

Council for Trade-Related Aspects of Intellectual Property Rights

NOTIFICATION PROVISIONS OF INTELLECTUAL PROPERTY CONVENTIONS
INCORPORATED BY REFERENCE INTO THE TRIPS AGREEMENT
BUT NOT EXPLICITLY REFERRED TO IN IT

Background Note by the Secretariat

1. At its meeting of 21 September 1995, the TRIPS Council, discussing those notification requirements under the provisions of the Berne Convention and the Rome Convention that were incorporated by reference into the TRIPS Agreement but not explicitly referred to in it and which had been listed in paragraphs 7 to 9 of document PC/IPL/7/Add.1, requested the Secretariat to prepare a background document setting out, first, the nature of the various notification provisions in question; second, the information that the Secretariat would be able to obtain, with the assistance of WIPO and the United Nations Legal Office, on the notifications that had already been made under the relevant provisions of the Berne Convention and the Rome Convention by TRIPS Members; and third, taking into account the way the TRIPS Agreement had handled other notification provisions, come forward with options for how the TRIPS Council might give effect also to these requirements. The purpose of this note is to respond to this request.

2. Annex 1 to this note contains the notifications already made pursuant to the relevant provisions of the Berne Convention and the Rome Convention and which are currently effective. The part of the Annex relating to the Berne Convention is prepared on the basis of a list of the notifications issued in respect of the relevant provisions of the Berne Convention and the Appendix thereto provided on 17 October 1995 by the International Bureau of the WIPO, whose Director General is the depositary of the Stockholm Act (1967) and the Paris Act (1971) of the Berne Convention. The part of the Annex relating to the Rome Convention is prepared on the basis of a list of States parties to the Rome Convention and the corresponding texts of reservations and declarations that was provided on 29 March 1995 by the Treaty Section of the Office of Legal Affairs of the United Nations, whose Secretary-General is the depositary of the Convention. The depositary notifications are drafted by both organizations in English and French only. The complete listings and other information provided by WIPO and the United Nations are available in the WTO Secretariat for consultation by interested delegations.

3. The texts of the relevant provisions of the Berne Convention and the Rome Convention are reproduced in Annex 2.

I Nature of the notification provisions

(a) The Berne Convention

4. Article 9.1 of the TRIPS Agreement requires Members to comply with Articles 14*bis*(2)(c) and 14*bis*(3) and Article 15(4) of the Berne Convention and the Appendix

thereto. The nature of the notification provisions contained in these Articles and the relevant Articles of the Appendix is discussed below.

5. Articles 14bis(2)(c) and 14bis(3) of the Berne Convention: Article 14bis(2)(b) of the Berne Convention as incorporated into the TRIPS Agreement applies to a WTO Member which in its legislation includes among the owners of copyright in a cinematographic work authors who have brought contributions to the making of the work. In such a Member it must be presumed that these authors have consented, in the absence of any contract to the contrary, to certain ways in which the film may be exploited. If such Member's legislation requires that the consent of the authors must have been in writing, Article 14bis(2)(c) requires that Member to inform other Members of this requirement by means of a notification. Article 14bis(3) requires that a Member the law of which does not make the presumption binding on the principal director of the film must similarly make a notification. The purpose of these notification requirements is to allow those concerned to know the Members the legislation of which applies the presumption in such a restricted way and to make their arrangements accordingly.

6. Under the Berne Convention one country has made a notification as foreseen in Article 14bis(2)(c) and one country as foreseen in Article 14bis(3) of the Berne Convention. For the text of these notifications, see Annex 1.

7. Article 15(4) of the Berne Convention: Article 15(4) of the Berne Convention as incorporated into the TRIPS Agreement is mainly directed at the protection of folklore. It deals with unpublished works where the identity of the author is unknown, but where there is every ground to presume that he or she is a national of a given WTO Member. In such a situation the Member concerned may designate a competent authority to protect the interests of the author. Other Members should be informed about this authority by means of a notification giving full information.

8. Under the Berne Convention one country has made a notification as foreseen in Article 15(4) of the Berne Convention. For the text of this notification, see Annex 1.

9. Appendix to the Berne Convention: Article 9.1 of the TRIPS Agreement requires Members to comply with the Appendix to the Berne Convention (1971), which contains special provisions for developing countries. The Appendix contains a number of notification procedures which are discussed below.

(a) Article I of the Appendix: Paragraph 1 requires a developing country Member wishing to avail itself of the possibilities provided in the Appendix to declare that it will avail itself of the faculty provided in Article II and/or Article III of the Appendix (compulsory licenses for, respectively, translations and reproductions) by means of a notification. According to paragraph 2 such declarations can be made for renewable periods of ten years. Such declarations may be renewed by means of a notification. Paragraph 5 deals with the possibility for a country to make notifications in respect of territories for which it has international responsibility.

(b) Article II(3)(b) of the Appendix: This provision deals with the situation where a developing country Member secures the agreement of all developed Members, in which the same language is in general use as in that developing country Member, to provide for a shorter period than the usual three years after publication for the application of compulsory licences to substitute for the exclusive right of translation. The provision requires that any such agreement shall be notified.

- (c) Article IV(2) of the Appendix: This provision deals with the situation where an applicant for a compulsory licence of the types provided for in Articles II and III cannot find the owner of the right in question. In such a situation, he or she must send a copy of the application to any national or international information centre which may have been designated by the Member in which the publisher of the work concerned is believed to have his principal place of business. The paragraph provides that such information centres must have been designated in a notification by the Member concerned.
- (d) Article IV(4)(c)(iv) of the Appendix: This provision allows developing country Members to export copies of translations made under compulsory licence, provided that a number of conditions are met: the language of the translation must not be English, French or Spanish; the recipients are individuals who are nationals of the Member whose competent authority has granted the license, or organizations grouping such individuals; the copies must be sent for teaching, scholarship or research purposes; there must be no commercial purpose; and there must be an agreement between the Member granting the licence and that to which the copies are sent. The provision requires that such an agreement shall be notified by the Member in which the license has been granted.
- (e) Article V of the Appendix: This Article provides that a developing country Member may choose, by way of a declaration made at the time of ratification or accession, the "ten-year régime" which appeared in the 1896 Act of the Berne Convention for translations instead of the compulsory licensing system provided for in Article II of the Appendix.

10. Under the Berne Convention one notification made under Article I of the Appendix is currently effective. For the text of this notification, see Annex 1.

(b) The Rome Convention

11. Article 17 of the Rome Convention: Article 14.6 of the TRIPS Agreement allows a WTO Member to avail itself of exceptions permitted under the Rome Convention. Article 17 of the Rome Convention allows a state which, on 26 October 1961 granted protection to producers of phonograms solely on the basis of the criterion of fixation to continue to do so, provided it makes a notification to this effect at the time of ratification, acceptance or accession.

12. Under the Rome Convention four countries have made a notification as foreseen in Article 17. For the text of these notifications, see Annex 1.¹

13. Article 18 of the Rome Convention: Articles 1.3, 3.1 and 14.6 of the TRIPS Agreement relate to certain exceptions under the Rome Convention the invocation of which require notification. Article 18 of the Rome Convention provides that any state which has invoked such an exception by means of notifications under Articles 5(3), 6(2), 16(1) or 17 of the Rome Convention may, by a further notification, reduce the scope of or withdraw the notification in question.

14. Under the Rome Convention certain countries have reduced in scope or withdrawn some of their earlier notifications under Articles 5(3), 6(2), 16(1) or 17 by means of a further

¹Three of these countries have conveyed information to the Council for TRIPS regarding the use they have made of Article 17 of the Rome Convention (see documents IP/N/2/DNK/1, IP/N/2/FIN/1 and IP/N/2/ITA/2).

notification under Article 18. Annex to document IP/C/W/3 and Annex 1 to this document contain the notifications already made under Articles 5(3), 6(2), 16(1)(b) and 17 as subsequently modified by such further notifications. Notifications under Article 18 of the Rome Convention have not been listed separately in Annex 1.

II Notification procedures

(a) Procedures

15. The Council has already dealt with notification procedures under certain provisions of the Berne and Rome Conventions incorporated into the TRIPS Agreement by reference similar to the provisions discussed in this Note, when it took the decision concerning notifications under Articles 1.3 and 3.1 of the TRIPS Agreement (paragraphs 11 and 12 of document IP/C/M/2). If the Council wishes to handle questions relating to notifications addressed in this Note in the same way, it would invite Members wishing to make such notifications to make them to the Council for TRIPS, even if the Member in question had already made a notification under the Berne or Rome Convention in regard to the same issue.

(b) Timing of notifications

16. Articles 14bis(2)(c) and 14bis(3) of the Berne Convention: Under Articles 14bis(2)(c) and 14bis(3) of the Berne Convention as incorporated into the TRIPS Agreement Members are required to make a notification in situations described in paragraph 5 above. Developed country Members, to which the notification obligations stemming from the incorporation of the provisions of these Articles into the TRIPS Agreement apply, should make necessary notifications as of 1 January 1996 and other Members as of the relevant date of application of Article 9.1 of the TRIPS Agreement for the Member in question. If a Member subsequently changes its legislation in a way that would require notification under these provisions, it should notify as of the time of the change.

17. Article 15(4) of the Berne Convention: The purpose of Article 15(4) of the Berne Convention is to facilitate benefitting from the protection available in other WTO Members. Therefore, it would be in the interest of a Member wishing to avail itself of the possibility stemming from the incorporation of the provisions of Article 15(4) of the Berne Convention into the TRIPS Agreement in relation to other WTO Members to notify the authority designated without delay, while being free to do so at any time.

18. The Appendix to the Berne Convention: Notification under Article I(1) of the Appendix may be deposited at the time of depositing the instrument of ratification or accession, or any time thereafter.

19. As far as the calculation of renewable periods of ten years is concerned (Article I(2) of the Appendix), this is a question that the Council would need to look into if any Member were to invoke any of the provisions of the Appendix as incorporated into the TRIPS Agreement. It would not seem necessary for the Council to come to a view on the matter at this point.

20. Other notifications stemming from the incorporation of the provisions of the Appendix into the TRIPS Agreement can be made at any time. The only exception in this regard is Article V(1) as incorporated into the TRIPS Agreement which requires that the choice provided in that paragraph has to be made at the time of ratification or accession.

21. Articles 17 and 18 of the Rome Convention: A notification under Article 17 of the Rome Convention has to be made at the time of ratification, acceptance or accession. A further

notification under Article 18 of the Rome Convention as incorporated into the TRIPS Agreement can be made at any time.

ANNEX 1

NOTIFICATIONS MADE UNDER THE NOTIFICATION PROVISIONS OF THE BERNE
CONVENTION AND ROME CONVENTION INCORPORATED BY REFERENCE INTO
THE TRIPS AGREEMENT BUT NOT EXPLICITLY REFERRED TO IN IT

Berne Convention

Article 14bis(2)(c)

PORTUGAL

The Director General of the World Intellectual Property Organization (WIPO) presents his compliments to the Minister for Foreign Affairs and, has the honor to inform him of the receipt, on November 5, 1986, of a declaration, dated November 3, 1986, of the Government of the Portuguese Republic, made pursuant to the provisions of paragraph 2(c) of Article 14bis of the Berne Convention for the Protection of Literary and Artistic Works of September 9, 1886, as revised at Paris on July 24, 1971 ("Paris Act (1971)") to the effect that the undertaking by authors to bring contributions to the making of a cinematographic work must be in a written agreement.

Article 14bis(3)

INDIA

The Director General of the World Intellectual Property Organization (WIPO) presents his compliments to the Minister for Foreign Affairs and has the honor to notify him that the Government of the Republic of India, referring to its ratification, with effect from January 10, 1975, of the Berne Convention for the Protection of Literary and Artistic Works of December 9, 1886, as revised at Paris on July 24 1971 ("Paris Act (1971)"), with the declaration that its ratification thereof does not apply to Articles 1 to 21 and the Appendix of the Paris Act (1971) (see BERNE Notification No. 59), deposited, on February 1, 1984, a declaration extending the effects of its ratification to the said Articles and the Appendix, subject to the following declarations:

1. With reference to Article 14bis of the Convention, the Government of India declares, in accordance with paragraph 3 of the said Article, that this ratification shall not apply to the provisions of Article 14bis, paragraph 2(b) thereof;

...

Article 15(4)

INDIA

The Director General of the World Intellectual Property Organization (WIPO) presents his compliments to the Minister for Foreign Affairs and has the honor to notify him that the Government of the Republic of India, referring to its ratification, with effect from January 10, 1975, of the Berne Convention for the Protection of Literary and Artistic Works of December 9, 1886, as revised at Paris on July 24 1971 ("Paris Act (1971)"), with the declaration that its ratification thereof does not apply to Articles 1 to 21 and the Appendix of the Paris Act

(1971) (see BERNE Notification No. 59), deposited, on February 1, 1984, a declaration extending the effects of its ratification to the said Articles and the Appendix, subject to the following declarations:

...

2. The Government of India declares and designates the Registrar of the Copyrights of India as a competent authority in terms of Article 15, paragraph 4(a) of the Convention;

...

Article I of the Appendix

THAILAND

The Director General of the World Intellectual Property Organization (WIPO) presents his compliments to the Minister for Foreign Affairs and has the honor to refer to the deposit by the Government of the Kingdom of Thailand, on September 29, 1980, of its instrument of accession to the Berne Convention for the Protection of Literary and Artistic Works of September 9, 1886, as revised at Paris on July 24, 1971 ("Paris Act (1971)"), and amended on September 28, 1979, which deposit was accompanied by a declaration that its accession did not apply to Articles 1 to 21 and the Appendix of the Paris Act (1971) (see BERNE Notification No. 101).

The Director General of WIPO has the honor to notify that the Government of the Kingdom of Thailand deposited, on May 23, 1995, a declaration extending the effects of the said accession to Articles 1 to 21 of the Paris Act (1971) and a notification declaring that the Government of the Kingdom of Thailand avails itself of the faculty provided for in Article II (Limitations on the Right of Translation) of the Appendix of the Paris Act (1971).

Articles 1 to 21 of the Paris Act (1971) will enter into force, with respect to the Kingdom of Thailand, on September 2, 1995.

As far as the relevant provisions of the Appendix are concerned, the said notification will be effective from September 2, 1995, to October 10, 2004, unless it is withdrawn earlier (see Article 1(2)(b) and (3) of the Appendix of the Paris Act (1971)).

Rome Convention

Article 17

DENMARK

...

- 4) *With regard to article 17:* Denmark will grant the protection provided for in article 5 only if the first fixation of the sound was made in another Contracting State (the criterion of fixation) and will apply for the purposes of paragraph 1 (a) (iii) and (iv) of article 16 the said criterion instead of the criterion of nationality.

FINLAND

...

6. *Article 17.* Finland will apply, for the purposes of article 5, the criterion of fixation alone and, for the purposes of article 16, paragraph 1 (a) (iv), the criterion of fixation instead of the criterion of nationality."

ITALY

...

(4) With regard to article 5 and in accordance with article 17 of the Convention, Italy will apply only the criterion of fixation for the purposes of article 5; the same criterion, instead of the criterion of nationality, will be applied for the purposes of the declarations provided for in article 16, paragraph I (a) (iii) and (iv), of the Convention.

SWEDEN

Notifications deposited with the instrument of ratification:

...

(e) With regard to article 17.

Withdrawal or amendment of the notifications deposited with the instrument of ratification:

With application of article 18 of the Convention, a notification notifying its withdrawal or amendment of the notifications deposited with the instrument of ratification on July 13, 1962, as follows:

...

3. The notification relating to article 17 is withdrawn in so far as reproduction of phonograms is concerned. Sweden will from July 1, 1986, grant protection according to article 10 of the Convention to all phonograms.

...

ANNEX 2

NOTIFICATION PROVISIONS OF THE BERNE CONVENTION AND THE ROME
CONVENTION INCORPORATED BY REFERENCE INTO THE TRIPS AGREEMENT,
BUT NOT EXPLICITLY REFERRED TO IN IT

Berne Convention

Article 14bis

(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.

(2)(a) Ownership of copyright in a cinematographic work shall be a matter for legislation in the country where protection is claimed.

(b) However, in the countries of the Union which, by legislation, include among the owners of copyright in a cinematographic work authors who have brought contributions to the making of the work, such authors, if they have undertaken to bring such contributions, may not, in the absence of any contrary or special stipulation, object to the reproduction, distribution, public performance, communication to the public by wire, broadcasting or any other communication to the public, or to the subtitling or dubbing of texts, of the work.

(c) The question whether or not the form of the undertaking referred to above should, for the application of the preceding subparagraph (b), be in a written agreement or a written act of the same effect shall be a matter for the legislation of the country where the maker of the cinematographic work has his headquarters or habitual residence. However, it shall be a matter for the legislation of the country of the Union where protection is claimed to provide that the said undertaking shall be in a written agreement or a written act of the same effect. The countries whose legislation so provides shall **notify** the Director General by means of a **written declaration**, which will be immediately communicated by him to all the other countries of the Union.

(d) By "contrary or special stipulation" is meant any restrictive condition which is relevant to the aforesaid undertaking.

(3) Unless the national legislation provides to the contrary, the provisions of paragraph (2)(b) above shall not be applicable to authors of scenarios, dialogues and musical works created for the making of the cinematographic work, or to the principal director thereof. However, those countries of the Union whose legislation does not contain rules providing for the application of the said paragraph (2)(b) to such director shall **notify** the Director General by means of a **written declaration**, which will be immediately communicated by him to all the other countries of the Union.

Article 15(4)

(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 I(1), (2), (5) of the Appendix

(1) Any country regarded as a developing country in conformity with the established practice of the General Assembly of the United Nations which ratifies or accedes to this Act, of which this Appendix forms an integral part, and which, having regard to its economic situation and its social or cultural needs, does not consider itself immediately in a position to make provision for the protection of all the rights as provided for in this Act, may, by a **notification** deposited with the Director General at the time of depositing its instrument of ratification or accession or, subject to Article V(1)(c), at any time thereafter, declare that it will avail itself of the faculty provided for in Article II, or of the faculty provided for in Article III, or of both of those faculties. It may, instead of availing itself of the faculty provided for in Article II, make a declaration according to Article V(1)(a).

(2)(a) Any declaration under paragraph (1) notified before the expiration of the period of ten years from the entry into force of Articles 1 to 21 and this Appendix according to Article 28(2) shall be effective until the expiration of the said period. Any such declaration may be renewed in whole or in part for periods of ten years each by a **notification** deposited with the Director General not more than fifteen months and not less than three months before the expiration of the ten-year period then running.

(b) Any declaration under paragraph (1) notified after the expiration of the period of ten years from the entry into force of Articles 1 to 21 and this Appendix according to Article 28(2) shall be effective until the expiration of the ten-year period then running. Any such **declaration** may be renewed as provided for in the second sentence of subparagraph (a).

(5) Any country which is bound by the provisions of this Act and which has deposited a declaration or a notification in accordance with Article 31(1) with respect to the application of this Act to a particular territory, the situation of which can be regarded as analogous to that of the countries referred to in paragraph (1), may, in respect of such territory, make the **declaration** referred to in paragraph (1) and the **notification** of renewal referred to in paragraph (2). As long as such **declaration or notification** remains in effect, the provisions of this Appendix shall be applicable to the territory in respect of which it was made.

Article II(3)(b) of the Appendix

(3)(b) Any country referred to in paragraph (1) may, with the unanimous agreement of the developed countries which are members of the Union and in which the same language is

in general use, substitute, in the case of translations into that language, for the period of three years referred to in paragraph (2)(a) a shorter period as determined by such agreement but not less than one year. However, the provisions of the foregoing sentence shall not apply where the language in question is English, French or Spanish. The Director General shall be **notified** of any such agreement by the Governments which have concluded it.

Article IV(2) of the Appendix

(2) If the owner of the right cannot be found, the applicant for a license shall send, by registered airmail, copies of his application, submitted to the authority competent to grant the license, to the publisher whose name appears on the work and to any national or international information center which may have been designated, in a **notification** to that effect deposited with the Director General, by the Government of the country in which the publisher is believed to have his principal place of business.

Article IV(4)(c)(iv) of the Appendix

(c) Where a government or other public entity of a country which has granted a license to make a translation under Article II into a language other than English, French or Spanish sends copies of a translation published under such license to another country, such sending of copies shall not, for the purposes of subparagraph (a), be considered to constitute export if all of the following conditions are met:

(iv) the country to which the copies have been sent has agreed with the country whose competent authority has granted the license to allow the receipt, or distribution, or both, and the Director General has been **notified** of the agreement by the Government of the country in which the license has been granted.

Article V of the Appendix

(1)(a) Any country entitled to make a declaration that it will avail itself of the faculty provided for in Article II may, instead, at the time of ratifying or acceding to this Act:

(i) if it is a country to which Article 30(2)(a) applies, make a **declaration** under that provision as far as the right of translation is concerned;

(ii) if it is a country to which Article 30(2)(a) does not apply, and even if it is not a country outside the Union, make a **declaration** as provided for in Article 30(2)(b), first sentence.

(b) In the case of a country which ceases to be regarded as a developing country as referred to in Article I(1), a declaration made according to this paragraph shall be effective until the date on which the period applicable under Article I(3) expires.

(c) Any country which has made a declaration according to this paragraph may not subsequently avail itself of the faculty provided for in Article II even if it withdraws the said declaration.

(2) Subject to paragraph (3), any country which has availed itself of the faculty provided for in Article II may not subsequently make a declaration according to paragraph (1).

(3) Any country which has ceased to be regarded as a developing country as referred to in Article I(1) may, not later than two years prior to the expiration of the period applicable under Article I(3), make a **declaration** to the effect provided for in Article 30(2)(b), first sentence, notwithstanding the fact that it is not a country outside the Union. Such **declaration** shall take effect at the date on which the period applicable under Article I(3) expires.

[Article 30(2)(b)]

(b) Any country outside the Union may declare, in acceding to this Convention and subject to Article V(2) of the Appendix, that it intends to substitute, temporarily at least, for Article 8 of this Act concerning the right of translation, the provisions of Article 5 of the Union Convention of 1886, as completed at Paris in 1896, on the clear understanding that the said provisions are applicable only to translations into a language in general use in the said country. Subject to Article I(6)(b) of the Appendix, any country has the right to apply, in relation to the right of translation of works whose country of origin is a country availing itself of such a reservation, a protection which is equivalent to the protection granted by the latter country.]

Rome Convention

Article 17

Any State which, on October 26, 1961, grants protection to producers of phonograms solely on the basis of the criterion of fixation may, by a **notification** deposited with the Secretary-General of the United Nations at the time of ratification, acceptance or accession, declare that it will apply, for the purposes of Article 5, the criterion of fixation alone and, for the purposes of paragraph 1(a)(iii) and (iv) of Article 16, the criterion of fixation instead of the criterion of nationality.

Article 18

Any State which has deposited a **notification** under paragraph 3 of Article 5, paragraph 2 of Article 6, paragraph 1 of Article 16 or Article 17, may, by a further notification deposited with the Secretary-General of the United Nations, reduce its scope or withdraw it.