

Owen H Dean

A unified intellectual-property law system for southern Africa



International intellectual-property laws

More than a century ago it was clear that for the intellectual-property system to work properly and achieve its aims, it must overcome national frontiers. So in 1883 the International Convention for the Protection of Industrial Property was signed in Paris. Usually called the Paris Convention, this set basic requirements for member countries to offer protection of intellectual property under their national laws. It also created a system of reciprocity among these countries, based on the principle of national treatment. These members were obliged to protect the works of subjects of other member countries as they would protect the works of their own subjects. The convention recognized that intellectual-property rights should be created by a process of territorial registration. Under a system of priority, persons that applied to register items of intellectual property in their home country could obtain corresponding rights by registration in foreign member countries. The foreign rights would date from the date of application in the home country.

The Paris Convention covers patents, trade marks, and designs. It does not deal with copyright. The main equivalent international convention on international copyright protection is the Berne Convention of 1887. This regulates international copyright on an automatic basis, not on the basis of registration or compliance with any other formalities. Like the Paris Convention, it sets basic standards for member countries' laws and provides for national treatment.

There are 117 members of the Paris Convention, and 105 of the Berne Convention. Both conventions have been amended over the years, but remain much as they were when adopted.

The philosophy that underpins intellectual property has reached the international marketplace. As a result, developers of intellectual property usually agree to make it available for commercial use in

Part 1: International arrangements and European conventions

Introduction

Intellectual-property law protects the products of the intellect which can be exploited commercially. They include inventions, designs, artistic and literary creations, and the identities of products symbolizing the goodwill in them. So this law concerns patents, designs, copyright, trade marks, and, to some extent, unlawful competition.

The underlying principle of intellectual-property law is to help those who develop products of the intellect to profit from exploiting them. It rewards the developers and also encourages them to create their products and exploit them to the greatest commercial advantage. It gives the developers a monopolistic or quasi-monopolistic right to use their products for a limited period. As a fair exchange for this privilege, the law requires that when the protection period ends, the developers must surrender to the public domain their products and their rights to them. In effect the developers and the State strike a form of agreement: this gives the developers a profit incentive in return for their dedicating their products in due course to the public benefit.

This system to protect intellectual property has worked well. Today it applies worldwide. It has aided the explosion of technology and the enrichment of the quality of life, especially in the developed world.

countries that give adequate protection and facilitate gain from this use of it. But developers usually decline to allow or encourage this use in countries that inadequately protect intellectual property. So good intellectual-property protection is an important prerequisite for international trade. For example, the intellectual-property regime is capitalistic; yet even the most diehard communist countries to whom the philosophy of intellectual property has been an anathema have, perhaps grudgingly, granted a measure of intellectual-property protection, particularly to foreign products. Now the Republic of China is trying hard to improve its intellectual-property law system and so attract international trade and investment.

Developers of intellectual property usually make it available for commercial use in countries that give adequate protection and facilitate gain from this use of it

Rationalization in intellectual-property law

Under the Paris Convention, intellectual-property rights can be obtained by registration in each separate country. The national laws of each country govern registration and the rights flowing from registration. But strictly-national registration of intellectual-property rights has various practical disadvantages, particularly for the creator wishing to protect the property. Serious disadvantages of this approach are:

- *Uncertainty:* Granting intellectual-property rights depends on national laws that can vary from country to country on important points. So a creator wishing to use his intellectual property internationally faces the uncertainty that property which can be protected in one country may not qualify for protection elsewhere.
- *Cost:* Official fees must usually be paid in each country where registration is sought. A worldwide programme of registering intellectual-property rights can be expensive for the developer, who tends to be discouraged from seeking international protection. This problem is closely linked to the next one.
- *Administrative complexities and burdens:* Having to file a separate application in each country in which registration and protection is sought

can cause serious administrative and bureaucratic problems and delays in securing protection. It requires the establishment of an institution and administrative resources to coordinate and maintain a vast array of national registrations.

These circumstances have over the years cried out for streamlining. Comprehensive international protection for intellectual property is needed with the minimum of formalities and practical difficulties. As a result, multinational arrangements have been introduced to ease the burden of having to register intellectual property in each individual country.

International intellectual-property arrangements

At the forefront of the move to create multinational systems of registering intellectual property are the World Intellectual Property Organization (WIPO) and the European Union. An agency of the United Nations, WIPO has emphasized the creation of systems for easing the administrative and financial burden of obtaining intellectual-property registrations in individual countries. This it has done by simplifying procedures, not by abolishing the principle of national registrations. By contrast, the countries of the European Union have tried to create central registration systems that grant registrations effective in a number of countries. I will examine some of the systems set up by these two bodies as being typical of the international trends.

WIPO Conventions

1 The Madrid Agreement on Trade Marks

The Madrid Agreement on Trade Marks was concluded in 1891. It has since been revised, most recently in 1979, and a protocol to it has now been proposed. In 1993 the agreement had 34 member states. It provides for the international registration of trade marks at the International Bureau of WIPO in Geneva.

To qualify for the advantages of obtaining an 'international registration', the applicant must be a national of one of the member countries or must be domiciled or have a place of business in one of the contracting states. A trade mark must first be registered in the country of origin. Then an international registration can be applied for through the trade-marks office of the country of origin. This registration, once made and published by the International Bureau, is notified to the contracting states in which the applicant seeks

protection. Each of these states may within a year declare its refusal to grant registration of the mark in its territory and must give reasons for doing so. If this declaration is made, the application continues as a national application before the registry concerned. If the declaration is not made within the one-year period, the international registration has the effect of a national registration in the contracting country.

The chief advantage of an international registration is that, having registered a trade mark in the country of origin, the proprietor need file only one application and pay fees to one office (the International Bureau). He need not file separate national applications in the trade-marks office of each contracting state.

2 Patent Cooperation Treaty (PCT)

The Patent Co-operation Treaty (PCT) was concluded in 1970 and amended in 1979 and 1984. In 1993 it had 57 signatories.

Under this treaty, nationals or residents of contracting states may file an 'international' patent application. This is initially filed in the national patent office of the country of origin. Initial applications can also be filed in some of the other multinational offices. The international application is sent to the International Bureau of WIPO. In his application the applicant must designate the countries in which he wishes his international application to have effect ('designated states'). Any international patent application has the same effect in each designated state as though a national patent application had been filed in that country's patent office.

On receipt by the International Bureau, the application undergoes an 'international search'. This is done by one of the main patent offices, such as those of the United States of America, the European Patent Office, Japan, and Sweden. An international search report is then issued: it lists citations that affect the patentability of the invention claimed in the international application. The report is communicated to the applicant, who can read it and then decide whether he wishes to continue the patenting process. If he decides to continue, he must within a certain period furnish each national patent office with an application in that office's official language. The various applications then proceed as national applications.

For the applicant, an international application has advantages over national applications. He has longer to evaluate the desirability of pursuing an

international patenting program. His international application cannot be rejected by national offices on formal grounds. And on the basis of the international search report he is well placed to assess the reasonable prospects of securing international patents.

European conventions

The major European Conventions relevant to the present discussion are the following:

1 European Patent Convention

The Convention on the grant of European patents (European Patent Convention) was signed in Munich on 5 October 1973. Its aim is to enable persons wishing to seek patent protection in several European countries to file a single application covering all the contracting states designated by the applicant. The applicant need not file a number of identical national patent applications. The European Patent Convention is currently effective in seventeen European countries, including all the major ones. In effect the Convention constitutes a common European law for the grant of patents. This law runs parallel with the contracting states' national laws granting national patents. So an applicant may choose to file a number of national applications rather than a European application.

The Convention established a European Patent Office based in Munich with sub-offices in The Hague and Berlin. These sub-offices do searches on patent applications.

A European patent application can be filed by a non-national of a contracting state. The Convention sets out the requirements for the registrability of patents and for applications. Once filed, an application is examined for compliance with formal requirements and then undergoes a novelty search. After examination the application is published; then it gives the applicant provisional protection that may vary from contracting state to state. Although the application cannot yet be opposed, on its publication a third party may submit written observations about the patentability of the invention.

The next step is for the application to undergo a substantive examination. If the applicant is satisfied with the terms on which the office is willing to grant registration, translations of the application are lodged and the application is then granted. The grant of the application is published in the European Patent Bulletin. It can then be opposed by third parties. The grant of the patent starts its

'national life' in each of the designated states. Most states require the filing of a translation of the patent into an official language of that country. After grant, a European patent must be considered as a bundle of national patents, each governed by the national law of the state for which it is valid. A European patent must be renewed separately in each designated state. But despite any contrary national laws of the contracting states, the patent lasts for twenty years from the date when the application is filed.

2 *European Community Trade Mark System (CTM)*

This trade mark system is being set up under the Community Trade Mark Regulation of the Council of the European Community dated 14 January 1994. It will probably not be available for at least another three to four years. A central Community Trade Marks Office will be based in Alacante, Spain, to which applications will be submitted. These may be in any one of five designated languages; translations into the other languages will be made at the CTM office.

A CTM application will be searched by the CTM office against earlier CTM marks. The applications will be referred to the national registries of those countries which have stated their intention that they wish to make national searches. National search results will be sent to the CTM office. The results of the CTM and national searches are sent to the applicant, then published and notified to existing CTM owners. If an existing owner wishes to oppose an application, he must enter formal opposition proceedings. An application that fails or encounters problems can become a series of national applications. These will then continue on a national basis. Once registered, a Community Trade Mark will enjoy the status of a national registration in each country. □

Owen H Dean: Spoor and Fisher

AND/OR...

'“And/or”, that befuddling, nameless thing, that Janus-faced verbal monstrosity, neither word nor phrase, the child of a brain of someone too lazy or too dull to express his precise meaning, or too dull to know what he did mean, now commonly used by lawyers in drafting legal documents, through carelessness or ignorance or as a cunning device to conceal rather than express meaning.'

[Fowler J in *Employers Mutual Liability Insurance Co v Tollefsen* 219 WIS 434 (1935)]