

# Industrial Property

Published monthly  
Annual subscription:  
Sw.fr. 140.-  
Each monthly issue:  
Sw.fr. 14.-

23rd Year - No. 9  
September 1984

Monthly Review of the  
World Intellectual Property Organization (WIPO)

## Contents

NOTIFICATIONS	
WIPO Conventinn. Accession: Cyprus .....	271
Patent Cooperation Treaty (PCT). Accession: Mali .....	271
Budapest Treaty (Microorganisms). Acquisitinn of the Status of Internatinnal Depository Authority: Nattinnal Collection of Animal Cell Cultures (NCACC) .....	271
PLANT VARIETIES	
Internatinnal Convention for the Protection of New Varieties nf Plants. Acceptance of the 1978 Act: Netherlands .....	273
WIPO MEETINGS	
WIPO Permanent Committee nn Patent Information (PCPI)	
I. Working Group on General Information .....	274
II. Wnrking Group on Special Questions .....	275
III. Working Group on Planning .....	275
IV. Working Group nn Search Informatinn .....	276
WIPO Permanent Program for Development Cooperation Related to Industrial Property. Group nf Consultants nn the Revision of the WIPO Licensing Guide for Developing Cnuntries .....	277
WIPO/UNDP. Regional Evaluatinn and Planning Meeting nn WIPO Development Cooperation Activities in the Field nf Industrial Property in Asia and the Pacific .....	278
GENERAL STUDIES	
The Functions nf Licensed Trademarks (A. Casado Cerviñn) .....	281
Comparison of United States Patent and Trademark Office, European Patent Office and Japanese Patent Office Patent Practice (M. Kalikow) .....	290
ACTIVITIES OF INDUSTRIAL PROPERTY OFFICES	
Swedish Patent and Trademark Centennial .....	300
NEWS FROM INDUSTRIAL PROPERTY OFFICES	
European Patent Office, Australia, India, Mauritius, Mexico .....	302
BOOK REVIEWS .....	303
CALENDAR OF MEETINGS .....	306
ANNEX	
Industrial Property Statistics for 1983 (Publication A)	

## INDUSTRIAL PROPERTY LAWS AND TREATIES

Editor's Nnte

### MEXICO

Agreement by Which a General Extension of One Year as from December 29, 1982, is Granted for Compliance with the Obligations Specified in Sections 127 and 128 nf the Law nn Inventinnns and Marks (of November 23, 1982) .....	Text 1-009
Agreement by Which a General Extension of One Year as from December 29, 1983, is Granted (of December 16, 1983) .....	Text 1-010

### SWEDEN

Decree on Patent Formalities (No. 838 of December 1, 1967, as last amended by Decree No. 435 of June 14, 1983) .....	Text 2-002
---	------------

© WIPO 1984

Any reproduction of nfficial notes nr reports, articles and translations of laws nr agreements published in  
this review is authorized nly with the prinr consent of WIPO.



## Notifications

### WIPO Convention

#### Accession

#### CYPRUS

The Government of Cyprus deposited, on July 26, 1984, its instrument of accession to the Convention Establishing the World Intellectual Property Organization, signed at Stockholm on July 14, 1967.

The said Convention will enter into force, with respect to Cyprus, on October 26, 1984.

WIPO Notification No. 129, of July 27, 1984.

---

### Patent Cooperation Treaty (PCT)

#### Accession

#### MALI

The Government of Mali deposited, on July 19, 1984, its instrument of accession to the Patent Cooperation Treaty (PCT), done at Washington on June 19, 1970.

The said Treaty will enter into force, with respect to Mali, on October 19, 1984.

PCT Notification No. 45, of August 6, 1984.

---

### Budapest Treaty (Microorganisms)

#### Acquisition of the Status of International Depository Authority

#### NATIONAL COLLECTION OF ANIMAL CELL CULTURES (NCACC)

The following written communication addressed to the Director General of WIPO by the Government of the United Kingdom under Article 7 of the Budapest

Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure was received on July 2, 1984, and is published by the International Bureau of WIPO pursuant to Article 7(2)(a) of the said Treaty:

"I have the honour to refer to the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, opened for signature at Budapest from 28 April to 31 December 1977. In accordance with the provisions of Article 7 of the said Treaty, the Government of the United Kingdom of Great Britain and Northern Ireland nominate the National Collection of Animal Cell Cultures (NCACC) as an International Depository Authority (IDA). The Government of the United Kingdom furnish their assurances that the NCACC complies and will continue to comply with the requirements specified in Article 6(2) of the Treaty for an IDA. The requisite information concerning this nominated Depository Institution is set out below.

"Accordingly I have the further honour to request that you carry out the procedures established by the Treaty and Regulations made under it, in connection with the acquisition of the status of IDA by the Institution nominated herein. The NCACC will start accepting deposits on 24 July 1984, and in accordance with Treaty Article 7(1)(b) hereby requests that the NCACC assumes an IDA status as from 12 July 1984.\*

"The NCACC is part of the Vaccine Research and Production Laboratory at the Public Health Laboratory Service (PHLS), Centre for Applied Microbiology and Research (CAMR), Porton Down, Salisbury, Wiltshire, SP4 0JG, England.

"The NCACC is the responsibility of the Public Health Laboratory Service Board (PHLSB), a corporate body established in the United Kingdom by Act of Parliament in 1961.\*\*

"The NCACC occupies a suite of laboratories which have been specifically designed and built to operate an animal cell culture collection. These facilities are separate, but adjacent to, the CAMR main

---

\* Note by the International Bureau of WIPO: in accordance with Article 7(2)(b) of the Treaty, the status of international depository authority is acquired from the date of publication, in this instance, September 30, 1984, inasmuch as the date indicated (July 12, 1984) is not later than the date of publication.

\*\* Public Health Laboratory Service Act, 1960, now incorporated into the National Health Service Act, 1977, which has been amended by Public Health Laboratory Service Act, 1979.

building. This allows the specialised technical and administrative support services in CAMR to be used without risking the biological integrity of the NCACC. A staff of five have been recruited to fulfil the various specialised scientific roles needed to operate the NCACC in a manner that ensures that deposits are kept viable and uncontaminated. There is an independent Scientific Advisory Committee which includes individuals prominent in the field of culture collections and cell biology. The NCACC performs its work in an impartial and objective way, and will be available for the purposes of Deposit under the Treaty to any Depositor under the same conditions.

"The NCACC has all the facilities necessary for the culturing, checking and long term preservation of animal cells. Cultures are stored routinely by freezing in liquid nitrogen. Patent cultures are stored in a locked refrigerator, and are subject to regular audit. Only authorised staff have access to them. To minimise the risk of loss, duplicate cultures and records are stored in a building separate from that housing the main collection.

"The NCACC is equipped and run in full accordance with the United Kingdom Health and Safety at Work, etc., Act, 1974, and in accordance with the advice contained in the 'Code of Practice for the Prevention of Infection in Clinical Laboratories and Post-Mortem Rooms' (HMSO 1978), so far as is reasonable and practicable.

"The NCACC will accept for deposit cell lines that can be preserved without significant change to or loss of their properties by freezing and long term storage. A statement on their possible pathogenicity to man and/or animals is required.

"In accordance with the Regulations under the Budapest Treaty, the NCACC will, in respect of cell lines referred to in paragraphs 6 and 8 above:

- (a) examine the viability of cell lines and store them;
- (b) issue receipt and viability statements as prescribed;
- (c) comply with the prescribed secrecy requirements; and
- (d) furnish samples under the conditions and in conformity with the prescribed procedures.

"On behalf of the nominated Depository Institution, I have the honour to inform you that in accordance with Rule 6.3(a) of the Regulations referred to above, the NCACC requires before it will accept cell lines for deposit:

- (i) that a deposit of cell lines should be in an appropriate form and adequate quantity to enable NCACC to carry out properly its duties under the Regulations;
- (ii) that Accession Forms established by the NCACC for the purpose of administrative procedures (annexed hereto) be completed;
- (iii) that the written statement referred to in Rule 6.1(a) or 6.2(a) be drafted in English;
- (iv) that the fee for storage referred to in Rule 12.1(a)(i) be paid; and
- (v) that the depositor complete the Application Form of the NCACC (annexed hereto) in order to enter into a contract with the NCACC establishing terms and conditions on which deposit will be accepted.

"The following fees will be payable to the Public Health Laboratory Service Board:

For the storage of the cell line in accordance with the Treaty . . . . .	£600.00
For the issue of a Viability Statement in those cases in which, in accordance with Rule 10.2, a fee may be charged . . .	£30.00
For furnishing of a sample in accordance with Rule 11.2 or 11.3 . . . . .	£50.00

All charges paid within the United Kingdom are subject to Value Added Tax at the current rate.

"The official language of the NCACC is English."

[End of text of Communication]

Pursuant to Article 7(2)(b) of the Budapest Treaty, the NCACC acquires the status of international depository authority as from September 30, 1984 (date of the present publication).

Budapest Communication No. 20 (this Communication is the subject of Budapest Notification No. 40, of July 17, 1984).

## **Plant Varieties**

### **International Convention for the Protection of New Varieties of Plants**

#### **Acceptance of the 1978 Act**

#### **NETHERLANDS**

The Government of the Netherlands deposited, on August 2, 1984, its instrument of acceptance, for the Kingdom in Europe, of the Act of October 23, 1978, of the International Convention for the Protection of New Varieties of Plants (UPOV) of December 2, 1961, as revised at Geneva on November 10, 1972.

The said International Convention as revised in 1978 entered into force, with respect to the Netherlands, on September 2, 1984.

UPOV Notification No. 31, of August 3, 1984.

## WIPO Meetings

### WIPO Permanent Committee on Patent Information (PCPI)

#### I. Working Group on General Information

Sixth Session  
(Geneva, April 9 to 13, 1984)

#### NOTE\*

The PCPI Working Group on General Information (hereinafter referred to as "the Working Group") held its sixth session in Geneva in April 1984. Seventeen States and one intergovernmental organization, members of the Working Group, were represented, with observers from four international non-governmental organizations. The list of participants follows this Note.

The Working Group discussed WIPO Standard ST.16—Standard Code for the Identification of Different Kinds of Patent Documents—and requested the International Bureau to prepare a revised updated Annex thereto, discussed a draft prepared by the International Bureau of a proposed Recommendation Concerning Name Indexes to Patent Documents and requested the International Bureau to prepare a further draft based upon the conclusions of that discussion, agreed upon (subject to adoption by the PCPI) a standard format for the Exchange in Machine-Readable Form of Bibliographic Data, Abstracts and the Full Texts of Patent Documents, and discussed and agreed upon, subject to a further round of comments, a draft standard for the Recording of International Patent Classification (IPC) Symbols on Machine-Readable Records which takes into account certain changes introduced into the fourth edition of the IPC, e.g., the introduction of hybrid symbols.

The Working Group discussed in detail, and approved, the proposals of the International Bureau for the improvement of the WIPO Industrial Property Statistics which would lead, in due course, to improved statistics useful for assessing the impact of international or regional agreements in the field of industrial property and discussed a proposal by the German Democratic Republic concerning amendments to WIPO Standard ST.7/E (Guidelines for Photo-Optically Generated Microfiches).

The Working Group finally agreed to recommend to the PCPI that WIPO Standard ST.3—Two-Letter Code for Countries, Organizations and the Like— should be amended to provide the code "AP" to represent the Industrial Property Organization for English-Speaking Africa (ESARIPO) and that INID Code 84 (Designated Contracting States under the European Patent Convention) provided in WIPO Standard ST.9—Recommendation concerning Bibliographic Data on and relating to Patent Documents—should be redefined so that ESARIPO could use that code to indicate designated contracting States on the front page of patent documents issued by ESARIPO following the entry into force on April 25, 1984, of the Protocol to the Lusaka Agreement establishing ESARIPO.

#### LIST OF PARTICIPANTS\*

##### I. Member States

**Austria:** H. Erber. **Canada:** W. Berdnikoff; C. McDermott. **Czechoslovakia:** M. Kopča; M. Fortová. **Denmark:** I.-L. Frisenberg. **Finland:** J. Rainesalo. **France:** M. Verderosa; M. Monka. **German Democratic Republic:** H. Konrad. **Germany (Federal Republic of):** H. Hannus. **Japan:** S. Ono. **Netherlands:** S. De Vries. **Norway:** P.E. Lillejordet. **Soviet Union:** A. Alekseev. **Spain:** A. Gómez García. **Sweden:** J.-O. Hyltner. **Switzerland:** M. Leuthold; K. Grünig. **United Kingdom:** T. Saul. **United States of America:** G. King.

##### II. Member Organization

**European Patent Office (EPO):** C.J. Jonckheere; H. De Vries.

##### III. Observer Organizations

**Patent Documentation Group (PDG):** P. Ochsenbein. **Commission of the European Communities (CEC):** H. Bank. **International Patent Documentation Center (INPADOC):** G. Quarda. **International Federation for Documentation (FID):** F. Schweikhardt.

##### IV. Officers

**Chairman:** I.-L. Frisenberg (Denmark). **Vice-Chairmen:** M. Leuthold (Switzerland); H. Konrad (German Democratic Republic). **Secretary:** P. Higham (WIPO).

\* Prepared by the International Bureau.

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

## V. International Bureau of WIPO

P. Claus (*Director, Patent Information and Classification Division*); B. Hansson (*Head, Patent Classification Section, Patent Information and Classification Division*); P. Higham (*Head, Patent Information Section, Patent Information and Classification Division*); R. Blumstengel (*Head, Developing Countries Section (Patent Information)*); G. Negulyaev (*Patent Information Officer, Patent Information Section*).

\* \* \*

## II. Working Group on Special Questions

Fifth Session  
(Geneva, May 3 to 11, 1984)

### NOTE\*

The PCPI Working Group on Special Questions (hereinafter referred to as "the Working Group") held its fifth session in Geneva in May 1984. Fourteen States and one intergovernmental organization, members of the Working Group, were represented, together with, upon the special invitation of the Director General, observers from eight organizations who were present during discussions of an agenda item concerning computerized searching aids. The list of participants follows this Note.

The Working Group completed its study of computerized searching aids by noting demonstrations given by observers from three organizations which had not demonstrated at the second session of the Working Group held in September 1982, gave guidance to the International Bureau so as to complete the inventory of available computerized searching aids that are devoted wholly, or for a substantial part, to patent information, agreed to recommend to the PCPI that the International Bureau should discuss with the brokers and/or vendors of such aids ways and means whereby closer coordination and standardization of the on-line services available could be undertaken, and also agreed to recommend to the PCPI certain steps that should be taken so as to assist developing countries in their access to and use of on-line retrieval of patent information.

The Working Group discussed a study made by INPADOC concerning the extension of the CAPRI System (*viz.* the Computerized Administration of Patent Documents Reclassified According to the IPC) so as to cover patent documents issued from 1973 and asked the International Bureau to obtain a slightly revised study from INPADOC, agreed upon a revised text of the IPC Revision Instructions which will be published in the *WIPO Handbook on Patent Information and Documentation*, had a preliminary discussion of the replies received to a recent WIPO Circular concerning the continuation of the JOPAL (*WIPO Journal of Patent-Associated Literature*) project and agreed upon the final text of the Introductory Manual to the IPC.

\* Prepared by the International Bureau.

## LIST OF PARTICIPANTS\*\*

### I. Member States

**Anstralia:** N. Young. **Austria:** F. Sohs. **Brazil:** G.R. Coaracy; A.R. de Holanda Cavalcanti. **Canada:** J.H.A. Gariépy; G.K. Guzzo. **Denmark:** H.I. Rasmussen. **France:** I. Savignon; A. de Pastors. **Germany (Federal Republic of):** W. Weiss. **Japan:** K. Yokoi; S. Ono. **Soviet Union:** K. Kukolev; V. Morenko. **Spain:** A. Gómez García. **Sweden:** L.G. Björklund; K. Bergström. **Switzerland:** E. Caussignac; R. Egli. **United Kingdom:** V.S. Dodd. **United States of America:** W.S. Lawson; T.F. Lomont.

### II. Member Organization

**European Patent Office (EPO):** A. Vandecasteele; R. Baré; C. Jonckheere; H.J. Schrijvers.

### III. Observer Organizations

**Chemical Abstracts Service:** A. Messmore; M.C. Jérôme. **Derwent Publications Ltd.:** A.M. Brooks; P. Dixon. **International Patent Documentation Center (INPADOC):** G.A. Rubitschka. **Japan Patent Information Center (JAPATIC):** H. Uchiyama; N. Tamai; J. Ochiai. **Japan Institute of Invention and Innovation (JIIC):** K. Obashi. **Mead Data Central Corporation:** A.F. Sharp. **Pergamon International Information Corporation:** P.J. Terragno. **Télésystèmes-Darc:** B. Drobycz.

### IV. Officers

**Chairman:** W.S. Lawson (United States of America). **Vice-Chairmen:** F. Sohs (Austria); A. de Pastors (France). **Secretary:** P. Higham (WIPO).

## V. International Bureau of WIPO

L.E. Kostikov (*Deputy Director General*); P. Claus (*Director, Patent Information and Classification Division*); B. Hansson (*Head, Patent Classification Section, Patent Information and Classification Division*); P. Higham (*Head, Patent Information Section, Patent Information and Classification Division*).

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

\* \* \*

## III. Working Group on Planning

Thirteenth Session  
(Geneva, May 3 to 11, 1984)

### NOTE\*

The PCPI Working Group on Planning (hereinafter referred to "the Planning Group") held its thirteenth session in Geneva from May 3 to 11, 1984. Thirteen States and one intergovernmental organization, members of the Planning Group were represented at the session. The list of participants follows this Note.

\* Prepared by the International Bureau.

The Planning Group decided to recommend to the PCPI that the Working Group on General Information should deal with the task of studying, in two phases, the question of the reciprocal admittance of priority documents on microfiche: the said Working Group should first look at the various alternative forms (e.g., paper or microform) in which priority documents could be made available, and should study the cost elements involved in each of those alternatives; the findings of the said Working Group should then be considered by the Planning Group with a view to making recommendations on how this question should be further dealt with.

On the question of the filing of patent applications in machine-readable form, the Planning Group, in view of the ongoing efforts at the EPO, decided that work in this area by PCPI bodies should be suspended in order to wait for the results of those efforts.

The Planning Group discussed a proposal for the establishment of an internationally agreed upon program for the elaboration of hybrid systems—that is, search systems in which indexing terms are combined with classifying terms—and decided to recommend to the PCPI that one of the tasks of the 1984-1985 program be reworded in order to clarify that the said task would include part of the proposal. It also decided to recommend that a detailed proposal concerning means of reducing the bulkiness of search files be put on the program of the PCPI in the present biennium (1984-1985), and be dealt with by the Working Group on Special Questions. It invited its members to submit comments on a proposal concerning the development of hybrid systems.

The Planning Group recommended to the PCPI the adoption of revised working procedures; it also recommended revision of the PCPI program for the 1984-1985 biennium in respect of certain IPC revision requests and the addition to the said program of tasks concerning the standardization of official gazettes and other patent "announcement" journals, e.g., abstract journals, and guidelines for the publication of indexes issued periodically by industrial property offices.

Finally, the Planning Group began consideration of a proposal on the possible WIPO contribution to offices preparing translations of new editions of the IPC, in order to enable those offices expeditiously to prepare exact translations of the authentic versions, and made arrangements for further information and comments to be submitted.

#### LIST OF PARTICIPANTS\*

##### I. Member States

**Australia:** N. Young. **Austria:** F. Sohs. **Brazil:** G.R. Coaracy; A.R. de Holanda Cavalcanti. **Canada:** J.H.A. Gariépy; G.K. Guzzo.

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

**France:** A. de Pastors. **Germany (Federal Republic of):** W. Weiss. **Japan:** K. Yokoi; S. Ono. **Soviet Union:** V. Kukolev; V. Morenko. **Spain:** A. Gómez García. **Sweden:** L.G. Björklund; K. Bergström. **Switzerland:** E. Caussignac. **United Kingdom:** V.S. Dodd. **United States of America:** W.S. Lawson; T.F. Lomont.

##### II. Observer State

**Denmark:** H.I. Rasmussen.

##### III. Member Organization

**European Patent Office (EPO):** A. Vandecasteele; R. Baré.

##### IV. Officers

**Chairman:** W.S. Lawson (United States of America). **Vice-Chairmen:** F. Sohs (Austria); A. de Pastors (France). **Secretary:** P. Claus (WIPO).

##### IV. International Bureau of WIPO

L.E. Kostikov (*Deputy Director General*); P. Claus (*Director, Patent Information and Classification Division*); B. Hansson (*Head, Patent Classification Section, Patent Information and Classification Division*); P. Higham (*Head, Patent Information Section, Patent Information and Classification Division*).

\* \* \*

##### IV. Working Group on Search Information

Twelfth Session  
(Geneva, May 14 to 25, 1984)

##### NOTE\*

The PCPI Working Group on Search Information (hereinafter referred to as "The Working Group") held its twelfth session in Geneva from May 14 to 25, 1984. Fourteen States and one intergovernmental organization, members of the Working Group, were represented at the session. The list of participants follows this Note.

The following items were discussed:

*IPC Revision Projects Carried Over from the 1983 Program.* The Working Group discussed 25 IPC

\* Prepared by the International Bureau.



revision projects carried over from the 1983 program and completed 13 of them. It agreed to amendments, in one language version, to eight subclasses.

*IPC Revision Projects on the 1984/1985 Program.* The Working Group discussed 46 of the other IPC revision projects of the 1984/1985 program and completed 14 of them. It agreed to amendments, in one language version, to 38 subclasses. Among them was subclass B 41 J, dealing with "selective printing mechanisms," which was substantially revised.

*Revision of the Guidelines on the Organization of Search Files Based on the IPC.* The Working Group agreed on a revised text of the Guidelines on the Organization of Search Files Based on the IPC, which now will correspond to the fourth edition of the IPC which will enter into force on January 1, 1985.

## LIST OF PARTICIPANTS\*

### I. Member States

**Brazil:** S.M. Fernandes Serpa; C.R. da Costa. **Denmark:** H.J. Petersen. **Finland:** H.T. Lommi. **France:** M. Lyon; P. Viala; L. Hornik; M. Lavé. **German Democratic Republic:** H. Konrad. **Germany (Federal Republic of):** K. Molewski; H. Brem; W. Höfer; E. Moritz; W. Anders. **Japan:** K. Yokoi; S. Ono. **Norway:** O. Os. **Soviet Union:** M. Makarov. **Spain:** J.D. Vila Robert. **Sweden:** J. von Döbeln. **Switzerland:** E. Caussignac; J. Borloz. **United Kingdom:** G. Lindsey; P. Redding. **United States of America:** P. Sullivan; R. Johnson.

### II. Member Organization

**European Patent Office (EPO):** E. De Bundel; F. Borms; R.P. Espeel; J.F.C. Atkins; H. Schrijvers.

### III. Officers

*Chairman:* E. De Bundel. *Vice-Chairman:* P. Sullivan. *Secretary:* B. Hansson (WIPO).

### IV. International Bureau of WIPO

L.E. Kostikov (*Deputy Director General*); B. Hansson (*Head, Patent Classification Section, Patent Information and Classification Division*); A. Sagarminaga (*Senior Patent Classification Officer, Patent Classification Section*); A. Nakamura (*Senior Patent Classification Officer, Patent Classification Section*).

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

## WIPO Permanent Program for Development Cooperation Related to Industrial Property

### Group of Consultants on the Revision of the WIPO Licensing Guide for Developing Countries

(Geneva, June 18 to 22, 1984)

#### NOTE\*

The Group of Consultants on the Revision of the WIPO Licensing Guide for Developing Countries (hereinafter referred to as "the Group of Consultants" and "the Guide," respectively) met in Geneva from June 18 to 22, 1984.

The meeting was convened by the Director General of WIPO pursuant to a recommendation made in June 1976 by the Working Group on Guidelines for Industrial Property Licensing in Developing Countries and noted with approval by the WIPO Permanent Committee for Development Cooperation Related to Industrial Property at its session in 1976. The purpose of the meeting was to review and evaluate the Guide with a view to publishing a revised edition on the basis of the experience acquired in its use in developing countries and of developments in the preparation and negotiation of licenses and technology transfer agreements in the field of industrial property, particularly as concerns patents, trademarks and know-how.

The Group of Consultants consisted of 14 persons selected by the Director General of WIPO or designated, upon his invitation, by governments and international organizations. Ten of the participants came from Chile, China, Germany (Federal Republic of), Indonesia, Kuwait, the Soviet Union, the United States of America and Zambia, while four were designated by one intergovernmental organization (the Permanent Bureau of the Hague Conference on Private International Law) and by two international non-governmental organizations (the International Licensing, Innovation and Technology Consultants Association (LITCA) and the Licensing Executives Society (International) (LES)). The list of participants follows this Note.

The current, first edition of the Guide, was published by WIPO in 1977. It was based on a draft prepared by the International Bureau which was examined by the above-mentioned Working Group and revised with the further assistance of consultants. The aim of the Guide is to provide practical help with the legal aspects of the negotiation and preparation of industrial property licenses and technology transfer agreements appropriate to the needs of developing countries. It has been issued in Arabic, Chinese, English, French, Japanese, Portuguese and Spanish.

\* Prepared by the International Bureau.

The Guide is intended primarily for use by potential licensees and technology recipients in developing countries. It strives to assist such licensees or technology recipients in identifying the legal problems which are likely to arise in the negotiation and preparation of an industrial property license or technology transfer agreement, to indicate the possible solutions, and to suggest courses of action that are most likely to be in their interest.

The Guide is also intended for use by government officials of developing countries whose responsibilities in the course of the administration of laws controlling the flow of technology, foreign investment and foreign exchange are to review industrial property licenses or technology transfer agreements and to give advice to licensees or technology recipients who are about to conclude industrial property licenses and technology transfer agreements. With the aid of the information provided in the Guide, such officials can draw the attention of a given licensee or technology recipient to the problems that may have been overlooked in the negotiation or preparation of the license or agreement or recommend a more appropriate solution than the one chosen by that licensee or technology recipient.

Since its publication in 1977, the Guide has been used, together with case studies of license contracts and simulated negotiation exercises, in some 12 training courses and workshops organized by WIPO at the national or regional level for the benefit of persons in developing countries.

The Group of Consultants had a discussion of a general nature concerning the purpose and use of the Guide before proceeding to a review of the contents of the Guide itself. During that discussion, the Group of Consultants congratulated the International Bureau for the high quality of the scholarship of the Guide, its logical presentation of the legal questions encountered by those in developing countries faced with the task of preparing and negotiating agreements concerning industrial property rights and technology transfer transactions, its balanced indication, on the whole, of the possible solutions to those questions, as well as its attention to the practical ways to give effect to those solutions and the implications that the choice of a given solution could have for the parties to the technology transfer arrangement.

The Group of Consultants was of the view that more extensive use of the Guide should be promoted by the International Bureau. To this end, the Group of Consultants suggested that the International Bureau organize more workshops on the subject of licensing and technology transfer and increase its efforts to make the Guide better known and available in developing countries.

The Group of Consultants engaged in an in-depth review of the contents of the Guide and made a number of suggestions for its improvement. Those suggestions, which were both of a general nature applicable to the whole of the Guide as well as of a more specific nature

applicable to certain parts or sections thereof, will be taken into consideration by the International Bureau in preparing the revised edition of the Guide. It is intended that the new edition will initially be issued by the International Bureau in one or two languages and will be followed thereafter by other language versions.

#### LIST OF PARTICIPANTS\*

##### I. Consultants

A.J. Abboushi (*Kuwait*); O. Agüero Wood (*Chile*); A. Dyer (*Netherlands*); R. Ernst (*Federal Republic of Germany*); J. Wehr (*Federal Republic of Germany*); I. Gambirn (*Indonesia*); J.N. Hazelwood (*United States of America*); Liu Shaoshan (*China*); Wang Zhengfa (*China*); F. Pombo (*Spain*); E. Triana (*Spain*); V.N. Roslov (*Soviet Union*); A. Wochinger (*Austria*); A.R. Zikonda (*Zambia*).

##### II. International Bureau of WIPO

G.A. Ledakis (*Legal Counsel*); E. Rubio (*Program Officer, Development Cooperation and External Relations Bureau for Latin America and the Caribbean*); V. Yossifov (*Program Officer, Industrial Property Law Section, Industrial Property Division*).

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

#### WIPO/UNDP

##### Regional Evaluation and Planning Meeting on WIPO Development Cooperation Activities in the Field of Industrial Property in Asia and the Pacific

(Pattaya, June 25 to 28, 1984)

#### NOTE\*

The WIPO Regional Evaluation and Planning Meeting on Development Cooperation Activities in the Field of Industrial Property in Asia and the Pacific was convened from June 25 to 28, 1984, in Pattaya, Thailand, with the cooperation of the Ministry of Commerce of the Government of Thailand and the assistance of the United Nations Development Programme (UNDP).

Fifty-one participants took part in the meeting, representing 19 developing countries of the region, seven industrialized countries and three intergovernmental organizations. The developing countries were: Bhutan, China, Fiji, India, Indonesia, Iran, Laos, Malaysia, Nepal, Pakistan, Papua New Guinea, Philip-

\* Prepared by the International Bureau of WIPO.

piners, Republic of Korea, Samoa, Sri Lanka, Thailand, Tonga, Vanuatu, Viet Nam; the industrialized countries were: Australia, France, Germany (Federal Republic of), Japan, Soviet Union, Sweden, United States of America; and the three intergovernmental organizations were: United Nations Development Programme (UNDP), United Nations Economic and Social Commission for Asia and the Pacific (ESCAP) and European Patent Office (EPO). The list of participants follows this Note.

At the opening of the meeting, addresses were delivered by H.E. Mr. Prayoon Chindasilpa, Deputy Minister of Commerce of Thailand, Dr. Arpad Bogsch, Director General of WIPO, and Mr. Winston Prattley, Regional Representative of UNDP in Thailand.

Mr. Chare Chutharatkul, Director General, Department of Commercial Registration, Ministry of Commerce of Thailand, was elected Chairman of the meeting.

The main purpose of the meeting was to evaluate, at mid-term, the activities carried out so far, and to plan, for the second half of the five-year term, and beyond, the activities to be carried out under WIPO's development cooperation program and under the regional project entitled "Establishment and Strengthening of Industrial Property Systems in Asia and the Pacific 1982 to 1986," financed by UNDP. Discussions were based on a document of more than a hundred pages, prepared by WIPO.

Representatives of industrialized countries and one industrial property organization informed the meeting about the achievements and plans of their industrial property offices in the field of the automation of their office procedures, gave additional information and made suggestions relevant to the subject matter of the meeting.

All representatives of the developing countries informed the meeting of the present state of industrial property protection in their respective countries. Many of them also made comments on the WIPO document and expressed wishes and proposals. They observed that the regional project had played an important catalytic role in stimulating national development in the field of industrial property and that the project should continue to supplement national efforts in the next inter-country program cycle, especially in view of the difficulties encountered in obtaining funds from National Indicative Planning Figures (IPF) for industrial property projects.

Most representatives expressed satisfaction with the accomplishments of the first two and a half years of the project and with plans for its continuation in the second half of that period and beyond.

Some of the suggestions for future activities made by participants were: that a similar evaluation and planning meeting be held in 1986; that the WIPO publication entitled *Industrial Property in Asia and the Pacific* should be continued; that experts should be employed from developing countries of the region on

advisory missions, that WIPO should formulate a three to five year individual and group training program, which would take account of national and common country needs, with training to be carried out within and outside the region; that more resources be devoted to encouraging inventive and innovative activities including training at the Philippine Asia and Pacific Invent School and institution building; that provision be made for strengthening patent information systems in the region, that Thailand would offer, through WIPO, its recently established computerized trademark system for possible use, with adaptations, by other developing countries of the region and that Australia and WIPO would cooperate with Thailand in its implementation in such countries; that assistance to the South Pacific and least developed countries be accelerated on aspects of industrial property suitable to their developmental needs; that more resources should be used for seminars on industrial property licensing and the payment of royalties; that, given the range and volume of activities and the number of countries involved in WIPO's development cooperation program in the region, WIPO staff dealing with that program should be increased.

The meeting concluded by, *inter alia*, stressing the need to maintain the project's flexibility so that both the common and individual needs of countries could and should be satisfied; urging WIPO and UNDP to maintain the vigorous tempo that had so far prevailed in the execution of the project; endorsing the program proposals for the period June 1984 to December 1986 and the plans for the period 1987 to 1991, subject to the continuing validity of the program assumptions; expressing the hope that WIPO, UNDP and interested industrialized countries would continue, if not increase, their contributions.

#### LIST OF PARTICIPANTS\*

##### I. Government Officials from Developing Countries of the Region

**Bhutan:** T. Thinlay. **China:** Daole Xu; Qun Wu; Jei Li. **Fiji:** G.M. Fong; P.S.E. Taganekurukuru. **India:** P.R. Chandran; S. Kumar. **Indonesia:** S. Suradimadja; A.B. Rikin. **Iran:** A. Hashemi; S.M. Mostafavi Tafreshi. **Laos:** L. Phetsavan; B.L. Sisouvanh. **Malaysia:** Y.H. Chan; N. Abidin. **Nepal:** M.S. Shrestha; C. Thapa. **Pakistan:** G.M. Samdani; M. Zafar. **Papua New Guinea:** N. Mohanty; G. Araga. **Philippines:** F.A. Adriano; C.C. Sandiego. **Republic of Korea:** Tae Chang Choi. **Samoa:** T. Malifa; P. Asera. **Sri Lanka:** B.W. Senarath Dissanayake; K. Jayasinghe. **Thailand:** C. Chutharatkul; B. Simaskul; T. Boonkong; V. Areerasd. **Tonga:** W.A. Holo; E.U. Tuita. **Vanuatu:** V. Duffy; T. Tarip. **Viet Nam:** K. Ngô Din; Tran Dung Tien.

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

## II. Government Officials from Industrialized Countries

Australia: P.A. Smith. France: G. de Maistre. Germany (Federal Republic of): F.P. Goebel. Japan: M. Iwade. Soviet Union: B.B. Nikolayev. Sweden: I. Schalin. United States of America: D.J. Quigg.

## III. Intergovernmental Organizations

United Nations Development Programme (UNDP): W. Prattley; D.M. Thorup; G. Mazzone. United Nations Economic and Social

Commission for Asia and the Pacific (ESCAP): P. Strunk. European Patent Office (EPO): H. Meylaerts.

## IV. International Bureau of WIPO

A. Bogsch (*Director General*); L. Kadirgamar (*Director, Development Cooperation and External Relations Bureau for Asia and the Pacific*); M. Qayoom (*Senior Program Officer, Development Cooperation and External Relations Bureau for Asia and the Pacific*); G. Yu (*Senior Program Officer, Development Cooperation and External Relations Bureau for Asia and the Pacific*).

## General Studies

### The Functions of Licensed Trademarks

A. CASADO CERVIÑO\*

#### I. Introduction

The importance attaching to the trademark license today, whether in its simplest form or in that of a franchising agreement, need not be emphasized.<sup>1</sup> The trademark license is a contract under which the owner of the trademark (the licensor), while retaining his ownership, authorizes a third party (the licensee), who is either a natural person or a legal entity, to make use of it.<sup>2</sup> It is moreover an indispensable instrument for any enterprise that wishes to extend its economic influence widely, rapidly and without having to rely solely on its own investment capacity;<sup>3</sup> that is especially true if one

bears in mind the difficulties that may be encountered by an enterprise, regardless of its size, in accumulating sufficient capital for the extension of its market presence. Consequently, the trademark license is one of the industrial property institutions that is being used more frequently and more intensively all the time and is now playing a major part in the modern economic system.<sup>4</sup>

A license is thus characterized by the fact that it allows an exclusive right, such as the use of the mark, to be exercised by a person other than its owner. The licensee may have the use of the mark but he does not acquire ownership, which remains in the hands of the giver of the license or licensor. That indeed is the main factor that distinguishes licensing from assignment, which entails actual transfer of the ownership of the trademark from the assignor to the assignee.<sup>5</sup> The main effect of the license is that it prevents the licensor from exercising his *ius prohibendi* when the trademark is used by the licensee, as there is no usurpation of the licensor's rights.<sup>6</sup> However, this is not the only effect produced by the grant of the license. As has rightly been mentioned in Spanish legal writing, by Gómez Segade,<sup>7</sup> there is alongside this negative effect another positive one, namely, the fact that the licensor authorizes the licensee to make use of the trademark; he grants him a positive right of use.

Nevertheless, acceptance of trademark licensing used to be—and indeed still is—a controversial matter. Against this possibility it can be argued that, where the trademark is used by two or more persons on account of the license, it is difficult to assert that it is still performing its functions, and in particular that it is serving to identify a single origin or source. The essence of this criticism is that the licensing of a trademark causes the sign constituting it to identify not a single origin but rather a number of origins, with the result that

\* Head of the International Relations Department, Spanish Industrial Property Registry, Madrid.

<sup>1</sup> On the subject of trademark licenses in general, the following may be consulted: on European law, Chavanne and Bursi, *Droit de la propriété industrielle* (2nd edition), Paris, 1980, pp. 466 *et seq.*; Ascarelli, *Teoría de la concurrencia y de los bienes inmateriales* (Spanish translation by Verdera and Suárez-Llanos), Barcelona, 1970, pp. 349 *et seq.*; Saini-Gal, *Protection et défense des marques de fabrique, de commerce ou de service*, Paris, 1972; Gaspar, Floreni, "La licence de marque," *Revue de droit intellectuel, L'Ingénieur-Conseil*, 1972, pp. 189 *et seq.*; Troller, *Précis du droit de la propriété immatérielle*, Basle, 1978, pp. 161 *et seq.*; White and Jacob, *Kerly's Law of Trade Marks and Trade Names* (10th edition), London, 1972, Nos. 13-30, pp. 270 *et seq.*; on US law, McCarthy, *Trademarks and Unfair Competition*, New York, 1973, vol. 1, No. 18:13, pp. 631 *et seq.*; Gilson, *Trademark Protection and Practice*, New York, 1974/1982, vol. 1, No. 6.01, pp. 6-2 *et seq.*; Callmann, *The Law of Unfair Competition, Trademarks and Monopolies*, Illinois, 1981, vol. 3, No. 78.2, pp. 452 *et seq.*; Vandenberg, *Trademark Law and Procedure* (2nd edition), New York, 1968/1973, No. 7.31, pp. 243 *et seq.* The World Intellectual Property Organization (WIPO) is itself contributing usefully to the promotion of the better knowledge of what is in fact another institution of industrial property through its numerous publications. Suffice it to mention, merely as an indication, the *Licensing Guide for Developing Countries*, Geneva, 1977, and, more recently, *The Role of Industrial Property in the Protection of Consumers*, Geneva, 1982, pp. 30 *et seq.*

<sup>2</sup> Similar definitions have been adopted by Spanish writers in studies on license agreements concerning the various forms of industrial property. See Fernández-Novoa, "Las funciones de la marca," *5 Actas de Derecho Industrial (ADI)* 46, (1978); Gómez Segade, "Licencias obligatorias e invenciones farmacéuticas," in *La protección jurídica de las invenciones y la industria químico-farmacéutica*, Madrid, 1974, p. 341, these on patent licensing, and the article by the same author, "Algunos aspectos de la licencia de Know-How," *7 ADI* 214-215 (1981), on the subject of know-how licensing.

<sup>3</sup> Trademark licensing provides small and medium enterprises with the ideal means of broadening their market horizons and competing successfully with larger firms.

<sup>4</sup> See "Trademark Licensing: the Problem of Adequate Control," 1968 *Duke Law Journal* 875.

<sup>5</sup> An enumeration of the main practical differences existing between licensing and assignment is to be found above all in McCarthy, *op. cit.*, vol. 1, Section 18:14, p. 634.

<sup>6</sup> On the positive (exclusive right) and negative (*ius prohibendi*) options available to the owners of distinctive signs and also industrial property rights in general, and their significance in the Spanish legal context, see Fernández-Novoa, "La inclusión de los derechos de Propiedad Industrial dentro de la transferencia de tecnología," in *Seminario sobre adquisición de tecnología extranjera*, Bilbao, 1975, pp. 143-144; Botana Agra, "Notas sobre la protección del nombre comercial adquirido por mero uso," *7 ADI* 229-230 (1981).

<sup>7</sup> See Gómez Segade, "Licencias obligatorias ...." *op. cit.*, p. 343.

the primary function of the trademark is weakened, the consuming public is misled as to the origin of the goods or services that it distinguishes, and the licensed trademark itself effectively lapses.

This criticism would be accurate if the trademark owner confined himself to authorizing third parties to make use of his trademark, in exchange for appropriate compensation, without adopting or implementing any measure of control over the licensees so authorized. However, the effective periodical exercise of specific measures of control<sup>8</sup> is a new factor, whose scope and consequences require analysis. Thus, after having put forward some brief considerations on the requirement of control, this paper will endeavor to examine the effects of control on the functions of a licensed trademark, and more specifically to ascertain whether the control exercised by the licensor makes it possible for the trademark to carry on performing its intended functions.

## II. The Need for Control

### A. Features of Control

As soon as different persons make use of the same trademark at the same time for the identification of essentially identical goods or services that are going to be distributed to the same commercial outlets, there is bound to be interdependence between the users of the trademark. This interdependence may express itself in a variety of measures, with the common purpose of achieving a certain interconnection or relation between the licensor and the licensee. One of the more striking of those measures is the control of the licensee by the real owner of the trademark. Control thus takes the form of machinery of which the licensor may avail himself to supervise the licensee's use of the licensed trademark, and as a result it becomes one of the means—indeed the principal means—whereby the licensor can assure consumers that the goods or services distinguished by the licensed trademark continue to be of the nature and quality associated with that trademark. Control then becomes a guarantee of authenticity, to such an extent that, while of course it is not the only requirement usually figuring in trademark licenses to ensure their validity, it is in fact the cornerstone of the whole system.

For the reasons outlined above, the legislation of certain countries or groups of countries<sup>9</sup> expressly

<sup>8</sup> On the various means of control that are usually adopted by licensors and their implementation, see Casado Cerviño, *La licencia de marca en el Derecho norteamericano: el requisito del control*, unpublished thesis, Santiago de Compostela, 1983.

<sup>9</sup> The presence of control is the most important legal problem raised by trademark licensing. See, with reference to Community law, Article 21 of the Draft Regulation on the Community Trade Mark, OJEC C 351 of December 31, 1980; in US law, Sections 5 and 45 of the 1946 Lanham Act (*Industrial Property Laws and Treaties*, UNITED STATES OF AMERICA — Text 3-001); in British law, Section 28 of the Trade Mark Act, 1938.

places licensors under the obligation to exercise control. This is true, for instance, of US law. The case law of the United States of America deserves credit for having made control into a prerequisite of validity for a license.<sup>10</sup> Moreover, this principle of case law was subsequently written into Sections 5 and 45 of the present Federal Trademark Act of 1946 (the Lanham Act). The latter Section reads as follows:

"The term 'related company' means any person who legitimately controls or is controlled by the registrant or applicant for registration in respect to the nature and quality of the goods or services in connection with which the mark is used."

Nowadays neither legal writers nor case law question the fact that the Lanham Act regulates trademark licensing, and that control is a prerequisite of the validity of licenses.<sup>11</sup>

Unlike what happens in US law, there is no provision in Spanish trademark law that expressly places the licensor under the obligation to control the licensee. Indeed even where the possibility of licensing a trademark may be inferred not only from Sections 31 *et seq.* of the Industrial Property Statute, which deal with the free transferability of industrial property rights in any way recognized by law, but also from the last paragraph of Section 11 of the same text, which, despite its faulty terminology, affords a presumption of a territorially limited trademark license, not one of those provisions actually states what constitutes the legal regime applicable to licenses.<sup>12</sup> And something that is even more serious is that this legal void has not been filled, as might appear logical, by jurisprudential developments in the area. The Spanish Supreme Court has barely had any opportunity to apply itself to the problems surrounding trademark licensing, and those rare opportunities have been overlooked.<sup>13</sup> This is why the author has had occasion to mention elsewhere that the trademark license, in Spanish law, is an atypical,

<sup>10</sup> Of the decisions of North American courts that recognized for the first time the validity of the controlled trademark license, we could mention the various Coca-Cola cases (*Coca-Cola Co. v. Bennett*, 238 F. 513 (8th Cir. 1916); *Coca-Cola Bottling Co. v. Coca-Cola Co.*, 269 F. 796 (DC 1920); *Coca-Cola Co. v. J.G. Butler & Sons*, 29 F. 224 (DC Ark. 1917); likewise *B.B. & Knight, Inc. v. W.L. Milner & Co.*, 283 F. 816 (DC Ohio 1922) and *Smith v. Dental Products Co.*, 60 U.S.P.Q. 260 (7th Cir. 1944).

<sup>11</sup> See especially Gilson, vol. 1, Sections 6.01(5), pp. 6-8; Callmann, vol. 1, Section 22.2, p. 789; McCarthy, vol. 1, Section 18:14, p. 633; among the judgments, we would mention *Haymaker Sports, Inc. v. Turian*, 198 U.S.P.Q. 610, 613 (C.C.P.A. 1978) and *Turner v. HMH Publishing Co. Inc.*, 380 F.2d 224, 229 (5th Cir. 1967).

<sup>12</sup> On this subject see Diaz Velasco, "Régimen y disolución de la copropiedad de marcas," *Revista de la Propiedad Industrial*, 1953, pp. 507-508; Baylos Corroza, *Tratado de derecho industrial*, Madrid, 1978, p. 679; Montero Palacios, *Propiedad Industrial: Comentarios a la Ley y a la Jurisprudencia*, Madrid, 1961, p. 13 *et seq.*

<sup>13</sup> STS (Civil) of May 5, 1930 (= Aranzadi Jurisprudencia, 1930-1931, No. 918, pp. 348-349; STS (First Chamber) of May 31, 1974 (= 2 ADI 648-649, 1975), Bertlitz case (on business signs); STS (First Chamber) of May 24, 1977 (= 5 ADI 559-560, 1978), Scandale case.



innominate contract.<sup>14</sup> Earlier writers on industry tended to deal with the situation by describing the trademark license contract—according to a rather unfeeling criterion—as a variant of the rental contract,<sup>15</sup> to which Sections 1542 *et seq.* of the Civil Code are applicable.

It will be readily deduced from the foregoing that, in the Spanish legal system, the trademark license takes the form of a consensual contract that is refined by agreement between the parties (Civil Code, Section 1258), and is governed by the principle of freedom of form written into Sections 1278 of the Civil Code and 51 and 52 of the Code of Commerce, and whose contents are determined by the agreements, clauses and conditions that the parties see fit to lay down, insofar as they are not contrary to laws, morality or public interest or policy (Civil Code, Sections 1255 and 1256, and, in the reverse sense, Code of Commerce, Section 53). Yet neither the absence of express provisions nor the great freedom enjoyed by the parties indicates, to our way of thinking, that control is not a necessary requirement for the trademark license to be valid; on the contrary. Before that, as shall be determined in the course of this article, control is exercised also within the purview of present Spanish trademark law as an essential safeguard protecting not only the specific interests of the owners of trademarks but also, and above all, the general interest of the consumer.<sup>16</sup>

Indeed, the contractual freedom of the parties is limited, among other things, by the public interest (Civil Code, Sections 6 and 1255), apart from which Spanish case law has repeatedly stressed that consumer protection forms part of the public interest concept.<sup>17</sup> On the other hand, the trademark is construed as a sign that serves to identify goods or services in relation to their origin (Industrial Property Statute, Section 118).

<sup>14</sup> Casado Cerviño, *La licencia de marca en el Derecho norteamericano: el requisito del control*, extract from the doctoral thesis of the same title, Santiago de Compostela, 1983, p. 8. This assertion is by no means weakened by the contents of the Spanish provisions on the control of foreign technology transfers (Decree 2.343/73 of September 21, 1973, *Boletín Oficial del Estado* (BOE) No. 236 of October 2, 1973; Order of December 5, 1973, BOE No. 301 of December 17, 1973; and Order of July 30, 1981; BOE No. 193 of August 13, 1981).

<sup>15</sup> Díaz Velasco, *Revista de la Propiedad Industrial*, 1953, p. 507. We are unable to agree with this opinion. For while it certainly does not seem feasible to treat the license contract legally as a contract for the rendering of a service, it is no less certain that there are definite analogies between the two which make it possible for some of the provisions governing the rendering of services to be applicable to license contracts. On these subjects, with reference to know-how and patent licenses, respectively, see Gómez Segade, 8 ADI 214 *et seq.* (1981), Gómez Fontecha, "Las licencias contractuales de patente y la industria farmacéutica española," in *La protección jurídica de las invenciones y la industria químico-farmacéutica*, Madrid, 1974, p. 431.

<sup>16</sup> Fernández-Novoa, with his accustomed clarity and precision, has pointed out the legal aspects of the licensor's control over the licensee. See 5 ADI 48-49 (1978).

<sup>17</sup> STS (Third Chamber) of May 10, 1975 (= 3 ADI 512-513, 1976) Bra case; STS (Third Chamber) of June 9, 1975 (= 3 ADI 526 *et seq.*, 1976), Hisa/Ishah case; STS (Third Chamber) of November 29, 1975 (= 3 ADI 560 *et seq.*), Iten/Hyten case.

To put it in another way, the legal order confers a right of exclusivity in relation to the trademark for the purpose of—in addition to protecting the private interest of its owner—saving consumers from being misled as to the origin of the goods or services.<sup>18</sup> In this way respect for the interest of consumers becomes a decisive factor in determining the validity of the license.<sup>19</sup> For if, as we explained, it seems beyond dispute that the general interest of the protective trademark would always be at risk if its owner were allowed to authorize a third party to make use of it without any form of safeguard, the logical consequence is that, in Spanish law, trademark licenses that do not guarantee the protection of the interests of the consumer are devoid of validity. In other words, a trademark license cannot be considered valid if the licensor does not adopt any means of control over the licensee's use of the trademark.

## B. Subject Matter of Control

Inasmuch as one of the purposes of control is to make it possible for the goods or services identified by the licensed trademark to maintain the same level of quality as those marketed by the licensor, and to prevent the licensee from using the trademark on goods or services other than those authorized by the owner, the latter is not expected to control the trademark itself, but merely the nature and the quality of the goods or services identified by it.<sup>20</sup> Control must therefore be primarily applied to the quality of the goods or services of the licensee. At first sight, however, it may come as a surprise that an obligation to control quality should be imposed in view of the fact that, in trademark law, no one questions the right of the user of a trademark, when he is at the same time the owner of the trademark, to alter the quality of the goods or services identified by it within the framework of a wide and varied range of possibilities. Trademark law allows the owner of the trademark to decide on the level of quality that his goods or services should attain. That level may be high, medium or low, depending solely on a series of factors

<sup>18</sup> See Fernández-Novoa, "El Relieve jurídico de la notoriedad de la marca (con especial referencia del riesgo de confusión)," *Revista de Derecho Mercantil*, 1969, p. 203; Otero Lastres, "La autorización del anterior titular de la marca y la protección de los consumidores," 3 ADI 300 (1976) and STS (First Chamber) of November 24, 1978 (= 6 ADI 344 *et seq.*, 1979-1980), Trelen case.

<sup>19</sup> In addition to the judgments mentioned in the preceding notes, Spanish case law has on other occasions recognized that the trademark protects not only the specific interest of the enterprise, but also the more general interest of consumers. See, in particular, the judgment of the TS (Third Chamber) of June 21, 1975 (= 3 ADI *et seq.*, 1976), Harriet Hubbard Ayer/Harriet Mill case; STS (Third Chamber) of May 7, 1975 (= 3 ADI 510 *et seq.*, 1976), Coratómico/Oraltómico case.

<sup>20</sup> This was the solution adopted in comparative law by the Draft Community Regulation, Article 21(3) of which provides that "the proprietor of a Community trade mark shall ensure that the quality of the goods manufactured or of the services provided by the licensee is the same as that of the goods manufactured or of the services provided by the proprietor," and also by Section 28 of the British law of 1938.

which almost always includes the individual desire of the entrepreneur who owns the trademark.<sup>21</sup>

However, if the owner of a trademark authorizes a third party to use it, this should at the same time create the obligation to control the quality of the goods or services because, as a result of the trademark license, there is a more pressing need to defend the interests of the consumer in the face of the new risks that then arise. Those risks were not so noticeable before the license was granted: where the trademark is used only by its owner, the latter's interest in preserving the value and goodwill associated with it will obviously make him take pains to maintain and even improve the quality of the goods or services it identifies; in such cases, therefore, the public interest is sufficiently safeguarded in relation to the trademark by the owner's own self-interest.<sup>22</sup> Where the trademark is licensed, however, the licensee's interest in maintaining the value of the trademark may not be the same as the owner's; for that reason it is not so obvious that the interests of the consumer are protected without further provision.

In the second place the licensor's control has to be over the nature of the goods or services, or their type. Unlike the owner, who can use the trademark for goods and services of a different kind, the licensee may only use it for the goods or services expressly mentioned by the licensor, so that he cannot lawfully alter their nature, or introduce any additional product or service under the licensed trademark, without the licensor's consent.<sup>23</sup>

This precisely is the criterion that has been observed in comparative law, notably by US legislation. Section 45 of the Lanham Act requires in particular that control be exercised in relation to the nature and quality of the goods and services. That requirement is one that has been repeatedly invoked by the US courts.<sup>24</sup> We therefore have no doubt but that the solution in Spanish law has to be the same as that adopted by the US case law and legislation. Specifically, if the main interest that has to be protected by means of control is the interest of the consumer, the arguments put forward so far show that the control has to apply to the quality and nature of the trademarked goods or services produced and distributed by the licensee.

<sup>21</sup> This view is also supported by Gilson (*op. cit.*, vol. 1, Section 6.01(4), pp. 6-6, 6-7), who points out that the level of quality of the goods or services will be subject to cost factors and to the trademark owner's own competitive interest. Nevertheless, it has to be mentioned that under certain circumstances the entrepreneur has to adapt to the provisions of administrative character that apply in connection with the quality of goods, in the food and pharmaceutical fields for instance.

<sup>22</sup> See Lahart, "Control—The Sine Qua Non of a Valid Trademark License," 50 T.M.R. 106 (1960).

<sup>23</sup> See Gilson, *op. cit.*, vol. 1, Section 6.01(5), p. 6-10; Diamond, "Requirements of a Trademark Licensing Program," XVII Business Lawyer 300 (1962).

<sup>24</sup> Section 45 provides in this connection that control is "... in respect to the nature and quality of the goods or services..." See also, by way of example, *In re Joseph Bancroft and Sons Co.*, 129 U.S.P.Q. 329 (T.T.A.B. 1961) and *Huntington Mattress Co. v. Celanese Corp. of America*, 132 U.S.P.Q. 395, (DC Md. 1962).

### III. The Legally Relevant Functions of the Trademark

Having reviewed the part played by control, and what it has to be applied to, it is necessary to consider its effect on the relevant functions of the licensed trademark. And the first question is precisely what those functions are. In spite of the universal significance of the subject, and presumably because of its intrinsic importance, there is no unanimity either among Spanish<sup>25</sup> or among foreign<sup>26</sup> legal writers on what functions the trademark actually performs. However, it is not the purpose of this article to make a survey of the various attitudes adopted, which in any case have been the subject of extensive and well-documented works.<sup>27</sup> From our point of view, and for the purposes of this study, the trademark performs three relevant functions, namely, the function of indicating the origin of goods and services, the quality function and the advertising function.<sup>28</sup>

#### A. The Controlled License and the Function of Indicating Origin

As Fernández-Novoa points out,<sup>29</sup> the function of indicating the origin of goods and services requires the trademark to attest, for the benefit of consumers, that all the goods or services of one and the same class that bear the same trademark have been produced or distributed by one and the same enterprise. He speaks here of the main function of the trademark, to which the other functions are really subordinate, with the result that, if a sign does not perform the first function, one cannot be said to be dealing with a genuine trademark.<sup>30</sup>

The overriding nature of this function was recognized by the writers of the Industrial Property Statute. Section 118 of the Statute defines the trademark as any sign or material means, whatever its type and form, that serves to indicate products of industry, commerce and

<sup>25</sup> See Fernández-Novoa, 5 ADI 33 *et seq.* (1978); Gómez Segade, "Protección constitucional de la marca y de las denominaciones de origen," 7 ADI 312-313 (1981); Arcán Lalín, "En torno a la función publicitaria de la marca," 8 ADI 57 *et seq.* (1982).

<sup>26</sup> See, in particular, Beier and Krieger, "Importance économique, fonction et finalité de la marque," Ann. AIPPI, 1976, pp. 19 *et seq.*; Chavanne and Burst, *op. cit.*, pp. 342 *et seq.*; Roubier, *Le droit de la propriété industrielle*, Paris, 1954, vol. II, pp. 510 *et seq.*; McCarthy, *op. cit.*, vol. 1, Section 3, pp. 85 *et seq.*

<sup>27</sup> See the authors quoted in notes 25 and 26 (*loc. cit.*).

<sup>28</sup> The German author Isay was the first in Europe to devise this—already classic—tripartite division of the functions of the trademark. See Isay, "Die Selbständigkeit des Rechts an der Marke," 34 GRUR 26 *et seq.* (1929).

<sup>29</sup> Cf. Fernández-Novoa, (5 ADI 35, 1978), who made a wide-ranging and well-documented study of this function.

<sup>30</sup> The predominant character of this function has been acknowledged by the most relevant doctrine. See Ladas, "Trademark Licensing and the Antitrust Law," 63 T.M.R. 245, 248 (1973); Robin, "Licensing and Franchising," in *Current Developments in Trademark Law*, p. 105; McCarthy, *op. cit.*, vol. 1, Section 3:3, pp. 90 *et seq.*; Fernández-Novoa, 5 ADI 35 (1978), Beier and Krieger, Ann. AIPPI, 1976, pp. 22 *et seq.*



work, distinguishing them from similar products.<sup>31</sup> Regardless of the multitude of criticisms and observations to which the above definition may be subjected,<sup>32</sup> the thing that is certain is that this Spanish law of 1929 clearly recognizes, in the definition of the trademark, the function of identifying the origin of the goods (and services) that is performed by the trademark. So, in the Spanish legal order, the trademark performs the basic function of designating a single, albeit anonymous source for the goods or services that it distinguishes. The trademark is an essential instrument at the disposal of the manufacturer or trader of goods or services for the launching of those goods or services on the market and for distinguishing them from identical or similar goods or services produced by competitors. Consequently, whatever the position in which the trademark finds itself, it has to identify the goods or services that it distinguishes as coming from a single source. This is because otherwise one would not be in the presence of a genuine trademark as conceived by legislation.

On the basis of the foregoing, and in an initial approximation, the function of the trademark consisting in indicating the origin of the goods or services that it identifies appears to be at variance with an institution like licensing, which enables a person who is not the owner of the trademark to produce and sell goods under it. It was precisely that reasoning that made US legal writers and case law of the highest rank deny the possibility of trademark licensing for many years.<sup>33</sup>

Now this doctrinal and jurisprudential attitude would be correct if the validity of an uncontrolled trademark license were recognized. It is not an acceptable argument, however, where the licensor does exercise sufficient control over the quality and nature of the goods or services distinguished by the licensed trademark. For in our opinion, even where the goods or services distinguished by the trademark are produced by two or more enterprises, there is no duality or plurality of origin if the owner of the trademark effectively controls the quality and nature of the trademarked goods or services: even though the trademark is being used by two or more enterprises, in fact it is identifying only one source, as all the goods or services are produced or distributed according to a single set of guidelines and criteria laid down by the licensor. On the

same lines, Ladas<sup>34</sup> points out that, in spite of the license, the trademark continues to inform the consumer of the origin, the latter being understood in the broadest sense of the trademark being used on its owner's authority and subject to his control. As a result of that control, Ladas maintains, the goods distributed by the licensee effectively come from the same source as if they had been produced and distributed directly by the licensor.

In order to evaluate and understand the full import of these statements, it must be borne in mind that the concept of origin is broad enough to accommodate the situation contemplated in cases of licenses subject to control. Because, as Ladas says, what the word origin denotes is that the goods or services are, at the very least, brought on to the market under the supervision of the trademark owner, who in that way takes responsibility for them.<sup>35</sup> It should not be overlooked that market realities reveal the consumer, both generally and in hypothetical cases of trademark licensing, usually to be ignorant of the origin or source of the goods or services identified by the trademark. And yet that ignorance should not lead to the deduction that the trademark has ceased to perform its function of designating the origin of the goods or services. The consumer may be ignorant of the name of the entrepreneur who is using the trademark, but in any case he is confident that, whoever the person is, he is always the same.<sup>36</sup>

Now, in hypothetical cases of trademark licensing, if control exists, the consumer can rely on the goods or services coming from one and the same source. If the licensor exercises adequate control over the quality and nature of the goods or services produced by his licensees, it is realistic to regard the licensed enterprises as being genuine subsidiaries of the licensing firm, or as offshoots of the licensor.<sup>37</sup> It has been mentioned in this connection that, when the goods or services distributed on the market are controlled by the owner of the trademark before being offered to consumers, it matters little whether the various entities engaged in the production of the goods or services are controlled by

<sup>34</sup> Cf. Ladas, 63 T.M.R. 249, 250, 251 (1973). See also Palladino, "Compulsory Licensing of a Trademark," 68 T.M.R. 522, 537 (1978).

<sup>35</sup> See Ladas, 63 T.M.R. 248 (1973). In the same sense, see Treece, "Trademark Licensing and Related Problems—Trademark Transfers and Product Restraints in Franchise Arrangements," 59 T.M.R. 160 (1969). The quality theory means that the owner of the trademark does not in fact need to take part in the production of the trademarked goods, it being sufficient that he exercise control over the quality of the goods coming from different physical sources.

<sup>36</sup> See, on Spanish law, Fernández-Novoa, 5 ADI 36-37 (1978). This writer nevertheless seems to accept that, in the case of trademark licenses, the function of indicating the source can yield to the quality function (p. 39).

<sup>37</sup> See Treece, 59 T.M.R. 160 (1969). Gilson, for his part, rightly points out that the changes that have taken place in recent times in the communication media and in various sectors of technology have resulted in consumers actually not knowing who is the physical manufacturer of the product (*op. cit.*, vol. 1, Section 1.03, pp. 1-15, 1-16). See also Paltishall and Hilliard, *Trademarks, Trade Identity and Unfair Trade Practices*, New York, 1974, Section 3.5, p. 2-56.

<sup>31</sup> See also Section 1 of the Industrial Property Statute. In comparative law and following the example already given of the law of the United States of America; Section 45 of the Federal Trademark Law of 1946 acknowledges this predominant character of the function of indicating the origin of the goods and services.

<sup>32</sup> Otero Lastres, "En torno a un concepto legal de marcas," 6 ADI 13 *et seq.* (1979-1980).

<sup>33</sup> See for instance Rogers, *Goodwill, Trademark and Unfair Trading*, Chicago-New York, 1914, pp. 106 *et seq.*, and *Macmahon Pharmacal, Co. v. Denver Chemical Manufacturing Co.*, 113 F. 468 (8th Cir. 1901); *Bulte v. Igleheart Bros.*, 137 F. 492 (7th Cir. 1905); *Everett O. Fisk and Co. v. Fisk Teacher's Agency, Inc.*, 3 F.2d 7 (8th Cir. 1924).

virtue of a license contract or merely form part of the enterprise of the trademark owner.<sup>38</sup> In any case, those goods or services will have the same origin as if they had been produced directly by the owner of the trademark,<sup>39</sup> since consumers will be obtaining from the licensee the same product or service as they would receive from the licensor.

The effect of control over the quality and nature of the goods and services is that the trademark is then enabled to perform its main function of safeguarding the interests of consumers by not misleading them as to the origin of the goods or services. Because the basic function of a trademark is the indication of the source of the goods or services, the owner who licenses his trademark always has to retain control over the merchandise or services that bear it. That is the only way of ensuring that the trademark continues to perform its main function. Consequently, if the licensor fails in this task of controlling the goods and services produced by the licensee, one is confronted not with a genuine trademark but merely with a sign incapable of performing the role attributed to a trademark.<sup>40</sup>

In comparative law, this is precisely the line taken, for instance, by the US legislation. In Section 45 of the Lanham Act, the enumeration of the possible causes of abandonment of a trademark includes:

"...any course of conduct...[that] causes the mark to lose its significance as an indication of origin."

In other words, according to the Federal Trademark Act, any sign that ceases to perform its function of indicating the source of the goods or services must be considered abandoned. Consequently, if as a result of licensing the trademark ceases to perform its main function, it becomes an abandoned or lapsed trademark. And so, with the disappearance of the subject matter of the contract, one would be forced to the conclusion that trademark licensing was not possible under US law. Now what the US legislator has written into Sections 5 and 45 of the Lanham Act to prevent this from happening is precisely the institution of control. If there is control, the license is valid and the trademark remains in force; it therefore continues to perform its main function. This interpretation has moreover been expressly ratified by the US courts.<sup>41</sup>

<sup>38</sup> Cf. Treece, 59 T.M.R. 160 (1969).

<sup>39</sup> See Scheller, "Problems of Licensing and Intent to Use in British-Law Countries," 61 T.M.R. 445 (1971). Krayner ("Domestic Trademark Licensing," XLIII Journal Patent Office Society 574 (1961)), states quite correctly that, thanks to control, the consumer does not suffer when he acquires a product or service coming not from the licensor but from the licensee, in view of the fact that, in any case, the real source of the product or service continues to be the owner of the trademark.

<sup>40</sup> For the same thing in US doctrine, see Scheller, 61 T.M.R. 445 (1971); Diamond, XVII Business Lawyer 296 (1962).

<sup>41</sup> See *Parkway Baking Co., Inc. v. Freihoffer Baking Co.*, 114 U.S.P.Q. 278 (DC Pa. 1957); *Dawn Donut Co., Inc. v. Hart's Food Stores, Inc.*, 121 U.S.P.Q. 430 (2d Cir. 1959); *Tetra Pak Co., Inc. v. Schneider*, 125 U.S.P.Q. 460 (T.T.A.B. 1960); *Stagecoach Properties, Inc. v. Wells Fargo and Co.*, 199 U.S.P.Q. 341 (T.T.A.B. 1978).

In Spanish law, the argument that the licensed trademark retains its primary function is backed up by Sections 1 and 118 of the Industrial Property Statute in conjunction with Sections 11 and 31 *et seq.* of the same text. Indeed we already know that, under those Sections, the indication of the source of the goods or services is the basic, essential function, without which the sign cannot operate as a trademark. We also know that there is nothing in the law to prevent a trademark from being licensed. So, if the contrary argument were allowed, according to which licensing makes a trademark cease to perform its basic function, we would be depriving the licensed sign of its essential characteristic, and consequently denying the trademark the possibility of being validly licensed. We therefore have to conclude that licensed trademarks, when subjected to control by the licensor, continue to perform their function of identifying the origin of the goods or services. To take the opposite stand would be to reject *de facto*—in the same manner as was pointed out regarding US law—the possibility of trademarks being licensed under Spanish law.

Misgivings may nevertheless be expressed as to whether a licensed trademark continues to perform its function of indicating the source of the goods or services in the hypothetical case of the owner of the trademark authorizing its use without in fact having ever used it himself. Reverting to the US example, there have been occasions on which the courts of that country have held that the main function of the trademark could cease to operate after it had been licensed. In the case of *Siegel v. Chicken Delight, Inc.*,<sup>42</sup> the Court of Appeals for the Ninth Circuit ruled that when the owner of a trademark licensed it to other persons, the trademark operated as a means of identifying the quality of the goods or services more than as an instrument serving to identify their origin.

This decision has been rightly criticized by US legal writers, however. For instance, the note published by the editor of the review *Trademark Reporter*<sup>43</sup> mentions that the conception of a trademark's function that emerges from the case of *Siegel v. Chicken Delight, Inc.*, conflicts with the definition of a trademark as being an indication of origin, which is accepted both by common law and by the Trademark Act of 1946. Lunsford<sup>44</sup> was stricter and more severe in his criticism. According to him, the statement lacks judicial support and is contrary to the provisions of the Lanham Act: not only does the definition of a trademark written into Section 45 of the Lanham Act recognize that the trademark basically performs the function of identifying the origin of goods and services, but in addition the same Section 45 estab-

<sup>42</sup> *Siegel v. Chicken Delight, Inc.* 448 F.2d (9th Cir. 1971).

<sup>43</sup> T.M.R., editor's note, *Reith B. Redd v. Shell Oil Co.*, 65 T.M.R. 511, 517 (1975).

<sup>44</sup> Lunsford, Jr., "Consumer and Trademarks: the Function of Trademarks in the Market Place," 64 T.M.R. 86, 87-88 (1974).

lishes that any trademark is considered abandoned when it has ceased to perform its function as an indication of origin. And, if we take into account that the rights in a trademark are lost if the trademark is abandoned, it follows that, if the US Court of Appeals for the Ninth Circuit was right in asserting that trademarks licensed under the conditions mentioned only performed a quality-denoting function, all the trademarks that were licensed without first having been used would be considered abandoned. As Lunsford points out,<sup>45</sup> the consequences would be even more illogical if the assertion made by the US court applied not only to trademark licenses not used by the licensor, but also to all forms of trademark licenses. These are considerations which, in the light of what has been said in this paragraph on the subject of control and the function of indicating the source of goods or services, are entirely applicable to Spanish law.

### B. The Controlled License and the Quality Function

Over the past relatively few years, a significant amount of legal theory and jurisprudence, both national and foreign, has, in view of the profound changes on the market that have come about as a result of the phenomenon of mass production and distribution, the interdependence of markets and the aggressive approaches and centralization in the advertising field, come to the defense of the argument that a trademark performs an additional function of indicating<sup>46</sup> to the consumer the quality of the goods or services that it identifies. It is held, moreover, that this function is not only performed in a socio-economic context but is also relevant in a legal context.<sup>47</sup> There does not seem to us to be any serious difficulty regarding the acceptance of these assertions. The very acceptance of trademark licensing would not have been possible had there not been a change in the traditional theory of the function of trademarks. Only when traditional conceptions had changed, and the fact been accepted that the trademark could serve to indicate to consumers the quality of the goods or services that it identified, did the door open to trademark licensing. These considerations are shared by a broad sector of legal scholars.<sup>48</sup>

The question that immediately arises is that of determining whether or not, as a result of a license, a trademark continues to perform this quality function. It

can be stated without risk of exaggeration that control is a means of saving the quality function from being seriously undermined by the license. Indeed, if the licensor does not exercise control—or exercises it to an insufficient degree—the licensee can use the licensed trademark for the marketing of goods and services inferior to those distributed by the trademark owner, in order to secure rapid and substantial profits. And if that were to happen, the trademark would immediately cease to be a symbol of the quality of those goods or services. In other words, the absence—or insufficiency—of control would result in the trademark ceasing to operate as a sign identifying the quality of the product or service.

If, on the other hand, the licensor exercises due control over the quality or nature of the trademarked goods or services produced by the licensee, it is indeed possible for the trademark to continue to exercise its quality function. Thus for our purposes control is the sole machinery guaranteeing to consumers that the product will always, regardless of its physical source, be of the same quality, and they will be spared the risk of being deceived.<sup>49</sup>

### C. The Controlled License and the Advertising Function

The crisis in the traditional concept of the functions of a trademark has manifested itself not only in the recognition of the quality function; it has at the same time caused the fact to be accepted that the trademark is actually an efficient advertising medium. Indeed, as Schechter<sup>50</sup> already pointed out in 1927, the trademark is not merely a symbol that does no more than “focus” goodwill, but is frequently also the most efficient device for creating one’s own goodwill. Trademarks sell goods; nowadays, therefore, they have an important part to play in the successful launching of goods or services on the market. The consumer does not acquire goods or services solely or exclusively for their objective properties of quality and usefulness; his choice is influenced by a varied set of factors, one of the more striking of which is undoubtedly the selling power of the trademark itself.<sup>51</sup> This close relation between the advertising function and what might be called the “goodwill-

<sup>45</sup> See Lunsford, Jr., 64 T.M.R. 87-88 (1974). This writer goes so far as to describe the assertions made by the Court of Appeals for the Ninth Circuit, in the case, as “balderdash.”

<sup>46</sup> Like McCarthy (vol. 1, No. 3:4, p. 82), the author feels that one should not speak of a quality guarantee function in view of the ambiguous interpretations that could be placed on the term “guarantee,” but merely of a quality function.

<sup>47</sup> See Fernández-Novoa, 5 ADI 40 *et seq.* (1978); McCarthy, *op. cit.*, vol. 1, No. 3:4, pp. 92 *et seq.*; Callmann; *op. cit.*, vol. 3, No. 65.2, pp. 9-10.

<sup>48</sup> See, in particular, Fernández-Novoa, 5 ADI 40 *et seq.* (1978); McCarthy, *op. cit.*, vol. 1, No. 3:4, pp. 92 *et seq.* For a contrary view, see Beier and Krieger, Ann. AIPPI, 1976, pp. 24 *et seq.*

<sup>49</sup> See Fernández-Novoa, 5 ADI 48 (1978); McCarthy, *op. cit.*, vol. 1, Nos. 18:13 and 18:14, pp. 633-634. This is undoubtedly what has happened in US law which, in regulating the controlled trademark license in Sections 5 and 45 of the Lanham Act, has not only recognized the function of a mark as an indication of the quality of goods or services, but has also given control a significant role in the maintenance of that function. See McCarthy, vol. 1, No. 3:5, p. 94 and No. 18:13, p. 633; Sage, “Trademark Licenses and ‘Control,’” 43 T.M.R. 675 (1953); Eckmann, “Antitrust Problems in Trademark Franchising,” 55 T.M.R. 836 (1965). Fernández-Novoa, 5 ADI 49 (1978). These same comments may be made on the present wording of Article 21(3) of the Draft Community Regulation.

<sup>50</sup> See Schechter, “The Rational Basis of Trademarks Protection,” 40 Harv. L. Rev. 818-819 (1927).

<sup>51</sup> See Areán Lalin, 8 ADI 59-60 (1982).

focusing" function<sup>52</sup> is apparent in the fact that the goodwill attaching to a trademark is not merely the consequence of the quality of the product or service that it distinguishes, but also the effect of the actual sign used as a trademark, whose purpose is to lend prestige to the goods or services; this is because, as recent Spanish legal analysis has shown,<sup>53</sup> the independent advertising function of the trademark depends on that same fact.

The factors enabling a trademark to perform an independent advertising function have been many: the suggestive character of the signs constituting them; the mental association with some well-known event or person; and especially their dissemination in advertising slogans. As pointed out by Areán Lalin, a symbiotic relationship develops between trademarks and advertising, inasmuch as trademarks not only facilitate advertising but also perform an advertising function themselves. Moreover, the trademark does not perform that independent advertising function exclusively on a socio-economic level; it has expanded into the legal sphere, so that the advertising function is relevant in that sphere too. This legal bias of the advertising function is today supported by a broad section of Spanish<sup>54</sup> and foreign<sup>55</sup> legal scholars.

There does not seem to be anything to prevent the trademark from continuing to perform its advertising function after it has been licensed. Moreover, as we established on examining the effect of the controlled trademark license on the quality function, the same possibility of licensing a trademark shows, on the one hand, that the advertising function is legally relevant inasmuch as the owner, on licensing his trademark, is directly exploiting the value that the trademark has acquired on the market—which includes its advertising value—and, on the other hand, that the same advertising function and the goodwill attaching to the trademark will persist and may indeed increase during the period of licensing of the trademark. If the trademark ceases to perform its advertising function as a result of the license, it is already of no further interest to the licensee since it should not be overlooked that one of the advantages that the licensee obtains through the use of the trademark is that it links his product or service to a sign or symbol that has already been introduced to the market, is already known to the consumer and has already generated a considerable demand. Apart from

that, the licensee is not obliged to go to the effort and expense, which is often prohibitive and always uncertain, of choosing and introducing a new sign. The licensee is not only going to use a trademark that is already known to the public, but is also going to take advantage of the goodwill and advertising potential and value associated with it.<sup>56</sup> Thus, by means of the trademark license, the licensee is permitted to use for his own benefit the promotional or advertising power possessed by the sign, and the licensor is permitted to exploit, outside his own enterprise, the special value that the trademark possesses as an independent property.

The question thus arises once again whether control is in fact the machinery required for the licensed sign to retain its independent advertising function. For as long as that function can rely on an intensive, costly advertising effort, it could be argued that the persistence of the advertising function of a trademark is not dependent on the exercise of the control requirement. Following the same reasoning, consumers will acquire the trademarked goods or services not so much on account of their intrinsic value, but rather because they are driven or drawn by the advertising campaign and by the attractive power that the licensed sign possesses as a result of it.

It does not seem possible to accept this conclusion, however. For one thing, even where it is certain that the selling power of a trademark may not derive exclusively—or even mainly—from the objective characteristics of the product or service that it distinguishes, it is no less certain that those same characteristics will sooner or later have an effect on that selling power. If the licensor fails to exercise due control, he is taking the risk of the licensee deciding to use the trademark for goods or services inferior to his own, with the resulting impairment of the goodwill of the trademark. And, with the impairment of the goodwill, there will be a gradual, parallel weakening of the trademark's attraction potential. Lack of control will therefore spoil the image of the sign, adversely affecting its value as an independent property and ultimately its advertising power or function.

There is an additional fact, moreover, namely, that lack of control would prevent the sign adopted as a trademark from continuing to perform its other functions, those being the function of indicating the source of the goods and services and the quality function. Without control, the licensed sign would lose its differentiating power and its distinctiveness, and it would cease to operate as a sign indicating quality, and hence as a trademark. Under those circumstances the advertising value of the sign would undoubtedly also be

<sup>52</sup> See Fernández-Novoa, 5 ADI 54 *et seq.* (1978).

<sup>53</sup> See Areán Lalin, 8 ADI 79 (1982).

<sup>54</sup> See Areán Lalin, 8 ADI 79 *et seq.* (1982); Gómez Segade, 7 ADI 312-313 (1981). This also seems to be the argument put forward by Otero Lastres, 3 ADI 289 (1976). For the opposite view, see Fernández-Novoa, 5 ADI 57 *et seq.* (1978).

<sup>55</sup> See McCarthy, *op. cit.*, vol. 1, No. 3:5, pp. 95-96; Gilson, *op. cit.*, vol. 1, No. 1.03 (4), pp. 1-24, 1-25; Ascarelli, *op. cit.*, pp. 397 *et seq.*; Hubmann, *Gewerblicher Rechtsschutz* (4th edition), Munich, 1981, No. 4, p. 42; Heydt, *Zur Funktion der Marke*, 1976 GRUR Int. 342.

<sup>56</sup> See Sage, 43 T.M.R. 675 (1953); Filseck, "Some Observations on the Licensing of Trademarks," 46 T.M.R. 735 (1956); Fernández-Novoa, 5 ADI 54 *et seq.* (1978).

destroyed.<sup>57</sup> If no trademark exists, but only a sign without any differentiating power, the advertising function cannot exist either.

#### IV. Final Considerations

From the above account it is clear that control plays an essential part in the maintenance of the functions of the trademark. However, in contrast to what happens under other legal systems, where the licensor's control over the goods or services of the licensee is a requirement expressly laid down by the law for the license to be valid, under Spanish law the Industrial Property Statute confines itself to making the validity of the trademark license subject—by implication—to the safeguarding of its role of indicating the single, albeit anonymous, origin of the goods or services that it identifies (Sections 1, 118, 11, 31 *et seq.*), and to the protection of the various interests at stake, including in particular, as has emerged from case law, the interest of the consumer. Inasmuch as control is the most suitable means of achieving these safeguards, it has to be inferred that it is not possible under Spanish law to license a trademark validly if the licensor does not exercise due control over the quality and nature of the goods or services of the licensee. Control therefore affords advantages both to consumers and also to the owner of the trademark and indeed to the licensee himself. On the one hand, it prevents the consumer from being misled as to the origin of the goods or services and, on the other hand, it prevents that public's expectations regarding the quality and nature of goods or services sold under the trademark from being frustrated. In the absence of all control, the public acquiring the service or product might well be deceived if it trusted in the trademark as being a sign guaranteeing in some way that the quality of the product or service distinguished by it was uniform and that it came from one and the same, albeit anonymous, source.<sup>58</sup>

<sup>57</sup> In the same way as the advertising function of a trademark enjoys the protection that the legal order grants to the other functions, it also benefits from the favorable effects deriving from the licensor's control over the nature and quality of the goods or services distinguished by the licensed trademark. And, in the same way as the other functions are maintained thanks to the control, the advertising function can only continue to operate if there is sufficient control.

<sup>58</sup> See Nathanson, "Licensing Your Trademark," 45 T.M.R. 136, 137 (1956); Bisgaier and Price, "Quality Control and the Antitrust Law in Trademark Licensing," 53 T.M.R. 1132 (1963); Lahart, 50 T.M.R. 135 (1960); Reynolds, "Contemporary Problems in Trademark Licensing—Related Company Concepts," 49 T.M.R. 1143 (1959).

Control furthermore allows the owner of the licensed trademark to protect the goodwill attaching to his trademark. The good reputation or goodwill enjoyed by trademarked goods or services, symbolized by that sign, will be maintained while at the same time, again by virtue of the control, no changes will be made to those goods or services other than what might be initiated by the owner of the trademark himself.<sup>59</sup> Consequently, control is the sole means whereby the trademark is enabled to preserve—and indeed increase—its promotional strength or advertising potential. That potential is one that, at the outset, operates clearly in favor of the entrepreneur who makes use of the trademark, by facilitating the marketing of his goods and services and their establishment on the market, and brings into play one of those assets of the trademark that have the greatest effect on its acceptance as subject matter for licensing. Also, control saves the owner of the trademark from being deprived of his rights in that sign as a result of abandonment. Adequate control over the quality and nature of the goods and services will enable its owner to preserve it and prevent it from lapsing.

Finally, the actual licensee who uses the trademark is favored in that, by virtue of the control, the sign retains the fullness of its distinguishing power and ability to win a clientele, which ultimately has a beneficial effect in the form of increased sales and the resulting profits.<sup>60</sup>

It may be observed, then, that the exercise of adequate control over the quality and nature of trademarked goods and services makes it possible for the trademark to continue to perform its functions for the benefit of consumers, the licensor and, to a certain extent, the licensee. All of them have, to a greater or lesser degree, an unquestionable interest in control being exercised. Consumers, to avoid being deceived, licensors, to retain their rights in the trademark, and licensees, to achieve steady and long-lasting increases in sales.

<sup>59</sup> See Callmann, *op. cit.*, vol. 3, Section 65.2, p. 11. For a comprehensive study in Spanish on goodwill, see Fernández-Novoa, 5 ADI 54 *et seq.* (1978).

<sup>60</sup> Nevertheless there is no doubt that the licensee's interest can fall far short of that of the consumer and that of the trademark owner. Apart from that, his interest may be at variance with theirs. It would be by no means vain for the licensee to adopt the strategy of making intensive use of the trademark on inferior goods or services, thereby securing substantial profits at the expense both of the consumer and of the owner of the licensed sign.

## Comparison of United States Patent and Trademark Office, European Patent Office and Japanese Patent Office Patent Practice\*

M. KALIKOW\*\*

### Introduction

The past 15 years have witnessed great progress in the harmonization of patent law and practice throughout the world. This period of harmonization began with the Patent Cooperation Treaty (PCT), developed from 1968 to 1970 under the auspices of the World Intellectual Property Organization (WIPO). The PCT set forth generally acceptable standards and procedures for patent searching (Chapter I) and examination (Chapter II). Most of the industrialized countries of the world, including the United States of America, have since adhered to at least Chapter I of the PCT, and many of these countries, including Japan and most European countries, have adhered to both Chapter I and Chapter II. The USA is now actively considering adhering to Chapter II.

The PCT was followed by the European Patent Convention (EPC) and the establishment of the European Patent Office (EPO) thereunder. The EPC was also based upon these PCT-developed, generally acceptable searching and examination standards and procedures. The various European Economic Community Member States which adhered to the European Patent Convention have modified their respective national patent laws and practices to harmonize with these PCT-EPC standards and procedures.

In the private patent sector international dialogue has also increased, not only through the activities of an expanded International Association for Protection of Industrial Property (AIPPI), but also by the establishment in 1970 of the Pacific Industrial Property Association (PIPA) comprising corporate patent practitioners in the United States and Japan who meet each year to promote mutual education and patent information exchanges.

During the past few years, the three major patent offices of the world (the United States Patent and Trademark Office (USPTO), the EPO and the Japanese Patent Office (JPO)) have also engaged in increasing dialogue and cooperation, culminating last year in the "First Annual Trilateral Conference" for the purpose of

"future cooperation among the three offices in automation and advanced documentation."

Since its inception, the EPO has also undertaken direct dialogue and educational seminars with its potential "customers" in the private sector, both in its member European Economic Community countries as well as in other countries, particularly in the USA and Japan. Last year, the EPO held an explanatory seminar in Munich for its top 50 worldwide applicants. Recently, the EPO has also agreed to the development of a program for continuing liaison with an advisory committee of the National Council of Patent Law Associations in the USA.

The USPTO and the JPO have not been as active as the EPO in promoting dialogue with their respective "foreign" applicants. While there have been occasional meetings between USPTO or JPO officials and visiting foreign patent practitioners or "study teams," the USPTO and JPO officials have not generally engaged in or held such "educational" seminars primarily for the benefit of their respective foreign applicants.

However, in a dramatic initiative, the JPO recently invited the American group of PIPA to assemble a team of US patent practitioners to visit the JPO in February 1984, in order to learn more about the workings of the Japanese patent system. The International and Foreign Law Committee of the APLA applauds and endorses this initiative of the JPO.

This present study and report of the APLA International and Foreign Law Committee was undertaken primarily for the purpose of promoting international harmonization of patent law and practice. The specific objective of this study is to compare the actual practices of the three major Patent Offices with respect to various aspects of the patent procurement process based upon the current experience of US patent practitioners who specialize in "foreign" patent practice. The *modus operandi* has been to set forth what in their view is actually happening rather than what the "rules" or "guidelines" indicate should be happening. It is hoped that this comparison will highlight areas where the US, European and Japanese practitioners are having problems with each other's patent practices, thereby focusing attention on the need for greater understanding of how to deal with a particular problem, or, in some cases, for modification of the practice in order to alleviate the problem.

### General Background Differences in the USA, EPC and Japanese Patent Systems

1. The US patent system is based upon a first-to-invent principle, and the date which normally prevails is the date on which the invention was actually made in the USA or on which it may be held to have been made as a result of a timely claim of priority under the Paris Convention. Interference proceedings are used to adjudicate conflicting claims of priority of inventorship.

\* This article was first prepared as a report of the American Patent Law Association (APLA) Committee on International and Foreign Law.

\*\* Chairman, Committee on International and Foreign Law, APLA; the report was delivered by A.H. Cole, Chairman of the Subcommittee on JPO Practice, at a conference of the Japan Patent Attorneys Association (JPA) on February 16, 1984.



The US system has long been a multiple claim system with independent enforceability of each claim. It has also been an examination system with the applicant and the examiner engaging in a series of direct exchanges of office actions and amendments until the issue of patentability is resolved. The examiner's actions are subject to review by more experienced supervisors. There are no oppositions by which adverse parties can directly challenge the grant of the patent in the USPTO, although the recently-introduced reexamination system provides a method by which a third party can request that the USPTO reconsider the validity of an issued patent. The costs to the applicant are moderately high, but not as high as those of the EPO or as low as those of the JPO.

2. The EPC patent system is a first-to-file system, and to a large extent is derived from the German national patent system. The EPC and the PCT borrowed those aspects of the German system which were universally acceptable and modified the unacceptable aspects to accommodate the needs and practices of applicants from countries not following German-type practice. This has resulted in a very sophisticated, high quality, high cost EPC search and examination system which embodies most of the desirable aspects of the prior patent systems and which is flexible enough to meet the needs of most applicants. More specifically, an absolute novelty, multiple claim system emerged, based upon a comprehensive search and thorough examination in which the applicant is given ample opportunity to argue and amend his application. Adverse parties are also given ample opportunity (nine months) in which to initiate an opposition. The elimination of multiple national examinations makes the high cost of this EPC system tolerable to applicants wishing to obtain coverage in more than about three EPC Member States.

3. The Japanese patent system, even though based upon the German system, was initially modified to accommodate national needs and desires for a simplified, low-cost system which encouraged innovation through a very wide participation of its technical people in the benefits of the system. A first-to-file, single claim, two-tier patent and utility model system was thus developed, which was later modified to permit multiple claims. This low-cost system has fostered a tremendous number of Japanese originated patent applications, particularly during recent years. In order to handle this large volume, the Japanese Patent Office has increased its efficiency by instituting centralized files and centralized communication with the applicant. The examiner normally has custody of the files of an application only during the brief periods of time he is actually examining an application, and his communication with the applicant is channeled through a central processing operation. Each examiner also carries an extremely heavy work load of applications, and is given very wide

latitude and independence in determining how he handles the prosecution of these applications.

### Outline of the Study

The aspects of patent practice covered by the study include the following:

- (i) Formal Filing Requirements (formal papers, final time deadlines);
- (ii) Examination of Applications (general procedures, amendments, oral communications, expediting examination, confidentiality, continuations, etc.);
- (iii) Ex Parte Appeals (reconsideration, deadlines, hearings, total time);
- (iv) Oppositions (deadlines, hearings, total time);
- (v) Post-Grant Revision (reexamination, reissue, amendment trial, parties, scope);
- (vi) Minimum Official Fees;
- (vii) Substantive Aspects (unity, divisions, dependent claims, inventorship requirements, novelty, patentable subject matter, scope of claims, sufficiency of disclosure, completeness of examiners' actions).

A comparison of each of these aspects of patent practice in the USPTO, EPO and JPO is set forth in the chart on pp. 293 to 290.

### Major Differences/Problem Areas

#### A. With Respect to USPTO Practice (from the viewpoints of Japanese and European applicants)

1. One major difference/problem area lies in the first-to-invent system in the USA vs. the first-to-file system in the EPO and JPO. The first-to-invent system is much more complicated than the first-to-file system and gives foreign applicants a great deal of trouble in the prosecution of US patent applications. The first-to-invent system requires the inventor to be the applicant, thereby necessitating an inventor's oath and assignment, and may also require the foreign applicant to engage in complicated and expensive interference proceedings. Moreover, the one-year inventor grace period together with the requirement that the invention be made in the US and the *In re Hilmer* rule<sup>1</sup> not only create problems in proof of the dates of invention or of the applicability of prior art, but also in the use of affidavits under Rule 131<sup>2</sup> for the purpose of "swearing back" of a reference.

As far as US applicants are concerned, although they are able better to handle this first-to-invent system, it

<sup>1</sup> See 359 F.2d 859, 149 U.S.P.Q. 480 (1966); 424 F.2d 1108, 165 U.S.P.Q. 255 (1970).

<sup>2</sup> See 37 C.F.R. Section 1131.

causes them often to delay their US application filing and priority dates, resulting in the loss of many valuable foreign patents.

2. A second major difference/problem area lies in the secrecy of US applications vs. the publication of EPO and JPO applications about 18 months after the priority date. This secrecy delays the citation of pertinent prior US applications until after the US patent is granted, unless corresponding foreign published applications exist.

On the other hand, this secrecy also protects the applicant from any participation by third parties throughout the prosecution of the US application. In the EPO and JPO, once an application is published, third parties may informally discuss the case with the examiner or call his attention to prior art.

3. A third major difference/problem area lies in the requirement for full disclosure in the USA based upon the "best mode" together with the restrictions in the addition of new matter. This is particularly troublesome to Japanese applicants because of the specificity with which indigenous Japanese applications are often written in order to meet the preferred Japanese standard of a single invention in a single application. It then becomes difficult to combine the disclosures of these "single inventions" to support a more generic and comprehensive multiple-priority US application.

A related difference/problem area is the availability in the US of continuations<sup>3</sup> and continuations-in-part.<sup>4</sup> It is often difficult for foreign applicants to understand and take full advantage of these continuing applications, particularly when problems of "new matter" arise. There can be a distinct benefit for applicants who do so.

#### B. *With Respect to EPO Practice* (from the viewpoints of US and Japanese applicants)

1. The patent procurement practice of the EPO is quite similar to the USPTO in its flexibility of amendment, divisions and interviews, and in its claiming structure and enforceability. However, the EPO practice is based upon the relatively simple first-to-file system rather than the more complex first-to-invent system. Moreover, the EPO practice in examination and opposition is very similar to the German practice which US applicants generally understand quite well. The EPO practice thus does not present any significant problems for US applicants.

2. The patent procurement practice of the JPO is based upon the same first-to-file German-type system

as the EPO, but is not as flexible as the EPO practice with respect to amendment, divisions, interviews and claiming structure and enforceability. The Japanese applicant should therefore have relatively few problems in handling the more flexible EPO practice.

#### C. *With Respect to JPO Practice* (from the viewpoints of US and European applicants)

1. By far the most important difference/problem area of JPO practice arises in connection with the completeness of examiners' office actions. While the EPO examiners always provide very comprehensive office actions, the JPO examiners generally provide very brief and sometimes difficult-to-understand office actions. More specifically, while the Japanese examiners will provide general reasons for a rejection, they seldom (a) indicate pertinent passages in cited references, (b) give detailed reasons for rejection (such as an explanation of the basis for a "lack of unity" rejection or an "insufficient disclosure" rejection), or (c) indicate allowable subject matter and claims. This makes it difficult for the applicant to prepare a suitable response or amendment.

2. Another important difference/problem area of JPO practice lies in the sufficiency of disclosure requirements in order to support the claims, and the difficulties which foreign applicants have in overcoming a rejection on the basis of insufficient disclosure. This problem arises primarily because US applications are often written with inclusive language and generalized examples in order to support broad generic-type claims. Under USPTO practice, the disclosure of a single embodiment of a mechanical/electrical invention may be sufficient to support broad "means plus function" claims, while under Japanese practice the JPO examiner may feel that the claims should be restricted to the particular embodiment described. In chemical/pharmaceutical cases, the JPO examiners often require additional examples to support such broad claims, or require comparative tests to demonstrate the advantages claimed. It may be difficult for the US applicant to meet these requirements during prosecution several years after the invention was made. Moreover, even if such additional examples are submitted, the examiner may often not allow them to be entered on the grounds that the new examples do not fall within the original "gist of the invention." In some cases the "insufficient disclosure" may also be the result of poor translation which makes the disclosure difficult to understand.

3. A third major difference/problem area of JPO practice relates to language and communication. The Japanese language is so difficult for Western applicants that almost every communication and most references must be partially or fully translated. Such translation is not easy to do and often introduces time delays, making it difficult to meet deadlines for action. This is particularly true with respect to the two-month deadline established for bringing an opposition. In order for a foreign

<sup>3</sup> A continuation is a second application for the same invention claimed in a prior application and filed before the original is abandoned.

<sup>4</sup> A continuation-in-part is an application filed during the life of an earlier application by the same applicant repeating a substantial portion or all of the earlier application and adding matter not disclosed therein.



applicant to bring an opposition, it is necessary for him to be alerted to the issuance of an adverse patent, obtain a copy, have it translated, find and evaluate the pertinent prior art, and have the opposition notice communicated, translated and lodged in the JPO. In a complex situation, this can sometimes take more than the two-month period specified.

**Other Significant Differences/Problem Areas**

Other differences/problem areas believed worthy of mention include the following:

1. In the USA, the translation of a foreign language specification need not be completed at the time of filing, but may be submitted later within a time set in an informality notice. Neither the EPO nor the JPO permit such later translation, but English is an EPC language.

2. Both the USPTO and the EPO permit amendments to be made virtually at any time during examination and even after appeal or allowance of the application, while the JPO permits amendments only at specified times.

3. In all three Offices, interviews are permissible and granted during prosecution at the discretion of the examiner, but are more readily granted in the USPTO and EPO than in the JPO. In the USPTO, during such interviews the examiner at his own option or at applicant's request will sometimes seek the advice of his more senior supervisor concerning questions of patentability. In the EPO, the applicant also has a right to a formal hearing before the three examiners of the full assigned "Examining Division."

4. In the US, an examiner will give consideration to an amendment submitted after final rejection and before an appeal is lodged. This not only saves money and time if the amendment makes the case allowable, but also places the application in better condition for appeal if the application remains finally rejected and the amendment is entered. Neither the EPO nor the JPO

provide this flexibility, although the JPO allows an amendment of right on the filing of an appeal, and the amended case is returned to the examiner for reconsideration before the full appeal process begins.

5. In the USPTO and the EPO, the dependent claims may include elements not in the main claim, and are deemed separately enforceable (without correction of the patent) even if the main claim is later held to be invalid. In the JPO, the dependent claims cannot include elements not in the main claim and cannot be separately enforced unless converted to a main claim in a trial for correction.

6. Finally, certified copies of priority documents may be filed at any time before the issue fee is due in the USPTO, within 16 months from the priority date in the EPO, and within three months from filing in the JPO. The EPO and JPO deadlines can create serious problems for US applicants because the USPTO may sometimes not be able to provide the certified copy in time.

**General Conclusion**

This study has revealed that the EPO practice, based upon a first-to-file, comprehensive search and examination system with great procedural flexibility, generally creates few problems and provides a universally acceptable model. However, this EPC system is quite expensive, and it is appreciated that it may not be entirely affordable in a national patent system. Nevertheless, it is believed that many of the differences/problem areas in the USPTO and JPO practices mentioned in this study may be minimized without great expense and without harm to national policies and goals.

The APLA Committee on International and Foreign Law also recommends that the USPTO, EPO and JPO be urged to take the lead in fostering the legal and procedural changes required to provide greater harmonization of their respective patent practices, to the great benefit of all applicants.

\* \* \*

**COMPARISON OF USPTO, EPO & JPO PATENT PRACTICE\***

Aspect of Foreign Patent Practice	U.S. Patent & Trademark Office	European Patent Office	Japanese Patent Office
<b>I. Formal Filing Requirements</b>			
<b>1. Formal Papers</b> (in addition to specification, dwgs., power of atty., formal request, priority claim, certified copy of priority document, and inventor name and address)	<ul style="list-style-type: none"> <li>● Specification in English</li> <li>● Inventor oath (or Declaration)</li> <li>● Inventor assignment</li> <li>● Abstract</li> </ul>	<ul style="list-style-type: none"> <li>● Specification in English, French or German</li> <li>● No inventor oath</li> <li>● Indication of assignee's right to European patent (Desig. of Inv. Form)</li> <li>● Abstract</li> </ul>	<ul style="list-style-type: none"> <li>● In Japanese</li> <li>● No inventor oath</li> <li>● When assignment to applicant is made before filing, it need not be submitted with initial papers</li> <li>● No abstract required</li> </ul>

Aspect of Foreign Patent Practice	U.S. Patent & Trademark Office	European Patent Office	Japanese Patent Office
<b>2. Final Time Deadlines</b>			
• Inventor Assignment	• By date issue fee is paid or due	• Designation of Inventor form—usually 2 months from notification of deficiency	• Only when requested by the JPO, or when assignment of application is made after filing
• Translation of Specification	• Within term set in informality notice	• At time of filing for U.S.A. and Japanese applicants (resident of contracting State has 3 months after filing; 13 months after priority date in priority filing) but note that English is an EPC language	• At time of filing
• Certified Copy of Priority Document	• By date issue fee is paid or due	• 16 months from priority date	• 3 months from filing
• Priority Claim	• May be included in new oath filed before issue fee is paid or due	• When application is filed	• When application is filed
• Abstract	• Within term set by examiner	• Usually 2 months from invitation	• Not required
• Translation of Certified Copy	• For interference; or to overcome a reference; or if examiner requires it	• If priority document not in English, French or German, must file translation in one of those languages within 21 months after priority date	• Translation only of certificate 3 months from filing
• Formal Drawings	• By date issue fee is paid or due	• Usually 2 months from invitation	• 1 month from invitation
• Power of Attorney	• At any time during pendency	• Usually 2 months from invitation	• 1 month from invitation
• Inventor Oath (or Declaration)	• Within time set in informality notice	• None required	• None required
• Payment of Filing Fees	• Within 2 months of deficiency notice	• Filing and search fees: 1 month from filing, or during 2 grace months with 50% surcharge. Designation fees: 12 months from priority date (Conv.) or filing date (non-Conv.), but at least 1 month from filing date, or during further 2 months grace period with 50% surcharge	• 1 month from invitation
<b>II. Examination of Applications</b>			
<b>1. General Procedure</b>			
• Must Exam be Requested? — Deadline for request	• No — N/A	• Yes — 6 months after publication of Search Report is mentioned in <i>European Patent Bulletin</i>	• Yes — 7 years from filing
• Usual Number of Official Actions before "Final"	• 1 or 2	• 2 or 3	• 1 or 2
• Examiner's Response Time	• Several months	• Several months	• Several months
• Average Total Time to Allowance/Rejection	• 2-3 years after filing	• 2-3 years after exam request	• 2 years, 2 months after exam request
<b>2. Amendment</b>			
• When may "Discretionary" Amendments be made	• Generally at any time before issue fee paid or due	• Obvious errors may be corrected at any time; other amendments at times set forth below	• Only at specified times set forth below
(a) Before exam	(a) At any time	(a) Between Search Report and first O.A.	(a) — Within 15 months from effective filing date — When exam requested
(b) During exam	(b) At any time, even after final rejection (in preparation for appeal) if permitted by examiner (frequent)	(b) — In response to first O.A. — Generally allowed at other times to remove notified deficiencies, restrict claims or clarify the spec.	(b) In response to O.A., 3 months with 1 month extension, subject to official fee (only 40 days for Japanese residents)
(c) On appeal	(c) At any time, if permitted by Board of Appeals (very rare)	(c) — In response to O.A. — Before oral proceeding (alternative submissions permitted)	(c) Within 30 days from filing (alternative submissions not permitted); in response to O.A. during appeal (same time limit as (b))

Aspect of Foreign Patent Practice	U.S. Patent & Trademark Office	European Patent Office	Japanese Patent Office
(d) After notice of allowance	(d) By date issue fee is paid or due, if permitted by examiner	(d) When settling on text of patent in addition to generally allowable amendments (see (b), above), can usually amend respecting new art	(d) None permitted
(e) During opposition	(e) N/A	(e) — At invitation of Opposition Division (alternative submissions permitted)  — When settling text (see (d), above)	(e) — Within time specified by JPO, 3 months + 1 grace month (only 40 days for Japanese residents) (alternative submissions not permitted); limited scope  — In answer to possible O.A.
(f) During opposition appeal	(f) N/A	(f) See (c), above	(f) Within 30 days from appeal; limited scope
(g) Post-grant	(g) Only during reissue or re-exam	(g) — See (e) and (f) — Resulting Euro/national patents may be amended in accordance with laws of respective countries	(g) Trial for correction possible at any time, except after decision of invalidity; see V.1
<ul style="list-style-type: none"> <li>● Conformance of Specification to Amended Claim</li> <li>● Term for Response to Official Action</li> </ul>	<ul style="list-style-type: none"> <li>● Not required</li> <li>● 3 months, with extensions permitted up to maximum response term of 6 months, subject to official fee</li> </ul>	<ul style="list-style-type: none"> <li>● Specification is conformed to amended claim before grant</li> <li>● 2-4 months, with extensions permitted up to maximum response term of 6 months</li> </ul>	<ul style="list-style-type: none"> <li>● When claim amendment is made</li> <li>● 3 months, with 1-month extension, subject to official fee (only 40 days for Japanese residents)</li> </ul>
<b>3. Oral Communications with Examiners</b>			
<ul style="list-style-type: none"> <li>● By Telephone — At attorney's request — At examiner's request</li> </ul>	<ul style="list-style-type: none"> <li>● Telephone communications are encouraged, but must be supplemented by written confirmation of substance of conversation</li> </ul>	<ul style="list-style-type: none"> <li>● Telephone communications are encouraged, when they are apt to expedite re-examination and reduce official actions</li> </ul>	<ul style="list-style-type: none"> <li>— Examiner will discuss only matters fresh in his memory</li> <li>— Some examiners call for clarification and even suggest nature of acceptable amendment</li> </ul>
<ul style="list-style-type: none"> <li>● Informal Office Interviews</li> </ul>	<ul style="list-style-type: none"> <li>● Encouraged (same as above)</li> </ul>	<ul style="list-style-type: none"> <li>● Same as above</li> </ul>	<ul style="list-style-type: none"> <li>● Encouraged, but examiners are generally reluctant to grant personal interviews</li> </ul>
<ul style="list-style-type: none"> <li>● Formal Hearings</li> </ul>	<ul style="list-style-type: none"> <li>● Formal interviews with an examiner and his supervisor are usually established at either the examiner's or applicant's request</li> </ul>	<ul style="list-style-type: none"> <li>● Oral proceedings take place either at the instance of the EPO or at the request of the applicant before the full Examining Division (3 examiners)</li> </ul>	<ul style="list-style-type: none"> <li>● Formal interviews at examiner's discretion (supervisor not present)</li> </ul>
<b>4. Expediting Examination</b>			
<ul style="list-style-type: none"> <li>● Procedures</li> </ul>	<ul style="list-style-type: none"> <li>● Petition Commissioner</li> </ul>	<ul style="list-style-type: none"> <li>● Petition President of EPO</li> </ul>	<ul style="list-style-type: none"> <li>● Petition Director of Patent Office</li> </ul>
(a) If serious allegation of infringement, or for other special reason	(a) Statement of facts (usually granted)	(a) Will normally be granted if strong supporting reasons are given	(a) When a person other than the applicant is working the invention as a business after laying open, but before the 2nd publication, he or the applicant may request preferential exam, submitting detailed explanation of circumstances and necessity of preferential treatment, copy of warning letter, evidence in support; very few petitions are granted
(b) To consolidate prosecution of related cases	(b) Interview Primary Examiner — (usually granted)	(b) At discretion of examiner	(b) Same as EPO
<b>5. Confidentiality of Examination</b>			
<ul style="list-style-type: none"> <li>● When is Application Accessible to Third Parties?</li> </ul>	<ul style="list-style-type: none"> <li>● Application kept secret throughout prosecution — In interference proceeding each party is given access to the other's file</li> </ul>	<ul style="list-style-type: none"> <li>● After laying open, i.e., 18 months after the earlier of priority date or actual filing date</li> </ul>	<ul style="list-style-type: none"> <li>● Same as EPO</li> </ul>

Aspect of Foreign Patent Practice	U.S. Patent & Trademark Office	European Patent Office	Japanese Patent Office
6. <i>Continuations, Continuations-in-Part, Patents of Addition</i>	• Continuations and continuations-in-part	• None provided for	• Patents of addition
<b>III. Ex Parte Appeals (Patent Office)</b>			
1. Examiner Reconsideration to Avoid Need for Full Appeal — With/without Amendment — Before/after appeal fee paid	1. Examiner will accept request for reconsideration, with or without amendment before appeal if request is timely filed	1. Examining Division may rectify its decision (interlocutory revision) within one month after receipt of detailed brief; appeal fee must be paid; amendments can be offered; fee reimbursement if there has been a substantial procedural violation	1. When amendment is offered on appeal examiner may rectify his decision or issue a further O.A.; fee must be paid; no reimbursement
2. Deadline for Filing Notice of Appeal	2. 3 months, extendable to 6 months subject to official fee	2. 2 months after notification of decision	2. 30 days for Japanese residents, 90 days for foreigners
3. Deadline for Detailed Brief	3. 2 months after filing notice of appeal, extendable as above	3. 4 months after notification of decision	3. 30 days from invitation
4. Oral Hearings	4. Will be held if requested	4. Oral proceeding before appeal board may be requested by appellant or by EPO	4. Informal interviews are often permitted; extensive prosecution occasionally takes place on appeal; formal hearings are sometimes permitted to gather evidence, interrogate witness (not usual)
5. Further Appeals, as a Matter of Right	5. (a) Court of Appeals for the Federal Circuit	5. Further appeal not provided for	5. (a) Tokyo High Court, then (b) Supreme Court
6. Average Total Time (1st Instance)	6. 2 years	6. 1-2 years	6. 3-5 years
<b>IV. Oppositions</b>			
1. Deadline for bringing	1. Not available	1. 9 months from grant; notice of grounds and a reasoned statement of the case, indicating the facts, evidence and arguments to be presented in support of grounds	1. Notice of opposition generally stating the grounds for opposition; within 2 months from 2nd publication date
2. Deadline for Initial Brief  — Supplementary briefs permitted?	2. Not available  — Not available	2. Facts and evidence must be submitted within 2 months after expiration of opposition period  — Only at the invitation of the Opposition Division or in connection with the content of the proposed final text	2. 30 days thereafter for Japanese residents; 90 days thereafter for foreigners  — Only at the invitation of the opposition board, but new evidence may not be filed; voluntary supplement may or may not be considered
3. Oral Hearings	3. Not available	3. The Opposition Division will endeavor to reach a decision in written proceedings, but oral proceedings may be had at the request of any party or the EPO	3. Formal hearings sometimes permitted to investigate evidence with the parties concerned or to interrogate witnesses.
4. Average Total Time	4. Not available	4. More than 1 year	4. 1-2 years
<b>V. Post-Grant Revision</b>			
1. Re-examination, Reissue, or Amendment Trial  — Ex parte vs. inter partes  — Broadening vs. narrowing	1. Re-examination or reissue at request of patentee  — Ex parte, but third parties may submit prior art  — Broadening claims permitted in reissue proceeding begun within 2 years of grant	1. Revision through opposition or proceedings before patent offices of designated countries  — Opposition revision is inter partes; national revision is ex parte, e.g.,—correction of obvious error in translation of patent text A.70(4)(a), R.88  — After 2nd publication, amendments limited to disclaimer, clarification and correction of obvious errors	1. Trial for correction  — Trial for correction is ex parte, but re-published, amended appln. may be opposed; and, after grant, may be subjected to invalidation trial  — Similar to EPO but errors may not be correctable

Aspect of Foreign Patent Practice	U.S. Patent & Trademark Office	European Patent Office	Japanese Patent Office
-----------------------------------	--------------------------------	------------------------	------------------------

**VI. Minimum Official Fees\*\***

	Regular (Dollars)	Small Entity (Dollars)	(DM)	(Yen)
1. Filing	1. } = 300	150	1. 520	1. 6,300
2. Search	2. }		2. 1,670	2. No separate fee
3. Examination	3. }		3. 1,980	3. 25,500
4. Appeal	4. 115	62.50	4. 630	4. 19,000
5. Opposition	5. —	—	5. 520	5. 3,800
6. Maintenance	6. 400; 800; 1,200 (every fourth year)	200; 400; 600	6. 430 3rd year, increasing to 1,500 20th year	6. 7,000 4th year, increasing to 56,000 15th year
7. Designation of States	7. —	—	7. 260 each State	7. —
8. Grant	8. 500	250	8. 430 + DM12 for each page to be printed	8. 13,500 (1st 3 years' maintenance)

**VII. Substantive Aspects**

**1. Unity of Invention Requirements**

<ul style="list-style-type: none"> <li>• Definition of "Related Inventions"                             <ul style="list-style-type: none"> <li>— Claims permissible in same application</li> </ul> </li> <li>• When May Divisions be Filed?                             <ul style="list-style-type: none"> <li>— Before final</li> <li>— During appeal</li> <li>— During opposition</li> </ul> </li> </ul>	<ul style="list-style-type: none"> <li>• Linked by a single general inventive concept                             <ul style="list-style-type: none"> <li>(1) Product, process and use</li> <li>(2) Process and apparatus/means for carrying out the process</li> </ul>                             In practice, restriction frequently required                         </li> <li>• Divisions may be filed at any time before "Final," even after appeal                             <ul style="list-style-type: none"> <li>— At any time before the patenting, abandonment, or termination of proceedings on the prior application</li> <li>— Yes (same as above)</li> <li>— N/A</li> </ul> </li> </ul>	<ul style="list-style-type: none"> <li>• Same as U.S.A. but restriction practice more liberal                             <ul style="list-style-type: none"> <li>— Any time between filing date and end of term for answering first O.A.; thereafter, at discretion of examiner, but within 2 months after limitation in response to non-unity objection, up to favorable conclusion of examination</li> <li>— If Board of Appeal considers that division is justified</li> <li>— Apparently not possible</li> </ul> </li> </ul>	<ul style="list-style-type: none"> <li>• (a) Combination &amp; subcombination having same effect</li> <li>• (b) Product, process for making it, process for using product, devices for making product, products solely utilizing the specific properties of the product</li> <li>• (c) Process, devices used directly in working the process                             <ul style="list-style-type: none"> <li>— When amendment is permitted</li> <li>— When amendment is permitted</li> <li>— When amendment is permitted</li> </ul> </li> </ul>
--	--	--	--

**2. Independent vs. Dependent Claims**

<ul style="list-style-type: none"> <li>• Several independent claims permitted, and related dependent claims which may and elements not in independent claim                             <ul style="list-style-type: none"> <li>— Dependent claims are separately enforceable</li> <li>— Invalidity of dependent claim does not affect independent claim</li> </ul> </li> </ul>	<ul style="list-style-type: none"> <li>• Same as U.S.A.                             <ul style="list-style-type: none"> <li>• One independent claim per invention                                     <ul style="list-style-type: none"> <li>— Dependent claims merely detail specified elements of independent claim—no new elements</li> <li>— Dependent claims not separately enforceable</li> <li>— patent not enforceable if any claim is invalid, but invalidity can be cured through trial for correction</li> </ul> </li> </ul> </li> </ul>
--	--

**3. Inventorship Requirements**

<ul style="list-style-type: none"> <li>• First-to-Invent vs. First-to-File</li> <li>• Inventorship Contests</li> <li>• Derivation Proceedings</li> </ul>	<ul style="list-style-type: none"> <li>• First-to-invent                             <ul style="list-style-type: none"> <li>• Interference proceedings for determining first inventor</li> <li>• Derivation proceedings available to invalidate patent</li> </ul> </li> </ul>	<ul style="list-style-type: none"> <li>• First-to-file                             <ul style="list-style-type: none"> <li>• No inventorship contests</li> <li>• Entitlement proceedings may be brought in courts of some designated States and ownership may be transferred</li> </ul> </li> </ul>	<ul style="list-style-type: none"> <li>• First-to-file                             <ul style="list-style-type: none"> <li>• No inventorship contests</li> <li>• Application or patent may be invalidated; no provision for transfer of ownership; however, if true inventor or assignee files before publication of wrongful filing, he may obtain patent upon invalidation of other case</li> </ul> </li> </ul>
--	---	--	--

Aspect of Foreign Patent Practice	U.S. Patent & Trademark Office	European Patent Office	Japanese Patent Office
<b>4. Novelty Requirements</b>			
<ul style="list-style-type: none"> <li>• What Constitutes Prior Art? (local use, experimental use, whole contents rule, etc.)</li> </ul>	<ul style="list-style-type: none"> <li>• Publication anywhere or public use or sale in U.S.; disclosed in "prior-filed" U.S. patent of another inventor of earlier U.S. filing date               <ul style="list-style-type: none"> <li>— "Experimental" use not considered public use</li> <li>— U.S. inventor can "swear back" of prior art reference filed within his 1-year grace period</li> </ul> </li> </ul>	<ul style="list-style-type: none"> <li>• Publication or public use anywhere; disclosed in any laid-open EPC appln. of earlier effective date in respect of commonly-designated country; and, in revocation proceeding in designated country, prior-filed laid-open applns. of that country per national law</li> </ul>	<ul style="list-style-type: none"> <li>• Publication anywhere; known or used in Japan; disclosed in laid-open Japanese application of a different applicant of an earlier effective date; publications circulated abroad only are not prior art against a patent after 5 years from grant</li> </ul>
<ul style="list-style-type: none"> <li>• Self-Collision</li> </ul>	<ul style="list-style-type: none"> <li>• No self-collision (i.e., when inventorship identical)</li> </ul>	<ul style="list-style-type: none"> <li>• Self-collision possible</li> </ul>	<ul style="list-style-type: none"> <li>• No self-collision when applicants are identical, even if inventors are different</li> </ul>
<ul style="list-style-type: none"> <li>• Grace period</li> </ul>	<ul style="list-style-type: none"> <li>• 1 year</li> </ul>	<ul style="list-style-type: none"> <li>• 6 months, for adverse publication derived from applicant or for applicant's divulgation at a recognized international exhibition</li> </ul>	<ul style="list-style-type: none"> <li>• 6 months, for experimental use or for applicant's divulgation at a recognized technical meeting</li> </ul>
<ul style="list-style-type: none"> <li>• Foreign-Originated Invention Priorities for Matter Disclosed But Not Claimed (<i>In re Hilmer</i>)</li> </ul>	<ul style="list-style-type: none"> <li>• Priority given only for matter claimed in priority application</li> </ul>	<ul style="list-style-type: none"> <li>• Priority given for all matter disclosed</li> </ul>	<ul style="list-style-type: none"> <li>• Same as EPO</li> </ul>
<b>5. Patentability</b>			
<ul style="list-style-type: none"> <li>• Unobviousness Standards               <ul style="list-style-type: none"> <li>— Requirements for comparative tests</li> </ul> </li> </ul>	<ul style="list-style-type: none"> <li>• Unobvious to person skilled in the art               <ul style="list-style-type: none"> <li>— Comparative data rarely required</li> </ul> </li> </ul>	<ul style="list-style-type: none"> <li>• Unobvious to skilled person               <ul style="list-style-type: none"> <li>— Comparative data may be required if examiner not otherwise convinced of alleged advantage over prior art</li> </ul> </li> </ul>	<ul style="list-style-type: none"> <li>• Same as EPO               <ul style="list-style-type: none"> <li>— "Meritorious effect" must be demonstrated</li> </ul> </li> </ul>
<ul style="list-style-type: none"> <li>• Utility               <ul style="list-style-type: none"> <li>— Proof of industrial applicability</li> </ul> </li> </ul>	<ul style="list-style-type: none"> <li>• Must be "useful"</li> </ul>	<ul style="list-style-type: none"> <li>• Must have industrial applicability</li> </ul>	<ul style="list-style-type: none"> <li>• Same as EPO</li> </ul>
<ul style="list-style-type: none"> <li>• Patentable Subject Matter</li> </ul>	<ul style="list-style-type: none"> <li>• Includes chemical substances, pharmaceuticals, some computer programs</li> </ul>	<ul style="list-style-type: none"> <li>• Same as U.S.A., but no protection for computer programs (for the time being Austria excepts chemical substances, pharmaceuticals and food products)</li> </ul>	<ul style="list-style-type: none"> <li>• Same as EPO except that, as a general rule, an invention related to a computer program may be claimed as a method, e.g., a method of controlling a machine</li> </ul>
<b>6. Scope/Breadth of Claims Deemed Acceptable</b>			
<ul style="list-style-type: none"> <li>• Generic vs. Specific Coverage</li> </ul>	<ul style="list-style-type: none"> <li>• Generic claims with broad language ("means" plus function) and with a scope limited only by the prior art are normally allowed even if based upon only a single fully disclosed embodiment, in mechanical/electrical cases, and a representative range of examples in chemical cases; specific claims based upon particular construction/features/examples disclosed are also allowed</li> </ul>	<ul style="list-style-type: none"> <li>• Same as U.S.A.</li> </ul>	<ul style="list-style-type: none"> <li>• Generic claims with broad language ("means" plus function) rarely allowed; examiners prefer specific claims based upon particular construction and features of embodiments disclosed in mechanical cases or particular examples set forth in chemical cases</li> </ul>
<ul style="list-style-type: none"> <li>• Sufficiency of Disclosure to Support Claims               <ul style="list-style-type: none"> <li>— Insufficient examples</li> <li>— Need for comparative tests</li> <li>— Not understandable</li> <li>— Actual vs. "paper" examples</li> </ul> </li> </ul>	<ul style="list-style-type: none"> <li>— A few examples within claimed scope usually enough</li> <li>— Not usually required to prove invention</li> <li>— Rarely</li> <li>— "Paper" examples permitted, but must be identified as such</li> </ul>	<ul style="list-style-type: none"> <li>— Examples should enable the teaching to be applied over the entire claimed scope</li> <li>— May be required to demonstrate advantages</li> <li>— Rarely</li> <li>— "Paper" examples do not appear to be prohibited</li> </ul>	<ul style="list-style-type: none"> <li>— Same as EPO</li> <li>— Same as EPO</li> <li>— Often (may be translation problems)</li> <li>— "Paper" examples not acceptable</li> </ul>

Aspect of Foreign Patent Practice	U.S. Patent & Trademark Office	European Patent Office	Japanese Patent Office
— Justification of numerical limitations	— Not required, except where crucial to patentability	— Same as U.S.A.	— Numerical limitation must be explained
— Best mode	— Required, but rarely a basis for rejection	— Not required	— Same as EPO
<i>7. Completeness of Office Actions of Examiners and Appeal Boards</i>			
● Identification of Applicable Passages in References	● Usual	● Almost always	● Examiner seldom indicates pertinent passages in references
● Statement of Specific Reasons for Rejection	● Almost always	● Always	● General reasons usual, but detailed reasons seldom given
— Explanation of Basis for Lack of Unity Rejection	— Usually	— Usually	— Rarely
— Explanation of "insufficient disclosure" rejection	— Always	— Always	— Seldom
● Indication of Allowable Subject Matter and Claims	● Usually	● Usually	● Rarely

\* Prepared by APLA Committee on International and Foreign Law, M. Kalikow — Chairman (February 1, 1984).

\*\* Current Exchange Rates: \$1.00 = Y 234 ; \$1.00 = DM 2.8 ; DM1 = Y 83.6 (January 26, 1984).

## Activities of Industrial Property Offices

### Swedish Patent and Trademark Centennial

"The Paris Convention for the Protection of Industrial Property was signed in 1883. Sweden was among the first States that adhered to the Convention. Patent and trademark legislation conforming to the Convention was adopted by the Swedish Parliament in 1884 and came into force on January 1, 1885. There were, of course, both patents and trademarks before this time, but the year 1884 marks the introduction in Sweden of a modern patent and trademark system."

\* \* \*

The preceding paragraph is quoted from the preface of the invitation to the celebration, signed by Mr. Göran Borggård, Director General of the Royal Patent and Registration Office, in his capacity as Chairman of the Government Organizing Committee.

The Centennial was celebrated in Stockholm from June 13 to 15, 1984, by a symposium, held in the Parliament Building, and a ceremony and banquet, held at the Stockholm City Hall.

The symposium was an international one, with speakers from a dozen countries and from WIPO and the European Patent Office. It attracted some 400 participants.

The ceremony and the banquet were honored and graced by Their Royal Majesties, King Carl XVI Gustaf and Queen Silvia. Approximately 900 persons participated. The World Intellectual Property Organization was represented by its Director General, who had the honor to sit next to the Queen during the banquet and who made, during the brilliantly organized celebration, a speech whose text is reproduced below. That text reflects the significance of the event and the importance that WIPO attached to it.

"I came here to pay tribute to Sweden on the occasion of the hundredth anniversary of its patent and trademark system.

"I came here to pay that tribute on behalf of the world community of industrial property as incarnated by the World Intellectual Property Organization.

"Sweden has been and is a most active, most constructive and most efficient member of that world community and of the said World Organization.

"I shall recall, in a few words, the role that Sweden has played and is playing on the international scene to promote worldwide cooperation in the field of the protection of industrial property, that is, the protection of the rights of inventors and industrialists in inventions and the rights of all kinds of enterprises in their trademarks.

"The basic international instrument guaranteeing the protection of the patent and trademark rights of Swedes abroad, and the patent and trademark rights of foreigners in Sweden, is the Paris Convention for the Protection of Industrial Property. That Convention is now more than a hundred years old. Sweden participated in the negotiations, among some 20 countries, that prepared the conclusion of the Paris Convention. Sweden's first delegates in those negotiations were a Secretary General of the Ministry of External Affairs, Lagerheim, and a professor and former minister, Brocb.

"The Paris Convention was revised, in diplomatic conferences of the countries party to it, six times during its first hundred years of existence. The first delegate to such conferences whom I could identify was, at the end of the last century, a Director of the Swedish Patent and Registration Office, Count Hugo Eric Gustaf Hamilton. Sweden was represented in all those diplomatic conferences and, with the imagination and interventions of its delegations, contributed to the improvement of the Convention.

"As a matter of fact, Sweden was the host of that Diplomatic Conference which revised the Paris Convention the most recently. That Conference was held in Stockholm in 1967.

"The Stockholm Diplomatic Conference not only revised the Paris Convention and half a dozen other international treaties in the fields of industrial property and copyright, but also adopted a new treaty, namely, the treaty that established the World Intellectual Property Organization, an organization that started functioning in 1970, became one of the then 14 United Nations specialized agencies in 1974, and is today the worldwide organizational frame for international cooperation among more than 100 States for all forms of intellectual property.

"That Organization, as I have said, was created in Stockholm, and the international community of intellectual property owes lasting thanks to Sweden for the intellectual and material contributions—the most important contributions among the contributions of all countries—that Sweden has made for that epoch-making conference.

"The preparations were conducted by Ambassador Sture Petré, and the Swedish Delegation was led by Herman Kling, Minister for Justice, and Torwald Hesser, Justice of the Supreme Court. Three, at least, of the members of the Delegation of the host country are today in the room: Göran Borggård, Claës Ugglå and Gunnar Karnell.

"But the quite exceptional, prominent role that Sweden has played in international contacts did not end with the 1967 Stockholm Conference. On the contrary, because of the brilliant success of Sweden in that Conference, the Member States of the World Intellectual Property Organization have somewhat developed the habit of turning to Swedes when particularly difficult and particularly delicate tasks have to be fulfilled.

"There is at least one eminent Swede whose name I should, and shall with pleasure, mention in this connection.

"He led the Swedish Delegation to some 100 international meetings of the World Intellectual Property Organization and was elected chairman of dozens of them.

"Recently, he has acquired particular merits by presiding over the negotiations that led to substantial improvements in the Patent Cooperation Treaty.

"He set an example on how to make a modern patent office particularly useful to inventors, industry and commerce in an advisory capacity, that is, even outside its role of granting or registering industrial property rights.

"He procures training and other technical assistance, through members of his staff and with the help of the Swedish International Development Agency, for nationals and industrial property institutions of developing countries in Africa, Asia and Latin America.



"This man, who is also the chief organizer of the present centenary celebrations, is the Director General of the Royal Patent and Registration Office, Mr. Göran Borggård.

\* \* \*

"Your Royal Majesties, with your kind and gracious permission, I should like now to conclude by expressing a feeling that, I am sure, all of us in the ceremony have.

"It is a feeling of gratitude towards Your Majesties for your presence and participation in this commemorative and ceremonial event. It shows, in the most convincing and the most elegant way one can think of, the importance that the Kingdom of Sweden, its sovereign, its people and its Government, attach to the protection of the rights of the inventive genius of mankind.

"The protection of those worthy rights rests on a good patent system which Sweden has and has had for a hundred years.

"We congratulate Sweden on its brilliant past accomplishments and wish continued success to it, for its own benefit and for the benefit of all people in the world."

## News from Industrial Property Offices

### EUROPEAN PATENT OFFICE

The Administrative Council of the European Patent Organisation, at its meeting from June 5 to 8, 1984, agreed that Mr. Paul Braendli, Director of the Swiss Patent Office and Head of the Swiss delegation on the Administrative Council, would succeed Mr. J.B. van Benthem as President of the European Patent Office with effect from May 1, 1985.

### AUSTRALIA

#### *Commissioner of Patents*

We have been informed that Mr. Pat Smith has been appointed Commissioner of Patents.

### INDIA

#### *Controller-General of Patents, Designs and Trade Marks*

We have been informed that Mr. R.A. Acharya has been appointed Controller-General of Patents, Designs and Trade Marks.

### MAURITIUS

#### *Comptroller of Customs*

We have been informed that Mr. S. Gunnoo has been appointed Comptroller of Customs.

### MEXICO

#### *Director General, Directorate General of Inventions, Marks and Technological Development*

We have been informed that Mr. Rubén Beltrán Guerrero has been appointed Director General of the Directorate General of Inventions, Marks and Technological Development.

## Book Reviews

**Trademarks and Unfair Competition** (2nd edition), by J. Thomas McCarthy. The Lawyers Co-Operative Publishing Co. and Bancroft-Whitney Co., Rochester (N.Y.) and San Francisco, 1984.—2 volumes, 2,269 pages.

The first edition of *Trademarks and Unfair Competition* was published in 1973, and enjoys the well-deserved reputation of being one of the leading treatises on United States trademark and unfair competition law. It is an extraordinarily lucid work that has been relied upon as authority by federal and state courts in numerous reported trademark opinions, and was mentioned by the U.S. Supreme Court in its only recent trademark decision.

While maintaining the same logical organization and coherent style of the first edition, the author has, with the second edition, significantly updated, augmented, revised and improved his treatise. As he points out in his Preface, about 40 percent of the material is newly written. Most of the changes were required by new case law and statutory developments; some of the new text, however, results from the author's desire to explain traditional principles and concepts with even greater clarity and depth. A few of the many outstanding features of the new edition include expanded coverage of trademark and unfair competition law in the literary and entertainment fields, a revised analysis of trademark infringement and false advertising (Section 43(a) of the Lanham Act as well as the First Amendment to the U.S. Constitution), inclusion of recent developments in trademark licensing and franchising law, and increased coverage of foreign trade problems, including importation of infringing and counterfeit goods, parallel imports and country of origin marking rules. In addition, the work contains some helpful illustrations and three valuable appendices that reproduce and annotate the text of the Lanham Act, provide detailed references to all other statutes relevant to trademarks and reprint and index the Trademark Rules of Practice.

In sum, the second edition of *Trademarks and Unfair Competition* is a remarkably well-conceived and well-written work that will no doubt prove to be an indispensable tool to any lawyer dealing with U.S. trademark or unfair competition law matters.

JE

**Patents for Inventions** (5th edition), by T.A. Blanco White. Stevens & Sons, London, 1983.—304 pages.

Since June 1, 1978, patent applications filed in the United Kingdom have been governed by the Patents Act 1977. All patents whose complete specifications were filed prior to that date, however, are governed by a complex hybrid system of law: in some instances the previous Act, the Patents Act 1949, applies; in others the 1977 Act is applicable; and in still others transitional provisions come into play.

The purpose of the fifth edition of this well-known and highly regarded text is to analyze and clarify that hybrid system of law. As the author explains in his Preface, the reason that he rightfully deems it essential to devote so much scrutiny to "old Act patents" is that "...by and large, patents become practically important, if at all, near the end of their lives. So, for the next decade and a half attention needs to be directed to the patents granted under the Act before...."

The author logically directs his analysis to the most relevant aspects of the law relating to old Act patents: the interpretation and permissible amendment of patent specifications; patent infringement; and patent validity. All three subjects are covered in depth and with great perspicuity. Moreover, the parts of the 1949 Act, and the Rules under it, that are still operative are reproduced in appendices.

This work is thus of vast utility to all practitioners who must make their way through the complexities of the British patent system and is an excellent complement to the author's comprehensive work on the new Act, the *Encyclopedia of United Kingdom and European Patent Law*.

JE

### Selection of New Publications

AHRENS (H.-J.), *Wettbewerbs- Verfahrensrecht zum vorbeugenden Rechtsschutz durch einstweiligen Rechtsschutz*. Carl Heymanns Verlag KG, Cologne, 1983.—535 p.

ATRIP *Biographical Directory: Teachers and Researchers in Intellectual Property Law*, International Association for Advancement of Teaching and Research in Intellectual Property, 1983.—111 p.

BERCOVITZ (A.), *Las Patentes en la Empresa*, Fundación del Instituto Nacional de Industria, Madrid, 1982.—191 p.

BERTIN (C. & G.) & PINSON (M.), *Les Conditions de protection du logiciel en France*, AREPIT, Paris, 1983.—118 p.

BLANCO WHITE (T.A.) et al., *Kerly's Law of Trade Marks and Trade Names* (11th edition), Sweet & Maxwell, London, 1983.—753 p.

CATALDO (V. di), *L'Originalità dell'invenzione*, A. Giuffrè, Milan, 1983.—113 p.

CAVALIER (G.) (ed.), *Leyes Vigentes sobre Propiedad Industrial* (3rd edition), Siski, Bogota, 1983.—273 p.

*Estudio Comparado de Legislación y Práctica Marcaria en América/Comparative Study of Trademark Legislation and Practice in America*, Inter-American Association of Industrial Property, Buenos Aires, 1984.—188 p.

FRIGNANI (A.), *Disciplina della Concorrenza nella CEE* (3rd edition), Jovene, Naples, 1983.—611 p.

GAUL (D.), et al., *Handbuch des gewerblichen Rechtsschutzes: Praktische Rechtshilfe für die Patent-, Rechts- und Lizenzabteilung* (2nd edition), O. Schmidt, Cologne, 1983.—2 vols. (looseleaf).

HAMBURG (C.B.), *1983-84 Patent Law Handbook*, Clark Boardman, New York, 1983.—367 p.

HOLMES (W.C.), *Intellectual Property and Antitrust Law*, Clark Boardman, New York, 1983.—666 p.

*Information on the Activities of the Council for Mutual Economic Assistance in the Field of Inventive Acts and Patenting*, Council for Mutual Economic Assistance, Moscow, 1983.—16 p.

INSTITUT DE RECHERCHE EN PROPRIÉTÉ INTELLECTUELLE HENRI DESBOIS, *L'avenir de la protection des désignations géographiques (à propos de la révision de la Convention de Paris)*, Cahiers IRPI—no 1, Paris, 1983.—81 p.

*Intellectual Property Rights and Innovation*, Her Majesty's Stationery Office, London, 1983.—45 p.

JAGER (M.F.), *1983 Trade Secrets Law Handbook*, Clark Boardman, New York, 1983.—461 p.

PACHÓN MUÑOZ (M.), *Las Preferencias en las Solicitudes de los Registros Marcarios*, Editorial Temis, Bogota, 1983.—98 p.

PACHÓN MUÑOZ (M.), *Manual de Propiedad Industrial* (2nd edition), Editorial Temis, Bogota, 1984.—175 p.

PEDRAZZINI (M.M.), *Patent- und Lizenzvertragsrecht*, Stämpfli, Berne, 1983.—195 p.

*Software Protection and Marketing* (edited by M.D. Goldberg), Practising Law Institute, New York, 1983.—2 vols., 1,348 p.

SHAW (L.), *The Practical Guide for People with a New Idea*, Butler & Associates, Birmingham, 1982.—98 p.

SOMA (J.T.), *Computer Technology and the Law*, Shepard's/McGraw-Hill, Colorado Springs.—486 p.

TROLLER (A.), *Immaterialgüterrecht: Patentrecht — Markenrecht — Muster- und Modellrecht — Urheberrecht — Wettbewerbsrecht* (3rd edition), Helbing & Lichtenhahn, Basel and Frankfurt, 1983.—540 p.

#### Selection of Recent Articles

ARMITAGE (E.), "Interpretation of European Patents (Art. 69 EPC and the Protocol on Interpretation)," IIC, International Review of Industrial Property and Copyright Law, 1983, vol. 14, no. 6, pp. 811-817.

ASAHINA (S.), "Notes for Foreigners Filing Japanese Patent Applications," Journal of the Japanese Group of AIPPI, International Edition, 1983, vol. 8, no. 2, pp. 53-64.

ASSARSSON (L.O.), "Observations on European Patent Practice in the Chemical Field with Particular Regard to Swedish Practice and Tradition," NIR, Nordiskt Immaterialt Rättsskydd, 1983, no. 3, pp. 327-367.

BARTELS (B.), "PCT: The Advantages for the Applicant in the United Kingdom," CIPA, 1983, vol. 13, no. 1, pp. 3-15.

BARTELS (B.), "The Advantages of the Patent Cooperation Treaty (PCT) for American Applicants," Journal of the Patent Office Society, 1983, vol. 65, no. 7, pp. 387-403.

BEIER (F.-K.), "One Hundred Years of International Cooperation: The Role of the Paris Convention in the Past, Present and Future," IIC, 1984, vol. 15, no. 1, pp. 1-20.

BERCOVITZ (A.), "Aspectos del proyecto de ley de patentes relevantes para la industria farmacéutica," Revista del derecho industrial, 1983, vol. 5, no. 14, pp. 275-295.

BORGGÅRD (G.), "Das schwedische Patentamt und die Zweite Revolution des Patentrechts," Gewerblicher Rechtsschutz und Urheberrecht, Internationaler Teil (GRUR Int.), 1983, no. 8, pp. 627-633.

BURST (J.-J.) & KOVAR (R.), "Droit de propriété industrielle et droit de la concurrence: d'utiles précisions données par la Cour de justice des Communautés européennes," Gazette du Palais, 1983, vol. 103, no. 292/293, pp. 2-9.

CABANELLAS, Jr. (G.), "Applicable Law under International Transfer of Technology Regulations," IIC, 1984, vol. 15, no. 1, pp. 39-67.

CALMUSCHI (O.), "La coopération entre les pays membres du CAEM dans le domaine de la propriété industrielle," Revue roumaine des sciences sociales: sciences juridiques, 1983, vol. 27, no. 2, pp. 127-132.

CAMPBELL (R.S.), "Patent Trends as a Technological Forecasting Tool," World Patent Information, 1983, vol. 5, no. 3, pp. 137-143.

CLERC (P.), "La contrefaçon commerciale en matière de marques et son impact sur le commerce international," Droit et affaires, 1983, no. 421, pp. 41-53.

COHEN JEHOAM (H.), "Protection of Industrial Designs between Copyright and Designs Laws: a Comparative Study," Copyright, 1983, vol. 19, no. 11, pp. 317-323.

CRESPI (R.S.), "Biotechnology and Patents: Outstanding Issues," European Intellectual Property Review, 1983, vol. 5, no. 8, pp. 201-205.

DIAMOND (S.A.), "Untangling the Confusion in Trademark Terminology," Trademark Reporter, 1983, vol. 73, no. 3, pp. 290-299.

FAUST (K.) & SCHEDL (H.), "International Patent Data: Their Utilization for the Analysis of Technological Developments," World Patent Information, 1983, vol. 5, no. 3, pp. 144-157.

HAERTEL (K.), "European Patent Convention—Munich Diplomatic Conference, Ten Years On," Official Journal of the European Patent Office, 1983, vol. 6, no. 9, pp. 361-371.

HAERTEL (K.), "The Harmonizing Effect of European Patent Law on National Patent Laws," IIC, 1983, vol. 14, no. 6, pp. 719-732.

KEDROVSKY (O.V.) & NEGULYAEV (G.A.), "Regional Cooperation of the CMEA Countries in the Patent Information Field," World Patent Information, 1983, vol. 5, no. 4, pp. 219-225.

KREYE (P.), "Intellectual Property Aspects of Plant Variety Genetic Engineering: View of a European Lawyer," Plant Variety Protection, 1983, no. 35, pp. 45-50.

LANDRY (J.-N.), "La protection des dessins et modèles par droit d'auteur ou dessin industriel au Canada," Revue canadienne du droit d'auteur, 1983, vol. 3, no. 2, pp. 29-57.

MARTIN (J.-P.), "L'interprétation des revendications de brevet et la sécurité des tiers," Gazette du Palais, 1984, no. 32/33, pp. 5-7.

MODIANO (G.), "Les contrats de transfert de technologie," Droit et pratique du commerce international, 1983, vol. 9, no. 3, pp. 553-591 (with English résumé).

MOSSINGHOFF (G.J.), "The Importance of Intellectual Property in International Trade," BNA's Patent, Trademark & Copyright Journal, 1983, vol. 26, no. 651, pp. 546-551.

NOTARO (A.), "Patents and Secret Prior User Rights: a Comparative View," Patent and Trademark Review, 1983, vol. 81, no. 9, pp. 347-364.

ODDI (A.S.), "Product Simulation and Contributory Trademark Infringement: A Right Suggests a Wrong," Arizona Law Review, 1983, vol. 25, no. 3, pp. 601-653.

PEROT-MOREL (M.-A.), "Les dessins et modèles entre la protection du droit d'auteur et de la propriété industrielle," Revue canadienne du droit d'auteur, 1983, vol. 3, no. 2, pp. 59-73.

PINGON (P. de) & DEPREZ (J.), "L'impôt sur les grandes fortunes et les droits de la propriété intellectuelle," Revue internationale de la propriété industrielle et artistique, 1983, no. 132/133, pp. 173-179.

REICHMAN (J.H.), "Design Protection in Domestic and Foreign Copyright Law: From the Berne Revision of 1948 to the Copyright Act of 1976," Duke Law Journal, 1983, no. 6, pp. 1143-1264.

REICHMAN (J.H.), "Design Protection after the Copyright Act of 1976: A Comparative View of the Emerging Interim Models," Journal of the Copyright Society of the U.S.A., 1984, vol. 31, no. 3, pp. 267-386.

SCHWARTZ (A.), "United States Trademark Use Requirements Revisited," BMM Bulletin, 1983, vol. 9, no. 1, pp. 62-76.

SCHWENDY (K.), "The Bundespatentgericht of the Federal Republic of Germany," European Intellectual Property Review, 1983, vol. 5, no. 9, pp. 243-249.

STAUDER (D.), "The Practical Significance of Infringement and Revocation Proceedings in the Federal Republic of Germany, France, Italy and the United Kingdom: Results of a Statistical and Empirical Study," IIC, 1983, vol. 14, no. 6, pp. 793-810.

SZWAJA (J.), "La protection de l'inventeur en droit polonois," Rivista di Diritto Industriale, 1983, vol. 32, no. 2, pp. 183-194.

TESCHEMACHER (R.), "Anmeldetag und Priorität im europäischen Patentrecht," GRUR Int., 1983, no. 9, pp. 695-702.

TSUR (Y.), "Registration of Designs in Israel," IIC, 1983, vol. 14, no. 4, pp. 508-514.

VISSERMAN (P.) & MORAN (J.C.), "Legal Protection of Computer Software," Patent and Trademark Review, 1983, vol. 81, no. 11, pp. 457-466.

WILLIAMS, Jr. (S.B.), "Intellectual Property Aspects of Plant Variety Genetic Engineering: View of an American Lawyer," *Plant Variety Protection*, 1983, no. 35, pp. 13-37.

WOOD (A.) & LLEWELYN (D.), "Merchandising and Trade Marks: Legality Reviewed," *European Intellectual Property Review*, 1983, vol. 5, no. 11, pp. 298-302.

**Selection of New WIPO Industrial Property Publications**

*100 Years of Industrial Property Statistics*, no. 876 (EF), September 1983 (Sw.fr. 90.-).

*The Role of Industrial Property in the Protection of Consumers*, no. 648 (EFS), October 1983 (Sw.fr. 25.-).

*WIPO Worldwide Forum on the Piracy of Broadcasts and the Printed Word*, no. 646 (EFS), October 1983 (Sw.fr. 20.-).

*Industrial Property Statistics for 1982, Publication B*, no. IP/STAT/1982/B (EF), January 1984 (Sw.fr. 75.-).

*Joint Inventive Activity Guide*, no. 650 (E), February 1984 (free of charge).

*Guide on the Industrial Property Activities of Enterprises in Developing Countries*, no. 649 (EFS), February 1984 (Sw.fr. 25.-).

*International Classification of Goods and Services for the Purposes of the Registration of Marks* (4th edition, bilingual), no. 500 (EF), April 1984 (Sw.fr. 110.-).

*UPOV: Important Texts and Documents: Part I* (Special Collection in Binders), no. 644 (FG), December 1983 (Sw.fr. 50.-); *Part II* (4 separate binders, trilingual), no. 645 (EFG), December 1983 (Sw.fr. 100.-).

## Calendar of Meetings

### WIPO Meetings

(Not all WIPO meetings are listed. Dates are subject to possible change.)

#### 1984

- October 8 to 10 (Doha) — Regional Group of Experts on Means of Implementation in Arab States of Model Provisions on Intellectual Property Aspects of Protection of Expressions of Folklore (convened jointly with Unesco)
- October 15 to 19 (Geneva) — Nice Union: Preparatory Working Group
- November 5 to 9 (Geneva) — Committee of Experts on Biotechnological Inventions
- November 19 to 23 (Geneva) — Permanent Committee on Patent Information (PCPI): Working Groups on Special Questions and on Planning
- November 26 to 30 (Paris) — Group of Experts on Copyright Problems Related to the Rental of Phonograms and Videograms (convened jointly with Unesco)
- November 26 to December 7 (Geneva) — Permanent Committee on Patent Information (PCPI): Working Group on Search Information
- December 10 to 14 (Paris) — Group of Experts on the Intellectual Property Aspects of the Protection of Folklore at the International Level (convened jointly with Unesco)
- December 17 (Geneva) — Informal Meeting with International Non-Governmental Organizations Essentially Concerned with Industrial Property
- December 17 (Geneva) — Informal Meeting with International Non-Governmental Organizations Essentially Concerned with Copyright and Neighboring Rights

#### 1985

- January 21 to 25 (Geneva) — International Patent Classification (IPC) Union: Committee of Experts
- February 4 to 8 (Geneva) — Permanent Committee for Development Cooperation Related to Copyright and Neighboring Rights
- February 25 to March 1 (Geneva) — Group of Experts on Copyright Protection of Computer Software (convened jointly with Unesco)
- March 11 to 15 (Geneva) — Permanent Committee on Patent Information (PCPI): Working Group on General Information
- March 18 to 22 (Paris) — Group of Experts on Copyright Problems in the Field of Direct Broadcasting Satellites (convened jointly with Unesco)
- April 22 to 26 (Paris) — Joint Unesco-WIPO Consultative Committee on the Access by Developing Countries to Works Protected by Copyright (convened jointly with Unesco)
- May 6 to 17 (Geneva) — Permanent Committee on Patent Information (PCPI): Working Group on Search Information
- June 6 to 14 (Geneva) — Permanent Committee on Patent Information (PCPI): Working Groups on Planning and on Special Questions
- June 17 to 25 (Paris) — Berne Union: Executive Committee (Extraordinary Session) (sitting together, for the discussion of certain items, with the Intergovernmental Committee of the Universal Copyright Convention)
- June 26 to 28 (Paris) — Rome Convention: Intergovernmental Committee (Ordinary Session) (convened jointly with ILO and Unesco)
- September 11 to 13 (Geneva) — Permanent Committee on Patent Information (PCPI): Working Group on Patent Information for Developing Countries
- September 16 to 20 (Geneva) — Permanent Committee on Patent Information (PCPI)
- September 23 to October 1 (Geneva) — Governing Bodies (WIPO General Assembly, Conference and Coordination Committee; Assemblies of the Paris, Madrid, Hague, Nice, Lisbon, Locarno, IPC, PCT, Budapest, TRT and Berne Unions; Conferences of Representatives of the Paris, Hague, Nice and Berne Unions; Executive Committees of the Paris and Berne Unions; Committee of Directors of the Madrid Union; Council of the Lisbon Union)
- October 7 to 11 (Geneva) — Permanent Committee on Patent Information (PCPI): Working Group on General Information
- November 18 to 22 (Geneva) — Permanent Committee on Patent Information (PCPI): Working Groups on Special Questions and on Planning
- November 25 to December 6 (Geneva) — Permanent Committee on Patent Information (PCPI): Working Group on Search Information

### UPOV Meetings

#### 1984

- October 8 to 11 (Valencia) — Technical Working Party for Fruit Crops, and Subgroups
- October 16 (Geneva) — Consultative Committee

October 17 to 19 (Geneva) — Council and Symposium  
November 6 and 7 (Geneva) — Technical Committee  
November 8 and 9 (Geneva) — Administrative and Legal Committee

## Other Meetings Concerned with Industrial Property

### 1984

Center for the International Study of Industrial Property — October 3 (Strasbourg) — “Demi-journée d'études sur la propriété industrielle et vingtième anniversaire du CEIPI;” December 3 to 7 (Strasbourg) — Seminar on the Drafting of European Patent Claims and Notices of Opposition  
European Patent Organisation — December 3 to 7 (Munich) — Administrative Council  
Pacific Industrial Property Association — November 7 to 9 (Sendai) — 15th International Congress  
Pharmaceutical Trade Marks Group — October 18 and 19 (Toulouse) — 29th Conference

### 1985

Center for the International Study of Industrial Property — January 28 to February 1 (Strasbourg) — Seminar on Legal Problems Concerning the European Patent Convention, the Paris Convention, the Patent Cooperation Treaty and the Community Patent Convention  
European Patent Organisation — June 10 to 14 and December 4 to 7 (Munich) — Administrative Council  
Hungarian Group of the International Association for the Protection of Industrial Property and the Hungarian Association for the Protection of Industrial Property — September 2 to 6 (Budapest) — Sixth International Conference on “New Technical Tendencies and Industrial Property Protection”  
International Association for the Protection of Industrial Property — May 13 to 19 (Rio de Janeiro) — Executive Committee  
International Federation of Industrial Property Attorneys — June 3 to 7 (Augsburg) — World Congress  
Japanese Government — April 18 and 19 (Tokyo) — Celebration and Symposium Commemorating the Centenary of the Japanese Industrial Property System

### 1986

International Association for the Protection of Industrial Property — June 8 to 13 (London) — XXXIII Congress

