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INTERNATIONAL UNIONS

Paris Convention**Ratification of Articles 1 to 12 of the Stockholm Act****FINLAND**

The Government of Finland, referring to the deposit made on June 8, 1970, and notified on June 15, 1970 (Paris Notification No. 22)¹, of its instrument of ratification of the Stockholm Act of July 14, 1967, of the Paris Convention for the Protection of Industrial Property of March 20, 1883, with a declaration to the effect that its ratification would not apply

¹ *Industrial Property*, 1970, p. 205.

to Articles 1 to 12, deposited, on July 17, 1975, a declaration by which it extends the effects of its ratification to the said Articles.

Pursuant to the provisions of Article 20(2)(c) and (3) of the Stockholm Act of the Paris Convention, Articles 13 to 30 entered into force with respect to Finland on September 15, 1970.

Pursuant to the provisions of Article 20(2)(c) of the said Act, Articles 1 to 12 will enter into force with respect to Finland on October 21, 1975.

Paris Notification No. 75, of July 21, 1975.

CONVENTIONS NOT ADMINISTERED BY WIPO

European Convention on the International Classification of Patents for Invention**Denunciation by Belgium**

In accordance with Article 8(2) of the European Convention mentioned above of December 19, 1954, the Belgian Government has denounced the said Convention. This denun-

ciation will take effect from the date on which the Strasbourg Agreement Concerning the International Patent Classification of March 24, 1971, enters into force for Belgium, namely July 4, 1976.

This denunciation, dated January 22, 1975, was transmitted by the Belgian Government to the Secretary General of the Council of Europe and registered at the Secretariat General of the Council of Europe on June 30, 1975.

covered by the protection in the case of accompanying material and preparatory material; acts by which software is transferred to other persons without authorization and use of the software by those persons — even where they do not know that the transfer was unauthorized — should also be included;

(iv) the protection should not be limited to strict identity but might also cover similarity, possibly taking into account the degree of creativity, if any, of the software protected;

(v) the protection should be granted only against acts resulting from access to the software; an exclusive right against independent creations should not be granted;

(vi) further study should be given to the question whether the doctrine of "fair use" should be applicable at all; in any case, even a single reproduction in a commercial product should not be considered "fair use";

(vii) the term of protection should be relatively short, taking into account the short period of actual economic importance of particular software; thus five to 20 years appeared to be sufficient; the starting date for protection would require further study;

(viii) the sanctions should include the possibility of an injunction and damages; penal sanctions could be provided for if they existed for copyright infringement;

(b) as regards the *registration of computer software*:

(i) the possibility of registration of software in an international register or in a scheme of internationally coordinated existing and future registers *for the purposes of mere dissemination of information* without any effects on legal protection was considered useful in order to facilitate access to information on computer software, in particular for the purposes of acquisition of such software by interested parties; however, the majority of the experts expressed the view that for the time being WIPO should deal with such a registration scheme only in so far as it served the purposes of legal protection, the dissemination of information being an important objective of such a protection system; it was furthermore agreed that this question required further study, in particular as regards the needs of developing countries;

(ii) a system should be established providing for optional deposit of software *for the purposes of legal protection*, reinforcing any existing national protection; the deposit should in particular have the advantage of constituting a presumption of access in case of identity or close similarity of the software deposited and the software used by another person; consideration could also be given to making deposit a condition for any legal proceedings; although usually the full text of a program with accompanying material should be deposited, no requirements concerning the subject-matter to be deposited should be made since this was self-regulatory: only the subject-matter which had been deposited would benefit from the advantages of the deposit; the technical modalities of the deposit (deposit of hard copies, magnetic tape or recording in the depositary's computer) would have to be further studied, taking into account technological developments; deposit should in any case not entail an examination as to substance; in principle, the deposited material should be

open to the public; however there should be the possibility of requesting that the deposited software, or part of it (e. g., the code), be kept secret, possibly by using a system of sealed cover; the term of secrecy was not resolved by the Advisory Group; suggestions ranged from one to 20 years; some experts proposed that it should be possible to maintain secrecy of at least the code during the period of protection; possibly the advantages of the deposit should not apply to those parts of the deposited software which had to be kept secret; the term of the deposit should be up to about 20 years, subdivided into maintenance periods of five years or shorter, and subject to the payment of maintenance fees; the possibility could also be considered of making the term of the protection referred to under (a) dependent on the maintenance of the deposit;

(c) as regards the *further action* to be taken, the International Bureau should prepare:

(i) model provisions for national laws on the protection of computer software following the principles of the special type of protection referred to above, with optional deposit carrying with it certain advantages for the depositor in the field of evidence; the provisions should contain alternatives for open and secret deposit;

(ii) draft treaty provisions providing for minimum protection according to the same principles on the international level; furthermore, provisions should be made in that treaty for the establishment of an international register and deposit system organized by the International Bureau; the use of such system would be optional and, where applicable, should give the said advantages and would replace any need for a deposit on the national level; the draft treaty should provide for the publication of abstracts (brief descriptions of the essence of the software), established by the depositor, useful for advertising the existence of the software and enabling reference thereto in any licensing contract.

List of Participants *

I. Non-Governmental Experts

American Bar Association (ABA): W. L. Keefauver; S. A. Diamond. Chartered Institute of Patent Agents (CIPA): G. H. R. Watson. Committee of National Institutes of Patent Agents (CNIPA): J. U. Neukom; J. E. Galama; D. W. F. Verkade. Council of European Industrial Federations (CEIF): W. Boekel. European Computer Manufacturers Association (ECMA): L. Perry. European Federation of Agents of Industry in Industrial Property (FEMIP): R. Gallois; W. White. European Industrial Research Management Association (EIRMA): M. Kindermann. International Association for the Protection of Industrial Property (AIPPI): W. E. Schuyler, Jr.; G. D. Kolle. International Chamber of Commerce (ICC): L. Perry. International Confederation of Societies of Authors and Composers (CISAC): A. Hirst. International Federation for Information Processing (IFIP): H. Bloom; M. L. B. Anderson (Mrs.); O. Smoot. International Federation of Automatic Control (IFAC): M. Cuénod. International Federation of Operational Research Societies (IFORS): H.-J. Zimmermann.

* A list containing the titles and functions of the participants may be obtained from the International Bureau.

International Federation of Patent Agents (FICPI): J.-F. Boissel; J. Lecca. International Group of Scientific, Technical and Medical Publishers (STM): U. Güntzer. International Law Association (ILA): E. Martin-Achard. International League Against Unfair Competition (LICCD): E. Martin-Achard. International Literary and Artistic Association (ALAI): J. Lecca. Pacific Industrial Property Association (PIPA): W. L. Keefauver. Union of European Professional Patent Representatives (UNION): G. Korsakoff. Union of Industries of the European Communities (UNICE): W. Boekel.

II. Governments

Canada: M. Gordon. Japan: K. Takami. Netherlands: J. Dekker. Soviet Union: Y. I. Plotnikov. United States of America: L. C. Hamilton; H. L. Oler (Mrs.).

III. Intergovernmental Organizations

United Nations (UN): T. J. King; H. Einhaus; R. G. Basten. United Nations Educational, Scientific and Cultural Organization (UNESCO): D. de San. Intergovernmental Bureau for Informatics (IBI): F. Piera.

IV. Officers

Chairman: W. E. Schuyler, Jr. (AIPPI); Secretary: L. Baeumer (WIPO).

V. WIPO

A. Bogsch (*Director General*); K. Pfanner (*Deputy Director General*); R. Harben (*Counsellor, Acting Head, External Relations Division*); L. Baeumer (*Counsellor, Head, Legislation and Regional Agreements Section, Industrial Property Division*); D. Devlin (*Legal Officer, Industrial Property Division*); P. Seipel (*Consultant*).

WIPO Permanent Legal-Technical Program

Working Group on the Model Law for Developing Countries on Inventions and Know-How

Second Session

(Geneva, May 26 to 30, 1975)

Note *

As a part of the WIPO Permanent Legal-Technical Program for the Acquisition by Developing Countries of Technology Related to Industrial Property, the Working Group on the Model Law for Developing Countries on Inventions and Know-How held its second session in Geneva from May 26 to 30, 1975.

At its first session, in November 1974, the Working Group had examined and discussed draft model provisions, which had been prepared by the International Bureau on contractual licenses, know-how, State control of license contracts, and the transfer of technology patent. These provisions had been designed to replace some of the provisions of the model

law for developing countries on inventions and know-how, published by BIRPI in 1965, or to supplement the BIRPI model law¹.

For its second session the Working Group consisted of 20 experts designated by the governments of their countries, but acting in a personal capacity, and of the Chairman of the WIPO Permanent Committee for the Acquisition by Developing Countries of Technology Related to Industrial Property, Mr. J. M. Rodríguez Padilla (Cuba), as recommended by the Permanent Committee during its second session (Geneva, March 17 to 21, 1975)². Three United Nations organizations and ten international non-governmental organizations were represented by observers. Mr. J. Alvarez Soberanis (Mexico) presided over the work of the Group. The list of participants follows this Note.

The Working Group examined and discussed in detail draft model provisions, which had been prepared by the International Bureau, on subjects which, in the BIRPI model law, come under chapters I (General Provisions), II (Right to Grant of Patent), IV (Rights Conferred by the Patent), V (Duration of Patent and Fees) and VIII (Compulsory Licenses).

The matters which were not dealt with during the first and second sessions of the Working Group will be discussed at the third session, which will take place in November 1975. Other sessions are scheduled for 1976.

List of Participants*

I. Experts

G. Albrechtskirchinger (Federal Republic of Germany); J. Alvarez Soberanis (Mexico); A. G. de Alencar (Brazil); A. R. B. Amerasinghe (Sri Lanka); A. M. Bolbol (Egypt); H. Bouhalila (Algeria); G. R. Clark (United States of America); J. Delicado Montero-Ríos (Spain); D. Ehongue Sone (Cameroon); E. A. Esteban (Argentina); E. Fischer (Federal Republic of Germany); M. Gabay (Israel); D. Januszkiewicz (Mrs.) (Poland); J. N. King' Arui (Kenya); L. Lebedeva (Mrs.) (Soviet Union); D. O. Lewis (United Kingdom); Y. Plasseraud (France); J. M. Rodríguez Padilla (Cuba); S. Sumodiredjo (Indonesia); Z. Szilvássy (Hungary); Tshinkela M. N. (Zaire).

II. Persons accompanying the experts

Elebe L. (Zaire); A. C. Ortéga Lechuga (Spain); G. Pusztai (Hungary); A. Zaitsev (Soviet Union).

III. Observers

Intergovernmental Organizations

United Nations (UN): H. Einhaus. United Nations Conference on Trade and Development (UNCTAD): S. Patel; P. Roffe. International Labour Office (ILO): R. Cuvillier (Mrs.).

International Non-Governmental Organizations

Council of European Industrial Federations (CEIF): G. Gansser. European Federation of Agents of Industrial Property (FEMIP): B. de Passemar. Inter-American Association of Industrial Property (ASIP): E. Aracama

¹ See *Industrial Property*, 1975, p. 49.

² See *Industrial Property*, 1975, p. 141.

* A list containing the titles and functions of the participants may be obtained from the International Bureau.

* This Note has been prepared by the International Bureau.

Zorraquín. Inter-American Bar Association (IABA): A. Ladrón de Guevara. International Association for the Protection of Industrial Property (AIPPI): H. Wichmann. International Chamber of Commerce (ICC): G. Gansser. International Federation of Inventors Associations (IFIA): H. Romanus. Licensing Executives Society (LES): F. Gevers. Pacific Industrial Property Association (PIPA): B. J. Kish. Union of Industries of the European Community (UNICE): G. Gansser.

IV. WIPO

A. Bogsch (*Director General*); K. Pfanner (*Deputy Director General*); R. Harhen (*Counsellor, Acting Head, External Relations Division*); L. Baeumer (*Counsellor, Head, Legislation and Regional Agreements Section, Industrial Property Division*); M. Porzio (*Counsellor, External Relations Division*); F. Curchod (*Legal Officer, General and Periodicals Section, Industrial Property Division*).

V. Chairman

J. Alvarez Soberanis (Mexico).

LEGISLATION

POLAND

Order of the President of the Patent Office on the Protection of Inventions and Utility Models

(of December 21, 1972)

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Chapter I

General Provisions

1. — For the purposes of this Order:

(i) "the Law" means the Law on Inventive Activity of October 19, 1972¹; when "Sections" are referred to in this Order without further specification the Sections of that Law are meant;

¹ *Industrial Property*, 1973, p. 296.

(ii) "the Decree" means the Decree of the Council of Ministers Concerning Invention Proposals of December 11, 1972²;

(iii) "the Office" means the Patent Office of the Polish People's Republic;

(iv) "the applicant" means the person who, on his own behalf, has filed with the Office an application for a patent or for a right to protection for a utility model;

(v) an "additional application" means an application for a patent or for a right to protection for a utility model containing a request for the issue of a patent of addition or of a certificate of additional protection for a utility model;

(vi) a "patent" means, unless otherwise specified, a patent, a patent of addition, a provisional patent or a provisional patent of addition;

(vii) "anteriority" means anteriority in the acquisition of a patent or of a certificate of protection for a utility model;

(viii) "priority" means priority in the acquisition of a patent or of a certificate of protection for a utility model resulting from the filing of an application abroad or the exhibiting of an invention or a utility model at a public exhibition in Poland or abroad constituting grounds for the recognition of a right of priority;

(ix) "the prior art" means everything which had been made public before the date on which anteriority in the acquisition of a patent or of a certificate of protection for a utility model was recognized;

(x) "the Paris Convention" means the Paris Convention for the Protection of Industrial Property of March 20, 1883, which is binding upon the Polish People's Republic.

² *Industrial Property*, 1975, p. 203.

2. — The official language for proceedings before the Office shall be Polish.

Chapter 2

Filing of Patent Applications

3. — (1) An application for a patent shall comprise:

- (i) a request;
- (ii) a description of the invention;
- (iii) a claim or claims;
- (iv) drawings, if necessary for the understanding of the invention.

(2) The application for a patent must also include:

- (i) an abstract of the description;
- (ii) a declaration or declarations on the part of the inventor(s) containing the particulars specified in Article 1 of the Annex to the Decree;

(iii) a certificate of priority, if the applicant claims priority, consisting of the documents listed in Article 2 of the Annex to the Decree;

(iv) where the applicant enjoys priorities recognized as commencing on more than one date, a declaration on the part of the applicant indicating the date of the priority he reserves for each of the claims contained in the application ("declaration on priority dates") made out in accordance with the requirements of Article 3 of the Annex to the Decree;

(v) a document attesting the applicant's right to priority if the certificate of priority is not made out in the applicant's name, containing the particulars specified in Article 4 of the Annex to the Decree;

(vi) a document attesting the assignment of the right to the patent if the applicant is not the inventor or the person entitled to the patent according to the Law, containing the particulars specified in Article 5 of the Annex to the Decree;

(vii) a power of attorney, if the applicant acts through the intermediary of an agent, containing the particulars specified in Article 6 of the Annex to the Decree.

(3) The documents referred to in paragraph (2), subparagraphs (iii) to (v), may also be deposited later, within a period of four months from the date of the filing of the application with the Office. Failure to deposit any one of these documents within the stipulated time limit shall be regarded as withdrawal of the declaration of priority.

4. — (1) The request shall include:

(i) the applicant's given name and family name, or designation, and his address;

(ii) a petition for the grant of a provisional patent or of a patent;

(iii) the title of the invention;

(iv) the inventor's given name and family name and address, if the applicant is not the inventor;

(v) an indication of entitlement to the patent, if the applicant is not the inventor;

(vi) a check-list of the accompanying documents;

(vii) the signature of the applicant or of his agent, if the applicant is acting through an agent, with the given name and family name, or designation, and address of the agent.

(2) The request must also include:

(i) a petition for the grant of a patent of addition, if the applicant desires the grant of such a patent; in this case, the petition should also indicate the number of the principal patent or the number of the application;

(ii) a declaration by the applicant to the effect that he claims priority, if he so claims, indicating the date and country of the application filed abroad and, if possible, the number of the application, or the name, place and country of the exhibition and the date on which the invention was exhibited;

(iii) where there are several applicants who are not acting through a joint agent, the name or designation and address of the joint representative appointed to receive communications.

5. — (1) The description of the invention (hereinafter called "the description") shall describe the invention in a manner sufficiently clear and detailed for a person skilled in the art to be able to carry out the invention.

(2) The description shall:

(i) first state the title of the invention;

(ii) specify the technical field to which the invention relates;

(iii) indicate the prior art, as known to the applicant, useful for understanding the invention, in particular, its novelty and lack of obviousness; in order to facilitate a search into the prior art relating to the invention and for the purposes of the examination of the invention in question, it is advisable for this part of the description to include bibliographical data concerning publications relating to the prior art;

(iv) explain the precise nature of the invention, in accordance with the patent claims, in such a way that the problem, even if it is not clearly formulated as such, and its technical solution can be understood, and state the advantageous effects, if any, of the invention with reference to the prior art;

(v) briefly explain the figures in the drawings, if any;

(vi) set forth at least one method of carrying out the invention in the form of an example or examples, referring to the drawings, if any;

(vii) indicate clearly how the invention can be applied, if this is not obvious from the description or nature of the invention.

(3) The provisions of paragraph (2) apply *mutatis mutandis* to the description in an additional application; however, the part of the description referred to in paragraph (2), subparagraph (iii), shall describe the invention which is the subject of the principal patent, even if that invention does not belong to the prior art, and state the number of the principal patent.

(4) It is recommended that each of the parts of the description referred to in paragraph (2), subparagraphs (ii) to (vii), be given an appropriate subtitle.

6. — (1) The patent claims, hereinafter called “the claims,” shall define the invention claimed by stating its technical features. The claims shall not mention features which the invention does not possess. Nor shall they include expressions containing value judgments concerning the invention or its individual features.

(2) Each claim shall be stated in a single sentence, clearly and concisely worded.

(3) The claims must be fully supported by the description.

(4) The number of claims shall be reasonable in relation to the invention claimed. If there are several claims, they shall be numbered consecutively in arabic numerals.

(5) Independent claims shall contain:

(i) a non-characterizing portion indicating all the technical features of the invention claimed which are essential for defining the subject-matter of the protection applied for, but which all belong to the prior art; this part of the claim shall begin with the title of the claim, or with that part of the title of the claim which applies to the invention referred to in the claim in question, and, where this is justified, may consist merely of the title of the invention or of the relevant part of the title;

(ii) a characterizing portion, concisely indicating the technical features (characterizing features) of the invention claimed which distinguish it from other technical solutions having all the technical features referred to in the non-characterizing portion.

(6) The provisions of paragraph (5) shall apply *mutatis mutandis* to an independent claim in an additional application; however, the non-characterizing portion of an independent claim shall indicate all the technical features which are essential for defining the subject-matter of the protection applied for and which are, at the same time, all the technical features of the invention protected by the principal patent, even if the invention does not belong to the prior art; it shall also give the number of the principal patent, preceded by the words: “In accordance with patent No. . . .”.

(7) (a) A dependent claim may also include technical features mentioned in another claim or claims of the same application and not given in this dependent claim. Such claims shall contain:

(i) at the beginning, a brief designation of the subject-matter of the claim, constituting the abridged title or the abridged relevant part of the title of the invention;

(ii) a reference to the claim or claims on which it is dependent, giving the number or numbers of the claim or claims referred to;

(iii) a characterizing portion preceded by the words “characterized in that,” giving the characterizing features additionally claimed in the dependent claim in question.

(b) The claim referred to in subparagraph (a) may only be dependent on two or more other claims (multiple dependent claims) in the alternative. In this case, the part of the dependent claim referred to in subparagraph (a)(ii) shall contain the word “or” between the numbers of the claims. A multiple dependent claim cannot be referred to in another multiple dependent claim.

(c) The dependence of a claim on one other claim means that the dependent claim contains all the features of the subject-matter of the claim on which it is dependent, as well as its own characterizing features.

(d) The dependence of a claim on several other claims means that the dependent claim contains all the features of the subject-matter of the claims on which it is dependent and in relation to which it is examined, as well as its own characterizing features. A multiple dependent claim shall be examined separately in relation to each of the claims on which it is dependent.

(8) (a) Except where necessary, claims shall not contain expressions referring to the description or drawings. In particular, they shall not contain such references as: “as described in part . . . of the description” or “as illustrated in figure . . . of the drawings.”

(b) Where the application contains a drawing, the characterizing features mentioned in the claims shall be followed by a reference to the individual parts of the drawing which correspond to the features in question; such references shall be placed in brackets and underlined. If the inclusion of such references in the claims does not evidently render the claims easier to understand, it is not necessary to include them.

(9) If the applicant requests the recognition of priorities effective from more than one date (see Section 12 (4) to (6) of this Order), the content of the claims, and, if the application contains dependent claims, the arrangement of their dependences, shall be such that, in accordance with paragraphs (1) to (7), only one date of priority corresponds to each of the claims.

7. — (1) The drawings shall present the subject-matter of the invention schematically.

(2) If the nature of the invention permits it to be represented by means of drawings, but these are not indispensable to the understanding of the invention:

(i) the applicant may include drawings with the application; and

(ii) the Office may order the applicant to supply drawings within a given time limit.

(3) Subject to the provisions of Section 8(2)(ii) and (3), (5) and (6) of this Order, chemical structural formulae are regarded as drawings; whenever, in subsequent provisions, there is reference to figures, this must be understood as covering also individual chemical structural formulae.

8. — (1) The abstract of the description, hereinafter called “the abstract,” is exclusively for purposes of information to facilitate searches concerning the prior art and, in particular, to give interested persons a general idea enabling

them to decide whether they need to see the description, the claims and the drawings in the application and, after the granting of a patent, the description of the patent.

(2) The abstract shall include:

(i) a summary of the most important particulars contained in the description, claims and drawings; this summary should specify the technical field to which the invention relates, and should clearly state the problem, the precise nature of the technical solution which constitutes the invention, and the principal application or applications of the invention;

(ii) if the nature of the invention so requires, the chemical formula which, among all the formulae contained in the application, best characterizes the invention; if this is a structural formula, it should be drawn on a separate sheet annexed to the abstract. Where this is justified, more than one structural formula may be indicated.

(3) The abstract shall give the number of the figure of the drawings which, among all the figures included in the application, best portrays the invention. Where this is justified, more than one figure of the drawings may be indicated.

(4) The abstract shall be concise. It is recommended that it should not contain more than 120 words. The abstract shall not include statements concerning the advantages or value of the invention or information or forecasts concerning its application at any specific time or place or by any specific person.

(5) Each of the principal technical features of the invention mentioned in the abstract and illustrated by a figure of the drawings shall be followed by a reference, in brackets, to the figure in question. In the cases referred to in paragraph (6), this reference may be changed or deleted by the Office.

(6) If the applicant has not fulfilled the requirements referred to in paragraph (3), or if the Office considers that another figure or figures among those in the drawings contained in the application describe the invention better than the figure or figures indicated by the applicant, or if the Office considers that the applicant has indicated too many figures, the Office may itself select the figure or figures to be published or — where this is justified by the nature of the invention — it shall publish the abstract without figures. This provision does not apply to structural chemical formulae.

9. — The terminology and designations used shall be consistent throughout the application and in accordance with the relevant obligatory provisions and with generally accepted practice.

10. — (1) All parts of the application shall be submitted in one copy, except for the abstract, which shall be submitted in duplicate, and the description, claims and drawings, which shall be submitted in triplicate.

(2) The description, claims, abstract and drawings shall be signed by the applicant or by his agent. Where the ap-

plicant is a unit of the socialized sector, it is advisable for these documents to be signed also by a patent agent, unless such an agent is acting as the applicant's agent.

(3) All parts of the application shall conform to the formal requirements laid down in Article 8 of the Annex to the Decree.

Chapter 3

Unity of Invention

11. — (1) An application shall relate to one invention only.

(2) An application may, however, relate to more than one invention provided that such inventions are linked in the application by a clearly discernible common inventive idea. In particular, either of the following possibilities is permissible:

(i) the inclusion in the application, in addition to an independent claim relating to a given product, of one independent claim for one process specially adapted for the manufacture of the said product, or

(ii) the inclusion in the application, in addition to an independent claim for a given process, of one independent claim for one apparatus or means specifically designed for carrying out the said process.

(3) Subject to the provisions of paragraphs (1) and (2), it is permissible to include in the same application two or more independent claims of the same category (i. e., product, process or apparatus), which cannot readily be covered by a single generic claim.

(4) Subject to the provisions of paragraphs (1) and (2), it is permissible to include in the same application a number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention.

Chapter 4

Priority

12. — (1) In the case of an application filed abroad, priority results from the first regularly filed application for the protection of an invention or a utility model in a country party to the Paris Convention. Priority covers also those features of an invention which, although not mentioned in the claims, are clearly disclosed in the patent application.

(2) A regularly filed application within the meaning of paragraph (1) is an application such that at least the filing date can be ascertained. The subsequent fate of this application filed in a given country has no effect on the priority resulting from the application.

(3) If, in one and the same country (paragraph (1)), in addition to the first application, a subsequent application concerning the same subject-matter has been filed, the subsequent application shall be considered as the first application within the meaning of paragraph (1) if, at the time of filing the sub-

sequent application, the previous first application had been withdrawn, abandoned or refused, without being disclosed to the public and without leaving any rights outstanding, and if it had not yet served as a basis for claiming priority. The previous application may not thereafter serve as a basis for claiming priority.

(4) In a patent application filed with the Office, it is permissible to claim priority resulting from two or more first applications filed abroad (multiple priority).

(5) In a patent application filed with the Office, it is permissible to claim priority resulting from a first application filed abroad relating only to certain parts of the application filed with the Office (partial priority). In this case, priority for the other parts of the subject-matter of the application is determined from the date of filing with the Office.

(6) Multiple priority and partial priority may be claimed simultaneously in a patent application filed with the Office.

13. — In a patent application filed with the Office, it is permissible to claim priority resulting from the display of an invention or a utility model at a public exhibition organized in Poland, as defined in the Order of the President of the Patent Office (Section 24(2)), or at an official international exhibition organized in a State party to the Paris Convention.

Chapter 5

Filing of Applications for the Protection of Utility Models

14. — Subject to the provisions of paragraphs (2) to (4) below, the provisions of Sections 3 to 10 of this Order shall apply *mutatis mutandis* to applications for the protection of utility models. —

(2) Descriptions of utility models shall, instead of describing a mode of execution by way of example, include a detailed description of the utility model for which protection is sought.

(3) Applications for the protection of utility models shall contain a drawing or drawings of the utility model.

(4) Applications for the protection of utility models shall relate to one utility model only.

Chapter 6

Examination of Patent Applications

15. — (1) During the course of the procedure, the Office may impose on the applicant time limits which may not exceed:

(i) two months if the applicant has his domicile or principal place of business in Poland;

(ii) three months, if the applicant has his domicile or principal place of business in a European country; and

(iii) four months, if the applicant has his domicile or principal place of business in a non-European country.

(2) If, before the expiry of the prescribed time limit, the applicant submits a duly reasoned request for the extension of the time limit, the Office may extend it once only for not more than two months.

16. — (1) The Office shall send all communications to the address indicated by the applicant.

(2) If the applicant is acting through an agent, the Office shall send communications to the address of the agent.

(3) Where there are several applicants who are not acting through a joint agent, the Office shall send communications to the address of a joint representative authorized to receive the said communications. Where a joint representative has not been designated, the applicant named first in the application shall be deemed to be such a representative. The delivery of a communication to the joint representative shall have the same legal effect as delivery of the communication to all the applicants.

(4) The persons referred to in paragraphs (1) to (3) shall notify the Office of any change of address. In the event of failure to do so, the delivery of a communication to the previous address shall have legal effect.

17. — (1) On receipt of a patent application, the Office shall note the filing date of the application and assign it a serial number and shall notify them to the applicant.

(2) An application shall be deemed to have been filed at the time when it was filed with the Office or handed in at a Polish post office for dispatch to the Patent Office.

(3) If an application has been handed in at a Polish post office and it is not possible to determine the date of posting, the filing date is taken to be the date on which the application was received by the Office.

18. — (1) At the applicant's request, the Office shall issue a certificate that the patent application has been filed with the Office (certificate of priority) for the purposes of claiming priority abroad.

(2) The Office shall issue a certificate of priority if, at the time of filing, the application contained a petition and at least one of the documents listed in Section 3(1)(ii) to (iv) of this Order.

(3) A certificate of priority shall consist of an attestation by the Office containing the given name and family name or designation of the applicant, the title of the invention, the filing date and number of the invention and copies of the documents, amongst those referred to in Section 3(1)(ii) to (iv) of this Order, which the applicant had annexed to the petition when filing his application. The Office shall certify the conformity of these copies with the original.

19. — During the preliminary examination, the Office shall, within the limits laid down in Section 33(1), verify whether the patent application fulfills the legal requirements for the acquisition of a patent. The provisions of Section 30 (2), (3) (i), (ii), (iv) and (v) and (4) and (5) and Section 31 (i) to (iv) and (vi) of this Order shall apply *mutatis mutandis*.

20. — (1) If the Office finds that any of the requirements for the filing of a patent application prescribed in Section 3(1)(i) to (iv) of this Order has not been fulfilled, it shall issue a decision rejecting the application. In this case, the fee paid when the application was filed shall be refunded. However, if the missing documents have been submitted before such a decision is taken, the Office shall issue an order to the effect that the date on which the last of the missing documents was filed shall be recognized as the filing date of the application for a patent. Such orders shall be subject to appeal.

(2) If the Office finds that the abstract is missing, it shall invite the applicant to remedy that defect within a prescribed time limit. If the applicant fails to produce the abstract within the prescribed time limit, the Office shall establish the abstract at the applicant's expense, charging a fee for so doing.

(3) If the Office finds that the fee for the filing of the application has not been paid, it shall invite the applicant to remedy this defect within one month. During this period, the applicant may submit a request for exemption from the fee in whole or in part. If the fee is not paid and no request for exemption is submitted, the patent application shall be regarded as having been withdrawn and the procedure shall be discontinued.

21. — (1) If the Office finds that the declaration of the inventor (Section 3(2)(ii) of this Order) is lacking, it shall inform the applicant and the inventor of the fact, fixing for the latter a time limit for the production of the declaration. Failure to produce the document within the time limit prescribed shall be regarded as amounting to the renunciation on the part of the inventor of the right to an inventor's certificate and of the right to be mentioned in the descriptions, registers and other documents and publications issued by the Office.

(2) If the applicant is a foreign national or a foreign legal entity, paragraph (1) shall apply if the applicant or the inventor has submitted a request for the issue of an inventor's certificate. Such a request may only be submitted before a decision is taken on the granting of a patent. If such a request is not submitted and in the absence of an inventor's declaration (Section 3(2)(ii) of this Order), the inventor shall be regarded as having waived the right to be mentioned in the descriptions, registers and other documents and publications issued by the Office.

(3) If the Office finds that the documents referred to in Section 3(2)(iii) to (v) of this Order have not been submitted within four months from the filing date of the invention with the Office, it shall regard the declaration of priority as having been withdrawn and make an order on the matter. Such order is subject to appeal.

(4) If the Office finds that the document attesting the assignment of the right to a patent is missing, it shall inform the applicant thereof, fixing a time limit within which the document shall be produced. If the applicant does not produce

the document within the prescribed time limit, the application shall be regarded as having been withdrawn and the procedure shall be discontinued.

(5) If, in a case where the application for a patent has been filed through the intermediary of an agent, the Office finds that the power of attorney is missing, it shall inform the person claiming to be the agent thereof and fix a time limit within which he shall produce the document. If the person in question fails to produce the power of attorney within the prescribed time limit, the application shall be regarded as having been withdrawn and the procedure shall be discontinued.

22. — (1) If the Office finds that the patent application infringes the provisions concerning unity of invention, it shall fix a time limit within which the applicant must file the separate applications contained in the initial application and pay the corresponding fees. Orders on this matter are subject to appeal. The fee paid in connection with the initial application shall be regarded as the fee for the application relating to the invention named first in the claims.

(2) If the applicant fails to file the separate patent applications in the time limit fixed, or fails to pay the relevant fees, the application shall be regarded as relating to the invention named first in the claims. In this case, the part of the application relating to the other inventions shall be regarded as having been withdrawn and the procedure shall be discontinued.

(3) The applicant may file separate patent applications contained in the initial application and pay the relevant fees without being invited to do so by the Office.

(4) In the case referred to in paragraph (3), the subsequent applications shall be regarded as having been filed on the filing date of the first application, if they were produced before the publication of the first application. Where the first application infringes the provisions concerning unity of invention, the Office shall give the separate applications the filing date of the first application, even if they have been filed after its publication. Orders refusing recognition of the initial filing date are subject to appeal.

23. — (1) The Office may order the applicant to produce models or samples within a fixed time limit, if it considers that they would appreciably facilitate the understanding of an invention. Such orders are subject to appeal.

(2) If the applicant fails to produce models or samples within the time limit fixed, the application shall be regarded as having been withdrawn and the procedure shall be discontinued.

(3) The dimensions of models and samples shall not exceed 50 cm x 50 cm x 50 cm. Models and samples shall be of durable construction.

(4) Models and samples shall be destroyed after use unless, when supplying them, the applicant indicates that he wishes them to be returned.

24. — (1) If, during its examination of an application, the Office finds omissions or significant defects other than those referred to in Sections 21 and 22 of this Order, it shall act in accordance with Section 29 of this Order.

(2) The fact that the Office has found the omissions or defects referred to in paragraph (1) and in Sections 21 and 22 of this Order shall not prevent publication of the filing of a patent application.

25. — During the preliminary examination, the Office shall issue a decision refusing the granting of a patent if it finds:

(i) that the application does not relate to a technical solution;

(ii) that the invention in question is not eligible for protection;

(iii) that the invention in question is incapable of application; or

(iv) that the invention obviously lacks novelty.

26. — (1) Where the applicant requests a provisional patent, the Office, after conducting the preliminary examination, shall publish the patent application as soon as nine months have elapsed after the filing date or eighteen months after the anteriority date, whichever is earlier. The applicant, however, in his petition, or within six months of the filing date, may request publication at an earlier date.

(2) Where the applicant requests a patent, the Office, after conducting the preliminary examination, shall publish the application as soon as eighteen months have elapsed from the anteriority date. The applicant, however, in his petition or within twelve months of the anteriority date, may request publication at an earlier date.

(3) The Office shall inform the applicant that this patent application has been published.

(4) The Office shall publish applications by inserting the following particulars in the Patent Office Gazette:

(i) the class and subclass of the patent according to the national and the international patent classification;

(ii) the number of the application;

(iii) the filing date;

(iv) the date and country of priority and the filing date of the application abroad or the name of the exhibition;

(v) the applicant's given name and family name or designation;

(vi) the applicant's domicile or principal place of business and country;

(vii) the inventor's given name and family name;

(viii) the title of the invention;

(ix) the abstract of the description and, where necessary, a figure from the drawings;

(x) the number of claims.

(5) The date of publication of a patent application is the date on which the particulars listed in paragraph (4) were published in the Patent Office Gazette.

27. — (1) Subject to the provisions of paragraph (2), the provisions of Sections 30(2) to (5) and 31 and 32 of this Order shall apply *mutatis mutandis* to the procedure followed during a limited examination.

(2) The Office shall conduct the limited examination within the limits defined in Section 34(1).

28. — (1) The Office may order a complete examination of a patent application either of its own motion or on submission of a request for such an examination in the cases defined in Sections 26(3), 35(1), 53(5) and 77(2), and Section 13 (3) of the Decree. After the granting of a provisional patent, a complete examination shall be conducted on the basis of the description of the patent.

(2) Where a complete examination conducted by the Office concerns an application for a patent of addition or an invention which is the subject-matter of a provisional patent of addition, the Office shall order a complete examination, at the applicant's expense, of the invention which is the subject-matter of the principal provisional patent or of the application for the principal provisional patent.

29. — The Office shall make an order refusing recognition of priority in whole or in part if it finds that:

(i) the applicant is not entitled to priority, or

(ii) the application filed abroad on which the applicant bases his claim to priority is not the first application within the meaning of Section 12 (1) to (3) of this Order, or

(iii) the exhibition, display at which is the basis of the applicant's claim to priority, does not fulfill the requirements laid down in Section 13 of this Order, or

(iv) the subject-matter of the application filed with the Office or the relevant part of that subject-matter, differs from the subject-matter of the application for which the applicant is entitled to priority.

Such orders shall be subject to appeal.

30. — (1) During a complete examination, the Office shall examine whether the legal requirements for the acquisition of a patent have been fulfilled. The provisions of Section 22 of this Order shall apply *mutatis mutandis*.

(2) The Office may invite the applicant to express his views, within a fixed time limit, on the results of the search into the prior art, the examination of the invention filed and of other points which, in the light of the application, may give rise to doubt as to whether the legal requirements for the acquisition of a patent have been fulfilled. Failure by the applicant to express his views within the time limit fixed shall be regarded as withdrawal of the application and the procedure shall be discontinued.

(3) After conducting the examination:

(i) the Office shall not recognize the subject-matter of an application as an invention if it finds that it is not a solution of a technical character;

(ii) the Office shall declare a filed invention to be lacking in novelty if it can confront the applicant with a do-

cument or other evidence which shows the invention to be lacking in novelty within the meaning of Section 11;

(iii) the Office shall declare a filed invention to be an obvious solution if, in the light of the prior art as set forth in one or, jointly, in several documents, or of other evidence which can be shown to the applicant, the solution appears obvious to a person familiar with the technical field in question;

(iv) the Office shall declare a filed invention as incapable of practical application if products cannot be manufactured in accordance with the invention or the technical process cannot be used in accordance with the invention;

(v) the Office shall declare a filed invention as being ineligible for protection if it finds that it is unpatentable under Section 12.

(4) The provisions of paragraph (3)(i) to (v) shall apply *mutatis mutandis* if the failure to fulfill the legal requirements for the acquisition of a patent affects only part of the subject-matter covered by the protection applied for and defined in the claims, and, although he has been informed of this by the Office, the applicant fails to limit the subject-matter covered by the protection applied for within the prescribed time limit.

(5) The Office shall invite the applicant to submit, within a fixed time limit, his comments in writing on objections concerning failure to fulfill the legal requirements for the acquisition of a patent. Failure to submit such comments within the time limit fixed shall be regarded as withdrawal of the application, and the procedure shall be discontinued.

31. — After conducting a complete examination, the Office shall issue a decision refusing to grant a patent, if it finds that:

(i) the application does not relate to a solution of a technical character; or

(ii) the invention filed is not eligible for protection; or

(iii) the invention filed is incapable of practical application; or

(iv) the invention filed is not new; or

(v) the invention filed follows obviously from the prior art for a person skilled in the art; or

(vi) the applicant is not entitled to the patent; or

(vii) a patent has been granted to a patentee with anteriority.

32. — If the Office does not find any failure to fulfill the legal requirements for the acquisition of a patent, it shall issue a decision granting a patent, provided that the prescribed periodic or lump-sum fee has been paid, or without this condition, if the applicant has been exempted from the payment of a fee under Section 75(2) of the Decree.

33. — (1) If, after conducting a complete examination of an application for a provisional patent under Section 34(3), the Office finds a failure to fulfill the legal requirements for the acquisition of a patent (Section 31(i) to (vii) of this Order), it shall issue a decision refusing the granting of a provisional patent.

(2) If, having granted a provisional patent, the Office finds, after conducting a complete examination to be carried out in the cases referred to in Sections 26(3), 34(3) and 53(5) or Section 13(3) of the Decree, that the legal requirements for the acquisition of a patent have not been fulfilled, it shall revoke the decision granting a provisional patent.

(3) If, having granted a provisional patent, the Office, after conducting the complete examination to be carried out in the cases referred to in Sections 34(3) and 53(5) or Section 13(3) of the Decree, finds it necessary to limit the extent of protection, it shall revoke the decision granting a provisional patent and issue a new decision granting a provisional patent.

(4) If, having granted a provisional patent, the Office, after conducting the complete examination to be carried out in the cases referred to in Sections 34(3) and 53(5) or Section 13(5) of the Decree, does not find any failure to fulfill the legal requirements for the acquisition of a patent, it shall make an order based on this finding.

34. — If, after conducting the complete examination prescribed in the cases referred to in Section 77(2), the Office finds that the legal requirements for the acquisition of a patent have not been fulfilled, it shall issue a decision refusing the granting of a patent, and if it finds no failure to fulfill those requirements, it shall make the necessary formal corrections to the description contained in the application for protection of a utility model and shall issue a decision granting a patent, at the same time revoking the decision granting a right to protection for a utility model. The provisions of Section 32 of this Order shall apply *mutatis mutandis*.

Chapter 7

Examination of Applications for the Protection of Utility Models

35. — The provisions of Sections 15 to 28 of this Order, with the exception of Section 26(2), shall apply *mutatis mutandis* to the examination of applications for the protection of utility models.

36. — Where the owner of a patent submits a petition of the kind mentioned in Section 77(1), the Office shall check whether the patented invention has also the characteristics of a utility model, after which it shall make the necessary formal corrections to the description contained in the application for a patent and shall issue a decision granting the right to the protection for a utility model, at the same time revoking the decision granting a patent.

Chapter 8

Granting and Restoration of Protection

37. — Having verified that the prescribed periodic or lump-sum fee has been paid within the time limit or that the patentee is exempt from such payment, the Office shall record the granting of the patent in the register and publish the patent description.

38. — (1) The Office shall invite the applicant or the patentee to pay the fee for the publication of the description within a prescribed time limit. Once the fee has been paid, the Office shall issue a patent document to the patentee.

(2) However, the Office shall not issue the patent document unless the fee for the preparation of the revised abstract has been paid.

39. — Subject to the provisions of Section 14(3), the Office shall issue an inventor's certificate to the inventor at the same time as the patent document, except in the cases referred to in Section 21(1) of this Order, and except where the inventor has waived his right to an inventor's certificate.

40. — The provisions of Sections 37 to 39 of this Order shall apply *mutatis mutandis* to the grant of a right to protection for a utility model.

41. — The Office shall issue a decision setting the time limit afresh for the payment of a periodic fee for the protection of an invention or a utility model and restoring the protection of the invention or utility model after the expiry of two months from the date of the announcement in the Patent Office Gazette of the submission of a request for the restoration of that time limit, if it recognizes that the petitioner has established that, without fault on his part, he could not observe the time limit for making the payment in question.

42. — The Office shall record the fact of the setting afresh of the time limit referred to in Section 38 of this Order, and the restoration of protection for an invention or a utility model, and also any refusal to set the said time limit afresh, in the patent register and shall make an announcement thereof in the Patent Office Gazette.

Chapter 9 Registers

43. — The Office shall keep a register of patents and a register of rights to protection of utility models in which it shall make the entries prescribed by the Law.

44. — The patent register kept by the Office shall consist of a public and a secret part. Entries relating to patents for public inventions shall be made in the public part, and entries relating to patents for secret inventions shall be made in the secret part.

45. — (1) Entries in the patent register shall be made pursuant to orders concerning the making of entries in the patent register.

(2) The Office shall check whether the documents submitted as justification for the making of an order concerning an entry in the patent register comply with the provisions in force.

(3) Where the grant of a patent is entered in the patent register that patent shall be given a serial registration number.

(4) When an entry is made in the patent register, the grounds for the entry shall be stated.

(5) The individual entries made under a given heading shall be numbered serially and shall be separated one from another by a horizontal line.

(6) Changes or cancellations of entries shall be inserted under a new serial number under the same heading as that under which the changed or cancelled entry was made.

(7) Previous entries which have been changed or cancelled shall be underlined in red.

(8) Clerical errors and other obvious mistakes in entries shall be crossed out in red ink in such a way that the original text is still legible and the correct entry shall be made under the same heading.

(9) The person making the entry shall insert the date of the entry and appose his signature.

46. — (1) The public and the secret parts of the register shall be kept in separate record books.

(2) The method of keeping record books is specified in Articles 9 and 10 of the Annex to the Decree.

47. — If the competent superior organ finds that a secret invention does not possess the characteristics of secrecy, the Office shall make an entry concerning the patent for that invention in the public part of the patent register under a serial registration number and shall make a reference thereto in the secret part of the register on the page relating to that patent.

48. — The Office shall publish announcements concerning entries in the public part of the patent register in the Patent Office Gazette.

49. — Any person may consult entries in the public part of the patent register, but only persons authorized by the competent superior organ shall have access to the secret part of the register, within the limits of such authorization.

50. — (1) On the written request of any person and after payment by such person of the prescribed fee, the Office shall, with respect to the public part of the register, issue:

- (i) copies from the register;
- (ii) extracts from the register;
- (iii) attestations concerning the existence of entries.

(2) A copy from the register shall contain all the current particulars entered in the register relating to a particular patent. At the applicant's request, changed or cancelled entries shall also be included in a copy from the register.

(3) An extract from the register shall include the particulars requested by the applicant.

(4) An attestation concerning the existence of an entry shall include confirmation of the existence of the entry in question, the grounds on which the entry was made, the

name of the register, the name of the part of the register, the registration number and the number of the page in the record book.

(5) Where no entry has been made under headings and parts of headings in the register, these headings and parts of headings shall be crossed out in copies and extracts from the register.

(6) The round seal of the Office shall be affixed to the documents referred to in paragraphs (2) to (4).

(7) A reference to the issue of the documents referred to in paragraphs (2) to (4) shall be entered on request, giving the date of issue.

51. — Sections 43 to 50 of this Order shall apply *mutatis mutandis* to the register of rights to protection for a utility model.

Chapter 10

Provision of Information concerning Applications and Access to Application Files

52. — (1) The Office shall provide information concerning applications for the grant of patents or for the protection of utility models and shall permit access to the relevant application files at all stages of the procedure:

- (i) to the applicant and his agent;
- (ii) to the superior unit of the applicant and its agent, where the applicant is a unit of the socialized sector;
- (iii) to the author of an invention or utility model and to his agent;
- (iv) to the organs responsible for prosecution and for the administration of justice and their authorized representatives;
- (v) to other persons, if the applicant has given his written consent.

(2) Entries concerning the provision of information about applications for the grant of a patent or for the protection of a utility model before their publication and concerning the fact that access to an application file has been given shall be made in the application file in question.

53. — (1) From the date of publication of an application for the grant of a patent or for the protection of a utility model, third persons may have access to the description of the invention or utility model, to the claims concerning patents or the protection of utility models and to the drawings; they may make copies of them or obtain offprints against payment.

(2) At the request of persons who establish their lawful interest therein, the Office shall grant access to the documents contained in the application file other than those referred to in paragraph (1).

54. — The provisions of this Chapter shall not apply to secret inventions and secret utility models.

Chapter 11

Transitional and Final Provisions

55. — Applications for the grant of patents or for the protection of utility models made for the purposes of claiming priority rights which have been filed with the Office before the date of entry into force of this Order, shall be regarded as applications for the grant of patents or for the protection of utility models if the applicant pays the application fee within six months of the date of entry into force of the Decree.

56. — (1) The documents referred to in Section 3(2) (ii) to (vii) of this Order, in English, French, German or Russian, or with a translation into one of those languages, may be filed with the Office within six months of the date of entry into force of the Decree.

(2) The provisions of Article 7, paragraph (2), of the Annex to the Decree shall apply *mutatis mutandis*.

57. — (1) The Order of the President of the Patent Office of the Polish People's Republic of January 29, 1963 on the method of paying and time limits for paying fees for the printing of patent descriptions (*Monitor Polski*, No. 17, text No. 98) is repealed.

(2) The following Orders are repealed in so far as they relate to inventions and utility models:

(i) the Order of the President of the Patent Office of the Polish People's Republic of May 7, 1963 on the filing of applications with the Patent Office of the Polish People's Republic for the grant of patents and for the protection of utility models and industrial designs (*Monitor Polski*, No. 42, text No. 207); and

(ii) the Order of the President of the Patent Office of the Polish People's Republic of May 31, 1963 on the registers kept by the Patent Office of the Polish People's Republic (*Monitor Polski*, No. 49, text No. 254).

58. — This Order shall enter into force on the date of its publication³.

³ This Order was published in *Monitor Polski* (No. 1, text No. 4) of January 12, 1973.

ITALY

Decrees concerning the Temporary Protection of Industrial Property Rights at Exhibitions

Sole Section

Industrial inventions, utility models, designs and trademarks relating to objects appearing at the following exhibitions:

LIII^a Fiera di Milano — Campionaria internazionale (Milan, April 14 to 25, 1975);

II^a Fiera caccia e pesca (Genoa, April 25 to May 1, 1975);

- Rassegna suinicola internazionale* (Reggio Emilia, May 1 to 14, 1975);
- AUTOMOTOR '75 — Mostra mercato internazionale parti, ricambi, accessori e attrezzature per autofficina* (Turin, May 14 to 18, 1975);
- Salone internazionale del tappeto e del tessile d'arredamento* (Milan, May 22 to 26, 1975);
- XXX^a Fiera del Mediterraneo — Campionaria internazionale* (Palermo, May 24 to June 8, 1975);
- XXIII^a Fiera di Roma — Campionaria nazionale* (Rome, May 31 to June 15, 1975);
- XXVII^a Fiera di Trieste — Campionaria internazionale* (Trieste, June 17 to 29, 1975);
- XIII^a Dimostrazione di macchine impianti ed attrezzature per la raccolta lavorazione e conservazione dei foraggi* (Valloreschi (Treviso), July 14, 1975);
- XXXVI^a Fiera di Messina — Campionaria internazionale* (Messina, August 2 to 17, 1975);
- MACEF-Autunno 1975 — Mostra mercato internazionale degli articoli casalinghi, cristallerie, ceramiche, argenterie, articoli da regalo, articoli da giardinaggio, ferramenta e utensilerie* (Milan, September 4 to 8, 1975);
- Mostra internazionale di conigliocultura* (Erba (Como), September 5 to 8, 1975);
- VII^e Dimostrazioni di macchine, impianti e sistemi per la raccolta, lavorazione e conservazione del mais* (Ceregnano (Padua), September 10, 1975);
- XXVIII^a Fiera di Bolzano — Campionaria internazionale* (Bolzano, September 13 to 22, 1975);
- XV^o Salone del mobile italiano* (Milan, September 16 to 21, 1975);
- IV^o INTERSAN — Mostra mercato internazionale della ortopedia tecnica e sanitaria, sanitari, strumenti chirurgici, attrezzature ospedaliere, apparecchi fisioelettromedicali, articoli sanitari per la prima infanzia* (Milan, September 27 to 30, 1975);
- V^o MIPAN — Salone internazionale delle macchine, impianti e prodotti per la panificazione e la pasticceria* (Bari, October 11 to 19, 1975);
- IV^a Fiera agricola dell'arco alpino* (Bolzano, October 24 to 27, 1975);
- II^o EDICOS — Salone dell'editoria e delle comunicazioni sociali* (Naples, October 31 to November 4, 1975);
- X^a Esposizione internazionale delle attrezzature per il commercio ed il turismo — EXPO CT '75* (Milan, November 1 to 9, 1975);
- EIMA — Esposizione internazionale delle industrie di macchine per l'agricoltura* (Bologna, November 19 to 23, 1975);
- XLIV^a Esposizione internazionale del ciclo e del motociclo* (Milan, November 22 to 30, 1975);
- XIV^e Mostre avicunicole internazionali — MAV* (Padua, December 5 to 8, 1975)
- shall enjoy the temporary protection established by the decrees mentioned in the preamble¹.

¹ Royal Decrees No. 1127 of June 29, 1939, No. 1411 of August 25, 1940, No. 929 of June 21, 1942 and Law No. 514 of July 1, 1959. (See *La Propriété industrielle*, 1939, p. 124; 1940, pp. 84 and 196; 1942, p. 168; 1960, p. 23.)

Opposition procedure before the Patent Office of the Federal Republic of Germany

Dietrich LEWINSKY *

Introduction

We have already dealt in this periodical¹ with the experience that has been gained in the field of patent grant procedure since the entry into force in 1968 of the new Patent Law of the Federal Republic of Germany². At the time we mentioned the opposition procedure only to recall that the possibility of opposing the grant of a patent existed, in view of the fact that the legislative provisions on opposition had not been amended in 1968. Here [today] we propose to deal specifically with the opposition procedure. We know that this procedure, which does not exist in the laws of the majority of European countries, is provided for in the Convention on the Grant of European Patents³. Although in fact the opposition procedure of the European Patent Convention differs on essential points, which we shall mention in passing, from the opposition procedure in the Patent Law of the Federal Republic of Germany, the future European Patent Office would certainly benefit from a study of the German Patent Office's experience in this field. It would be useful to refresh our memories on the characteristic features of the German opposition procedure.

Form of opposition

After a German patent application has been examined and where the result of the examination is favorable — which means that the examiner has recognized its novelty, technical advance and inventive step, in other words its patentability — it is published as a green specification ("*Auslegeschrift*" or "*DAS*") pending a decision on the grant of a patent. During the three months following this publication, any person may oppose the grant of the patent, such opposition being filed in writing and accompanied by a statement of the grounds.

It will also be possible to file opposition with the future European Patent Office. This opposition must also be in writing and be accompanied by a statement of the grounds. However, the procedure differs from that of the Federal Republic of Germany in that an opposition fee will have to be paid and the opposition may be filed only after the grant of the patent. The opposition period will be nine months, beginning on publication of the statement that the patent has been granted.

As soon as the grant of a German Patent has been opposed, all subsequent proceedings before the German Patent Office pass from the examiner to the Patent Division. The Patent Division is only competent to take decisions when at least three members participate, two of whom must be technical members. Normally the Patent Division works on oppositions with three technical members, including the Chairman of the Patent Division concerned, who presides over the hearings, and the examiner who published the application to be dealt with, who generally acts as rapporteur in the opposition proceedings. Only in certain cases involving special legal difficulties is a legal member called in, preferably as a fourth member.

In proceedings before the future European Patent Office, the examination of oppositions will be within the competence of special Opposition Divisions, also composed of three technical examiners, at least two of whom must not have taken part in the procedure for the grant of the patent opposed. The processing of a European patent application will generally be in the hands of one examiner, as in the Federal Republic of Germany, but only an Examining Division composed of three technical examiners will be competent to decide on the grant of a European Patent.

We propose now to recall the more important formal requirements in German opposition procedure.

Opposition has to be filed within a period of three months after publication of the application; the opposition period ends at the end of the day of the third month having the same number as that of the day of publication (for instance, if publication occurred on April 5, the opposition period ends on July 5); if the last day is a Saturday, a Sunday or an official holiday observed throughout the country, the opposition period is extended to the next working day, and if the third month does not have the day which normally would determine the end of the opposition period, the period ends on the last day of the month. If the opposition reaches the German Patent Office after the end of the opposition period, it is not admissible.

The opposition must be filed in writing, in German. The requirement of written filing is not met unless the opposition document bears the handwritten signature of the responsible natural person entitled to sign. Oppositions may be filed by telegram or telex, however: the handwritten signature of the signatory may thus be avoided but there is no way of dispensing with the signature of the agent or agents. If the opposition document does not bear the handwritten signature or an indication of the names of the opponents, it is not admissible. Such a defect may only be remedied during the opposition period, although the filing of opposition by a national agent acting on behalf of a foreign opponent is still acceptable after expiration of the three-month period.

* Dipl.-Ing., Dipl. oec. publ., Patent Agent, Munich.

¹ *Industrial Property*, 1973, p. 86.

² *Industrial Property*, 1968, p. 134.

³ *Industrial Property*, 1974, p. 51.

The right to file opposition extends to all natural persons and legal entities entitled to be party to legal proceedings. Third-party interventions are not allowed on behalf of either the opponent or the applicant (this procedure differs from the future European procedure, where a third party will be able to intervene, after the end of the opposition period, if he proves that he has been accused of infringement of the patent, or that he has been advised of the existence of the patent and has himself brought the matter before a court in order to be recognized as not having infringed it).

Grounds

The grounds for filing an opposition have to be the fact that the subject-matter of the application cannot be patented (for instance because, being impossible to implement or lacking usefulness, it is not susceptible of protection by a patent, or because it is unpatentable for want of novelty, technical advance or inventive step). In principle, the same considerations apply to procedure before the future European Office, except that in the latter case the absolute grounds for refusing a patent are listed limitatively (unlike in German law, where grounds for refusal are partly determined by case law). Of the grounds for refusal of a patent, the European Patent Convention contains only lack of novelty and inventive step. Examination for technical advance will be dispensed with in favor of a requirement of industrial applicability.

Under German law grounds for opposition may be the fact that prior applications totally or partly preclude the grant of a patent, or that earlier patents will result from such applications. In such cases, practically all that is verified is the identicalness of the subject-matter of the earlier protection rights and that of the more recent patent application, in order to avoid patenting the same invention twice; the inventive step of the second invention in relation to the first is thus not examined. Under the European Patent Convention, on the other hand, the earlier rights deriving from previously-filed European Patent applications are included in the state of the art and are therefore treated as if they had already been published on the day of the filing of the more recent application.

Finally, opposition may be filed, under German procedure, for unlawful dispossession, that is, on the grounds that the essential subject-matter of the application proceeded against has been abstracted from the possession or ownership of a third party without the latter's consent, in other words "unlawfully." In such cases only the injured party or his successors in title have the right to file opposition. If their opposition results in the withdrawal or rejection of the application on grounds of unlawful dispossession and if, within one month after official notification thereof, the opponent himself files an application in respect of the invention, he may claim the date of the withdrawn or refused application as the filing date.

In principle there can be no "unlawful" abstraction from a person of something that already belongs — according to objective criteria — to the state of the art, in other words

something that has already been published in writing or publicly used in such a way that use by other persons with technical training might appear possible. The thing abstracted must therefore be new, and what is new must constitute the essence of the subject-matter of the application. Thus, before it can be asserted that unlawful abstraction has occurred, the subject-matter of the application must be demarcated in relation to earlier rights, if any; only then can it be determined whether the remainder of the subject-matter of the application has been unlawfully abstracted. If it is found that the application cannot in any event result in the grant of a patent, the ruling on the allegation of unlawful abstraction may be dispensed with, since the patent has to be refused for reasons of unpatentability. The right of appeal from such a decision of refusal belongs both to the applicant and to the party filing the opposition on grounds of unlawful abstraction.

The most frequently stated grounds for opposition are lack of novelty, insufficient technical advance and lack of inventive step. The opponent's contentions under these headings are more often than not based on written publications (patent literature, as in prior examination procedure, and other publications such as advertising brochures, which are often not included in the material at the examiner's disposal). All the facts on which the opposition is based should be stated within the opposition period; proof may be provided afterwards.

The statement of grounds accompanying the opposition is sufficient when it provides detailed information for a given factual situation to be recognized, the accuracy of which may subsequently be verified. Indeed here it is of little consequence whether the reasons put forward by the opponent in fact justify refusal of the patent: the opposition may be acceptable *per se*, in other words it may state grounds that can subsequently be verified, even if the opponent's contentions have no foundation in objective terms. A distinction should therefore be made between the question whether an opposition is admissible with respect to form and the question whether, in substantive terms, it will be successful.

Admissibility

The admissibility of an opposition with respect to form requires that the grounds stated by the opponent be sufficiently enlarged upon. For instance, an opposition is not supported by sufficient grounds, and is therefore inadmissible, if it does no more than indicate the patents that have already been taken into consideration in the prior examination and appear in the application file, and if the opponent does not give more detailed reasons why this state of the art, already examined, should be an obstacle to the grant of the patent.

Neither is it sufficient merely to quote the numbers of alleged anticipations within the prescribed period, and then to indicate why those anticipations should be an obstacle to the grant of a patent corresponding to the application to which the opposition relates. If it is only after thorough examination that it may be ascertained whether and to what extent the patents of which the numbers have been quoted

may be an obstacle to patentability, the opposition must be declared inadmissible for want of grounds. Therefore, even information containing all the necessary facts for the filing of the opposition and for the justification of the alleged lack of patentability cannot be considered sufficient for the Office to examine whether the subject-matter of the application does indeed have the defect attributed to it.

An opposition is inadmissible in any event if it is based on a patent that was not published before the filing of the application opposed, or on a work by the applicant himself which, although published prior to the filing of the application, did not appear until the six-month protection period had started. This period of six months prior to the filing of the application is also provided for in the European Patent Convention, although in a somewhat more restrictive form in that the only disclosures not taken into consideration are those resulting from an evident abuse in relation to the applicant or from the fact that the applicant has displayed the invention at official exhibitions. A publication by the applicant himself, on the other hand, always destroys novelty in terms of the European Patent Convention.

An opposition is equally inadmissible if it is based on a more recent patent or an earlier application that has already been withdrawn or refused by a court. A renounced or lapsed patent remains valid with respect to prior rights, but a patent that is cancelled or unpublished at the time of the filing of the application is not an obstacle to the patentability of a more recent application.

In principle the inadmissibility of an opposition may be decided upon before the substance is considered. The opponent naturally has the right to appeal from this prior decision. If an opponent whose opposition is admissible *per se* mentions other anticipations after the expiration of the opposition period, those anticipations may not be included in the procedure; in that respect, therefore, the opposition is inadmissible. However, if the anticipations mentioned later are important for assessing the patentability of the subject-matter of the application, the Patent Division has to take them into consideration at the same time as the other elements for assessing patentability. Thus, even after the expiration of the opposition period, one need not hesitate to file additional documents in support of one's opposition when those documents are important for assessing patentability.

An opposition is also inadmissible when it is not based on the grounds for opposition stated in the Patent Law and discussed above, but only, for instance, on a procedural fault such as the fact that the application fees have not been paid, that the invention lacks unity, that the description is inadequate or has been unduly enlarged upon, that an addition is not properly linked to the main application, that there has been breach of contract or undue use of a trademark, etc. It is admissible, however, if the above objections relate or are complementary to admissible contentions. These defects may thus be indicated in addition.

One objection concerning patentability that is generally put forward by an opponent only during the opposition procedure is known as "prior public use." Under the German

Patent Law an invention is not new if it has already been publicly used within the country in such a manner that its use by other persons skilled in the art seems possible. Thus prior public use on national territory belongs to the state of the art in the same way as a published document.

Prior use of the subject-matter of the application may be constituted by the fact that the subject-matter has been manufactured, marketed, offered for sale or used prior to the filing of the application. None of these types of use can be prejudicial to novelty, however, unless they occur "publicly." The public nature of such prior use is present when the possibility of disclosure to third parties is established. Such public use does not affect novelty unless it occurs on national territory; the future European patent law does not provide for this limitation to national territory.

In order to prove prior public use, concrete information should be provided on the exact circumstances constituting the prior use (nature, time, place) and on the publicity which enabled that use to be reproduced. Proof of prior use presupposes the establishment of definite facts showing in detail not only the prior use but also the essential resemblance between the subject-matter used previously and the characteristics of the invention. It is important, therefore, that the subject-matter of the prior use be indicated with accuracy: a mere statement that that subject-matter is the same as the subject-matter of the application is not sufficient. If a drawing is necessary to illustrate the subject-matter of the prior use, it should be submitted within the opposition period, or at least its essential contents should be indicated in detail.

In order to prove publicity, it must be possible to draw the conclusion that the use created a not-too-remote possibility for third parties, and therefore also for experts, to acquire a sure and sufficient knowledge of the subject-matter of the prior use, either directly, owing to its having been open to inspection by an unlimited number of persons, or indirectly, owing to its having been inspected by a few experts not committed to secrecy. Thus it is not important for the proving of publicity that knowledge of the prior use be actually acquired: a not-too-remote possibility is sufficient. A distinction should be made between the not-too-remote possibility of third parties becoming acquainted with the subject-matter of the prior use and cases where that possibility is purely theoretical and only abstract or very remote. In any event publicity should be denied when the prior use was the subject of an express or tacit agreement of secrecy, or again when such an agreement is the bona fide result of the circumstances of the case.

In all cases it must be possible, within the opposition period, to assemble all the facts constituting proof of the prior use and of the publicity afforded to it. The evidence supporting an allegation of prior public use does not meet the legal requirements unless it describes the circumstances necessary for assessment in a manner sufficiently comprehensive for the applicant and the Patent Office to be able to take a final decision. Care should therefore be taken to ensure, even during the opposition period, that the claim of prior public use is already supported by conclusive proof.

Initiation of the opposition procedure

In the past, opposition proceedings before the German Patent Office lasted for an inordinately long time. This state of affairs still persists to a certain extent, but its effects can be offset by means of well-founded requests for rapid action. In principle, the determining date for the continuation of the proceedings is that of the applicant's rebuttal. However, applications in respect of which the preliminary examination procedure has already lasted more than the average time may be treated as exceptions and given priority. There is also a tendency to depart from the normal course of proceedings when the applicant, or even the opponent, submits valid reasons for speeding up the processing of the opposition. Finally, priority is also given to opposition procedures on which other more recent applications depend, regardless of whether the processing of those more recent applications has been suspended or not.

The opposition document and other documents submitted by either party in the course of the opposition procedure are sent to the other party. If there are several oppositions, they are exchanged between the opponents. It is therefore recommended that a sufficient number of copies be submitted at the same time as the opposition. Moreover, every opponent is informed, on expiration of the opposition period, of the number of other opponents. Given this procedure, it is no longer necessary that the applicant make a separate rebuttal of each of the different oppositions, since each opponent is in any case acquainted with all the opposition documents. The applicant should therefore deal with the substance of all the oppositions in a common rebuttal document.

With regard to the time at which these documents, other than the opposition document, should be sent, there are different interpretations at the Patent Office and even at the Federal Patent Court. Until such time as a top-level judicial decision has been rendered, the President of the Patent Office has recommended to the Patent Division that, should a ruling on an opposition procedure not be possible within a foreseeable time, the documents received should be sent without delay to the other parties, but that, should the decision not be possible within about the following three months, the subsequent communication to the parties of a document received during the intervening period should be avoided, provided of course that the decision rendered by the court is not likely to suffer thereby. In principle, documents in an opposition procedure are transmitted without comment, strictly for information; in such cases no time limit is generally fixed. Only when the Patent Division considers a reply useful or necessary does a specific time limit have to be imposed on the parties for the submission of documents.

The applicant is usually accorded a period of four months for his rebuttal of an opposition. If there are several oppositions, the documents are sent together after the expiration of the opposition period, so that they may all be dealt with together.

As a general rule, time limits should not be too short, so that unnecessary requests for extension may be avoided. Ex-

tensions of time limits should only be granted if there are sufficient grounds, that is, if the respective request is supported by circumstances that can be verified and on the basis of which it can be established that it is not possible to reply in time to the opposition or the provisional decision.

Provisional replies are not normally sent in the opposition procedure before the Patent Office: after the oppositions have been submitted and the time limit accorded to the applicant for rebuttal has expired, a decision is generally taken at once. Such a provisional reply is mandatory, however, when the Patent Division wishes to introduce new circumstances into the proceedings or considers it necessary to make changes other than mere drafting changes to the application file in relation to the DAS. If, in the light of the documents already examined during the preliminary examination procedure, the Patent Division comes to a different decision on the inventive step of the subject-matter of the application from that reached by the examiner before the publication of the application, the production of a provisional reply is not always necessary, as the anticipations are already known to the applicant and have merely been evaluated in a different way. Neither is a provisional reply necessary when the Examining Section or an opponent considers anticipations introduced in the proceedings or examines them according to different criteria from those of the Patent Section, except where those other criteria are based on technical characteristics of the anticipations that were unknown previously.

If the applicant submits new documents with amended contents, and if it seems possible for the Patent Division to accept the claims thus submitted, the new documents are sent without comment to the other parties before the final decision is drafted, and a time limit is fixed for replies. This communication may be dispensed with when the new documents have already been proposed or mentioned in a previous provisional reply or when they relate only to parts of the description that have been adapted to claims already sent. If the Patent Division considers that the new claims cannot be accepted owing to circumstances already indicated during the procedure and known to the applicant, it immediately issues a decision refusing the patent applied for.

In the opposition procedure before the future European Patent Office, the documents filed must also be submitted to the other parties and a time limit fixed for replying, and, if necessary, the European Office must issue provisional replies. The details are laid down in the Implementing Regulations of the European Patent Convention.

Certain provisions of the German Patent Law and the European Patent Convention are the same in the sense that, in the opposition procedure, the parties may be invited to attend oral deliberations, there may be a preliminary investigation, and witnesses, experts and parties may be heard, under oath or otherwise. Such oral deliberations do not constitute a right, however. They are therefore extremely rare in first-instance opposition proceedings before the German Patent Office. In second-instance proceedings, that is, in the appeal procedure before the Federal Patent Court, such oral deliberations are prescribed by the Law and must take place,

even without having been requested by the parties. On the subject of this opposition procedure before an appeal chamber of the Federal Patent Court, it should be noted that, if the opponent withdraws his appeal from the decision to grant the patent, the appeal procedure cannot continue, even if the appeal chamber concerned has found that the decision to grant the patent in the first instance in fact should not have been made. If, on the other hand, the decision taken by the Office was to refuse the patent and the applicant had appealed from that decision, when the opponent withdraws his opposition the procedure nevertheless has to continue. Similarly, in the first-instance proceedings before the Office, the opposition procedure continues even after the withdrawal of the opposition, in view of the fact that the Office has to verify for its own purposes the arguments put forward in connection with the opposition and determine the patentability of the subject-matter of the application in question.

Finally, there is one more rule which is the same in the German Patent Law and in the European Patent Convention: in the opposition procedure, the individual parties hear personally, in principle, the costs incurred by them. Only in special cases are other costs charged to one of the parties,

such other costs being only those resulting from the preliminary investigation, the hearing of witnesses and parties, etc. A decision regarding the distribution of costs may also be taken when the application or the opposition has been entirely or partly withdrawn. However, a decision regarding the distribution of costs generally presupposes that those costs were occasioned by the action of one of the parties. The cost of the preparation of oral proceedings is repayable only when the application is withdrawn shortly before the expiration date. A party failing to observe a procedural time limit allowed him on request has to repay the resulting costs to the opposing party, in view of the fact that he has omitted to inform the latter in time of his intention not to take part in the oral proceedings.

A decision relating to the opposition procedure may be taken in the course of an oral proceeding. If this occurs in the first instance, the appeal period starts at the time of the announcement of the decision. Usually, however, first-instance decisions are taken in the course of the written proceedings, and the appeal period starts at the time of receipt of the written text of the decision.

LETTERS FROM CORRESPONDENTS

Letter from the Federal Republic of Germany

Friedrich-Karl BEIER* and Paul KATZENBERGER**

Part I

Summary

I. Jurisprudence concerning designs

1. Unity of the design
2. Novelty and originality
3. Importance of the description for the purposes of deciding eligibility for protection
4. Depositing of the same object as a two-dimensional and as a three-dimensional design
5. Proof of imitation

* Dr. jur., Professor of Law, University of Munich, Director of the Max-Planck-Institute for Foreign and International Patent, Copyright and Competition Law, Munich.

** Dr. jur., Staff Member of the Max-Planck-Institute for Foreign and International Patent, Copyright and Competition Law, Munich.

II. Jurisprudence on trademarks

1. No formal protection for service trademarks
2. Risk of confusion
3. Similarity of goods
4. Opposition procedure
5. Obligation to use trademarks
6. Transfer of trademarks
7. Conditions governing the protection of attributes (*Ausstattungs-schutz*)
8. International trademark law

Our last Letter gave an account of Legislation, Reform Efforts, and Practice in all sectors of industrial property¹ and of Jurisprudence governing employees' inventions and patents². Our new Letter, which is also split up into two parts, deals with Jurisprudence relating to designs and trademarks

¹ *Industrial Property*, 1975, p. 102.

² *Industrial Property*, 1975, p. 128.

(Part I) and court decisions concerning the other fields of industrial property, particularly the protection of trade names and the law governing unfair competition (Part II). The reporting period ranges from 1972 to the end of 1974³.

I. Jurisprudence concerning designs

The considerable economic importance of the legal provisions concerning designs is reflected not only in the large number of applications for the registration of designs⁴ but also in the large number of decisions handed down by the courts, including the Federal Supreme Court, relating to this field of law. Some of these decisions will be considered below. They have a particular bearing on the question of eligibility for protection, in addition to matters affecting registration procedure and infringements.

1. Unity of the design

Design protection can only extend to an aesthetic creation which may serve as a pattern for a product of handicraft or industry. This fact of being intended for a *product* presupposes also the unitary character of a design eligible for protection. The rule is that a design is not so eligible unless it takes the form of a product which can be regarded as a unitary whole.

The importance of the design unity criterion emerges particularly in cases where a new aesthetic effect is achieved only by the combination of separate objects. A typical example of this is provided by a furniture suite consisting of a number of separate pieces of furniture. They are to be considered as a unitary product and hence eligible for protection as a design provided that they are conceived and constructed as a unit and also, as a rule, bought and assembled as such. This is particularly often the case with bedroom suites. In accordance with this principle, the German courts have repeatedly found that such units are eligible for protection⁵.

Unity is deemed to be lacking in cases where, although the objects can be arranged and grouped in a particular way, they nevertheless retain their character as separate objects and are normally sold and used as such. For example, in a more recent judgment relating to the allied question of copyright protection for an "armchair set," i. e., a particular arrangement of upholstered seats to form straight rows and angles, the court found against the eligibility for protection of the set as a whole and recognized only the eligibility of the individual armchairs⁶.

These principles were confirmed in another recent decision⁷, whereby the Federal Supreme Court recognized the unity and eligibility for protection of a "bedsitting-room set."

The particularity of this furniture set consisted in the fact that the separate items could be arranged in any order without detracting from the aesthetic individuality of the room.

2. Novelty and originality

Under German law aesthetic designs are, as such, eligible for protection but only provided they meet two essential substantive conditions, namely the novelty and the originality of the specific design.

With regard to the *novelty* criterion, the question whether an objective or subjective concept of novelty should be adopted was long in dispute. Objectively speaking, a design is new if it did not exist before. From the subjective standpoint, however, it can be regarded as new if the creator has established it independently, i. e., without imitating a pattern. In the German text books, it is mainly the subjective concept of novelty that has been regarded as the correct one, particularly in view of the copyright approach adopted under German law relating to designs. However, the Federal Supreme Court has handed down a basic judgment in which it ruled in favor of objective novelty as a condition of eligibility for protection⁸.

Even this decision does not stipulate, however, that a design must be absolutely new, i. e., that it has never — at any place or time — existed in the past. The point is rather that a design is considered as lacking novelty only if it was, or might have been, known to experts within the country at the time of application, if they took notice of the creations existing in the same or allied industrial sectors and if such notice is imputable to them. The courts assume that the experts also keep in touch to a certain extent with developments abroad, particularly within the western world. However, a large number of individual problems still remain to be settled.

In addition to novelty, German law establishes *originality* of the design as a further independent condition of eligibility for protection. Originality corresponds to the creative achievement which is the essential prerequisite for copyright protection, and thus constitutes one of the main criteria of the copyright approach adopted under German law relating to designs. A design is original provided that its essential aesthetic features appear as the outcome of individual creative activity. It is a fixed tenet of case law that this creative activity must go beyond the average ability of a design creator in the sector concerned and that mere craftsmanship is not enough⁹. Moreover, although the creative achievement or standard of creation (*Gestaltungshöhe*) required for design protection should generally not be underestimated, it is generally recognized that the requirements of design protection are somewhat less stringent than those which must be met by a work of art eligible for copyright protection.

In each specific case, the assessment of originality must be based on the forms already existing in the relevant sector and the scope for new creations. This scope may be restricted, for example, by technical standards or the technical purpose of a product. The courts apply these factors not only to decide

⁸ BGH of May 8, 1968 — *Rüschenhäube*, GRUR 1969, p. 90, with commentary by Heydt.

⁹ Cf. BGH of May 20, 1974 — *Dreifachkombinationsschalter*, GRUR 1975, pp. 81 and 83, with commentary by Henssler.

³ The new Letter follows, with respect to subject and time, the Letter published in *Industrial Property*, 1973, pp. 125 and 201. Part II will follow in a later issue.

⁴ About 61,000 design applications in Germany in 1973. Cf. WIPO Statistics 1973 IP/STAT/1973/1, p. 54.

⁵ Federal Supreme Court (BGH), of March 14, 1958 — *Schlafzimmermodell*, in *Gewerblicher Rechtsschutz und Urheberrecht* (GRUR) 1958, p. 509; BGH of December 4, 1970 — 1 ZR 102/68 (not published).

⁶ BGH of October 10, 1973 — *Sessel*, GRUR 1974, p. 740, with commentary by Gerstenberg (pp. 707—710).

⁷ BGH of September 20, 1974 — *Möbelprogramm*.

what an average creator can achieve by the further development of existing forms, and what would on that account be considered as lacking in originality; they also take into account the need of competitors also to make use of these free forms and to adapt their products to new trends in taste. A recent decision⁹, in which the court found against the originality of a light switch, brings out this factor explicitly for the first time. Not infrequently, the originality requirement proves a more intractable obstacle to design protection than even the criterion of objective novelty.

3. Importance of the description for the purposes of deciding eligibility for protection

German law upholds the principle that only the deposited design or photograph or drawing shall be taken into account in assessing novelty and originality. Features of products fabricated according to the design which are not recognizable from the deposited design or drawing shall be absolutely disregarded¹⁰.

Furthermore, protection shall not be justified or increased by a description attached to the design at the time of deposit. Here, too, the decisive factors are the aesthetic features to be derived from the deposited design, or photograph or drawing thereof. However, a description is not entirely devoid of importance. It is in particular recognized that the protection of the deposited design may be restricted by a description to a particular aesthetic effect¹¹. A recent judgment¹² recognized that a description is favorable from the protection standpoint in cases where the description merely refers to the cause of an aesthetic effect which is to be derived as such from the deposited design, or photograph or drawing thereof. In such a case, the description may be used for purposes of clarification; protection is not thereby increased beyond the scope of the claim. The case at issue concerned a standard lamp in which the stem contained glass cylinders which could be illuminated. The photographs submitted showed the particular aesthetic effect produced by these cylinders when illuminated. The description explained that the particular light effect was created by bulbs inside the cylinders and not by illumination from the outside, for example, produced by the photographer.

4. Depositing of the same object as a two-dimensional and as a three-dimensional design

Particular importance attaches to a Federal Supreme Court decision¹³ on a question concerning the deposit procedure, particularly for the light it sheds on a certain peculiarity of the somewhat out-of-date German law relating to designs. Under Article 6(2) of the relevant German Ornamental Design Law of January 11, 1876, the imitation of designs intended

for flat products by plastic products and vice versa is completely permissible. Change in dimension hence constitutes no infringement of the law relating to designs, regardless of the extent to which the aesthetically specific features of the protected design, two or three-dimensional, may be imitated. This provision also explains why, when a design is deposited, the German courts require a declaration in the application for the registration of a design as to whether the design relates to a two-dimensional or a three-dimensional product¹⁴.

This decision of the Federal Supreme Court now finally settles the long unresolved dispute concerning whether the same creation can be the subject of separate applications for two-dimensional and three-dimensional designs. The Court produced weighty arguments in support of its affirmative ruling. This judgment is to be welcomed, in that it shows at least a way in which depositing can escape the consequences of the above-mentioned obsolete provision restricting the scope of protection of protected designs.

5. Proof of imitation

In contrast, for instance, to patent law, design law does not protect the object against all uses but only against imitation. To decide whether imitation has in fact occurred in any given case, the courts make an objective overall comparison of the products against which complaint is made with the protected features of the design. Then, to the benefit of the protected design, it is the points of similarity rather than the divergences which are taken as a basis for a decision¹⁵.

The evidence for imitation has both an objective and a subjective component. This gives rise to certain difficulties of proof for the owner of the design and the plaintiff. The courts allow for this, in holding that a substantial similarity of the products in question to the design constitutes *prima facie* evidence of imitation. The onus is then on the defendant to produce evidence suggesting a serious possibility that the design has not been imitated. According to the Jurisprudence of the Federal Supreme Court, account is normally taken only of evidence to the effect that the protected design was unknown to the creator of the products complained of and that knowledge of the design had not been conveyed to him by descriptions provided by third parties who have seen the design¹⁶. As a matter of principle, the creator's claim that he was not aware of the design is not an adequate defense. The reason is that the creator may have unwittingly retained in his mind some earlier sighting or description subsequently forgotten and may have unconsciously been influenced by it when creating the products complained of; this argument is sufficient for the purposes of establishing imitation and infringement¹⁷. Generally speaking, it will be extremely difficult for the defendant to refute any *prima facie* evidence of imitation.

¹⁰ Cf. BGH of February 20, 1970 — *Gardinenmuster*, GRUR 1970, pp. 369 and 370 and BGH of July 14, 1961 — *Buntstreifensatin*, GRUR 1962, pp. 144 et seq., with commentary by Dietrich Reimer.

¹¹ Cf. BGH of January 30, 1963 — *Fahrradschutzbleche*, GRUR 1963, pp. 328 and 329, with commentary by Henssler.

¹² BGH of March 1, 1974 — *Stehlampe*, GRUR 1974, p. 737, with commentary by Lehmpfuhl (pp. 703—707).

¹³ BGH of September 15, 1972 — *Doppelanmeldung*, GRUR 1973, p. 214, with commentary by Henssler.

¹⁴ Cf. Section 6 of the Rules Governing the Maintenance of the Design Register (*Bestimmungen über die Führung des Musterregisters*) of February 29, 1876.

¹⁵ Cf. BGH of September 30, 1964 — *Küchenmaschine*, GRUR 1965, pp. 198 and 201, with commentary by Henssler.

¹⁶ Cf. BGH of March 14, 1958 — *Schlafzimmermodell*, GRUR 1958, pp. 509 and 511, with commentary by Henssler.

¹⁷ Cf. BGH of July 4, 1961 — *Strassenleuchte*, GRUR 1961, pp. 640 and 643, with commentary by Henssler.

However, these principles apply unrestricted only in cases where products fabricated according to the protected design have already been in circulation. If this is not the case, an important recent decision¹⁸ rules that the creator's claim not to have been familiar with the design carries weight. In this case also, it is admittedly theoretically conceivable that the creator or a third party who has informed the creator has become aware of the design by consulting the design register. Neither is the possibility to be ruled out that the creator still had a merely unconscious recollection of the design when he created the product complained of. The decision, however, will be based on the typical course of events, according to which it is usually products which have already been put into circulation that are imitated rather than designs which have merely been deposited¹⁹. In the Federal Republic of Germany, the decisive factor is that neither photographs nor drawings are published as part of the registration procedure and that there is in principle no central design authority.

II. Jurisprudence on trademarks

1. No formal protection for service trademarks

One of the most serious shortcomings of the present German law governing commodity trademarks is the lack of any formal protection for service trademarks (which might be achieved by simple entry in the trademark register). This clearly emerged yet again from a recent decision handed down by the Federal Supreme Court²⁰. The Court had decided on a previous occasion²¹ that a service undertaking, such as a laundry and dry cleaning establishment, could not obtain such protection even by the circuitous means of depositing a trademark for articles of clothing which it merely processed on behalf of clients. In its latest decision, the Court found, logically and in keeping with the law in force, that a trademark cannot be registered for share certificates. Share certificates do not constitute *goods*, but only documents relating to certificated *rights*; economically speaking, it is these certificated rights which are concerned in the transaction. German law, however, only provides for the registration of a trademark in cases where the mark characterizes a "commodity". This ruling provided a fresh impetus to the sponsors of urgent legal reform designed to introduce formal protection for service trademarks into Germany. A private bill to this effect has already been tabled²².

2. Risk of confusion

The courts have of course repeatedly been called upon to rule on the question concerning the risk of confusion, which is fundamental to trademark law as a whole. Although no basic new developments have occurred, nevertheless mention

should be made of three judgments which relate to new variations on old themes.

The first decision²³ which should be mentioned in this context concerns the question of *motif protection*. It has already been made clear²⁴ that, under the latest case law, this protection does not imply that, if the meaning of two marks coincides, a risk of confusion is automatically indicated. It is rather the total circumstances of the individual case which are decisive. In a number of decisions, the courts have moreover evolved the principle that coincidence of meaning is less likely to lead to confusion the more common it is²⁵. The public either does not retain the meaning of a trademark at all, or it does not automatically conclude from two signs representing the same general meaning that they derive from the same firm. The new decision makes it clear that the situation is similar in cases where two marks use an identical basic motif, but where in one of them the motif is modified in a particular way to denote the commodity concerned. In such a case, the public will construe the modification, but not the underlying motif, as denoting the origin of the commodity. The case at issue involved two trademarks which employed the well-known fairytale motif of the "Seven Swabians" (*Sieben Schwaben*). The disputed symbol used the motif in its original form; seven men in mediaeval clothing, the "Seven Swabians," attack a hare with a large spear and at the same time recoil from it in fear. The form used by the defendants representing "Seven Chicken pastry products" (*7-Hühnchen Teigwaren*), depicts seven chickens attacking an egg with a halberd; thus the "Seven Swabian" motif was modified in a characteristic way so as to denote the commodity in question. According to the above arguments, the Court could not find that there was a risk of confusion merely on the grounds that the defendant's mark was ultimately derived from the "Seven Swabians" motif.

In the second decision²⁶, the problem hinged on the risk of confusion caused by so-called *series marks*. The case law dealing with confusion arising from such marks makes allowance for the well-known practice of many firms of using the same basic mark for all their goods, with a modified version in which the basic mark still remains recognizable, for individual commodities. If another firm uses a mark with the same component, the public might conceivably take it to be a modified mark of the firm which normally uses the component as a basic mark. The mere similarity of a mark component, however, does not necessarily lead to confusion, provided that the marks otherwise convey a clearly distinctive overall impression. Confusion is caused rather in cases where the public takes the common component to be in fact the basic mark of one of the firms, in the manner explained above. In the cases decided so far, this condition was fulfilled in cases where either a firm had already accustomed the public to a number of marks incorporating the same basic mark or

¹⁸ BGH of November 28, 1973 — *Elektroschalter*, GRUR 1974, pp. 406 and 410, with commentary by Henssler.

¹⁹ Cf. also Lehmpfuhl, *Die Niederlegung eines Geschmacksmusters*, GRUR 1974, pp. 703 and 705.

²⁰ March 8, 1974 — *Concentra*, in *Entscheidungen des Bundesgerichtshofs in Zivilsachen* (BGHZ) pp. 62, 212 — GRUR 1974, p. 657.

²¹ Cf. *Industrial Property*, 1968, p. 301.

²² Cf. Droste, "*Concentra*" und noch keine Dienstleistungsmarke!, GRUR 1974, pp. 649 and 651.

²³ BGH of February 8, 1974 — *Sieben-Schwaben-Motiv*, GRUR 1974, p. 467, with commentary by v. Falck.

²⁴ Cf. *Industrial Property*, 1968, pp. 303 et seq.

²⁵ Lastly BGH of April 30, 1969 — *Roth Hündle*, GRUR 1969, p. 686, with commentary by Schulze zur Wiesche.

²⁶ BGH of September 28, 1973 — *Räuber*, GRUR 1974, p. 93, with commentary by v. Falck.

where the basic mark was particularly characteristic of the firm, i. e., when it was used as an abbreviation of the firm name. Neither of these points was applicable in a recent decision relating to the common mark component. The case concerned potential confusion between the mark "Spessart robber" (*Spessarträuber*), representing alcoholic spirits, for which an application was filed, and the older and already protected "Pirate" (*Seeräuber*) mark representing the same type of goods. The common component here was the word *Räuber* which, apart from being an everyday word not particularly indicative of origin, was used by the defendant only in a single mark (*Seeräuber*). The Federal Supreme Court correctly emphasizes that the public would only in exceptional cases identify such a mark component with the basic mark of a firm, and then only in cases where the other mark components were conducive to such an interpretation. However, stringent criteria should be applied in this latter respect in order to prevent any undue extension of mark protection. Accordingly, in the case at issue, the Court found against the character of the word *Räuber* as the basic mark and hence denied the risk of confusion.

The third decision²⁷ is worth mentioning for its connection with an old and disputed question of protection of *indications of geographical origin*. According to a former decided case, which has frequently been criticized in text books, the word *Pilsener* enjoys no protection as an indication of origin for beer from Pilsen in Czechoslovakia, when it is accompanied by references to a different place of manufacture²⁸. A Pilsen brewery had attempted to obtain protection for the designation *Pilsener* on the basis of trademark law. Invoking marks which had been registered for it internationally, such as *Ur-Pilsener*, it appealed against the registration of the trademark *Club-Pilsener aus der Dortmunder Union-Brauerei*. However, this appeal was unsuccessful. The Federal Supreme Court found against risk of confusion on the grounds that the word *Pilsener*, accompanied by another mark component referring to a German brewery, was construed in Germany as designating a type of beer rather than the firm's origin. The Federal Supreme Court judgment left open the question whether the word *Pilsener* alone would in Germany be construed as a geographical indication referring to beer from Pilsen. Effective protection of this designation in Germany will presumably only be achieved by an international agreement.

3. Similarity of goods

Like the risk of confusion, the question of similarity of goods is a constant source of litigation. In this connection, however, mention should be made only of one decision of the Federal Supreme Court²⁹, marking a consistent development of case law relating to the problem of similarity between raw materials and semi-finished products on the one hand and

finished products on the other. Similarity between these products should as a matter of principle be denied, since they are intended for different purposes, largely derived from different firms and are directed towards different customers via different distribution circuits. In the fundamental "Dolan" decision³⁰, the Federal Supreme Court departed from this principle with regard to synthetic fibres on the one hand and, on the other hand, articles of clothing manufactured from these *fibres*. It found in favor of similarity, taking into account the textile industry's practice of attaching the fibre symbol as a so-called "accompanying mark" to finished articles of clothing and publicizing the fibre mark in the advertising used for finished clothing for the final consumer. In the latest decision, this case law was extended to the relation between textile *yarns* on the one hand and articles of clothing manufactured therefrom on the other hand. Admittedly, the yarn stems from a manufacturing stage posterior to the fibre production. However, the marks used for both these semi-finished products are also attached as accompanying marks to finished items. Furthermore, even the experts do not draw a precise distinction between fibres and yarns. One point which is particularly relevant to future cases is that, in its latest judgment, the Federal Supreme Court did not attach decisive importance to the circumstance whether it had already become a general trade practice to attach the yarn mark as an accompanying mark to finished items; in the "Dolan" decision, particular emphasis had been laid on this trade practice. The Court now considers it sufficient if publicity on behalf of the finished product includes the yarn mark to a substantial degree, thus suggesting the economic proximity of the goods. This constitutes a considerable lowering of the requirements for the assumption of similarity of goods.

4. Opposition procedure*

The Federal Supreme Court has handed down three decisions on the point, not unimportant from the practical angle, whether and under what conditions an opposition can still be withdrawn when the Federal Patent Court has reached a conclusion at second instance on the opposition in favor of similarity and confusion between the deposited mark and the opponent's mark. It is useful to provide for an effective *withdrawal of the opposition* at such a late stage of the procedure in those not frequent cases in which the depositor and the opponent still manage to agree and, for example, reach a delimitation agreement after the Federal Patent Court's judgment. If the opposition can still be withdrawn during proceedings before the Federal Supreme Court, which only decides points of law as the final court of appeal, the deposited trademark can be registered without the so-called action for "authority to register" (*Eintragungsbewilligungsklage*) initiating a new time-consuming and expensive court procedure. In an initial decision³¹, the Federal Supreme Court recognized the principle that an opposition can be withdrawn up until the point at which no appeal lies against a decision and that

²⁷ BGH of October 19, 1973 — *Club-Pilsener*, GRUR 1974, p. 220, with commentary by v. Falck.

²⁸ Cf. Beier, *Der Schutz geographischer Herkunftsangaben in Deutschland*, GRUR 1963, pp. 236 et seq.

²⁹ Cf. January 19, 1973 — *Smarty*, BGHZ 60, 159 — GRUR 1973, p. 316, with commentary by Röttger.

* See also General Study above by D. Lewinsky, p. 242.

³⁰ Cf. *Industrial Property*, 1973, pp. 131 et seq.

³¹ Cf. March 2, 1973 — *Anginetten*, GRUR 1973, p. 605, with commentary by Droste (p. 606).

such withdrawal can still be effected for the first time in the course of the appeal procedure which is before the Court. The Federal Supreme Court has handed down two further judgments^{32, 33} upholding and extending this jurisprudence.

Reference should also be made to a Federal Supreme Court decision³⁴ which avoids an unnecessarily stringent approach to the *time limit for oppositions*. The opponent had, within the correct time limit, lodged an opposition concerning two marks but had only paid one fee. He did not explain to the Patent Office, as trademark authority, for which of the two marks the fee was intended until the time limit had expired. It therefore did not become absolutely clear within the time limit which of the two marks was actually concerned in the opposition. The Federal Supreme Court, however, held this to be immaterial, since payment of the fee is not so essential a part of the opposition procedure as to affect the decision of substance.

Mention should also be made of a decision³⁵ affecting the question of *costs* in the opposition procedure. German civil law recognizes the principle that the losing party also has to bear the costs of the winning party. The Patent Office procedure relating to industrial property and thus also including trademark protection cannot, however, possibly be equated with a civil action. The question of costs is therefore governed by particular rules under which each party has to bear his own costs and one party can be ordered to make good the costs of the other party only on the grounds of fairness. The decision in question shed light on a hitherto obscure situation in explaining that, for this purpose, special circumstances are required, such as failure to observe due process. The mere fact of losing a case does not by any means signify that the party concerned must bear the costs of the winning party.

5. *Obligation to use trademarks*

As has already been explained³⁶, the general obligation to use trademarks, introduced by the "Transitional Law" (*Vorabgesetz*), did not become effective until January 1, 1973. It is therefore not surprising that the reporting period includes no Supreme Court case law relating to this provision, which is an innovation for Germany. However, reference may be made to some important rulings which have been made on this point.

A first decision, the *Porotex* judgment³⁷, concerns an important question of *transitional law*, relating to *compliance with the obligation to use in the opposition procedure*. The law (Article 5(7) of the Trademark Law (WZG)) specified that the depositor of a trademark can challenge the use of the opponent's mark if it has already been registered for at

least five years at the time when the more recent mark is published. If he then wishes his opposition to be upheld, the opponent must convince the court that he has used his mark within the five years previous to the publication of the disputed mark. The transitional provisions of the *Vorabgesetz* (Article 7(2)) stipulate that, in the case of trademarks already registered on the coming-into-force of the *Vorabgesetz* on January 1, 1968, the periods indicated in Article 5(7) WZG shall not begin earlier than that date.

Under the Federal Supreme Court decision, this does not merely mean that each owner of an older trademark had until January 1, 1973, to use the mark from the standpoint of obligation to use. It also means that, if the depositor's defense on grounds of failure to use is to succeed, the five-year period running from registration of the opponent's mark to publication of the depositor's more recent mark, against which the opposition has been lodged, starts to run at the earliest on January 1, 1968. It follows therefore that the obligation to use cannot arise in the case of oppositions lodged against marks published before January 1, 1973. It is only with reference to publications which take place after this date that the five-year period referred to above, counting from January 1, 1968, can have expired. This invalidates the objection on the grounds of failure to use the opposition mark in a total of approximately 20,000 opposition actions³⁸ which were pending on January 1, 1973, quite irrespective of whether the opposition mark was used between January 1, 1968 and January 1, 1973, or not.

It is only at first sight that this outcome would seem unsatisfactory. If the only condition established for the transitional period were that the five-year period starting on January 1, 1968, within which the opposition mark could be used had expired, the question whether failure to use the mark could be invoked or not would be largely a matter of chance: in all opposition actions concluded before January 1, 1973, this would have been impossible, but not in all the cases still outstanding after this date. Furthermore, a solution different from that provided by the Federal Supreme Court would have meant that the approximately 20,000 opposition cases still pending on January 1, 1973, would have been vulnerable from the new standpoint of obligation to use irrespective of the status of each individual case. This would have caused considerable additional delays. The purpose of the *Vorabgesetz* was precisely to make things easier for the trademark authorities. It should also be borne in mind that a depositor of a trademark published before January 1, 1973, can, after this date, bring separate proceedings against the owner of the mark on which the opposition is based, the grounds for those separate proceedings being failure to use, and can then get his own mark registered by means of what is known as an action for authority to register. He is debarred from invoking the legal obligation to use only with reference to the opposition procedure.

Two other important decisions hinged on the question of the conditions to be fulfilled in order for the use to meet the

³² Cf. May 11, 1973 — *Gyromat*, GRUR 1973, p. 606, with commentary by Droste.

³³ Cf. January 18, 1974 — *Lomapect*, GRUR 1974, p. 465, with commentary by Utescher.

³⁴ Cf. November 30, 1973 — *Erba*, GRUR 1974, p. 279, with commentary by Pietzcker.

³⁵ BGH of March 3, 1973 — *Lewapur*, GRUR 1972, p. 600, with commentary by Droste.

³⁶ Cf. *Industrial Property*, 1973, pp. 125 et seq.

³⁷ BGH of May 3, 1974 — *Porotex*, GRUR 1974, p. 659, with commentary by Heydt.

³⁸ Cf. Heil, *Benutzungszwang in der Praxis des Deutschen Patentamts*, GRUR 1973, pp. 170 and 172.

requirements of the obligation to use. In one case³⁹, the question was whether the use was adequate if a trademark registered only for *imported goods* was used solely for goods produced within the country. The Federal Supreme Court replied in the affirmative to this question, laying particular emphasis on the limited purpose which the observation "import-export" is intended to serve in the list of products to which a trademark is referable: it is not intended to restrict the scope of legal protection of the trademark but only to make it clear that the registration of the mark is not yet to be taken as an indication that it may be validly used within the country. The validity of such use may, for example, in the case of foreign language designations, be dubious from the standpoint of confusion as to the geographical origin of the goods. In the view of the Federal Supreme Court, it appears, having regard to this limited purpose of the observation "import-export", that use is adequate so far as regards obligation to use if the mark is used only for domestic goods.

The *KIM-Mohr* case⁴⁰ provided the Federal Supreme Court with its first opportunity to reach a decision on the important question of the conditions in which a use of a trademark in a *modified form* of the registered version constitutes an adequate use in the sense of obligation to use. In this action, the opponent referred to a combined word and image mark for cigarettes in which a Moor was displayed in front of the outline of an oriental town, under which the word *KIM* appeared in broad calligraphy together with the words *Echte Orient-Cigaretten* in small print. In 1970, i. e., during the period of grace provided in the *Vorabgesetz* as regards the obligation to use, the opponent had used only the word component *KIM* in this mark. Although the Federal Supreme Court has not itself decided whether this constitutes an adequate use of the registered mark, it has established the following principles, which are to be approved, for the judgment of the question by the Court of Appeal:

In principle, maintenance of the mark protection can only be assured by a use corresponding to the registered form. However, exceptions in which a modified form may be regarded as an adequate use of the registered trademark are possible. The prerequisite of such an assumption is that the public should consider the registered form and the form actually used as one and the same mark. The extent to which this occurs will largely depend on the actual practice in the trade concerned. According to this principle, even the mere use of the word component of a combined word-and-picture mark may possibly constitute an adequate use of the mark.

The Federal Supreme Court arrived at this conclusion after weighing up the interests concerned: the purpose for which the obligation to use was introduced, namely, to remove unused marks from the list and to make it possible for new trademarks to be registered, should not be jeopardized by an over-generous approach to the criteria of use. On the other hand, economic values, particularly those embodied in fairly old trademarks, should not be destroyed without a com-

elling reason. On the latter point, account also had to be taken of the fact that numerous owners of old trademarks had in the past used their marks in modified and, in particular, modernized forms on the assumption that this would not weaken their legal position. Moreover, the Federal Supreme Court was able to rely upon Article 5C(2) of the Paris Convention for guidance in reaching its conclusion. This provides that the use of a trademark in a modified form shall not impair the protection granted to the trademark provided that the modification affects only component parts and that the distinctive character of the mark is not thereby affected.

It should also be pointed out in this connection that, particularly in the transitional period, i. e., until the general obligation to use comes into full effect, the principles, recognized in case law, relating to the restricted protection of *reserve* and *defensive marks* shall continue to apply⁴¹. These principles have been recently confirmed and even extended. One of them is that the subsequent use of a temporarily unprotected reserve or defensive mark is ineffective in relation to marks which are liable to confusion and in which somebody else has acquired rights before such use. As recognized in the *King* judgment⁴², this ruling also holds good if the more recent mark has been deposited even before the older reserve or defensive mark became unprotected. In the same judgment it was also held, with regard to the principles evolved concerning reserve and defensive marks, that the fact that negotiations for the granting of a trademark license are taking place does not as a rule justify the conclusion that there is an interest worthy of protection such as to maintain a trademark which has been left unused for an unduly long period. Some misgivings might be aroused by a further finding in this judgment, according to which protection is generally removed from reserve and defensive marks after a five-year period of non-use even before the obligation to use has become effective. In our view, this constitutes an unwarrantable extension of the effects of the newly-introduced general obligation to use. In case law, reserve and defensive marks have hitherto not generally been considered due for expiry until after much longer periods of non-use⁴³.

6. Transfer of trademarks

A significant clarification of the conditions governing the effective transfer of trademarks (and firm names) was provided by the Federal Supreme Court's *Baader* decision⁴⁴. Under German law, trademarks and firm names can only be effectively transferred to another provided that the business to which they belong is simultaneously transferred (Article 8(1), 2nd sentence of the Trademark Law, Article 23 of the Commercial Code). Although this ruling is widely regarded as anachronistic, it is still the law in force. This linking of the transfer of the mark to the transfer of the business is intended to maintain the original function of the marks be-

⁴¹ Cf. also *Industrial Property*, 1973, pp. 131 et seq.

⁴² Particularly BGH of October 26, 1973 — *King*, GRUR 1974, p. 276, with commentary by Kraft.

⁴³ Cf. *Industrial Property*, 1973, p. 122.

⁴⁴ BGH of May 26, 1972 — *Baader*, GRUR 1973, p. 363, with commentary by Heydt.

³⁹ BGH of January 31, 1975 — *Importvermerk*, GRUR 1975, p. 258, with commentary by Heydt.

⁴⁰ Decision of May 31, 1974 — *KIM-Mohr*, GRUR 1975, p. 135, with commentary by Schulze zur Wiesche.

longing to a business and to prevent the public from being misled. With regard to the simultaneous transfer of the business, the above decision explains with gratifying clarity that the indispensable prerequisite of the effective transfer of the mark is a genuine and not an apparent transfer of the business or part thereof. However, it is immaterial whether the transferer intends to continue the business or not. This is a unilateral subjective decision on the part of the transferee which, in the interests of legal certainty, should not be made a condition of the effective transfer of the mark.

7. Conditions governing the protection of attributes (*Ausstattungsschutz*)

Under German law, protection is not of course restricted to registered trademarks but is also extended to unregistered attributes provided that they have been accepted as distinguishing the goods of a firm. The term "attributes" therefore includes not only the external appearance of a commodity — its form, color and packaging; practically speaking, protection is afforded rather to all the conceivable distinguishing forms, particularly all those signs for which trademark protection can be justified by registration. Thus mere word signs and word components of word-picture compounds are subject to protection as attributes.

With regard to such word signs or word components, the Federal Supreme Court has been called upon to decide two cases which hinged on whether the conditions of protection of attributes were fulfilled. It was a particular feature of both cases that the terms employed were fundamentally *generic names* for particular goods, which were both used by a large number of manufacturers and for which it was difficult to find alternatives. One case⁴⁵ concerned the use of the dialect term *Kroatzbeere* for a blackberry liqueur, while the other case⁴⁶ concerned the use of the term *Stonsdorfer* for a herb liqueur which from being an indication of geographical origin, had developed into a generic name. These facts did not of course constitute an obstacle to the granting of protection of attributes to a particular producer for the use of each of these designations; generic names can also, in the public mind, become characteristic signs denoting that particular goods originate from a particular firm. As the Federal Supreme Court rightly assumed in both cases, however, in view of the substantial need of competitors to be allowed free use of these generic names, this popular acceptance must be virtually unanimous for protection of attributes to be allowed. A survey showed that, in the case of *Kroatzbeere*, 58.6% and in the case of *Stonsdorfer* as much as 74% of the public associated the firm with an individual designation of commercial origin. However, public acceptance of these terms as indications of commercial origin was by no means "virtually unanimous," so that protection of attributes was denied.

These decisions of the Federal Supreme Court thus consistently uphold the previous case law relating to the protec-

tion afforded to so-called straightforward descriptions of properties, there being strong grounds for keeping use of these unhampered⁴⁷.

8. International trademark law

Finally, two interesting decisions concerning international trademark law are worthy of mention.

The first decision⁴⁸ related to the eligibility for protection of the internationally-registered Italian mark *Lemonsoda* for lemon-containing drinks in the Federal Republic of Germany. After being used for some decades in Italy, the mark had achieved substantial market acceptance; it had also been widely used in Switzerland. The German public, however, construed the term *Lemonsoda*, previously not used as a mark in the Federal Republic, merely as a non-distinctive indication of the nature of the goods. The judgment therefore hinged on the question whether, under Article 6^{quinquies} B.2 and C of the Paris Convention, protection should be either denied to or withdrawn from the internationally-registered mark *Lemonsoda* in Germany or whether such action should be ruled out on grounds of the *wide trade acceptance and use of the mark in Italy and Switzerland*. The Federal Supreme Court ruled that the decision whether protection should be denied on grounds of insufficient distinctiveness should be based solely on the conditions prevailing in the country in which protection was challenged. Admittedly, allowance should also be made for conditions in other countries, particularly the considerable trade acceptance of the mark in the country of origin, Italy; this, however, applied only to the extent that market acceptance was affected in the country in question (i. e., the Federal Republic of Germany). Since, however, the mark *Lemonsoda* had not yet been accepted in Germany as denoting the commercial origin of the commodity, protection was withdrawn.

It is regrettable that the German Federal Supreme Court is not prepared to attach greater weight to the considerable foreign trade acceptance of a mark in judging eligibility for protection in Germany. In view of the increasing economic interdependence of states, excessive emphasis on domestic conditions in deciding the eligibility for protection of international marks is no longer in keeping with economic facts and requirements. In cases such as the one described above, in which competitors have no need to use the sign to describe their own goods, the fact that a descriptive indication has already become a well-known commercial mark in a country with which there are such close economic links should also be given decisive weight in the Federal Republic. Although the Federal Supreme Court based its decision primarily on an interpretation of the provisions of the Paris Convention, particularly with regard to its historical background, it would nevertheless seem that it was the influence of the territorial

⁴⁵ BGH of May 31, 1974 — *Kroatzbeere*, GRUR 1975, p. 67, with commentary by Heydt.

⁴⁶ BGH of July 31, 1973 — *Stonsdorfer*, GRUR 1974, p. 337, with commentary by Heydt.

⁴⁷ Cf. BGH of June 30, 1959 — *Nährbier*, GRUR 1960, p. 83, with commentary by Hefermehl.

⁴⁸ BGH of January 23, 1974 — *Lemonsoda*, GRUR 1974, p. 777, with commentary by Heydt — 5 *International Review of Industrial Property and Copyright Law* (IIC), p. 451 (1974) (English translation).

principle, insufficiently understood, that subconsciously governed the decision⁴⁹.

The *Cinzano* decision⁵⁰, the last case which we shall discuss here, relates to the well-known problem of the *parallel importation of trademarked goods*, involving exhaustion of the domestic right to the mark by the introduction of products using the same mark abroad. The action related to the alleged infringement of several German trademarks using the word *Cinzano*. The plaintiff, owner of the mark, was the German subsidiary of the Italian enterprise Francesco Cinzano & Cia, S. p. A.; the plaintiff sells in the Federal Republic the well-known Cinzano vermouth wines made by the Italian parent-company. The plaintiff's action was against the sale in the Federal Republic of Germany of Cinzano vermouths coming from Spain and France, where they are produced by the Spanish subsidiary and by the French licensee of the Italian parent-company, and are imported into the Federal Republic by the defendant, a trading enterprise, for the purposes of sale. The labels of the French and Spanish Cinzano vermouth wines sold by the defendant were in most respects identical to those on the Italian products, sold by the plaintiff. The French and Spanish Cinzano vermouth wines have a different taste from Italian Cinzano. The plaintiff lost his case before the Federal Supreme Court. The Court's *Cinzano* judgment thus brings to a convincing conclusion, so far as the Federal Republic of Germany is concerned a development which began with the well-known *Maja* case⁵¹, which was also decided by this Court. In this earlier decision the Court had correctly barred the attempt of the owner of a trademark on the basis of his German trademark, to prevent the import of unaltered trademark goods which he had himself put on the market

⁴⁹ Cf. on this and related questions Beier, *Die Bedeutung ausländischer Tatumsstände für die Markenschutzfähigkeit*, GRUR 1968, pp. 492—497.

⁵⁰ BGH of February 2, 1973 — *Cinzano*, BGHZ pp. 60 and 185 — GRUR 1973, p. 468, with commentary by Heydt — GRUR (*Internationaler Teil*) 1973, p. 562, with commentary by Beier — 4 IIC, p. 432 (1973) with commentary by Beier (English translation).

⁵¹ Cf. *Industrial Property*, 1968, p. 309.

abroad under the same mark. From the standpoint of the "exhaustion" of the right to the trademark, the Federal Supreme Court convincingly ruled that it was the purpose of the trademark to denote the commercial origin of the goods covered by the mark and that the right to the trademark had in fact achieved that purpose (had become "exhausted") when the owner of the trademark put the goods which he had himself marked on the market. He could thus no longer prevent the further circulation of the goods on grounds of his right to the trademark.

The *Cinzano* decision upholds this interpretation and develops it from two different standpoints: in the first place, it ruled that the fact that the Spanish and French Cinzano wines, imported by the defendant into Germany, were not first marketed by the plaintiff but by a different subsidiary and a licensee of the Italian parent-company is immaterial. As a member of an *international group of companies*, the plaintiff must take account of the other companies belonging to the group, since these actions, i. e., the sale of Cinzano vermouth wines in Spain and France, have taken place with the consent of the Italian parent-company.

Secondly, the *Cinzano* decision is the first judgment to be handed down since the War in connection with the keenly debated problem of the *parallel importation of trademarked goods of different qualities* which arose in conjunction with *Nescafé*. From the standpoint of trademark law, the Court rightly holds it to be immaterial that the Spanish and French Cinzano wines have different tastes as compared with Italian Cinzano. In explaining this ruling, the Federal Supreme Court, again rightly, makes special reference to the fact that the sole legally relevant function of the trademark is to denote origin; accordingly the parallel import of trademarked goods of different quality does not lead to confusion in the public mind.

The Federal Supreme Court's *Cinzano* decision is to be welcomed in that it finally puts a stop to any attempts to misuse trademark law as a means of dividing up the market and hindering international trade, contrary to its real function.

NEWS ITEMS

PAKISTAN*Registrar of Trade Marks*

We have been informed that Mr. Riaz Ahmed Malik has been appointed Registrar of Trade Marks. He succeeds Mr. H. H. Rahman.

We take this opportunity of congratulating Mr. Malik on his appointment.

SPAIN*Head of the Spanish Register of Industrial Property*

We have been informed that Mr. Antonio Villalpando Martínez has been appointed Head of the Spanish Register of Industrial Property. He succeeds Mr. Antonio Fernández-Mazarambroz.

We take this opportunity of congratulating Mr. Villalpando Martínez on his appointment.

CALENDAR

WIPO Meetings

- September 17 to 19, 1975 (Geneva) — ICIREPAT — Plenary Committee (PLC)
- September 22 and 23, 1975 (Geneva) — Trademark Registration Treaty (TRT) — Interim Advisory Committee
- September 23 to 30, 1975 (Geneva) — WIPO Coordination Committee; Executive Committees of the Paris and Berne Unions; Assembly and Committee of Directors of the Madrid Union; Assembly of the Nice Union
- October 1 to 3, 1975 (Geneva) — Scientific Discoveries — Committee of Experts
- October 1 to 3, 1975 (Geneva) — International Patent Classification (IPC) — Bureau
- October 6, 1975 (Geneva) — International Patent Classification (IPC) — Joint ad hoc Committee
- October 7 to 9, 1975 (Geneva) — International Patent Classification (IPC) — Assembly and Committee of Experts
- October 13 to 17, 1975 (Nairobi) — Conference on Industrial Property Laws of English-Speaking Africa — Committees of Experts (convened jointly with the Economic Commission for Africa of the United Nations)
- October 13 to 17, 1975 (Geneva) — ICIREPAT — Technical Committee for Search Systems (TCSS)
- October 20 to 24, 1975 (Washington) — ICIREPAT — Technical Committee for Standardization (TCST)
- October 27 to 31, 1975 (Mexico City) — Latin American and Caribbean Seminar on the Rights of Performers, Producers of Phonograms and Broadcasting Organizations
(Meeting organized jointly with ILO and Unesco)
- October 27 to November 3, 1975 (Geneva) — Patent Cooperation Treaty (PCT) — Interim Committees
- November 3 to 7, 1975 (Geneva) — International Classification of Goods and Services for the Purposes of the Registration of Marks — Committee of Experts
- November 3 to 14, 1975 (Berne) — International Patent Classification (IPC) — Working Group II

- November 10 to 14, 1975 (Geneva) — Revision of the Model Law on Inventions — Working Group (3rd session)
- December 1 to 5, 1975 (Geneva) — International Protection of Appellations of Origin and Other Indications of Source — Committee of Experts
- December 1 to 12, 1975 (Munich) — International Patent Classification (IPC) — Working Group III
- December 8, 9 and 16, 1975 (Geneva) — International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations — Intergovernmental Committee — Ordinary Session (jointly organized with ILO and Unesco)
- December 10 to 12, 1975 (Geneva) — ICIREPAT — Technical Coordination Committee (TCC)
- December 10 to 16, 1975 (Geneva) — Executive Committee of the Berne Union (Extraordinary Session)
- December 15 to 19, 1975 (Geneva) — International Classification of the Figurative Elements of Marks — Provisional Committee of Experts
- December 15 to 22, 1975 (Geneva) — Revision of the Paris Convention for the Protection of Industrial Property — Group of Governmental Experts
- March 15 to 19, 1976 (Geneva) — WIPO Permanent Legal-Technical Program for the Acquisition by Developing Countries of Technology Related to Industrial Property — Permanent Committee (3rd session)
- September 27 to October 5, 1976 (Geneva) — WIPO General Assembly, Conference and Coordination Committee; Assemblies of the Paris, Madrid, Nice, Lisbon, Locarno, IPC and Berne Unions; Conferences of Representatives of the Paris, Nice and Berne Unions; Executive Committees of the Paris and Berne Unions; Council of the Lisbon Union — Ordinary Sessions
- March 14 to 18, 1977 (Geneva) — WIPO Permanent Legal-Technical Program for the Acquisition by Developing Countries of Technology Related to Industrial Property — Permanent Committee (4th session)
- September 26 to October 4, 1977 (Geneva) — WIPO Coordination Committee and Executive Committees of the Paris and Berne Unions

UPOV Meetings

Council: October 7 to 10, 1975 — Consultative Committee: October 6 and 10, 1975 — Technical Steering Committee: November 6 and 7, 1975 — Committee of Experts on International Cooperation in Examination: November 4 and 5, 1975 — Committee of Experts on the Interpretation and Revision of the Convention: December 2 to 5, 1975; February 17 to 20, 1976

Note: All these meetings will take place in Geneva at the headquarters of UPOV

Technical Working Party for Ornamental Plants: September 9 to 11, 1975 (Hornum - Denmark)

Meetings of Other International Organizations concerned with Intellectual Property

- September 12 and 13, 1975 (Liège) — International League Against Unfair Competition — Study Meetings
- September 16 to 19, 1975 (Budapest) — International Federation of Musicians — Executive Committee
- September 17 to 20, 1975 (London) — Union of European Professional Patent Representatives — General Assembly
- September 22 to 24, 1975 (Basle) — Licensing Executives Society (LES) — International Conference
- October 1 to 3, 1975 (Berlin) — International Literary and Artistic Association — Working Session
- October 13 and 14, 1975 (Paris) — International Confederation of Societies of Authors and Composers — Legal and Legislative Commission
- October 21 to 23, 1975 (Rijswijk) — International Patent Institute — Administrative Board
- November 3 to 12, 1975 (Paris) — United Nations Educational, Scientific and Cultural Organization (UNESCO) — Committee of Governmental Experts on the Double Taxation of Copyright Royalties
- November 17 to December 15, 1975 (Luxembourg) — General Secretariat of the Council of Ministers of the European Communities — Luxembourg Conference on the Community Patent
- December 17 to 19, 1975 (Rijswijk) — International Patent Institute — Administrative Board
- May 25 to June 1, 1976 (Tokyo) — International Publishers Association — Congress