand, many delegations pointed out that lawyer's fees were a necessary expense which an injured party had to assume in order to obtain redress against counterfeiting or piracy. They stated that it was, accordingly, entirely proper that lawyer's fees should be paid by the infringer.

150. Many delegations and representatives also stated that the expression "lawyer's fees" ought to be extended to require the payment by the infringer of other costs incurred by an injured party in obtaining redress against an infringer. In this regard, they cited the costs of investigating an act of counterfeiting or piracy, the cost of obtaining survey and other evidence, of obtaining advice by an industrial property counsel, of establishing proof of damage, of travel of the plaintiff or his lawyer or industrial property counsel and of transporting material witnesses for the purposes of litigation.

151. With regard to Article C(2), a number of delegations considered that the mandatory requirement that the court order the destruction of counterfeit goods or pirate copies and their packaging was too harsh. They pointed out that goods or copies may represent only partial infringements, and that consideration should be given to the possibility of disposing of goods or copies, rather than destroying them. In this respect, it was suggested that a discretion be vested in the court to decide on the appropriate measure.

152. Several other delegations, however, stated that the utmost care should be taken to ensure that no counterfeit goods or pirate copies, or the materials for making such counterfeit goods or pirate copies, be permitted to re-enter circulation. Accordingly, they favored either the mandatory destruction of counterfeit goods or pirate copies, or the disposal of such goods or copies in such a way as to ensure that the infringer could not receive any benefit from the goods or copies and that the goods or copies could not later be used again for the purposes of counterfeiting or piracy.

153. With regard to Article C(3), some delegations stated that the word "danger" in the first line of this provision might be too strong a requirement and favored its replacement with the word "possibility."

154. One delegation stated that it wished consideration to be given to the confiscation by the State of offending tools that might have another legitimate productive use. Several other delegations, however, considered that, where tools had been used in respect of counterfeiting or piracy, it should be mandatory that the court order their destruction.

155. In conformity with comments made in respect of the term "tools" in Article B(2)(iii), a number of delegations suggested that the word "tools" in Article C(3) be replaced with the expression "all electronic, mechanical and other means used to manufacture, produce, assemble or package" counterfeit goods or pirate copies.

156. In respect of Article C(4), certain delegations expressed concern over the imposition of a fine in respect of civil proceedings. Other delegations pointed out that the fine would, in this provision, be imposed, not in respect of the civil proceedings, but in respect of the disobedience of a court order granted in the civil proceedings. The matter was, therefore, a question of contempt of court, and required a provision.

157. Some delegations favored a discretion on the part of the court to determine whether a fine or a prison sentence would be appropriate in respect of disobedience of an order under this provision.

Article D

158. In introducing Article D, the Secretariat stated that this Article--even more than the other Articles--could only provide guidelines for national laws and could probably not be enacted as such in any national laws, since provisions of criminal law usually took into account certain well-established national traditions, which considerably differed from country to country. The model provisions contained in Article D were only guidelines and were not exhaustive. On the other hand, certain parts of Article D (for example, paragraph (3) concerning cases of recidivism) might not require enactment in each country because they represented general principles which were contained in general provisions of criminal law.

159. The need for criminal sanctions in cases of counterfeiting and piracy was generally recognized. It was underlined that persons engaged in counterfeiting and piracy could be effectively deterred from such action only through severe criminal sanctions.

160. Several delegations requested that the commentary to the next draft state that criminal sanctions for patent counterfeiting be optional in the context of this model law. The reason for this request was that in cases of patent infringement complicated technical questions were at stake, such as the

validity of a patent and the interpretation of the claims in order to define the scope of protection of a patent.

161. The great majority of the delegations who spoke on these questions expressed themselves in favor of Alternative B of paragraph (1), in particular because there should not be any criminal sanctions in case of counterfeiting and piracy without criminal intent. One delegation, however, stated that although negligent counterfeiting or piracy should be not punishable, criminal sanctions might nevertheless be provided for in cases of gross negligence.

162. Several delegations expressed the view that the comparison of counterfeiting and piracy with theft was not always appropriate. On the other hand, it was emphasized that, whenever an intellectual property right was infringed, there was a violation of property which usually was considered as a case of theft. The Secretariat explained that the reference to theft was not meant to be understood as an assimilation of the act of counterfeiting and piracy with theft, but was rather made for the purpose of indicating what kind of criminal sanctions should be provided for. In this connection, some delegations indicated that, in the national laws of their countries, counterfeiting and piracy were assimilated to crimes other than theft.

163. In connection with a question how to prove the intent of the accused infringer, reference was made to the practice under certain national laws to conclude from particular circumstances--for example the fact that the accused infringer had counterfeit products and tools for their manufacture in his possession--that he must have acted intentionally; under such circumstances, the accused infringer would have to demonstrate his good faith.

164. It was underlined that the simultaneous application of two criminal sanctions, namely imprisonment and a fine, was appropriate in many cases of counterfeiting and piracy. One delegation said this should be left to the criminal policy in a country.

165. Some delegations considered that profits earned should not be taken into account when fixing the amount of a fine.

166. With respect to paragraph (2), it was stated that acts of endangering health or safety might be punishable also under other criminal provisions, which in any case should remain applicable.

167. It was suggested to add among the criminal sanctions the publication of the criminal judgment.

168. One delegation stated that paragraph (3) was not in line with its national policy. There was a tendency to reduce in criminal law the provisions solely directed against recidivism. For the practice in concrete sanctioning this would not make any difference. In its national legislation a specific provision would be introduced with regard to infringements of intellectual property law (especially copyright law), which were committed professionally or commercially.

169. With respect to paragraph (4), one delegation indicated that the remedies referred to in Article C(2) and (3) could not automatically be transferred into the criminal law because of substantial differences in procedure in criminal and civil matters.

Document C&P/CE/3: Provisions in the Paris, Berne and
Neighboring Rights Conventions

170. The Committee of Experts did not consider document C&P/CE/3. It was agreed that this document should be examined in a further meeting.

IV. FUTURE WORK

171. The Delegation of Mexico, on behalf of the Latin American Group, made the following statement:

"With reference to the initial statement made by the Latin American Group at the beginning of the present meeting of the Committee of Experts, the Group wishes to reaffirm the importance and usefulness of the work that has been done on the drafting of the model provisions.

"The Latin American Group considers that the work should continue in the coming year, and therefore, on the occasion of the next meeting of the Governing Bodies, in September, it will request and endorse the continuation of the work on the part of the International Bureau with a view to the planning of another meeting.

"Nevertheless, it is our view that, in accordance with the mandate entrusted to it, the Committee of Experts should undertake a study in greater depth of the current international treaties in the field, such as the Paris Convention, the Berne Convention and other treaties on related rights, in order to analyze the provisions and the procedures that those texts specify and thereby produce a comprehensive overall picture of the subject which enables it to be better understood, in view of the fact that they have not, either on this or on earlier occasions, been thoroughly studied.

"With regard to an exchange of information, it should consist solely in the analysis of new aspects and measures, the explanation of existing procedures, and ways of remedying shortcomings or filling gaps in the law, as has been consistently done up to now at meetings of the Committee, in the course of which various delegations, by means of the comments and contributions that they have made, have explained their legislation; in no event, however, should any meeting become a forum for accusations, as problems arising out of the counterfeiting of goods are ultimately disputes between individuals and not between states."

172. The Delegation of the United Republic of Tanzania associated itself with the declaration made by the Delegation of Mexico on behalf of the Latin American Group.

173. The Delegation of Italy raised the question whether a continuation of work within WIPO could not have the consequence that work undertaken in GATT in respect of the area under consideration would not be pursued, and whether such a consequence was in the interest of all countries.

174. The Delegation of Colombia said that progress had indeed been made with the consideration of a model law, but drew attention to the fact that the mandate of the Committee also included consideration of the international conventions on the subject, which was an important aspect of the work of WIPO, as the Organization was the universal forum par excellence for matters concerning intellectual property. It added that such consideration would make it possible to analyze the procedures provided for in the conventions, or their shortcomings, and indeed could go so far as to propose the revision of some aspects of them with a view to improving the protection of intellectual property against piracy and the counterfeiting of goods. That could well be a more expeditious way of effecting the required strengthening of provisions, as the majority of the States present were party to the conventions concerned, which would facilitate the implementation of the proposed measures in a manner consistent with reality and legal, political and economic circumstances. Consequently the Delegation favored the continuation of the work in the direction indicated in the declaration by the Latin American Group.

175. The Delegation of France drew attention to the fact that the work within WIPO comprised two aspects, namely, industrial property and copyright, but that it should be avoided that unnecessary distinctions be created by using two different expressions. The terminology to be used, therefore, should be reviewed. Thus, it was important to have a further meeting of the Committee of Experts as soon as possible.

176. The Delegation of the United Republic of Tanzania, referring to the statement made by the Delegation of Italy, indicated that a continuation of the work within WIPO would not entail any risks, and that, in any case, it was necessary to carry the work of WIPO to a logical conclusion. Thus, the matter should be submitted to WIPO's Governing Bodies, with the proposal to continue the work.

177. The Director General said that he would report to the Governing Bodies when they meet in September 1988 that the April 1988 session of the Committee of Experts could not complete its work because of lack of sufficient time. In particular, the Committee could not study the significance of the Paris and Berne Conventions in the field of counterfeiting and piracy. Furthermore, the numerous and important suggestions made by the governmental experts and the representatives of intergovernmental and non-governmental organizations in respect of the draft model provisions for national laws required amendment and re-discussion of the said draft. In this regard, the Director General stated that he would welcome written observations from the delegations prior to the

preparation of the revised text of the model provisions. For those reasons, the Director General would report to the September 1988 session of the Governing Bodies that, unless the Governing Bodies are of a different opinion, he would reconvene the Committee of Experts in 1989.

V. OBSERVATIONS ON METHODS OF DRAFTING THE REPORT

178. The Delegation of Côte d'Ivoire stated that, in view of the complexity of the matter, it would be desirable that each chapter should not only reflect the interventions made, but also the conclusions arrived at in the discussions. The Secretariat stated that this depended on the discussions themselves, but the wish could be complied with if general conclusions were arrived at, which, however, was not always the case in a Committee of Experts.

179. The Delegation of the United Republic of Tanzania expressed the wish that in parts of the report which only mention the number of delegations, the names of the countries should also be indicated in order to permit a better understanding of the positions taken by each country in the discussions of the Committee of Experts.

180. This report was unanimously adopted by the Committee of Experts in its meeting of April 28, 1988.

[Annex follows]

LISTE DES PARTICIPANTS/LIST OF PARTICIPANTS/LISTA DE PARTICIPANTES

I. ETATS/STATES/ESTADOS

(dans l'ordre alphabétique français des noms des Etats)/
(in the French alphabetical order of the names of the States)/
(en el orden alfabético francés de los nombres de los Estados)

AFGHANISTAN

Abdul Mohammad SHOOGUFAN, First Secretary, Permanent Mission, Geneva

ALGERIE/ALGERIA/ARGELIA

Amar DAHMOUCHE, Représentant permanent adjoint, Mission permanente, Genève

ALLEMAGNE (REPUBLIQUE FEDERALE D')/GERMANY (FEDERAL REPUBLIC OF)/ALEMANIA
(REPUBLICA FEDERAL DE)

Raimund LUTZ, Public Prosecutor, Federal Ministry of Justice, Bonn

ARGENTINE/ARGENTINA

Daniel CHUBURU, Secrétaire d'Ambassade, Mission permanente, Genève

Antonio Gustavo TROMBETTA, Secrétaire d'Ambassade, Mission permanente, Genève

AUSTRALIE/AUSTRALIA

Geoffrey BAKER, Acting Deputy Commissioner of Patents, Australian Patent,
Trade Marks and Designs Offices, Phillip, A.C.T.

AUTRICHE/AUSTRIA

Gudrun MAYER-DOLLINER (Mrs.), Head of Legal Department (for International
Affairs and Trademarks), Federal Ministry for Economic Affairs, Austrian
Patent Office, Vienna

BELGIQUE/BELGIUM/BELGICA

Dominique VANDERGHEYNST, Conseiller adjoint, Office de la propriété industrielle, Bruxelles

BRESIL/BRAZIL/BRASIL

Paulo Roberto DE ALMEIDA, First Secretary, Permanent Mission, Geneva

Sonia RIBEIRO MAIA (Mrs.), Director of Marks, National Institute of Industrial Property, Rio de Janeiro

BULGARIE/BULGARIA

Orlin DELEV, First Secretary, Permanent Mission, Geneva

BURUNDI

Grégoire MUYOVU, Premier conseiller d'Ambassade, Mission permanente, Berne

CANADA

Alan Michael TROICUK, Legal Analyst, Quebec

John S. GERO, Counsellor, Permanent Mission, Geneva

CHINE/CHINA

LIU Minxue, Deputy Director General, State Administration for Industry and Commerce, Beijing

LIU Yuanying (Mrs.), Head of the Office of China Consumers Association, Beijing

LI Yuanmin (Mrs.), Vice Chief of Foreign Affairs, State Administration for Industry and Division of Commerce, Beijing

COLOMBIE/COLOMBIA

Alejandro GAMBOA ALDER, Premier secrétaire, Mission permanente, Genève

CONGO

Dominique GANGA BIDIE, Directeur, Bureau congolais du droit d'auteur, Brazzaville

COTE D'IVOIRE

Florent K. EKRA, Conseiller, Mission permanente, Genève

CUBA

Miguel JIMENEZ ADAY, Segundo Secretario, Misión Permanente, Ginebra

DANEMARK/DENMARK/DINAMARCA

Lise ØSTERBORG (Mrs.), Head of Division, Danish Patent Office, Copenhagen

Anne Reinholt JØRGENSEN (Mrs.), Expert, Danish Patent Office, Copenhagen

EGYPTE/EGYPT/EGIPTO

Wafik Zaher KAMIL, Ministre plénipotentiaire, Mission permanente, Genève

Ahmed FATHALLA, Premier secrétaire, Mission permanente, Genève

ESPAGNE/SPAIN/ESPAÑA

Jesus GOMEZ MONTERO, Consejero técnico, Departamento Estudios y Relaciones Internacionales, Registro de la Propiedad Industrial, Madrid

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Nicole RENAUDIN (Mme), Chargée de mission auprès du Directeur de la Communication, Ministère des affaires étrangères, Paris

HONDURAS

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HONGRIE/HUNGARY/HUNGRIA

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INDE/INDIA

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IRLANDE/IRELAND/IRLANDA

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ITALIE/ITALY/ITALIA

Marco G. FORTINI, Ministre plénipotentiaire, Ministère des affaires étrangères, Rome

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JAMAIQUE/JAMAICA

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NORVEGE/NORWAY/NORUEGA

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PAKISTAN

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PORTUGAL

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REPUBLIQUE DE COREE/REPUBLIC OF KOREA/REPUBLICA DE COREA

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Administration, Seoul

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Tae-Chang CHOI, Attaché, Permanent Mission, Geneva

REPUBLIQUE POPULAIRE DEMOCRATIQUE DE COREE/DEMOCRATIC PEOPLE'S REPUBLIC OF
KOREA/REPUBLICA POPULAR DEMOCRATICA DE COREA

Dok Hun PAK, Counsellor, Permanent Mission, Geneva

REPUBLIQUE-UNIE DE TANZANIE/UNITED REPUBLIC OF TANZANIA/REPUBLICA UNIDA DE
TANZANIA

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Khamis J. SUEDE, Deuxième Conseiller (Affaires économiques), Mission
permanente, Genève

ROYAUME-UNI/UNITED KINGDOM/REINO UNIDO

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SUEDE/SWEDEN/SUECIA

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Anna MÖRNER (Ms.), Legal Adviser, Ministry of Justice, Stockholm

Kerstin SUNDSTRÖM (Ms.), Head of Trademark Department, Royal Patent and Registration Office, Stockholm

Arne RODIN, Counsellor, Permanent Mission, Geneva

SUISSE/SWITZERLAND/SUIZA

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TOGO

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TUNISIE/TUNISIA/TUNEZ

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Habib BOUFARES, Conseiller des Affaires étrangères, Mission permanente, Genève

TURQUIE/TURKEY/TURQUIA

Akin ALGAN, Conseiller, Mission permanente, Genève

UNION SOVIETIQUE/SOVIET UNION/UNION SOVIETICAS

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URUGUAY

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YEMEN

Mohamed S. AL-QUTAISH, Ambassador Counsellor (Advisor), Permanent Mission, Geneva

YUGOSLAVIE/YUGOSLAVIA

Radoslav TESIC, Ministre conseiller, Mission permanente, Genève

ZAIRE

Ngimbi Mak MANTUBA, Premier secrétaire, Mission permanente, Genève

Mewa MUTAMBULA (Mlle), Attachée, Mission permanente, Genève

II. ORGANISATIONS INTERGOUVERNEMENTALES/INTERGOVERNMENTAL
ORGANIZATIONS/ORGANIZACIONES INTERGUBERNAMENTALES

ORGANISATION INTERNATIONALE DU TRAVAIL (OIT)/INTERNATIONAL LABOUR ORGANIZATION (ILO)/ORGANIZACION INTERNACIONAL DEL TRABAJO (OIT)

Christiane PRIVAT, Spécialiste sectorielle, Service des employés et travailleurs intellectuels, Genève

ORGANISATION DES NATIONS UNIES POUR L'EDUCATION, LA SCIENCE ET LA CULTURE (UNESCO)/UNITED NATIONS EDUCATIONAL, SCIENTIFIC AND CULTURAL ORGANIZATION (UNESCO)/ORGANIZACION DE LAS NACIONES UNIDAS PARA LA EDUCACION, LA CIENCIA Y LA CULTURA (UNESCO)

Alvaro GARZON, Spécialiste du programme, Division du droit d'auteur, Paris

ACCORD GENERAL SUR LES TARIFS DOUANIERS ET LE COMMERCE (GATT)/GENERAL AGREEMENT ON TARIFFS AND TRADE (GATT)/ACUERDO GENERAL SOBRE ARANCELES ADUANEROS Y COMERCIO (GATT)

Adrian OTTEN, Counsellor, Group of Negotiations on Goods and GATT Policy Affairs Division, Geneva

COMMISSION DES COMMUNAUTES EUROPEENNES (CCE)/COMMISSION OF THE EUROPEAN COMMUNITIES (CEC)/COMISION DE LAS COMUNIDADES EUROPEAS (CCE)

Suzanne JESSEL (Mme), Administrateur principal, Direction générale du marché intérieur et des affaires industrielles, Bruxelles

Christoph BAIL, Conseiller juridique, Délégation permanente, Genève

CONSEIL DE COOPERATION DOUANIÈRE (CCD)/CUSTOMS CO-OPERATION COUNCIL (CCC)/CONSEJO DE COOPERACION ADUANERA (CCA)

G. FARINES, Administrateur technique principal, Bruxelles

ORGANISATION DE L'UNITÉ AFRICAINE (OUA)/ORGANIZATION OF AFRICAN UNITY (OAU) ORGANIZACION DE LA UNIDAD AFRICANA (OUA)

Mohamed Hafiz TUNIS, Counsellor (Economic Affairs), Geneva

ORGANISATION INTERNATIONALE DE POLICE CRIMINELLE (INTERPOL)/INTERNATIONAL CRIMINAL POLICE ORGANIZATION (INTERPOL)/ORGANIZACION INTERNACIONAL DE POLICIA CRIMINAL (INTERPOL)

Robert CODERE, Officier spécialisé, Paris

III. ORGANISATIONS NON GOUVERNEMENTALES/NON-GOVERNMENTAL ORGANIZATIONS/ORGANIZACIONES NO GUBERNAMENTALES

AMERICAN BAR ASSOCIATION (ABA)

Allan S. PILSON, Chairman, ABA Committee 202, International Trademarks, New York

ASSOCIATION ASIATIQUE D'EXPERTS JURIDIQUES EN BREVETS (APAA)/ASIAN PATENT ATTORNEYS ASSOCIATION (APAA)/ASOCIACION ASIATICA DE EXPERTOS JURIDICOS EN PATENTES (APAA)

Kiyoshi MURAKI, Registered Patent Attorney, Tokyo

Farrukh Irfan KHAN, Registered Attorney at Law, Lahore

Chi Keung KWONG, Solicitor and Agent for Trademarks and Patents, Hong Kong

ASSOCIATION BRÉSILIENNE DE LA PROPRIÉTÉ INDUSTRIELLE (ABPI)/BRAZILIAN ASSOCIATION OF INDUSTRIAL PROPERTY (ABPI)/ASOCIACION BRASILENA DE LA PROPIEDAD INDUSTRIAL (ABPI)

José R. GUSMÃO, Avocat, Rio de Janeiro

ASSOCIATION DES PRATICIENS DES COMMUNAUTES EUROPEENNES DANS LE DOMAINE DES
MARQUES (ECTA)/EUROPEAN COMMUNITIES TRADEMARK PRACTITIONERS' ASSOCIATION,
(ECTA)/ASOCIACION DE PROFESIONALES EN MARCAS DE LAS COMUNIDADES EUROPEAS (ECTA)

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ASSOCIATION EUROPEENNE DES INDUSTRIES DE PRODUITS DE MARQUE (AIM)/EUROPEAN
ASSOCIATION OF INDUSTRIES OF BRANDED PRODUCTS (AIM)/ASOCIACION EUROPEA DE
INDUSTRIAS DE PRODUCTOS DE MARCA (AIM)

David CARLISLE, Chairman, AIM Anti-Counterfeiting Committee, Brussels

Anthea WORSALL (Mrs.), Secretary, AIM (UK Anti-Counterfeiting Group), Bucks.,
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ASSOCIATION INTERNATIONALE POUR LA PROTECTION DE LA PROPRIETE INDUSTRIELLE
(AIPPI)/INTERNATIONAL ASSOCIATION FOR THE PROTECTION OF INDUSTRIAL PROPERTY
(AIPPI)/ASOCIACION INTERNACIONAL PARA LA PROTECCION DE LA PROPIEDAD INDUSTRIAL
(AIPPI)

Roland KNAAK, Attorney at Law, Munich

BUNDESVERBAND DER DEUTSCHEN INDUSTRIE e.V. (BDI)

Franz WINTER, avocat, Ludwigshafen

BUREAU INTERNATIONAL DES SOCIETES GERANT LES DROITS D'ENREGISTREMENT ET DE
REPRODUCTION MECANIQUE (BIEM)/INTERNATIONAL BUREAU OF SOCIETIES ADMINISTERING
THE RIGHTS OF MECHANICAL RECORDING AND REPRODUCTION (BIEM)/OFICINA
INTERNACIONAL DE SOCIEDADES ADMINISTRADORAS DE DERECHOS DE GRABACION Y
REPRODUCCION MECANICA (BIEM)

Antoine VACHER-DESVERNAIS, Secrétaire général, Paris

CENTRE D'ETUDES INTERNATIONALES DE LA PROPRIETE INDUSTRIELLE (CEIPI)/CENTRE
FOR INTERNATIONAL INDUSTRIAL PROPERTY STUDIES (CEIPI)/CENTRO DE ESTUDIOS
INTERNACIONALES DE LA PROPIEDAD INDUSTRIAL (CEIPI)

José Roberto GUSMÃO, Chargé de Mission auprès du CEIPI, Strasbourg

CHAMBRE DE COMMERCE INTERNATIONALE (CCI)/INTERNATIONAL CHAMBER OF COMMERCE
(ICC)/CAMARA DE COMERCIO INTERNACIONAL (CCI)

Janette M.W. BURAAS (Mrs.), ICC Representative to the U.N., Geneva

COMITE DES INSTITUTS NATIONAUX D'AGENTS DE BREVETS (CNIPA)/ COMMITTEE OF
NATIONAL INSTITUTES OF PATENT AGENTS (CNIPA)/COMITE DE INSTITUTOS NACIONALES
DE AGENTES DE PATENTES (CNIPA)

Terence Leslie JOHNSON, Patent Attorney, London

COMITE POUR LA LUTTE ANTI-CONTREFAÇON (COLC INTERNATIONAL)/COMMITTEE AGAINST
COUNTERFEITING (COLC INTERNATIONAL)/COMITE PARA LA LUCHA ANTIFALSIFICACION
(COLC INTERNACIONAL)

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François BLUM, Secrétaire général, Genève

Michèle WEIL-GUTHMANN (Mme), Conseil en propriété intellectuelle, Genève

Cedric BOSSERT, avocat, Genève

CONFEDERATION INTERNATIONALE DES SOCIETES D'AUTEURS ET COMPOSITEURS (CISAC)/
INTERNATIONAL CONFEDERATION OF SOCIETIES OF AUTHORS AND COMPOSERS (CISAC)/
CONFEDERACION INTERNACIONAL DE SOCIEDADES DE AUTORES Y COMPOSITORES (CISAC)

Ndéne NDIAYE, Conseiller, Paris

CONSEIL EUROPEEN DES FEDERATIONS DE L'INDUSTRIE CHIMIQUE (CEFIC)/EUROPEAN
COUNCIL OF CHEMICAL MANUFACTURERS' FEDERATIONS (CEFIC)/CONSEJO EUROPEO DE
FEDERACIONES DE LA INDUSTRIA QUIMICA (CEFIC)

Arthur N. CALDWELL, Cheshire

DEUTSCHE VEREINIGUNG FÜR GEWERBLICHEN RECHTSSCHUTZ UND URHEBERRECHT (DVGR)

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FEDERATION INTERNATIONALE DES ASSOCIATIONS DE DISTRIBUTEURS DE FILMS (FIAD)/
INTERNATIONAL FEDERATION OF ASSOCIATIONS OF FILMS DISTRIBUTORS (FIAD)/
FEDERACION INTERNACIONAL DE ASOCIACIONES DE DISTRIBUIDORES CINEMATOGRAFICOS
(FIAD)

Gilbert GREGOIRE, Président adjoint, Paris

FEDERATION INTERNATIONALE DES ASSOCIATIONS DE PRODUCTEURS DE FILMS (FIAPF)/
INTERNATIONAL FEDERATION OF FILM PRODUCERS ASSOCIATIONS (FIAPF)/FEDERACION
INTERNACIONAL DE ASOCIACIONES DE PRODUCTORES CINEMATOGRAFICOS (FIAPF)

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FEDERATION INTERNATIONALE DES CONSEILS EN PROPRIETE INDUSTRIELLE (FICPI)/
INTERNATIONAL FEDERATION OF INDUSTRIAL PROPERTY ATTORNEYS (FICPI)/FEDERACION
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Yves PLASSERAUD, Membre du Groupe de travail marques, Paris

FEDERATION INTERNATIONALE DES PRODUCTEURS DE PHONOGRAMMES ET DE VIDEOGRAMMES
(IFPI)/INTERNATIONAL FEDERATION OF PHONOGRAM AND VIDEOGRAM PRODUCERS (IFPI)/
FEDERACION INTERNACIONAL DE PRODUCTORES DE FONOGRAMAS Y VIDEOGRAMAS (IFPI)

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Edward THOMPSON, Consultant, Geneva

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FEDERATION INTERNATIONALE DES TRADUCTEURS (FIT)/INTERNATIONAL FEDERATION OF
TRANSLATORS (FIT)/FEDERACION INTERNACIONAL DE TRADUCTORES (FIT)

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INSTITUT MAX PLANCK DE DROIT ETRANGER ET INTERNATIONAL EN MATIERE DE BREVETS
DE DROIT D'AUTEUR ET DE LA CONCURRENCE/MAX-PLANCK-INSTITUTE FOR FOREIGN AND
INTERNATIONAL PATENT, COPYRIGHT AND COMPETITION LAW/INSTITUTO MAX PLANCK DE
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SOCIETE INTERNATIONALE POUR LE DROIT D'AUTEUR (INTERGU)/INTERNATIONAL COPYRIGHT SOCIETY (INTERGU)/SOCIEDAD INTERNACIONAL PARA EL DERECHO DE AUTOR (INTERGU)

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UNION DES CONFEDERATIONS DE L'INDUSTRIE ET DES EMPLOYEURS D'EUROPE (UNICE)/UNION OF INDUSTRIAL AND EMPLOYERS' CONFEDERATION OF EUROPE (UNICE)/UNION DE CONFEDERACIONES DE LA INDUSTRIA Y DE LOS EMPLEADORES DE EUROPA (UNICE)

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IV. BUREAU INTERNATIONAL DE L'ORGANISATION MONDIALE DE LA
PROPRIETE INTELLECTUELLE (OMPI)/INTERNATIONAL BUREAU OF THE
WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)/
OFICINA INTERNACIONAL DE LA ORGANIZACION MUNDIAL DE LA
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Alfons SCHÄFERS, Vice-directeur général/Deputy Director General/Director
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Director, Industrial Property Division/Director, División de la Propiedad
Industrial

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Copyright Law Division/Director, División jurídica del derecho de autor

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Industrial

Bernard IBOS, Juriste, Division de la propriété industrielle (projets
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V. BUREAU/OFFICERS/MESA

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Vice-présidents/Vice-Chairmen/ : Paulo R. DE ALMEIDA (Brésil/Brazil/Brasil)
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Secrétaires/Secretaries/ : Ludwig BAEUMER (OMPI/WIPO)
Secretarios Mihály FICSOR (OMPI/WIPO)

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