

# Industrial Property

Monthly Review of the International Bureau  
for the Protection of Industrial Property  
Geneva

1<sup>st</sup> Year

No. 7

July 1962

---

## Contents

	Pages
<b>INTERNATIONAL UNION</b>	
France. Ratification of the Additional Act to the Arrangement of The Hague (of 25 <sup>th</sup> May, 1962) . . . . .	162
<b>LEGISLATION</b>	
Australia. Patents Act 1952-1960 (Part three) . . . . .	162
Italy. Decrees for the temporary protection of industrial property rights at twelve exhibitions (11 <sup>th</sup> , 12 <sup>th</sup> , 30 <sup>th</sup> April, 2 <sup>nd</sup> , 3 <sup>rd</sup> , 4 <sup>th</sup> , 5 <sup>th</sup> , 7 <sup>th</sup> , 8 <sup>th</sup> , 12 <sup>th</sup> and 25 <sup>th</sup> May, 1962)	169
<b>GENERAL STUDIES</b>	
Structural Evolution of the International Unions for the Protection of Intellectual Property (Professor Jacques Secretan) . . . . .	170
<b>CORRESPONDENCE</b>	
Letter from Argentina (B. Salomon) . . . . .	179
<b>CONGRESSES AND MEETINGS</b>	
Committee of Experts on Patents of the Council of Europe (Meeting of July, 1962)	183

# INTERNATIONAL UNION

## FRANCE

### Ratification of the Additional Act to the Arrangement of The Hague

(25<sup>th</sup> May, 1962)

We have received the following communication from the Federal Political Department:

"In a Note dated 25<sup>th</sup> April, 1962, the Legation of the Principality of Monaco has notified us that France has deposited its instrument of ratification in respect of the Additional Act to the Arrangement of The Hague concerning the International Deposit of Industrial Designs or Models of 6<sup>th</sup> November 1925, revised at London on 2<sup>nd</sup> June, 1934, and signed at Monaco on 18<sup>th</sup> November, 1961.

"We have the honour to inform you that we are today instructing our Diplomatic representatives to notify this deposit to the signatory Governments of the above-mentioned Additional Act".

# LEGISLATION

## AUSTRALIA

### Patents Act 1952-1960

(Part three)\*

#### *Extension on ground of war loss*

95. — (1) Where, by reason of hostilities between Her Majesty and a foreign state, a patentee as such has suffered loss or damage, including loss of opportunity of dealing in or developing his invention, the patentee may, after advertising, as prescribed, his intention to do so, apply to the High Court or to the Commissioner for the extension of the term of the patent.

(2) This section does not apply where the patentee:

(a) is a subject of the foreign state; or

(b) is a company:

(i) the business of which is managed or controlled by;  
or

(ii) which is carried on wholly or mainly for the benefit of,

subjects of the foreign state, notwithstanding that the company is registered in Australia or in some other part of the Queen's dominions.

(3) For the purposes of this section, account shall not be taken of loss or damage suffered by a person while he was a subject of the foreign state or by a company while its business was managed or controlled as specified in paragraph (b) of the last preceding sub-section.

(4) An application for the extension of a patent may be made under this section notwithstanding that the patent has previously been extended, or a new patent for the invention has previously been granted, on the ground of inadequate remuneration or, on one or more occasions, on the ground of loss or damage suffered by reason of hostilities between Her Majesty and a foreign state.

(5) An application under this section shall be made at least six months before the expiration of the term of the patent or at such later time as the High Court or the Commissioner, as the case may be, allows.

(6) An application to the High Court under this section shall be made as prescribed by Rules of Court and an application to the Commissioner shall be made as prescribed by the regulations.

(7) A person interested may:

(a) in the case of an application to the High Court — within such time and in such manner as are prescribed by Rules of Court; or

(b) in the case of an application to the Commissioner — within such time and in such manner as are prescribed by the regulations,

give notice of opposition to the granting of the application and shall serve a copy of the notice on the applicant.

(8) A person so giving notice is entitled to appear and be heard on the application.

(9) If the High Court finds that the patentee has suffered loss or damage by reason of hostilities between Her Majesty and the foreign state, the High Court may:

(a) order the extension of the term of the patent, subject to such restrictions, conditions and provisions (if any), for such further term as the Court thinks fit; or

(b) order the grant of a new patent for such term, and containing such restrictions, conditions and provisions (if any), as the Court thinks fit.

(10) If the Commissioner finds that the patentee has suffered loss or damage by reason of hostilities between Her Majesty and the foreign state, the Commissioner may:

(a) extend the term of the patent, subject to such restrictions, conditions and provisions (if any) as the Commissioner thinks fit, for such further term as the Commissioner thinks fit; or

(b) grant a new patent for such term, and containing such restrictions, conditions and provisions (if any), as the Commissioner thinks fit.

(11) The term granted on the application (whether by way of extension or grant of a new patent) shall not exceed ten years but where the term of the patent has previously been extended or a new patent for the invention has previously been granted, on the ground of loss or damage suffered by reason of hostilities between Her Majesty and a

\*) See *Industrial Property*, 1962, p. 112, 144.

foreign state, the aggregate of the terms (whether by way of extension or grant of a new patent) shall not exceed ten years.

(12) If the Commissioner considers that an application made to him under this section ought to be decided by the High Court, he may refer the application to the High Court and the High Court may decide the application as though it had been made to the High Court in the first instance.

(13) The patentee shall serve on the Commissioner an office copy of an order of the Court under this section and the Commissioner shall insert in the Register a reference to the order.

#### *Application by exclusive licensee*

96. — In this Part, a reference to a patentee includes a reference to an exclusive licensee.

### Part X. Restoration of Patents

#### *Application for restoration of patents which have ceased*

97. — (1) Where a patent has ceased by reason of failure to pay a prescribed fee within the prescribed time, the patentee may apply to the Commissioner for the restoration of the patent.

(2) The application shall contain a statement of the circumstances which led to the failure to pay the prescribed fee within the prescribed time, and if it appears from the statement that the failure was unintentional, and that no undue delay has occurred in the making of the application, the Commissioner shall advertise the application in the *Official Journal*.

(3) A person interested may, within such time as is prescribed, give notice to the Commissioner of opposition to the restoration and shall serve a copy of the notice on the patentee.

#### *Hearing of application and order thereon*

98. — (1) The Commissioner shall hear the case and either restore the patent (including any patent of addition on that patent) or dismiss the application.

(2) The Commissioner shall not restore the patent until all unpaid renewal fees have been paid.

(3) The Commissioner may, if he thinks fit, as a condition of restoring the patent, require that an entry shall be made in the Register in respect of a document or instrument in respect of which the provisions of this Act as to entries in the Register have not been complied with.

(4) Where a patent is restored under this section, such provisions as are prescribed have effect for the protection or compensation of persons who availed themselves, or took definite steps by contract or otherwise to avail themselves, of the subject-matter of the patent after the patent was notified in the *Official Journal* as having ceased and before the date of the first advertisement of the application.

(5) Proceedings shall not be taken in respect of an infringement of a patent committed between the date on which the patent ceased and the date of the restoration of the patent.

(6) An appeal lies to the Appeal Tribunal from a decision of the Commissioner under this section, and the Commissioner shall be entitled to appear and be heard, and shall appear if so directed by the Appeal Tribunal.

### Part XI. Revocation and Surrender of Patents

#### *Petition to revoke patent*

99. — The Attorney-General or any other person may present a petition to the High Court for the revocation of a patent.

#### *Grounds of revocation*

100. — (1) A patent may be revoked, either wholly or in so far as it relates to any claim of the complete specification, on one or more of the following grounds, but on no other ground:

- (a) that the applicant was not a person entitled to apply for the patent, so far as the invention is claimed in any claim;
- (b) that the patent, so far as the invention is claimed in any claim, was obtained in contravention of the rights of the petitioner or of some person under or through whom the petitioner claims;
- (c) that the complete specification does not comply with the requirements of section forty of this Act;
- (d) that the invention, so far as claimed in any claim, is not an invention within the meaning of this Act;
- (e) that the invention, so far as claimed in any claim, was obvious and did not involve an inventive step, having regard to what was known or used in Australia on or before the priority date of that claim;
- (f) that the invention, so far as claimed in any claim, is the subject of a valid claim of earlier priority date contained in the complete specification of another patent;
- (g) that the invention, so far as claimed in any claim, was not novel in Australia on the priority date of that claim;
- (h) that the invention, so far as claimed in any claim, is not useful;
- (i) that the patentee has contravened, or has not complied with, the conditions contained in the patent;
- (j) that the patent was obtained on a false suggestion or representation;
- (k) that the invention, so far as claimed in any claim, was secretly used in Australia, before the priority date of that claim; and
- (l) that leave to amend, or a direction to amend, the complete specification under Part VIII of this Act was obtained by fraud.

(2) For the purposes of paragraph (e) or (g) of the last preceding sub-section, account shall not be taken of any secret use.

(3) For the purposes of paragraph (k) of sub-section (1) of this section, account shall not be taken of any use of the invention, so far as claimed in any claim:

- (a) for the purposes of reasonable trial or experiment only; or

(b) by a department or authority of the Commonwealth, or of a State or Territory of the Commonwealth, or by a person authorized by such a department or authority, where the patentee, or a person from whom he derives his title, has communicated or disclosed the invention, so far as so claimed, to the department, authority or person.

(4) This section is subject to section one hundred and fifty-eight of this Act.

*Petition may be presented on basis that indicated priority date is incorrect*

101. — (1) The petitioner may, in his petition, specify a ground of invalidity by reference either to the priority date indicated in the relevant claim or by reference to a date which the petitioner alleges to be the priority date of that claim as determined by this Act.

(2) If the High Court finds that a date other than the date indicated in the claim (whether that other date is the date alleged in the petition or not) is the priority date of the claim as determined by this Act, the High Court shall, in deciding the case, treat the first-mentioned date as the priority date of the claim.

*Hearing of petition*

102. — The respondent is entitled to begin and give evidence in support of the patent, and, if the petitioner gives evidence disputing the validity of the patent, the respondent is entitled to reply.

*Powers of Court*

103. — The High Court may:

- (a) revoke the patent, and shall order the petitioner to serve on the Commissioner an office copy of the order for the revocation of the patent; or
- (b) if it is of opinion that a claim in the complete specification is invalid, revoke the patent in so far as it relates to that claim, and shall order the patentee to lodge at the Patent Office a disclaimer of the invalid claim.

*References to be made in Register*

104. — The Commissioner shall insert in the Register a reference to an order or disclaimer served on him or lodged at the Patent Office in pursuance of the last preceding section.

*Defences in action for infringement*

105. — Every ground on which a patent may be revoked is available as a ground of defence in an action for infringement of a patent, and, for the purposes of such a ground of defence in such an action, references in this Part to the petitioner and the respondent shall be read as references to the defendant and plaintiff, respectively.

*Surrender of patent*

106. — (1) A patentee may at any time, by giving notice to the Commissioner, offer to surrender his patent, and the Commissioner may, after giving notice of the offer and bearing all parties interested who desire to be heard, if he thinks fit, accept the offer, and shall thereupon revoke the patent.

(2) An appeal lies to the Appeal Tribunal from a decision of the Commissioner under the last preceding sub-section.

(3) Where an action for infringement, a proceeding for the revocation of a patent, or a proceeding in which the validity of a patent, or of a claim in the complete specification, is disputed, is pending in a court, the Commissioner shall not accept the offer for the surrender, or revoke the patent, except by leave of the court or by consent of the parties to the action or proceeding.

*Grant of patent where patent revoked*

107. — (1) Where a patent has been revoked, in so far as it relates to any claim of the complete specification, on the ground of fraud, or where a patent fraudulently obtained has been surrendered and revoked, the Commissioner may, on application made in accordance with the provisions of this Act, grant to the applicant a patent for the whole or a part of the invention in lieu of the patent so revoked.

(2) The priority date of each claim of the complete specification shall be such date as the Commissioner determines, having regard to the priority dates of the claims of the complete specification of the revoked patent.

(2A) An appeal lies to the Appeal Tribunal from a determination of the Commissioner under the last preceding sub-section.

(3) No action lies for an infringement of a patent granted under subsection (1) of this section which occurred before the sealing of the patent.

**Part XII. Working of Patents and Compulsory Licences**

*Compulsory licences*

108. — (1) A person interested may, after the expiration of three years from the date of sealing of a patent, present a petition to the Commissioner alleging that the reasonable requirements of the public with respect to the patented invention have not been satisfied, and praying for the grant of a compulsory licence.

(2) The Commissioner shall consider the petition, and, if the parties do not come to an arrangement among themselves and the Commissioner is satisfied that a *prima facie* case has been made out, he shall refer the petition to the High Court; if the Commissioner is not so satisfied he shall dismiss the petition.

(3) Where the Commissioner refers a petition to the High Court in pursuance of the last preceding sub-section, and the Court is satisfied that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the Court may order the patentee to grant licences on such terms as, subject to this Part, the Court thinks just.

(3A) In an order under the last preceding sub-section, the Court shall direct that the licence to be granted:

- (a) shall be a licence that does not confer on the licensee, or on the licensee and persons authorized by him the right to make, use, exercise and vend the patented invention to the exclusion of all other persons, including the patentee; and

(b) shall be a licence assignable only in connexion with an enterprise or goodwill in connexion with which the licence is used.

(4) On the hearing of a petition under this section:

(a) the patentee, and any person claiming an interest in the patent as exclusive licensee or otherwise, shall be made a party to the proceedings; and

(b) the Commissioner shall be entitled to appear and be heard.

(5) An order directing the grant of a licence operates, without prejudice to any other method of enforcement, as if it were embodied in a deed granting a licence executed by the patentee and all other necessary parties.

(6) The petitioner shall serve on the Commissioner an office copy of an order under this section directing the grant of a licence and the Commissioner shall insert in the Register a reference to the order.

#### *Revocation for non-working*

109. — (1) A person interested may, after the expiration of two years from the date of granting of the first compulsory licence, present a petition to the Commissioner alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied, and praying for the revocation of the patent.

(2) The Commissioner shall consider the petition, and, if the parties do not come to an arrangement among themselves and the Commissioner is satisfied that a *prima facie* case has been made out, he shall refer the petition to the High Court; if the Commissioner is not so satisfied he shall dismiss the petition.

(3) Where the Commissioner refers a petition to the High Court in pursuance of the last preceding sub-section, and the Court is satisfied that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the Court may (unless the patentee gives satisfactory reasons for his default) make an order revoking the patent.

(4) On the hearing of a petition under this section:

(a) the patentee, and any person claiming an interest in the patent as exclusive licensee or otherwise, shall be made a party to the proceedings; and

(b) the Commissioner shall be entitled to appear and be heard.

(5) The petitioner shall serve on the Commissioner an office copy of an order under this section revoking a patent and the Commissioner shall insert in the Register a reference to the order.

#### *Reasonable requirements of public deemed not to have been satisfied in certain circumstances*

110. — (1) For the purposes of the last two preceding sections, the reasonable requirements of the public shall be deemed not to have been satisfied:

(a) if, by reason of the default of the patentee:

(i) to manufacture to an adequate extent, and supply on reasonable terms, the patented article, or a part

of the patented article which is necessary for its efficient working;

(ii) to carry on the patented process to an adequate extent; or

(iii) to grant licences on reasonable terms, an existing trade or industry, or the establishment of a new trade or industry, in Australia is unfairly prejudiced, or the demand for the patented article, or the article produced by the patented process, is not reasonably met;

(b) if a trade or industry in Australia is unfairly prejudiced by the conditions attached by the patentee, whether before or after the commencement of this Act, to the purchase, hire or use of the patented article, or to the using or working of the patented process;

(c) if the patented invention, being an invention capable of being worked in Australia, is not being worked in Australia on a commercial scale and no satisfactory reason is given for the non-working; or

(d) if the working of the patented invention in Australia on a commercial scale is being hindered by the importation from abroad of the patented article by:

(i) the patentee or persons claiming under him;

(ii) by persons directly or indirectly purchasing from him; or

(iii) by other persons against whom the patentee is not taking, or has not taken, proceedings for infringement.

(2) Where, in any case to which paragraph (c) of the last preceding sub-section applies, the Court is satisfied that the time which has elapsed since the sealing of the patent has, by reason of the nature of the invention or for some other cause, been insufficient to enable the invention to be worked in Australia on a commercial scale, the Court may adjourn the further hearing of the petition for such period as appears to the Court to be sufficient for that purpose.

#### *Order not to be at variance with treaty*

111. — An order shall not be made under this Part which is at variance with a treaty, convention, arrangement or engagement between the Commonwealth and some other part of the Queen's dominions or between the Commonwealth and a foreign country.

#### *Avoidance of certain conditions attached to sale, etc., of patented articles*

112. — (1) It is not lawful, in a contract in relation to the sale or lease of, or a licence to use or work, a patented article or patented process, to insert a condition the effect of which would be:

(a) to prohibit or restrict the purchaser, lessee or licensee from using an article or class of articles or process, whether patented or not, supplied or owned by a person other than the seller, lessor or licensor, or his nominee; or

(b) to require the purchaser, lessee or licensee to acquire from the seller, lessor or licensor, or his nominee, an article or class of articles not protected by the patent, and any such condition is void.

(2) The last preceding sub-section does not apply if:

- (a) the seller, lessor or licensor proves that, at the time the contract was entered into, the purchaser, lessee or licensee had the option of purchasing the article or obtaining a lease or licence on reasonable terms without the condition; and
- (b) the contract entitles the purchaser, lessee or licensee to relieve himself of his liability to observe the condition on giving the other party three months' notice in writing, and on payment in compensation for that relief:
- (i) in the case of a purchase — of such sum; or
- (ii) in the case of a lease or licence — of such rent or royalty for the residue of the term of the contract, as is fixed by an arbitrator appointed by the Attorney-General.

(3) In an action, application or proceeding under this Act, a person is not estopped from applying for or obtaining relief by reason only of an admission made by him as to the reasonableness of the terms offered to him under paragraph (a) of the last preceding sub-section.

(4) A contract relating to the lease of, or licence to use or work, a patented article or patented process may at any time after the patent, or all the patents, by which the article or process was protected at the time of the making of the contract has, or have, ceased to be in force, and notwithstanding anything in the same or in any other contract to the contrary, be determined by either party on giving three months' notice in writing to the other party.

(5) The insertion by the patentee in a contract of a condition which, by virtue of this section, is void is available as a defence to an action for infringement of the patent to which the contract relates, brought while that contract is in force.

(6) If the patentee offers to the other parties to a contract in which any such condition is inserted a new contract from which the condition is omitted but under which the rights of the parties are otherwise identical, then, whether the other parties accept the new contract in lieu of the existing contract or not, the defence ceases to be available in respect of the contract, but the patentee is not entitled to recover damages, or to an account of profits, in respect of an infringement of the patent committed before the new contract has been so offered.

(7) Nothing in this section:

- (a) affects a condition in a contract by which a person is prohibited from selling goods other than those of a particular person;
- (b) validates a contract which, but for this section, would be invalid;
- (c) affects a right of determining a contract, or a condition in a contract, exercisable independently of this section; or
- (d) affects a condition in a contract for the lease of, or licence to use, a patented article, by which the lessor or licensor reserves to himself or his nominee the right to supply such new parts of the patented article as are required to put or keep it in repair.

### Part XIII. Infringement of Patents

#### *High Court to have jurisdiction in infringement actions*

113. — Jurisdiction is, by this section, conferred on the High Court to hear and determine an action or proceeding for the infringement of a patent, but this section does not deprive another court of jurisdiction which it possesses to hear and determine such an action or proceeding.

#### *Exclusive licensee may sue for infringement*

114. — (1) An exclusive licensee may bring an action or proceeding for the infringement of a patent.

(2) The patentee shall, unless he is joined as a plaintiff in the action or proceeding, be joined as a defendant.

(3) A patentee joined as a defendant is not liable for costs unless he enters an appearance and takes part in the proceedings.

#### *Defendant may counter-claim for revocation*

115. — A defendant in an action or proceeding for infringement of a patent may, without presenting a petition to the High Court under Part XI, apply by way of counter-claim in the action or proceeding for the revocation of the patent.

#### *Proceedings to be removed from State Courts to High Court where counter-claim for revocation*

116. — (1) Where a defendant, in an action or proceeding for the infringement of a patent in a court other than the High Court, applies by way of counter-claim for the revocation of the patent, the action or proceeding shall thereupon be removed into the High Court.

(2) The proceedings in the action or proceeding, and such documents (if any) relating to the action or proceeding as are filed as of record in the court in which the action or proceeding was commenced, shall be transmitted to the Registry of the High Court in the State or Territory of the Commonwealth in which the first-mentioned court is situated, or, if there is no such Registry, to the Principal Registry of the High Court.

(3) The provisions of sections forty-one, forty-three, forty-four and forty-six of the *Judiciary Act 1903-1950* apply in relation to an action or proceeding which is, or ought to be, removed into the High Court under this section.

#### *Procedure in action for infringement of patent*

117. — In an action or proceeding for infringement of a patent:

- (a) the plaintiff shall deliver with his statement of claim or declaration, or, by order of the court, Justice or Judge, at a subsequent time, particulars of the infringements complained of; and
- (b) the defendant shall deliver with his statement of defence or plea, or, by order of the court, Justice or Judge, at a subsequent time, particulars of the objections on which he relies.

#### *Relief in action for infringement of patent*

118. — (1) The relief which a court may grant in an action or proceeding for infringement of a patent includes an

injunction (subject to such terms, if any, as the court thinks fit) and, at the option of the plaintiff, either damages or an account of profits.

(2) The court, Justice or Judge may, on the application of either party, make such order for inspection, and impose such terms and give such directions with respect to the inspection, as the court, Justice or Judge thinks fit.

*Order revoking patent to be served on Commissioner*

119. — (1) Where, in an action or proceeding for the infringement of a patent, the court, on an application by the defendant by way of counter-claim —

- (a) revokes the patent — the court shall order the defendant to serve on the Commissioner an office copy of the order revoking the patent; or
- (b) revokes the patent in so far as it relates to an invalid claim — the court shall order the patentee to lodge at the Patent Office a disclaimer of the invalid claim.

(2) The Commissioner shall insert in the Register a reference to an order or disclaimer served on him or lodged at the Patent Office in pursuance of the last preceding sub-section.

*Declaration as to non-infringement*

120. — (1) A person who desires to use a process, or to make, use or sell an article, may, by action in the High Court against a patentee or exclusive licensee, claim a declaration that the use of the process, or the making, use or sale of the article, would not constitute an infringement of a claim of the specification of the patent, although no assertion to the contrary has been made by the patentee or licensee.

(2) The High Court has jurisdiction to hear and determine an action under the last preceding sub-section.

(3) The High Court shall not make a declaration sought in an action under sub-section (1) of this section unless —

- (a) the plaintiff —
  - (i) has applied in writing to the defendant for an admission in writing to the effect of the declaration sought;
  - (ii) has furnished the defendant with full particulars in writing of the process or article; and
  - (iii) has undertaken to pay a reasonable sum for the expenses of the defendant in obtaining advice in respect of the declaration sought; and
- (b) the defendant has refused or failed to make such an admission.

(4) The costs of all parties in proceedings for a declaration under this section shall, unless the High Court otherwise orders, be paid by the person seeking the declaration.

(5) The validity of a claim in the specification of a patent shall not be called in question in proceedings for a declaration under this section and the making of, or refusal to make, the declaration does not imply that the patent is valid.

(6) Proceedings for a declaration under this section may be taken at any time after the publication of the complete specification and references in this section to a patentee shall be read as including a reference to an applicant whose complete specification has been published.

*Groundless threats of legal proceedings*

121. — (1) Where a person, by means of circulars, advertisements or otherwise, threatens a person with an action or proceeding for infringement of a patent, or some other like proceeding, then, whether the person making the threats is or is not entitled to or interested in a patent, or is or is not interested in an application for a patent, a person aggrieved may bring an action against the first-mentioned person and may obtain a declaration to the effect that the threats are unjustifiable, and an injunction against the continuance of the threats, and may recover such damages (if any) as he has sustained, unless the first-mentioned person satisfies the court that the acts in respect of which the proceedings were threatened constitute, or, if done, would constitute:

- (a) an infringement of a patent in respect of a claim in the specification which is not shown by the plaintiff to be invalid; or
- (b) an infringement of rights arising from the publication of the complete specification in respect of a claim in the specification which is not shown to be one which would be invalid if a patent had been granted in respect of the complete specification.

(2) The mere notification of the existence of a patent does not constitute a threat of proceedings within the meaning of this section.

(3) Nothing in this section renders a legal practitioner or a patent attorney liable to an action under this section in respect of an act done by him in his professional capacity on behalf of a client.

(4) Jurisdiction is, by this section, conferred on the High Court to hear and determine an action under this section, but this section does not deprive any other court of any jurisdiction which it possesses to hear and determine such an action.

*Counter-claim by defendant for infringement*

122. — (1) The defendant in an action under the last preceding section may apply, by way of counter-claim, for relief to which he would be entitled in a separate action in respect of an infringement, by the plaintiff, of the patent to which the threats relate and in any such case the provisions of this Act with respect to an action for infringement of a patent are, *mutatis mutandis*, applicable in relation to the action.

(2) Where the defendant applies by way of counter-claim for relief in respect of such an infringement, the plaintiff may, without presenting a petition to the High Court under Part XI, apply in the action for the revocation of the patent, and in any such case the provisions of section one hundred and sixteen of this Act and the provisions of this Act with respect to a petition for the revocation of a patent are, *mutatis mutandis*, applicable in relation to the action.

*Special provisions as to vessels, aircraft and land vehicles*

123. — (1) Subject to this section, the rights of the patentee are not infringed:

- (a) by the use on board a foreign vessel of the patented invention in the body of the vessel or in the machinery, tackle, apparatus or other accessories of the vessel, if the

vessel comes into waters within the territorial limits of Australia temporarily or accidentally only and the invention is used exclusively for the needs of the vessel; or

- (b) by the use of the patented invention in the construction or working of a foreign aircraft or land vehicle, or in the accessories of such an aircraft or vehicle, if the aircraft or vehicle comes into Australia temporarily or accidentally only.

(2) In this section:

- (a) "foreign vessel" and "foreign aircraft" mean a vessel or aircraft registered in a country with respect to which there is in force for the time being a Proclamation declaring that the laws of that country confer corresponding rights with respect to vessels, aircraft and land vehicles of Australia<sup>8</sup>); and
- (b) "foreign land vehicle" means a land vehicle owned by a person ordinarily resident in such a country.

#### *Exemption of innocent infringer from liability for damages*

124. — (1) A court may refuse to award damages, or to make an order for an account of profits, in respect of an infringement of a patent committed after the date of commencement of this Act from a defendant who satisfies the court that, at the date of the infringement, he was not aware, and had no reason to believe, that a patent for the invention existed.

(2) If articles manufactured according to a patented invention and marked in such a manner as to indicate that the articles are patented in Australia have been sold or used in Australia to a substantial extent, the defendant shall be deemed, unless the contrary is proved, to have been aware of the existence of the patent.

(3) Nothing in this section affects the power of a court to grant relief by way of an injunction.

### Part XIV. The Crown

#### *Use of inventions for services of the Commonwealth or a State*

125. — (1) At any time after an application for a patent has been lodged at the Patent Office or a patent has been granted, the Commonwealth or a State, or a person authorized in writing by the Commonwealth or a State, may make, use, exercise or vend the invention for the services of the Commonwealth or State.

(2) Where a patented invention was, before the priority date of the relevant claim of the complete specification, recorded in a document by, or tested by or on behalf of, the Commonwealth or a State, otherwise than in consequence of the communication of the invention directly or indirectly by the patentee or by a person from whom he derives title, no remuneration is payable to the patentee in respect of the use

of the invention by the Commonwealth or the State, as the case may be, under the last preceding sub-section.

(3) Authority may be given under sub-section (1) of this section either before or after a patent for the invention has been granted, and either before or after the acts in respect of which the authority is given have been done, and may be given to a person notwithstanding that he is authorized directly or indirectly by the applicant or patentee to make, use, exercise or vend the invention.

(4) Where an invention has been made, used, exercised or vended under sub-section (1) of this section, the Commonwealth or State shall, unless it appears to the Commonwealth or State that it would be contrary to the public interest to do so, inform the applicant or patentee as soon as possible of the fact and shall furnish him with such information as to the making, use, exercise or vending of the invention as he from time to time reasonably requires.

(5) Subject to sub-section (2) of this section, where a patented invention is made, used, exercised or vended under sub-section (1) of this section, the terms for the making, use, exercise or vending of the invention are such terms as are, whether before or after the making, use, exercise or vending of the invention, agreed upon between the Commonwealth or the State and the patentee or, in default of agreement, as are fixed by the High Court.

(6) The High Court may, in fixing those terms, take into consideration compensation which a person interested in the invention or patent has received, directly or indirectly, from the Commonwealth or State in respect of the invention or patent.

(7) An agreement or licence (whether made or given before or after the commencement of this Act) fixing the terms upon which a person other than the Commonwealth or a State may make, use, exercise or vend an invention is inoperative with respect to the making, using, exercising or vending of the invention, after the commencement of this Act, under subsection (1) of this section, unless the agreement has been approved by the Attorney-General of the Commonwealth or of the State.

(8) No action for infringement lies in respect of the making, use, exercise or vending of a patented invention under sub-section (1) of this section.

(9) The right to make, use, exercise and vend an invention under sub-section (1) of this section includes the right to sell goods which have been made in exercise of that right and a purchaser of goods so sold, and a person claiming through him, is entitled to deal with the goods as if the Commonwealth or State were the patentee of the invention.

(10) Where the Government of the Commonwealth has made an agreement or arrangement with the Government of some other country for the supply to that country of goods required for the defence of that country

(a) the use of an invention by the Commonwealth, or by a person authorized in writing by the Commonwealth, for the supply of those goods shall, for the purposes of this Part, be deemed to be use of the invention by the Commonwealth for the purposes of the Commonwealth;

<sup>8</sup> The Governor-General, by Proclamations dated 20<sup>th</sup> April, 1954 and 24<sup>th</sup> July, 1958, declared that the laws of certain specified countries confer corresponding rights with respect to vessels, aircraft and land vehicles of Australia. See *Commonwealth Gazette* 1954, p. 1237, and Vol. V of Commonwealth Statutory Rules 1901-1956, p. 5466; and *Commonwealth Gazette* 1958, p. 2691, and Commonwealth Statutory Rules 1958, p. 530.

- (b) the Commonwealth or that person may sell those goods to that country in pursuance of the agreement or arrangement; and
- (c) the Commonwealth or that person may sell to any person such of those goods as are not required for the purpose for which they were made.

*Declaration may be sought as to use of patented invention*

126. — (1) A patentee who considers that a patented invention has been made, used, exercised or vended under sub-section (1) of the last preceding section may apply to the High Court for a declaration accordingly.

(2) In a proceeding under the last preceding sub-section:

- (a) the Commonwealth or the State concerned, as the case may be, shall be the defendant; and
- (b) the Commonwealth or State may, by way of counterclaim in the proceeding, apply for the revocation of the patent, in which case the provisions of this Act with respect to the revocation of patents apply, *mutatis mutandis*, in relation to the counter-claim.

*Exclusive licensees*

127. — In the last two preceding sections, references to a patentee include references to an exclusive licensee under the patent.

*Forfeited articles*

128. — Nothing in this Part affects the right of the Commonwealth or of a State, or a person deriving title directly or indirectly from the Commonwealth or a State, to sell or use an article forfeited under a law of the Commonwealth or the State.

*Acquisition of inventions and patents by the Commonwealth*

129. — (1) The Governor-General may direct that an invention the subject of an application for the grant of a patent, or a patent, shall be acquired by the Attorney-General from the applicant or patentee and thereupon the invention or patent, and all rights in respect of the invention or patent, are, by force of this section, transferred to and vested in the Attorney-General in trust for the Commonwealth.

(2) Notice of the acquisition shall be given to the applicant or patentee and be published in the *Official Journal* and the *Gazette* unless, in the case of the acquisition of an invention the subject of an application for a patent, an order is in force under section one hundred and thirty-one of this Act in relation to the application.

(3) The Commonwealth shall pay to the applicant or patentee, and, in the case of the acquisition of a patent, to all other persons appearing in the Register as having an interest in the patent, such compensation as is agreed upon between the Commonwealth and the applicant, patentee or other persons, as the case may be, or as, in default of agreement, is determined by the High Court in an action for compensation against the Commonwealth.

(To be continued)

(Translation)

ITALY

Decrees

concerning the temporary protection of industrial property rights at twelve exhibitions

(of 11, 12, 30 April, 2, 3, 4, 5, 7 and 8 May, 1962) <sup>1)</sup>

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

X<sup>a</sup> *Mostra nazionale di elettrodomestici* (Milan, 5-12 September, 1962);

XXVIII<sup>a</sup> *Mostra nazionale della radio e televisione* (Milan, 5-12 September, 1962);

XX<sup>a</sup> *Fiera di Ancona — Mostra mercato internazionale della pesca, degli sports nautici e attività affini* (Ancône, 23 June-18 July, 1962);

XXVI<sup>a</sup> *Fiera del Levante — campionaria internazionale* (Bari, 9-24 September, 1962);

*Salone internazionale della ceramica* and

*Mostra nazionale dell'argenteria e oreficeria*, and

*Mostra nazionale biennale del marmo* (Vicenza, 6-16 September, 1962);

*Settimana della calzatura e del cuoio — XXVI<sup>o</sup> Salone internazionale* (Vigevano, 15-23 September, 1962);

XVII<sup>a</sup> *Mostra internazionale delle conserve alimentari e dei relativi imballaggi — Salone internazionale per le attrezzature delle industrie alimentari* (Parma, 20-30 September, 1962);

XII<sup>o</sup> *Salone internazionale della tecnica* (Turin, 22 September, 1962);

XLIV<sup>o</sup> *Salone internazionale dell'automobile* (Turin, 31 October-11 November, 1962);

*Biennale italiana della macchina utensile* (Milan, 6-15 October, 1962)

shall enjoy the temporary protection provided by laws No. 1127 of 29<sup>th</sup> June, 1939<sup>2)</sup>, No. 1411 of 25<sup>th</sup> August, 1940<sup>3)</sup>, No. 929 of 21<sup>st</sup> June, 1942<sup>4)</sup>, and No. 514 of 1<sup>st</sup> July, 1959<sup>5)</sup>.

<sup>1)</sup> Official communications from the Italian Administration.

<sup>2)</sup> See *Prop. ind.*, 1939, p. 124; 1940, p. 84.

<sup>3)</sup> *Ibid.*, 1940, p. 196.

<sup>4)</sup> *Ibid.*, 1942, p. 168.

<sup>5)</sup> *Ibid.*, 1960, p. 23.

# GENERAL STUDIES

(Translation)

## Structural Evolution of the International Unions for the Protection of Intellectual Property <sup>1)</sup>

Jacques SECRETAN

Avocat honoraire,

Emeritus Professor of the University of Lausanne,  
Member of the International Diplomatic Academy,  
Director of the United International Bureaux for the Protection  
of Industrial, Literary and Artistic Property

### I

#### The traditional structure of the International Unions for the Protection of Intellectual Property

1. — The structure of the International Unions for the Protection of Intellectual Property and their joint International Bureau is at present undergoing a basic transformation.

The first factor which strikes the observer is the "antiquity" of the structure of the Unions and their International Bureau. This is clearly expressed in the following observations by Professor Robert Plaisant:

"The Bureau is no longer a surprise. When it was first established, it represented something novel, because international organisations did not then exist. It was established in order to meet certain well-defined requirements and not because of general concepts relating to the operating of an international society.

After seventy-five years it retains its originality but from another viewpoint. It no longer surprises by its existence but rather because it appears, however active it may be, as an institution of the past..."

2. — When internationalists write the history of intergovernmental organisations <sup>2)</sup>, they usually distinguish three periods:

(a) Before the First World War, the type of "Dependent Unions" first appeared which, with the exception of the International River Commissions, lacked representative bodies of the Member States, were not empowered to take steps against Members who did not respect their conventional obligations and whose management was entrusted to one State Member.

(b) After the First World War, with the League of Nations and the International Labour Office and, in particular after the Second World War with the establishment of the United Nations and their Specialised Agencies, the type of "Independent Unions" or intergovernmental organisations appeared which were autonomous and had general competence to take, within limits and according to procedures laid

down by treaties, all necessary initiative to meet the requirements of an international society in their respective fields. Moreover, these intergovernmental organisations are endowed with bodies competent to take all necessary initiative on behalf of the organisation itself and to bind the States Members.

(c) Finally and more recently, "supra-national" organisations have made their appearance, symbolised by the European Communities which exercise powers which have hitherto never been conceded to international organisations; such powers are moreover characterised by the immediate action of the community which may affect persons directly i.e., without having to pass via the intermediary of any national procedure.

Now, if this evolution has taken place in a relatively short period of time, it has been such that the type of "dependent Unions" which symbolise the past, have been obliged to transform their structure completely as is the case with the Universal Postal Union and the International Telecommunications Union, when such organisations have not been purely and simply absorbed by new organisations.

The reason for this change in the structure of international institutions is obvious. In a world in which international technical cooperation is being increasingly strengthened and in which it is inconceivable for example that the struggle against epidemics be limited by frontiers, former institutions of international cooperation tend to become real and effective supra-national public services among which those purely static international administrations, lacking the means of taking direct action, no longer find their place.

Hence the present tendency to strengthen the important international ministries which are the United Nations' Specialised Agencies (Ministry of Health or World Health Organisation, Ministry of Labour or International Labour Organisation, Ministry of Education or UNESCO, etc.), and to do away with such Unions which formerly exercised certain powers in the fields now covered by these specialised agencies.

3. — After the Second World War it was discussed whether the International Bureau for the Protection of Industrial Property, known as the Paris Union and the International Bureau for the Protection of Literary and Artistic Works, known as the Berne Union, should be absorbed by other international organisations.

In fact, on the 29<sup>th</sup> August, 1948, the Economic and Social Council adopted the following Resolution 171 (VII):

"The Economic and Social Council,

Believing that the establishment of the United Nations and of the Specialised Agencies having wide responsibilities in the economic, social, cultural, educational, health and related fields makes desirable re-examination by Member Governments of possible duplication or dispersion of effort between these organisations and other existing intergovernmental organisations...

Recommends that Member States and the specialised agencies submit by the 1<sup>st</sup> February, 1949, their views regarding:

- (1) the possible termination, absorption or integration of any of these organisations into the United Nations or the specialised agencies;
- (2) relationships which might be established between any of the listed organisations and the United Nations or the specialised agencies..."

<sup>1)</sup> The author wishes to express here his thanks to M. Richard Wipf, First Secretary at the United International Bureaux for the Protection of Industrial, Literary and Artistic Property, Assistant Head of the Legal Division, for his valuable contribution to this study.

<sup>2)</sup> See Jacques Secretan, "Nations Unies ou Fédéralisme?", reprinted from Sirey, 1958.

In the list of organisations susceptible of a "possible termination" were the Bureaux of the Unions of Paris and Berne<sup>3</sup>).

If finally the United International Bureaux for the Protection of Industrial, Literary and Artistic Property survived this crisis, it is because the international ministry which was to absorb the Bureaux i. e. the International Trade Organisation, was never finally established<sup>4</sup>).

These circumstances enabled the United International Bureaux for the Protection of Industrial, Literary and Artistic Property once more to take an active part between the International Ministry of Culture (UNESCO) and the International Ministry of Labour (ILO); the United International Bureaux were naturally called upon to play the role of Ministry of Intellectual Property as was pointed out by Professor Robert Plaisant:

"Perforce, the Bureau of the Union finds itself in the centre of a domain over which it alone can exercise a certain unifying influence. Documentation in itself and for itself is of no avail. Documentation must concern itself with people as well as texts. To be of any effective use it must be accompanied by information, discussions and persuasion. From then on, the Bureau abandons its work as a mere repository of archives and enters the path of diplomacy."

4. — Since 1883 — when the Union of Paris was founded — and 1886 — when the Berne Union was first set up — the International Unions for the Protection of Industrial, Literary and Artistic Property possessed the following organs:

- (1) *An International Bureau charged with*
  - (i) centralising information relating to the Unions and communicating it to the States, making studies of general utility and publishing periodical reviews concerning the Unions;
  - (ii) establishing annual management reports and communicating them to the countries of the Union;
  - (iii) assisting the Administrations of those countries responsible for organising conferences of revision; and
  - (iv) finally, holding itself at all times at the disposal of the countries of the Unions in order to supply them with any special information they may need<sup>5</sup>).

Furthermore, this Bureau is responsible under the terms of separate Arrangements for certain other administrative tasks: the international registration of trade marks, the deposit of industrial designs or models, the registration of appellations of origin, etc.

(2) *A High Authority*, the Government of the Swiss Confederation, responsible for

- (i) regulating the organisation and supervising the working of the Bureau;
- (ii) superintending the expenses of the Bureau and making the advances of necessary funds and for rendering an

<sup>3</sup> United Nations Organisation, Economic and Social Council, Document E/818, 11<sup>th</sup> June, 1948, VII<sup>th</sup> Session, pp. 11 and 29.

<sup>4</sup> See Resolution 262 (IX) of the Economic and Social Council of 10<sup>th</sup> August, 1949, and point 44 of United Nations document E/1687.

<sup>5</sup> See International Union for the Protection of Literary and Artistic Works, Convention of Berne, revised at Brussels on 26<sup>th</sup> June, 1948, and the International Union for the Protection of Industrial Property, Convention of Paris, revised at Lisbon on 31<sup>st</sup> October, 1958.

annual account which is communicated to all the Administrations of the Unionist countries; and

- (iii) finally, for receiving from the States and for communicating to them all declarations regarding the application of the conventions (adhesions, denunciations, extension to dependent territories, entry into force of a convention, etc.

(3) *Periodical Diplomatic Conferences of Revision* charged with the revision of Conventions with a view to the introduction of amendments calculated to improve the system of the Union and to fix the ceiling of the expenditure of the International Bureau.

(4) Finally, in the interval between the Diplomatic Conferences of Revision, the Paris Union has recently instituted Conferences of Representatives of all the countries of the Union which are scheduled to meet every three years to draw up a report on the foreseeable expenditure of the International Bureau for the next three-yearly period and to consider questions relating to the protection and development of the Union.

Furthermore, they may modify, by unanimous decision, the maximum annual amount of the expenditure of the International Bureau, provided they meet as a Conference of Plenipotentiaries of all the countries of the Union, convened by the Government of the Swiss Confederation.

Moreover, the above-mentioned Conferences may be convened between their three-yearly meetings by either the Director of the International Bureau or the Government of the Swiss Confederation<sup>6</sup>).

(5) Since the Diplomatic Conference which revised the Berne Convention in Brussels in 1948, the International Union for the Protection of Literary and Artistic Works possesses a *Permanent Committee* composed of representatives of twelve States. This Committee is exclusively responsible for

"assisting the Bureau of the Union in fulfilling the task entrusted to it under the terms of Article 24, para. (2) of the Convention signed at Brussels on 26<sup>th</sup> June, 1948",

that is to say, to assist the Bureau in its task of preparing, with the Administration of the State in which the Conference of Revision is scheduled to take place, the programme of the Conference.

Anxious to hasten the development already begun, the Diplomatic Conference held in Lisbon from 6<sup>th</sup> to 31<sup>st</sup> October, 1958, by the International Union for the Protection of Industrial Property for the revision of the text of the Convention, decided by means of a Resolution:

"That every three years, at the invitation of the Government of the Swiss Confederation, a Consultative Committee composed of representatives of all the countries of the Union shall meet and draw up a report on the foreseeable expenditure of the Bureau for the next three-yearly period.

Further, the Consultative Committee may be convened between such three-yearly meetings on the initiative either of the Director of the International Bureau or of the Government of the Swiss Confederation."

<sup>6</sup> International Union for the Protection of Industrial Property. Convention revised at Lisbon on 31<sup>st</sup> October, 1958.

5. — The technical evolution of the modern world is continuously accelerating. To be convinced of this, one only needs to consider the important developments in processes available to those works protected by the Berne Convention: records, magnetic tape recorders, radio-telephony, television, etc. The appearance of new technical methods give rise to new problems. For example, the protection of the rights of performers, producers of phonograms and broadcasting organisations has recently been the subject of an International Convention signed in Rome in October, 1961, and the protection of new plant products has also given rise to another Convention, signed in Paris, in December, 1961.

6. — The International Unions for the Protection of Intellectual Property at present do not have at their disposal competent organs with sufficient powers to order the examination of such problems with their necessary costly studies or to bind the States Members financially or suggest solutions to them.

The consequences of this state of affairs are obvious. In a work recently published<sup>7)</sup> we have pointed out that such a situation gives rise to at least two serious dangers.

“The first danger is that a dispersion of intellectual property ... might well bring about the disintegration of the basic principles on which are established both the Conventions of Paris and Berne.

Another danger exists: in view of the general and perfectly understandable desire to see the field of intellectual property put more in order, such a re-organisation might well be undertaken elsewhere by international institutions having other functions and protecting different interests.”

## II

### International Economic and Social Cooperation

1. — Articles 55 to 60 of the United Nations Charter deal with “international economic and social cooperation”.

In pursuance of Article 55 of the Charter, the Organisation may deal with questions relating to the promotion of “higher standards of living, full employment and conditions of economic and social progress and development; solutions of international economic, social, health and related problems; and international cultural and educational cooperation”.

As will be seen, this power, recognised by more than 100 States, of which a large proportion are Member States of the International Unions for the Protection of Intellectual Property, is applicable to those fields covered by the Conventions of these Unions.

2. — The Economic and Social Council has been set up in order to exercise this competence. Its composition, functions and powers and the procedure which it must adopt are set out in Articles 61 to 72 of the Charter of the United Nations.

In accordance with Article 62 of the Charter, it “may make or initiate studies and reports with respect to international economic, social, cultural, educational, health and related matters”; in these fields it may “prepare draft conventions for submissions to the General Assembly” (of the Organisation) and “may call . . . international conferences on matters falling within its competence”.

<sup>7)</sup> Jacques Secretan, “*Vers l'organisation internationale de la propriété industrielle*”, in *Mélanges Marcel Plaisant*, published by Sirey, Paris 1960, pp. 175-176.

Finally, under Article 63 of the Charter, the Economic and Social Council “may coordinate the activities of the specialised agencies through consultation with and recommendations to such agencies and through recommendations to the General Assembly and to Members of the United Nations”.

3. — The Economic and Social Council is, by reason of the powers ceded to it, the indispensable coordinating body with regard to international relations.

In this field its action is threefold.

(a) On the one hand, the Council may prepare draft international conventions and set up new intergovernmental organisations in respect of those fields in which conventions or organisations do not exist.

Thus it was that the Council convened a meeting in Havana from 21<sup>st</sup> November, 1947, to 24<sup>th</sup> March, 1948, namely the “International Conference on Trade and Employment”, which resulted in the creation of “the Interim Commission for the International Trade Organization” (ICITO), whose field of action is of particular interest to the Union of Paris since it covers the expansion of world economy and the development of industry and production (patents) as well as the exchange and consumption of goods (trade marks).

It also initiated the recently created “International Olive Oil Council”, charged with the development of the production, trade and consumption of olive oil, which is of direct interest to the Union of Paris and the separate Union of Lisbon for the Protection of Appellations of Origin.

(b) On the other hand, the Council may seek and propose to the States the appropriate means for remedying any possible over-lapping or dispersion of effort among the different intergovernmental organisations in the fields enumerated in Article 62 of the Charter. It is within the framework of this power that it adopted, in 1948, the Resolution already mentioned under point I which aimed at a considerable reduction in the number of intergovernmental organisations.

(c) Finally, the Economic and Social Council may “coordinate the activities of the specialised agencies”<sup>8)</sup> through

<sup>8)</sup> Article 57 of the Charter defines specialised agencies as intergovernmental organisations “established by intergovernmental agreement and having wide international responsibilities, as defined in their basic instruments, in economic, social, cultural, educational, health and related fields”;

in compliance with Article 63 of the Charter, “the Economic and Social Council may enter into agreement with any of the agencies referred to in Article 57, defining the terms on which the agency concerned shall be brought into relationship with the United Nations”;

and by virtue of Article 57, para. 2 of the Charter, “such agencies thus brought into relationship with the United Nations are hereinafter referred to as specialised agencies”;

there should not be confusion between the “organs of the United Nations” such as the Economic and Social Council, the International Court of Justice, the Permanent Central Committee for Opium or the Economic Commission for Europe, for instance, and the “specialised agencies” such as the International Labour Organisation, UNESCO, World Health Organisation, Universal Postal Union, or International Telecommunications Union for example. Whereas the “organs of the United Nations” are strictly dependent on the United Nations Organisation, the “specialised agencies” are independent organisations, often older than the United Nations or even the League of Nations and whose relationships with the United Nations or other intergovernmental organisations are governed by contractual agreements establishing mutual recognition, cooperation and reciprocal representation; these agreements

consultation with and by means of recommendations to them and through recommendations to the General Assembly and to the Members of the United Nations i. e. to the States (Art. 63 of the Charter).

4. — We have pointed out above that the traditional structure of the International Unions for the Protection of Intellectual Property present at least two main dangers: the first, that the dispersion of texts protecting intellectual property might well lead to a disintegration of the principles on which the Unions are based, and the second, that new conventions providing for the protection of intellectual property might be initiated within the framework of other international organisations representing other fields of activities and protecting different interests from those traditionally connected with such property.

The protection of intellectual property concerns both the conditions governing creations of the mind and the general interests of individuals and peoples and also the economic system. Articles 22 and 27 of the Universal Declaration of Human Rights recognises for everyone the right to "economic, social and cultural rights indispensable for the dignity and the free development of his personality" and to the "protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author". Thus the objective sought by the authors of the International Unions for the Protection of Intellectual Property has been formally recognised by the United Nations and the competence of the Economic and Social Council is thereby established.

It is obvious that, if the legal principles which are at the bases of the International Unions for the Protection of Intellectual Property are to triumph, the competence of these Unions should not only be recognised by the intergovernmental organisations concerned but also by the Economic and Social Council of the United Nations, because of its own competence in this field and also because one of its tasks is to coordinate international activities.

It would be appropriate therefore to re-examine the Agreements concluded by the United International Bureaux for the Protection of Industrial, Literary and Artistic Property with UNESCO, ICITO, WHO, the Council of Europe, the Organisation of American States, the International Patent Institute and the International Olive Oil Council and to complete these Agreements by a general Accord with the Economic and Social Council of the United Nations.

It will not be sufficient to affirm the exclusive competence of the Unions so long as these are not represented in regard to the States and the other international organisations by their own organs<sup>9)</sup>.

have no other object than to provide for the indispensable coordination of the activities of intergovernmental organisations and do not entail any subordination of such organisations to the United Nations Organisation.

<sup>9)</sup> An Agreement can only be concluded with the Economic and Social Council by an "agency" set up by an intergovernmental agreement, whereas neither the Convention of Paris, the Convention of Berne or even the United International Bureaux are "agencies". In order that their exclusive competence be recognised in the industrial property and copyright fields, each Union must become an "agency", i. e. a generally recognised juridical and international body, possessing organs fully re-

### III

#### Recent Evolution of the International Unions for the Protection of Intellectual Property

##### *A. International Union for the Protection of Industrial Property*

1. — The proposals of the Director of the International Bureau to the Diplomatic Conference of Lisbon which, in 1958, revised the Convention of Paris, tended towards the above mentioned principles.

The Director of the International Bureau in fact suggested that, apart from the Conference of Revision whose task was to make amendments where necessary to the provisions of substantive law in the Convention, a periodical Conference composed of representatives of all the States of the Union should meet periodically in order to examine all administrative and financial questions; special tasks of the Conference were to be:

- (a) to appoint of a restricted Council;
- (b) to seek an Agreement with the Berne Union with a view to setting up a single Statute for the United International Bureaux;
- (c) to instruct the restricted Council as to the means of seeking an Agreement with the Economic and Social Council, including any other instructions on questions relating to the operation of the Union.

2. — It may be of interest to recall here that this problem of the protection and representation of interests protected under the Union Convention was raised in similar circumstances within the framework of all the other international organisations. Generally speaking, all the other international organisations have provided for a Conference composed of representatives of all the States Members whose task is to examine all questions relating to such organisations; moreover, those international organisations which have a large number of Member States have also set up a restricted Council alongside the Conference emerging from the said Conference and able to meet more often and more easily than the general Conference itself. Thus, the Universal Postal Union, the World Meteorological Organisation, the International Labour Organisation, the World Health Organisation, the International Telecommunications Union, the United Nations Educational, Scientific and Cultural Organisation (UNESCO), the United Nations Food and Agricultural Organisation (FAO), the International Civil Aviation Organisation (ICAO), the International Monetary Fund, the International Bank for Reconstruction and Development, the Council of Europe, the Central Office for International Railway Transport, the International Institute for the Unification of Private Law, the International Bureau of Weights and Measures, and the International Institute of Refrigeration have, for example, set up General Assemblies (called Assemblies, Councils, Conferences, etc.) and a Council or restricted Committee; on the other hand the International Patent Institute, the International Exhibition Bureau and the Inter-

representative of the States and a Secretariat; such transformation must be effected by means of an intergovernmental agreement.

national Vine and Wine Office which group a smaller number of States have only one representative body which groups all the States Members and holds all the powers which in other organisations are shared by the Assembly and the restricted Council.

As will be seen, the Director of the United International Bureaux proposed solutions which had already proved fully successful elsewhere.

3. — Unfortunately, as indicated by the texts previously quoted, the States were unwilling at Lisbon to go as far as the Director of the United International Bureaux had advised.

Thus the Lisbon Conference decided to set up a "Conference of representatives of all the countries of the Union" which will meet periodically — every three years — and possessing relatively extensive powers as it will "consider questions relating to the protection and development of the Union" and will report on the financing of the policy determined by it but the representative character of which is not sufficiently emphasised.

As can be seen, the Diplomatic Conference of Lisbon in 1958 initiated the structural reforms of the Union of Paris which must take place but maintained the traditional structures of the Union i. e. periodical Conference of Revision, limited to amending substantive law, and the High Authority of Supervision which continues to control the operation of the International Bureau of the Union in liaison with the newly established administrative and financial Conference.

There is still a considerable difference between "a Conference of Representatives of all the countries of the Union which shall meet in order to draw up a report<sup>10)</sup> on the foreseeable expenditure of the International Bureau for each three-year period to come", a Conference of plenipotentiaries empowered to "modify, by unanimous decision, the maximum annual amount of the expenditures of the International Bureau" and the representative organs with general competence to which we are referring.

4. — This movement towards reform has however been pursued since 1958 in spite of understandable resistance. With regard to the General Convention, it soon became apparent that it would be necessary to complete the Conference of Representatives of the countries of the Union with a restricted body capable of meeting more often and at less cost. Thus, the "Consultative Committee" set up by the Lisbon Conference pending the establishment of the Conference of Representatives (which is in fact an interim Conference of Representatives), provided in its Internal Regulations, for the establishment of a restricted council called the "Permanent Bureau". The Permanent Bureau is composed of representatives of fifteen countries and has the task of preparing the sessions of the Committee and of "considering and reporting on the action taken on its advice" which gives it a very large field of action and also the opportunity to meet as often as may be necessary.

5. — Meanwhile, the restricted Unions, i. e. for the classification of trade marks, the registration of trade marks, the

deposit of industrial designs and models, the protection of appellations of origin, have followed suit.

In 1957 and 1958, the Conferences of Nice and Lisbon established, in respect of the two Unions concerned respectively with marks and appellations of origin, "councils" grouping representatives of all the Member countries of the said Unions responsible for their administration. In 1960, the Conference of The Hague completed this development by creating within the frameworks of the restricted Union for the deposit of industrial designs and models, an "International Designs Committee" charged with the technical, administrative and financial management of the Union (Art. 21 of the new Agreement).

As these separate Unions group a restricted number of States in comparison with the General Union of Paris, it will probably not be necessary to complete their structure by setting up, alongside the councils or committees of the Unions, organs which only group a limited number of the States Members.

#### *B. Union for the Protection of New Plant Products*

1. — In a field closely related to industrial property, the International Conference which took place in Paris in November of 1961 for establishing an international Convention for the protection of new plant products<sup>11)</sup> followed the path already taken by the Union for the Protection of Industrial Property.

The new Union, which will be the third general Union to come within the framework of the United International Bureaux for the Protection of Industrial, Literary and Artistic Property, and whose object is the protection of new varieties of plants, will in fact possess the following organs once it comes into force:

- (a) a Council;
- (b) an International Bureau;
- (c) a High Authority of Supervision;
- (d) Conferences of Revision.

2. — The Council will include representatives from all the Unionist States and will meet in ordinary session once a year. The Council will be empowered:

- (i) to adopt its rules of procedure and, "after having consulted the Government of the Swiss Confederation", the administrative and financial regulations of the Union;
- (ii) to adopt the programme of future work of the Union, fix the date and place of Conferences of Revision, prepare the working documents and give the necessary instructions to the International Bureau;
- (iii) to make proposals to the High Authority concerning the appointment of the Secretary-General and the senior officials of the International Bureau;
- (iv) to examine and approve the accounts and annual budget and determine the contributions of the States Members; and
- (v) generally, to take all decisions necessary to assure the efficient operation of the Union.

<sup>11)</sup> This Convention was concluded in Paris on 2<sup>nd</sup> December, 1961; it will come into force following ratification by three countries — probably in the course of 1963.

<sup>10)</sup> Our italics.

3. — The International Bureau will be directed by a Secretary-General, responsible to the Council. The Secretary-General shall submit to the Council a draft budget and the annual accounts and shall report on the activities and financial position of the Union.

4. — The High Authority, the Government of the Confederation, shall appoint the Secretary-General and all the senior officials of the International Bureau on the proposal of the Council; it shall control the expenditure and accounts of the Bureau and shall present to the Council an annual report on its supervisory function; it shall give its opinion to the Council on the administrative and financial rules of the Union; lastly, it shall establish rules (in agreement with the Unions concerned) governing the procedures for the technical and administrative cooperation between the Bureau of the new Union and the other Unions administered by the United International Bureaux.

5. — The Conferences of Revision will, of course, be responsible for amending the substantive provisions.

6. — It will thus be seen that this new Union is following the movement already initiated by the Union of Paris and is developing along very interesting lines.

Incidentally, it may be noted here that the new Convention provides for only one administrative and financial organ, the Council, and has not completed it by a smaller body. If, at a later stage, the need was felt for completing the structure of the Union by setting up such a restricted organ, then the Council could always do so within the framework of its competence under the Convention in the same way as did the Union of Paris for the Protection of Industrial Property.

### *C. International Union for the Protection of Literary and Artistic Works*

1. — It is inevitable that the evolution referred to above will be followed by the Union of Berne for the Protection of Literary and Artistic Works which incidentally was the first of the International Unions for the Protection of Intellectual Property to set up an Intergovernmental Committee, even though this Committee has only a consultative function.

It is therefore likely that the Diplomatic Conference of Revision which is scheduled to take place in Stockholm in 1965 will establish in respect of the Berne Union such representative organs as are necessary, namely:

- (i) a periodical conference with competence to examine all administrative and financial problems relating to the Union, to raise all new questions and to decide on the convening of Committees of Experts, to prepare proposals for the States, to vote the budget etc.; in other words, to act as the directing organ of the Berne Union;
- (ii) a restricted Council with competence to meet as often as may be necessary, to execute such decisions as may be taken by Conference and to act as the executive organ of the Conference.

It is also possible that, because of the urgency, the Diplomatic Conference of Revision will be preceded by a general

conference of the States of both Unions which will examine structural reforms.

2. — Whatever may be the final decision taken by the States — whether it be a diplomatic conference of revision for each Union or a general conference — a number of problems will present themselves.

The first concerns the rule of unanimity.

We are of the opinion that this rule is necessary so long as it is a question of revising existing conventions of private international law, as this rule alone safeguards the subjective rights acquired by those persons protected by the conventions but the same rule is difficult to justify when it is a question of deciding on the general policy of a Union or when it is a question of deciding on the financing of that policy.

Whatever the situation may be at present, the rule of unanimity is giving way more and more to the principle of a qualified or simple majority, even in the case of the revision of existing conventions.

Thus, in the field of intellectual property, the recent development is as follows:

The Consultative Committee of the Paris Union takes its decisions by a majority of four-fifths of the votes cast (Art. 11 of the Regulations).

The International Designs Committee takes its decisions by a majority of four-fifths of the members voting for certain important questions — such as the alteration of the ceiling of the reserve fund or the establishment of the International Designs Classification — and by a simple majority in all other cases (Art. 21 of the new Arrangement of The Hague).

The new Union for the Protection of New Plant Products has gone even further since the Council takes its more important decisions e.g., budgetary decisions, by a three-quarters majority and all other decisions by a simple majority (Art. 22 of the Convention). Unanimity is no longer required even for revising the Convention, as a majority of five-sixths of the States members represented at the Conference of Revision is sufficient.

Lastly, the new International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations has not adopted the rule of unanimity since the adoption of any revision of this Convention will require a majority vote of two-thirds of the States represented at the Conference of Revision provided that this majority includes two-thirds of the States which, at the time of the revision Conference, are parties to the Convention (Art. 29 of the Convention).

As can be seen, the States are in the process of abandoning more and more the rule of unanimity, even when it is a matter of revising substantive law. We believe however that the Conference of Revision should maintain the principle of unanimity when it is a case of revising fundamental rules of the Convention<sup>12)</sup>, but that it might follow the above-mentioned precedents with respect to the administrative and

<sup>12)</sup> Such were the proposals made by the Bureaux at the Conferences of Rome for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations, and at Paris for the Protection of New Plant Products; the States, however, preferred the majority system.

financial Conference of the Berne Union so that it may take certain particularly important decisions, such as budgetary decisions, by a qualified majority of say three-quarters, all other decisions being taken by a simple majority.

3. — Another problem which the Conference will have to decide upon is the extent of the powers to be given to the new organs.

Between a very detailed enumeration of powers of the new organs, which might at some future date prove to be incomplete because, for instance, of an unpredictable evolution of technical methods of reproduction (and past experience proves that such an evolution is possible) and a very general drafting of such powers, the Conference would be well advised in entrusting to the new organs all questions relating to the "safeguard and development of the Union". It being understood that the new organs should be given full administrative and financial powers and be in position to direct and define the general policy of the Union and decide upon the financing of the policy they have determined<sup>13)</sup>.

Naturally, the revision of the Convention should continue to be a matter for the Conference of Revision, the administrative and financial Conference being restricted to the preparation of the work of the Conferences of Revision.

4. — Another problem is that of harmonising the respective tasks of the new organs and those of the High Authority of Supervision. As can be seen from the preceding pages, it is becoming more and more evident that the States consider that the Conference of Representatives of all the States Members is the directing organ of the Union which should possess all the necessary powers to direct the Union effectively, which includes all administrative, operational and financial powers. This fact has been observed in the setting up of the new Union for the Protection of New Plant Products.

5. — The problem of the relations of the Councils of each of the Unions with the United Bureaux will also have to be settled. We have seen that the Union for the Protection of New Plant Products has provided for a Secretary-General as head of the Bureau responsible to the Council, whereas at the head of the Bureaux of the two other International

Unions for the Protection of Intellectual Property is a Director who is not responsible to representative organs of the States.

If the unity of the protection of intellectual property is to be maintained, it is necessary to maintain a single International Bureau. Moreover, if this unity is to be reinforced it will be advisable to complete the work already accomplished by adding to the single Bureau a single Assembly of representatives of all the Unions.

One might therefore appoint a Director-General or a Secretary-General at the head of the United International Bureaux to be responsible to this single Assembly and appointed on the proposal of this Assembly whereas the common services of each General Union would be the responsibility of Assistant Directors-General or Assistant Secretaries-General appointed on the proposals of the Assembly of the Union concerned.

6. — Finally, the last problem which the Conference of Revision will have to examine is the form of the instrument relating to the new administrative and financial organs.

It will be remembered that the provisions dealing with the administration and financing of the Union were not included in the original text of the Berne Convention of 1886 but were the object of a separate Protocol. Subsequently the Protocol was inserted in the Union Convention.

It would be advisable if the Conference would take out of the Conventional text all administrative and financial provisions as such provisions will come within the competence of the new organs.

It is sometimes necessary to revise very quickly certain administrative and financial provisions. The naturally slow rhythm for the revision of provisions of substantive law contained in the Union Conventions and the long intervals between the Conferences of Revision (on an average 20 years) might well paralyse the new organs if the revision of administrative and financial provisions remain within the competence of the Conference of Revision<sup>14)</sup>.

Moreover, the setting up of the new organs should not be dependent on the more or less slow procedure of ratification by the States of revisions of substantive law. These new organs should be able to operate immediately following the Conference of Revision. If the provisions relating to these organs are contained in a separate instrument from that of the Union Convention, the States would be in a position to ratify them within a relatively short time without having first to revise their national legislation.

Finally, if a State is not prepared to ratify the new text of the Convention from the point of view of substantive law because it does not agree, for instance, with the form of conventional regulation of cinematographic rights, it would hardly be logical to prevent that same State from being represented

<sup>14)</sup> It may be recalled here that the necessity of being able to change quickly the ceiling of expenditure of the Union was clearly understood at the Brussels Conference in 1948, since that Conference amended Article 23 of the Convention by allowing the "Countries of the Union" to substitute themselves, when necessary, for the Conferences of Revision. It would therefore be logical to allow representatives of those countries to be able to discuss these problems within the framework of the new organs.

<sup>13)</sup> As an example, Article 21 of the new International Convention for the Protection of New Plant Products is drafted in the following terms:

The tasks of the Council shall be the following:

- (a) to study measures to safeguard the interests of and to encourage the development of the Union;
- (b) to examine the annual report of the activities of the Union and adopt the programme of future work of the Union;
- (c) to give to the Secretary-General, whose functions are set out in Article 23, all necessary directions, including those concerning relations with national authorities;
- (d) to examine and approve the budget of the Union and fix the contribution of each Member State of the Union in accordance with the provisions of Article 26;
- (e) to examine and approve the accounts presented by the Secretary-General;
- (f) to fix, in accordance with the provisions of Article 27, the date and place of the conferences referred to in that Article and take the measures necessary for their preparation;
- (g) to make proposals to the Government of the Swiss Confederation concerning the appointment of the Secretary-General and the officials of the senior grade;
- (h) generally, to take all decisions necessary to assure the efficient functioning of the Union.

in the new organs on the sole grounds that it had not ratified the revised Convention, although it is prepared to ratify administrative and financial rules immediately.

For all these reasons, we therefore believe that the States would be well advised to insert the administrative and financial rules in a separate instrument from the Union Convention, in, say, an Additional Protocol which the States might ratify immediately.

#### IV

### The Future Evolution of the International Unions for the Protection of Intellectual Property

1. — In 1956, at the Congress of Washington of the International Association for the Protection of Industrial Property, the Director of the United International Bureaux for the Protection of Industrial, Literary and Artistic Property made the following statement:

“Three years of experience with the Paris Union and thirty years of experience with other Organisations of States have led me to conclusions which I hope will be duly considered by the Diplomatic Conference at Lisbon. These conclusions are as follow:

- (a) The intellectual rights, whether they concern patents and trade marks or copyright, should be protected internationally, as are the rights contained in the Declaration of Human Rights; to this end, they should have the benefit of their own intergovernmental organisation in the same way as labour rights, the rights of the individual to health, or the rights of the individual and of peoples to security.
- (b) This intergovernmental organisation should be given its own proper authority in intellectual rights, and suitable organs to represent it, and those rights, effectively in international relations.
- (c) Lastly, this organisation should become a part of the family of the United Nations”<sup>15</sup>).

In 1958, the Director of the United International Bureaux made the following proposals to the Lisbon Conference:

“...and charge the administrative conference with the following functions in addition to the exercise of the financial authority:

- appointment of a Council;
- study of an agreement with the Berne Union for the Protection of Literary and Artistic Works with a view to the establishment of a single Statute for the United International Bureaux for the Protection of Industrial, Literary and Artistic Property;
- instructions to be given to the Council with a view to the study of an agreement with the Economic and Social Council, and for all other questions concerning the functioning of the Union”<sup>16</sup>).

Lastly in 1959, the Director of the United International Bureaux wrote the following<sup>17</sup>):

“The Intellectual Property Unions will be able to function to the satisfaction of the States, the public and the creators when they have been given organs capable of winning back the initiative in the field of the international protection of intellectual property, that is to say, when the following structural reforms have been carried out:

- (1) The creation, at the head of all the Unions of intellectual property, both general and restricted, of a common organ with power to take all necessary steps with a view to the protection and strengthening of the Intellectual Property Unions.
- (2) This common organ should, moreover, have the power to vote the overall budget necessary for implementing the policy which it is

competent to determine, that is to say, the establishment of a single budget for intellectual property;

if this is not done, the multiplicity of separate budgets and special funds would make it very difficult for the representatives of States to control the expenditure of the sums paid to the United International Bureaux.

- (3) A certain latitude should be left to this common organ enabling it to take decisions according to a majority system, be it simple or qualified;

here again, the rule of unanimity is valid so long as it is a question of revising provisions of international private law embodied in the existing Convention, but, applied to an organ charged with taking initiative, it can only cause difficulties; moreover, this rule is not effective and has never been effective when it is a case of adopting new international instruments.

- (4) In other words, it is a question of creating a truly International Organisation of Intellectual Property, capable of taking its place beside the other existing important international organisations and of protecting the interests of intellectual property within the framework of the family of “specialised agencies”.

2. — The Paris Union has already taken such a course.

The Union for the Protection of New Plant Products has followed suit.

The Berne Union will inevitably follow the same path, either at Stockholm or even earlier.

3. — On the 19<sup>th</sup> December 1961, and at the instance of Brazil, the General Assembly of the United Nations adopted the following resolution:

The General Assembly,

Recalling its resolution 1429 (XIV) of 5 December 1959 on the possibilities of a further expansion of international contacts, as well as an increased exchange of knowledge and experience in the field of applied science and technology,

Taking note of Economic and Social Council resolution 375 (XIII) of 13 September 1951 and of the reports on restrictive business practices prepared by the Secretariat and by the *Ad Hoc* Committee established under the above-mentioned Council resolution,

Bearing in mind that a United Nations Conference on the Application of Science and Technology for the Benefit of the Less Developed Areas will be convened under Economic and Social Council resolution 334 (XXXII) of 3 August 1961,

Bearing in mind that access to knowledge and experience in the field of applied science and technology is essential to accelerate the economic development of under-developed countries and to enlarge the over-all productivity of their economies,

Realizing that the protection of the rights of the patent-holders both in their country of origin and in foreign countries has contributed to technical research and, therefore, to international and national industrial progress,

Affirming that it is in the best interest of all countries that the international patent system should be applied in such a way as to take fully into account the special needs and requirements of the economic development of under-developed countries, as well as the legitimate claims of patentees,

Requests the Secretary-General, in consultation with appropriate international and national institutions, and with the concurrence of the Governments concerned, to prepare for the Committee for Industrial Development, for the Economic and Social Council, and for the General Assembly at its eighteenth session, and taking into consideration any pertinent discussions which might take place in the United Nations Conference on the Application of Science and Technology for the Benefit of the Less Developed Areas, a report containing:

- (a) A study of the effects of patents on the economy of under-developed countries;
- (b) A survey of patent legislation in selected developed and under-developed countries, with primary emphasis on the treatment given to foreign patents;

<sup>15</sup> *Industrial Property Quarterly*, July, 1956, p. 65; *La Propriété industrielle*, 1956, pp. 148-149.

<sup>16</sup> Lisbon Conference, Preliminary Documents, Proposals with Explanatory Notes. First Volume. First Part, p. 10 of Point XXV.

<sup>17</sup> “Vers l'organisation internationale de la propriété industrielle”, *op. cit.*, pp. 179-180.

- (c) An analysis of the characteristics of the patent legislation of underdeveloped countries in the light of economic development objectives, taking into account the need for the rapid absorption of new products and technology, and the rise in the productivity level of their economies;
- (d) A recommendation on the advisability of holding an international conference in order to examine the problems regarding the granting, protection and use of patents, taking into consideration the provisions of existing international conventions and the special needs of developing countries, and utilizing the existing machinery of the International Union for the Protection of Industrial Property.

This decision of the General Assembly once more gives rise to the possibility of a new international instrument dealing with industrial property being established within the framework of the United Nations, an instrument which might well be based on different principles from those which have been established in the Paris Convention.

4. — Consequently, the Permanent Bureau of the Consultative Committee of the Paris Union adopted, at its meeting on 29<sup>th</sup> and 30<sup>th</sup> March, 1962, a resolution charging a restricted Working Group to examine the entire structure and tasks of the Intellectual Property Unions and their Bureau and, in particular, (a) "the international status of the representative bodies and the United Bureaux of the Paris and Berne Unions and their Arrangements"; and (b) "relations with the United Nations and Switzerland".

5. — It is obvious that any structural reform concerns both the Union of Berne and the Union of Paris. As M. G. Finnis, Inspector General, Chairman of the Consultative Committee and of its Permanent Bureau put it:

"It is also normal to envisage that the Member States of the Unions should be able to take part in the reorganisation of their Bureaux. Participation of the Member States might be foreseen in two ways:

- (a) either through the already existing consultative bodies whose terms of reference are precisely to give their opinion on all questions concerning the work, operations and development of the Unions and of the United International Bureaux; or
- (b) through a Joint Committee grouping representatives who would be appointed by each of the existing consultative bodies. This latter formula is obviously the simpler, since considerable practical problems would be raised if the Consultative Committees had to be convened, either in succession or simultaneously"<sup>18</sup>).

The Permanent Bureau of the Union of Paris has thus charged the Working Group, which it has set up, to submit a complete report on the question of the structure and tasks of the Unions and of the United Bureaux<sup>19</sup>) and to submit such report to a Joint meeting of the Permanent Bureau of the Paris Union and the Permanent Committee of the Berne Union; this joint meeting may take place in Geneva in Oc-

tober of 1962. Following the work of this joint meeting, an *ad hoc* Diplomatic Conference might be convened and in fact should be convened as soon as possible in view of the urgency of solving the problem of the relations of the Unions with the United Nations.

6. — What should be the task of this Diplomatic Conference:

(a) If we refer back to the Resolution adopted by the General Assembly of the United Nations on 19<sup>th</sup> December, 1961, it will be realised that it is indispensable that our Unions be recognised by the United Nations and such recognition should be determined by means of an Accord between the representative organs of the States Members of the Unions and those of the United Nations.

But, as we have seen, such an Accord can only be concluded by the Economic and Social Council with an "institution"; an institution is not merely a Union or a Bureau lacking a generally recognised international legal status<sup>20</sup>); it is an entity comprising one or several Unions of States, a Bureau and representative organs of the Members established by "inter-governmental accord" and provided (by such intergovernmental accord) with an international legal status, privileges and immunities which it requires in order to carry out its task, such legal status and privileges being recognised by all the States parties to the intergovernmental accord.

Thus the first task of this diplomatic conference should be to create such an "institution" — which could be called the International Organisation of Intellectual Property.

(b) To this effect a number of problems must be solved.

We have already mentioned such problems above, in particular in connection with the Diplomatic Conference of Stockholm.

We can however recall as a reminder the problem concerning the form of the representative organs; there exist two possibilities: either a number of representative organs of the States (one per Union), or the setting up of a common organ in respect of all the Intellectual Property Unions.

The second formula is by far the most simple.

Furthermore, if the States Members of the Unions wish to strengthen the unity of intellectual property, then one should think of the *Organisation* of Intellectual Property and no longer of the *Unions*; it would then be necessary to envisage a single Organisation responsible for several Conventions and possessing a single Assembly which would adopt a single budget even if, for example, the separate budget of each Union is approved solely by the delegates of the States Members of that particular Union.

(c) Another problem is that of the form of the "Inter-governmental Accord". One might envisage the adoption of three Additional Protocols to the Conventions of Paris for the Protection of Industrial Property, of Berne for the Protection of Literary and Artistic Works and of Paris for the

<sup>18</sup>) Report of the President to the Consultative Committee of the Paris Union, Paris, 13<sup>th</sup> March, 1962, p. 3.

<sup>19</sup>) The Working Group met at the headquarters of the Bureaux from 12<sup>th</sup> to 14<sup>th</sup> June, 1962 under the Chairmanship of M. Guillaume Finnis, President of the Permanent Bureau of the Consultative Committee of the Paris Union, and included representatives from the United States of America, France, Italy, Netherlands and United Kingdom; the representative of Czechoslovakia was unable to attend but has addressed his observations in writing to the President of the Working Group.

The result of the work is contained in proposals for a re-organisation of the Unions and Bureaux which follow closely the views expressed in the present article and principles put forward by the Director of the United Bureaux since 1953.

<sup>20</sup>) At present, the legal status of the Unions and Bureaux as well as the privileges and immunities which they require have not been formally recognised by all the States Members; in Switzerland however, the Federal Council has made an unilateral recognition of the legal status, privileges and immunities.

Protection of New Plant Products. Nevertheless, the preparation and the holding of simultaneous or consecutive diplomatic conferences will give rise to a number of practical problems difficult to solve. Moreover, in order to strengthen the unity of intellectual property, it would be preferable to have a *single* international instrument which would *ipso facto* abrogate the relevant provisions of the different existing Conventions.

This latter instrument could be a "Constitutive Act" whose ratification would not require any amendment of national legislation and would not give rise to any special problem. Thus the new Organisation could be set up very quickly.

(d) Other problems of a practical nature might be noted here, but these are of only secondary importance as compared with the question of principle which is to determine whether the States Members of the industrial property Unions wish to maintain, on the international level, the basic principles embodied in these Unions.

7. — To conclude, the only question which must finally be resolved is whether the States Members of the Intellectual Property Unions wish to maintain and strengthen, on the international level, those principles which have given birth to these Unions.

If the answer to this question is in the affirmative, then it is a matter for the States to set up a truly International Organisation for Intellectual Property and to seek the recognition of the competence of such an Organisation by the Economic and Social Council of the United Nations.

This is a question which is not within the competence of the United International Bureaux and can only be determined by the States Members of the Unions. It is a matter for the States alone to decide and to act accordingly. In effect, it is a problem of a political nature and must be settled through diplomatic channels.

For our part, we are firmly convinced that it is urgent to strengthen the intellectual property Unions on the international level and thus to create the International Organisation of Intellectual Property and to seek recognition of its competence by the Economic and Social Council of the United Nations.

If this is achieved, the work of re-organisation undertaken for the past ten years by the States Members in agreement with the directing bodies of the United International Bureaux will finally lead to the horizons which we have envisaged in our address to the International Diplomatic Academy on 6<sup>th</sup> May, 1957 on the subject of the "Intellectual Rights of the United Nations":

"In 1883 and in 1886, courageous and enterprising men established the conventional foundations of intellectual property in the two Conventions of Paris and Berne.

Most precious assets for the development of our civilisation, that is to say, the opportunity for the author and the artist to work and the right of the inventor or manufacturer to benefit from his work, have been safeguarded and have thus enabled civilisation, by relatively simple and practical means, to shine with increasing brilliance.

It is the duty of our generation to complete this task and to establish the house of Intellectual Rights...<sup>21)</sup>

<sup>21)</sup> *La Propriété industrielle*, May, 1957, pp. 98 *et seq.*

## CORRESPONDENCE

### Letter from Argentina

By Dr. B. SALOMON, Buenos Aires

We had hoped in this report to give some information on the bringing up to date of Argentine patent and trade mark law (see our previous report<sup>1)</sup>). Unfortunately, our hopes have not materialized. Dr. Pedro Breuer Moreno, whom the Government had entrusted with the preparation of a draft, certainly submitted it very promptly; but it ran up against opposition from several quarters, with the result that it was buried by Parliament, to which it had been duly transmitted, by reference to a committee. At any rate, nothing more has been heard of it for the last two years, and reform must therefore be regarded as deferred for an indefinite period.

Although the text of the law is out of date, readers of "Industrial Property" will have had ample opportunity of establishing that its administration by the courts is at all times guided by an understanding of the underlying economic conditions, and shows no signs of rigid adherence to the letter of the law, which rests on other assumptions. Hence, the great part of the draft prepared by Dr. Breuer Moreno represented merely the legal confirmation of principles already developed in the administration of the law; it follows that the non-appearance of the new law has made no difference in this regard. Certain rules of court procedure could be introduced by means of an amending bill to the existing Act, which perhaps would be simpler than to draft a completely new text. Care could at the same time be taken to protect utility models and industrial designs.

1. — Since, in Argentina, both the acquisition and the renewal of trade mark rights depend in principle only on registration, and not on use, many well-known marks are registered not only for the goods that bear them, but also for many or all of the other categories. No objection can be taken in principle to these "defensive" trade marks, which give their proprietors the same protection as marks which are actually used.

Dr. Felipe Prat, a judge of the Buenos Aires Courts, was called upon to deal with a case concerning one such "defensive" trade mark (judgement of 23<sup>rd</sup> May, 1960, in re *E. Masciorini et Cia. S. A. v. Salvador Adib Canen*). The plaintiff's business has to do with the manufacture and sale of paints, which are marketed under the registered trade mark "*El Mono*" ("The Monkey") which bears a picture of a monkey. Dyestuffs fall in category 10. The respondent is an important manufacturer of underclothes, which have been decorated by him with pictures of various kinds of monkeys. Underclothes fall in category 15. The respondent, however, had had various pictures of different kinds of monkeys registered in all categories, and the plaintiff accordingly sought the cancellation of such registration in category 10.

<sup>1)</sup> *Prop. ind.*, 1960, p. 71.

Both the court of first instance and the Court of Appeal (Judgement of 20<sup>th</sup> December, 1960) dismissed the application. They laid it down that in principle defensive trade marks conferred the same rights as those which were actually used for the products in respect of which they were registered. In other words, it could not be asserted against the respondent's trade mark that its proprietor has no justified interest in it. Moreover, both courts were of the opinion that there was no risk of confusion, since quite different pictures of monkeys were involved, and the plaintiff could lay no claim to an exclusive right to pictures of monkeys as such. In addition, the Court of Appeal rather surprisingly interpreted the fact that the respondent's mark was of a defensive nature *in his favour*, asserting that for this very reason the risk of confusion between the two products was diminished. It seems to us that on this argument plaintiff's counsel ought to have advised him not to institute proceedings, but we feel equally that the Court itself ought on principle to have recognised the stronger claim to protection of a trade mark actually used as compared with that of a right deriving solely from appearance on the trade marks register. It must however be said that in this particular case the Court of Appeal dismissed the claim mainly because it found that there was no risk of confusion between the marks concerned.

2. — Since the Patent Office is not empowered to decide in cases of opposition lodged in due form and in good time (Art. 21 of the Trade Marks Act), the notice of opposition is purely formal. The opposer confines himself to specifying the right on which he bases his case and to declaring that he is lodging formal opposition. It is then left to the applicant to seek an amicable settlement, to apply to the regular courts for an order of inadmissibility in respect of the opposition, or to allow the application to fall away.

If the matter comes to court, both parties submit the usual pleadings, and the question frequently arises whether the opposer can at this stage broaden his grounds, and especially whether he can subsequently assert in his favour trade marks which he has not included in the notice of opposition. Judge Ehrlich Prat, of the Buenos Aires bench, and the Court of Appeal have answered this question in the negative in their judgements (of 22<sup>nd</sup> February and 21<sup>st</sup> October, 1960, respectively) in *re Via. Metalurgica Austral Argentina S. A. v. Marre et Cia. S. A.* It appears that the hearing before the Patent Office and the court proceedings are to be considered as a single trial, the scope of which is limited by the application for registration on the one side and by the notice of opposition on the other. An opposer who has failed to assert a right of any kind has other means to hand of making good his omission, namely, an application for cancellation after the trade mark in question has been granted.

3. — Court proceedings move exceedingly slowly in every country in the world, and Argentina is no exception. For this reason, the "provisional" measures which the courts are empowered to order are of exceptional interest, although they often oblige the parties against whom they are directed to lay down their weapons, regardless of whether they are in the right or in the wrong.

Article 57 of the Trade Marks Act enables parties, whose trade marks have allegedly been infringed, to seek from the courts an order for the provisional seizure of "signs, labels, bottles, capsules or any other like articles that represent their trade marks or pertain to them". The appropriate order will then be made "on the sole responsibility of the applicant and against security to cover the case of the application being dismissed".

In the case of *Singer Manufacturing Company v. J. Torti*, the plaintiff caused sewing machines, to which the trade mark "Singer" had been affixed, to be seized "provisionally", i. e., until the end of the legal dispute. The respondent applied for the order to be rescinded, on the ground that Article 57 permitted seizure only of the "trade mark", and not of the article bearing it; so far as the latter was concerned, the proprietor of the trade mark could do no more than have an inventory drawn up by the court. Whereas the judge in the lower court found for the respondent, the Buenos Aires Court of Appeal, by its ruling of 20<sup>th</sup> March, 1960, upheld the original order of seizure. Article 57 was to be so interpreted as to permit of the seizure of articles bearing the trade mark, the respondent's interests being guaranteed in that he was entitled to demand security.

4. — Argentinian trade mark law gives to the first applicant the right of registration (Art. 6), and use is in principle meaningless (Art. 7). This provision is frequently made use of to register in Argentina trade marks that are well-known abroad, in order to prevent the rightful owner, should he wish some day to enter the Argentinian market, from using his own trade mark.

The case of *Fromageries Bell S. A. v. Enrique Ivaldi* (judgements of Judge González Bonorino of 30<sup>th</sup> October, 1959, and of the Buenos Aires Court of Appeal of 28<sup>th</sup> February, 1961) concerned the French trade mark "*La vache qui rit*" (words and drawing) that the respondent had registered in Argentina as long ago as 1927. When the plaintiffs applied for registration of the same mark in 1952, the respondent opposed the application on the ground of his prior right, whereupon the plaintiffs sought the cancellation of his mark.

Applications for invalidation of this kind are based on Article 953 of the Civil Code, according to which legal transactions that are contrary to morality are null and void<sup>2)</sup>.

The respondent invoked the statute of limitations: in accordance with unanimous jurisdiction, applications for invalidation become statute barred after the lapse of ten years, in which case the general rule in Article 4023 of the Civil Code, which deals with the prescription "of personal applications on the ground of claims due", applies.

The court overruled this objection: invalidation proceeding from an infringement of Article 953 of the Civil Code is absolute, and cannot be remedied by the passage of time. However, the court also dismissed the plaintiff's case, on the grounds that he had failed to establish either the existence of the trade mark in France or the respondent's bad faith.

<sup>2)</sup> See, in this connection, *Prop. ind.*, 1960, p. 73.

The Court of Appeal set aside this judgement and found for the plaintiff: the existence of the French mark emerged clearly from the documents in the case, and bad faith was to be inferred, since it was a matter of the underhand abstraction of a foreign trade mark.

The Court of Appeal stated expressly that there could be no question of objection on the ground of limitation, since the respondent in his answer to the case stated in the notice of appeal, had not renewed his objection.

A review of the case by the Supreme Court is still pending. The Supreme Court's first and principal task will be to decide the question of legal procedure, namely: whether an objection on the ground of limitation must also be expressly lodged with the court of second instance where the court of first instance has found against the plaintiff on other grounds, and the respondent, in his pleadings before the higher court, has confined himself to replying to the plaintiff's submissions relating to the positive grounds of the judgement against which the appeal has been made.

We would in any event like to think that the courts will continue to apply Article 4023 of the Civil Code to cases of invalidation brought under Article 953. When all is said and done, it is not unreasonable to require that the foreign proprietor of a trade mark should institute proceedings at latest within ten years of the date on which his mark was registered in Argentina. Should he fail to do so, then his belated interest merits no protection in view of the need to refrain so far as possible from interfering with acquired rights. That the Court of Appeal itself entertained doubts about the validity of its underlying premise is also apparent from the fact that it observed expressly that the respondent had not proved his use of the mark registered by him in 1927, so that "in this particular case" the plaintiff's application should be granted. When, in the application of Article 953 of the Civil Code, it is simply a matter of bad faith at the time of registration, what significance could subsequent use of the mark possibly have?

5. — Applications concerning changes of business names which resemble other, older names or trade marks to the point of confusion, become prescribed after the lapse of one year, and the term of limitation can be interrupted only by lodging an appeal. The parties frequently conclude agreements to confine themselves to their respective rights to the names, and in proceedings instituted for non-performance of such agreements, again, general objection is frequently raised on the ground of limitation.

The Swedish firm *Aktiebolaget B. A. Hjorth and Co.*, manufacturers of the well-known "Primus" stove, had difficulties for many years with an Argentinian firm over the Primus name and trade mark. These difficulties finally led to a court action, which was ended by an agreement, by the terms of which the Argentinian firm was allowed to use the name "Casa Primus" on condition that at least 60 per cent of its sales should consist of goods manufactured by the Swedish firm; the agreement was concluded for a period of five years. During the course of these five years import restrictions were introduced in Argentina, which rendered impossible the sale

of "Primus" stoves and similar products made by the Swedish firm. The latter, however, waited until the expiry of the five-year period, and then instituted proceedings within one year against the Argentinian firm with the object of obliging the latter to remove the mark "Primus" from its name.

The respondents objected on the ground of statute limitation, basing their case on, among other things, the following: already during the term of the original agreement they had acquired an indisputable right to the name; and the one-year term of limitation had expired long before the institution of the legal proceedings during which the agreement had been concluded. And inasmuch as a right to use the name had been conceded to them under the agreement, it was simply a matter of the confirmation of a prior right, and not one of the acquisition of a new right, as a consequence of which a new one-year term of limitation would have begun to run. Moreover, the agreement itself had been rendered inoperative by the Argentinian import restrictions long before the lapse of its five-year term, and the term of limitation had therefore to be reckoned from that moment, and not from the final date of expiry of the agreement.

Whereas the judge in the lower court found for the respondent, the Court of Appeal found for the appellant: regardless of how the rights of the parties may have appeared before the conclusion of the agreement, they must be viewed in the manner in which they were embodied therein, and so long as the conditions laid down in the agreement held, the respondent could not acquire any rights whatsoever at the appellant's expense on the ground of statute limitation. The decision is to be welcomed (judgement of 10<sup>th</sup> May, 1961, in re *Aktiebolaget B. A. Hjorth v. Casa Primus C. Longuet S. R. L.*).

6. — Where a foreign trade mark cannot be registered in Argentina, the proprietor must use another in its stead, a course that is not always easy in the case of series-produced goods. A few years ago Miroslav Rousek registered the trade mark "Tatra" in Argentina for motor cars and lorries. As the Czech firm of the same name wished to register the same mark, it instituted proceedings for cancellation against Rousek. The courts dismissed the application, since it had not been proved that the Tatra Works had used its mark previously in Argentina (*Miroslav Rousek v. Tatra National Corporation*, judgements of Judge José Rosario of 29<sup>th</sup> August, 1952, and of the Buenos Aires Court of Appeal of 11<sup>th</sup> August, 1954)<sup>3</sup>).

The Czech manufacturers accordingly used the trade mark "Skoda" for their lorries. None the less, certain parts still bore the trade mark "Tatra", of which fact Rousek took advantage to institute proceedings against the Argentinian importers for infringement of his mark. The lorries were openly sold under the name "Skoda", and to forbid trade in them on the sole ground that certain parts, which were not particularly visible to the public eye, still bore the trade

<sup>3</sup> Following the decision described under 4 above in the "La Vache qui rit" case, the courts are now going substantially further and protecting the unregistered proprietor of a foreign trade mark against attempts to acquire his mark through bad faith, regardless of whether or not the proprietor has previously used his mark in Argentina.

mark "Tatra" would be going too far (*Miroslav Rousek v. José Nóbrega and Carmelo Baccri*; judgement of the Buenos Aires Court of Appeal of 11<sup>th</sup> August, 1961).

7. — The profound changes in our economic and social conditions and ideas often make difficult the interpretation of the Trade Marks Act, which dates from the year 1900, and leads to contradictory decisions.

In 1900 there was neither radio nor television, and the users of such goods were still in their infancy. Similarly, there were no "slogans" of economic significance. With the appearance of the latter, some slogans were registered as trade marks by the Patent Office. The registration of others was refused, and the Supreme Court upheld this decision in the case of the slogan "*Bonafide quiere decir buena fe y es la marca del buen café*" ("*Bona fide* means good faith and is the trade mark of good coffee") (*Café Bonafide, ex-parte*, judgement of the Supreme Court, published in *Patentes y Marcas*, 1948, p. 80).

In a judgement of 24<sup>th</sup> April, 1961, the Buenos Aires Court of Appeal took the opposite position (*Domec, Cía. de Artefactos Domésticos S. R. L., ex-parte*), declaring the slogan "*La llama anuncia su fama*" ("*The flame reveals its glory*") to be eligible for registration. In doing so, the Court made express reference to the divergent jurisdiction of the Supreme Court, and observed, citing a number of formal legal opinions which do not interest us here, that slogans of this kind both needed protection and were protectable.

8. — The difficulty of reconciling what appears to be "lawful" with what is "right" is well demonstrated by the judgement of Judge Felipe Ehrlich Prat of Buenos Aires of 16<sup>th</sup> February, 1961, in re *Telesur S. R. L. v. Telesud S. A.*

The plaintiff, a limited liability company, ran a retail business in television sets and other domestic appliances in a suburb of Buenos Aires. Shortly after its establishment, the respondent company set up a factory to manufacture television sets. The names "Telesur" and "Telesud" being virtually identical — "sud" and "sul" are alternative forms of the Spanish word for "south" — the plaintiff demanded that the respondent change its name. Despite the apparently clear facts of the case, the judge in the lower court rejected the application. In doing so, he made it clear that although the plaintiff had indeed made first use of the name, the respondent company had formally existed before the plaintiff's company. In any event, the two names had come into use practically simultaneously. They were not absolutely identical, and, lastly, a factory manufacturing television sets was different from a retail business distributing them.

The Court of Appeal had no hesitation in setting aside the judgement of the lower court and finding for the plaintiff. It was quite clear from the papers in the case that Telesur S. R. L. had been in business under that name before Telesud S. A. The names were similar to the point of confusion, and even though the two companies worked in different branches of the trade, the similarity between identical articles being handled by manufacturer and distributor could not seriously be disputed.

It is certain that the Court of Appeal rightly applied the letter of the law (Art. 43 of the Trade Marks Act). On the other hand, the reasoning of the judge of the lower court is understandable. When the law gives the first user of a business name the right to forbid the use of similar names to newcomers in the same branch of industry or trade, it does so only on the basis of an unwritten assumption, namely, that such use will subjectively harm someone else, or at least objectively harms him. It seemed obvious to the judge that neither damage nor intent to damage could reasonably be inferred where a large factory inadvertently imitated the name of an obscure suburban tradesman, and he therefore believed that he was perfectly right to refuse to apply the provisions of the Act to a case for which it had clearly not been coined. The Court of Appeal viewed the matter more simply, and adhered to the letter of the law.

9. — The transfer of a trade mark, and the accompanying formalities which have to be complied with, are provided for in detail in the Trade Marks Act and in the regulations for its implementation, and present no difficulty. The deeds on which the transfer is based are submitted to the Patent Office, the details of the transfer are entered on the register, and the conveyance is duly noted on the deeds. On the other hand, there is no procedure for transferring business names from one owner to another, for the simple reason that the right to such a name is acquired through use and not by registration.

A case in which this situation played an important part occupied the time of the courts in Buenos Aires (judgements of Judge González Bonorino of 30<sup>th</sup> June, 1958, and of the Court of Appeal of 28<sup>th</sup> September, 1960, in re *Beacon S. A. v. Beacon Argentina S. R. L.*). In 1942, Enrique Prais secured the agency for the American firm "Beacon International Corporation", which expressly allowed him to operate the agency under his own name followed by the name "Beacon International Corporation de la Argentina". A few years later, the appellant firm was established under the name "Beacon S. A.". Finally, Enrique Prais converted his business into a limited liability company, which he named, with the permission of the American firm, "Beacon Argentina S. R. L.". (It is not clear from the written judgement whether the new firm was also the agent of Beacon International Corporation; but this would seem not to be the case.) The appellant demanded that "Beacon Argentina S. R. L." eliminate the word "Beacon" from its name, since there was risk of confusion.

The lower Court granted the application, and expressly stated that the firm "Beacon Argentina S. R. L." could not assert the acquired right of its founder, Prais, to the name Beacon. The Court of Appeal did not accept this view, set aside the judgement and dismissed the appeal. Even if the respondent firm "Beacon Argentina S. R. L." was formally not to be regarded as the legal successor to the one-man firm "Enrique Prais — Beacon International Corporation de la Argentina", nothing stood in the way of the transfer of the right to the name from this firm to any other; it followed that this fact provided ample justification for the use of the name "Beacon". (In addition, the Court of Appeal based its

decision on the circumstance that the two parties operated in different branches of trade.)

The decision of the Court of Appeal is in any event to be welcomed. If it was possible for the businesses of "Beacon S. A." and "Enrique Prais — Beacon International Corporation de la Argentina" to work side by side for many years without infringing one another's rights, then clearly "Beacon S. A." could have no protectable interest in the change of name of "Beacon Argentina S. R. L."

10. — Another problem relating to the right to trade marks which is in some respects similar to the foregoing concerns re-registration (judgements of Judge Verrier of 24<sup>th</sup> September, 1959, and of the Court of Appeal of 19<sup>th</sup> August, 1960, in re *Establecimientos Anilinas Colibrí v. Blyth & Platt Ltd.*).

The trade mark "Cohra" was registered for twenty years for chemical products and dyestuffs in categories 1 and 10 in the name of German Ortkras. Ortkras founded the appellant firm, but died before the registration could be legally transferred to him. To simplify matters, his successors (the appellant firm) simply re-registered the trade mark in both categories in its name on the day on which fees fell due. It then ran up against opposition from the respondents, who were the manufacturers of a world-famous brand of shoe polish, also under the name "Cohra". This second trade mark had been registered for many years in the appropriate category (14).

Here again, the judge in the lower court found for the respondent on purely legal grounds. Since the appellant company, or rather its legal predecessors, had not taken the trouble to have the old registration transferred to them, they could not justifiably complain of the consequences; and having regard to the identity of the marks, to the similarity between the products, which would be sold in the same retail establishments, and the proven importance of the "Cohra" mark for the respondents, the application must be dismissed.

The Court of Appeal, however, reversed the decision. The respondent could not oppose the transfer of the mark originally registered by Ortkras, and this right ought not to be ceded to them simply because the appellant had legally followed another course; the material legal rights would not be infringed by such a circumstance.

On the day on which it rendered judgement in the "Cohra" case, the Court of Appeal decided in a similar case (*Pablo Perez & Cía. S. R. L. v. Inchauspe & Cía.*), in which the main principle to emerge was that the proprietor of a well known trade mark ought not to be penalized by loss of his rights if he fails to comply with registration formalities but shortly afterwards makes a new application for registration of the same mark. "It should not be forgotten that the Trade Marks Act was above all conceived for the purpose of preventing unfair competition", to quote the Court on this occasion; and the decisions reported in this letter very well show that the Courts in Argentina hear this consideration firmly in mind.

## CONGRESSES AND MEETINGS

### Committee of Experts on Patents of the Council of Europe

(Meeting of July, 1962)

The Committee of Experts on Patents of the Council of Europe met in Strashourg, under the chairmanship of Mr. Grant (United Kingdom).

The Committee has prepared a "Draft Convention on the unification of certain points of substantive law on patents for invention".

Its purpose is to unify certain basic features of the law on patents. It refers successively to the requirements an invention must fulfil to be patented and to the conditions governing the description of the invention and the claims contained in the patent. In spite of the fundamental differences in national legislations, the Committee reached agreement on most points.

The draft Convention will be submitted to the Committee of Ministers of the Council of Europe for approval. It follows two European Conventions which entered into force on 1<sup>st</sup> June and 1<sup>st</sup> August, 1955, respectively, i. e. the "European Convention relating to the Formalities required for Patent Applications" and the "European Convention on the International Classification of Patents for Invention".

The July meeting was attended by experts of all member countries of the Council of Europe. Observers from Israel, Spain and Switzerland, and representatives of the European Economic Community, Euratom and the International Patent Institute of The Hague were also present.

The International Bureau for the Protection of Industrial Property was represented by its Vice-Director, M. Ch.-L. Magnin.

