

# Industrial Property

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## INTELLECTUAL PROPERTY CONFERENCE OF STOCKHOLM, 1967

### Additional Act of Stockholm, of July 14, 1967, to the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods

of April 14, 1891,

as revised

at WASHINGTON on June 2, 1911, at THE HAGUE on November 6, 1925,  
at LONDON on June 2, 1934, and at LISBON on October 31, 1958 \*)

#### Article 1

[Transfer of Depositary Functions in Respect of the Madrid Agreement]

Instruments of accession to the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods, of April 14, 1891 (hereinafter designated as "the Madrid Agreement"), as revised at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, and at Lisbon on October 31, 1958 (hereinafter designated as "the Lisbon Act"), shall be deposited with the Director General of the World Intellectual Property Organization (hereinafter designated as "the Director General"), who shall notify such deposits to the countries party to the Agreement.

#### Article 2

[Adaptation of References in the Madrid Agreement to Certain Provisions of the Paris Convention]

References in Articles 5 and 6(2) of the Lisbon Act to Articles 16, 16<sup>bis</sup>, and 17<sup>bis</sup>, of the General Convention shall be construed as references to those provisions of the Stockholm Act of the Paris Convention for the Protection of Industrial Property which correspond to the said Articles.

#### Article 3

[Signature and Ratification of, and Accession to, the Additional Act]

(1) This Additional Act may be signed by any country party to the Madrid Agreement and may be ratified or acceded to by any country which has ratified or acceded to the Lisbon Act.

(2) Instruments of ratification or accession shall be deposited with the Director General.

#### Article 4

[Automatic Acceptance of Articles 1 and 2 by Countries Acceding to the Lisbon Act]

Any country which has not ratified or acceded to the Lisbon Act shall become bound also by Articles 1 and 2 of this Additional Act from the date on which its accession to the Lisbon Act enters into force, provided, however, that, if on the said date this Additional Act has not yet entered into

force pursuant to Article 5(1), then, such country shall become bound by Articles 1 and 2 of this Additional Act only from the date of entry into force of this Additional Act pursuant to Article 5(1).

#### Article 5

[Entry Into Force of the Additional Act]

(1) This Additional Act shall enter into force on the date on which the Stockholm Convention of July 14, 1967, establishing the World Intellectual Property Organization has entered into force, provided, however, that, if by that date at least two ratifications or accessions to this Additional Act have not been deposited, then, this Additional Act shall enter into force on the date on which two ratifications or accessions to this Additional Act have been deposited.

(2) With respect to any country which deposits its instrument of ratification or accession after the date on which this Additional Act has entered into force pursuant to the foregoing paragraph, this Additional Act shall enter into force three months after the date on which its ratification or accession has been notified by the Director General.

#### Article 6

[Signature, etc., of the Additional Act]

(1) This Additional Act shall be signed in a single copy in the French language and shall be deposited with the Government of Sweden.

(2) This Additional Act shall remain open for signature at Stockholm until the date of its entry into force pursuant to Article 5(1).

(3) The Director General shall transmit two copies, certified by the Government of Sweden, of the signed text of this Additional Act to the Governments of all countries party to the Madrid Agreement and, on request, to the Government of any other country.

(4) The Director General shall register this Additional Act with the Secretariat of the United Nations.

(5) The Director General shall notify the Governments of all countries party to the Madrid Agreement of signatures, deposits of instruments of ratification or accession, entry into force, and other relevant notifications.

#### Article 7

[Transitional Provision]

Until the first Director General assumes office, references in this Additional Act to him shall be construed as references to the Director of the United International Bureaux for the Protection of Intellectual Property.

\*) Translation by BIRPI.

## Madrid Agreement Concerning the International Registration of Marks

of April 14, 1891,  
as revised

at BRUSSELS on December 14, 1900, at WASHINGTON on June 2, 1911,  
at THE HAGUE on November 6, 1925, at LONDON on June 2, 1934,  
at NICE on June 15, 1957,

and at STOCKHOLM on July 14, 1967<sup>1)</sup>

### Article 1

[Establishment of a Special Union. Filing of Marks at International Bureau. Definition of Country of Origin]<sup>2)</sup>

(1) The countries to which this Agreement applies constitute a Special Union for the international registration of marks.

(2) Nationals of any of the contracting countries may, in all the other countries party to this Agreement, secure protection for their marks applicable to goods or services, registered in the country of origin, by filing the said marks at the International Bureau of Intellectual Property (hereinafter designated as "the International Bureau") referred to in the Convention establishing the World Intellectual Property Organization (hereinafter designated as "the Organization"), through the intermediary of the Office of the said country of origin.

(3) Shall be considered the country of origin the country of the Special Union where the applicant has a real and effective industrial or commercial establishment; if he has no such establishment in a country of the Special Union, the country of the Special Union where he has his domicile; if he has no domicile within the Special Union but is a national of a country of the Special Union, the country of which he is a national.

### Article 2

[Reference to Article 3 of Paris Convention (Same Treatment for Certain Categories of Persons as for Nationals of Countries of the Union)]

Nationals of countries not having acceded to this Agreement who, within the territory of the Special Union constituted by the said Agreement, satisfy the conditions specified in Article 3 of the Paris Convention for the Protection of Industrial Property shall be treated in the same manner as nationals of the contracting countries.

### Article 3

[Contents of Application for International Registration]

(1) Every application for international registration must be presented on the form prescribed by the Regulations; the Office of the country of origin of the mark shall certify that the particulars appearing in such application correspond to the particulars in the national register, and shall mention the dates and numbers of the filing and registration of the mark in the country of origin and also the date of the application for international registration.

(2) The applicant must indicate the goods or services in respect of which protection of the mark is claimed and also,

if possible, the corresponding class or classes according to the classification established by the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks. If the applicant does not give such indication, the International Bureau shall classify the goods or services in the appropriate classes of the said classification. The indication of classes given by the applicant shall be subject to control by the International Bureau, which shall exercise the said control in association with the national Office. In the event of disagreement between the national Office and the International Bureau, the opinion of the latter shall prevail.

(3) If the applicant claims color as a distinctive feature of his mark, he shall be required:

1. to state the fact, and to file with his application a notice specifying the color or the combination of colors claimed;
2. to append to his application copies in color of the said mark, which shall be attached to the notification given by the International Bureau. The number of such copies shall be fixed by the Regulations.

(4) The International Bureau shall register immediately the marks filed in accordance with Article 1. The registration shall bear the date of the application for international registration in the country of origin, provided that the application has been received by the International Bureau within a period of two months from that date. If the application has not been received within that period, the International Bureau shall record it as at the date on which it received the said application. The International Bureau shall notify such registration without delay to the Offices concerned. Registered marks shall be published in a periodical journal issued by the International Bureau, on the basis of the particulars contained in the application for registration. In the case of marks comprising a figurative element or a special form of writing, the Regulations shall determine whether a printing block must be supplied by the applicant.

(5) With a view to the publicity to be given in the contracting countries to registered marks, each Office shall receive from the International Bureau a number of copies of the said publication free of charge and a number of copies at a reduced price, in proportion to the number of units mentioned in Article 16(4)(a) of the Paris Convention for the Protection of Industrial Property, under the conditions fixed by the Regulations. Such publicity shall be deemed in all the contracting countries to be sufficient, and no other publicity may be required of the applicant.

### Article 3<sup>bis</sup>

[“Territorial Limitation”]

(1) Any contracting country may, at any time, notify the Director General of the Organization (hereinafter designated as “the Director General”) in writing that the protection resulting from the international registration shall extend to that country only at the express request of the proprietor of the mark.

(2) Such notification shall not take effect until six months after the date of the communication thereof by the Director General to the other contracting countries.

<sup>1)</sup> This is a provisional English translation prepared by BIRPI.

<sup>2)</sup> Articles have been given titles to facilitate their identification. There are no titles in the signed, French text.

**Article 3<sup>ter</sup>**

[Request for "Territorial Extension"]

(1) Any request for extension of the protection resulting from the international registration to a country which has availed itself of the right provided for in Article 3<sup>bis</sup> must be specially mentioned in the application referred to in Article 3(1).

(2) Any request for territorial extension made subsequently to the international registration must be presented through the intermediary of the Office of the country of origin on a form prescribed by the Regulations. It shall be immediately registered by the International Bureau, which shall notify it without delay to the Office or Offices concerned. It shall be published in the periodical journal issued by the International Bureau. Such territorial extension shall be effective from the date on which it has been recorded in the International Register; it shall cease to be valid on the expiration of the international registration of the mark to which it relates.

**Article 4**

[Effects of International Registration]

(1) From the date of the registration so effected at the International Bureau in accordance with the provisions of Articles 3 and 3<sup>ter</sup>, the protection of the mark in each of the contracting countries concerned shall be the same as if the mark had been filed therein direct. The indication of classes of goods or services provided for in Article 3 shall not bind the contracting countries with regard to the determination of the scope of the protection of the mark.

(2) Every mark which has been the subject of an international registration shall enjoy the right of priority provided for by Article 4 of the Paris Convention for the Protection of Industrial Property, without requiring compliance with the formalities prescribed in Section D of that Article.

**Article 4<sup>bis</sup>**

[Substitution of International Registration for Earlier National Registrations]

(1) When a mark already filed in one or more of the contracting countries is later registered by the International Bureau in the name of the same proprietor or his successor in title, the international registration shall be deemed to have replaced the earlier national registrations, without prejudice to any rights acquired by reason of such earlier registrations.

(2) The national Office shall, upon request, be required to take note in its registers of the international registration.

**Article 5**

[Refusal by National Offices]

(1) In countries where the legislation so authorizes, Offices notified by the International Bureau of the registration of a mark or of a request for extension of protection made in accordance with Article 3<sup>ter</sup> shall have the right to declare that protection cannot be granted to such mark in their territory. Any such refusal can be based only on the grounds which would apply, under the Paris Convention for the Protection of Industrial Property, in the case of a mark filed for national

registration. However, protection may not be refused, even partially, by reason only that national legislation would not permit registration except in a limited number of classes or for a limited number of goods or services.

(2) Offices wishing to exercise such right must give notice of their refusal to the International Bureau, together with a statement of all grounds, within the period prescribed by their domestic law and, at the latest, before the expiration of one year from the date of the international registration of the mark or of the request for extension of protection made in accordance with Article 3<sup>ter</sup>.

(3) The International Bureau shall, without delay, transmit to the Office of the country of origin and to the proprietor of the mark, or to his agent if an agent has been mentioned to the Bureau by the said Office, one of the copies of the declaration of refusal so notified. The interested party shall have the same remedies as if the mark had been filed by him direct in the country where protection is refused.

(4) The grounds for refusing a mark shall be communicated by the International Bureau to any interested party who may so request.

(5) Offices which, within the aforesaid maximum period of one year, have not communicated to the International Bureau any provisional or final decision of refusal with regard to the registration of a mark or a request for extension of protection shall lose the benefit of the right provided for in paragraph (1) of this Article with respect to the mark in question.

(6) Invalidation of an international mark may not be pronounced by the competent authorities without the proprietor of the mark having, in good time, been afforded the opportunity of defending his rights. Invalidation shall be notified to the International Bureau.

**Article 5<sup>bis</sup>**

[Documentary Evidence of Legitimacy of Use of Certain Elements of Mark]

Documentary evidence of the legitimacy of the use of certain elements incorporated in a mark, such as armorial bearings, escutcheons, portraits, honorary distinctions, titles, trade names, names of persons other than the name of the applicant, or other like inscriptions, which might be required by the Offices of the contracting countries shall be exempt from any legalization or certification other than that of the Office of the country of origin.

**Article 5<sup>ter</sup>**

[Copies of Entries in International Register. Searches for Anticipation. Extracts from International Register]

(1) The International Bureau shall issue to any person applying therefor, subject to a fee fixed by the Regulations, a copy of the entries in the Register relating to a specific mark.

(2) The International Bureau may also, upon payment, undertake searches for anticipation among international marks.

(3) Extracts from the International Register requested with a view to their production in one of the contracting countries shall be exempt from all legalization.

### Article 6

[Period of Validity of International Registration. Independence of International Registration. Termination of Protection in Country of Origin]

(1) Registration of a mark at the International Bureau is effected for twenty years, with the possibility of renewal under the conditions specified in Article 7.

(2) Upon expiration of a period of five years from the date of the international registration, such registration shall become independent of the national mark registered earlier in the country of origin, subject to the following provisions.

(3) The protection resulting from the international registration, whether or not it has been the subject of a transfer, may no longer be invoked, in whole or in part, if, within five years from the date of the international registration, the national mark, registered earlier in the country of origin in accordance with Article 1, no longer enjoys, in whole or in part, legal protection in that country. This provision shall also apply when legal protection has later ceased as the result of an action begun before the expiration of the period of five years.

(4) In the case of voluntary or ex officio cancellation, the Office of the country of origin shall request the cancellation of the mark at the International Bureau, and the latter shall effect the cancellation. In the case of judicial action, the said Office shall send to the International Bureau, ex officio or at the request of the plaintiff, a copy of the complaint or any other documentary evidence that an action has begun, and also of the final decision of the court; the Bureau shall enter notice thereof in the International Register.

### Article 7

[Renewal of International Registration]

(1) Any registration may be renewed for a period of twenty years from the expiration of the preceding period, by payment only of the basic fee and, where necessary, of the supplementary and complementary fees provided for in Article 8(2).

(2) Renewal may not include any change in relation to the previous registration in its latest form.

(3) The first renewal effected under the provisions of the Nice Act of June 15, 1957, or of this Act, shall include an indication of the classes of the International Classification to which the registration relates.

(4) Six months before the expiration of the term of protection, the International Bureau shall, by sending an unofficial notice, remind the proprietor of the mark and his agent of the exact date of expiration.

(5) Subject to the payment of a surcharge fixed by the Regulations, a period of grace of six months shall be granted for renewal of the international registration.

### Article 8

[National Fee. International Fee. Division of Excess Receipts, Supplementary Fees, and Complementary Fees]

(1) The Office of the country of origin may fix, at its own discretion, and collect, for its own benefit, a national fee which it may require from the proprietor of the mark in re-

spect of which international registration or renewal is applied for.

(2) Registration of a mark at the International Bureau shall be subject to the advance payment of an international fee which shall include:

- (a) a basic fee;
- (b) a supplementary fee for each class of the International Classification, beyond three, into which the goods or services to which the mark is applied will fall;
- (c) a complementary fee for any request for extension of protection under Article 3<sup>ter</sup>.

(3) However, the supplementary fee specified in paragraph (2)(b) may, without prejudice to the date of registration, be paid within a period fixed by the Regulations if the number of classes of goods or services has been fixed or disputed by the International Bureau. If, upon expiration of the said period, the supplementary fee has not been paid or the list of goods or services has not been reduced to the required extent by the applicant, the application for international registration shall be deemed to have been abandoned.

(4) The annual returns from the various receipts from international registration, with the exception of those provided for under (b) and (c) of paragraph (2), shall be divided equally among the countries party to this Act by the International Bureau, after deduction of the expenses and charges necessitated by the implementation of the said Act. If, at the time this Act enters into force, a country has not yet ratified or acceded to the said Act, it shall be entitled, until the date on which its ratification or accession becomes effective, to a share of the excess receipts calculated on the basis of that earlier Act which is applicable to it.

(5) The amounts derived from the supplementary fees provided for in paragraph (2)(b) shall be divided at the expiration of each year among the countries party to this Act or to the Nice Act of June 15, 1957, in proportion to the number of marks for which protection has been applied for in each of them during that year, this number being multiplied, in the case of countries which make a preliminary examination, by a coefficient which shall be determined by the Regulations. If, at the time this Act enters into force, a country has not yet ratified or acceded to the said Act, it shall be entitled, until the date on which its ratification or accession becomes effective, to a share of the amounts calculated on the basis of the Nice Act.

(6) The amounts derived from the complementary fees provided for in paragraph (2)(c) shall be divided according to the requirements of paragraph (5) among the countries availing themselves of the right provided for in Article 3<sup>bis</sup>. If, at the time this Act enters into force, a country has not yet ratified or acceded to the said Act, it shall be entitled, until the date on which its ratification or accession becomes effective, to a share of the amounts calculated on the basis of the Nice Act.

### Article 8<sup>bis</sup>

[Renunciation in Respect of One or More Countries]

The person in whose name the international registration stands may at any time renounce protection in one or more

of the contracting countries by means of a declaration filed with the Office of his own country, for communication to the International Bureau, which shall notify accordingly the countries in respect of which renunciation has been made. Renunciation shall not be subject to any fee.

#### Article 9

[Changes in National Registers also Affecting International Registration. Reduction of List of Goods and Services Mentioned in International Registration. Additions to that List. Substitutions in that List]

(1) The Office of the country of the person in whose name the international registration stands shall likewise notify the International Bureau of all annulments, cancellations, renunciations, transfers, and other changes made in the entry of the mark in the national register, if such changes also affect the international registration.

(2) The Bureau shall record those changes in the International Register, shall notify them in turn to the Offices of the contracting countries, and shall publish them in its journal.

(3) A similar procedure shall be followed when the person in whose name the international registration stands requests a reduction of the list of goods or services to which the registration applies.

(4) Such transactions may be subject to a fee, which shall be fixed by the Regulations.

(5) The subsequent addition of new goods or services to the said list can be obtained only by filing a new application as prescribed in Article 3.

(6) The substitution of one of the goods or services for another shall be treated as an addition.

#### Article 9<sup>bis</sup>

[Transfer of International Mark Entailing Change in Country of Proprietor]

(1) When a mark registered in the International Register is transferred to a person established in a contracting country other than the country of the person in whose name the international registration stands, the transfer shall be notified to the International Bureau by the Office of the latter country. The International Bureau shall record the transfer, shall notify the other Offices thereof, and shall publish it in its journal. If the transfer has been effected before the expiration of a period of five years from the international registration, the International Bureau shall seek the consent of the Office of the country of the new proprietor, and shall publish, if possible, the date and registration number of the mark in the country of the new proprietor.

(2) No transfer of a mark registered in the International Register for the benefit of a person who is not entitled to file an international mark shall be recorded.

(3) When it has not been possible to record a transfer in the International Register, either because the country of the new proprietor has refused its consent or because the said transfer has been made for the benefit of a person who is not entitled to apply for international registration, the Office of the country of the former proprietor shall have the right to

demand that the International Bureau cancel the mark in its Register.

#### Article 9<sup>ter</sup>

[Assignment of International Mark for Part Only of Registered Goods or Services or for Certain Contracting Countries. Reference to Article 6<sup>quater</sup> of Paris Convention (Assignment of Mark)]

(1) If the assignment of an international mark for part only of the registered goods or services is notified to the International Bureau, the Bureau shall record it in its Register. Each of the contracting countries shall have the right to refuse to recognize the validity of such assignment if the goods or services included in the part so assigned are similar to those in respect of which the mark remains registered for the benefit of the assignor.

(2) The International Bureau shall likewise record the assignment of an international mark in respect of one or several of the contracting countries only.

(3) If, in the above cases, a change occurs in the country of the proprietor, the Office of the country to which the new proprietor belongs shall, if the international mark has been transferred before the expiration of a period of five years from the international registration, give its consent as required by Article 9<sup>bis</sup>.

(4) The provisions of the foregoing paragraphs shall apply subject to Article 6<sup>quater</sup> of the Paris Convention for the Protection of Industrial Property.

#### Article 9<sup>quater</sup>

[Common Office for Several Contracting Countries. Request by Several Contracting Countries to be Treated as a Single Country]

(1) If several countries of the Special Union agree to effect the unification of their domestic legislations on marks, they may notify the Director General:

- (a) that a common Office shall be substituted for the national Office of each of them, and
- (b) that the whole of their respective territories shall be deemed to be a single country for the purposes of the application of all or part of the provisions preceding this Article.

(2) Such notification shall not take effect until six months after the date of the communication thereof by the Director General to the other contracting countries.

#### Article 10

[Assembly of the Special Union]

(1) (a) The Special Union shall have an Assembly consisting of those countries which have ratified or acceded to this Act.

(b) The Government of each country shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.

(c) The expenses of each delegation shall be borne by the Government which has appointed it, except for the travel expenses and the subsistence allowance of one delegate for each member country, which shall be paid from the funds of the Special Union.

- (2) (a) The Assembly shall:
- (i) deal with all matters concerning the maintenance and development of the Special Union and the implementation of this Agreement;
  - (ii) give directions to the International Bureau concerning the preparation for conferences of revision, due account being taken of any comments made by those countries of the Special Union which have not ratified or acceded to this Act;
  - (iii) modify the Regulations, including the fixation of the amounts of the fees referred to in Article 8(2) and other fees relating to international registration;
  - (iv) review and approve the reports and activities of the Director General concerning the Special Union, and give him all necessary instructions concerning matters within the competence of the Special Union;
  - (v) determine the program and adopt the triennial budget of the Special Union, and approve its final accounts;
  - (vi) adopt the financial regulations of the Special Union;
  - (vii) establish such committees of experts and working groups as it may deem necessary to achieve the objectives of the Special Union;
  - (viii) determine which countries not members of the Special Union and which intergovernmental and international non-governmental organizations shall be admitted to its meetings as observers;
  - (ix) adopt amendments to Articles 10 to 13;
  - (x) take any other appropriate action designed to further the objectives of the Special Union;
  - (xi) perform such other functions as are appropriate under this Agreement.

(2) (b) With respect to matters which are of interest also to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization.

(3) (a) Each country member of the Assembly shall have one vote.

(b) One-half of the countries members of the Assembly shall constitute a quorum.

(c) Notwithstanding the provisions of subparagraph (b), if, in any session, the number of countries represented is less than one-half but equal to or more than one-third of the countries members of the Assembly, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the countries members of the Assembly which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiration of this period, the number of countries having thus expressed their vote or abstention attains the number of countries which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

(d) Subject to the provisions of Article 13(2), the decisions of the Assembly shall require two-thirds of the votes cast.

(e) Abstentions shall not be considered as votes.

(f) A delegate may represent, and vote in the name of, one country only.

(g) Countries of the Special Union not members of the Assembly shall be admitted to the meetings of the latter as observers.

(4) (a) The Assembly shall meet once in every third calendar year in ordinary session upon convocation by the Director General and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization.

(b) The Assembly shall meet in extraordinary session upon convocation by the Director General, at the request of one-fourth of the countries members of the Assembly.

(c) The agenda of each session shall be prepared by the Director General.

(5) The Assembly shall adopt its own rules of procedure.

## Article 11

[International Bureau]

(1) (a) International registration and related duties, as well as all other administrative tasks concerning the Special Union, shall be performed by the International Bureau.

(b) In particular, the International Bureau shall prepare the meetings and provide the secretariat of the Assembly and of such committees of experts and working groups as may have been established by the Assembly.

(c) The Director General shall be the chief executive of the Special Union and shall represent the Special Union.

(2) The Director General and any staff member designated by him shall participate, without the right to vote, in all meetings of the Assembly and of such committees of experts or working groups as may have been established by the Assembly. The Director General, or a staff member designated by him, shall be ex officio secretary of those bodies.

(3) (a) The International Bureau shall, in accordance with the directions of the Assembly, make the preparations for the conferences of revision of the provisions of the Agreement other than Articles 10 to 13.

(b) The International Bureau may consult with intergovernmental and international non-governmental organizations concerning preparations for conferences of revision.

(c) The Director General and persons designated by him shall take part, without the right to vote, in the discussions at those conferences.

(4) The International Bureau shall carry out any other tasks assigned to it.

## Article 12

[Finances]

(1) (a) The Special Union shall have a budget.

(b) The budget of the Special Union shall include the income and expenses proper to the Special Union, its contribution to the budget of expenses common to the Unions, and, where applicable, the sum made available to the budget of the Conference of the Organization.

(c) Expenses not attributable exclusively to the Special Union but also to one or more other Unions administered by the Organization shall be considered as expenses common to

the Unions. The share of the Special Union in such common expenses shall be in proportion to the interest the Special Union has in them.

(2) The budget of the Special Union shall be established with due regard to the requirements of coordination with the budgets of the other Unions administered by the Organization.

(3) The budget of the Special Union shall be financed from the following sources:

- (i) international registration fees and other fees and charges due for other services rendered by the International Bureau in relation to the Special Union;
- (ii) sale of, or royalties on, the publications of the International Bureau concerning the Special Union;
- (iii) gifts, bequests, and subventions;
- (iv) rents, interests, and other miscellaneous income.

(4) (a) The amounts of the fees referred to in Article 8(2) and other fees relating to international registration shall be fixed by the Assembly on the proposal of the Director General.

(b) The amounts of such fees shall be so fixed that the revenues of the Special Union from fees, other than the supplementary and complementary fees referred to in Article 8(2)(b) and (c), and other sources shall be at least sufficient to cover the expenses of the International Bureau concerning the Special Union.

(c) If the budget is not adopted before the beginning of a new financial period, it shall be at the same level as the budget of the previous year, as provided in the financial regulations.

(5) Subject to the provisions of paragraph (4)(a), the amount of fees and charges due for other services rendered by the International Bureau in relation to the Special Union shall be established, and shall be reported to the Assembly, by the Director General.

(6) (a) The Special Union shall have a working capital fund which shall be constituted by a single payment made by each country of the Special Union. If the fund becomes insufficient, the Assembly shall decide to increase it.

(b) The amount of the initial payment of each country to the said fund or of its participation in the increase thereof shall be a proportion of the contribution of that country as a member of the Paris Union for the Protection of Industrial Property to the budget of the said Union for the year in which the fund is established or the decision to increase it is made.

(c) The proportion and the terms of payment shall be fixed by the Assembly on the proposal of the Director General and after it has heard the advice of the Coordination Committee of the Organization.

(d) As long as the Assembly authorizes the use of the reserve fund of the Special Union as a working capital fund, the Assembly may suspend the application of the provisions of subparagraphs (a), (b), and (c).

(7) (a) In the headquarters agreement concluded with the country on the territory of which the Organization has its headquarters, it shall be provided that, whenever the working capital fund is insufficient, such country shall grant advances. The amount of those advances and the conditions on which they are granted shall be the subject of separate agreements, in each case, between such country and the Organization.

(b) The country referred to in subparagraph (a) and the Organization shall each have the right to denounce the obligation to grant advances, by written notification. Denunciation shall take effect three years after the end of the year in which it has been notified.

(8) The auditing of the accounts shall be effected by one or more of the countries of the Special Union or by external auditors, as provided in the financial regulations. They shall be designated, with their agreement, by the Assembly.

### Article 13

[Amendment of Articles 10 to 13]

(1) Proposals for the amendment of Articles 10, 11, 12, and the present Article, may be initiated by any country member of the Assembly, or by the Director General. Such proposals shall be communicated by the Director General to the member countries of the Assembly at least six months in advance of their consideration by the Assembly.

(2) Amendments to the Articles referred to in paragraph (1) shall be adopted by the Assembly. Adoption shall require three-fourths of the votes cast, provided that any amendment to Article 10, and to the present paragraph, shall require four-fifths of the votes cast.

(3) Any amendment to the Articles referred to in paragraph (1) shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of the countries members of the Assembly at the time it adopted the amendment. Any amendment to the said Articles thus accepted shall bind all the countries which are members of the Assembly at the time the amendment enters into force, or which become members thereof at a subsequent date.

### Article 14

[Ratification and Accession. Entry into Force. Accession to Earlier Acts. Reference to Article 24 of Paris Convention (Territories)]

(1) Any country of the Special Union which has signed this Act may ratify it, and, if it has not signed it, may accede to it.

(2) (a) Any country outside the Special Union which is party to the Paris Convention for the Protection of Industrial Property may accede to this Act and thereby become a member of the Special Union.

(b) As soon as the International Bureau is informed that such a country has acceded to this Act, it shall address to the Office of that country, in accordance with Article 3, a collective notification of the marks which, at that time, enjoy international protection.

(c) Such notification shall, of itself, ensure to the said marks the benefits of the foregoing provisions in the territory of the said country, and shall mark the commencement of the period of one year during which the Office concerned may make the declaration provided for in Article 5.

(d) However, any such country may, in acceding to this Act, declare that, except in the case of international marks which have already been the subject in that country of an

earlier identical national registration still in force, and which shall be immediately recognized upon the request of the interested parties, application of this Act shall be limited to marks registered from the date on which its accession enters into force.

(e) Such declaration shall dispense the International Bureau from making the collective notification referred to above. The International Bureau shall notify only those marks in respect of which it receives, within a period of one year from the accession of the new country, a request, with the necessary particulars, to take advantage of the exception provided for in subparagraph (d).

(f) The International Bureau shall not make the collective notification to such countries as declare, in acceding to this Act, that they are availing themselves of the right provided for in Article 3<sup>bis</sup>. The said countries may also declare at the same time that the application of this Act shall be limited to marks registered from the day on which their accessions enter into force; however, such limitation shall not affect international marks which have already been the subject of an earlier identical national registration in those countries, and which could give rise to requests for extension of protection made and notified in accordance with Articles 3<sup>ter</sup> and 8(2)(c).

(g) Registrations of marks which have been the subject of one of the notifications provided for in this paragraph shall be regarded as replacing registrations effected direct in the new contracting country before the date of entry into force of its accession.

(3) Instruments of ratification and accession shall be deposited with the Director General.

(4) (a) With respect to the first five countries which have deposited their instruments of ratification or accession, this Act shall enter into force three months after the deposit of the fifth such instrument.

(b) With respect to any other country, this Act shall enter into force three months after the date on which its ratification or accession has been notified by the Director General, unless a subsequent date has been indicated in the instrument of ratification or accession. In the latter case, this Act shall enter into force with respect to that country on the date thus indicated.

(5) Ratification or accession shall automatically entail acceptance of all the clauses and admission to all the advantages of this Act.

(6) After the entry into force of this Act, a country may accede to the Nice Act of June 15, 1957, only in conjunction with ratification of, or accession to, this Act. Accession to Acts earlier than the Nice Act shall not be permitted, not even in conjunction with ratification of, or accession to, this Act.

(7) The provisions of Article 24 of the Paris Convention for the Protection of Industrial Property shall apply to this Agreement.

#### Article 15

[Denunciation]

(1) This Agreement shall remain in force without limitation as to time.

(2) Any country may denounce this Act by notification addressed to the Director General. Such denunciation shall constitute also denunciation of all earlier Acts and shall affect only the country making it, the Agreement remaining in full force and effect as regards the other countries of the Special Union.

(3) Denunciation shall take effect one year after the day on which the Director General has received the notification.

(4) The right of denunciation provided for by this Article shall not be exercised by any country before the expiration of five years from the date upon which it becomes a member of the Special Union.

(5) International marks registered up to the date on which denunciation becomes effective, and not refused within the period of one year provided for in Article 5, shall continue, throughout the period of international protection, to enjoy the same protection as if they had been filed direct in the denouncing country.

#### Article 16

[Application of Earlier Acts]

(1) (a) This Act shall, as regards the relations between the countries of the Special Union by which it has been ratified or acceded to, replace, as from the day on which it enters into force with respect to them, the Madrid Agreement of 1891, in its texts earlier than this Act.

(b) However, any country of the Special Union which has ratified or acceded to this Act shall remain bound by the earlier texts which it has not previously denounced by virtue of Article 12(4) of the Nice Act of June 15, 1957, as regards its relations with countries which have not ratified or acceded to this Act.

(2) Countries outside the Special Union which become party to this Act shall apply it to international registrations effected at the International Bureau through the intermediary of the national Office of any country of the Special Union not party to this Act, provided that such registrations satisfy, with respect to the said countries, the requirements of this Act. With regard to international registrations effected at the International Bureau through the intermediary of the national Offices of the said countries outside the Special Union which become party to this Act, such countries recognize that the aforesaid country of the Special Union may demand compliance with the requirements of the most recent Act to which it is party.

#### Article 17

[Signature, Languages, Depositary Functions]

(1) (a) This Act shall be signed in a single copy in the French language and shall be deposited with the Government of Sweden.

(b) Official texts shall be established by the Director General, after consultation with the interested Governments, in such other languages as the Assembly may designate.

(2) This Act shall remain open for signature at Stockholm until January 13, 1968.

(3) The Director General shall transmit two copies, certified by the Government of Sweden, of the signed text of this

Act to the Governments of all countries of the Special Union and, on request, to the Government of any other country.

(4) The Director General shall register this Act with the Secretariat of the United Nations.

(5) The Director General shall notify the Governments of all countries of the Special Union of signatures, deposits of instruments of ratification or accession and any declarations included in such instruments, entry into force of any provisions of this Act, notifications of denunciation, and notifications pursuant to Articles 3<sup>bis</sup>, 9<sup>quater</sup>, 13, 14(7), and 15(2).

### Article 18

[Transitional Provisions]

(1) Until the first Director General assumes office, references in this Act to the International Bureau of the Organization or to the Director General shall be construed as references to the Bureau of the Union established by the Paris Convention for the Protection of Industrial Property or its Director, respectively.

(2) Countries of the Special Union not having ratified or acceded to this Act may, until five years after the entry into force of the Convention establishing the Organization, exercise, if they so desire, the rights provided for under Articles 10 to 13 of this Act as if they were bound by those Articles. Any country desiring to exercise such rights shall give written notification to that effect to the Director General; such notification shall be effective from the date of its receipt. Such countries shall be deemed to be members of the Assembly until the expiration of the said period.

## Complementary Act of Stockholm, of July 14, 1967, to the Hague Agreement Concerning the International Deposit of Industrial Designs

of November 6, 1925,  
as revised

at LONDON on June 2, 1934, and at THE HAGUE on November 28, 1960,  
and completed by the

Additional Act of MONACO on November 18, 1961<sup>1)</sup>

### Article 1

[Definitions]

For the purposes of this Complementary Act:

“1934 Act” shall mean the Act signed at London on June 2, 1934, of the Hague Agreement concerning the International Deposit of Industrial Designs;

“1960 Act” shall mean the Act signed at The Hague on November 28, 1960, of the Hague Agreement concerning the International Deposit of Industrial Designs;

“1961 Additional Act” shall mean the Act signed at Monaco on November 18, 1961, additional to the 1934 Act;

“Organization” shall mean the World Intellectual Property Organization;

“International Bureau” shall mean the International Bureau of Intellectual Property;

“Director General” shall mean the Director General of the Organization;

“Special Union” shall mean the Hague Union established by the Hague Agreement of November 6, 1925, concerning the International Deposit of Industrial Designs, and maintained by the 1934 and 1960 Acts, by the 1961 Additional Act, and by this Complementary Act.

### Article 2

[Assembly]

(1) (a) The Special Union shall have an Assembly consisting of those countries of the Union which have ratified or acceded to this Complementary Act.

(b) The Government of each country shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.

(c) The expenses of each delegation shall be borne by the Government which has appointed it.

(2) (a) The Assembly shall:

- (i) deal with all matters concerning the maintenance and development of the Special Union and the implementation of this Agreement;
- (ii) give directions to the International Bureau concerning the preparation for conferences of revision, due account being taken of any comments made by those countries of the Special Union which have not ratified or acceded to this Complementary Act;
- (iii) modify the Regulations, including the fixation of the amounts of the fees relating to the international deposit of industrial designs;
- (iv) review and approve the reports and activities of the Director General concerning the Special Union, and give him all necessary instructions concerning matters within the competence of the Special Union;
- (v) determine the program and adopt the triennial budget of the Special Union, and approve its final accounts;
- (vi) adopt the financial regulations of the Special Union;
- (vii) establish such committees of experts and working groups as it may deem necessary to achieve the objectives of the Special Union;
- (viii) determine which countries not members of the Special Union and which intergovernmental and international non-governmental organizations shall be admitted to its meetings as observers;
- (ix) adopt amendments to Articles 2 to 5;
- (x) take any other appropriate action designed to further the objectives of the Special Union;
- (xi) perform such other functions as are appropriate under this Complementary Act.

(b) With respect to matters which are of interest also to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization.

(3) (a) Each country member of the Assembly shall have one vote.

<sup>1)</sup> This is a provisional English translation prepared by BIRPI.

(b) One-half of the countries members of the Assembly shall constitute a quorum.

(c) Notwithstanding the provisions of subparagraph (b), if, in any session, the number of countries represented is less than one-half but equal to or more than one-third of the countries members of the Assembly, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the countries members of the Assembly which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiration of this period, the number of countries having thus expressed their vote or abstention attains the number of countries which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

(d) Subject to the provisions of Article 5 (2), the decisions of the Assembly shall require two-thirds of the votes cast.

(e) Abstentions shall not be considered as votes.

(f) A delegate may represent, and vote in the name of, one country only.

(g) Countries of the Special Union not members of the Assembly shall be admitted to the meetings of the latter as observers.

(4) (a) The Assembly shall meet once in every third calendar year in ordinary session upon convocation by the Director General and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization.

(b) The Assembly shall meet in extraordinary session upon convocation by the Director General, at the request of one-fourth of the countries members of the Assembly.

(c) The agenda of each session shall be prepared by the Director General.

(5) The Assembly shall adopt its own rules of procedure.

### Article 3

[International Bureau]

(1) (a) International deposit of industrial designs and related duties, as well as all other administrative tasks concerning the Special Union, shall be performed by the International Bureau.

(b) In particular, the International Bureau shall prepare the meetings and provide the secretariat of the Assembly and of such committees of experts and working groups as may have been established by the Assembly.

(c) The Director General shall be the chief executive of the Special Union and shall represent the Special Union.

(2) The Director General and any staff member designated by him shall participate, without the right to vote, in all meetings of the Assembly and of such committees of experts or working groups as may have been established by the Assembly. The Director General, or a staff member designated by him, shall be ex officio secretary of those bodies.

(3) (a) The International Bureau shall, in accordance with the directions of the Assembly, make the preparations for the conferences of revision of the provisions of the Agreement.

(b) The International Bureau may consult with inter-governmental and international non-governmental organizations concerning preparations for conferences of revision.

(c) The Director General and persons designated by him shall take part, without the right to vote, in the discussions at those conferences.

(4) The International Bureau shall carry out any other tasks assigned to it.

### Article 4

[Finances]

(1) (a) The Special Union shall have a budget.

(b) The budget of the Special Union shall include the income and expenses proper to the Special Union, its contribution to the budget of expenses common to the Unions, and, where applicable, the sum made available to the budget of the Conference of the Organization.

(c) Expenses not attributable exclusively to the Special Union but also to one or more other Unions administered by the Organization shall be deemed to be expenses common to the Unions. The share of the Special Union in such common expenses shall be in proportion to the interest the Special Union has in them.

(2) The budget of the Special Union shall be established with due regard to the requirements of coordination with the budgets of the other Unions administered by the Organization.

(3) The budget of the Special Union shall be financed from the following sources:

- (i) international deposit fees and other fees and charges due for other services rendered by the International Bureau in relation to the Special Union;
- (ii) sale of, or royalties on, the publications of the International Bureau concerning the Special Union;
- (iii) gifts, bequests, and subventions;
- (iv) rents, interests, and other miscellaneous income.

(4) (a) The amounts of the fees referred to in paragraph (3)(i) shall be fixed by the Assembly on the proposal of the Director General.

(b) The amounts of such fees shall be so fixed that the revenues of the Special Union from fees and other sources shall be at least sufficient to cover the expenses of the International Bureau concerning the Special Union.

(c) If the budget is not adopted before the beginning of a new financial period, it shall be at the same level as the budget of the previous year, as provided in the financial regulations.

(5) Subject to the provisions of paragraph (4)(a), the amount of the fees and charges due for other services rendered by the International Bureau in relation to the Special Union shall be established, and shall be reported to the Assembly, by the Director General.

(6) (a) The Special Union shall have a working capital fund which shall be constituted by the excess receipts and, if such excess does not suffice, by a single payment made by

each country of the Special Union. If the fund becomes insufficient, the Assembly shall decide to increase it.

(b) The amount of the initial payment of each country to the said fund or of its participation in the increase thereof shall be a proportion of the contribution of that country as a member of the Paris Union for the Protection of Industrial Property to the budget of the said Union for the year in which the fund is established or the decision to increase it is made.

(c) The proportion and the terms of payment shall be fixed by the Assembly on the proposal of the Director General and after it has heard the advice of the Coordination Committee of the Organization.

(7) (a) In the headquarters agreement concluded with the country on the territory of which the Organization has its headquarters, it shall be provided that, whenever the working capital fund is insufficient, such country shall grant advances. The amount of those advances and the conditions on which they are granted shall be the subject of separate agreements, in each case, between such country and the Organization.

(b) The country referred to in subparagraph (a) and the Organization shall each have the right to denounce the obligation to grant advances, by written notification. Denunciation shall take effect three years after the end of the year in which it has been notified.

(8) The auditing of the accounts shall be effected by one or more of the countries of the Special Union or by external auditors, as provided in the financial regulations. They shall be designated, with their agreement, by the Assembly.

### Article 5

[Amendment of Articles 2 to 5]

(1) Proposals for the amendment of this Complementary Act may be initiated by any country member of the Assembly, or by the Director General. Such proposals shall be communicated by the Director General to the member countries of the Assembly at least six months in advance of their consideration by the Assembly.

(2) Amendments referred to in paragraph (1) shall be adopted by the Assembly. Adoption shall require three-fourths of the votes cast, provided that any amendment to Article 2 and to the present paragraph, shall require four-fifths of the votes cast.

(3) Any amendment referred to in paragraph (1) shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of the countries members of the Assembly at the time it adopted the amendment. Any amendment thus accepted shall bind all the countries which are members of the Assembly at the time the amendment enters into force, or which become members thereof at a subsequent date.

### Article 6

[Amendment of the 1934 Act and the 1961 Additional Act]

(1) (a) References in the 1934 Act to “the International Bureau of Industrial Property at Berne,” to “the Berne

International Bureau,” or to “the International Bureau,” shall be construed as references to the International Bureau as defined in Article 1 of this Complementary Act.

(b) Article 15 of the 1934 Act is repealed.

(c) Any amendment of the Regulations referred to in Article 20 of the 1934 Act shall be effected in accordance with the procedure prescribed under Article 2(2)(a)(iii) and (3)(d).

(d) In Article 21 of the 1934 Act, for the words “revised in 1928” there shall be substituted the words “for the Protection of Literary and Artistic Works.”

(e) References in Article 22 of the 1934 Act to Articles 16, 16<sup>bis</sup>, and 17<sup>bis</sup>, of “the General Convention” shall be construed as references to those provisions of the Stockholm Act of the Paris Convention for the Protection of Industrial Property which, in the said Stockholm Act, correspond to Articles 16, 16<sup>bis</sup>, and 17<sup>bis</sup>, of the earlier Acts of the Paris Convention.

(2) (a) Any modification of the fees referred to in Article 3 of the 1961 Additional Act shall be effected in accordance with the procedure prescribed under Article 2(2)(a)(iii) and (3)(d).

(b) Paragraph (1) of Article 4 of the 1961 Additional Act, and the words “When the reserve fund has reached this amount” in paragraph (2), are repealed.

(c) References in Article 6(2) of the 1961 Additional Act to Articles 16 and 16<sup>bis</sup> of the Paris Convention for the Protection of Industrial Property shall be construed as references to those provisions of the Stockholm Act of the said Convention which, in the Stockholm Act, correspond to Articles 16 and 16<sup>bis</sup> of the earlier Acts of the Paris Convention.

(d) References in paragraphs (1) and (3) of Article 7 of the 1961 Additional Act to the Government of the Swiss Confederation shall be construed as references to the Director General.

### Article 7

[Amendment of the 1960 Act]

(1) References in the 1960 Act to “the Bureau of the International Union for the Protection of Industrial Property” or to “the International Bureau” shall be construed as references to the International Bureau as defined in Article 1 of this Complementary Act.

(2) Articles 19, 20, 21, and 22, of the 1960 Act are repealed.

(3) References in the 1960 Act to the Government of the Swiss Confederation shall be construed as references to the Director General.

(4) In Article 29 of the 1960 Act, the words “periodical” (paragraph (1)) and “of the International Design Committee or” (paragraph (2)) are deleted.

### Article 8

[Ratification of, and Accession to, the Complementary Act]

(1)(a) Countries which, before January 13, 1968, have ratified the 1934 Act or the 1960 Act, and countries which have acceded to at least one of those Acts, may sign this Complementary Act and ratify it, or may accede to it.

(b) Ratification of, or accession to, this Complementary Act by a country which is bound by the 1934 Act without being bound also by the 1961 Additional Act shall automatically entail ratification of, or accession to, the 1961 Additional Act.

(2) Instruments of ratification and accession shall be deposited with the Director General.

#### Article 9

[Entry Into Force of the Complementary Act]

(1) With respect to the first five countries which have deposited their instruments of ratification or accession, this Complementary Act shall enter into force three months after the deposit of the fifth such instrument of ratification or accession.

(2) With respect to any other country, this Complementary Act shall enter into force three months after the date on which its ratification or accession has been notified by the Director General, unless a subsequent date has been indicated in the instrument of ratification or accession. In the latter case, this Complementary Act shall enter into force with respect to that country on the date thus indicated.

#### Article 10

[Automatic Acceptance of Certain Provisions by Certain Countries]

(1) Subject to the provisions of Article 8 and the following paragraph, any country which has not ratified or acceded to the 1934 Act shall become bound by the 1961 Additional Act and by Articles 1 to 6 of this Complementary Act from the date on which its accession to the 1934 Act enters into force, provided that, if on the said date this Complementary Act has not yet entered into force pursuant to Article 9(1), then, such country shall become bound by the said Articles of this Complementary Act only from the date of entry into force of the Complementary Act pursuant to Article 9(1).

(2) Subject to the provisions of Article 8 and the foregoing paragraph, any country which has not ratified or acceded to the 1960 Act shall become bound by Articles 1 to 7 of this Complementary Act from the date on which its ratification of, or accession to, the 1960 Act enters into force, provided that, if on the said date this Complementary Act has not yet entered into force pursuant to Article 9(1), then, such country shall become bound by the said Articles of this Complementary Act only from the date of entry into force of the Complementary Act pursuant to Article 9(1).

#### Article 11

[Signature, etc., of the Complementary Act]

(1) (a) This Complementary Act shall be signed in a single copy in the French language and shall be deposited with the Government of Sweden.

(b) Official texts shall be established by the Director General, after consultation with the interested Governments, in such other languages as the Assembly may designate.

(2) This Complementary Act shall remain open for signature at Stockholm until January 13, 1968.

(3) The Director General shall transmit two copies, certified by the Government of Sweden, of the signed text of this Complementary Act to the Government of all countries of the Special Union and, on request, to the Government of any other country.

(4) The Director General shall register this Complementary Act with the Secretariat of the United Nations.

(5) The Director General shall notify the Governments of all countries of the Special Union of signatures, deposits of instruments of ratification or accession, entry into force, and all other relevant notifications.

#### Article 12

[Transitional Provision]

(1) Until the first Director General assumes office, references in this Complementary Act to the International Bureau of the Organization or to the Director General shall be construed as references to the Bureau of the Union established by the Paris Convention for the Protection of Industrial Property or its Director, respectively.

## INTERNATIONAL UNIONS

### Committee of Experts on the BIRPI Plan for Facilitating the Filing and Examination of Applications for the Protection of the Same Invention in a Number of Countries (BIRPI Plan for a Patent Cooperation Treaty (PCT))

(Geneva, October 2 to 10, 1967)

#### Note <sup>1)</sup>

##### Introduction

On the invitation of the Director of the United International Bureaux for the Protection of Intellectual Property (BIRPI), the First Committee of Experts on a Patent Cooperation Treaty ("PCT") met in Geneva from October 2 to 10, 1967, in order to examine BIRPI's plan for facilitating the filing and examination of applications for the protection of the same invention in a number of countries.

Those 23 countries in which, according to the latest available yearly statistics, more than 5,000 applications are filed were invited to attend as members of the Committee. They all accepted the invitation and were represented. They were the following: Argentina, Australia, Austria, Belgium, Brazil, Canada, Czechoslovakia, Denmark, France, Germany (Federal Republic), Italy, Japan, Mexico, Netherlands, Norway, Poland, South Africa, Soviet Union, Spain, Sweden,

<sup>1)</sup> Note prepared by the Secretariat of BIRPI on the basis of the Report of the Committee.

Switzerland, United Kingdom, United States of America. Two countries — India and Hungary — were represented by observers.

The following seven intergovernmental organizations were represented: United Nations, International Patent Institute, Organization of American States, Council of Europe, European Communities, European Free Trade Association, African and Malagasy Industrial Property Office.

Ten non-governmental organizations, representing inventors, industrialists, patent lawyers, and patent agents, were invited and were represented. They were the following: Committee of National Institutes of Patent Agents, Council of European Industrial Federations, European Industrial Research Management Association, Inter-American Association of Industrial Property, International Association for the Protection of Industrial Property, International Chamber of Commerce, International Federation of Patent Agents, National Association of Manufacturers (USA), Union of European Patent Agents, Union of Industries of the European Economic Community.

Observers had the same opportunities for participating in the discussions as full members of the Committee.

The Director of BIRPI, Professor G. H. C. Bodenhausen, participated in all the discussions.

The Committee unanimously elected as Chairman Mr. J. Voyame, Director of the Swiss Federal Office of Intellectual Property, and, as Vice-Chairmen, Mr. E. I. Artemiev, Deputy Chairman of the Committee for Inventions and Discoveries attached to the Council of Ministers of the Union of Soviet Socialist Republics, and Mr. E. M. Braderman, US Deputy Assistant Secretary of State for Commercial Affairs and Business Activities.

Dr. Arpad Bogsch, Deputy Director, BIRPI, acted as Secretary of the Committee.

The list of participants appears at the end of this Note. The number present was around one hundred.

#### Discussions of the Committee

Reference is made to the document, entitled "Explanatory Memorandum," which was published in the July 1967 issue of this periodical (page 161). That document described the aim of the proposed agreement (the "PCT") and briefly summarized its main features. The present Note generally does not repeat what has been said in that document but merely tries to outline the main reactions as reflected by the discussions of the Committee. The full text of the report on the meeting (BIRPI document PCT/I/11) may be obtained from BIRPI on request. It exists in English and French.

In general, the experts expressed the view that the PCT draft was highly worth while examining further and, after appropriate changes, completing within the shortest possible time.

The idea of international filing and international search was generally very favorably received.

As to the question whether the possibility of filing international applications should be limited to nationals of countries party to the PCT or open also to nationals of other Paris Union countries, opinions seemed to be fairly divided.

An international search to be carried out by one central institution, of a kind such as the International Patent Institute (IIB), seemed an ideal solution to a number of participants. It was generally recognized, however, that, at least for the foreseeable future, the only workable solution was a decentralized international search system making use of the existing facilities of the IIB and of the best equipped national Offices.

The uniform high quality of the international search reports was recognized as the most important single factor for the success of the PCT. Numerous suggestions were made on the question how to achieve such quality. A thorough exploration of the possibilities of the prospective searching Authorities and a careful study of all the problems connected with the proposed system of international search will be one of the main tasks of the coming months.

Whereas the draft presented to the Committee provided that international filing must always *precede* international search, the additional possibility, suggested by the Committee, of filing *after* the search results are known to the applicant will also be explored. Should the international application differ from the first national application forming the basis of the search, a complementary international search report would probably become necessary.

Examination as to form of the international applications should generally not be effected by the International Bureau but by the national Patent Offices or the searching Authorities.

The need for regulating the formalities of international applications, including the structure of the description and the claims, was generally recognized.

All unnecessary transmittal of documents between national Offices, searching Authorities, and the International Bureau, should be avoided.

The majority of the experts favored the rule of publishing international applications promptly after 18 months from the date of the first application. Some participants suggested that, if an applicant designates a country whose national law provides for publication promptly after 18 months, the deadline for international publication should be the same, whereas it could be extended until the expiration of the 24<sup>th</sup> month, if no such country is designated.

It was generally agreed that applicants may adjust their claims to the requirements of each national law once the international application reaches the various national Offices.

The procedure concerning certificates of examination (rather than "certificates of patentability") should be streamlined. Some proposed that the procedures for a search report and a certificate of examination should be telescoped and the failure to obtain a certificate kept a secret between the applicant and examining Authority. Others suggested that any elected country should have the right to ask for an international certificate. Some experts wondered whether the whole procedure concerning certificates should not be delayed until the procedure concerning central international filing and search reports had been tested in practice, while others expressed doubts as to the usefulness of the whole PCT Plan if only the international filing and international search procedure were to be put into effect without, at the same time, bringing

into operation also the procedure concerning certificates of examination.

The proposal according to which failure to act, within a year, by a national Office which has received an international application or an international certificate of examination could have the effect of a national patent will not be maintained.

To sum up, the main tendency manifested by the Committee was that the proposed system should be simplified to the maximum extent and should require as little change as possible in the substantive patent laws of the participating countries.

As to the continuation of the preparatory work on the plan, the Director of BIRPI declared that he would report to the competent organs of the Paris Union, and, subject to their approval, he planned to convene working parties and a second Committee of Experts, in the course of the year 1968, to which interested intergovernmental and non-governmental organizations would also be invited as observers.

## List of Participants

### I. States

#### Argentina

Mr. L. M. Laurelli, Third Secretary, Permanent Mission of the Republic of Argentina, Geneva.

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- Mr. S. Finne, Director, Federation of Finnish Industries, Helsinki.

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- Mr. A. van der Auweraer, Vice-President of EIRMA, Industrial Patent Counsel, Gevaert Agfa, NV, Mortsel-Antwerp.
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- Mr. F. O. Hess, Chairman of the Patents Committee of NAM, President, Selas Corporation of America, Dresher, Pennsylvania.
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- Mr. J. P. Simon, Legal Service, Syndicat Général de la Construction électrique, Paris.
- Mr. K. T. Heimhach, Farnefabriken Bayer, Leverkusen, Germany (Fed. Rep.).

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Professor G. H. C. Bodenhausen, Director.  
 Dr. Arpad Bogsch, Deputy Director.  
 Mr. Klaus Pfanner, Counsellor, Head of the Industrial Property Division.  
 Mr. G. R. Wipf, Counsellor, Industrial Property Division.  
 Mr. I. Morozov, Industrial Property Division.  
 Miss G. Davies, Industrial Property Division.

### IV. Officers of the Meeting

Chairman: Mr. J. Voyame (Switzerland).  
 Vice-Chairmen: Mr. E. I. Artemiev (Union of Soviet Socialist Republics).  
 Mr. E. M. Braderman (United States of America).

## LEGISLATION

### FEDERAL REPUBLIC OF GERMANY

#### Law

#### for the Amendment of the Patent Law, Trademark Law and Other Laws

(Of September 4, 1967)<sup>1)</sup>

The *Bundestag* has enacted the following law:

#### Article I

#### *Amendment of the Patent Law*

The text of the Patent Law of May 9, 1961 (*Bundesgesetzblatt I*, pp. 549, 550), is amended as follows:

1. Section 1, paragraph (2), shall be worded as follows:

“(2) Inventions shall be excluded if their utilization would be contrary to laws or public morals, with the exception of laws which merely restrict the sale or marketing of the object of the invention or, if the invention relates to a process, of the article directly produced by that process.”

2. In Section 4, paragraph (1), the parenthesis “(Section 28)” shall be deleted.

3. Section 11, paragraphs (1)-(4), shall be worded as follows:

“(1) For every application a publication fee (Section 31) is to be paid prior to publication, for every application and for every patent an annual fee, as prescribed in the schedule of fees, shall be due at the beginning of the third year and of each subsequent year after the day following the date of application.

(2) In the case of a patent of addition (Section 10, paragraph (1), sentence 2) no annual fees shall be due. If the patent of addition is converted to an independent patent, fees shall

be due in connection therewith. The due date and the annual amount shall be determined by the date of commencement of the hitherto existing main patent. These provisions shall be applicable to the application for a patent of addition, provided that in cases where an application for a patent of addition is considered as an application for an independent patent, annual fees shall be due as in the case of an originally independent application.

(3) Fees for the third and subsequent years shall be paid within two months from the due date. If this period has elapsed, an additional fee for delayed payment as prescribed in the schedule of fees shall be paid. After expiration of the grace period the Patent Office shall notify the applicant or patentee that the application will be considered withdrawn (Section 35, paragraph (3)) or that the patent will lapse (Section 12) if the fee and the additional fee as prescribed in the schedule of fees is not paid within six months from the due date or within one month from the service of notice if the latter period expires later than six months after the due date.

(4) The Patent Office may postpone the sending of the notice at the request of the applicant or patentee on proof that lack of resources prevent his paying at that time. Postponement may be made conditional upon payment of installments within specified periods. If an installment is not paid in time, the Patent Office shall advise the applicant or patentee that the application will be considered withdrawn or that the patent will lapse if the balance is not paid within one month after service of notice.”

4. Section 11, paragraph (6), sentence 2, shall be worded as follows:

“Installments paid shall not be refunded if the patent lapses (section 12) or if the application is considered withdrawn (section 35, paragraph (3)) because of non-payment of the outstanding balance.”

5. Section 11, paragraph (7), shall be worded as follows:

“(7) If the applicant or patentee establishes his lack of resources, the publication fee and the fees for the third to the ninth year may be postponed until the commencement of the tenth year, and may be waived if the application is withdrawn or if the patent lapses within the first ten years.”

6. In Section 11, paragraph (9), sentence 2, the following words shall be inserted after the word “withdrawn”:

“or if the application is withdrawn or rejected.”

7. The following paragraph (6) shall be added to Section 14:

“(6) If the declaration is submitted in connection with an application, the provisions of paragraphs (1)-(5) shall be applicable.”

8. In Section 17, paragraph (3), sentence 1, the words “President of the Patent Office” shall be substituted for “Minister of Justice”.

9. Section 24, paragraphs (3) and (4), shall be worded as follows:

“(3) The Patent Office shall grant anyone so requesting access to the files and to models and samples relating thereto if, and to the extent that, justified interest has been substantiated. Anyone shall have access to:

<sup>1)</sup> *Bundesgesetzblatt I*, No. 56, September 4, 1967, p. 953. — This translation was prepared by the U.S. Patent Office in cooperation with the German Patent Office. — Translations of the consolidated texts of the amended laws will be published as soon as they have been established (see Article 7, Section 4 of this Law).

- (1) The Register,
- (2) The files of unpublished patent applications, if eighteen months have elapsed since the date of filing of the application or since an earlier date, if such a date has been claimed as determinative, and a notice as specified in paragraph (4) has been published,
- (3) The files of published patent applications, and,
- (4) The files of issued patents, including the files relating to restriction procedures (section 36a),

as well as models or samples relating to the said files. If so requested by the inventor designated by the applicant, in connection with the naming of the inventor (Section 26, paragraph (6)), inspection, according to sentence 1 only, shall be authorized; Section 36, paragraph (1), sentences 4 and 5, shall be applicable. Inspection of patent applications and patents which have not been published in accordance with Section 30a shall be permitted by the Patent Office only after hearing the highest proper authority of the Federal Republic, if and to the extent that a special protection-deserving interest of the petitioner appears to warrant the requested inspection without entailing possible risks for the welfare of the Federal Republic of Germany or of one of its several States thereof.

(4) The Patent Office shall publish the specifications and drawings which are the basis for the issue of patents (*Patentschriften*), a review of the entries in the Register at regular intervals, provided they do not relate solely to the normal expiration of patents, and notices of the accessibility of files of still unpublished patent applications [*Patent Gazette (Patentblatt)*]. The Patent Office may also publish the contents of files laid open to public inspection in accordance with paragraph (3), No. 2. Section 30a, paragraph (1), shall remain unaffected."

10. The following paragraph 5 shall be added to section 24:

"(5) From the date of publication of the notice according to paragraph (4), sentence 1, the applicant may claim compensation as determined by the circumstances from anyone who has utilized the invention although he knew or should have known that the invention utilized by him was the object of the application; during the period preceding publication, claims in accordance with Section 47, paragraphs (1) and (2), shall be excluded. The claim does not exist if the object of the application is obviously unpatentable. Section 48, sentence 1, shall be applicable."

11. Former paragraph (5), Section 25, shall become paragraph (6).

12. The following sentence 2 shall be added to Section 26, paragraph (4):

"If the applicant has also filed his invention in another country, he shall, independently of the requirements specified in sentence 1, submit the serial number of the application and the printed references cited in opposition in the procedure before the patent office of the other country."

13. Section 26, paragraph (5), shall be worded as follows:

"(5) Up to the time of the decision to publish the application, amendments to and corrections of the specification shall be permissible, provided that the subject of the applica-

tion is not broadened; however until a petition for examination is filed (Section 28b), only the correction of obvious errors, elimination of deficiencies specified by the Examining Office, or amendments or revisions of claims shall be permissible. No rights may be derived from amendments or revisions which broaden the subject of the application."

14. Section 26, paragraph (6), sentence 1, shall be worded as follows:

"Within a period of three months from the date of filing of the application the applicant shall name the inventor or inventors and affirm that to his knowledge no other person is concerned with the invention."

15. Section 26, paragraph (7), shall be worded as follows:

"(7) If the applicant makes a verified showing that he is prevented by extraordinary circumstances from making the declarations prescribed in paragraph (6), in due time, the Patent Office shall grant him a reasonable extension. This extension shall not continue beyond the time of issue of the order granting the patent. If the above circumstances still exist at that time, the Patent Office shall grant another extension. Six months before the expiration of the period the Patent Office shall notify the patentee that the patent will lapse if he does not make the prescribed declarations within six months after service of notice."

16. Section 27, sentence 2, shall be worded as follows:

"After receipt of the declaration of priority the Patent Office shall request the applicant to indicate the serial number of the prior application and to file a copy of the said application within two months from service of the request, if such action has not already been taken."

17. Section 28 shall be worded as follows:

"Section 28.

(1) If the application obviously does not comply with the prescribed requirements (section 26), the Examining Office shall request the applicant to correct the deficiencies within a specified period. If, in the case of Section 27, the production of documentary evidence (copies of the prior application, specifications, drawings, etc.) is required, this period shall be established to end not less than three months after the filing of the application. If the application does not comply with the regulations of other requirements for applications (Section 26, paragraph (3)), the Examining Office may refrain from objecting to the deficiencies until the examining procedure is conducted (Section 28b).

(2) If, in the opinion of the Examining Office, the subject of the application obviously

- (1) constitutes essentially no invention,
- (2) does not lend itself to industrial application,
- (3) is excluded from being patentable in accordance with Section 1, paragraph (2),
- (4) is not intended as an improvement or development of the other invention in the instance of Section 10, paragraph (1), sentence 2,

the Examining Office shall notify the applicant thereof with an indication of the reasons, and request a statement of his views within a specified period.

(3) The Examining Office shall reject the application if the deficiencies specified in paragraph (1) are not corrected or the application is maintained although obviously no patentable invention exists (paragraph (2), Nos. 1-3), or the requirements of Section 10, paragraph (1), sentence 2, are obviously not met (paragraph (2), No. 4). If the rejection is to be based on facts that have not yet been communicated to the applicant, the applicant shall first be given the opportunity to state his views within a specified period."

18. The following provisions shall be inserted as Sections 28a-28c after Section 28:

"Section 28a.

(1) The Patent Office shall ascertain upon petition the publications which are to be cited in connection with the determination of patentability of the invention.

(2) The petition may be filed by the applicant or by any third party who however shall not thereby become a participant in the procedure. The petition is to be submitted in writing. Section 16 shall be applicable. A fee as determined by the fee schedule shall be paid with the petition; if the fee is not paid the petition shall not be considered filed. If the petition is filed in connection with an application for a patent of addition (Section 10, paragraph (1), sentence 2) the Patent Office shall request the applicant to file a petition as specified in paragraph (1) within a period ending one month following the request for the application of the main patent; if the petition is not filed the application for the patent of addition shall be considered as an application for an independent patent.

(3) The filing of the petition shall be published in the Patent Gazette (*Patentblatt*), but not before publication of the notice specified in Section 24, paragraph (4), sentence 1. If the petition is filed by a third party, the applicant shall be advised of the filing of that petition. Anyone shall be authorized to inform the Patent Office of publications which might prejudice the grant of a patent.

(4) A petition shall not be considered filed if a petition in accordance with Section 28b has been filed previously. In this case, the Patent Office shall notify the petitioner of the date of filing of the petition according to Section 28b. The fee paid for the petition shall be refunded.

(5) If a petition according to paragraph (1) has been filed, subsequent petitions shall not be considered filed. Paragraph (4), sentences 2 and 3, shall be applicable.

(6) If a petition filed by a third party, after notification of the applicant (paragraph (3), sentence 1), is proved ineffective, the Patent Office shall so advise the third party and the applicant.

(7) The Patent Office shall communicate the ascertained publications as specified in paragraph (1) to the applicant and if the petition has been filed by a third party, to that party and the applicant without guarantee of completeness and the issue of the communication shall be published in the Patent Gazette (*Patentblatt*).

(8) To accelerate disposals in the patent granting procedure the Federal Minister of Justice shall be authorized to direct by statutory order that:

(1) the ascertainment of the publications specified in paragraph (1) be assigned to Patent Office organizations other than the Examining Offices (Section 18, paragraph (1)) or to another national or international organization in whole or for specific arts or languages, provided that the organization concerned appears competent to ascertain the publications to be taken into consideration,

(2) the Patent Office shall supply the foreign or international authorities with data from the files of patent applications for mutual information on the results of examination procedures and prior art investigations, provided that the case relates to applications of inventions for which the grant of a patent has also been applied for with the said foreign or international authorities,

(3) the examination of patent applications according to Section 28, as well as the control of fees and time periods shall be transferred in whole or in part to Patent Office organizations other than the Examining Offices or Patent Sections (Section 18, paragraph (1)).

Section 28b.

(1) The Patent Office on petition shall examine whether the application complies with the prescribed requirements (Section 26) and whether the subject matter of the application is patentable according to Sections 1, 2, and 4, paragraph (2).

(2) The petition may be filed by the applicant or by any third party, who however shall not thereby become a participant in the examining procedure, until seven years have elapsed after the filing of the application.

(3) A fee determined by the fee schedule shall be paid with the petition; if the said fee is not paid the petition shall not be considered filed.

(4) If a petition according to Section 28a has been filed previously the examination procedure shall begin only after disposal of the petition according to Section 28a. In addition, Section 28a, paragraph (2), sentences 2, 3 and 5, and paragraphs (3), (5) and (6), shall be applicable. If a petition filed by a third party is ineffective the applicant himself may file a petition within a period of three months from the service of notice, provided that the said period terminates later than the period specified in paragraph (2). If the applicant does not file a petition, a publication shall be made in the Patent Gazette (*Patentblatt*) referring to the publication of the petition filed by the third party that the said petition is ineffective.

(5) The examination procedure shall continue even if the petition for examination is withdrawn. In the case of paragraph (4), sentence 3, the procedure shall continue from the status at the time of filing of the applicant's petition for examination.

Section 28c.

(1) If the application does not comply with the prescribed requirements (Section 26), the Examining Office shall request the applicant to correct the deficiencies within a specified period. If, in the case of Section 27, submission of documents (copies of prior applications, specifications, drawings, etc.) is required, the said period shall be determined to end at the

earliest three months after the date of filing of the application.

(2) If, in accordance with Sections 1, 2, and 4, paragraph (2), the Examining Office reaches the conclusion that the invention is not patentable the said Office shall so advise the applicant, giving reasons therefor, and request a statement of his views within a specified period."

19. Section 29, shall be worded as follows:

"The Examining Office shall reject the application if the deficiencies specified in Section 28c, paragraph (1), have not been remedied, or if the application is maintained although no patentable invention is involved, according to Sections 1, 2 and 4, paragraph (2). Section 28, paragraph (3), sentence 2, shall be applicable."

20. In Section 30, paragraph (2), sentence 2, insert the word "also" before the word "against."

21. Section 30, paragraph (4), shall be worded as follows:

"(4) Publication shall be postponed at the applicant's request for a period of fifteen months from the date of filing of the application with the Patent Office or, if an earlier date has been claimed as determinative, from that date."

22. In Section 35, paragraph (2), sentences 2 and 3 shall be replaced by the following sentence:

"With the withdrawal or refusal, the effects of the provisional protection (Section 24, paragraph (5), sentence 1; Section 30, paragraph (1), sentence 2) shall not be regarded as having come into force.

23. The following paragraph (3) shall be added to Section 35:

"(3) If a petition for examination is not filed within the period specified in Section 28b, paragraph (2), or if the annual fee in connection with the application is not paid in due time (Section 11), the application shall be considered withdrawn."

24. In Section 36a, paragraph (3), sentence 2, the words "Sections 28, 29 and 33, paragraph (1)" shall be replaced by "Section 28b, paragraph (1), Sections 28c, 29 and 33, paragraph (1)"

25. Section 36d, paragraph (1), shall be worded as follows:

"(1) The Board of Appeals, when deciding cases relating to Section 14, paragraph (4), and Section 30a, paragraphs (1) and (2), shall consist of one legal member as chairman and two technical members; in cases relating to Section 36l, paragraph (3), and Sections 46b, 46c and 46e, of one technical member as chairman, two additional technical members, and one legal member; in cases relating to Section 24, paragraph (3), sentence 4, of one legal member as chairman, one additional legal member, and one technical member; and in other cases, it shall consist of three legal members."

26. Section 36g, paragraph (1), shall be worded as follows:

"(1) Proceedings before the Board of Appeals shall be public if the application has been published or if a notice announcing the accessibility of the files for inspection (Section 24, paragraph (4), sentence 1) has been published. The

provisions of Sections 172-175 of the Judiciary Act shall be applicable, provided that:

- (1) on petition by a participating party the proceedings shall not be public if they may prejudice the petitioner's interests deserving protection,
- (2) decisions shall not be made public until publication of a notice of accessibility of the files for inspection (Section 24, paragraph (4), sentence 1) or until publication of the application (Section 30)."

27. Section 36l, paragraph (2), sentence 3, shall be worded as follows:

"The appeal and all papers containing legal petitions or declarations for the withdrawal of an appeal or of a petition, shall be served officially to the other participating parties; other papers shall be served informally to the said parties if official service is not ordered."

28. In Section 36l, paragraph (4), sentence 3, the words "two weeks" shall be replaced by the words "three months".

29. The following paragraph (3) shall be added to Section 36p:

"(3) The Patent Court may countermand the contested decision without itself deciding the case on its merits if:

- (1) the Patent Office has not yet decided the case on its merits,
- (2) the proceedings before the Patent Office suffer from a substantial defect,
- (3) new facts or evidence have become known, which are important for the decision.

The Patent Office must base its decision on the legal judgment on which the countermand is based."

30. Section 41c, paragraph (3), shall be worded as follows:

"(3) For the grant of permission to inspect the files to third parties, Section 24, paragraph (3), shall be applicable. The request shall be decided by the Patent Court. Inspection of files of proceedings for the purpose of a declaration of invalidity of a patent shall not be authorized if and to the extent that the patentee proves a protection deserving interest to the contrary."

31. The following paragraph (5) shall be added to Section 43:

"(5) Paragraph (4) shall be applicable if the provisional protection (Section 24, paragraph (5), sentence 1, Section 30, paragraph (1), sentence 2) is reinstated."

32. Section 46b, paragraph (2), shall be worded as follows:

"(2) The grant of paupers' privileges shall release the applicant provisionally from payment of,

- (1) the filing fee, in the case specified in Section 4, paragraph (3), sentence 2,
- (2) the fees for petitions specified in Sections 28a and 28b,
- (3) the fee for appeal (Section 36l, paragraph (3)),
- (4) arrears and expenses accruing in the future, including compensation for witnesses and experts, as well as service costs."

33. Section 46b, paragraph (5), shall be worded as follows:

“(5) Paragraphs (1)-(4) shall be applied appropriately:

- (1) in cases specified in Sections 28a and 28b to the petitioning third party if he can substantiate a personal interest deserving protection,
- (2) in the case of Section 32 to the opposing party if the opposition is based on Section 4, paragraph (3).”

34. The following provision shall be introduced as Section 47a, after Section 47.

“Section 47a.

If, prior to the grant of a patent, rights are judicially established which are based on an application the files of which may be inspected by anyone (Section 24, paragraph (3), sentence 2, Nos. 2 and 3), and if the decision on a litigation depends from the fact that the subject matter of the application is provisionally protected (Section 24, paragraph (5), sentence 1, and Section 30, paragraph (1), sentence 2), the Court may order that the proceedings be deferred until the decision upon the grant of the patent. If a petition for examination as specified in Section 28b has not been filed, the Court may assign, at the request of the opposing party, to the party who has asserted rights on the basis of the application a time period for the filing of the petition for examination. If the petition for examination is not filed within that time period the rights involved in the litigation on the basis of the application may not be asserted.”

## Article 2

### *Amendment of the Trademark Law*

The text of the Trademark Law of May 9, 1961 (*Bundesgesetzblatt I*, pp. 549, 574), as amended by the law of July 21, 1965 (*Bundesgesetzblatt I*, p. 625), is amended as follows:

1. Section 2, paragraph (4), shall be worded as follows:

“(4) If the application is withdrawn before the Patent Office has decided publication thereof according to Section 5, paragraph (2), or has issued a rejection order, the fees paid for more than one class or subclass shall be refunded.”

2. The following sentence 2 shall be added to Section 3, paragraph (2):

“The Patent Office shall grant access to the files to anyone who substantiates a justified interest therein.”

3. Section 5, paragraph (6), sentence 2, shall be worded as follows:

“Section 33, paragraph (2), of the Patent Law shall be applicable, with the provision that the Patent Office may also rule that other costs incurred by the parties in the opposition proceedings, provided that they were necessary as determined by equitable estimate for suitable protection of the claims and rights concerned, be charged in whole or in part to one of the parties.”

4. The following paragraph (7) shall be added to Section 5:

“(7) If a mark on the basis of which opposition has been raised has been entered in the Trademark Register for at least five years at the time of publication of the pending mark, and if the applicant contests the use of the mark, the

opposing party must establish the presumption that he has used the mark within the last five years preceding the publication of the pending mark. Use of the mark by a third party with the consent of the opposing party is equivalent to the use by the opposing party. In its decision on the similarity of the marks the Patent Office shall consider only the goods for which the opposing party has established presumption of use. If the mark against which opposition has been raised was registered in accordance with Section 6a, and if opposition was raised against registration of the said mark, sentences 1-3 only shall be applicable if five years have elapsed since the termination of the opposition proceedings.”

5. Section 5, paragraphs (7) and (8), shall become Section 5, paragraphs (8) and (9).

6. In Section 6, paragraph (2), the following sentence shall be inserted after sentence 2:

“The suit must be initiated within one year from the date at which the decision establishing the similarity of the marks becomes final.”

7. In Section 6, paragraph (2), sentence 3, the words “in his favor” shall be replaced by the words “in favor of the applicant”.

8. In Section 6, the following provision shall be inserted as paragraph (3) after paragraph (2), and the present paragraph (3) shall become paragraph (4):

“(3) If the Patent Office has determined the similarity of a pending mark with one or more marks for which opposition has been raised, it may suspend proceedings on other oppositions until the decision on the registration of the pending mark is final.”

9. Section 6a, paragraph (3), sentence 3, shall be worded as follows:

“Section 5, paragraphs (3)-(7) and (9), shall be applicable to opposition proceedings.”

10. In Section 6a, paragraph (4), sentence 4 the words “sentences 2 and 3” shall be replaced by “sentences 2 to 4”.

11. The following sentence 5 shall be added to Section 6a, paragraph (4):

“Section 6, paragraph (3), shall be applicable.”

12. The following No. 4 shall be added to Section 11, paragraph (1):

“(4) If a trademark has been registered in the Trademark Register for at least five years, and if the mark holder has not used the mark within the last five years before the petition for cancellation, unless circumstances prevented his use during the said period. Section 5, paragraph (7), sentences 2-4, shall be applicable.”

13. In Section 11, paragraph (4), the words “and 4” shall be inserted after the words “in paragraph (1), No. 2”.

14. The following paragraphs (5) and (6) shall be added to Section 11:

“(5) If a trademark has not been used either within five years after registration or in the cases specified in Section 6a after termination of the opposition proceedings, the mark holder may not invoke use in connection with a petition for cancellation as specified in paragraph (1), No. 4 if

- (1) use was initiated only after the threat of petition for cancellation, or
- (2) use was initiated only after publication of a corresponding mark applied for in connection with identical or similar goods at a later date (Section 5, paragraph (2); Section 6a, paragraph (3)), and the applicant for the said mark or his legal successor has filed a petition for cancellation within six months from publication.

“(6) Paragraph (1), No. 1, shall not be applicable if, at the time of publication of the trademark of the party adverse to the petition (Section 5, paragraph (2); Section 6a, paragraph (3)), the conditions for cancellation of the trademark of the petitioner were present as specified in paragraph (1), No. 4.”

15. In Section 12, paragraph (2), No. 1, the numeral “8” shall be substituted for the numeral “7”.

16. Section 12, paragraph (3), shall be worded as follows:

“(3) The business of the Examining Office shall be conducted by a legal or a technical member (examiner), or by a senior grade official. The said official shall not be authorized, however, to order oaths, administer oaths, or to direct petitions to the Patent Court as specified in the Patent Law, Section 46, paragraph (2).”

17. Section 12, paragraph (5), sentence 1, shall be worded as follows:

“The Federal Minister of Justice shall be authorized to issue statutory orders

- (1) to delegate to senior grade officials the conduct of individual tasks incumbent upon the Trademark Divisions which entail no legal difficulty, except in the case of decisions on the cancellation of trademarks as specified in Section 10, paragraph (3), sentence 3, of the issue of expert opinions (Section 14), and of decisions to refuse the issue of expert opinions,
- (2) to delegate to middle grade officials the conduct of individual tasks incumbent upon the Examining Offices and Trademark Divisions which do not entail legal difficulty, except in the case of decisions on applications, oppositions and other petitions.”

18. Section 12, paragraph (6), sentence 2, shall be worded as follows:

“The said provisions shall apply to senior and middle grade officials, provided that they have been entrusted with the conduct of tasks incumbent upon the Examining Offices or the Trademark Divisions.”

19. The following provision, designated as Section 12a, shall be inserted after Section 12:

“Section 12a.

(1) The decisions of the Examining Offices and of the Trademark Divisions, issued by senior grade officials, may be responded to by an objection. The objection must be filed with the Patent Office in writing one month from service of notice. Section 34, paragraph (2), of the Patent Law shall be applicable.

(2) Decisions on the objection shall be made by one legal or one technical member. Section 36 l, paragraph (4), sentence 1, and paragraph (5), of the Patent Law shall be applicable.”

20. Section 13, paragraphs (1) and (2), shall be worded as follows:

“(1) Appeals from the decisions of the Examining Offices and Trademark Divisions shall be taken before the Patent Court, unless an objection is proper (Section 12a, paragraph (1)).

(2) If the appeal is from a decision relating to:

- (1) a trademark application, an opposition or a petition for cancellation; or
- (2) an objection against a decision as specified in No. 1, a fee as specified in the schedule of fees shall be paid within the period for appeal; if this fee is not paid the appeal shall not be considered filed.”

21. In Section 21, paragraph (1), the words “Section 11, paragraph (1), No. 1, 1a and 3,” shall be replaced by the words “Section 11, paragraph (1), No. 1, 1a, 3 and 4.”

22. The following paragraph (3) shall be added to Section 21:

“(3) In cases specified in Section 5, paragraph (7), and Section 11, paragraph (1), No. 4, and paragraph 5, use of a collective mark shall be recognized only if at least two members of the association use the mark.”

23. Section 28 shall be worded as follows:

“Section 28.

(1) Foreign goods which, illegally bearing the name of a German firm and locality or a legally protected trademark, enter the area of jurisdiction of the present law, for purposes of import or transit, shall upon petition by the injured party and deposition of security therefor be seized in order to remove the illegal mark.

(2) Seizure shall be effected by the customs authorities which shall also direct the necessary actions to be taken to remove the illegal mark. If the directions of the customs authorities are ignored or if removal is impracticable the customs authorities shall order confiscation of the goods.

(3) Seizure and confiscation may be contested by legal action as permissible in damage proceedings according to the law on illegal seizure and confiscation. The petitioner shall be heard in the legal proceedings.”

24. Section 34, sentence 2, shall be worded as follows:

“Seizure and confiscation shall be ordered by the customs authorities; Section 28, paragraph (3), shall be applicable.”

### Article 3

#### *Amendment of the Gebrauchsmuster (Utility Model) Law*

The text of the Gebrauchsmuster Law of May 9, 1961 (*Bundesgesetzblatt I*, pp. 549, 570), as amended by the law of July 21, 1965 (*Bundesgesetzblatt I*, p. 625), is amended as follows:

- (1) Section 2, paragraph (5), sentence 3, shall be deleted.
- (2) Section 3, paragraph (5), shall be worded as follows:

“(5) Anyone shall be granted access to the Register and to the files of registered Gebrauchsmuster, including the files of cancellation proceedings. In addition, the Patent Office shall grant access to the files to anyone upon request, provided

and to the extent that a justified interest has been substantiated."

3. Section 12, paragraph (2), shall be worded as follows:

"(2) The provisions of the Patent Law granting paupers' privileges (Sections 46a-46k) shall be applied appropriately to Gebrauchsmuster cases."

**Article 4**

*Amendment of the Law on Patent Office and Patent Court Fees*

The text of the law on Patent Office and Patent Court fees of May 9, 1961 (*Bundesgesetzblatt I*, pp. 549, 582) is amended as follows:

1. In Section 1, part A, the following provisions shall be inserted as Nos. 1a-1c after No. 1

"1a. Petition for ascertainment of documents to be cited (Section 28a) . . . . . 100.—

1b. Petition for examination of an application (Section 28b) if a petition according to Section 28a has already been filed . . . . . 200.—

1c. Petition for examination of an application (Section 28b) if a petition according to Section 28a has not been filed . . . . . 300.—"

2. Section 1, part C, No. 2 shall be worded as follows:

"2. Application class fee (Section 2, paragraph (3))

(a) first and second class, each . . . . . 40.—

(b) third and fourth class, each . . . . . 60.—

(c) all additional classes . . . . . 70.—"

3. In Section 1, part C, No. 3, the number "12" shall be replaced by number "75".

4. In Section 1, part C, No. 6, the number "60" shall be replaced by the number "200".

5. Section 1, part C, No. 8, shall be worded as follows:

"8. Extension of term of protection class fee (Section 9, paragraph (2))

(a) first and second class, each . . . . . 60.—

(b) third and fourth class, each . . . . . 80.—

(c) all additional classes, each . . . . . 100.—"

6. In Section 1, part C, No. 10, the number "50" shall be replaced by the number "100".

7. In Section 1, part C, No. 13, the number "75" shall be replaced by the number "150".

8. In Section 1a, parts A, B and C, every occurrence in No. 1, and in part C also in No. 3, the number "60", shall be replaced by the number "150".

**Article 5**

*Amendment of the Law on Employees' Inventions*

The text of the Law on employees' inventions of July 25, 1957 (*Bundesgesetzblatt I*, p. 756), as amended by the Law of March 23, 1961 (*Bundesgesetzblatt I*, pp. 274, 316), is amended as follows:

1. Section 17, paragraph (2), is cancelled, the present paragraph (3) shall become paragraph (2) and be worded as follows:

"(2) If the employer does not accept the capability of protection of an employee's invention he may refrain from obtaining a protection right if he appeals to the Arbitration Office (Section 29) to bring about an agreement on the capability of protection."

2. Section 17, paragraph (4), shall become Section 17, paragraph (3).

**Article 6**

*Amendment of the Law on the Accession of the Reich to the Madrid Agreement on the Suppression of False Indications of Source on Goods*

Section 2, paragraph (2), of the Law on the accession of the Reich to the Madrid Agreement on the Suppression of False Indications of Source on Goods, of March 21, 1925 (*Reichsgesetzblatt II*, p. 115), shall be worded as follows:

"(2) Seizure shall be effected by the customs authorities which shall also direct the necessary actions to be taken to remove false indications. If the directions of the customs authorities are ignored or if removal is impracticable the customs authorities shall order confiscation of the goods. Seizure and confiscation may be contested by legal action as permissible in damage proceedings according to the law on illegal seizure and confiscation."

**Article 7**

*Transitional and Final Provisions*

**Section 1**

*Patent Applications and Patents*

(1) In the case of patent applications for which, as of the effective date of the present law, the Patent Office has ordered publication, the hitherto existing provisions shall apply; however, in connection with the payment of annual fees for the third and every subsequent year beginning the day following the application date after the present law takes effect, the provisions of the patent law in the wording of the present law shall be applicable. The same provisions shall apply to still unpublished patent applications rejected by the Patent Office at the time the present law takes effect on the ground that no patentable invention exists according to Sections 1, 2 and 4, paragraph (2).

(2) Aside from this, patent applications still pending at the time the present law takes effect shall be subject to the regulations of the Patent Law in the wording of the present law with the following provisions:

1. Publication of the notice concerning the possibility of inspection of the files of unpublished patent applications (Section 24, paragraph (4), sentence 1) shall not occur until six months have elapsed after service of notice to the applicant or after a corresponding announcement is published by the President of the Patent Office in the Patent Gazette (*Patentblatt*), wherein the patent application shall be indicated in general form, and not before the period specified in Section 24, paragraph (3), No. 2, has elapsed. After publication of the notice according to Section 24, paragraph (4), sentence 1, the portions of the files of the said patent applications existing at the time the present law takes effect shall be laid open to

public inspection provided the applicant has not submitted new and complete papers (Section 26, paragraph (1)) by the end of the six month period. If new papers are submitted, public inspection shall be permitted only of papers which are to be identified by the Patent Office as having been newly submitted; in all other cases of inspection of papers of those applications existing at the time the present law takes effect, the hitherto existing provisions shall apply. The sequence of patent applications in connection with which a notification or announcement according to sentence 1 is issued shall be determined by the President of the Patent Office.

2. Section 28a shall not be applicable unless application thereof is specified in Section 28b.

3. A petition for examination (Section 28b) shall be permitted only after issue of the notification or announcement specified in No. 1. The period specified in Section 28b, paragraph (2), shall not expire before two years have elapsed after the said notification or announcement.

4. If the petition for examination is filed by the applicant, the fee for the petition (Section 28b, paragraph (3)) shall count toward the filing fee (Section 26, paragraph (2), sentence 1). The old regulations shall remain in effect with respect to the payment of the annual fees for patent years which have already begun before the present law takes effect.

(3) The regulations in force to date shall remain applicable to the inspection of the portions of files of published applications and issued patents, including the files of restriction procedures (Section 36a), already existing at the time the present law takes effect; in appeal cases the Board of Appeals, composed of one legal member as chairman, one additional legal member and one technical member, shall decide.

(4) In other cases, inspection of the files of the Patent Office shall be determined by the provisions contained in the present text of the Patent Law.

(5) Patent applications still pending at the time the present law takes effect and for which the Patent Office has not yet ordered publication, and inventions of articles of food and taste, medical preparations or other substances prepared by chemical methods shall be regulated by Section 1, paragraph (2), of the present text of the Patent Law. Patent applications shall be considered filed as of that date on which the inventions in the application papers are expressed such that utilization by others skilled in the art appears possible (Section 26, paragraph (1), sentence 4, of the Patent Law). Provisions according to which an earlier date may be claimed as determinative remain unaffected. The declaration of priority (Section 27, sentence 1, of the Patent Law) may be filed until the expiration of two months after the present law takes effect. Anyone who in this country has reduced to practice the subject of such a patent application or has made arrangements therefor prior to the date the present law takes effect, shall be authorized to utilize the subject of the patent application for the purposes of his own business in his own or in foreign plants; this authorization may only be devolved or transferred together with the business.

## Section 2

### *Trademarks*

In the case of trademarks registered in the Trademark Register at the time the present law takes effect Section 5, paragraph (7), Section 6, paragraph (2), and Section 11, paragraph (1), No. 4, and paragraph (5) of the Trademark Law, in the wording of the present law shall be applicable with the provision that the periods specified in these provisions shall not begin to run before the present law takes effect.

## Section 3

### *Fees*

(1) Fees due before the effective date of the present law shall be paid on the basis of the hitherto existing rates.

(2) If a fee for a petition or a legal action is due within three months following the effective date of the present law and paid in due time according to the old rates, the balance between the amount due in accordance with the old rates and the amount specified by the present law may be paid within a period set by the Patent Office one month after service of notice. If the balance is paid within the period set by the Patent Office, the fee shall be considered paid in due time.

(3) If a fee for the extension of the term of protection of a trademark is due within three months following the effective date of the present law and is paid in due time on the basis of the old rates, notice as specified in Section 9, paragraph (2), of the Trademark Law shall be served only for the balance between the fee paid and the fee due in accordance with the present law. The additional fee prescribed in the schedule of fees for late payment shall not be charged.

## Section 4

### *Publication of the Text of the Amended Laws*

The Federal Minister of Justice shall be authorized to publish the texts of the Patent Law, Trademark Law, Gebrauchsmuster Law, and Law on Patent Office and Patent Court Fees in the wording established by the Present law with the new date, and to eliminate any discrepancy of wording.

## Section 5

### *Application to the Land Berlin*

According to the provisions of Section 13, paragraph (1), of the Third Transitional Law of January 4, 1952 (*Bundesgesetzblatt* I, p. 1), the present Law shall also apply to the Land Berlin. Statutory orders issued on the basis of the present law shall apply to the Land Berlin according to Section 14 of the Third Transitional Law.

## Section 6

### *Effective Dates*

(1) Article 2, No. 23 and 24 and Article 6 shall come into force the day after the publication of this law.

(2) Article 1, No. 1, Article 2, No. 1-22 and Article 7, Section 1, paragraph (2), No. 1, paragraph (5), Sections 2 and 4 shall come into force on January 1, 1968.

(3) The other provisions of the present Law shall come into force on October 1, 1968.

# NEW PLANT VARIETIES

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

### Ratification

#### NETHERLANDS

The Government of the Netherlands has ratified the International Convention for the Protection of New Varieties of Plants, signed in Paris on December 2, 1961<sup>1)</sup>. The instrument of ratification was deposited with the French Government on August 8, 1967.

It will be noted that the United Kingdom of Great Britain and Northern Ireland and the Netherlands are the first two countries to have ratified this Convention, which will come into force, in respect of those States which have ratified it, thirty days after the deposit of the third instrument of ratification [Article 31 (3)].

<sup>1)</sup> See *Industrial Property*, 1962, pp. 6 *et seq.*

# CORRESPONDENCE

## Letter from France \*)

By Paul MATHÉLY  
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(Second Part)

### Trademarks

#### Legislation

(1) A Law of December 31, 1964, already amended by a Law of June 23, 1965, instituted a new marks régime in France.

This régime came into force on August 1, 1965.

It is known that the reform covered essentially the following points:

- (a) a mark may designate services as well as manufactured or commercial goods;
- (b) the right to a mark is no longer derived from usage but from the registration of the deposit; the Administration is empowered to reject a deposit not only on the ground that it does not comply with requirements as to form, but also on the ground that it pertains to a mark that is not validly protectable;

\*) BIRPI translation. The first part of this "Letter" was published in *Industrial Property*, October 1967 issue, pp. 250 *et seq.*

- (c) the deposit is made for a period of 10 years instead of 15 years; however, it may be renewed any number of times;
- (d) the owner's rights may be forfeited if his mark has not been used for five years at the time the request for cancellation is made;
- (e) there is a special statute on collective marks.

(2) A problem concerning the transition from the old régime to the new one has already had to be settled in court.

The problem related to the application of Article 11 of the new Law, which provides for the cancellation of a mark that has not been used for over five years.

The question was whether cancellation could be imposed on a mark filed in due and proper form under the old Law of June 23, 1857, and unused for over five years at August 1, 1965, the date on which the new Law came into force.

Under the old régime, the deposit sufficed to confer ownership rights in respect of the mark, without there being any obligation to use it.

It has just been ruled that cancellation cannot be imposed on a mark appropriated when the old Law was in force, unless the five years of non-use required under the new Law have elapsed under the régime of that Law (Seine Court of High Instance, November 17, 1965, *Ann. prop. ind.*, 1965, p. 85; confirmative judgment of the Court of Paris, July 1, 1967, unpublished).

In the first place, this ruling is in conformity with the general rules of law on the application of new statutes as regards time. New statutes apply from the date of their entry into force; however, they apply to situations already in existence at that date and apply not only in their effects but also in their requirements. Consequently, the old marks in force at the date on which the new statute becomes applicable risk the sanction of forfeiture, but it is also necessary that the requirements of such forfeiture be fulfilled, that is, that there be a five-year period of non-use counted from the date on which the new Law became applicable.

The ruling is further in line with the rule of the preservation of acquired rights, laid down in Article 35 of the Law. Under the old Law, the depositor had the possibility of preserving his right without the obligation of using it: he may not be deprived retroactively of that right.

#### Validity of the Mark

(1) A Court of Paris judgment of November 10, 1964, sets forth in excellent terms the requirements a sign must fulfill in order to constitute a valid mark (*Ann. prop. ind.*, 1965, p. 74).

A sign does not have to be original or new *per se* in order to be a valid mark, for the right to a mark is not a right of creation but a right of possession.

Although it does not have to be original, the sign must at least be distinctive as regards the goods identified. A sign is distinctive as long as it is neither necessary nor common and is not merely descriptive of the nature, basic qualities or intended purpose of the goods.

Finally, the sign may be distinctive in itself or, under the terms of Article 6<sup>quinquies</sup> C(1) of the Paris Convention, it may

acquire such distinctiveness by having been known and used for a long period of time.

The Court thus held that the name "Calor" was a valid mark for the identification of household electric apparatuses. As a matter of fact, although the French meaning of the Latin word *calor* may be known to the public, as an independent, common word, it does not belong to the stock of words making up the French language or even the vernacular; and it is not necessarily descriptive of the purpose, nature or function of the goods so identified, all the more so in that the use of the "Calor" mark in France has been well known for a long time owing to the wide circulation of goods bearing the mark and the fact that it has been intensively advertised.

(2) A Court of Colmar judgment of November 10, 1960, had annulled the "Reine des bières" mark identifying a beer on grounds that the name was no longer of any originality in view of the many deposits of marks that included the words "roi" (king) or "reine" (queen) in respect of the most diversified goods, so as to commend their qualities.

However, in a decision of December 22, 1964 (*Ann. prop. ind.*, 1965, p. 71), the Court of Cassation reversed the judgment on grounds that the lower court had not found the name "Reine des bières" to be in common use and hence to have fallen in the public domain at the date of the first deposit, and that the decision had not sought to determine whether or not the expression, taken as a whole, was distinctive.

(3) In a judgment of November 27, 1963 (*Ann. prop. ind.*, 1964, p. 136), the Court of Cassation upheld a decision validating the "Miel Epil" mark identifying depilatories.

The Court felt that the name could constitute a valid mark because, regardless of the fact that, taken separately, the two elements of which the mark was composed were of no originality, this was not so when they were combined, since the combination made of them was neither necessary nor usual but, on the contrary, arbitrary and fanciful.

It was added that the mark could not be considered misleading on grounds that the product did not contain honey: the purchaser of a depilatory cream does not think of the properties of honey, which has never been regarded as having hair-removing qualities; he merely looks upon the product as having the softness of honey.

(4) On the other hand, the Supreme Court held, in a judgment of February 11, 1964 (*Ann. prop. ind.*, 1964, p. 140), that the name "pratiquement incassable" ("practically unbreakable") identifying glassware articles could not be protected.

Solidity is, in fact, specifically sought by the purchasers of glassware; the adjective "incassable" — whether accompanied by an adverb or not — is in constant use and cannot be monopolized at the expense of the competitors.

(5) Lastly, an interesting decision was handed down in respect of the mark "Super Production Seve" identifying bean seeds (Court of Cassation, February 20, 1964; *Ann. prop. ind.*, 1964, p. 144).

There is a regulation in France setting up a catalogue at the Ministry of Agriculture for types and varieties of plants: such varieties must be listed in the catalogue under a name which becomes compulsory.

Consequently, the listed name cannot be the subject of privative appropriation as a mark, for such appropriation would give the owner a monopoly on the production and sale of the variety, which is contrary to the principle of free trade.

#### *Articles Identified by the Mark*

May a mark identify a periodical? In other words, may the title of a periodical be protected by the deposit of a mark?

The Court of Paris, in a judgment of February 3, 1965 (*Ann. prop. ind.*, 1965, p. 180 and the commentary of G. Gaultier), answers this question in the affirmative.

Until now, the problem had been discussed by scholars, but case law was doubtful.

Some recent decisions had recognized that a title was a distinctive sign *sui generis*, and that usurpation thereof was simply repressed by the rules governing unfair competition.

The judgment cited above states that none of the provisions of the Law on marks restricts the nature of the goods in respect of which the mark is used.

A periodical, be it a review or a newspaper, is certainly merchandise which is put on the market and which, like any other merchandise, is worthy of being individualized by a mark.

The title of a review, if filed as a mark to identify publications, newspapers, periodicals and books, listed in classe 16 of the administrative classification, enjoys the protection granted to marks: any usurpation of the title, in any form or manner, is thus reprehensible.

#### *Mark Ownership*

It is a rule of law in France that the mark is independent both of the person of the owner and of the goodwill in respect of which it is used.

As a result, a person may be the legitimate owner of a mark even if he does not have the power or capacity to use it.

The Court of Cassation called this to mind in a judgment of June 16, 1964, ruling that a non-pharmacist could own a mark intended to identify pharmaceutical specialities, and that he could make use of it by licensing pharmacists to exploit it (*Ann. prop. ind.*, 1964, p. 26).

#### *Scope of the Right*

It is established that the deposit of a complex mark protects not only the mark taken as a whole but also each element of the mark taken separately, provided that each such element is distinctive *per se* as regards the goods identified, and constitutes an essential characteristic part of the mark.

The Court of Cassation therefore upheld, in a judgment of May 11, 1964 (*Ann. prop. ind.*, 1964, p. 257), a decision protecting the word "Ski" on the basis of the deposit of a mark comprising, apart from the word "Ski", the sub-title "Exquis" and a device showing a skier in the snow.

#### *Damage to the Right in a Mark*

(1) A mark is infringed by its reproduction alone, irrespective of what any other circumstances may be.

Hence, there is no need to determine whether the reproduced mark has been used: under the terms of the Law, the infringement of a mark and the use of an infringed mark are two distinct offenses. In all likelihood, the mark would have to have been reproduced with a view to using it for the infringement to be punishable. It is enough, however, that the mark has in principle been intended for use: the specific use does not have to have been decided and it is not necessary to know whether or not it will be effected.

Consequently, the manufacturer of a wrapper that is protected as a mark is, himself, the infringer of the mark even though he does not market the goods identified by the mark (Court of Cassation, March 18, 1964; *Ann. prop. ind.*, 1964, p. 255).

Likewise, the reproduction of the mark constitutes the offense of infringement without its being necessary to find out whether it might result in any confusion, in the mind of the purchaser, as to the nature or source of the goods marked. The reproduction itself suffices for the offense to exist: confusion does not have to have resulted or have been possible (Court of Cassation, December 22, 1964; *Ann. prop. ind.*, 1965, p. 71).

(2) It is rare that a mark is simply reproduced. More often than not, the mark is altered, especially by the addition of a different element.

(a) It is an established rule in case law that infringement is not removed by the addition of another element to the reproduced mark, where such element remains distinct from the mark.

Difficulties arise, however, when the added element and the reproduced mark form a whole. In such a case, the damage to the mark must usually be judged within the framework of fraudulent imitation rather than infringement. Moreover, where the mark loses its individuality and distinctiveness in the composite design formed of the reproduced mark and the additions made to it, there is no imitation.

(b) The name "Clareski" was thus held to be an illegal imitation of the mark "Ski" because the essential element of the "Clareski" mark is the ending "Ski", and it is always that ending which attracts attention (Court of Cassation, May 11, 1964; *Ann. prop. ind.*, 1964, p. 257).

In the same vein, the name "Tricobel" was deemed to be not simply an imitation but, indeed, an infringement of the mark "Bel", deposited in respect of hosiery and knitted goods. Despite the addition of the prefix "Trico", the name "Bel" retains its consonance as well as its individuality; what is more, the use of the prefix "Trico", a generic phonetic indication of the goods identified, puts the accent on the syllable "bel" and causes it to be stressed (Seine Court of High Instance, November 25, 1963, final; *Ann. prop. ind.*, 1964, p. 263).

Similarly, it was held that the name "Fargas" infringed the "Far" mark, used in respect of gas apparatuses: in fact, regardless of the particular phonetic and visual aspect of the two syllables combined together to form the name "Fargas", this name represents a derivative of the "Far" mark, especially since the latter mark is used in respect of

gas apparatuses (Court of Lyons, February 11, 1965; *Ann. prop. ind.*, 1965, p. 192).

(c) On the other hand, in a judgment of November 7, 1963 (*Ann. prop. ind.*, 1964, p. 159), the Court of Paris held that the name "Sonorama" was neither an infringement nor an imitation of the "Sonora" mark. Despite the fact that "Sonorama" does reproduce the three syllables So-no-ra, the general effect of each word is such that no confusion between the two is possible, for the public — accustomed to words like Cinerama — notices essentially the combination "orama." As a result, the name "Sonorama" is visually and phonetically quite different from the mark relied upon.

(3) Although, in the pharmaceutical field, imitation is judged according to the normal rules, it is agreed that the average consumer — through whose eyes the possibility of confusion must be assessed — is of necessity more attentive as regards pharmaceuticals. The choice of a pharmaceutical is, in fact, important, and the consumer is guided in this choice by his doctor and by the pharmacist.

The Court of Paris, in two judgments of March 17, 1964 (*Ann. prop. ind.*, 1964, p. 162), kept this consideration in mind. The Court held that the "Quinosol" and "Chinosol" marks were imitated by the "Cynosol" mark but not by the "Mycosol" mark.

(4) On May 14, 1963 (*Ann. prop. ind.*, 1965, p. 81), the Court of Aix-en-Provence delivered a judgment deserving of attention: it stated that the use of what might be called an "appeal" mark constituted injury to the owner's rights in the mark.

In his advertisements, a tailor offered the well-known "Sportex" cloth for sale but, being in possession of only a very small stock of such cloth, he was not in a position to keep his promises.

It was the opinion of the Court that, by using the "Sportex" mark in his advertisements, the tailor was usurping, for his personal profit and at the expense of the owner, the mark's prestige and selling power; by so doing, he had injured the owner's rights in the mark.

(5) The question of the compensation awarded to the owner of a mark in cases of injury to his rights does not generally give rise to as many difficulties as it does in patent matters.

In a judgment of January 15, 1959 (*Ann. prop. ind.*, 1965, p. 191), the Court of Cassation referred to the principle that, in matters of mark infringement, the settlement of damages should be made in accordance with the general rules of law. Hence, the earnings of which the owner had been deprived should be taken into account — that is, the profits the owner would have made on sales that were lost because of the infringement.

#### *Seizure on Importation*

The Court of Paris, in a judgment dated June 29, 1962 (*Ann. prop. ind.*, 1965, p. 201), applied Article 9 of the Paris Convention.

Article 9 states: "All goods unlawfully bearing a trademark or trade name shall be seized on importation into those countries of the Union where such mark or name has a right to legal protection."

In pursuance of this provision, the owner of a mark filed in France in due and proper form has the right to have seizure made of imported merchandise bearing his mark; the seizure proceedings, which must be used, are set forth in the Law of June 23, 1857, on marks.

#### *Warning the Infringer*

It is common practice for the owner of a mark to instruct his attorneys to warn the infringer before he takes legal action.

In a judgment of May 23, 1964 (*Ann. prop. ind.*, 1964, p. 266), the Court of Cassation held that such a warning served a legitimate purpose and did not constitute misconduct, especially where it contains no affirmation of the other party's guilt; this means that the warning must be made with restraint and not include any threats.

#### **Name - Sign**

(1) It may be said that any person or entity has the right to protect his or its name.

This is true not only for surnames and trade names but also for the names of non-commercial associations.

The Court of Cassation referred to this principle in a judgment of July 15, 1963 (*Ann. prop. ind.*, 1964, p. 170) concerning a riding club established in the form of a registered association with the name "Club hippique d'Aix-en-Provence."

An appellate court had non-suited the club in its action to prevent another club from using the name "Club hippique d'Aix-Beauvallon."

The Supreme Court reversed the decision of the appellate court on grounds that it had not ascertained whether the name of the plaintiff association was an original one that could be the subject of a privative right.

(2) The Court of Paris delivered a judgment of interest on March 17, 1964 (*Ann. prop. ind.*, 1964, p. 27).

There is a company called "Paris-France," founded 60 years ago, that runs a chain of wholesale and retail stores all over the country. Recently a company, whose purpose is the promotion of building construction, was formed under the business style "Constructions Paris-France." The "Paris-France" company petitioned the judge to prohibit the "Constructions Paris-France" company from using the words "Paris-France."

It could not be the usurpation of a trade name that was involved. It is, in fact, known that a trade name becomes appropriated only in regard to the field of activity of the establishment it identifies. In the present case, the activities of the two companies concerned were quite different.

But the Court nevertheless issued an interdict prohibiting the second company from using the name "Paris-France."

The Court made a noteworthy distinction between the trade name, identifying the establishment, and the business style, identifying the legal entity of the company. The trade name may be special, but this is not so for the business style.

Consequently, the use of the same — or almost the same — business style, even in a different field of activity, may constitute a transgression if it creates confusion as to the identity of the company.

This is what had happened in the case under discussion and this is why the interdict was issued.

(3) There is an interesting judgment on the protection of a sign which should be mentioned.

The celebrated Paris cabaret "Maxim's," belonging to the English company Maxim's Ltd, is well known. Not too long ago, a nightclub also called "Maxim's" opened in Nice.

At the request of Maxim's Ltd, the Court of Aix-en-Provence, in a judgment of May 12, 1964 (*Ann. prop. ind.*, 1965, p. 88), prohibited the Nice cabaret from using the name "Maxim's."

The opinion of the Court was that such use would constitute unfair competition. As a matter of fact, said the Court, the name of the Paris restaurant is known internationally, the customers who go to the Paris and Nice establishments are in part the same, and the use by the Nice establishment of the name "Maxim's" might make it less glamorous and reduce its power of attraction.

#### **Economic Freedom - Unfair Competition**

##### *Restrictions on Economic Freedom*

The rules laid down by case law regarding the restrictions that can be made on economic freedom are quite consistent and can be summed up as follows:

(i) economic freedom may be restrained by the contract between the parties, provided that such contract does not imply a general and absolute interdiction, unlimited in both time and space;

(ii) the breacher is accountable for the breach of a validly concluded contract restricting economic freedom; he may be sued for damages and, in certain exceptional cases, his prohibited activities may be stopped by injunction;

(iii) a third party who becomes an accomplice to the breach of contract is also accountable.

This is what was ruled in two Court of Paris judgments in particular, dated December 23, 1963, and February 5, 1965 (*Ann. prop. ind.*, 1965, p. 103 and 274).

Another Court of Paris judgment, of April 23, 1963 (*Ann. prop. ind.*, 1964, p. 295 and the note of G. Gaultier), dealt with the employee who undertakes temporarily not to re-establish himself after leaving his job. The judgment stated that the employee, if he disregards the interdiction, may be held responsible but that the third party who engages him cannot be deemed to have acted with knowledge of the facts if the testimonial provided by the previous employer made no mention of the interdiction.

##### *Prohibition of Agreements in Restraint of Trade*

(1) New opinions of the Technical Agreements Committee have been published.

One such opinion deserving of special mention is that of June 22, 1962 (*Ann. prop. ind.*, 1964, p. 9). It states that the prohibition of agreements applies to industrial property contracts in cases where the holder of the right does not restrict himself to granting a license but imposes conditions intended to reduce competition among licensees and thwart competition from third parties.

(2) Where an agreement has been judged unlawful, competitors outside the agreement may request the parties to the agreement to repair the damage caused to them (Court of Cassation, March 13, 1963; *Ann. prop. ind.*, 1964, p. 26).

#### *Refusal of Sale*

The Law represses an industrialist's or tradesman's refusal to sell and deliver his goods.

A serious problem comes up when the manufacturer has organized a network of license-holders to whom he has guaranteed exclusive rights for the distribution of his production.

Can the manufacturer, without laying himself open to the sanctions of the Law, refuse to sell to a retailer not belonging to the network of license-holders, by maintaining that the requested merchandise is not available to him?

The Court of Cassation has replied, in particular in a judgment of October 22, 1964 (*Ann. prop. ind.*, 1965, p. 109), that the existence of an exclusive license agreement can justify refusal to sell only where, under the terms of the agreement, the co-contracting parties themselves have reciprocally restricted their own trade freedom and where it is established that the purpose or result of the said agreement does not limit, even indirectly, the license-holder's freedom to fix, as he sees fit, the sales price of the product but is intended, on the contrary, to ensure better service to the consumer.

#### *Facts Constituting Unfair Competition*

Unfair competition may take innumerable forms.

The following types of unfair competition can be cited as examples.

It is an established rule that the manufacture and sale of spare parts is lawful where such parts are not protected by a patent. However, those who manufacture and market such parts, and who are obliged to specify the intended purpose of the parts in order to sell them, must nevertheless take every precaution to avoid any possibility of confusion between their parts and the original parts.

Anyone, therefore, who sells attendant parts marked "original quality" is guilty of unfair competition: as a matter of fact, although the expression is not "original parts," the purchaser is nevertheless struck by the word "original" and may be led into error (Court of Paris, March 11, 1963; *Ann. prop. ind.*, 1964, p. 63).

Copying of the manner in which goods are presented constitutes unfair competition. This was true of a tradesman who offered a set of bath towels for sale that was a slavish imitation of a competitor's set, as both sets included the same number of articles made of the same cloth and bearing the same decoration (Court of Paris, November 3, 1964; *Ann. prop. ind.*, 1965, p. 96).

While it is still unlawful to discredit a competitor, a product may be criticized independently of the manufacturer; however, such criticism must be objective and restrained. In a judgment of June 19, 1963 (*Ann. prop. ind.*, 1965, p. 250), the Court of Paris convicted a polemist who had led a campaign against bakery bread by making charges excessively devoid of objectivity and not based on unquestionable scientific findings.

An industrialist was held to be an unfair competitor for having published tracts referring to the legal texts governing his manufactures when the references to these texts were made with the sole intention of criticizing competitors and the purpose of the tracts was to attract customers, not to give objective, unbiased information to the users (Court of Paris, June 6, 1964; *Ann. prop. ind.*, 1965, p. 283).

### Letter from Scandinavia\*)

By Professor Berndt GODENHJELM, Helsinki

In connection with the Intellectual Property Conference of Stockholm, 1967, it seems appropriate to note the extensive development of Scandinavian legislation in the field of intellectual property which has taken place in recent years. New Acts have been passed in some fields; in others, preparatory work is in progress or almost complete. Governmental committees in the various countries have worked closely together to attain maximum uniformity of legislation. This cooperation was originally undefined, but the 1962 Treaty of Helsinki provided legislative support by defining, to a certain extent, the scope of the cooperation in various fields of law. As a rule, the national committees have not only held inter-Nordic plenary meetings but have also set up joint drafting committees. Analysis of individual matters related to the legislation in question has been assigned to the national committees, where the various questions are discussed on the basis of personal or other memoranda before the final reports of the committees are decided on. Mutual assistance has thus given rise to thorough discussions and resulted in Acts which, in essence, are uniform.

The chief aim of the Stockholm Conference was to revise the Berne Convention; here it may be noted briefly that the Scandinavian countries have, after a long period of preparation, recently adopted new Copyright Acts. The Swedish Act on copyright in respect of literary and artistic works is dated December 30, 1960, and the corresponding Finnish Act, July 8, 1961. The Danish and Norwegian Copyright Acts are dated May 31, 1961, and May 12, 1961, respectively.

I shall now turn to the present situation as regards the protection of industrial property.

I. — In the matter of *patent law*, I refer readers to my article, "The Scandinavian Patent Community" (*Industrial Property*, 1965, pp. 10 *et seq.*). Bills for new patent legislation were introduced last autumn in the Parliaments of the Scandinavian countries. The Bills are based largely on the recommendations submitted in the reports of the Scandinavian patent committees, but certain alterations have been made. One of the most important of these is that the name of the inventor must always be cited in the patent application. The preliminary report of the committees, dated December 1961, included a regulation on "establishment inventions." Where an invention was the result of cooperation among several persons within one enterprise so that it was impossible to describe a

\*) BIRPI translation.

specific person as the inventor, then the enterprise was to be entitled to apply for a patent in its own name. Preparatory discussion of the recommendations to be submitted by the committees showed that there was considerable opposition to the rule as suggested, and, in their final report, the committees attempted to arrive at a compromise solution. The outcome was that no rule on establishment inventions was laid down, but, while the inventor himself was entitled to insist on the inclusion of his name in the patent, there was no obligation for the applicant to mention the inventor as such in the patent application. Two members of the Swedish committee (Messrs. Reiland and von Zweigbergk) expressed reservations with regard to this solution, holding the view that the applicant should be obliged to mention the inventor in the patent application. After the recommendations had been discussed, the Bills were drawn up in accordance with that view.

The drawing up of the Bills themselves involved close cooperation among the Scandinavian countries; likewise, at the time of the parliamentary discussions, three joint meetings of representatives of the Parliaments from each country were held. The purpose of these meetings was to avoid separate amendments in the final Patent Acts of each country, but, although the discussions were very useful, it appears that some minor divergences were unavoidable. These are not of such a character as to hinder the establishment of the system of "Nordic patent applications." It seems, however, that the entry into force of the said system will be postponed until the aim mentioned above has been reached. The Bills for new patent legislation are, it is true, based on the principle that the earlier barring from patentability of chemical products, food products, and medical products should end, but the transitional provisions provide that food and medical products will continue to be unpatentable, as products, until this is otherwise stipulated by administrative edict (and it seems that, so far as Denmark is concerned, methods for producing food products will also be barred from patentability). This system makes it possible to await international development before abolishing these bars. Until then, it will remain possible to issue patents only for methods of making food and medical products (also taking into account the above mentioned Danish bar).

In the statements accompanying the patent committees' reports with the recommendations for new Patent Acts, including the introduction of a system of "Nordic patent applications," the need for a common Scandinavian appeal instance was emphasized. The question also came up before the Nordic Council, which recommended investigation. Committees were set up in the Scandinavian countries, except for Iceland, which took no active part in the patent question. The committees, working together, have formulated a preliminary draft convention for a common Scandinavian appeal instance, the "Nordic Administrative Supreme Court of Patents," which, along with attendant matters, should be submitted to the relevant ministries of the countries concerned during the course of the year. It is too early to give a more detailed account of the deliberations of the committees, as the report has not yet been submitted. Work seems to be progressing favorably, and I hope to be able to return to this question later.

It may here be noted that legislation on *employees' inventions* has also involved Scandinavian cooperation. In Finland, the rules on this are at present contained in the Patent Act and must be made into a separate Act in connection with the new, uniform legislation. With this in mind, and since legislation in this field was of current interest in Norway which had hitherto lacked provisions on the subject, all the Scandinavian countries worked on the question. Sweden had had a separate Act on employees' inventions since 1949, but a possible revision of this Act was contemplated. In Denmark, the Act of 1955 was considered satisfactory, but it was thought useful for that country to follow developments in the other Scandinavian countries. Close cooperation resulted in similar recommendations, in the committees' reports, for legislation on the matter in all four countries. In Sweden, however, the discussion of the recommendations submitted was particularly negative in tone, and it seems unlikely that the recommendations will lead to any legislative measures in that country. In Norway and Finland, Bills based on the recommendations have recently been submitted to Parliament. In these circumstances, it seems unlikely that Denmark will change her present Act. The state of the present legislation in this field is very different in the Scandinavian countries. The Finnish Patent Act largely gives the employer rights in the inventions of persons in his employment if such inventions fall within the sphere of the employer's activities. The Swedish Act in principle gives the employer such rights only in the case of "research inventions." The Danish Act adopts an intermediary position. However, in contract practice, many departures from the provisions of the Act have occurred in Sweden. The recommendations in the Scandinavian reports were influenced by the provisions of the Swedish Act, but draw the line between the rights of the employer and those of the employee somewhat to the advantage of the employer. The Norwegian report had such a warm reception that its recommendations were adopted in Norway's collective agreements. It is in my opinion regrettable — especially in view of the Scandinavian labor market — that the provisions of the Acts governing employees' inventions will not be made uniform throughout Scandinavia.

II. — Scandinavian cooperation in the *trademark* field has already led to new Trademark Acts. Earlier legislation in Sweden and Finland went back to the Swedish Ordinance of 1884 on the protection of trademarks and the corresponding Finnish Ordinance of 1889, based in essence on the Swedish one. Later, certain significant changes were made in these statutes. In Denmark and Norway, the Trademark Acts of 1890, resulting from Scandinavian cooperation, were superseded by more recent Acts, the Danish Act dating from 1936.

The older trademark legislation was based on the principle of registration as a prerequisite for the protection of a trademark. A certain relaxation of this principle developed in that an established trademark was recognized as being an obstacle to the registration, by another party, of an identical or similar trademark. This reform was put through in Finland by an amendment to the Act in 1953; the other Scandinavian countries had made corresponding changes in the 1930s. The proprietor of a registered trademark was not entitled to object

to the use of an unregistered, established trademark. The new Trademark Acts — the Danish Act of June 11, 1959, the Swedish Act of December 2, 1960, the Norwegian Act of March 3, 1961, and the Finnish Act of January 10, 1964 — go all the way and, in principle, put established trademarks and registered trademarks on an equal footing. An express clause in each Act provides that an established trademark is one that, in the interested commercial or consumer circles of the country concerned, is generally known as distinctly identifying the proprietor's goods. In cases of rivalry between an established and a registered trademark, priority goes to the one which can prove earlier right. There are two exceptions to this rule. First, if a registered trademark which has come into use is liable to cause confusion with an older established trademark which has not been registered, the use of the more recent trademark cannot be prohibited, provided the registration was applied for in good faith and has been valid for five years before a declaration of its invalidity is sought. Secondly, if an established trademark is liable to cause confusion with the trademark of another party which was registered or established earlier, and if the proprietor of the older trademark has not protested within a reasonable period against the use of the more recent one, he can no longer prevent its use. We have here, then, an effect of "passivity" in favor of the proprietor of a more recent trademark. In such controversies as I have mentioned, however, the court may, depending on circumstances, decide that it is reasonable to allow the use of one or both trademarks only in a special way, for example in a particular design or with the addition of a place name or in some other distinct manner.

In the matter of where the right to trademark protection originates, the Scandinavian countries have chosen a solution which takes into due consideration the actual circumstances and the interests of commercial and industrial life without disregarding the need for security of protection. For a trademark to be considered established, its adoption alone is not enough; it must have become generally known among the commercial or consumer circles concerned. There can be no doubt that this significantly reduces the risk of controversy between the trademarks of different commercial bodies. There is, however, a difference between the solutions found in the Finnish and Swedish Trademark Acts on the one hand and those found in the Danish and Norwegian Acts on the other; the latter Acts state (Section 3(3)) that it is also prohibited to use any mark which is liable to be confused with a trademark already in use in Denmark or Norway by another party. Internationally speaking, it is interesting to note that in other countries there is a strong tendency to provide only one basis for the right to trademark protection, that is, registration (cf. the discussions on this subject in IAPIP).

On the question of what may constitute the subject matter of rights in a trademark, the new legislation, with the legal rules presented in a more logically correct form, shows a significant development with respect to the earlier law. Opinion long ago veered away from the idea that the trademark had to represent some kind of figure — even if it consisted of words — and it was recognized that it could consist of a specially devised word which did not indicate the type, quantity

or any other feature of the article. The new Trademark Acts give a statement of principle in Section 1 to the effect that the trademark may consist of a figure or of one or more words, letters or numbers. Only later, in connection with the requirement for distinctiveness, is it stipulated that a trademark which, as it stands or with only slight alteration, indicates the nature, composition, quantity, purpose, origin, or date of manufacture, of the article, is not considered distinctive *per se*. In judging distinctiveness, note must be taken of all material circumstances, particularly the length of time and extent of the trademark's use. A trademark which is not distinctive *per se* may thus become registrable through being established. On this point, the Swedish committee's report (*Statens offentliga utredningar* 1958: 10, p. 273) suggests a practice for judging distinctiveness that is somewhat more lenient than the previous one.

Section 1, mentioned above, goes on to extend the concept of a trademark to cover the distinguishing guise of the article or its packaging, a sign of identification which could not have been registered under the earlier legislation.

Finally, Section 1 of the new Acts provides that what is said of goods shall be correspondingly adapted to services supplied by commercial or professional enterprises. Thus the service mark is put on an absolutely equal footing with the trademark proper. In Denmark, even before the Trademark Act, 1936, the registration authority had adopted the practice of recognizing registration by commercial enterprises other than those which simply sold goods, and the Act of 1936 was considered to provide legislative sanction for this practice. In Sweden and Norway, too, though not in Finland, registration practice had been liberal with regard to what trademarks could be applied to. Registrations were granted to such enterprises as shipowners, airlines, express offices and garage firms. The new Trademark Acts go all the way and even the new Finnish Act affords protection to service marks.

The distinctive signs discussed above can be protected by registration (Section 1) or by establishment (Section 2). The new Acts provide that slogans used by those in commerce as separate distinctive signs are afforded equal protection in Finland and Sweden by, and only by, establishment, and in Denmark and Norway also by registration. The report of the Swedish committee (*Statens offentliga utredningar* 1958: 10, p. 95) points out, however, that it may sometimes be difficult to draw the line between registrable trademarks consisting of words and unregistrable slogans. It has happened that marks consisting of words with something of the character of slogans have been registered, but it is thought that, in general, it should not be difficult to draw the line, as slogans are normally in the form of a sentence.

As regards the procedure for the registration of trademarks, it need only be said that the examination of the registration authority is combined with an opposition procedure. If the authority finds that there are no obstacles to registration, the application is published in the Trademarks Journal. Anyone wishing to oppose the application must do so, in writing, within two months of the date of publication. In this way, a procedure has been established which is in conformity with the procedure for patent applications.

According to the earlier law, trademarks could only be assigned together with the goodwill in respect of which the trademark was used. The Danish Trademark Act of 1936 introduced a change in this, stating the principle of the right to free assignment. This was partly prompted by the fact that limitation of the right to assign was based on predominantly theoretical considerations. In practice, it was simple to circumvent a prohibition. The amendment of 1953 relaxed the Finnish Trademark Ordinance in the matter of assignment by providing that a trademark could be assigned together with the goodwill or a portion thereof. Even earlier, circumstances after the Second World War had necessitated a waiving of the requirement for assignment only with the goodwill, in the assignment of German-owned trademarks to the Soviet Union. The new Acts, then, introduce the principle of the free assignment of trademarks. Furthermore, they provide that if goodwill is assigned, the trademark therein employed is also assigned unless some other provision has been made.

The assignment of trademarks can conceivably cause the public to be misled. For this reason, the registration authority is empowered to refuse to record the assignment where it is found that use of the mark is clearly liable to mislead the public if the mark is not altered, or some addition made to it such as will avoid this inconvenience.

The rules on the assignment of trademarks are supplemented by the provisions on the licensing of trademarks. The rules guarding against the misleading of the public as a result of licensing are identical with those concerning assignment. There is also a rule on interpretation, according to which the licensee is not empowered to assign his right further unless otherwise agreed. The Finnish Trademark Act has a special provision on the placing of a lien on a trademark, in conformity with the corresponding provision in the Finnish Patent Act, 1943, and in the Finnish Bill for a new Patent Act; such a provision does not appear in the other Scandinavian intellectual property statutes. The placing of a lien on a trademark must be done in writing and notice of this must be recorded in the trademark register; the right to the lien originates in such notice (Section 33(3)).

There are separate rules for cases where the trademark, after it has been assigned or licensed, becomes misleading when used by the new proprietor or the licensee. In such cases, the court is empowered to prohibit the use of the trademark. Certain safety measures for the protection of the public are also prescribed.

The new Trademark Acts regulate the consequences of trademark infringement, an area in which the earlier legislation, particularly in Finland and Sweden, was deficient. The system of remedies is closely parallel to the corresponding rules in the patent law, but there are certain differences. There are differences, too, in the rules on remedies for infringement in the different Scandinavian countries, for example in the matter of liability for damages. The Danish, Finnish and Norwegian Acts have a rule that, if any person infringes a trademark right without intention or by negligence, he shall not be liable to pay damages in excess of the gain he may be presumed to have obtained on account of the infringement. It is, however, for the court to determine, in individual cases,

whether it is reasonable, in the light of the conditions in which the defendant acted and other circumstances, to deem him liable to payment. There is no corresponding rule in the Swedish Act, where it was observed that the profit requisite leads to particular practical difficulties.

III. — I now turn to the law on *industrial designs*. In this area of intellectual property protection, too, Scandinavian co-operation has led to recommendations for Acts which are largely similar, although no joint Scandinavian report has been presented. Here, as in the case of trademarks, each national committee has presented a separate report. The Swedish committee presented its report first (*Statens offentliga utredningar* 1965: 61), followed by the Danish report (*Betaenkning* No. 417/66). The Finnish committee's report, submitted at the end of 1966, was published recently (*Komiteanmietintö* 1966: A 13). The Norwegian report has been somewhat delayed.

In the Scandinavian Copyright Acts, the products of art handicraft and of the art industry are among the works classed as enjoying copyright. The Scandinavian committees on the protection of industrial designs have proceeded from the standpoint that a work can enjoy protection both as a work of art and as a design; they have thus proceeded from the principle of dual protection. This means that the registration of a work as a design does not prevent it from qualifying for copyright protection.

At present, only Denmark (1905, revised 1936) and Norway (1910) have effective Industrial Designs Acts. Sweden's legislation in this area is incomplete. According to the Swedish Act of 1899 on the protection of certain designs, only ornamental designs within the metal industry are protected. As yet, Finland has no legislation on industrial designs. Nor has case law developed any rules on the protection of industrial designs based on the general clause in the Act on Unfair Competition. Hence, it has been considered that slavish imitation could not be prohibited unless there was a risk of confusion. Relatively high requirements have been set up for the protection of copyright in Finland, which explains why applications for copyright protection of industrial designs have not been accepted by the courts. In Sweden, on the contrary, furniture, for example, has been considered protected under the provisions of the Copyright Act (see *NIR* 1959, p. 60; 1963, p. 122). The deficient protection for designs in the Swedish Industrial Designs Act and the absence of such protection in Finland has so far made it impossible for these countries to ratify the 1958 Lisbon Act of the Paris Convention.

The committees' recommendations, as noted, include the introduction of protection for industrial designs by registration, and it is suggested that the relevant patent authority should also deal with the registration of industrial designs. It is further suggested that registration should be based on a preliminary study of earlier registrations in the Scandinavian countries. More detailed stipulations regarding the study are to be included in the edict.

The reports define an industrial design as being a prototype of an article's shape or configuration or a prototype of an ornament. This implies that the subject of a design copyright may be decorative as well as useful. The latter designs are those where the article in which the design is incorporated

serves a practical purpose, as in the case, for example, of a chair or a glass (in Swedish, designs of such articles are called "nyttomönster"). It should, however, be emphasized that this by no means covers what is called utility models (in Swedish "nyttighetsmönster," cf. the German term "Gebrauchsmuster") where the technical or functional effect is decisive. It is the form only which may be protected as a design according to the draft submitted in the reports. The legislation of other countries is less inclined to extend protection to designs serving a practical purpose; in general, only decorative designs are protected. The Norwegian Industrial Designs Act, 1910, however, also provides for the protection of designs serving a practical purpose. A Swedish committee report of 1919 made no distinction between decorative and other designs. This was partly due to the lack of any pronounced distinction or sharp dividing line between the beautiful and the practical or useful. In practice, it has often been difficult to decide whether or not a design served an aesthetic end. By permitting the rules of the draft to cover both decorative designs and designs serving a practical purpose, we achieve a desirable uniformity and simplicity, which the Scandinavian committees considered should be made the basis of the legislation. However, designs serving a practical purpose should, as mentioned, be distinguished from the "Gebrauchsmuster" type which is not covered by the Scandinavian recommendations; indeed, no rules on this type exist in Scandinavian law. It was not considered expedient to create another type of protection for technical subjects concurrently with the patent protection.

In discussing the criteria for determining whether a design can be protected under the proposed Act, as drafted, two views have been put forward: a copyright approach and a patent approach. The question here is whether the main emphasis should be on the originality of the design as a creation of its author, or, as in patent law, on its being new. It has been said that the creations here in question do not represent a high creative achievement of an artistic character, in which case novelty would be the more relevant criterion. There is yet a further aspect: a design may also display artistic qualities. In such a case, the dual protection mentioned earlier comes into the picture. On the criterion of novelty, the same principle has been followed as in the Bills for new Scandinavian Patent Acts, that is, the requirement is for absolute novelty. The committees' reports thus say that design copyright may only be granted to designs that are essentially different from any designs known before the application for registration is made. The expression "known" covers anything that has become generally current, through representation, exhibition, sale or any other means.

The applicant has every interest in having his design application accepted relatively quickly, and so a more comprehensive test of novelty has not been suggested. Testing is, however, linked up with a procedure enabling third parties to oppose the application. Material which the registration authority does not *ex officio* take into account can thus be taken into consideration. The suggested opposition period is two months from the announcement of the application for the design registration. The rules laid down represent an attempt to make the situation clear to the applicant so that he will not violate any

existing design copyright or one with better priority. If, in addition, testing is extended to include design registrations in the other Scandinavian countries, there will be some assurance that the design is new. Thus the applicant runs no appreciable risk of being forced to cease using the design. Should he lose his exclusive right, this will not prevent him from continuing to use the design, and it may be that he will have obtained a certain advantage over his competitors. The procedure for registering designs may be further noted. The application, which must be in writing, is to contain information on the articles for which the design is to be registered; it must also state who has created the design. A graphic representation of the design should accompany the application. The applicant may furnish a model of the design and, in this case, the model will be considered to represent the design in regard to earlier and later registrations and to any infringement of the design copyright. More than one design may be included in the same application only if all of them are connected with the manufacture and use of the articles, for example sets of instruments, services, furniture, etc. It is suggested, however, that no more than twenty designs may be included in the same application.

It is further proposed that design registration should be valid for five years from the date of application for registration, and that renewal should be possible for two further five-year periods.

The Scandinavian reports on the protection of industrial designs include in the drafts certain rules on the assignment, licensing, etc., of designs. The discussions covered such matters as whether the drafts should include rules on rights in employees' designs. This was not considered expedient, in the light of the opportunity for dual protection and since the Scandinavian Copyright Acts do not include rules on the ownership of works protectable by copyright and made by employees.

The reports include limited possibilities for compulsory licenses. These relate to cases where someone in the country concerned has already been using a design professionally when the registration proceedings in respect of another application are made public. The provision concerned corresponds to a provision in the Bills for the new Patent Acts. The Swedish draft on the protection of industrial designs also includes a provision on compulsory licenses in cases where the public interest strongly demands this. There is no corresponding provision in the Danish and Finnish drafts, since it was considered that, in the field of designs, there is no public interest in permitting the use of a form registered for another. The point made was that such interest can be found in the field of patents and, therefore, such a provision is quite rightly included in the Bills for new patent legislation.

It may finally be noted that the drafts on the protection of industrial designs include provisions dealing with the infringement of design copyright which are in essence similar to the corresponding provisions in the Bills for new Scandinavian Patent Acts and in the new Scandinavian Trademark Acts. Thus anyone who intentionally or through negligence infringes a design must pay reasonable compensation for having used the design and restitution for the additional harm caused by

the infringement. In questions of mere negligence, the restitution can be adjusted. Should infringement occur unintentionally and not through carelessness, the infringer is obliged to pay compensation for use if, and to the extent that, such compensation is considered reasonable. Thus, in cases of this kind, it is the court which decides whether there is any question of compensation payment.

IV. — It emerges from what I have said that, in recent years, legislative activity in the different fields of intellectual property has been very lively in the Scandinavian countries. Significant results have already been achieved, and it should not take long before further results can be shown. I have here confined myself to legislation on patents, trademarks and designs, and to related questions. It should be noted, however, that the Scandinavian countries are also working together on trade names and legislation against unfair competition. The Swedish and Danish reports on the latter have already been submitted, and the reports on trade names will probably be published this year. In the light of the close relationship between the protection of trademarks and the protection of trade names, and in view of the fact that our earlier legislation on trade names included stipulations on formal matters only, we may await the outcome of Scandinavian cooperation in this field with great interest.

## GENERAL STUDIES

### Invention and Nonobviousness in United States Patent Law \*)

By Jeanne BOUCOURECHLIEV, Paris

#### PART II

#### The 1952 Act and the Notion of Obviousness

##### A. The Origins and Intents of Section 103 of the 1952 Act

The National Patent Planning Commission, set up in 1941 by President Roosevelt to examine the patent system and headed by Charles F. Kettering, a noted inventor and industrialist, is credited with the initiative of calling upon the legislator to intervene. The very year of the Cuno ruling, the Commission remarked: "One of the greatest technical weaknesses of the patent system is the lack of a definitive yardstick as to what is invention. To provide such a yardstick and to assure that the various courts of law and the Patent Office shall use the same standards, several changes are suggested. It is proposed that Congress shall declare a national standard whereby patentability of an invention shall be determined by the objective test as to its advancement of the arts and sciences." On

the other hand, the Commission points out "that patentability shall be determined objectively by the nature of the contribution to the advancement of the art, and not subjectively by the nature of the process by which the invention may have been accomplished."

In an attempt to solve this problem, a number of proposals were then put forward to modify Title 35 U. S. Code. The first one, presented by Representative Hartley to the 79<sup>th</sup> and 80<sup>th</sup> Congresses, took up the terms of the Kettering Commission almost verbatim. At the same time, Representative Gamble proposed a text which made the determination of invention an issue of fact and established the test of the long-felt want not met by the skill in the art. Senator Wiley and Representative Church (81<sup>st</sup> Congress) tried to settle the question by making use of the notion of novelty, defined as "beyond what is reasonably to be expected of the ordinary person exercising the mere routine skill of the art"; the Patent Office's finding in the matter would be final as far as the courts were concerned, except in cases of obvious error.

None of these texts dealing with both the definition of the patentable invention and the value conferred to the patent reached the stage of public debate. Hearings enabled specialized circles to give technical criticism. The matter was taken up again on the occasion of a "proposed revision and amendment of the patent laws" presented by Representative Bryson, Chairman of Subcommittee 4 of the Committee on the Judiciary, in February 1950. When Title 35 U. S. Code was recodified, it was to appear in Section 103, reading as follows:

"Section 103. Conditions for patentability; nonobvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

In the original proposal of Representative Bryson, the last sentence of the article read: "Patentability as to this condition shall be determined by the nature of the contribution to the art, and shall not be negated . . ." As proposal H. R. 9133 was replaced by proposal H. R. 3760, this phrase disappeared.

As a whole, the 1952 Act was presented as a codification, and that is just what it is, a restatement of law. Of course, Section 103 constitutes an addition to the previous Patent Act<sup>86)</sup>, but this does not mean that it is an innovation. The reports of the Senate and the House of Representatives (the texts are the same) state: "Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts . . . This has been expressed in a large

<sup>86)</sup> There are only a few; one can cite the introduction into the statute of rules already accepted, like the rule of partial infringement (Sec. 271) or the presumption of patent validity (Sec. 282). G. S. Rich, "Act of 1952 - Patents," in *The Encyclopedia of Patent Practice and Invention Management*, Reinhold Pub. Co. N. Y., 1964.

\*) BIRPI translation. — The first part of this study was published in *Industrial Property*, October 1967, pp. 276 et seq.

variety of ways in decisions of the courts and in writing. Section 103 states this requirement in the title<sup>87</sup>).

However, codification presupposes a certain consensus on the matter which, as we have seen, was far from existing. There was a great deal of uncertainty as to the tests applicable and even more uncertainty as to the amount of requirement admissible. We shall see later to what extent Section 103 provides a test of patentable invention. In fact, what was first looked into was the effect of the new provision on the standard of invention, that is, on the severity with which this ideal line separating the patentable invention from the unpatentable invention should be drawn. Can any indication concerning severity or tolerance be found, if not in the Act itself, at least in the congressional reports and records?

The report of the Senate and House of Representatives implies at least one intent of Congress: "That provision paraphrases language which has often been used in decisions of the courts, and the section is added to the statute for uniformity and definiteness. This section should have a stabilizing effect and minimize great departures which have appeared in some cases." Similarly, the Revision Notes state: "This paragraph is added with the view that an explicit statement in the statute may have some stabilizing effect, and also to serve as a basis for the addition at a later time of some criteria which may be worked out."

It was, therefore, the intent of Congress to do something about the uncertainty prevailing before 1952. But, considering the general conviction that the standard of invention had been raised by the recent Supreme Court decisions, what direction was this stabilization to take? Should it confirm the existing state of case law, or should the legislator go back to the classic standard, as expressed by *Hotchkiss v. Greenwood* (to which reference is made several times in the congressional reports), that was supposedly more lenient?

Although codification usually puts law, as it exists at the time, into statutory form, the commentaries of the jurists most closely associated with the drafting of the text suggest that the opposite was intended. One of these commentaries, that of Mr. Federico, is particularly persuasive. It appears in the commented edition of Title 35 of the United States Code, as the title results from the 1952 Act, and follows the above-mentioned Revision Notes, also written by Mr. Federico.

The commentary adds the following details to what is said in the Notes: "There has been some discussion as to whether Section 103 modifies the so-called standard of invention (which itself is an unmeasurable quantity having different meanings for different persons) in the courts and it may be correct to state that the printed record does not show an explicit positive command to the courts. While it is not believed that Congress intended any radical change in the level of invention or patentable novelty, nevertheless, it is believed that some modification was intended in the direction of moderating the extreme degree of strictness exhibited by a number of judicial opinions

<sup>87</sup> House Report 1923, 82nd Congress, 2nd Session; Senate Report 1979, 82nd Congress, 2nd Session. Same wording in the Revision Notes attached to the reports and in the commentary of Mr. Zinn, Advisor to the House Commission. I. Edwards, "Efforts to Establish a Statutory Standard of Invention," Study No. 7 of the Subcommittee on Patents, Trademarks and Copyrights of the Committee on the Judiciary, U. S. Senate, 85th Congress, 1st Session (1958).

over the past dozen or more years; that is, that some change of attitude more favorable to patents was hoped for. This is indicated by the language used in Section 103 as well as by the general tenor of remarks of the Committees in the reports and particular comments. Weight should be given to the terms used in the section since a variety of expressions used in the decisions were available, including some stated with an extreme degree of strictness, which could have been used as the model for the phraseology to be adopted, but the language selected was of the more moderate variety . . . The departures of which complaint has been made in the recent past are all departures in the direction of greater strictness and, hence, these would be what the report indicates should be minimized<sup>88</sup>).

Likewise, J. L. Harris, advisor to the House Committee at the time the bill was drafted, writes that "unfavorable decisions of the Supreme Court and the decisions of the lower courts in response to the strict interpretations of the Supreme Court, were the 'great departures' referred to in the report"<sup>89</sup>). Judge Smith considers that "these unambiguous statements are very persuasive evidence of legislative purpose, and, viewed in conjunction with the history of the act, bespeak a congressional intent to establish a more lenient test of invention"<sup>90</sup>).

#### B. Doctrinal and Case-Law Interpretation of Section 103

At first, it did not seem that Section 103 would mark a turning point in the history of patentability. Codification, stabilization . . . was this not an endorsement of the courts' past action? Many thought so and kept their methods of judgment, their vocabulary and their old standard of patentable invention, considering that "Congress had merely codified existing decisional law," or had "attempted to state what the law has been"<sup>91</sup>). Many do not even cite the text and simply refer, in terms of invention or even flash of genius<sup>92</sup>), to past decisions. Let us mention, too, the opinion according to which, if Congress had intended to modify the standard of invention, "that effort must fail for the reason that the Supreme Court is the final authority on the constitutional standard of patentability"<sup>93</sup>).

Uncertainty is eliminated on one point only: the last sentence of Section 103 provides that it does not matter how the invention is made. The courts have been inclined to separate this sentence from the rest of the section and to consider it the only contribution of the 1952 Act. They recognize that this provision put an end to the theory some of them had tried to draw from the *Cuno Engineering* case that flash of genius

<sup>88</sup> P. J. Federico, "Commentary on the New Patent Act," 35 *USCA* 1, 22-23 (1954).

<sup>89</sup> L. J. Harris, "Some Aspects of the Underlying Legislative Intent of the Patent Act of 1952," 23 *The George Washington Law Review* 658 (1955); "Section 103 Revisited," 9 *PTC Journal of Research and Education (IDEA)* 617 (1965).

<sup>90</sup> A. M. Smith, *op. cit.*, p. 478.

<sup>91</sup> *Wasserman v. Burgess and Blancher Co.*, 217 F. 2nd 402 (CA 1, 1954); *R. M. Palmer Co. v. Luden's Inc.*, 236 F. 2nd 496 (CA 3, 1956). See also: *Interstate Rubber Prod. Corp. v. Radiator Specialty Co.*, 214 F. 2nd 546 (CA 4, 1954).

<sup>92</sup> See footnote 66 and our considerations of the meaning given to this expression by most courts, clearly expressed in *Blish Mize and Silliman Hdwre Co. v. Time Saver Tools Inc.*, 236 F. 2nd 913 (CA 10, 1956).

<sup>93</sup> *Seismograph Service Corp. v. Offshore Raydist*, 135 F. Supp. 342 (E. D. La 1955).

is a distinct test of patentable invention. There is henceforth no doubt that the judgment of what is a patentable invention must be objective: that is, it must pertain to the invention itself, and it does not matter whether this invention is the result of genius, plain hard work, accident, or sheer stupidity, to use the terms of the Radiator Specialty Co. case.

If the courts were unable to find, in Section 103, a new notion or a different method for determining patentability, were they at least conscious of the somewhat veiled intent of Congress to see the establishment of a less severe judgment of patentability? The first decisions note the stabilizing intent of Section 103 without looking into the requirement level at which such stabilization should be carried out, and yet the courts had generally decried, or had at least pointed out, a raising of the classic standard in the previous decisions of the Supreme Court<sup>94</sup>). For the Court of Customs and Patent Appeals, "the Patent Act of 1952 has apparently neither raised nor lowered the standard of invention"; it is true that the CCPA has always refused to see any raising of the standard of invention in the modern decisional law of the Supreme Court<sup>95</sup>).

However, in the *Lyon v. Bausch* decision of 1955<sup>96</sup>), written by Judge Hand, a renowned authority in patent matters, the Second Circuit Court of Appeals posed the problem of how Section 103 should be interpreted as regards the standard of invention applicable. The Court proposed a solution which led to a reversal of trends and thus excited a great deal of interest.

Judge Hand begins by contrasting the classic Supreme Court decisions with more recent decisions: "Lyon's contribution to the art would certainly have been patentable 20 or 30 years ago; the failure of the attempt made in the last ten years in the art concerned shows that the method, although simple, was not 'obvious to a person having ordinary skill in the art' (Section 103)." He adds, however, that during the 20 years or so preceding the 1952 Act, the claims would almost certainly have been held invalid due to the fact that, from recent Supreme Court opinions, the courts of appeal had generally inferred a more stringent standard of patentable invention than that formulated in Section 103. He therefore asks the question: should Section 103 be interpreted as re-establishing the law as it existed when the Supreme Court defined invention (*Hotchkiss v. Greenwood*) or should it be interpreted as codifying the case law prevailing at the time the Act was promulgated?

Judge Hand pointed out that, although there were innumerable variations in the widely applied classic definition, it had never been directly overruled (even in the *Cuno* decision which refers to the *Hotchkiss* case) and that no specific test had been substituted for it. He concludes that "Section 103 only restores the original gloss, substantially *in ipsissimis verbis*, which has never been overruled, but on the contrary for

70 or 80 years had continued to be regarded as authoritative." The validity of the *Lyon* patent was thus upheld. Judge Rich considered that this was the first opinion "to express clearly what was actually in the minds of the drafters of the act"<sup>97</sup>).

The establishment by Judge Hand of a precedent for a more lenient standard of patentable invention, together with the commentaries of the drafters of the Act, has caused a part of the decisional law to move somewhat in that direction. In the 14-year absence of a Supreme Court decision in the matter, the courts have become divided as to the scope of Section 103 in respect of the problem of the standard of invention. Tables of cases — not always agreeing — have often been compiled, to which we refer<sup>98</sup>). The result is that, after a slow advance of the *Lyon v. Bausch* doctrine and despite uncertainties that still subsist in certain cases, it can be considered that the Second, Third and Fourth Circuit Courts and the Court of the District of Columbia have adopted a more lenient standard of invention. On the other hand, the First, Fifth, Eighth, and Ninth Circuit Courts remain attached to the doctrine resulting from Supreme Court decisions prior to the 1952 Act. The position of the Seventh and Tenth Circuit Courts is not yet clear.

The question of patentable invention posed in terms of the standard of invention has thus remained open for quite some time and lawyers have been going to a lot of trouble to bring a given case before one court rather than another, depending on whether they are plaintiffs or defendants and interested in having the court hold the patent in question to be valid or invalid.

Like case law, doctrine did not on the whole consider that its customary approach to the problem should be altered by Section 103. Being in favor of a more lenient application of the patentability requirements than that prevailing in case law before 1952, doctrine retained in general only the intended purpose, that of a stabilization in the direction of less severity. It found in the new text neither the precise standard nor the sure test of patentability which, it thought, alone could settle the problem. Some scholars feel that the nonobviousness requirement simply refers to the basic distinction between invention and mere mechanical skill and believe that the Act, although not codifying them, allows the solutions and criteria of classic case law to subsist<sup>99</sup>).

Other writers have strongly criticized the notion of obviousness as a test or standard of patentability, usually restricting themselves to an analysis of certain elements, only, of the provision. The person having ordinary skill has been called "a fiction, and the level of skill of this fiction is impossible of determination." This test has been reproached for not pertaining to the invention itself but to the degree of perspicacity of a mythical person: it is, they say, therefore not objective

<sup>97</sup> G. S. Rich, "Principles of Patentability," 28 *The George Washington Law Review* 393 (1960).

<sup>98</sup> "Efforts to Establish a Statutory Standard of Invention" (1958), cited above. Gay Chin, "The Statutory Standard of Invention: Section 103 of the 1952 Patent Act," 3 *PTC Journal of Research and Education* 317. Arthur M. Smith, *op. cit.* (1959) 482.

<sup>99</sup> K. B. Lutz, "The New 1952 Patent Statute," 35 *JPOS* 155 (1953). G. M. Brumbaugh, "Sustaining Patentability in U. S. Courts and Related Question," 40 *JPOS* 35 (1958).

<sup>94</sup> *Wasserman v. Burgess and Blancher Co.* (1954); *R. M. Palmer Co. v. Luden's Inc.* (1956), both cited above.

<sup>95</sup> *In re O'Keefe*, 202 F. 2d 767 (CCPA 1953); before the 1952 Act, *in re Shortell*, cited above.

<sup>96</sup> *Lyon v. Bausch & Lomb Optical Co.*, 224 F. 2d 530 (CA 2, 1955); the writ of certiorari was refused by the Supreme Court.

and consequently has the same defects as the flash-of-genius test rejected by the Act<sup>100</sup>).

Although some scholars advocate abandoning the notion (Mr. Bailey suggests replacing it with the notion of progress), others take up the classic positive and negative rules of patentability, either as presumptions or as exceptions to the requirement of nonobviousness<sup>101</sup>). A. W. Deller thus lists the following as ruling out the allegation of obviousness: new, improved, unexpected or contra-indicated results; the satisfaction of a persistent need; increased usefulness, economy or production; the solution of a persistent problem. Certain of Walker's headings can be recognized in this heterogeneous list.

In actual fact, these writings denote a misunderstanding of Section 103. Under the pretext that the 1952 Act is a codification, they do not see the possibility of its having brought in anything new regarding the definition of patentable invention or the method of determining it. It was not by chance that the Act listed no tests for the presence of invention and retained only a synthetic formula. In this respect, the exceptions proposed by Mr. Deller are on a completely different level from that of the rule to which he suggests they be applied.

Moreover, whereas the "rules" of patentability were used previously as presumptions admitting of exception, like types of frequent situations occurring frequently and calling for identical treatment, the scholars who remain attached to them are now putting them forward as tests, as codified rules of law, without taking into account the recognized limits they have always had. Considered in this light, these rules are contrary not only to the letter and spirit of Section 103 but also to the solutions established well beforehand. Rather than pertaining to the invention itself, the proposal made by Mr. Bailey and most of the rules suggested by Mr. Deller relate to its advantages, the progress it involves, or — in other words — to its degree of utility. As we have seen, all of these elements have, for quite some time, been considered extrinsic to the determination of "invention." Besides, it might be supposed that it was in order to avoid any such ambiguity that the reference, in the second sentence of the draft of Section 103, to determining invention "by the nature of the contribution to the art" was omitted from the Act finally passed, even though this phrase was intended merely to bar the test of "the manner in which the invention was made"<sup>102</sup>).

These old themes can, therefore, not be taken up again under the pretext that they represent an elaboration of criteria from the notion of obviousness envisaged by Mr. Federico. It seems they could only lead to the very contradiction and confusion that Section 103 was intended to put an end to. The text thus apparently requires that a new and different approach be made to the problem of patentable invention and, in particular, that all terms of the provision itself be taken into consideration.

<sup>100</sup>) A. W. Deller, "An Inquiry into Uncertainties of Patentable Invention and Suggested Remedies," 38 *JPOS* 152 (1956); Deller is Walker's modern publisher. M. Bailey, "Progress as a Requirement to Patent," 41 *JPOS* 192 and 231; 42 *JPOS* 223 (1959 and 1960).

<sup>101</sup>) A. W. Walker, *op. cit.* A. H. Oldham, "On Patentability," 46 *JPOS* 5 (1964).

<sup>102</sup>) Hearings H. R. 3760, p. 123-124. "Efforts to Establish a Statutory Standard of Invention," *op. cit.*

### C. A New Method of Judgment

A few writers, some of whom had actively participated in the drafting of Section 103, have expressed the opinion that, although this provision constitutes a codification of the established (ever since the Hotchkiss case) requirement for something more than simple mechanical skill, it is also intended to break with the habits of the past. The terms of Section 103 should be carefully examined from this angle, and the formulas it omits are of as much interest as those it uses.

The word invention thus ceases to designate a requisite of patentability, for it was found to be indefinable; with it disappear the positive and negative "rules" of patentability and their exceptions, which were merely a means of including a given case in, or excluding it from, this purely formal concept, "a cliché, meaningless though it is . . . The use of the term 'invention' was, in fact, carefully avoided with a view to making a fresh start, free of all the divergent court opinions and rhetorical pronouncements about 'invention'"<sup>103</sup>). Likewise discarded is "the so-called standard of invention which itself is an unmeasurable quantity having different meanings for different persons"<sup>104</sup>), this standard "which the Courts pretended was being raised and lowered like an elevator as though it were something tangible" and which "never was a standard"<sup>105</sup>). As to inventive activity or faculties, they led to numerous unpatentable inventions for simple want of novelty and are consequently of no help; they are precluded in the second sentence of Section 103.

The insufficiency of these false notions was, in fact, leaving the Patent Office and the courts free to decide, themselves, about patentability, and this is dangerous for it touches on a matter of political economy that is the province of Congress, alone. By replacing the notion of invention with that of obviousness, Congress was indeed aiming at "stabilization, uniformity and precision," not by supplying a definition or a standard, but by providing a method of determining patentable invention which excludes all else<sup>106</sup>). "Section 103 does not . . . represent the reduction of the known concepts of patentability into definite rules that can be applied objectively by the courts. This part of the statute then can hardly be said to establish a statutory standard of invention, but 'at most fixes a standard of judgment' . . . which must be applied by the Patent Office and the courts in the light of their past decisions"<sup>107</sup>). For Judge Smith, any other conception is a "misconception."

The language of the Act and the method it implies were adopted first of all by the Court of Customs and Patent Appeals which handles appeals of final decisions made by the Patent Office<sup>108</sup>). While it is beginning to penetrate the Patent Office itself, this attitude is strongly supported by the Supreme Court in four decisions of February 21, 1966, the doctrinal portion of which is common to all four as regards the

<sup>103</sup>) Giles S. Rich, "The Vague Concept of 'Invention' as Replaced by Section 103 of the 1952 Patent Act," 8 *PTC Journal of Research and Development*, conf. No. 136 (1954), 46 *JPOS* 855. L. J. Harris, *op. cit.*

<sup>104</sup>) P. J. Federico, "Commentary on the New Patent Act," *op. cit.*

<sup>105</sup>) See note 103.

<sup>106</sup>) D. J. Libert, *op. cit.*

<sup>107</sup>) G. Chin, *op. cit.*, quoting A. M. Smith, *op. cit.*, 1st Ed. 454.

requirement of nonobviousness: *Graham v. John Deere Co.*, *Calmar Inc. v. Cook Chemical Co.*, *Colgate Palmolive Co. v. Cook Chemical Co.*, *U. S. v. Adams*<sup>109</sup>). After explaining, in these decisions, the exact scope of the 1952 "codification," the Supreme Court carefully comments on Section 103 and gives a systematic, literal application of the provision.

"The truth is the word (invention) cannot be defined in such a manner as to afford any substantial aid in determining whether a particular device involves an exercise of inventive faculty or not (*McClain v. Ortmyer*). Its use as a label brought about a large variety of opinions as to its meaning both in the Patent Office, in the courts, and at the bar. The Hotchkiss formulation, however, lies not in any label, but in its functional approach to questions of patentability. In practice, Hotchkiss has required a comparison between the subject matter of the patent, or patent application, and the background skill of the calling . . . Approached in this light, the Section 103 additional condition, when followed realistically, will permit a more practical test of patentability. The emphasis on nonobviousness is one of inquiry, not quality, and, as such, comports with the constitutional strictures."

After making reference to *A & P* and affirming that validity is a question of law<sup>110</sup>, the Court reasons out, from the very terms of Section 103, a method calling for "several basic factual inquiries." Let us refer to the first sentence of that section:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

### 1. Differences over the Prior Art

The first phrase (up to "title") indicates that nonobviousness is a supplementary requisite of patentability to be added to the novelty requirement and should not be investigated unless the latter requirement has been met, that is unless there is no identical anticipation. According to P. J. Federico, it is a "limitation on Section 102"<sup>111</sup>.

In the very words of the statute, it is these "differences between the subject matter sought to be patented and the prior art" which are examined<sup>112</sup>. The expression is not new in patent language: the classic decisions used the words "patentable difference." It is important to note the neutrality of the expression: there is no question of progress or improvement, or even of a "step," only a question of differences. Similarly, in *Graham v. John Deere Co.*, the Supreme Court refers to "innovation, advancement, and things which add to the sum of useful knowledge" as meeting the sole "standard"

given in the Constitution: the promotion of "the progress of useful arts."

In order to determine these differences, the prior art must be accurately defined. This is the first of the determinations of fact called for in the implementation of Section 103. It concerns both obviousness and novelty<sup>113</sup>). The rules of this determination are also classic: the prior art includes everything already invented, constructed or used in the United States, and anything patented or described in a printed publication anywhere<sup>113</sup>). With respect to both novelty and obviousness, the prior art includes all fields of technology, not merely that of the alleged invention, subject to the reservations we shall indicate below. Just as in penal law, ignorance is no excuse: the parties interested in a patent's validity are presumed to be fully aware of the state of the art at the time of the invention<sup>114</sup>).

If the alleged invention is not identically anticipated, that is, disclosed by a single identical achievement or publication, then the obviousness of the differences found with respect to the prior art as a whole must be investigated. Are such differences, even if they are new, suggested by one or more previous inventions? Are they implicitly contained in the prior art taken as a whole?

Section 103 gives three imperative and capital indications of the elements to be considered. It is (1) the subject matter as a whole which must be obvious, (2) at the time the invention was made, (3) to a person having ordinary skill in the art concerned.

### 2. The Subject Matter as a Whole

Since the subject matter of the invention must be considered as a whole, to bar patentability, it is not sufficient that each element, taken separately, should appear to be suggested by the prior art. Consequently, rejection cannot be justified by "a piecemeal reconstruction of the prior art patents in the light of appellant's disclosure"<sup>115</sup>). If this were possible, a combination of old means or elements could never be patentable; however, such a combination is patentable if the actual idea of such a combination is not obvious.

In addition to resulting from the solution offered or the means employed, nonobviousness may result: (1) from the discovery of a problem or its cause<sup>116</sup>), even if the solutions to the problem are known; or (2) from the objective sought by the inventor. It is then in relation to the inventor's objective that the use of known means might not be obvious, and invention would lie in the establishment of a new cause-effect relation<sup>117</sup>). Likewise, although in chemistry a new compound may appear obvious from its formula, the patentable invention may lie either in the idea of making such a compound or in

<sup>113</sup> Walker, *op. cit.*, p. 117; where the application in respect of a patent dates earlier than the invention considered, the patent belongs to the prior art even if granted after the date of the invention: *Hazeltine Research Co. v. Brenner*, 382 U.S. 252 (1965). The application of this rule to the condition of nonobviousness is now being widely discussed: D. A. Roth, "Obviousness under Section 103," 47 *JPOS* 811 (1965); L. Belkin, "More Comments on Section 103," 48 *JPOS* 123 (1966).

<sup>114</sup> Mast, Foos & Co. v. Stover Mfg. Co., 117 U.S. 485 (1900).

<sup>115</sup> In re Rothermel, 276 F.2d 393 (CCPA 1960), in re Ratti cited above.

<sup>116</sup> In re Conover, 304 F.2d 680 (CCPA 1962).

<sup>117</sup> Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U.S. 45 (1923).

<sup>108</sup> G. S. Rich, *op. cit.*; for example in re Sporck, 301 F.2d 686 (CCPA 1962); in re Sejournet, 285 F.2d 823 (CCPA 1961).

<sup>109</sup> *Graham v. John Deere Co.*, *Calmar Inc. v. Cook Chemical Co.*, *Colgate Palmolive Co. v. Cook Chemical Co.*, *U. S. v. Adams*, 148 *USPQ* 459 (1966).

<sup>110</sup> See note 65.

<sup>111</sup> P. J. Federico, *op. cit.* V. E. Woodcock, "What is Prior Art?" in *Dynamics of the Patent System*, *op. cit.* (1960).

<sup>112</sup> In re Hidy and Phillips, 303 F.2d 954 (CCPA 1962).

the unexpected new properties of the end product with respect to the formula<sup>118</sup>).

### 3. The Time the Invention Was Made

Obviousness must be assessed "at the time the invention was made." This time may not always be easy to prove, but the problem presents no difficulty unless a change occurs in the elements determining obviousness between the time the invention was made, which the American inventor can rely upon, and the time the patent application was filed<sup>119</sup> (in any event, the inventor must take the various preclusions of Section 102 into account)<sup>120</sup>. This, too, is a classic rule: many decisions handed down before 1952 criticized "knowledge after the event" and "hindsight"<sup>121</sup>.

It is not always easy, however, to avoid shifting judgment<sup>122</sup>, particularly in a very crowded art or in cases where the invention is simple, since many litigations occur years after the invention was made and the patent granted, when the invention has become an integral part of the art. Nevertheless, the inclusion of the rule into Section 103 appears to have served a purpose, and the courts seem to be devoting greater attention to this capital point which the Supreme Court has expressly mentioned. One consequence of this rule is that the obviousness of claims must not be judged in the light of the disclosure made in the patent specification which is not an integral part of the prior art<sup>123</sup>.

### 4. Reference to the Person Having Ordinary Skill

The third element in the judgment is "a person having ordinary skill in the art to which said subject matter pertains." This reference eliminates the complacently subjective attitudes of certain judges: "shock or surprise," "excitement" in the face of invention, "an answering flash," "sixth sense . . . hunch"<sup>124</sup> are not tests, and the upholding of a patent should not be "a function of the judicial scientific ignorance." The courts must, therefore, reconstitute this precise, but perhaps mythical, character, and the difficulties of doing so are, according to the Supreme Court, the same as in matters of civil responsibility or of determining "due care." The person having ordinary skill is a personification of the "mere mechanical skill" that was contrasted with invention in classic case law and doctrine, and, because of this, Judge Hand was able to say that Section 103 takes up *Hotchkiss v. Greenwood* again "in *ipissimis verbis*"<sup>125</sup>.

Whereas the classic texts sometimes spoke of the ordinary mechanic and sometimes of the skill in the art, Section 103

uses the less exacting expression: "person having ordinary skill." The highly specialized expert is thus eliminated by virtue of his training, experience or talent<sup>126</sup>. This ordinary person is not supposed to be familiar with the prior art in its entirety (this is taken into consideration when the novelty of the invention is assessed), but simply with the art that concerns him and the main points of related or similar arts. The level of this person's abilities will consequently vary greatly depending on whether the branch under consideration is electronics or shoemaking; the level of technology as a whole is also subject to evolution. These considerations influence the determination of obviousness.

From this "basic factual inquiry" and by comparing results, the Patent Office examiner or the judge will have to decide on the obviousness or nonobviousness of the invention for the person having ordinary skill. However, as the reader will tell us, the problem still remains of defining obviousness!

### 5. Obviousness

The use of dictionary definitions, attempted by a few scholars<sup>127</sup>, is generally rejected. In patent law, "obvious" does not mean that which requires "no thought or consideration to understand or analyze"<sup>128</sup>. The word already had a special technical meaning in patent law before 1952, and it is in the light of the solutions acquired and maintained since that time that it should be interpreted. What is obvious is thus not just any invention which a person having ordinary skill would understand without effort if it were presented to him, nor is it an invention he would think of immediately; it is rather any solution which a person having ordinary skill, confronted with the given problem, would discover through reflection and upon making simple routine experiments.

It has been claimed<sup>129</sup> that any person having ordinary skill, confronted with a given problem, will finally solve it in some way or another, by the end of a certain period of time; this is certainly not true for a vast number of problems and, as for the others, if they require time and systematic research, then they are not obvious. They are therefore worthy of a patent, unless one wants to return to the flash-of-genius test which the Supreme Court has just referred to as "but a rhetorical embellishment."

It will be noted that, as Mr. Federico has written, the most moderate of the formulas in force was the one chosen by the drafters of the 1952 Act. This indicates a trend in its application. Furthermore, the usual meaning of the term, even if it is not the one intended, serves as a reference and as a sort of limit to the extension that can be given to its technical meaning.

More specifically, obviousness defines the capacity of a person having ordinary skill to combine or modify, without going into special research, the various elements of the invention which are already revealed in the prior art in order to come up with the invention itself. Although, in determining the references that can be cited against the inven-

<sup>118</sup> In re Papesch, 315 F. 2nd 381 (CCPA 1963). M. W. Western, "Is USC 103 Applicable to Chemical Compounds?" 8 *PTC Journal of Research and Education (IDEA)*, p. 443 (No. 3, 1964); U. S. v. Adams (1966) cited above.

<sup>119</sup> In re Palmquist, 319 F. 2nd 547 (CCPA 1963). This would be changed by the act new presented to the Congress.

<sup>120</sup> In re Foster, 145 *USPQ* 116 (CCPA 1965).

<sup>121</sup> *Diamond Rubber Co. v. Consolidated Rubber Tire* (1911), cited above. *Lorenz v. F. M. Woolworth Co.*, 305 F. 2nd 102 (CA 2, 1962), dissenting opinion of Judge Medina.

<sup>122</sup> *Marconi Wireless Tel. Co. v. U. S.*, 320 *U. S.* 1 (1943) and the dissenting opinion of Justice Frankfurter; in re Ratti, cited above.

<sup>123</sup> In re Murray and Peterson, 122 *USPQ* 364 (CCPA 1959).

<sup>124</sup> G. Gerhardt, "Patent Policy and Inventions," 46 *Ill. Law Review* No. 4 (1951), 34 *JPOS* 877 (1952).

<sup>125</sup> Judge Hand in *Lyon v. Bausch* cited above.

<sup>126</sup> *LOF Glass Fiber Co. v. Watson*, 107 *USPQ* 197 (DC CA 1955).

<sup>127</sup> Oldham, *op. cit.*

<sup>128</sup> Webster's Third New International Dictionary (1963 edition).

<sup>129</sup> Oldham, *op. cit.*

tor, the Patent Office examiner or judge must take the whole of the prior art into consideration, Section 103's mention of the "person having ordinary skill in the art concerned" limits the possibility of combining or modifying the references found when no one of them constitutes anticipation that bars novelty. As a matter of fact, the person having ordinary skill is able to think of modifications such as those indicated in the former negative rules of patentability (changes of dimension or proportion or inversion of parts, for example), he is able to combine the elements belonging to his art, he can also seek a solution to a given problem in a close or related art, but it would not be obvious for him to borrow, for instance, a method being used in an altogether different art in order to combine a device belonging to a similar art with a device existing in his own art. Thus, since the early days, borrowings from a totally different art have been considered, in the terms of that period, to require "as acute a perception of the relation between cause and effect, and as much of the peculiar inventive genius which is a characteristic of great inventors . . . as would be necessary to create the device *de novo*"<sup>130</sup>). Patentability is negated by a reference drawn from an unsimilar art, only where the reference discloses the actual structure of the claimed invention<sup>131</sup>).

Obviousness may, therefore, depend on whether a reference pertains to the art in question or a similar one, or whether it pertains to a completely different one. A good example of the decisive importance of this question was given, before 1952, in the *Paramount Publix Corp. v. American Tri Ergon Corp.* case (cited above, 1934). The patent covered a process for producing a positive film giving both sound and picture. The Supreme Court held that the patent was invalid in view of the fact that the process does not belong to the art of sound reproduction — in regard to which it might have been novel — but to that of photography, which already taught the method of producing one positive film from two negatives.

Although, in principle, there is no limit to the number of references that may be combined, the very condition of non-obviousness generally requires that no central reference should serve as a basis for the combination of other references, and that the combination itself should not be obvious in view of the desired objective, like the *A & P* case, for example, as analyzed by the Supreme Court. On the other hand, if one of the secondary references relied upon modifies the basic principle of the main reference<sup>132</sup>), the cause-effect relationship established by the prior art, in fact, disappears and the invention is not obvious. Similarly, the use of known devices to achieve results that are contrary to what is taught by the prior art is not obvious and can be deemed an indication of patentability, as can the fact of pursuing research and achieving success in an undertaking skilled persons had considered from experience to lead to a blind alley<sup>133</sup>).

#### 6. The Continuity of Supreme Court Case Law

When going into a detailed analysis of the method of judgment involved in Section 103, we thus run into a number of the

problems raised in the first part of this study, and, to illustrate this, we can cite decisions prior to 1952. Section 103 formulates into the statute a method that could be induced for several decades from Supreme Court decisions and that was often misunderstood by the lower courts which clung to the classic rules of patentability. In 1966, the Supreme Court explicitly recalled its doctrine regarding these "rules," already formulated in the *A & P* decision, for instance, and as early as 1891 in the *McClain v. Ortmayer* decision: "Such secondary considerations as commercial success, long-felt but unsolved need, failure of others, etc. might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As *indicia* of obviousness or nonobviousness, these inquiries may have relevancy."

It seems to us that the conformity of the Supreme Court's decisions with Section 103, as well as the continuity of its decisional law since *Hotchkiss v. Greenwood*, is the most clearly apparent when the method of judgment is seen from this angle. As was the conscious desire of the drafters of Section 103, the method itself omits any reference to a standard or quantitative evaluation of invention, since this was deemed impossible. The laying-down of the steps it imposes to the exclusion of all others should, of course, have a stabilizing effect and eliminate aberrant solutions, together with a number of uncertainties. There is still some latitude, however, depending on the judgment of the skill of the average skilled person and consequently what seems obvious to him. "The problem is still of necessity one of judgment."<sup>134</sup>)

This flexibility of judgment is necessary and permits the evolution of technology to be taken into account. The Supreme Court based itself on this when, in taking up the previous opinions of certain courts of appeal<sup>135</sup>), it reaffirmed that it had never altered the standard of invention: "The standard has remained invariable in this Court. Technology however has advanced — and with remarkable rapidity in the last 50 years. Moreover the ambit of applicable art in given fields of science has widened by disciplines unheard of a half-century ago. It is but an even-handed application to require that those persons granted the benefit of a patent monopoly be charged with an awareness of these changed conditions."

In the light of its decisions and opinions, the Supreme Court's affirmation does not seem to be questionable. We have seen, however, that the lower courts generally concluded from the Supreme Court's decisions of the past 30 years that the standard of patentable invention had been raised or, for those who avoid this quantitative expression, that there had at least been an invitation to judge patentability more stringently. We have also seen that the drafters of the 1952 Act, while rejecting any quantitative definition, formulated the old requirement of invention moderately and that the stabilization they reckoned on was to lead to "moderating the extreme degree of strictness exhibited by a number of judicial opinions over the past dozen or more years; that is . . . some change of attitude more favorable to patents"<sup>136</sup>). Yet, the Supreme Court categorically denies any change in its own evaluation of inven-

<sup>130</sup> *In re Lobl*, 108 *USPQ* 229 (CCPA 1956).

<sup>131</sup> *Potts v. Creager*, 155 *U. S.* 597 (1895).

<sup>132</sup> *In re Ratti*, cited above. *In re Lobl*, cited above.

<sup>133</sup> *U. S. v. Adams*, cited above; *Fisch v. Gould*, 246 *F. 2d* 5 (CA 3, 1957).

<sup>134</sup> P. J. Federico, *op. cit.*

<sup>135</sup> R. Frankl, "On Judgments of Patentability," 35 *JPOS* 214 (1953), 37 *JPOS* 125 (1955), 39 *JPOS* 122 (1957).

<sup>136</sup> P. J. Federico, *op. cit.*

tion or any intent of Congress to alter the "standard" of invention.

From this point of view, some have regretted not the solutions of the Supreme Court in the recent cases<sup>137)</sup>, but the fact that the Court, which may freely choose among the cases submitted to it those which it will review, decided, for the first time in 15 years as far as this controversial test of patentable invention is concerned, to rule on extremely weak titles calling for a holding of invalidity. It had, on the other hand, refused the writ of certiorari for the decisions of Judge Hand (*Lyon v. Bausch and Reiner v. Leon Co.*, for example) which, taking the intents of Congress into account, had been responsible for creating a more favorable attitude towards patents on the part of the lower courts. L. J. Harris fears that the courts as a whole will see in this an inducement to severity which would not be in line with the intent of Section 103. He feels that Justice Clark has thus applied the 1952 reform correctly to the letter but has not reflected its spirit<sup>138)</sup>.

It will be up to the courts not to make an interpretation of the Supreme Court's decisions which is uncalled for in our opinion. After all, the drafters of Section 103 have also shown a concern for continuity, a concern which — as we have seen — has been constantly displayed by the Supreme Court ever since the *Hotchkiss v. Greenwood* case. The lower courts should be aided effectively in making a well-balanced application of the law by the decisive clarification of notions and methods given in Section 103 and quite strictly adopted by the Supreme Court.

#### D. The Role of the Notion of Obviousness in Determining Patentability

Lastly, we must look into the role that this gradually developed, finally clarified notion plays in determining patentability. For this, we have only fragmentary notations at our disposal, and any attempt to put them together might, in the eyes of the American jurist, appear to be a typically Latin — and perhaps vain — concern for synthesis. We shall take this risk, however, even if only in an attempt to give the non-American jurist a better understanding of the debate.

Even before the 1952 Act, the present nonobviousness requirement was considered, under the name "invention," to be a distinct requisite of patentability. This specificity of the notion is reflected by the fact that the search for its legal foundation was sought, not in a broad interpretation of the novelty requirement, but in the terms "invented" and "invention" in spite of the fact that they are used in another sense in both the legal provisions and in the Constitution. It is also shown in the particular technique of judgment which does not refer to one or more identical prior references, but to one or more combined or approximate references, that is, to an approximation. The notion led to the working out of independent rules, the so-called "positive and negative rules of patentability." In its 1966 decisions, the Supreme Court confirmed that it constitutes "one of three conditions, each of which must be satisfied."

Still, nonobviousness appears to be an additional, and even dependent, requirement. It is additional because it may not be determined until novelty<sup>139)</sup> and utility have been determined. Walker studied the question of invention before going into the only two conditions then statutory, and perhaps this partially explains why he was unable to present a comprehensive view of it. The 1952 Act mentions nonobviousness last, and Mr. Federico in his commentary and the Supreme Court in its decisions support this characteristic of being additional. Once it is established that there is a difference between the invention and the prior art, it must be determined whether or not this difference is obvious: the expression "patentable difference" as opposed to "essentially or substantially similar," frequently employed in classic case law, is still being used<sup>140)</sup>.

Before 1952, Mr. Federico spoke of "degree or character or quantity of newness"<sup>141)</sup>. Here, we must guard against any quantitative judgment of this requirement in so far as it would lead to a quantitative judgment of invention, or a search for a veritable inventive level — a notion unknown in American law. It is here that the intents of Congress, as they are expressed by the drafters of the Act and "the phraseology . . . of the more moderate variety," used in Section 103, take on their full significance. In this sense, the 1952 Act was indeed intended to put an end to the divergent opinions according to which: "Upon the difficulty and indefinite requirement that an invention should be beyond the scope of one skilled in the art, there was engrafted an even more difficult and indefinite requirement that somehow it should be considerably beyond the scope of the skilled mechanic — perhaps so far beyond as to amount to the work of a genius"<sup>142)</sup>. Section 103 does not define a standard but a requirement and — one might say — a minimum requirement because of the way it is worded. For this reason, in the terms of D. L. Libert, "the effect on the standard of invention is more a conclusion than an analytical tool." By affirming, in its 1966 decisions, that the requirement "to promote the progress of . . . useful arts" is the only "standard" indicated in the Constitution, the Supreme Court excludes any quantitative approach to the problem in favor of a judgment enlightened by the ultimate goals of the system as a whole and, more particularly, those of this additional requisite of patentability. The abandoning, as tests of patentability, of the notions of the invention's importance, technical progress, scientific value, and finally of genius, in fact, leaves no room for a quantitative judgment, and the criticism of it made after 1952 by certain commentators seems to be final.

P. J. Federico's expression "degree, character or quantity of newness" actually eludes the problem of a standard, for novelty obviously cannot be measured; that writer, who again uses it in his "Commentary on the New Patent Act," also uses the expression "patentable novelty." Drawing a parallel between these terms corresponds exactly to what was done in classic decisions which, rising above the "rules of patentability," sometimes termed their requirement for something more than simple mechanical skill as "quantity or quality of novelty"

<sup>139)</sup> On the relations between nonobviousness and novelty, see E. W. Kitch, *op. cit.*

<sup>140)</sup> P. J. Federico, "The Concept of Patentable Invention," *op. cit.*

<sup>141)</sup> P. J. Federico, *op. cit.*

<sup>142)</sup> D. J. Libert, *op. cit.*

<sup>137)</sup> Of the four decisions of February 21, 1966, three held the patent to be invalid and two of these decisions concerned the same patent.

<sup>138)</sup> L. J. Harris, "Section 103 Revisited," *PCT Journal of Research and Education (IDEA)* 617 (1966).

and sometimes as "what is new as distinguished from that which is a colorable variation of what is old (*McClain v. Ort-mayer*).

Thus, Section 103 does not define an independent requisite of patentability, but a distinct step leading to an additional requirement for the determination of novelty, that of a certain quality of novelty. As P. J. Federico wrote in his commentary on the 1952 Act: "In form this section is a limitation on Section 102, and it should more logically have been made part of Section 102, but it was made a separate section to prevent 102 from becoming too long and involved and because of its importance."

This particular quality of novelty comes from the fact that the alleged invention is compared not only with what had previously been achieved or described but also with what the prior art, taken as a whole, directly suggests in both its explicit and implicit teachings. In cases of "an advance plainly indicated by the prior art" (*Cuno Engineering*), the contributor is not really an inventor: he has contributed nothing new but has merely given form to ideas suggested by the known art. According to Justice Bradley, he watches "the advancing wave of improvement and gathers its foam." His invention does not, therefore, represent a disclosure worthy of the grant of a monopoly; in fact, such a monopoly would "subtract from former resources freely available to skilled artisans" (*A & P*) and, in the eyes of the American jurist, would therefore be illegal and constitute a threat to the freedom to draw from the public domain.

This requirement, which, in the absence of a statute, the courts of a number of important countries have felt obliged to lay down, necessarily restricts the field of the patent system. The innovations thus excluded from the protection of the law do not, however, automatically fall into the public domain. When they are of a nature to do so, they add to the always vast store of know-how for which secrecy remains the most effective protection. Under this protection, they may naturally become the subject of exchanges and contracts; they may also be rediscovered and used independently of the first discoverer, and this is bound to happen if they are really obvious with respect to the prior art. Yet, since they do not involve a legal monopoly of exploitation, these unpatentable inventions will not be systematically disclosed by the publication of a patent.

The judges consequently find themselves bound on either side by imperatives of far-reaching economic and political consequence: on the one hand, they run the risk of tolerating unfounded monopolies that would "lay a heavy tax on the industry of the country, without contributing to the real advancement of the arts" (*Atlantic Works*); on the other, they run the risk of not meeting the objectives of a system wherein the patent represents both the best recompense and the best inducement to research and development and to the disclosure of the results. Thus we see both the difficulty and the necessity of setting up rules that indicate as clearly as possible where to draw this essential dividing line which constitutes the definition of patentability.

## CONGRESSES AND MEETINGS

### International Federation of Patent Agents (FICPI) Cannes Congress

(September 26 to 29, 1967)

The International Federation of Patent Agents (FICPI) held a Congress at Cannes from September 26 to 29, 1967. This Congress was preceded, not only by a session of the Executive Committee of the Federation, but also, in view of the importance of certain matters appearing on the agenda of the Congress, by sessions of the Contact Commission FICPI — *Patentanwaltskammer*, the European Patent Agents Study Group and the *Union des Conseils en Brevets Européens*.

The Congress itself was attended by Federation members from a great many European and non-European countries. It was presided over by Mr. René Jourdain, President of the Federation, who conducted the discussions with authority and efficiency while maintaining perfect courtesy towards all participants. The organization of the Congress was flawless and beyond all praise.

BIRPI was represented at the Congress by its Director, Professor G. H. C. Bodenhausen.

The work of the Congress was devoted to the following subjects:

At the first working session the Director of BIRPI presented and commented on, the outcome of the Diplomatic Conference of Stockholm.

Mr. Ernest A. Faller, Delegate of the Commissioner of Patents in Washington, on permanent mission in Geneva, then gave some information on the main provisions of the new United States Patent Bill.

Mr. L. Robbins (United States) also spoke on the Patent Bill and, at the same time, made some advance comments concerning the discussion of the following subject.

At the second working session the Director of BIRPI broadly outlined the BIRPI PCT plan, which is intended to provide for international cooperation in respect of patents, and pointed out a number of problems which would have to be resolved in order for that plan to be successful.

This report was followed by an extensive debate in which official representatives of the International Association for the Protection of Industrial Property (IAPIP), the Union of European Patent Agents, and the European Patent Agents Study Group, took part, in particular.

In a statement that received wide attention, Mr. Guillaume Finnis, President and Director General of the International Patent Institute (IIB), discussed the IIB and the international solution for patent proceedings presented by BIRPI.

Mr. Roger Gajac, representing Mr. F. Savignon, Director of the Institut National Français de la Propriété Industrielle, brought in some very interesting information on the subject of the reform of the French Patent Law.

Mr. Höst-Madsen (Denmark) then reported on the Patent Bill in the Scandinavian countries.

The last working session of the Congress was devoted to matters concerning the patent agent profession and the exercise of that profession on the national and international levels. Those who took the floor during the meeting were, *inter alia*: Professor Jean-Marc Mousseron, representing Professor Bastian, Director of the Center of International Studies in Industrial Property at Strasbourg; Dr. Radt, President of the Patentanwaltskammer; and Mr. Massalski, Vice-President of the Federation.

The Congress carried out its work in the magnificent setting of Cannes. The organizers were able to take advantage of this by planning a brilliant program of social events, including a reception by the Municipality of Cannes, an excursion for ladies and another excursion for all Congress participants, a buffet dinner at the Club House of the new Cannes yacht harbor, and a splendid closing dinner at the Palm Beach Casino, brightened by fire works. In addition, the participants met for lunch every day at the Carlton Hotel.

## NEWS ITEMS

### MALTA

#### *Appointment of New Director of Industrial Property Office*

We have been informed that Mr. Louis Sammut Briffa has been appointed Comptroller of the Maltese Industrial Property Office. He succeeds Mr. Joseph Schranz who has retired.

### FEDERAL REPUBLIC OF GERMANY

#### *Inauguration of the New Headquarters of the Max-Planck-Institute for Foreign and International Law of Patents, Copyright and Competition, Munich*

The *Max-Planck-Institut für ausländisches und internationales Patent-, Urheber- und Wettbewerbsrecht* (Max-Planck-Institute for

Foreign and International Law of Patents, Copyright and Competition), and the *Institut für Gewerblichen Rechtsschutz und Urheberrecht der Universität München* (Institute for Industrial Property and Copyright of the University of Munich) inaugurated their new headquarters in Munich, Siebertstrasse 3, on October 17, 1967.

The ceremony was attended by several hundred guests coming from some twenty different countries. Professor G. H. C. Bodenhausen, Director of BIRPI, was among the speakers who greeted the new Max-Planck-Institute and its Director, Professor Eugen Ulmer.

The Institute's new headquarters include spacious facilities for its library which constitutes an exceptionally rich collection of works on intellectual property subjects. The collection, containing approximately 15,000 volumes, is organized into sections by countries, and each section is subdivided according to the main branches of the law of intellectual property.

The Institute has some 50 collaborators, half of them with academic degrees. In addition to its scientific research tasks, the Institute lays great emphasis on the training of a new generation of scientists in the field of intellectual property law. In this connection, the Institute accepts also foreign scientists as guest collaborators.

The inauguration was followed by lectures given by Professor Eugen Ulmer, Professor Friedrich-Karl Beier, Miss Barbara Ringer, and Mr. Gert Kolle.

## CALENDAR

### Meetings of BIRPI

Date and Place	Title	Object	Invitations to Participate	Observers Invited
<b>1967</b>				
December 18 to 21, 1967 Geneva	Interunion Coordination Committee (5 <sup>th</sup> Session)	Program and Budget of BIRPI	Belgium, Brazil, Ceylon, Czechoslovakia, Denmark, France, Germany (Fed. Rep.), Hungary, India, Italy, Japan, Mexico, Morocco, Netherlands, Nigeria, Portugal, Rumania, Spain, Sweden, Switzerland, Union of Soviet Socialist Republics, United Kingdom, United States of America, Yugoslavia	All other Member States of the Paris Union or of the Berne Union

Date and Place	Title	Object	Invitations to Participate	Observers Invited
December 18 to 21, 1967 Geneva	Conference of Representatives of the International Union for the Protection of Industrial Property (2 <sup>nd</sup> Session)	Program and Budget (Paris Union)	All Member States of the Paris Union	United Nations; Council of Europe; International Patent Institute
December 18 to 21, 1967 Geneva	Executive Committee of the Conference of Representatives of the Paris Union (3 <sup>rd</sup> Session)	Program and Budget (Paris Union)	Ceylon, Czechoslovakia, France, Germany (Fed. Rep.), Hungary, Italy, Japan, Mexico, Morocco, Netherlands, Nigeria, Portugal, Spain, Sweden, Switzerland, Union of Soviet Socialist Republics, United Kingdom, United States of America, Yugoslavia	All other Member States of the Paris Union
December 20 and 21, 1967 Geneva	Council of the Lisbon Union for the Protection of Appellations of Origin and their International Registration (2 <sup>nd</sup> Session)	Annual Meeting	All Member States of the Lisbon Union	All other Member States of the Paris Union
<b>1968</b>				
March 25 to 29 1968 Geneva	Working Group — Patent Cooperation Treaty (PCT)	Questions concerning searching, etc.	To be announced later	To be announced later
June 17 to 21 1968 Geneva	Working Group — Patent Cooperation Treaty (PCT)	Questions concerning formalities, etc.	To be announced later	To be announced later
September 24 to 27 1968 Geneva	Interunion Coordination Committee (6 <sup>th</sup> Session)	Program and Budget of BIRPI	To be announced later	To be announced later
October 2 to 8, 1968 Locarno	Diplomatic Conference	Adoption of a Special Agreement concerning the International Classification of Industrial Designs	All Member States of the Paris Union	To be announced later
November 4 to 12 1968 Geneva	Committee of Experts — Patent Cooperation Treaty (PCT)	New Draft Treaty	To be announced later	To be announced later

## Meetings of Other International Organizations Concerned with Intellectual Property

Place	Date	Organization	Title
<b>1967</b>			
The Hague	December 4 to 6, 1967	International Patent Institute (IIB)	94 <sup>th</sup> Session of the Administrative Council
<b>1968</b>			
Buenos Aires	April 15 to 19, 1968	International Association for the Protection of Industrial Property (IAPIP)	Presidents' Conference
Munich	April 22 to 26, 1968	Committee for International Cooperation in Information Retrieval among Examining Patent Offices (ICIREPAT)	Advisory Board for Cooperative Systems — Standing Committees I and II
Amsterdam	June 9 to 15, 1968	International Publishers Association (IPA)	Congress
Vienna	June 24 to 29, 1968	International Confederation of Societies of Authors and Composers (CISAC)	Congress
Tokyo	October 21 to November 1, 1968	Committee for International Cooperation in Information Retrieval among Examining Patent Offices (ICIREPAT)	8 <sup>th</sup> Annual Meeting
Lima	December 2 to 6, 1968	Inter-American Association of Industrial Property (ASIPI)	Congress