

**PREPARATORY COMMITTEE
FOR THE
WORLD TRADE ORGANIZATION**

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**SUB-COMMITTEE ON INSTITUTIONAL,
PROCEDURAL AND LEGAL MATTERS**

INFORMAL CONTACT GROUP ON TRIPS

Report by the Chairman as approved by the Sub-Committee
on 18 November

Addendum

This addendum reproduces the informal note by the Secretariat of 19 July 1994, prepared for the Informal Contact Group on TRIPS, on the provisions of the TRIPS Agreement which lay down notification obligations for Members of the WTO. It also takes account of the addendum to that note of the same date.

TRIPS AGREEMENT: PROVISIONS ON NOTIFICATION

Note by the Secretariat

A. TRIPS Notification Obligations not Referring to Provisions of Other IP Conventions

1. Article 63.2: National laws and regulations pertaining to the availability, scope, acquisition, enforcement and prevention of the abuse of IPRs.
2. Article 4(d): International agreements relating to the protection of intellectual property which entered into force prior to the entry into force of the WTO Agreement, on the basis of which a Member seeks to justify an exception to m.f.n. treatment.
3. Article 69: Contact points in the administrations of Members established with a view to cooperation in the elimination of trade in infringing goods.

B. Notification Obligations Explicitly Mentioned in TRIPS and Referring to Provisions of Other IP Conventions

4. Article 1.3: Any Member making exceptions of the sort provided for in Articles 5(3) and 6(2) of the Rome Convention to the normal criteria for determining beneficiaries entitled to TRIPS treatment is required to make a notification as foreseen in those provisions to the TRIPS Council. (The text of the relevant provisions of the Rome Convention is reproduced in the Annex to this Note.)
5. Article 3.1: Any Member making exceptions to the requirement to give national treatment of the sort provided for in Article 6 of the Berne Convention or Article 16(1)(b) of the Rome Convention is required to make a notification as foreseen in those provisions to the TRIPS Council. (The texts of the relevant provisions of the Berne and Rome Conventions are reproduced in the Annex.)
6. Article 63.2: The TRIPS Council is required to consider, in connection with the consultations with WIPO on the establishment of a common register of laws and regulations, any action required regarding notifications pursuant to the obligations under the TRIPS Agreement stemming from the provisions of Article 6ter of the Paris Convention. Article 6ter concerns protection against the use or registration as trademarks, without authorization, of state emblems, official hallmarks and the emblems of intergovernmental organizations. (The text of the relevant provisions of Article 6ter of the Paris Convention is reproduced in the Annex.)

C. Other Notification Provisions of IP Conventions Incorporated by Reference into the TRIPS Agreement, but not Explicitly Referred to in TRIPS

7. Article 9.1: Article 9.1 of the TRIPS Agreement requires Members to comply with Article 14bis(2)(c) and Article 14bis(3) of the Berne Convention. These provisions deal with the situation where there is a presumption that authors who have contributed to the making of a cinematographic work have consented, in the absence of any contract to the contrary, to certain ways in which the film may be exploited. If a country's legislation requires that the consent of the authors must have been in writing, Article 14bis2(c) requires that country to

notify the Director General of WIPO. Article 14*bis*(3) of the Berne Convention requires that, if a country's law does not make the presumption binding on the principal director of the film, it must notify the Director General of the WIPO. (For full text of relevant Berne provision, see Annex.)

8. Article 9.1: Article 9.1 of the TRIPS Agreement requires Members to comply with Article 15(4) of the Berne Convention. This provision of the Berne Convention is directed at the protection of folklore. It deals with unpublished works where the identity of the author is unknown, but where there is ground to presume that he or she is a national of a Berne country (under TRIPS of a WTO Member). In such a situation, the country concerned may designate a competent authority to protect the interests of the author. The authority designated must be notified to the Director General of the WIPO giving full information.
9. Article 9.1: Article 9.1 of the TRIPS Agreement requires Members to comply with the Appendix to the Berne Convention, which contains special provisions for developing countries. The Appendix contains a number of notification procedures (for text of relevant provisions, see Annex):
 - Article I: Paragraph 1 requires a developing country wishing to avail itself of the possibilities provided for in Article II and/or Article III of the Appendix to deposit a notification or declaration with the Director General of WIPO at the time of ratification or accession, or at any time thereafter. Paragraph 2 deals with the duration of such notifications and the possibility to renew them. Paragraph 5 deals with the possibility for a country to make notifications in respect of territories for which it has international responsibility.
 - Article II(3)(b): This provision deals with the situation where a developing country secures the agreement of all developed countries in which a language is in general use 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 the Director General of WIPO shall be notified of any such agreement by the governments which have concluded it.
 - Article IV(2): 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 government of the country 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 deposited with the Director General of WIPO by the government concerned.
 - Article IV(4)(c)(iv): This provision allows developing countries 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 copies must be sent for teaching, scholarship or research purposes; there must be no commercial purpose; and there must be an agreement between the country granting the licence and that to which the copies are sent. The provision requires that such an agreement shall be notified to the Director General of WIPO.
 - Article V: This Article provides that, at the time of ratifying or acceding to the Paris Act of the Berne Convention, a developing country may choose, by way of a declaration,

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. Articles 1.3, 3.1 and 14.6: These provisions allow a TRIPS 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 deposited with the Secretary-General of the United Nations at the time of ratification, acceptance or accession. (For text of Article 17, see Annex.)

11. Articles 1.3, 3.1 and 14.6: These TRIPS provisions relate to exceptions under the Rome Convention. Article 18 of the Rome Convention provides that any state which has invoked certain of these exceptions by means of notifications under Articles 5(1), 6(2), 16(1) or 17 may, by a further notification deposited with the Secretary-General of the United Nations, reduce the scope of or withdraw the notification in question. (For text of relevant provision of Rome Convention, see Annex.)

ANNEX

PROVISIONS OF THE ROME, BERNE AND PARIS CONVENTIONS REFERRED TO

Rome Convention

Article 5

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

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 accept 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 16(1)(b) and (2)

1. Any State, upon becoming party to this Convention, shall be bound by all the obligations and shall enjoy all the benefits thereof. However, a State may at any time, in a **notification** deposited with the Secretary-General of the United Nations, declare that:

(b) as regards Article 13, it will not apply item (d) of that Article; if a Contracting State makes such a declaration, the other Contracting States shall not be obliged to grant the right referred to in Article 13, item (d), to broadcasting organisations whose headquarters are in that State.

2. If the **notification** referred to in paragraph 1 of this Article is made after the date of the deposit of the instrument of ratification, acceptance or accession, the declaration will become effective six months after it has been deposited.

[Article 13(d)]

Broadcasting organisations shall enjoy the right to authorise or prohibit:

(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 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.

Berne Convention

Article 6

(1) Where any country outside the Union fails to protect in an adequate manner the works of authors who are nationals of one of the countries of the Union, the latter country may restrict the protection given to the works of authors who are, at the date of the first publication thereof, nationals of the other country and are not habitually resident in one of the countries of the Union. If the country of first publication avails itself of this right, the other countries of the Union shall not be required to

grant to works thus subjected to special treatment a wider protection than that granted to them in the country of first publication.

(2) No restrictions introduced by virtue of the preceding paragraph shall affect the rights which an author may have acquired in respect of a work published in a country of the Union before such restrictions were put into force.

(3) The countries of the Union which restrict the grant of copyright in accordance with this Article shall give notice thereof to the Director General of the World Intellectual Property Organization (hereinafter designated as "the Director General") by a **written declaration** specifying the countries in regard to which protection is restricted, and the restrictions to which rights of authors who are nationals of those countries are subjected. The Director General shall immediately communicate this declaration to all the countries of the Union.

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)(a) and (b)]

(2)(a) Any country of the Union ratifying or acceding to this Act may, subject to Article V(2) of the Appendix, retain the benefit of the reservations it has previously formulated on condition that it makes a declaration to that effect at the time of the deposit of its instrument of ratification or accession.

(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.]

Paris Convention

Article 6ter(3)-(6)

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

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

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

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

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

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