

# Industrial Property

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This issue contains: (1) an Order Form for the new publication (in French only) by the International Bureau of the International Classification of Goods and Services to which Trade Marks apply; (2) a List of Member States of the Paris Union and of the Separate Unions (Pink Sheet)

# INTERNATIONAL UNION

## ISRAEL

### Ratification

of the Arrangement of Lisbon for the Protection of Appellations of Origin and their International Registration<sup>1)</sup>

The following communication has been received from the Swiss Federal Political Department:

*(Translation)*

"In compliance with the instructions of the Federal Political Department dated 1<sup>st</sup> June, 1963, the Swiss Embassy has the honour to inform the Ministry of Foreign Affairs that, by a Note dated 30<sup>th</sup> January, 1963, received on 31<sup>st</sup> of the same month, the Embassy of Israel in Berne deposited with the Political Department the instrument of ratification of that State to the Arrangement of Lisbon for the Protection of Appellations of Origin and their International Registration, signed on 31<sup>st</sup> October, 1958 (including the Regulations for the execution of the said Arrangement)."

## UNITED STATES OF AMERICA

### Application

of the Paris Convention to Puerto Rico, the Virgin Islands, Samoa and Guam

The following communication has been received from the Swiss Federal Political Department:

"In compliance with the instructions of the Swiss Federal Political Department dated 7<sup>th</sup> June, 1963, the Swiss Embassy has the honour to inform the Ministry of Foreign Affairs that in a note dated 5<sup>th</sup> March, 1963, the Embassy of the United States of America in Berne informed the Political Department that in application of Article 16<sup>bis</sup> of the Convention of Paris for the Protection of Industrial Property, the said Convention is applicable to Puerto Rico, Virgin Islands, Samoa and Guam.

The text of the note was as follows:

'The Embassy of the United States of America presents its compliments to the Federal Political Department and has the honor to refer to the 1911, 1925, 1934 and 1958 revisions of the Convention of Paris for the Protection of Industrial Property. On behalf of the Government of the United States, the Embassy gives notice of territorial application of these revisions to Puerto Rico, the Virgin Islands, Samoa and Guam.

It is noted that pursuant to Article 16<sup>bis</sup> of the 1958 and 1934 revisions, the notification will apply with respect to

such revisions one month after the dispatch of the communication by the Government of the Swiss Confederation to the other countries of the Union. The Government of the United States desires that the notification apply with respect to the 1925 and 1911 revisions on that same date.'

In accordance with paragraph (1) of Article 16<sup>bis</sup> of the Convention of Paris, the notification of the United States of America will take effect on 7<sup>th</sup> July, 1963."

# LEGISLATION

## IRELAND

### Trade Marks Act

(No. 9, of 1963)<sup>1)</sup>

*(First Part)*

#### Arrangement of Sections

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<sup>1)</sup> Communicated by the Industrial and Commercial Property Registration Office, Dublin.

<sup>1)</sup> This Arrangement has so far been ratified by France and Czechoslovakia. It will come into force after the fifth ratification [see Article 13 (2) of the Arrangement].

## Section

32. Power of registered proprietor to assign and give receipts.
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72. Transitional provisions.

## FIRST SCHEDULE

*Certification Trade Marks*

## SECOND SCHEDULE

*Transitional Provisions*

An Act to make new provision in respect of trade marks and related matters, in substitution for the provisions of Part IV and (so far as it relates to trade marks) Part V of the Industrial and Commercial Property (Protection) Act, 1927, and other enactments relating thereto, and to provide for other matters connected with the matters aforesaid [3<sup>rd</sup> April, 1963].

Be it enacted by the *Oireachtas* as follows:

## PART I

## Preliminary and General

*Short title and commencement*

1. — (1) This Act may be cited as the Trade Marks Act, 1963.

(2) This Act shall come into operation on such date as the Minister may by order appoint.

*Interpretation*

2. — (1) In this Act, unless the context otherwise requires:

"the Act of 1927" means the Industrial and Commercial Property (Protection) Act, 1927;

"assignment" means assignment by act of the parties concerned;

"the Controller" means the Controller of Industrial and Commercial Property appointed under the Act of 1927;

"the Court" means the High Court;

"the Journal" means the *Official Journal of Industrial and Commercial Property*;

"limitations" means any limitations of the exclusive right to the use of a trade mark given by the registration of a person as proprietor thereof, including limitations of that right as to mode of use, as to use in relation to goods to be sold (or otherwise traded in) in any place within the State, or as to use in relation to goods to be exported to any market outside the State;

"mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof;

"the Minister" means the Minister for Industry and Commerce;

"the Office" means the Industrial and Commercial Property Registration Office established under the Act of 1927;

"partnership" has the meaning assigned to it by section 1 of the Partnership Act, 1890;

"permitted use" has the meaning assigned to it by paragraph (b) of subsection (1) of section 36 of this Act;

"prescribed" means, in relation to proceedings before the Court, prescribed by rules of court, and, in other cases, prescribed by this Act or the rules;

"the register" means the register of trade marks kept under this Act;

"registered trade mark" means a trade mark that is actually on the register;

"registered user" means a person who is for the time being registered as such under section 36 of this Act;

"the rules" means rules made by the Minister under section 3 or section 44 of this Act;

"trade mark" means, except in relation to a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as pro-

prietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered under section 45 of this Act;

“transmission” means transmission by operation of law, devolution on the personal representative of a deceased person, and any other mode of transfer not being assignment.

(2) (a) In this Act references to the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark, and references to the use of a mark in relation to goods shall be construed as references to the use thereof upon, or in physical or other relation to, goods.

(b) In any other Act references to a trade mark shall be construed as references to a trade mark under this Act.

#### *Power of Minister to make rules*

3.— (1) The Minister may from time to time make such rules, prescribe such forms and generally do such things as he thinks expedient:

- (a) for regulating the practice under this Act, including the service of documents;
- (b) for classifying goods for the purposes of registration of trade marks;
- (c) for making or requiring duplicates of trade marks and other documents;
- (d) for securing and regulating the publishing and selling or distributing, in such manner as the Minister thinks fit, of copies of trade marks and other documents;
- (e) generally, for regulating the business of the Office in relation to trade marks and all things by this Act placed under the direction or control of the Controller or of the Minister;
- (f) for prescribing any matter referred to in this Act as prescribed or to be prescribed.

(2) Rules made under this Act shall, while in force, be of the same effect as if they were contained in this Act.

(3) Every rule made under this Act shall be advertised twice in the Journal, and shall be laid before each House of the Oireachtas as soon as may be after it is made and if a resolution annulling the rule is passed by either House within the next subsequent twenty-one days on which that House has sat after the rule is laid before it, the rule shall be annulled accordingly but without prejudice to the validity of anything previously done thereunder.

#### *Fees*

4.— (1) There shall be paid in respect of applications, registrations, notices, notifications, statements, counter-statements, amendments, renewals, cancellations, declarations, certificates, certified copies, entries and other matters in relation to trade marks under this Act such fees as may from time to time be prescribed by the Minister with the sanction of the Minister for Finance.

(2) All fees prescribed under this section shall be collected and accounted for in such manner as the Minister with the sanction of the Minister for Finance shall direct.

(3) The Public Offices Fees Act, 1879, shall not apply in respect of any fees payable under this Act.

#### *Exercise of powers of Minister*

5.— All things required or authorised under this Act to be done by, to or before the Minister may be done by, to or before the secretary of the Department of Industry and Commerce or any person authorised in that behalf by the Minister.

#### *Excluded days*

6.— Whenever the last day fixed by this Act for doing anything under this Act falls on a day which is specified by the rules as an excluded day, the rules may provide that the thing may be done on the next subsequent day which is not specified by the rules as an excluded day.

#### *Expenses*

7.— The expenses incurred by the Minister in the administration of this Act shall, to such extent as may be sanctioned by the Minister for Finance, be paid out of moneys provided by the Oireachtas.

#### *Repeal and savings*

8.— (1) The following sections of the Act of 1927, namely, sections 3 and 9 (in so far as they refer to trade marks), 80 to 123, and (in so far as they refer to trade marks) 124, 125, 127 to 138, and 140 to 153, are hereby repealed.

(2) Nothing in this Act shall affect any order, rule, regulation or requirement made, table of fees or certificate issued, notice, decision, determination, direction or approval given, application made, thing done or trade mark or mark registered under the Act of 1927; and every such order, rule, regulation, requirement, table of fees, certificate, notice, decision, determination, direction, approval, application, thing, trade mark or mark, shall, if in force at the commencement of this Act, continue in force and shall, so far as it could have been made, issued, given, done or registered under this Act, have effect as if made, issued, given or done under the corresponding section of this Act.

(3) Any document referring to any enactment repealed by this Act shall be construed as referring to the corresponding section of this Act.

## **PART II**

### **Provisions relating to Registration**

#### *The register of trade marks*

9.— (1) There shall continue to be kept at the Office for the purposes of this Act a book called the register of trade marks, wherein shall be entered all registered trade marks with the names, addresses and descriptions of their proprietors, notifications of assignments and transmissions, the names, addresses and prescriptions of all registered users, disclaimers, conditions, limitations, and such other matters relating to registered trade marks as may be prescribed.

(2) The register shall continue to consist of two parts called respectively Part A and Part B.

(3) The register shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed.

(4) The register shall be kept under the control and management of the Controller.

(5) The register may, in lieu of being kept in the form of a book, be kept in such other form of record as may from time to time be approved by the Minister.

*No action for infringement of unregistered trade mark*

10.— No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark, but nothing in this Act shall be deemed to affect rights of action against any person for passing off goods as the goods of another person or the remedies in respect thereof.

*Registration to be in respect of particular goods*

11.— A trade mark must be registered in respect of particular goods or classes of goods, and any question arising as to the class within which any goods fall shall be decided by the Controller.

*Right given by registration in Part A and infringement thereof*

12.— (1) Subject to this section, and to sections 15 and 16 of this Act, the registration (whether before or after the commencement of this Act) of a person in Part A of the register as proprietor of a trade mark (other than a certification trade mark) in respect of any goods shall, if valid, give or be deemed to have given to that person the exclusive right to the use of the trade mark in relation to those goods and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a registered user thereof using by way of the permitted use, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either:

(a) as being use as a trade mark; or

(b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark or to goods with which such a person as aforesaid is connected in the course trade.

(2) The right to the use of a trade mark given by registration as aforesaid shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode, in relation to goods to be sold or otherwise traded in in any place, in relation to goods to be exported to any

market, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(3) The right to the use of a trade mark given by registration as aforesaid shall not be deemed to be infringed by the use of any such mark as aforesaid by any person:

(a) in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark; or

(b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact a connection in the course of trade between any person and the goods.

(4) The use of a registered trade mark, being one of two or more registered trade marks that are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration as aforesaid, shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

*Right given by registration in Part B and infringement thereof*

13.— (1) Except as provided by subsection (2) of this section, the registration (whether before or after the commencement of this Act) of a person in Part B of the register as proprietor of a trade mark in respect of any goods shall, if valid, give or be deemed to have given to that person the like right in relation to those goods as if the registration had been in Part A of the register, and the provisions of section 12 of this Act shall have effect in like manner in relation to a trade mark registered in Part B of the register as they have effect in relation to a trade mark registered in Part A of the register.

(2) In any action for infringement of the right to the use of a trade mark given by registration as aforesaid in Part B of the register, otherwise than by an act that is deemed to be an infringement by virtue of section 14 of this Act, no injunction or other relief shall be granted to the plaintiff if the defendant establishes to the satisfaction of the Court that the use of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the trade mark.

*Infringement by breach of certain restrictions*

14.— (1) Where, by a contract in writing made with the proprietor or a registered user of a registered trade mark, a

purchaser or owner of goods enters into an obligation to the effect that he will not do, in relation to the goods, an act to which this section applies, any person who, being the owner for the time being of the goods and having notice of the obligation, does that act, or authorises it to be done, in relation to the goods, in the course of trade or with a view to any dealing therewith in the course of trade, shall be deemed thereby to infringe the right to the use of the trade mark given by the registration thereof, unless that person became the owner of the goods by purchase for money or money's worth in good faith before receiving notice of the obligation or by virtue of a title derived through another who so became the owner thereof.

(2) The acts to which this section applies are:

- (a) the application of the trade mark upon the goods after they have suffered alteration in any manner specified in the contract as respects their state or condition, get-up or packing;
- (b) in a case in which the trade mark is upon the goods, the alteration, part removal or part obliteration thereof;
- (c) in a case in which the trade mark is upon the goods, and there is also thereon other matter, being matter indicating a connection in the course of trade between the proprietor or registered user and the goods, the removal or obliteration, whether wholly or partly, of the trade mark unless that other matter is wholly removed or obliterated;
- (d) in a case in which the trade mark is upon the goods, the application of any other trade mark to the goods;
- (e) in a case in which the trade mark is upon the goods, the addition to the goods of any other matter in writing that is likely to injure the reputation of the trade mark.

(3) In this section references in relation to any goods to the proprietor, to a registered user, and to the registration, of a trade mark shall be construed, respectively, as references to the proprietor in whose name the trade mark is registered, to a registered user who is registered, and to the registration of the trade mark, in respect of those goods, and "upon" includes in relation to any goods a reference to physical relation thereto.

#### *Saving for vested rights*

15.— Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date anterior:

- (a) to the use of the first-mentioned trade mark in relation to those goods by the proprietor or a predecessor in title of his; or
- (b) to the registration of the first-mentioned trade mark in respect of those goods in the name of the proprietor or a predecessor in title of his;

whichever is the earlier, or to object (on such use being proved) to that person being put on the register for that identical or nearly resembling trade mark in respect of those goods under subsection (2) of section 20 of this Act.

#### *Saving for use of name, address or description of goods*

16.— No registration of a trade mark shall interfere with:

- (a) any *bona fide* use by a person of his own name or of the name of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business; or
- (b) the use by any person of any *bona fide* description of the character or quality of his goods, not being a description that would be likely to be taken as importing any such reference as is mentioned in paragraph (b) of subsection (1) of section 12, or in paragraph (b) of subsection (3) of section 45, of this Act.

#### *Distinctiveness requisite for registration in Part A*

17.— (1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:

- (a) the name of a company, individual, or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in paragraphs (a), (b), (c) and (d) of this subsection, shall not be registrable under this paragraph except upon evidence of its distinctiveness.

(2) For the purposes of this section "distinctive" means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(3) In determining whether a trade mark is adapted to distinguish as aforesaid the Court or the Controller (as the case may be) may have regard to the extent to which:

- (a) the trade mark is inherently adapted to distinguish as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

#### *Capability of distinguishing requisite for registration in Part B*

18.— (1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor

of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(2) In determining whether a trade mark is capable of distinguishing as aforesaid the Court or the Controller (as the case may be) may have regard to the extent to which:

- (a) the trade mark is inherently capable of distinguishing as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

*Prohibition of registration of deceptive and certain other matter*

19.— It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of law, or would be contrary to law or morality, or any scandalous design.

*Prohibition of registration of identical and resembling trade marks*

20.— (1) Subject to subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark be-

longing to a different proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion.

(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or the Controller make it proper so to do, the Court or the Controller (as the case may be) may permit the registration of trade marks that are identical or nearly resemble each other in respect of the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as the Court or the Controller (as the case may be) may think it right to impose.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks that are identical or nearly resemble each other, in respect of the same goods or description of goods, the Controller may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or by the Court on an appeal, as the case may be:

Provided that where separate applications by different persons to be registered as proprietors respectively of trade marks that are identical or nearly resemble each other are made on different dates, the Controller may refuse to proceed with the second or later of those applications until the first application shall have been determined, and that the trade mark the subject of the first application shall, if that trade mark is thereupon registered, be deemed to be a trade mark already on the register under subsection (1) of this section in relation to the trade mark the subject of the second or later application.

(To be continued)



## GENERAL STUDIES

### The Industrial Property Revolution in the Common Market and the United States<sup>1)</sup>

By David L. LADD, Commissioner of Patents, Washington

A truly great revolution — be it in politics, science, economics or whatever other human activity — affects people far beyond its focal point. The revolution that has started among the members of the European Economic Community in the field of industrial property law is no exception. Its effects are felt, and are going to be felt in increasing measure, in all countries of the world in which industrial property is protected. The fact that here in America, a country which did not participate in the drafting of the proposed European Patent Convention, we are holding this conference, shows that we are fully aware of the significance of the work of our European colleagues.

This work is one for which we have great admiration. Although one might disagree with some details of the Draft, there is no doubt in my mind that it is the clearest, the best thought through, the most imaginative proposal for a supranational patent law that has been formulated thus far. Whatever the fate of this document — a matter depending to some extent on the uncertainties of politics — it will always stand as a monument to the legal and professional skill and wisdom of the men who drafted it, and particularly to Dr. Haertel who directed the Working Party on Patents to its goal in such a remarkably short time.

He and others, far more qualified than I to speak about the details of the Draft Convention, will do so in the course of this conference. I, as an American, propose to speak on three questions of immediate interest to us Americans, and indeed to all those who are outside the European Economic Community.

The three questions are: first, the availability of the European patent; second, accession to the Convention and association with it; and, third, its general inspirational effect towards more international cooperation in the field of industrial property.

#### Availability

The first question I propose to deal with, the question of availability, sometimes called the question of accessibility. I find the latter term ambiguous and shall try to avoid it since "accessibility", when employed in connection with a treaty or convention, usually brings to mind the question of whether a country may accede — that is, become a party — to the

treaty or convention. This is not the question I shall discuss now — although I shall come to it later.

The question I propose to examine now is whether nationals of countries not parties to the future Convention should or should not be entitled to obtain a European patent. In other words, whether European patents should be available to them. It is dealt with in Article 5 of the Draft.

As most of you probably know, this is one of the few questions on which the six countries, authors of the Draft, were unable to agree. Consequently, Article 5 contains two alternatives.

One of them, the first in the order in which they appear in the Draft, makes no distinctions on the basis of the nationality of the applicant for a European patent. It is similar in this respect to our own patent law under which nationals of any country have the right to apply for a U. S. patent. As far as I know, the patent laws of all other countries follow the same principle. Since this alternative of Article 5 makes no distinctions on the basis of the applicant's nationality, European patents could — under the first alternative — be obtained by nationals of non-contracting as well as contracting countries.

The second alternative would make a European patent available only to nationals of the contracting countries, and then only if they first file an application for a national patent in one of the contracting countries.

A footnote to the Draft indicates that intermediate solutions between the two alternatives may be envisaged. There is no indication what they might consist of. We have heard about only two such intermediate solutions, one being a variant of the first alternative, the other, of the second.

The first would somewhat restrict the first alternative: nationals not of any country but only of countries members of the Paris Union for the Protection of Industrial Property could apply for a European patent.

The second would somewhat liberalize the second alternative: the condition of first filing in a contracting country would be dropped. This would still mean that only nationals of contracting countries could apply for a European patent.

Most of us in America — why not state it frankly — are surprised and somewhat puzzled by the existence of the proposed second alternative — for both practical and legal reasons.

On the practical level, we are perplexed by such questions as whether the maintenance, *ad infinitum*, of national patents and national patent offices is not the very thing the European patent system is intended to eliminate. Under the second alternative, they could, of course never be eliminated since nationals of non-contracting countries could otherwise obtain no protection whatsoever. Are the contracting countries prepared to assume the heavy financial obligations of maintaining dual patent systems indefinitely? We find it difficult to believe that such a situation is envisaged by any of these countries. Be this as it may, I am not going to examine here the *practical* aspects of the second alternative because, after all, this would be to question the wisdom of that alternative and I, as a non-European, certainly do not want to formulate a judgment as to what is or is not practical for Europeans.

<sup>1)</sup> An address by David L. Ladd, Commissioner of Patents, to the "Briefing Conference on Industrial Property Protection, Antitrust Laws, and the European Economic Community", sponsored by the Federal Bar Association, Villanova University, and Georgetown University in cooperation with the Bureau of National Affairs, Inc., the Philadelphia Bar Association, and the Philadelphia Patent Law Association, on 1st April, 1963.



But the question of law is a different matter because it is a question of the rights and obligations of the Member States of the Paris Union of which the United States and some 44 other non-E. E. C. countries are also members.

May I advance the opinion — and try to support it in a minute — that the second alternative raises serious questions in relation to the Paris Convention. I know that many share this opinion. The arguments are also more or less well-known but perhaps it will be useful for our later discussions to refer briefly to some of them here.

The main argument is that the Paris Union requires national treatment, that is, simply stated, it requires that each Paris Union member country must grant the same industrial property protection to nationals of all the other member countries as it grants to its own nationals.

Thus, if the European Patent Convention is to provide that European patents will have effect in *all* the contracting countries, and, therefore, *also in the contracting country of which the patentee is a national*, then the only way to place Paris Union nationals of non-contracting countries on the same footing is to make the European patent available also to them. For example, we all know that some provisions of the European Patent Convention differ in a number of respects from the provisions of the national laws of one or more of the individual E. E. C. countries and, in at least some cases, are more liberal than the national laws. Further, when the European Patent Convention comes into being the contracting countries will offer to their nationals a choice of two ways to protect their inventions whereas the nationals of non-contracting countries will have only one way available to them, that is, protection under the national laws. Thus, significant questions of both a substantive and procedural nature are raised by the second alternative in relation to the national treatment provision of the Paris Convention.

It has been advanced against this argument that the Paris Convention expressly permits Paris Union members to conclude special agreements not contravening the provisions of the Paris Convention; that some of them did conclude the Madrid Agreement on the international registration of trade marks and The Hague Agreement on the international registration of designs; that these Agreements were of the same nature as the proposed European Patent Convention; that the Madrid and The Hague Agreements were never held to be in contravention to the Paris Convention; *ergo*: The European Patent Convention cannot be considered as contravening the Paris Convention.

Assuming that the Madrid and The Hague Agreements do not contravene the Paris Convention, the validity of this argument turns on the question of whether it is really true that their nature is the same as that of the proposed European Patent Convention.

Those who say that this similarity exists argue that the two Agreements provide, as would the European Convention, procedures in an international office to replace procedures in the several national offices.

In our opinion, however, the procedures in question are simply not comparable. Deposit and registration are not the same as the grant of a patent. Furthermore, the international

registration of trade marks or designs is, or may be subjected to, scrutiny and non-recognition in a member country, whereas the European patent could not be subjected to scrutiny and non-recognition in the member countries.

But perhaps an even more important difference is that the substantive law of protection is governed by the national laws even if the trade mark or design has been internationally registered, whereas the substantive law of protection of inventions would, under the European Convention, be governed by the Convention itself and not by national patent laws.

In the countries parties to the two Agreements protection is governed by the domestic laws, and such protection is the same for nationals and non-nationals of countries parties to the Agreement. The difference exists merely in that some may obtain it in either of two ways — domestic or international registration — whereas others may obtain it only through domestic registration. But under the proposed European system there would be two kinds of protection in each member country: a protection provided in the domestic law and a different protection provided in the Convention which, significantly, bears the title “Convention Relating to a European Patent Law”. The second alternative of Article 5 of the Draft would exclude nationals of non-members from the protection provided in each member country for its own nationals under the Convention. Thus the requirement of granting the same protection to nationals and foreigners, as prescribed by Article 2 of the Paris Convention, would not be met.

One more point under the problem of availability — as proposed in the second alternative.

I want to refer to the requirement that before an applicant may apply for a European patent he first has to file in the national patent office of one of the contracting countries.

In my opinion, such a requirement flies in the face of the priority principle of the Paris Union — a principle which is second only to — unless it is equally important as — the national treatment principle. The provision in the second alternative is a negation of the priority principle as it has generally been understood since the Union came into being. If each and every one of the 51 member countries of the Paris Union could ask for *first* filing in its national office — and why not if the countries parties to the European Convention could — nothing would be left of the possibility secured to all applicants under the Paris Convention of filing first at home, and within a year abroad.

Thus, it appears that the second alternative of Article 5 would for all practical purposes discard *both* fundamental principles of the Paris Union: national treatment and priority. If this is what is going to happen we shall find that we are back in that same disorder from which our ancestors — 80 years ago — successfully emerged when they founded the Paris Union.

#### Accession and Association

Let no one think, however, that we believe that the second alternative of Article 5 is characteristic of the Draft Convention.

Quite the contrary is true.

The first alternative of the same Article — even if it is to be restricted to nationals of Paris Union countries — as

well as several other provisions of the Draft reflect a truly outward looking philosophy.

To begin with, it is nowhere said in the Draft that the original contracting states will be the members of the European Economic Community. Although political realities make such a beginning likely, the Draft, as it stands, would make it legally possible to start with more countries or less countries than the present six full members of the E. E. C.

But whatever the number and identity of the first adherents, additional countries may accede to the Convention if they are members of the Paris Union. Article 211 of the Draft provides for this possibility. A footnote to this Article indicates a further difference of opinion among the drafters: some of them would restrict accessibility to the European members of the Paris Union, whereas others would be ready to admit non-European countries as well, if they are members of the Paris Union. In any case, accession would require a unanimous decision of the countries already party to the Convention. Consequently any such country could veto the joining of any applicant for admission.

In addition to accession, the Draft provides for the possibility of what it calls association. As in the case of accession only Paris Union countries could apply for association, and the terms of association would have to be unanimously approved by the full members.

Professor Roscioni, Director of the Italian Patent Office, during a visit to the United States last fall, informally suggested, as have some others, that this Government might wish to study the possibilities of association under Article 212 of the Draft Convention. We are grateful to Professor Roscioni for his suggestion, which exemplifies his broad outlook in the international patent field. However, our informal conversations with Professor Roscioni did not go into the examination of the possible contents of association. The Draft contains no indications as to the conditions and forms of association and I have the impression that this question needs further examination by the United States and — undoubtedly — by other Paris Union countries.

Furthermore, I have the impression that the dividing line between accession and association is not a very definite one since accession, according to Article 211, is subject to a special agreement which presumably could deviate to a certain unspecified extent from the provisions of the basic Convention.

Whatever is the name given to cooperation between full members and other countries, it would be interesting to know more about European views as to the possible modalities of such cooperation.

We can try to imagine what association could consist of. Please note that I am not saying that either the European or we ourselves necessarily hold any of the theoretical possibilities — which I am about to mention — practical or desirable.

One of the theoretical fields of possible cooperation would be the exchange of search results between the cooperating patent offices, for example the future European Patent Office and the U. S. Patent Office. Thus, the European Patent Office and the cooperating patent offices could communicate to each other the citations which are referred to against a given pend-

ing application, if applications from the same person are pending for the same alleged invention before both patent offices at the same time. Such cooperation presupposes, of course, that both patent offices are somehow apprised of the fact that applications concerning the same invention have been filed in both of them. If the applicant in one office relies on the priority date of the filing in the other, the information is automatically available. But how will the office in which the first filing occurred know about the later filing in the other office? Or, if the first filing occurred in a third patent office, how will the two cooperating offices know that the applicant subsequently filed in both of them? There are several possible answers to these questions. Perhaps the simplest one would be to oblige the applicant to indicate all prior filings in other patent offices for the same invention. If one of them was made in a cooperating patent office, the two patent offices could get together and exchange their respective search results.

Another possibility of cooperation would have as its objective to make it easier for an applicant filing in one country to also file in the other. For example, an applicant before one of the cooperating patent offices could request that a copy of his application be forwarded by that office to the other patent office to constitute thereby a filing in the other office. Now, of course, if the languages used in the two patent offices are not the same or if the formalities to be followed in the second patent office are different from the formalities obtaining in the first patent office, it might have to be provided that the applicant has to furnish, within a period of time to be fixed, translations, and has to modify the form of his application in conformity with the law governing the operations of the second patent office. But the transmittal of the copy of his application would at least have the effect of establishing the date of filing in the second patent office.

Still another field of cooperation between or among patent offices is the field of searching. The International Patent Institute of The Hague — in the creation of which our dynamic French colleague, Director-General Finniss, played such an important role — serves as an exemplary prototype. It is imaginable that cooperating patent offices could, in certain fields, entrust to each other the task of searching for prior art. Each office could specialize in certain fields. Or, the search in certain fields, could be entrusted to a third organization, for example the International Patent Institute I just mentioned. In view of the very high and ever increasing cost of searching, a cooperation of this type appears to be most desirable from a budgetary viewpoint. Furthermore, there really is much truth in what has already been said many times by others, namely, that it is a bit silly to waste the engineering and legal talent of our countries by tying down a good many of them merely for the purpose of duplicating each other's work of searching.

#### The Draft's General Impact on International Patent Cooperation

I could go on speculating about the possibilities of cooperation between the future European Patent Office and

other patent offices, but time is running out, and before closing I would like to mention briefly one other topic.

It has to do with the general impact of the European Draft Convention on contemporary thinking about international patent problems.

The running of an efficient patent system, at least a system of the kind we know and to which we are accustomed, becomes more and more difficult. The reasons are well-known, and I shall mention only two of the most important ones. One to which I have already alluded, is the spectacular increase — both in volume and complexity — of technical knowledge that has to be classified, stored and ultimately retrieved in order to determine properly the novelty of an invention. Another, is the difficulty of finding qualified people to serve as examiners in patent offices and, once having found and trained them, the formidable task of keeping them.

Now, if these are problems in the industrially developed countries — and they certainly are in, for example, the United States — then they represent even greater problems in countries industrially less developed.

The European Draft is the prototype of a solution for lessening, if not for completely overcoming, these difficulties. The solution, of course, is international cooperation and, wherever possible, the establishment of supranational patents.

Let us think for a minute about some of the countries of Latin America and Asia and of the newly independent countries of Africa. Is it reasonable to expect that most of these countries can individually develop effective national patent systems? They have a terrible shortage of technically trained people and could hardly spare them for work in patent offices. And most of them simply do not have the money to organize and maintain a patent office of any value. Yet, if they are to develop their national economies, and especially their national industries, they need some kind of legal protection for inventions to attract foreign capital and to encourage their own citizens to invent.

The history of the industrial growth of Europe and the United States indicates that the protection of property rights in inventions is one of the essential preconditions of rapid and spontaneous industrialization — at least in a free society. And I would note that this economic fact is appreciated even in countries like the Soviet Union.

Now, how can appropriate industrial property protection best be provided in the industrially less-developed countries? I suggest to you that this can best be done by pooling the

resources and the talent of these countries, by trying to avoid as much duplication as possible; in a word, by way of international cooperation.

And what better exemplar for international cooperation is there than the European Patent Convention? Many variations of the proposed European patent system may be visualized; and, of course, modifications would be necessary before such a system could be adapted to serve the special needs of the less-developed countries. As to these countries, for example, public policy and economic factors would probably call for more exceptions deferring to national sovereignty than are now found in the Draft European Patent Convention.

I may add that for some of these countries a patent system of the examination type may be totally inappropriate. But whatever their preference, the point I wish to make is that international cooperation in the protection of industrial property is the key, and the European Patent Convention is the one great model for such cooperation.

The industrially developed countries with a long experience in industrial property law should be ready to assist the less developed and, in this field, less-experienced countries. We have here a matter which urgently needs to be studied. Imaginative, yet practical solutions are demanded. The existing machinery of the Paris Union — its committees and its secretariat — should be mobilized. The great number of countries — many of them newly independent — wishing to develop their industrial capacity, the difficulties of efficiently and economically running any patent system in view of the growing complexity of the task — these are all challenges and opportunities which require urgent attention and action.

The Draft Convention for a European Patent Law is now, and is going to remain, a constant source of inspiration for closer international cooperation. Even though still only a draft, it has revolutionized modern thinking about the possibilities of such cooperation in the patent field. It is the boldest, the most imaginative proposal of its kind thus far. Most of the countries of the world are probably not yet ready to accept the advanced form of cooperation embodied in the Draft. But there is no doubt that it will set things in motion even outside the six countries which shared the toil and the glory of being its authors, for the significance of their work far transcends the borders of the European Common Market.

All those who look with hope to a bright future of worldwide cooperation in the field of industrial property owe their thanks and congratulations to the authors of the Draft. I am delighted today to be able to offer mine.

## CONGRESSES AND MEETINGS

### III<sup>rd</sup> Meeting of the Committee of Experts on the International Protection of Type Faces

(Geneva, 19<sup>th</sup> to 23<sup>rd</sup> November, 1962)

Report by Th. Lorenz and J.-L. Marro

#### I

In accordance with the recommendation expressed by the Committee of Experts charged with studying the international protection of type faces during its second Meeting from 26<sup>th</sup> February to 2<sup>nd</sup> March, 1962, this Committee has continued its work in Geneva, from 19<sup>th</sup> to 23<sup>rd</sup> November, 1962, under the chairmanship of Mr. J.-N. de Bavinchove (France).

The Committee of Experts was composed as follows:

#### Germany

Mr. E. Born, Verbands-Geschäftsführer, Offenbach/Main.  
Mr. G. Schneider, Regierungsdirektor, Bundesjustizministerium, Bonn.

#### Austria

Mr. Th. Lorenz (Rapporteur), Oberkommissär des Patentamtes, Bundesministerium für Handel und Wiederaufbau, Referat Gewerblicher Rechtsschutz, Vienna.

#### Spain:

Mr. E. Rua Benito, Jurist, Head of Section, Registry of Industrial Property, Madrid.

#### United States of America

Mr. G. A. Tesoro, Counsellor, U. S. Mission to International Organizations, Geneva.

#### France

Mr. J.-N. de Bavinchove (President), Civil Administrator, Ministry of Industry (Institut national de la propriété industrielle), Paris.

#### Greece

Mr. A. Petropoulos, Permanent Delegate of Greece to International Organizations, Geneva.

#### Italy

Mr. M. Lorusso, Secretary of the Association of Italian Constructors, Rome.  
Mr. P. Marchetti, Central Patent Office (Ministry of Industry and Commerce), Rome.

#### Luxembourg

Mr. J. Mersch, Vice-President of the Association of Master Printers of the Grand Duchy of Luxembourg.

#### Mexico

Mr. A. de Icaza, Secretary of the Mexican Diplomatic Service, Permanent Delegation of Mexico to International Organizations, Geneva.

#### Netherlands

Mr. G. W. Ovink, Amsterdam.  
Mr. W. M. J. C. Phaf, Head of the Legal Section of the Ministry of Economic Affairs, The Hague.  
Mr. E. van Weel, Member of the Patent Council, The Hague.

#### United Kingdom

Mr. J. G. Dreyfus, Typographical advisor to the University Press, Cambridge, and to the Monotype Corporation, London.  
Mr. W. E. C. Richards, H. M. Patent Office, London.

#### Switzerland

Mr. A. Hoffmann, Vice-Director, Fonderie de caractères Haas S. A., Münchenstein (Bâle-Campagne).  
Mr. A. Kundig, Master Printer, Observer of the International Bureau of Patron Federations of Graphical Industries, Geneva.  
Mr. J.-L. Marro (Rapporteur), Assistant to the Federal Bureau of Intellectual Property, Berne.

The Administrations from *Belgium* and *Yugoslavia* were excused.

Various international organizations were also represented, as follows:

#### International Typographical Association

Mr. Ch. Peignot, President.  
Maître G. Poulin, Legal Counsel.

#### International Association for the Protection of Industrial Property

#### International Chamber of Commerce

#### International Law Association

Maître Ed. Martin-Achard.

#### International League against Unfair Competition

#### International Union of Lawyers

Maître J. Guyet.

The International Bureau for the Protection of Industrial Property was represented by:

Mr. G. Ronga, Counsellor, Chief of Legal Division.  
Mr. G. R. Wipf, First Secretary, Legal Division.  
Mrs. I. Soutter, Secretary, Legal Division.

The International Literary and Artistic Association, which had also been invited, were unable to be present.

#### II

The programme of the meeting comprised essentially the study of a Draft Arrangement and Regulations for its Application, and the study of a Draft Additional Protocol to The Hague Arrangement concerning the International Deposit of Industrial Designs or Models. These three drafts had been prepared in Geneva, from 27<sup>th</sup> May to 1<sup>st</sup> June, 1962, by the International Bureau in collaboration with, and under the direction of the President of the Committee of Experts, Mr. J.-N. de Bavinchove, and on the basis of the basic rules established by the same Committee at the beginning of the year (see Document PJ/13). Finally, the Committee of Experts had

been convened to state its preference for one of the two possible forms of diplomatic instrument, while the final decision thereon remained with the interested Governments.

### III

The meeting of the Committee was opened by Mr. Ch.-L. Magnin, Vice-Director of the International Bureau, who welcomed the experts and expressed his satisfaction with the results obtained thus far. He recalled that the Committee had started from zero with the study of new problems on the subject of typography, the solution of which has not as yet clearly emerged. He emphasized that the procedure becomes increasingly important as the work draws to its close. Finally, he proposed that the drafts prepared by the Committee be transmitted, as is the custom, to the Governments of the Member States of the Paris Union, who will have to formulate their observations and will be invited to form a committee of governmental experts to draw up in final form the documents which thereafter will be submitted to a diplomatic conference.

The Committee was then addressed by Mr. J.-N. de Bavinchove, acting as president, who briefly summarised the work of the previous meetings of the Committee and recalled that, thanks to the contribution made by each participant, considerable progress had been achieved in working out a scheme of international protection for the creators of new typographical characters and for the protection of their work against infringement which is undoubtedly facilitated by the evolution and development of modern techniques of photographic reproduction. In the absence or owing to the insufficiency of protection afforded by national and international legislation, this danger was even greater since, accurate delimitation being difficult, industrial models and creations of applied art were protected sometimes by special legislation on models, sometimes by copyright legislation and sometimes even by both. In the view of the president, it was necessary to protect a creation which is not, in the real sense of the word, a work of art, but which is derived from it. In fact, the initial design, a work of art in itself, was transformed when it became a type face and thus passed from the stage of a work of *pure art* to the stage of art applied in industry.

Mr. de Bavinchove showed that the complexity of the problem lies precisely in the transfer of the work of the artist to the industrial field which puts the typographical industry in an exceptional and unique position and gives it a hybrid aspect which has up to now required the simultaneous application of copyright, applied art and industrial property protection.

During its previous sessions the Committee of Experts had recognised that the original idea of the artist ought to be maintained and protected on its adaptation to the industrial field, and had thus been prompted to elaborate a new law, a law somewhat *sui generis*, adapted to a definite category of industry which by its very nature is based partly on copyright, on account of a certain artistic degree of its works, and partly on the subject of models and designs, by reason of its character of industrial application.

Mr. de Bavinchove recalled that the substantive law, which had thus been gradually elaborated, respects the general prin-

ciples of industrial property rights and protects the legitimate interests of the designing artists and those casting the type faces, since the typographical characters are first designed by graphic artists and then cast in accordance with the processes of modern industrial technique. In this way, the typographical industries could be given equitable and effective protection, safeguarding at the same time the interests of the makers and the requirements of the public interest.

Mr. de Bavinchove congratulated the Committee for having explored an area which was as yet little or not very well known and had hitherto been neglected by jurists, and for having *innovated* in the proper and full sense of the word.

Before concluding, Mr. de Bavinchove thanked the International Bureau for its valuable help, enumerated the tasks still to be accomplished and confirmed that a diplomatic conference would have to be preceded by a meeting of governmental experts to choose the specific form of international instrument.

After adopting the agenda proposed by the International Bureau, the Committee confirmed Mr. de Bavinchove in his function of president and started with its work.

### IV

After a first quick exchange of views on the form of the future international instrument, the Committee examined the draft of an additional protocol to The Hague Arrangement concerning the International Deposit of Industrial Designs or Models and rejected it *unanimously*, by reason of, on the one hand, the absolute incompatibility of several of its clauses with certain fundamental rules of the said Arrangement (particularly as regards the system of sealed deposits, the maximum number of objects which may be included in a deposit and the minimum duration of protection resulting from the international deposit), and on the other hand, the fact that important industrial States are not party to The Hague Arrangement and do not appear desirous of joining it.

This question would, however, be reconsidered at the end of the meeting when the German experts would submit a counter-proposal for an *abbreviated* additional protocol.

### V

The drafts for a special arrangement and regulations for its application which were then studied by the Committee envisaged in their first version the establishment of a protection for type faces — based on the arrangement itself — so as to avoid the necessity of creating national laws which, moreover, might not be uniform.

The drafts envisaged, in fact, that protection would only be ensured by a single international deposit.

During the study of the drafts it was found that there were three basic problems:

(1) In the view of certain experts, the rule of assimilation contained in Articles 2 and 3 of the Convention of the Paris Union would oblige the States of the Union to guarantee to nationals of Unionist countries *not* party to the proposed arrangement, as well as to foreigners who are domiciled or have a fixed and permanent industrial or commercial establishment

in a country of the Union, the same protection as that accorded to nationals. Therefore, it would be necessary either to give such persons the possibility of international deposit, or to provide for national registration in each member country.

(2) In the unanimous view of the experts protection by means of a deposit must be based on the criterion of novelty.

However, the "copyright" system, particularly as in force in the United Kingdom, requires the originality of the work.

The difference between these two concepts, therefore, seems to stand in the way of a uniform system of protection of type faces.

(3) The constitutional systems of certain States do not permit the automatic application of the provisions of Conventions on the national level. In these States, a law is essential for putting them into force. Moreover, it does not appear at all possible to insert into the arrangement itself all the provisions of procedure, competence, etc., so as to make them applicable without the intervention of the national legislator.

The solution of these problems involved a modification of the texts submitted for examination to the Committee of Experts; the latter adopted a system of protection with the following characteristics, comprising two separate groups of the provisions of the Convention:

The first group (Art. 1-8 and 19 of the arrangement) impose on the member States the guarantee of special protection for type faces (Art. 4, para. 1). It contains the basic rules — such as the extent (Art. 7) and the duration of protection (Art. 8) — which establish the minimum protection to be accorded by the member States. The details of the protection (sanctions, procedures, competence, etc.) will have to be decreed by the member States (Art. 4, para. 2).

Articles 4 and 5 leave the States free to ensure protection either by a deposit, or by the mere fact of creation, the first one based on the criterion of novelty, the other on the criterion of originality. These provisions are intended to enable States having different systems of protection to accede to the arrangement. For the rest, all member States undertake to give the term novelty, as set out in Article 6, a strictly identical sense and importance.

The second group of provisions of the Convention (Art. 9 to 18 and 20 of the arrangement, and the implementing regulations) institute the international deposit. This deposit is reserved to nationals of the Contracting States and foreigners having their domicile or a permanent industrial or commercial establishment in a member State (Art. 9, para. 1).

The Committee agreed with the view of the experts who thought that Article 2 of the Paris Convention would oblige the Contracting States to institute a national deposit for nationals of other Unionist countries (Art. 5, para. 1). Exempt from this obligation would be only those Contracting States where type faces are protected on the basis of the "copyright system" (Art. 5, para. 3).

It should be stated at this point that other experts had pointed out that the application of Article 2 of the Paris Convention in a State party to the special arrangement concluded within the framework of this Convention, did not present any problems to the extent that the special arrangement pro-

vided rights identical to those offered by the internal legislation of the State concerned. In effect, in this case the nationals of other Unionist States would benefit from the advantages of the internal legislation in conformity with Article 2 and, consequently, enjoy the same rights as the nationals of the State.

On the other hand, the problem did arise where the special arrangement grants rights not provided by the national legislation. In this case, the national of a non-contracting State would benefit solely from the rights accruing from the internal legislation, but not from the rights derived from the arrangement.

Finally, these experts were of the opinion that the benefit of the special arrangement would not extend to nationals of Unionist States which were not a party to the said arrangement.

The effects of the international deposit will not be identical in all States party to the arrangement; those applying the criterion of novelty will bring the effects of the international deposit in line with those of the national deposit, in conformity with Article 9, para. 3, of the draft. In these States, the effects of the international deposit will vary according to their national legislation.

On the other hand, *in the States applying the criterion of originality and not providing for national deposit, the international deposit itself will produce no direct effects.* However, the Committee of Experts considered that the system provided by the arrangement would not result in a lack of protection in countries applying the rules of "copyright" where the protection is subject exclusively to the originality of the type faces.

## VI

The provisions concerning international deposit and registration are modelled on those of The Hague Arrangement concerning industrial models and designs, as modified on 28<sup>th</sup> November, 1960.

The preparatory documents contained detailed explanations on the drafts of the International Bureau, hence it remains to comment on various modifications or additions made by the Committee.

Thus, in *Article 3*, the term "graphic designs" in the basic rules (Art. 1, para. 2) was deleted, so as to avoid an excessively broad interpretation of the terms "type faces".

*Article 4* should be read in conjunction with Articles 5 and 9, paras. 1 and 2, of the draft of the Committee.

*Article 5* develops the two variants of protection indicated in Article 4, para. 2, and establishes the conditions (novelty and absence of previous rights, or originality).

The deposit mentioned in *paragraph 1* can be national or international, special, or centred on the legislation regarding designs and models. According to certain experts, whose views were shared by the majority of the Committee, the States applying the criterion of novelty should institute a national deposit, having regard to Article 2 of the Union Convention. On the other hand, the effects of a judgment declaring a deposit nul and void (paragraph 2) will be limited to the territory of the State in which this judgment was given.



The "previous deposit" mentioned in *paragraph 2* may be either a *national deposit* made by a national of a State of the Paris Union not party to the special arrangement, or an *international deposit*.

*Paragraph 3* takes into account the special situation of the United Kingdom in regard to the protection of type faces and the efforts made by the British legislation to ensure their protection. In this State, the type faces forming the subject matter of an international deposit will be protected automatically, without deposit, as from the date of their creation, by virtue of the principles of "copyright", provided they are "original" within the meaning of British legislation.

In the other Contracting States, the type faces created by British nationals will be protected, according to the rules of the arrangement, by international deposit.

*Article 6, para. 1*, of the draft of the Committee is imperative for the legislators of the Contracting States protecting type faces by a deposit. It also binds the Contracting States in regard to the validity of national deposits.

The "novelty" within the meaning of this article is *relative*, since the opinion of specialists in the Contracting States only is decisive; however, it could also be maintained that it is *absolute*, since it would be destroyed if type faces were used outside the territory of the restricted Union, provided these type faces were known to specialists of a Contracting State.

*Paragraph 2* enumerates some examples of criteria for the novelty, while leaving its interpretation free to the competent judge who, moreover, will frequently be induced to consult an expert.

*Article 7* of the draft of the Committee prohibits all reproduction, with the exception of that of a third party for his "private use".

The criterion of "commercial purposes" or "for profit" was rejected by the Committee, since it was liable to exclude from the protection certain categories of printed work, particularly that of governmental printing establishments.

As regards the proposal of one expert that the printer should, if he so wished, be permitted to use types purchased from the caster in a size larger or smaller than the original, the experts held that this facility would depend on contracts and customary usage in the profession. Should these admit this facility without the explicit authorisation of the caster, the printers would be at liberty to use the type faces as suited their convenience and no special provision in the Convention would be required. It would be up to the caster to specify if he wished to prevent such use being made of his products by the printers who had purchased them. If the printer disregarded the restriction of use formulated by the caster or imposed by customary usage, he would violate the contract or customary usage and incur the consequences laid down by the national legislation.

*Article 8* on the duration of protection is a provision of substantive law. The States are free to fix the term of validity of the national deposit and the renewals as they deem fit. The only condition imposed on them is that the minimum total term of protection granted the deposit should not be less than twenty-five years. In the States where the legal effect of sealed

deposits is not recognised, the minimum term of 25 years shall be counted as from the date of the sealed deposit, and not as from the date of opening of the seal. The term of 25 years constitutes a compromise between the explicit "vœux" expressed by the International Typographical Association (minimum 35 years) and the term of 15 years requested by various States and provided in the additional protocol to The Hague Arrangement as revised in 1960.

*Article 9* defines the persons entitled to make the international deposit, as well as the State of origin, in conformity with the provisions of The Hague Arrangement, as revised in 1960. The term "serious" has been replaced by the term "permanent", as it complies better with the requirements.

In *paragraph 3 of Article 10* the Committee has inserted the words "... having legal effect only ...", instead of the formula previously adopted "... will recognise legal effects only ...". In the States availing themselves of the option contained in *paragraph 3*, sealed deposits shall be deemed non-existent up to the time of their opening. It follows that not only shall the type faces forming the subject matter of a sealed deposit be protected only after the opening of the seal, but, moreover, these deposits cannot be considered as "previous deposits" by the national judge, within the meaning of *Article 5, para. 2*, of the Committee's draft.

The provision of *Article 13* stems from *Article 9* of The Hague Arrangement as revised in 1960. In addition, international deposit made for designs and models within the framework of The Hague Arrangement, will give rise to the right of priority provided by *Article 4* of the Paris Convention.

The procedure for renewal, established by *paragraphs 3 and 4 of Article 14*, is taken from *Article 10, paras. 1 and 2*, of The Hague Arrangement, as revised in 1960, except as concerns the term of validity of the renewals, *which will be ten*, instead of *five years*. Although the number of possible renewals of the international deposit is not limited, the depositors will, in fact, have no interest in renewing the deposit beyond the maximum term of protection provided by the Contracting State giving the longest term of protection.

As regards *Article 16*, it is envisaged that, when the reserve fund has reached the amount fixed by the International Committee on Type Faces, the fees charged by the International Bureau shall be reduced accordingly, so as not to exceed the ceiling fixed. This method was preferred to that previously envisaged of returning the surplus of receipts to the Contracting States.

*Article 20* describes the powers vested in the International Committee on Type Faces, which conform with those provided by *Article 21* of The Hague Arrangement, as revised in 1960, for the International Committee on designs or models.

## VII

### *Special provisions (cf. Annex 1)*

The draft arrangement of the International Bureau envisaged a provision stating that type faces deposited as designs or models pursuant to The Hague Arrangement could ultimately, upon the explicit request of the depositor, made within a limited period of time, be deposited internationally on the



basis of the projected arrangement. Under the terms of this provision, the legal effects of this new international deposit would not affect the former international deposit as regards States party to The Hague Arrangement but not party to the new arrangement.

A number of experts opposed such a provision which would give to deposits made previously on the basis of The Hague Arrangement protection in States which are party to the new arrangement but not to The Hague Arrangement and thus compel casting works in those States to give up the use of type faces which they had hitherto legitimately used.

Nonetheless, the Committee of Experts has admitted the provision proposed by the International Bureau, but inserted a reservation concerning the effects of deposits which stem from deposits previously made under The Hague Arrangement: these deposits under the new arrangement would have no effect in States which were not party to The Hague Arrangement when they become party to the new arrangement.

### VIII

The Committee also studied the draft Implementing Regulations prepared by the International Bureau. This draft, which concerns the working of the office for the international deposit of type faces, is in harmony with the administrative rules already adopted by similar bodies.

The Committee made a few modifications of a formal character to this draft, while leaving open the amount of fees (cf. tariff attached to the Regulations) for the various operations to be performed by the said office.

After discussion, the Committee completed or modified the draft of the International Bureau particularly on the following points:

- (a) the application for deposit may contain samples of the type faces or their reproductions; this, however, is optional and not compulsory (Art. 1, para. 2 d);
- (b) while there is no prescribed size for the samples or reproductions of the type faces to be deposited, a maximum size has been prescribed for documents for publication in the *International Bulletin for Type Faces*; this is because publication must be identical in size to the deposited documents (Art. 2).

### IX

Shortly before the end of its meeting, the draft of an abbreviated counter-proposal for an additional protocol to The Hague Arrangement was submitted to the Committee by the experts of the German Federal Republic. The authors of the counter-proposal had sought to eliminate the principal objections formulated by the Committee on the occasion of the study of the draft protocol submitted by the International Bureau.

The counter-proposal of the German Delegation provided that the option of postponing the publication envisaged by Article 6 of The Hague Arrangement, as revised in 1960, be extended from twelve months to three years, so as to take into account the special needs of the typographical industry. On this point the experts pointed out that the States party to

The Hague Arrangement and not party to the additional protocol could request the International Bureau to make publication within the twelve months following the deposit. Consequently, if the publication was postponed for a further two years in accordance with the German counter-proposal, The Hague Arrangement would be violated as regards these States. On the other hand, if the International Bureau published the registration within the twelve months, then the option of postponement for three years, as proposed by the German experts, would remain a dead letter.

In view of this obvious incompatibility, the German experts withdrew the relevant provision of their counter-proposal which does not now, contain any rule of substantive law, with the exception of a clause fixing the term of protection for type faces at a *minimum* of twenty-five years.

### X

Before closing the meeting, the Committee discussed the question of the form of the new international instrument: a special arrangement within the framework of Article 15 of the Paris Convention, or an additional protocol to The Hague Arrangement.

The great majority of the experts indicated their preference for the special arrangement. In fact, it was stated that any form of additional protocol presented the difficulty that States not party to The Hague Arrangement, to which this protocol would of necessity be added, would be excluded.

In the view of certain experts, the conditions laid down in Article 26 of The Hague Arrangement, as revised in 1960, could be liable to impede the coming into force of this instrument and, consequently, of an additional protocol concerning type faces.

The representatives of the typographical industry pointed out that the German counter-proposal for an additional protocol did not meet the special requirements of protection for their activity. In their view, an effective protection on a limited territory was preferable to a lesser protection on a larger territory. The prolongation of the term of protection, as envisaged in the German counter-proposal, did not of itself suffice to bridge all the gaps in the protection of type faces based on the legislation on designs and models. In particular, the term of one year for secrecy appeared too short to them. They concluded that only a special arrangement would be appropriate to the essential needs of the typographical industry, for such an instrument could clearly define the extent of the protection and guarantee a more satisfactory term of secrecy without limiting the number of signs or symbols contained in a deposit. Moreover, it would permit the accession of all Member States of the Paris Union, whichever their system of protection (deposit or "copyright"). Lastly, since the entry into force of a special arrangement was subject to the ratification or accession of only three States, this could be brought about in the near future.

The majority of the experts agreed with the various points stated above in favour of a special arrangement.

The German experts replied that a special arrangement, with its provisions of substantive law which are numerous and complicated in application, would require the elaboration of

new laws and special administrative machinery for the national deposit of type faces. The question could thus arise as to whether these innovations were not too extensive in relation to the limited section of industry to be protected. On the other hand, the adoption of an additional protocol would present the advantage of not involving important modifications to the national legislations: it would suffice that the term of protection of type faces be fixed at a minimum of twenty-five years. The German experts emphasised further that the States would more readily adopt an additional protocol which would allow them to maintain the system of protection already in force in their territory for designs and models and that, therefore, an additional protocol would become a reality more quickly than a special arrangement.

## XI

At the conclusion of its work, the Committee stated that a large majority of its members recommended the adoption of a special arrangement.

The Committee recommended that the Member States of the Paris Union be invited by the International Bureau to state their position in regard to the draft of the special arrangement and the regulations for its application, as well as in regard to the German counter-proposal for an additional protocol. In this way, the States would have before them more complete information on which to base their opinion on the basic question of the form to be given to the international instrument.

Consequently, the Committee expressed the wish that the International Bureau forward the above mentioned documents, together with this report, to the Member States of the Union, so as to enable them to state their observations and proposals.

Geneva, 21<sup>st</sup> February, 1963.

### **Draft Arrangement of . . . . . for the Protection of Type Faces and the International Deposit thereof (Of . . . . ., 196 . .)**

The Contracting States,

Taking into consideration the Recommendation made on November 28<sup>th</sup>, 1960, by the Diplomatic Conference for the Revision of the Arrangement of The Hague on the International Deposit of Industrial Designs or Models;

Conscious of the fact that the present international Conventions and national legislation governing the Protection of Intellectual Property no longer conform to the special requirements necessary for the adequate protection of newly invented type faces;

Moved by the desire to assure such adequate protection of type faces on an international basis;

Considering that rules of substantive law should be drawn up to that end, and, on the other hand, that an International Deposit should be established;

Referring to Article 15 of the Paris Convention for the Protection of Industrial Property, of March 20<sup>th</sup>, 1883, revised

at Brussels on December 14<sup>th</sup>, 1900, at Washington on June 2<sup>nd</sup>, 1911, at The Hague on November 6<sup>th</sup>, 1925, at London on June 2<sup>nd</sup>, 1934, and at Lisbon on October 31<sup>st</sup>, 1958,

Have agreed as follows:

## Article 1

The States parties to the present Arrangement shall constitute a Separate Union for the International Protection of Type Faces within the framework of the International Union of Paris for the Protection of Industrial Property.

## Article 2

For the purposes of the present Arrangement, the term "Separate Union" shall be understood to mean the International Union constituted by this Arrangement; and the term "Regulations", to mean the Rules governing the execution of the said Arrangement; and the term "International Bureau", to mean the "International Bureau for the Protection of Industrial Property"; and the term "International Deposit", the deposit of type faces with the said International Bureau.

## Article 3

For the purposes of the present Arrangement, the term "Type Faces" shall signify the designs of

- (a) letters and alphabets as such with their accessories (such as accents, numerals and punctuation marks);
- (b) additional signs for reading purposes;
- (c) ornaments (borders, fleurons, vignettes).

## Article 4

(1) Each Contracting State shall undertake to ensure the protection of type faces in conformity with the provisions of the present Arrangement.

(2) If necessary, the said State shall provide its national legislation such measures as shall ensure their enforcement, either by means of a special national deposit or by the extension of the deposit already provided for designs and models by such legislation; or again by other national enactments designed to ensure an analogous protection founded on the criterium of originality, within the meaning of the Berne Convention for the Protection of Literary and Artistic Works.

## Article 5

- (1) National protection is acquired by deposit.
- (2) Any deposit may be declared nul and void by a national court on proof either of absence of novelty or of previous deposit.
- (3) Each Contracting State has the option of declaring, at the time of signature of the present Arrangement or on depositing its Instrument of Ratification or of Accession, that the said State will not apply paragraphs (1) and (2) above, in which case protection shall not be acknowledged by the national court should the exhibit be proved devoid of originality.

## Article 6

(1) Any type face shall be considered new if, at the time of deposit, it shall be deemed to be a newly invented aesthetic

design unknown to specialists in the States parties to the present Arrangement.

(2) The novelty of type faces shall be judged not only in relation to their general aspect and style but also in relation to such technical and aesthetic criteria as are, in particular, hereunder enumerated:

- (a) the relative proportion of the height and the width of the letters;
- (b) the relative proportions between the thick and thin strokes;
- (c) the particular shapes of the serifs and the terminals;
- (d) the spacing between the letters;
- (e) the alignment of type.

#### Article 7

(1) Protection entitles the owner of the right to prohibit any reproduction, whether identical or slightly modified, of the type faces covered by the said protection, without his consent, by any means, form or medium whatsoever, with the exception of reproductions by a third party for his private use.

(2) When the option provided by Article 5 (3) above has been invoked by a Contracting State, protection thereunder shall entitle the owner of the right to prohibit any imitation whatsoever of the type faces under protection.

(3) Protection shall enable the owner to prohibit all reproduction obtained by the distortion of the said type faces by any technical, mechanical, photographic or other means whatsoever.

#### Article 8

The term of protection granted shall not be less than twenty-five years.

#### Article 9

(1) The nationals of the Contracting States or persons who are not nationals of one of the said States, but who are domiciled or who possess a fixed and permanent industrial or commercial establishment in the territory of any one of the said States, shall be entitled to make an international deposit of type faces with the International Bureau in conformity with the provisions of the present Arrangement.

(2) This international deposit shall enjoy protection identical with that provided by the national deposits provided under Article 4 (2) in all States members of the present Arrangement.

(3) International deposits can be made with the International Bureau either

- (a) directly, or
- (b) through the intermediary of the national Administration of a Contracting State providing that the laws of the said State so permit.

(4) The national legislation of each Contracting State may require that all international deposits, in respect of which the said State is held to be the country of origin, be dealt with through the channel of its national Administration. Non-observance of such regulations shall not, however, prejudice the effects of international deposit in the other Contracting States.

(5) Within the meaning of the present Article, the term country of origin shall denote the Contracting State wherein the depositor possesses a fixed and permanent industrial or commercial establishment, or in the event of the possession by the said depositor of similar establishments in more than one of the Contracting States, the Contracting State he shall have designated in his application; if the said depositor has no domicile in any of the Contracting States, then the Contracting State of which he is a national.

#### Article 10

(1) The international deposit of type faces shall be made with the International Bureau under open or sealed deposit.

(2) Sealed deposits shall be opened at the end of a period of three years, or earlier at the request of the depositor or of a competent tribunal.

(3) Each Contracting State has the option of declaring at the time of the signature of the Arrangement or of the deposit of its Instrument of Ratification or of Accession, that a sealed deposit shall be recognized as having legal effect in respect of the said State only as from the date of the opening thereof, and without prejudice to the provisions governing the term of protection.

(4) The deposit may consist of the original design, or any reproductions thereof developed for use in trade, industry or the crafts.

(5) The depositor of an original design shall have the right, on the production of the registration number of his deposit, to complete the said design by reproductions thereof developed for use in trade, industry or the crafts.

#### Article 11

(1) The deposit shall be accompanied by an application for international registration in triplicate, together with the fees, and the documents and declarations, in English or French, as required by the Regulations.

(2) An international deposit shall be considered valid from the date on which the International Bureau receives the application made in proper form together with the fees and all other documentation prescribed by the Regulations; if these are not received simultaneously, the said deposit shall only be valid from the date on which the last formality has been fulfilled.

(3) Upon receipt of an application for a deposit, whether open or sealed, the International Bureau shall immediately record the said application on a special register, and shall publish it in the *Bulletin international des caractères typographiques*, copies of which shall be sent free of charge to the national Administrations of each of the Contracting States.

#### Article 12

(1) Each international deposit of type faces shall be published in the *Bulletin international des caractères typographiques* as soon as possible, and shall include in particular the following items:

- (a) the full reproduction in black and white, or, at the express request of the depositor, in colour, of the type faces;
- (b) the date of the international deposit;

(c) whatever information shall have been prescribed by the Regulations.

(2) Sealed deposits shall only be published on the date of the opening thereof.

#### Article 13

Should an international deposit of type faces be effected within the six months following the prior deposit of the same type faces in one of the States of the Union of Paris, or the first international deposit within the terms of the Arrangement of The Hague, and should priority be subsequently claimed for the international deposit provided for by the present Arrangement, the date of priority shall be the first of the aforesaid deposits.

#### Article 14

(1) The international deposit is valid for a period of fifteen years, with the possibility of renewal for further periods of ten years.

(2) During the first six months of the last year of each period the International Bureau shall send the depositor an unofficial warning of the date of expiry.

(3) Each depositor has the right to prolong the period of deposit of ten years by the payment of the fees prescribed by the Regulations and effected during the last year preceding the expiry of each period.

(4) Six months grace shall be granted in respect of renewals of international deposits upon payment of the surtax provided for by the Regulations.

#### Article 15

Depositors may, at any time, renounce their deposit by making a declaration to this effect addressed to the International Bureau which shall publish it in accordance with Article 11 above.

#### Article 16

The fees charged by the International Bureau shall be allotted

- (a) to meeting the cost of the International Service of Type Faces;
- (b) to the establishment and maintenance of a reserve fund the amount of which shall be fixed and revised by the International Committee on Type Faces set up under Article 20 of the present Arrangement.

#### Article 17

(1) The International Bureau shall enter in its registers any change in rights arising from a deposit of type faces.

(2) These changes in registration shall be subject to a fee fixed by the Regulations.

#### Article 18

(1) The International Bureau shall deliver to any person, upon application and payment of a special fee, a certified copy of the entries on the Register opened in accordance with Article 11 (3) above.

(2) The information shall be accompanied by a certified copy, or, if required, by a reproduction of the type face certified as being in conformity with the open deposit.

#### Article 19

(1) The provisions of the present Arrangement shall authorize the granting of rights wider in scope, that might eventually be enacted by the domestic legislation of the Contracting States, thus making it possible to assure the protection extended to artistic works and works of applied art by the international Conventions and Treaties on Copyright.

(2) The Contracting States which have already granted special protection to type faces shall have the option of stipulating that the benefit of protection already covering designs or models shall not extend, within their territory, to type faces.

#### Article 20

(1) There shall be established an International Committee on Type Faces composed of Representatives of all the Contracting States, in whom shall be vested the following powers:

1. the establishment of Rules of Procedure;
2. amendment of the Regulations;
3. the fixing of the maximum amount of the Reserve Fund referred to in Article 16 (b);
4. the examination of problems relating to the application and possible revision of the present Arrangement and all other questions relating to the international protection of type faces;
5. decisions on the Annual Reports on the work of the International Bureau, and general instructions to the said Bureau on the performance of the duties for which it is responsible in virtue of the present Arrangement;
6. the drawing up of a Report on the estimated expenditure of the Bureau for each forthcoming period of three years.

(2) The decisions of the Committee shall be taken by a four-fifths majority of the members voting.

(3) The Committee shall be convened by the Director of the International Bureau once every three years, or at any time at the request of one third of the Contracting States, or by the Government of the Swiss Confederation.

(4) The travelling expenses and the subsistence allowances of the Members of the Committee shall be borne by their respective Governments:

#### Article 21

The present Arrangement shall be submitted to revision on the proposal of the International Committee on Type Faces.

#### Article 22

(1) Two or more Contracting States shall have the option at any time of notifying the Government of the Swiss Confederation that a common Administration has been substituted for their separate national Administrations and that, consequently, the whole of their territories shall be treated as a single State for the purpose of application of the provisions for international deposit.

(2) This notification shall only take effect after six months from the date of the communication thereof by the Government of the Swiss Confederation to the other Contracting States.

## Article 23

(1) The present Arrangement shall remain open for signature until . . . . .

(2) It shall be ratified and the Instruments of Ratification shall be deposited with the Government . . . . .

## Article 24

(1) States members of the International Union for the Protection of Industrial Property which have not signed the present Arrangement shall be permitted to accede thereto.

(2) This accession shall be notified to the Government of the Swiss Confederation through diplomatic channels, and notified by the said Government to the Governments of all the Contracting States.

## Article 25

(1) The present Arrangement shall come into force after the expiration of a period of one month from the date on which the Government of the Swiss Confederation shall have despatched a notification to the Contracting States of the deposit of three Instruments of Ratification or of Accession.

(2) Thereafter, the Government of the Swiss Confederation shall notify to the Contracting States all further deposits of Instruments of Ratification or of Accession. Such Ratifications and Accessions shall become effective after the expiration of a period of one month from the date of the despatch of such notification, unless, in the case of accession, a later date shall have been indicated in the Instrument of Accession.

## Article 26

The provisions of Article 16<sup>bis</sup> of the Paris Convention for the Protection of Industrial Property shall be applicable to the present Arrangement.

## Article 27

In the event of the denunciation of the present Arrangement, Article 17<sup>bis</sup> of the Paris Convention for the Protection of Industrial Property will apply.

## Article 28

(1) The present Act shall be signed in a single copy and deposited in the archives of the Government of . . . . .

A certified copy thereof shall be forwarded to the Governments of each of the States signatories to, or having acceded to, the present Arrangement.

(2) Official translations of the present Arrangement shall be established in Dutch, English, German, Italian and Spanish.

### Draft Regulations for the Application of the Arrangement of . . . . . for the International Protection of Type Faces

## Article 1

(1) Every application referred to in Article 11 of the Arrangement shall be worded in English or French, and submitted in triplicate on forms issued by the International Bureau.

(2) Each application shall contain:

- (a) the surname, name, or the business name, and address of the applicant; should there be an agent, the latter's name and address (it must be stated to which of the several addresses given the International Bureau is to send all correspondence);
  - (b) a statement setting forth the details required under Article 9 (1) of the Arrangement;
  - (c) the nature of the deposit, namely, whether open or sealed;
  - (d) a list of the documents, and, if necessary, of copies or reproductions accompanying the application, together with a statement of the fees paid to the International Bureau;
  - (e) should the applicant lay claim to the priority referred to in Article 13 of the Arrangement, a statement of the date of the national, or international, deposit, the registration number on which the claim is based, and, in the case of a national deposit, the name of the State.
- (3) The application may be accompanied by:
- (a) a further application for publication in colour;
  - (b) documents supporting any possible priority claim;
  - (c) a statement revealing the name of the true inventor of the type faces which have been deposited.

## Article 2

(1) For publication in black and white, a photograph or other fac-simile of the type faces shall be attached to each of the triplicate forms of application.

(2) For publication in colour, one positive film in colour with colour prints in triplicate of the type faces shall accompany the application.

(3) The documents mentioned in paragraphs (1) and (2) above shall not exceed twelve inches (30 centimetres) maximum width or height.

(4) Publication shall be identical in size to the deposited documents.

## Article 3

Any interested party, who, under the provisions of Article 17 (1) of the present Arrangement, shall request the registration of changes in the rights resulting from the deposit of type faces, must provide the necessary documentary proofs to the International Bureau.

## Article 4

When a court or any other competent authority shall order the communication to it of type faces deposited under seal, the International Bureau, when properly required, shall proceed to the opening of the deposited package, and extract and remit the contents thereof to the authority requiring it. The documentation thus communicated shall be returned in the shortest possible time, and, if necessary, reincorporated in its identical package and sealed up again.

## Article 5

(1) The schedule of fees herewith attached forms an integral part of the present Regulations.

(2) Every depositor shall pay:

- (a) at the time of filing his application for deposit, the international basic fee, and the international publication fee;
- (b) subsequently, and should the contingency arise: the prolongation fee, and the fee for the opening and sealing up again the sealed deposit;
- (c) all fees shall be payable in Swiss francs.

#### Article 6

(1) As soon as the International Bureau shall have received the application for deposit in good and due form together with the total fees payable and the photographs or other fac-simile designs of the type faces, the date of the international deposit, the number of the deposit and the seal of the International Bureau shall be affixed to the three copies of the application and on each of the reproductions, or, in the case of a sealed deposit, on the latter. Each copy of the application shall be signed by the Director of the International Bureau or by the representative he shall have designated for the purpose. One of the copies shall be incorporated in the Register, and shall constitute the official act of registration; the second copy, which shall constitute the registration certificate, shall be returned to the depositor; the third copy shall be transmitted on loan by the International Bureau to any national Administration of a State member of the Arrangement which shall request it.

(2) All prolongations, changes affecting the ownership of the type faces, changes in the name or address of the owner of the deposit or his agent, declarations of renunciation effected in application of the provisions of Article 15 of the Arrangement, shall be recorded and published by the International Bureau.

#### Article 7

(1) The International Bureau shall publish a periodical bulletin entitled the *Bulletin international des caractères typographiques*.

(2) The *Bulletin* shall contain indexes, statistics, and other information of general interest.

(3) Information on selected registrations shall be published in French and English. All information of a general nature shall likewise be published in French and English.

(4) The International Bureau shall transmit, as soon as possible, a free copy of the bulletin to the national Administrations of each of the Contracting States.

Every national Administration shall receive, upon request, a total of five free copies, and ten copies at one third of the normal subscription rates.

#### Article 8

The International Bureau shall dispose of the copies and reproductions in deposit and destroy the files, five years after the date on which the possibility of prolongation has ceased to exist, or on which the deposit shall have been withdrawn or annulled, unless the person shown by the International Register of Type Faces to be the last owner of the deposit, shall have requested their return to him at his expense.

#### Article 9

The present Regulations shall come into force at the same date as the Arrangement.

#### Schedule of Fees

Francs

##### International basic fee:

per deposit . . . . .

##### International publication fee:

— for publication in black and white, per standard space . . . . .

— for publication in colour, per standard space and per colour . . . . .

The standard space corresponds to . . . square inches or . . . square centimetres.

##### International prolongation fee:

— for the first prolongation . . . . .

— for further prolongations . . . . .

— for the surtax referred to in Article 14 (4) of the Arrangement . . . . .

##### For registration and publication

of changes in ownership resulting from a deposit of type faces . . . . .

##### For registration and publication

of changes of names and of addresses . . . . .

##### For the issue of extracts from the Register or the File(s):

per page or fraction of page . . . . .

##### For supplying a copy of the certificate of deposit . . . . .

##### For supplying information contained in the Register:

per hour or fraction of hour for research . . . . .

##### For an identity certificate of a reproduction or fac-simile of the design . . . . .

##### For the opening and the re-sealing of a sealed deposit . . . . .

#### Special Provisions

All type faces deposited in conformity with the provisions of the Arrangement of The Hague of November 6<sup>th</sup>, 1925, on the International Deposit of Industrial Designs or Models, as revised at London during 1934<sup>1)</sup>, shall be admitted to the benefits of the special protection provided under the terms of the Arrangement of . . . . . subject to the following conditions and restrictions, namely that:

- (a) the legal effects of a new international deposit shall be limited to the territories of States that, at the time of signature and ratification of, or accession to, the Arrangement, are already parties to the above-mentioned Arrangement of The Hague;
- (b) a new international deposit shall have been created in accordance with the terms of Articles 9 to 15 of the Arrangement of . . . . . and containing references to the preceding international deposit;

<sup>1)</sup> With the reservation that these underlined words be replaced by the words "as revised at The Hague in 1960" as soon as this last Act of Revision shall have come into force.



- (c) the present deposit shall enjoy the term of protection brought into effect by the Arrangement of . . . . . subject to the deduction of the period between the old and the new deposit;
- (d) the application for a new deposit shall be made within the maximum delay of one year from the date of the ratification of, or accession to, the Arrangement of . . . . . by the State in which the depositor shall have fulfilled the conditions laid down under Article 9 of the said Arrangement;
- (e) from the fees payable for the new deposit there shall be deducted a sum equivalent to the amount still outstanding on the annuities of the former deposit.

**Proposal of the German Delegation  
for a Draft Additional Protocol to the Arrangement  
of The Hague of November 6<sup>th</sup>, 1925,  
on the International Deposit of Industrial Designs  
as revised at The Hague on November 28<sup>th</sup>, 1960**

The States parties to the Arrangement of The Hague on the International Deposit of Industrial Designs or Models which have become parties to the present Protocol hereby agree to the provisions hereunder for the special method of dealing with the international deposits provided for in the Arrangement of The Hague, as revised on November 28<sup>th</sup>, 1960, having for object the industrial designs or models incorporated in type faces.

**Article 1**

Within the meaning of the present Protocol, the term "type faces" comprises designs or models of

- (a) letters and alphabets as such with their accessories, including accents, numerals and punctuation marks;
- (b) additional signs for reading purposes;
- (c) ornaments and borders, fleurons, vignettes.

**Article 2**

With respect to the designs or models referred to in Article 1 above, the period of protection granted by the States parties to the present Protocol to designs or models shall not be less than twenty-five years as from the date fixed by Article 11 (1) (a) or (b) of the Arrangement of The Hague, as revised on November 28<sup>th</sup>, 1960, according to the case.

**Article 3**

(1) The present Protocol shall remain open to signature until . . . . .

(2) It shall be ratified and the Instruments of ratification deposited with the Government of . . . . .

**Article 4**

(1) The States parties to the Arrangement of The Hague on the International Deposit of Industrial Designs or Models, as revised on November 28<sup>th</sup>, 1960, which shall not have signed the present Protocol shall be admitted to accede thereto.

(2) This accession shall be notified to the Government of . . . . . through diplomatic channels, and by the said Government to the Governments of all the Contracting States.

**Article 5**

(1) The present Protocol shall come into force at the expiration of a period of one month dating from the despatch by the Government of . . . . . of the notification of deposit of three Instruments of ratification or of accession, to the Contracting States.

(2) All subsequent deposits of Instruments of ratification and of accession shall be notified to the Contracting States by the Government of . . . . .; such ratifications and accessions shall come into force at the completion of the period of one month, dated from the despatch of the aforesaid notification, unless, in the case of accession, a later date shall have been stated in the Instrument of accession.

## BOOK REVIEW

**Publications on Industrial Property  
added to the Library of the International Bureau  
in April 1963**

*Aspects juridiques du Marché commun (Les)*. Summary records of the seminar organised at Chaudfontaine from 22<sup>nd</sup> to 24<sup>th</sup> May, 1958, with the assistance of Baron J. Ch. Snoy et d'Oppuers and of Messrs. F. Dehousse, P. Pescatore, A. Vander Haeghen, J. Marcotty and G. Van Hecke. Liège, Faculty of Law, 1958. - 25 cm., 157 pages, BF. 150.—. Commission Droit et Vie des affaires. Collection scientifique de la Faculté de droit de l'Université de Liège, vol. 8.

The special interest offered by this study lies in the current considerations of M. A. Vander Haeghen, "chargé de cours" at the Free University of Brussels on the "Repercussions of the Common Market Treaty on Patents, Trade Marks and Models". After reviewing broadly the structure of industrial property which the author classifies under the concept of "Intellectual Rights", M. Vander Haeghen studies the repercussions which will follow the coming into force of the Common Market Treaty on the existing legal system.

BOGUSLAVSKII (M. M.). *Patentnye voprosy v mezhdunarodnykh otnosheniakh - Mezhdunarodnopravovye problemy izobretatel'stva*. Moscow, Izdatel'stvo Akademii Nauk SSSR, 1962. - 20 cm., 343 pages. 1 R. 20 K.

CLAIR (F. X.). *What the new Canadian Law on Trade Marks means to You. A Primer on the Canadian Trade Marks Act of 1954* prepared by the United States Trademark Association, New York, U. S. Trademark Association, 1955. - 23 cm., 12 pages.

The increasingly closer commercial relations between the United States of America and Canada have led the United States Trademarks Association to publish a booklet on the more important provisions of the Canadian Trade Mark Law of 1954. After a short historic introduction, the authors review the requirements and the procedure to be followed for obtaining trade mark protection in Canada.

COMMUNAUTÉ ÉCONOMIQUE EUROPÉENNE. *Avant-projet de convention relatif à un droit européen des brevets élaboré par le groupe de travail "brevets" — Vorentwurf eines Abkommens über ein euro-*



*päisches Potentrecht ausgearbeitet von der Arbeitsgruppe "Patente"* — *Schemo di convenzione sul diritto europeo dei brevetti predisposto dal Gruppo di lavoro "brevetti"* — *Voorontwerp Verdrag betreffende een Europees octrooirecht opgesteld door de werkgroep "octrooien"*. S.l., Coordinating Committee on Industrial Property, 1962. - 29,5 cm., 107 + 107a pages. NF. 9.—

ELLWOOD (L. A.). *Industrial Property Convention and the "telle quelle" Clause (The)*. New York, U. S. Trademark Association, 1956. - 26 cm., [18] pages. Extr. Trademark Reporter, January 1956, pages 36-52.

This is a reproduction of the address given in London by the well-known British expert. The author reviews the history of the principle of the protection of "telle quelle" marks. He points out that at the Diplomatic Conference in 1880, the delegates had been faced with the problem of the Russian Law which only permitted the registration of word marks written in Russian characters. In an exchange of correspondence, between the French and Russian Governments, it had been agreed that marks registered in France could also be deposited in Russia in their original form. The agreement stated, word for word, that "French marks regularly deposited in France would be accepted 'telles quelles' and protected in Russia, even though these were in French". In the author's view, in this context lies the meaning of a clause often misinterpreted.

GEIGEL (Herihant). *Potent- und Gebrauchsmusterrecht. Einführung und Praxis*. Weinheim, Verlag Chemie, 1962. - 22 cm., 407 pages. DM. 28.—. 3rd Edition of Patentfibel.

That this is the third edition of the introduction to the laws on patents and utility models in a relatively short time is sufficient proof of its value. The latest edition is equally justified by the fact that the Appeal and Nullity Sections have been detached from the *Patentamt* (Patent Office) and reorganised in a new Federal Patent Tribunal and now separate, from an organisational point of view, from the Patent Office Courts of First Instance. The inclusion of court decisions is aimed at showing how the legal principles have been applied by the Courts.

GOUDY (Emile). *Concurrence déloyale par dénigrement (De la)*. Lyon, Faculty of Law, 1960. - 27 cm., 186 pages. Thesis.

The author reviews clearly and systematically the different kinds of slander and then goes on to examine the various sanctions which can be applied. In conclusion, he considers that it would be a mistake to attempt to prevent these different kinds of slander by adopting special laws. In the author's opinion, it is a matter for the courts to ensure that the rules of honest trade practices are respected, relying on case law developed over a number of years.

LANGBALLE (P. O.). *Facts in Figures about Patents compiled and condensed in the International Patent Information Code IPIC*. Copenhagen, Hofman-Bang & Boutard, 1955. - 29,5 cm., 27 pages.

The practitioner is often faced with the problem of how to fulfil the requirements for obtaining the protection of an invention in certain countries. There are a series of handbooks published containing information on this subject, but what characterises the study of M. Langballe is the original manner in which he provides the information required. This information is given in the form of figures in a first Part A which covers 43 different countries. The corresponding

meaning of the figures is given in a second Part B. This method of presentation enables patent owners quickly to find the answers to the main problems with which they are likely to be faced.

OCTROOIRAAD. *Aanwinsten Juridische Literatuur van de Bibliotheek Octrooiraad (1953-1962)*. The Hague, Octrooiraad, 1962. - 20 cm., 27 pages.

OFFICE INTERNATIONAL DE LA VIGNE ET DU VIN. *IX<sup>th</sup> International Congress of the Wine and the Vine* (Algiers, 8<sup>th</sup> to 15<sup>th</sup> October, 1959). Alençon, Poulet-Malassis, s. d. - 23 cm., 3 vol., 244 + 773 + 366 pages.

PAKISTAN PATENT OFFICE. *Guide to Inventors and Applicants for Potents in Pakistan (A)*. Karachi, Government of Pakistan, 1961. - 23,5 cm., 33 pages. Preface by S. M. Ahmed, 2<sup>nd</sup> edition.

— *Guide to persons who wish to register designs in Pakistan (A)*. Karachi, Government of Pakistan Press, 1960. - 24 cm., 25 pages. Preface by S. M. Ahmed, 2<sup>nd</sup> edition.

— *Handbook*. Karachi, Government of Pakistan Press, 1962. - 24,5 cm., VIII-311 pages. Preface by S. M. Ahmed, 2<sup>nd</sup> edition.

This handbook consists of a collection of provisions applicable in Pakistan in patent matters. It is further completed by a detailed alphabetical index.

PLAISANT (Marcel). *Etudes sur la propriété industrielle, littéraire, artistiques - Mélanges Plaisant*. Paris, Sirey, 1960. - 25 cm., XIII-304 pages. NF. 28.—.

This series of scientific studies by well-known authors is published in memory of the distinguished French jurist who died in 1958. These studies will be reviewed more fully in a subsequent book review, though it should be pointed out here that they cover industrial property as well as copyright.

QUEMNER (Thomas A.). *Legal dictionary English-French, French-English (law, finance, commerce, customs, insurance, administration)*. Paris, Ed. de Navarre, 1953. - 23 cm., 323 + 269 pages. NF. 33.— per vol. Preface by Gilbert Gidel.

RIGGENBACH (Bernhard). *Uebersicht der Literatur über schweizerisches Recht — Bibliographie juridique suisse*. Basel, Helbing & Lichtenhahn, 1947-1960. - 22 cm., 11 vol. Reprint from "Revue de droit suisse".

STEIN (Werner vom). *Festschrift Werner vom Stein - Zum 25jährigen Bestehen der Kommer für Patentstreitsachen am Landgericht Düsseldorf*. Karlsruhe, Bruchhausen, 1961. - 22,5 cm., 158 pages. DM. 2.50.

This collection consists of 17 studies by well-known German authors (scientists, judges and practitioners). These cover problems relating to industrial property as well as copyright. The volume was published in honour of *Landgerichtsdirektor* Werner vom Stein, an expert on problems dealing with the protection of industrial property.

VSEIOUZNAIA TORGAVALA PALATA. PATENTN'II. OTDEL. *Spravochnik o poriadke patentovaniia inostrann'ik izobretanni i registratsii inostrann'ik tovor'ikh ziskov v SSSR - Anleitung zum Patentieren ausländischer Erfindungen und zum Registrieren ausländischer Warenzeichen in der UdSSR*. Moscow, s. n. 1956. - 25,5 cm., 10 + 11 pages.

