

Industrial Property

Monthly Review of the United International Bureaux
for the Protection of Intellectual Property (BIRPI)
Geneva

8th Year

No. 5

May 1969

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INTERNATIONAL UNIONS

Paris Union

Denunciation of the Paris Convention for the Protection of Industrial Property

LAOS

According to a communication received from the Swiss Federal Political Department, the following note was addressed by the Embassies of the Swiss Confederation in the countries of the Paris Union to the Ministries of Foreign Affairs of those countries:

(Translation)

“By a Note from the Ministry of Foreign Affairs of Laos, dated October 26, 1967, which was received by the Swiss Embassy in Djakarta on November 30, 1967, the Royal Government of Laos declared its decision to withdraw from the ‘Paris Convention for the Protection of Trademarks.’

Having been informed of the declaration, the International Bureau for the Protection of Industrial Property requested the Ministry of Foreign Affairs of Laos to specify whether the above-mentioned Note should be interpreted as signifying that Laos intended to withdraw from the ‘general’ industrial property Convention, that is, the Paris Convention for the Protection of Industrial Property of October 31, 1958, to which it had acceded in 1963.

On January 3, 1969, the Royal Embassy of Laos in Paris confirmed to the International Bureau the denunciation of the Paris Convention for the Protection of Industrial Property. The denunciation took effect, pursuant to Article 17^{bis} of the said Convention, on November 30, 1968.”

LEGISLATION

FRANCE

I

Decree

Concerning Applications for, and the Issuance and Maintenance in Force of, Patents and Certificates of Utility

(No. 68-1100 of December 5, 1968)

CHAPTER I

Patent Applications

Article 1

Patent applications shall be filed either with the National Institute of Industrial Property in Paris or with a *Préfecture* other than that of Paris.

Filing with the National Institute of Industrial Property may also be effected by sending the application, together with a request for advice of receipt, by registered mail from a French or foreign post office.

Article 2

Applications may be filed personally by the party soliciting the grant or by an agent having his domicile, registered offices or an establishment in France.

Natural persons or legal entities not having their domicile or registered offices in France and not possessing an industrial or commercial establishment in that country shall, within a period of two months of the date of receipt of the notification inviting them to do so, appoint an agent having his domicile, registered offices or an establishment in France.

Unless otherwise provided, the power-of-attorney of an agent appointed in accordance with the provisions of the foregoing paragraphs shall extend to all acts and to the receipt of all notifications provided for in this Decree, with the exception of those mentioned in Articles 25 and 58.

Powers-of-attorney shall not require authentication.

Article 3

A patent application shall include:

- (a) a petition for the grant of a patent;
- (b) a description of the invention and claims which define the scope of protection sought;
- (c) where applicable, the drawings or samples to which the description refers;
- (d) an abstract of the technical features of the invention;
- (e) proof of payment of the fees due at the time of filing the application;
- (f) where applicable, the power-of-attorney of the agent.

Article 4

The benefits of the filing date of the patent application shall be secured if, at the time of filing, the application is accompanied by at least one copy of the papers prescribed in Article 3(a), (b) and (c) of this Decree, regardless of whether the form of such papers is regular, as well as by proof of payment of the fees referred to in Article 3(e).

If the patent application does not include at least one copy of these papers and, without prejudice to the provisions of Article 5, third paragraph, of this Decree, proof of payment of the said fees, it shall be declared inadmissible; the application shall be returned to the applicant and any fees paid shall be refunded.

Article 5

An acknowledgment stating the date and hour of filing of the patent application shall be issued to the applicant.

Where filing is effected with a *Préfecture*, the papers constituting the patent application, together with a duplicate of the acknowledgment of filing, shall be transmitted, within five days of the filing date, to the National Institute of Industrial Property, which shall give the *Préfecture* an acknowledgment of receipt.

Where the application is filed by mail, the date and hour of filing shall be those of the receipt of the envelope containing the application by the National Institute of Industrial Property. In cases where the fees due at the time of filing are only paid subsequently, the date of filing of an application sent in by mail shall be that of such payment, and the hour of filing shall be that of the closing, on that day, of the offices of the National Institute of Industrial Property. The application shall be declared inadmissible if such payment is not made within the two months that follow receipt of the application by the National Institute of Industrial Property.

Article 6

Within the fortnight that follows filing, the National Institute of Industrial Property shall assign a national registration number to the patent application and shall notify it forthwith to the applicant. This number shall be the number under which the notifications provided for in this Decree shall be issued to the applicant.

Article 7

The description shall indicate:

- (a) the title of the invention;
- (b) at least one branch of technology to which the invention relates, such branch being as precise as possible;
- (c) the state of the art in the branch considered;
- (d) at least one result which the invention is intended to achieve;
- (e) the means employed in order to arrive at that result, new elements being distinguished from known elements to the greatest possible extent and the said means being clarified, where required, by examples;
- (f) the possibilities of industrial application of the invention.

The elements of the description shall follow the order of arrangement set out above, unless another arrangement is justified by the subject matter of the invention.

The information referred to in (a), (b), (d) and (e) is compulsory; that referred to in (c) and (f) is optional.

Where the invention relates to a medicine, the description shall give:

- (1) in connection with the information prescribed in (d) of the first paragraph above, an indication of the pharmacological properties and of at least one therapeutic, dietetic or diagnostic application of the medicine described;
- (2) in connection with (e), the formula of the medicine and possibly that of its constituents, the physical, chemical or biological characteristics by which it can be identified, and at least one process for the preparation thereof from known elements. If it cannot be identified by a formula or by physical, chemical or biological characteristics, the medicine may be defined by a process for the preparation thereof. Where known active principles are regrouped in a new way, the properties of the regrouping shall be compared with the sum of the activities of the constituents, taken separately;
- (3) in connection with (f), an example of the therapeutic application indicated in connection with (d), to the extent that this is possible.

Article 8

The claims shall, in the form of a statement of the technical features, define the invention for which protection is sought.

The claims shall not contain, as regards the technical features, a general reference to the description and drawings. However, where necessary, they may refer to a drawing or formula.

Each claim shall contain, in principle:

- (1) a preamble, which indicates the subject matter of the invention and its known features, if any;
- (2) a technical characterization which sets out the special, new elements and which, together with the preamble, defines the limits of the protection claimed.

The preamble of any claim may refer to one or more preceding claims and thereafter indicate additional features. General expressions such as "in combination or separately" are prohibited.

Article 9

A single patent application may, within the meaning of Article 14 of the Law of January 2, 1968, include claims relating to a product, an application of that product, a process for the manufacture of the said product, and means especially designed to put that process into practice.

Article 10

An abstract of the technical subject matter of the invention in respect of which the patent application is applied for shall be drawn up for documentary purposes. It shall not constitute part of the patent and shall not be taken into account in defining the rights deriving from the patent.

The applicant may be invited to amend the abstract he has filed with a view to improving the documentary content thereof. If, within a period of one month from the date of the notification issued to him for that purpose, the applicant has not filed amendments in the sense of the indications given, the abstract may be amended *ex officio*.

The abstract shall be published in the *Bulletin officiel de la propriété industrielle* after publication in that *Bulletin* of the notice prescribed in Article 26 of this Decree.

Article 11

Any patent application the description or claims of which are not drafted in the French language shall be declared inadmissible.

However, an application which is filed by a foreign natural person or legal entity and the description or claims of which are drafted in a foreign language shall be declared admissible provided that the country of such person or entity grants equivalent treatment to French nationals and that a translation of the papers originally filed is supplied by the applicant within a period of two months from the filing of the patent application.

Natural persons or legal entities to whom an application filed abroad, or a right of priority in respect of such an application, has been transferred may also file applications containing descriptions and claims drafted in a foreign lan-

guage, provided that the country in which the original application was filed grants, to French nationals, the equivalent treatment mentioned in the foregoing paragraph and that a translation of the papers filed is supplied within the time limit prescribed in the said paragraph.

A list of the countries regarded as granting equivalent treatment, as well as the language in which nationals of such countries may file applications, shall be established by order of the Minister for Foreign Affairs and the Minister responsible for Industrial Property.

Article 12

Proof of the right of exhibition defined in Article 8(2) of the Law of January 2, 1968, shall be submitted in the form of an attestation issued during the course of the exhibition by the authority responsible for ensuring the protection of industrial property at that exhibition and stating that the invention was in fact exhibited. The attestation shall be accompanied by a description of the invention, the authenticity of which shall be certified by the authority referred to above.

Article 13

Any claim to a right of priority deriving from an earlier filing shall be submitted in a written document which shall mention the date of the earlier filing and its references, the country in which it was effected, and the name of the beneficiary of the rights deriving from the filing; the document shall be accompanied by proof of payment of the fee due. If these papers are not filed within the time limit prescribed in the first paragraph of Article 15 of the Law of January 2, 1968, the claim to priority right shall be declared inadmissible.

If a certified copy of the description, drawings and claims of the earlier application, accompanied, where applicable, by an authorization to claim the priority, given in writing by the owner of the earlier application, is not filed within the time limit prescribed in the second paragraph of Article 15 of the Law of January 2, 1968, no mention of the claim to priority right shall appear in the publications provided for in this Decree or in the document incorporating the grant.

Any applicant who, in respect of a single application, wishes to take advantage of two or more priority rights must observe, in respect of each such right, the requirements laid down in the foregoing paragraphs.

CHAPTER II

Applications of Importance to National Defense

Article 14

Specially empowered delegates of the Minister responsible for National Defense, whose names and qualifications have been brought to the knowledge of the Minister responsible for Industrial Property by the Minister responsible for National Defense, shall, on the premises of the National Institute of Industrial Property, take cognizance of the patent applications filed.

These applications shall be submitted to them within a period of two weeks from the date of receipt thereof by the National Institute of Industrial Property.

Article 15

Requests for authorization to disclose and freely work inventions, which are the subject of patent applications, prior to the expiration of the period prescribed in Article 25 of the Law of January 2, 1968, shall be addressed to the National Institute of Industrial Property; this may be done as from the filing of the patent application. Such authorization shall be notified to the applicant by the Minister responsible for Industrial Property.

In the absence of such authorization, the owner of the patent application may, at any time, petition the Minister responsible for National Defense direct, with a view to obtaining special authorization to perform specific acts of exploitation. The conditions to which such acts of exploitation are subject shall be specified by the said Minister, if he grants the authorization requested.

Where the special authorization relates to the assignment of a patent application or the grant of a license of exploitation, the Minister responsible for National Defense shall issue a copy of his decision to the Minister responsible for Industrial Property.

Article 16

A requisition addressed to the Minister responsible for Industrial Property by the Minister responsible for National Defense for the purpose of retaining in effect prohibitions on the disclosure and free working of an invention in respect of which a patent has been applied for must be received by the National Institute of Industrial Property not less than a fortnight prior to the expiration of the period of five months prescribed in Article 25, third paragraph, of the Law of January 2, 1968.

Any requisition to renew a period in which prohibitions have been retained in effect must be received in the same way not less than a fortnight prior to the expiration of the current period of one year.

The retaining of prohibitions in effect shall be pronounced by order of the Minister responsible for Industrial Property and shall be notified to the applicant prior to the expiration of the current period of prohibition.

The order may contain special provisions authorizing, subject to certain conditions, the filing of applications for protection of the invention abroad. In such cases, a request to that effect must have been made by the owner of the patent application to the Minister responsible for National Defense who shall inform the Minister responsible for Industrial Property of his decision.

Special authorizations to perform specific acts of exploitation may be granted in accordance with the provisions of the second and third paragraphs of Article 15 of this Decree.

The Minister responsible for National Defense may at any time inform the Minister responsible for Industrial Property that prohibitions retained in effect under Article 26 of the Law of January 2, 1968, have been lifted. This measure shall be the subject of an order of the Minister responsible for Industrial Property, notified to the owner of the patent application.

Article 17

Any petition by the owner of the patent application for compensation for loss suffered by reason of the fact that prohibitions on disclosure and free working have been retained in effect shall be made by registered mail, with a request for advice of receipt, to the Minister responsible for National Defense. The petition shall specify the various items of loss claimed, giving the figures for each item.

The *Tribunal de grande instance* shall not hear cases involving settlement of the amount of compensation prior to the end of a period of four months from the date of receipt of the petition, unless an express decision has been made during the course of that period.

Article 18

Judgments, both final and interlocutory, of the court to which a case is referred pursuant to Article 26 or 27 of the Law of January 2, 1968, shall not include any analysis of the invention likely to entail disclosure thereof.

Such judgments shall be delivered in sittings of courts in chambers. Only the State Attorney and the parties or their agents may obtain copies thereof.

If expert testimony is ordered, it may be given only by persons who have received the approval of the Minister responsible for National Defense.

Article 19

Where the prohibitions on disclosure and free working prescribed in Article 25 of the Law of January 2, 1968, terminate more than one year after the filing date of the patent application, the said application may be made available to the public in accordance with the provisions of Article 26 of this Decree only after the expiration of a period of six months from the time that the measures taken to implement the prohibitions are discontinued, unless within that period the applicant has submitted the requisition provided for in the said Article 26.

Where the aforesaid prohibitions terminate more than eighteen months after the filing date of the patent application, the applicant shall have a period of six months, reckoned from the time that measures taken to implement the prohibitions are discontinued, in which to request the drawing up of a documentary report or the conversion of his patent application into an application for a certificate of utility.

Article 20

The provisions of Article 17 of this Decree shall apply to the petition for revision of the amount of compensation provided for in Article 27 of the Law of January 2, 1968.

CHAPTER III

Division of the Application

Article 21

If the patent application does not comply with the provisions of Article 14 of the Law of January 2, 1968, the National Institute of Industrial Property shall issue a notifica-

tion to the applicant inviting him to have the said application divided in accordance with instructions given to him by that Institute.

The applicant shall have a period of three months, reckoned from the date of receipt of the notification, in which to file divisional applications. At the request of the applicant, this period may be renewed once for an additional period of the same duration.

Article 22

Up to the date of grant of the patent, the applicant may, on his own initiative, file applications that are divided from his original patent application.

Article 23

In the event that a patent application is divided in accordance with Articles 21 and 22, above, the applicant must comply with the formalities prescribed in Article 3 of this Decree.

The documents of the first divisional application shall be composed of the original documents after deletion of all parts foreign to the sole subject matter it should contain; there shall be no further amendments or additions other than those deriving from the limitation itself or necessitated by style.

The description, drawings and claims of each other divisional application shall contain, in addition to the texts, figures and claims taken from the description, drawings and claims of the original application, only such connecting and explanatory sentences as are required for clarity of expression.

CHAPTER IV

Correction, Withdrawal and Publication of the Application

Article 24

Until the time that the patent is granted, the applicant may, upon making a justified request, ask that clerical errors discovered in the papers filed be corrected.

The request must be submitted in writing and include the text of the amendments proposed by the applicant; it shall be admissible only if accompanied by proof of payment of the fee due.

If the corrections are refused by the Director of the National Institute of Industrial Property, the papers filed shall remain unaltered.

Article 25

Prior to the date of grant of the patent, the patent application may at any time be withdrawn by written declaration.

Such declaration may refer to one application only. It shall be made by the owner of the application or by an agent. In the latter case, a special power-of-attorney for withdrawal must be attached to the declaration.

Where the patent application has been filed in the names of two or more persons or entities, withdrawal thereof may only be effected if it is requested by both or all such persons or entities.

Where real property rights, liens or license rights have been recorded in the National Register of Patents, the declaration of withdrawal shall be admissible only if the written consent of the beneficiaries of such rights is attached thereto.

If the application is withdrawn after publication in the *Bulletin officiel de la propriété industrielle* of the notice prescribed in Article 26 of this Decree, the withdrawal shall be automatically recorded in the National Register of Patents.

In all cases of withdrawal of an application, a copy of the latter shall be kept by the National Institute of Industrial Property.

Article 26

At the end of the period prescribed in Article 17 of the Law of January 2, 1968, and provided that the patent application has not been withdrawn, or at any time prior to the expiration of such period, upon the written requisition of the applicant, a notice shall be published in the *Bulletin officiel de la propriété industrielle* announcing that the patent application is made available to the public. Such notice shall give the indications required for identification of the patent application.

As from the date of the publication provided for in the foregoing paragraphs, any person may take cognizance, free of charge, at the National Institute of Industrial Property of the description, drawings and claims of the patent application and of any corrections that may have been made in the documents of the application; he may obtain, at his own expense, reproductions of these papers as well as of the documents, prescribed in Article 13 of this Decree, concerning priority right.

Article 27

As from the date of the publication provided for in Article 26, above, and until the expiration of the period provided for in the first paragraph of Article 40 of this Decree, any person may file, with the National Institute of Industrial Property, comments on the patentability of the invention to which the patent application relates, subject to the conditions and in the manner prescribed in Article 40.

The applicant shall be notified forthwith of the content of such comments. No observations filed in response to the comments notified shall be admissible so long as the procedure for drawing up the documentary report has not been commenced.

Article 28

Without prejudice to the implementation of the provisions of Articles 15 and 16 of this Decree, the applicant may at any time obtain, at his own expense, an official copy of the documents of his patent application.

CHAPTER V

Rejection of Applications

Article 29

If, apart from cases where the application is declared inadmissible under the provisions of this Decree, the patent application is irregular as to form with regard to the provisions of this Decree or to provisions laid down for the implementation thereof pursuant to Article 106, or in the event that fees other than those due at the time of filing have not been paid or that payment thereof has been insufficient, a notification stating the reasons shall be issued to the

applicant who shall have a period of one month from the date of receipt of such notification in which to regularize the application or pay the fees due. This period may be extended, upon justified request, but shall not exceed three months.

If the application is not regularized or the fees are not paid within the time limit prescribed in the foregoing paragraph, the patent application shall be rejected by a reasoned decision of the Director of the National Institute of Industrial Property notified to the applicant.

Article 30

If a divisional application filed under Article 21 or Article 22 of this Decree enlarges on the subject matter of the description contained in the original application, the applicant shall be invited by notification to amend the divisional application in the sense of indications given to him by the National Institute of Industrial Property.

The applicant shall have a period of three months from the date of receipt of the notification in which to amend the divisional application. This period may be renewed once, at the request of the applicant, for an additional period of the same duration.

Article 31

Within the time limit prescribed in Articles 21 and 30 of this Decree, the applicant may submit observations in writing in which he refutes the indications given by the National Institute of Industrial Property for the division of his original application or the amendment of the divisional application.

If, within the time limit prescribed in Articles 21 and 30, the applicant has not submitted observations and if the patent application has not been divided or the divisional application has not been amended in the sense of the indications given, the said application shall be rejected by a reasoned decision of the Director of the National Institute of Industrial Property notified to the applicant.

If the observations submitted by the applicant are rejected, he shall be so notified. In cases where the original application is not divided or the divisional application not amended within a period of two months from the date of receipt of the notification, the said application shall be rejected by a reasoned decision of the Director of the National Institute of Industrial Property notified to the applicant.

Article 32

If the patent application is subject to rejection because it represents one of the cases barred under Article 16(4), (5) and (6) of the Law of January 2, 1968, a notification, stating the reasons, shall be sent to the applicant who shall have a period of three months from the date of receipt of such notification in which to submit his observations. This period may be renewed once, at the request of the applicant, for an additional period of the same duration.

If the applicant has not submitted observations within the time limit prescribed in the foregoing paragraph or if his observations are rejected, the patent application shall be rejected by a reasoned decision of the Director of the National Institute of Industrial Property notified to the applicant.

CHAPTER VI
The Documentary Report

Article 33

The provisional documentary reports and the final documentary report prescribed in Article 19 of the Law of January 2, 1968, shall be composed of a list of the items of the state of the art which may have a bearing on the patentability of the invention in respect of which an application for a patent has been applied for, without an indication of whether such elements are cited under Article 8 or under Article 9 of the aforesaid Law.

Each citation of a document shall include references permitting identification thereof as well as a reference to the most pertinent passages, a brief analysis of each such passage, and an indication of the claim which they concern. The date on which the documentary search was made shall be given.

If the said search has not uncovered any documents which might have a bearing on the patentability of the invention, this shall be mentioned in the provisional report or in the final report.

Article 34

The procedure for drawing up the documentary report may be deferred in accordance with the provisions of Article 19 of the Law of January 2, 1968, if the request is submitted at the time of filing of the application.

Waiver of this request shall be made in writing; it shall be admissible only if accompanied by proof of payment of the fee prescribed in Article 80 of this Decree.

Article 35

Requests by any third party that the procedure for drawing up the documentary report be commenced shall be made in writing. They shall be admissible only if accompanied by proof of payment of the fee prescribed in Article 80 of this Decree.

When the request is received, it shall be notified forthwith to the applicant. If, within a period of two months from the date of receipt of such notification, the applicant requests that his patent application be withdrawn or that it be converted into an application for a certificate of utility in accordance with the provisions of Article 36 of this Decree, the procedure for drawing up the documentary report shall not be commenced and the fee prescribed in Article 80 shall be refunded to the person who presented the request referred to in the first paragraph.

At the expiration of the time limit prescribed in the foregoing paragraph, the procedure for drawing up the documentary report shall be undertaken. Such procedure shall be discontinued in the event that the patent application is withdrawn or converted into an application for a certificate of utility.

Article 36

Requests for the conversion of a patent application into an application for a certificate of utility shall be made in writing. So long as the patent has not been granted, such a request may be submitted at any time during the period prescribed in the last paragraph of Article 19 of the Law of January 2,

1968, even if the applicant has not availed himself of the possibility provided for in Article 34, first paragraph, of this Decree or if a third party has requested implementation of Article 35 of the said Decree.

Article 37

The applicant shall be notified of the *ex-officio* conversion provided for in the last paragraph of Article 19 of the Law of January 2, 1968, and shall have a period of two months from the date of receipt of the notification in which to submit observations. If no comments are submitted within that time limit or if comments submitted are rejected, the *ex-officio* conversion shall be maintained or confirmed; in the latter case, a new notification, stating the reasons, shall be issued to the applicant.

Article 38

The applicant shall have a period of two months from the date of receipt of the notification of the first provisional documentary report in which to file, in writing, observations and redrafted claims. This period may be renewed once, at the request of the applicant, for an additional period of the same duration.

The purpose of such observations shall be:

- (1) to discuss the pertinence of the prior art cited in the provisional report;
- (2) to bring out the technical features, either in the original claims or in redrafted claims, in respect of which he considers the prior art cited not to be pertinent.

The provisions of the foregoing paragraphs shall again apply after notification of the second provisional documentary report which, at the expiration of the time limit prescribed in the first paragraph, shall be made available to the public in accordance with the provisions of Article 39, below.

Article 39

A notice shall be published in the *Bulletin officiel de la propriété industrielle* announcing that the second provisional documentary report on the invention which is the subject of the patent application is made available to the public.

If the provisions of Article 26 of this Decree have not already been implemented, they shall be executed forthwith.

As from the date of the publication provided for in the first paragraph above, any person may take cognizance, free of charge, at the National Institute of Industrial Property of provisional documentary reports and of observations and redrafted claims submitted by the applicant; such person may obtain reproductions of these papers at his own expense.

Article 40

Within a period of three months from the date of the publication provided for in Article 39, above, any person may submit comments in writing on the second documentary report.

Such comments shall be submitted in the form of a list of items of the state of the art which may have a bearing on the patentability of the invention, within the meaning of Articles 8 and 9 of the Law of January 2, 1968, drawn up in accord-

ance with the provisions of the second paragraph of Article 33 of this Decree.

On pain of inadmissibility, such comments shall be accompanied by the documents cited or reproductions thereof and by any information or proof required. This provision shall not apply to documents consisting of patents, whether French or foreign; however, at the express request of the National Institute of Industrial Property, foreign patents must be furnished within a period of two months from the date of receipt of the said request.

Article 41

Comments filed by third parties under Article 40, above, shall be notified to the applicant by the National Institute of Industrial Property. The applicant shall have a period of two months, reckoned from the date of receipt of such notification, in which to file in writing his observations in reply and redrafted claims. This period may be renewed once, at the request of the applicant, for an additional period of the same duration.

Article 42

At the expiration of the time limit prescribed in Article 40 of this Decree, if no comments have been submitted by third parties, the final documentary report shall be established and shall have the same content as the second documentary report.

At the expiration of the time limit prescribed in Article 41 of this Decree, if third parties have submitted comments, the final documentary report shall be established; either it shall have the same content as the second documentary report or it shall further include all or part of the prior art cited by the third parties, after such prior art has been confronted with the observations, if any, of the applicant.

Article 43

If, owing to the filing of redrafted claims after notification of the second documentary report, the final report does not pertain to the final claims, mention of this shall be made in the report which, in such cases, shall indicate the earlier claims to which it refers.

Article 44

Notwithstanding the fact that real property rights, liens or license rights are recorded in the National Register of Patents in respect of a patent application, the applicant may amend the claims of his application without the consent of the beneficiaries of such rights.

Article 45

If the owner of a patent application considers that one or more items of the state of the art cited in the documentary report do not have a bearing on the patentability of the invention which is the subject of the said application because disclosure of such items was the consequence of an evident abuse in relation to him within the meaning of Article 8(1) of the Law of January 2, 1968, he may so state in his comments and briefly give the reasons therefor. Such a statement shall not alter the content of the documentary report.

Any final judicial decision on the applicability of the provisions of Article 8(1) of the Law of January 2, 1968, shall be recorded in the National Register of Patents at the request of the owner of the patent application or patent.

Such recording shall entail a correlative amendment of the documentary report.

If this record is entered after publication of the patent, the copies of the patent available at the National Institute of Industrial Property for consultation by the public and for sale shall be marked to show the amendment made to the documentary report.

CHAPTER VII

Grant and Publication of Patents

Article 46

Grant of the patent shall be withheld until the expiration of a period of eighteen months from the filing of the patent application, if a written request to that effect was submitted at the time of filing of the said application. An applicant who has requested that he be granted the benefits of this provision may forgo such benefits at any time by a written declaration.

If a priority has been claimed in accordance with Article 13 of this Decree, the period prescribed in the foregoing paragraph shall be reckoned as from the date on which the right of priority came into existence.

Implementation of the provisions of the foregoing paragraphs shall entail waiving implementation of Article 39 of this Decree until the expiration of the period provided for in the said paragraphs.

Article 47

The patent shall be granted in the name of the applicant by a decision of the Director of the National Institute of Industrial Property stating that the application complies with the requirements laid down in the Law of January 2, 1968, in this Decree, and in the order prescribed in Article 106 of this Decree. The applicant shall be notified of such decision.

In the event that the application has been assigned, the patent shall be granted in the name of the assignee at the latter's request accompanied by the consent of the assignor. At the request of both parties, the name of the assignor shall also be mentioned in the patent.

The final documentary report, of which the full content as defined in Articles 42 or 43 of this Decree is included in the patent, shall, where applicable, make mention of the fact that the original claims were amended or that observations were submitted by the applicant or by third parties during the procedure for drawing up the final documentary report.

The patent shall, in particular, indicate the filing date of the application, the publication date of the application, the date of the decision to grant the patent, and the date of publication of the grant of the patent in the *Bulletin officiel de la propriété industrielle*; where applicable, it shall further mention the priorities claimed, the existence of a division of the original application, and the fact that, at the time of filing, the description or the claims were drafted in a foreign language in accordance with the provisions of the second and third paragraphs of Article 11 of this Decree.

Article 48

In the event that forfeiture of the rights deriving from the patent application has been published in conformity with Article 61 of this Decree, the procedure for grant of the patent shall be discontinued.

Article 49

A notice announcing the grant of the patent shall be published in the *Bulletin officiel de la propriété industrielle* within a period of one month from the date of the notification of grant issued to the applicant in conformity with the second paragraph of Article 47 of this Decree.

This notice shall, where appropriate, mention the issue number of the *Bulletin officiel de la propriété industrielle* in which the patent application was made available to the public, as well as the existence of any amendments made to the original claims.

Following this publication, a certified copy of the patent shall be issued to the applicant.

If the patent application was not published, the abstract provided for in Article 10 of this Decree shall be published underneath the notice announcing the grant of the patent.

As from the date of the publication provided for in the foregoing paragraphs, any person may take cognizance of the patent free of charge at the National Institute of Industrial Property or obtain a reproduction thereof at his own expense.

Article 50

The full texts of patents shall be published and kept on file at the National Institute of Industrial Property.

Documents pertaining to patent applications shall be kept on file at the National Institute of Industrial Property until a period of ten years has elapsed from the expiration of the rights deriving from the patents.

During that period, any person may take cognizance, free of charge, of the papers relating to the filing of the application, the procedure for grant, and the procedure for drawing up the documentary report, or may obtain a reproduction of such papers at his own expense.

After the expiration of the period prescribed in the second paragraph of this Article, the National Institute of Industrial Property may destroy documents pertaining to patent applications. Notwithstanding the provisions of Article 4 of the Decree of July 21, 1936, such destruction shall not require endorsement by the directorate of the *Archives de France*.

However, the originals of descriptions and drawings pertaining to patents not printed prior to the implementation of the Law of April 7, 1902, shall remain on file at the National Institute of Industrial Property.

Article 51

Collections of patents and the *Bulletin officiel de la propriété industrielle* shall be kept on file for consultation by the public free of charge at the headquarters of the National Institute of Industrial Property in Paris and at the Documentation Centers of that public institution in Lyons and Marseilles.

They shall also be kept on file for the same purposes in the towns listed by order of the Minister responsible for Industrial Property and the Minister responsible for Cultural Affairs, either in the Record Office of the *Département* or at the Chamber of Commerce and Industry, or else in a public library or any other establishment designated by the *Préfet*¹.

The *Bulletin officiel de la propriété industrielle* shall be kept on file in the Record Offices of the *Départements* and at the Chambers of Commerce and Industry not appearing in the list prescribed in the foregoing paragraph.

CHAPTER VIII

Naming of Inventor and Claim of Ownership

Article 52

Only the owner of the patent application or patent may name the inventor. This may be done at any time, even after the expiration of the patent.

The naming of any inventor may be deleted at the written request of the person named.

Designations of inventors are not controlled by the National Institute of Industrial Property.

Article 53

Any final judicial decision ruling on the naming of an inventor shall be recorded free of charge in the National Register of Patents on the *ex-officio* requisition of the court clerk or at the request of one of the parties to the suit.

Article 54

If the inventor is named or if such designation is altered after publication of the patent, the copies of the patent available at the National Institute of Industrial Property for consultation by the public and for sale shall be marked with the designation of the inventor or the alteration of such designation.

Article 55

Actions claiming ownership of a patent application or patent shall be recorded in the National Register of Patents at the request of the person who entered the action.

Any final judicial decision delivered on an action claiming ownership of a patent application or patent shall be recorded free of charge in the National Register of Patents on the requisition of the court clerk or at the request of one of the parties to the suit.

If the judicial decision delivered is favorable to the person who instituted the proceedings, the copies of the patent application or patent available at the National Institute of Industrial Property for consultation by the public and for sale shall be marked with an indication showing the change of ownership of the patent.

Article 56

The procedure for patent grant shall be suspended at the written request of any person who submits evidence that he has instituted court proceedings concerning a claim to ownership of the patent application.

¹ The administrative head of a *Département*.

Suspension of the procedure shall take effect as from the date on which the evidence is submitted and shall apply, in particular, to the period of two years provided for in the third paragraph of Article 19 of the Law of January 2, 1968; however, it shall not hinder implementation of Article 26 of this Decree.

The procedure for patent grant shall be resumed as soon as there is no appeal from the decision of the court; it may also be resumed at any time if the person who instituted the proceedings concerning a claim to ownership of the patent application gives his consent in writing; such consent shall be irrevocable.

Suspension and resumption of the procedure shall be automatically recorded in the National Register of Patents.

Article 57

As from the date on which a person submits evidence that he has instituted proceedings concerning a claim to ownership of a patent application or a patent, the owner of such application or such patent may not withdraw the said application or renounce the said patent either in full or in regard to one or more of the claims it comprises, except with the written consent of the person who instituted the proceedings concerning the claim to ownership.

CHAPTER IX

Renunciation and Forfeiture

Article 58

The patent or one or more of the claims therein may be renounced by written declaration.

This declaration shall pertain to one patent, only. It shall be made by the owner of the patent or by an agent. In the latter case, a special power-of-attorney for renunciation must be attached to the declaration.

If the patent belongs to two or more persons, renunciation may be effected only if requested by both or all such persons.

Where real property rights, liens or license rights have been recorded in the National Register of Patents, the declaration of renunciation shall only be admissible if accompanied by the consent of the beneficiaries of such rights.

Renunciation shall be automatically recorded in the National Register of Patents. It shall take effect on the date on which it is so recorded.

A notice of the recording shall be issued to the author of the renunciation.

Article 59¹

The period of six months provided for in the second paragraph of Article 41 of the Law of January 2, 1968, within which payments of annual fees made after the due date for such payments will be validated upon payment of a surcharge for late payment, shall be reckoned from the day on which the annual fee prescribed in the fourth paragraph of Article 79 of this Decree fell due.

Late payment of the annual fees mentioned in the foregoing paragraph, made in respect of a patent application

resulting either from the division of a patent application in conformity with Articles 21 and 22 of this Decree or from the conversion of an application for a patent of addition in conformity with Article 74 thereof, shall be deemed valid provided that such payments are made within a period of two months from the filing date of the divisional application or from the filing of the request for conversion of the patent of addition.

The periods provided for in the foregoing paragraphs shall be calculated in accordance with the provisions of Article 105 of this Decree. Moreover, if the day on which the annual fees fall due or the last day of the said periods is a Saturday, Sunday, holiday or a non-working day, or a day on which the offices of the National Institute of Industrial Property which are empowered to receive the payments are not open, such payments may be validly made on the next succeeding working day.

The provision of this Article shall apply to patent applications filed prior to the date of coming into operation of this Decree as well as to patents granted prior to that date, as regards annual fees falling due after that date.

Article 60

Where payment of an annual fee has not been made at the normal due date, the owner of the patent application or patent shall be issued a warning advising him that his rights will be subject to forfeiture if the said annual fee, together with the surcharge for late payment, is not paid before the expiration of the period provided for in the first paragraph of Article 59 of this Decree.

Absence of warning or any errors the warning might contain shall not involve the responsibility of the National Institute of Industrial Property and shall not constitute grounds for restoration of the rights of the patent owner.

Article 61

Within two months of the expiration of the period provided for in the first paragraph of Article 59 of this Decree, the Director of the National Institute of Industrial Property shall notify the owner of the patent application or the patent of the decision establishing forfeiture of his rights for non-payment, within the prescribed time limit, of the annual fee and the surcharge for late payment.

This notification shall indicate the date — after which forfeiture is made public by the automatic recording thereof in the National Register of Patents — of expiration of the period for appeal for restoration of rights provided for in the third paragraph of Article 48 of the Law of January 2, 1968.

If the owner of the patent application or patent has made an appeal from the decision establishing forfeiture, or if he has brought an action for the restoration of his rights before the Paris Court of Appeal, publication of the forfeiture shall be postponed until the court has delivered a decision; however, mention of the appeal or the action for restoration shall be automatically recorded in the National Register of Patents.

The decision of the Paris Court of Appeal shall be automatically recorded in the National Register of Patents. Where

¹ Including the correction which appeared in the *Journal officiel* of December 29, 1968, p. 12392.

applicable, it shall be accompanied by an indication of the fact that the owner of the patent application or patent has lodged an appeal with the Supreme Court [*Cour de cassation*]. The ruling of the Supreme Court shall be recorded in like manner in the National Register of Patents.

The provisions of this Article shall apply to patent applications filed prior to the date of coming into operation of this Decree and to patents granted prior to that date.

CHAPTER X

The National Register of Patents

Article 62

The National Register of Patents shall contain, in respect of each patent application or patent, in addition to the name of the applicant and the information required for identification of the application or patent, the dates of filing, publication, grant or rejection, as well as the records prescribed in this Decree.

Recording shall be effected by the insertion, in the Register, of instruments which can be invoked against third parties in the cases referred to in Articles 45, second paragraph, 53, 55, second paragraph, 58, fifth paragraph, 61, second and fourth paragraphs, 63, 65, 66 and 97 of this Decree or by entering information in the said Register in the cases referred to in Articles 55, first paragraph, 56, fourth paragraph, 61, third and fourth paragraphs, 67 and 68 of this Decree, as well as in the third paragraph of this Article.

The name of the applicant and the information required for identification of the patent application shall be automatically recorded in the National Register of Patents once the patent application has been made available to the public in accordance with the provisions of Article 26 of this Decree; no record shall be entered in the said Register prior to such publication.

Article 63

Applications for the recording, in the National Register of Patents, of transfers of property, assignments or licenses pertaining to a right of exploitation, the establishment or assignment of liens, as well as of any other deeds dealing with assignments of or changes in the rights deriving from a patent application or a patent, must be accompanied by an original of the deed if the latter is a simple contract, or by a copy if it is an authentic act, or by a document establishing transfer in the event of succession; in addition, proof of payment of the fees due must be submitted.

The original of a simple contract may be returned to the person who applied for recording thereof, provided that a reproduction of the agreement is made and authenticated, at his expense, by the National Institute of Industrial Property.

Recording may also be effected on the basis of an abstract of the deed. In such cases, where the signatures of the parties do not appear on the abstract, the person applying for the recording must submit the deed which shall be returned to him if he so requires after the conformity of the abstract with the deed has been controlled; no copy of the deed shall be kept by the National Institute of Industrial Property.

The applications for recording provided for in the foregoing paragraphs may be submitted only by the parties to the

deed or one such party, by their successors in title, heirs or legatees, or by their agent.

An application for the recording of a deed or of provisions taken from a deed shall be inadmissible if the parties have agreed in the said deed, or in any instrument submitted to the National Institute of Industrial Property, that the deed or the provisions of the deed are not to be published.

Article 64

In the absence of regularization in accordance with the requirements and within the time limits prescribed in Article 29 of this Decree, any application for the entry of records which does not comply with the provisions of Article 63, above, shall be rejected by a reasoned decision of the Director of the National Institute of Industrial Property notified to the person having applied for the recording, and the papers filed shall be returned to him.

Article 65

Any seizure of a patent shall be notified to the National Institute of Industrial Property by the party effecting seizure. The report on the public auction [*adjudication*] held in respect of the patent following the judgment validating seizure shall likewise be notified, by the first mover. These notifications shall be recorded in the National Register of Patents.

Article 66

Where there is no appeal from a decision ordering annulment of a patent, the decision shall be recorded in the National Register of Patents only if it pronounces the absolute nullity of the patent in accordance with the provisions of Article 50 of the Law of January 2, 1968. Such decisions shall be recorded free of charge on the requisition of the court clerk or at the request of one of the parties to the suit.

Article 67

Changes of name, style or address and corrections of clerical errors affecting records may be entered in the National Register of Patents. Changes of address, only, shall not require the filing of documents in proof.

Article 68

Records entered in the National Register of Patents in respect of liens on patents shall be cancelled upon the filing of either a final judicial decision or a written declaration in which the creditor or his assignee, substantiating his rights, consents to the cancellation.

Article 69

A notice of all records entered in the National Register of Patents shall appear in the *Bulletin officiel de la propriété industrielle*.

Article 70

Reproductions of records entered in the National Register of Patents or certificates attesting to the fact that there are no such records shall be issued to any person who so requests.

CHAPTER XI

Patents of Addition

Article 71

The provisions of this Decree which concern patents shall apply to applications for patents of addition, as well as to patents of addition, related to patent applications or patents, with the exception of Articles 37, 48, 59, first paragraph, 60, 61 and 79, third and fourth paragraphs, of this Decree.

No application for a patent of addition may be related to more than one patent application or more than one patent, or to one or more applications for a patent of addition or one or more patents of addition.

Article 72

Any application for a patent of addition shall be declared inadmissible if the applicant therefor is not the owner or one of the joint owners, recorded in the National Register of Patents, of the patent application or patent to which the application for the patent of addition is related, unless, within a period of two months from the date of receipt of the notification issued to him for that purpose, he has the document attesting to his capacity as owner or joint owner of the patent application or patent recorded in the said Register; however, if the patent application has not yet been made available to the public, the applicant for the patent of addition shall attest to his ownership or joint ownership of the patent application by any other means of proof.

Any application for a patent of addition which is related to a patent application or patent forfeiture of which has been published in accordance with Article 61 of this Decree shall also be declared inadmissible.

Article 73

Any application for a patent of addition related to a patent application or a patent and in respect of which a request for drawing up the documentary report is not submitted within the period prescribed in Article 19 of the Law of January 2, 1968, shall not undergo the procedure provided for in Articles 38 to 43 of this Decree and may no longer be converted into a patent application.

A patent of addition granted in accordance with the provisions of the foregoing paragraph shall expire no later than six years after the filing date of the application for the patent of addition; the limited term thereof shall be indicated in the document incorporating the grant.

The applicant shall be notified that the provisions of the foregoing paragraphs apply to his application for a patent of addition; he shall have a period of two months, reckoned from the date of receipt of the notification, in which to submit observations. If no observations are submitted within that period, or if the observations submitted are rejected, the notification shall be maintained or confirmed; in the latter case, a further notification, stating the reasons, shall be issued to the applicant.

Article 74

Any request for the conversion of an application for a patent of addition into an application for a patent shall be admissible only if submitted in writing before the date of receipt of the notification of grant of the patent of addition and if accompanied by proof of payment of the fee due.

Any application for a patent of addition related to a patent application or a patent may be converted, in accordance with the requirements prescribed in the foregoing paragraph, into an application for a certificate of utility.

Article 75

In the event that, after the filing of the application for a patent of addition, forfeiture of the patent application or patent to which such application for a patent of addition is related is published in accordance with Article 61 of this Decree, the procedure for the grant of the said patent of addition shall be discontinued, unless the applicant requests conversion of his application, in accordance with the requirements prescribed in the foregoing Article, within a period of two months from the date of receipt of the notification issued to him for that purpose.

CHAPTER XII

Certificates of Utility

Article 76

The provisions of this Decree shall apply to applications for certificates of utility and to certificates of utility, with the exception of Articles 27, 33 to 45, and the third paragraph of Article 47 of this Decree.

The provisions of Chapter XI of this Decree shall apply to applications for certificates of addition and to certificates of addition related to applications for certificates of utility or to certificates of utility, with the exception of Article 73 of this Decree.

An application for a certificate of addition related to an application for a certificate of utility may not be converted into a patent application.

Article 77

As from the date of the publication, provided for in Article 26 of this Decree, of the application for a certificate of utility and up to the publication of the grant of such certificate, any person may submit comments on the patentability of the invention to the National Institute of Industrial Property, in the manner prescribed in the second and third paragraphs of Article 40 of this Decree.

The content of such comments shall be notified forthwith to the applicant. No observations in reply shall be admissible.

Article 78

Up to the date of receipt of notification of the grant of the certificate of utility, the applicant may, upon written request, file redrafted claims.

The request shall be admissible only if accompanied by proof of payment of the fee prescribed in Article 83 of this Decree.

CHAPTER XIII

Fees and Charges

Article 79

A fee, due at the time of filing, shall be payable in respect of all patent applications.

The first annuity is included in this fee.

An annual fee for maintaining the patent application or patent in force shall be payable for each year of the term of the patent.

Payment of this fee shall fall due each year on the last day of the month in which the patent application was filed.

Article 80

A fee shall be payable in respect of drawing up a documentary report; this fee shall be due at the time that the application is filed unless the applicant submits the request provided for in Article 34 of this Decree.

The order prescribed in Article 90 of this Decree shall specify the deferred payments that may be made by a natural person filing an application in his own name.

If the procedure for drawing up the documentary report has not yet been undertaken at the time that a patent application is withdrawn pursuant to Article 25 of this Decree or at the time that the procedure for grant of the patent is discontinued under Article 48 of the said Decree, or if prohibitions on disclosure and free working have been retained in effect in respect of the patent application pursuant to Article 16 of the said Decree, the fee prescribed in the foregoing paragraph shall, if already paid, be refunded.

Article 81

A fee shall be payable in respect of every right of priority claimed.

Article 82

Each patent application shall be subject to the payment of fees in respect of:

- (1) any page of description or any sheet of drawings in excess of the number fixed in the order prescribed in Article 90 of this Decree;
- (2) any claim in excess of the number fixed in the order prescribed in the said Article 90;
- (3) any correction of clerical errors which has been authorized in accordance with the provisions of Article 24 of this Decree.

Article 83

A fee shall be payable in respect of filing the redrafted claims provided for in Article 78 of this Decree.

Article 84

A fee shall be payable in respect of requests, provided for in Articles 21, 30, 32, 38 and 41 of this Decree, for the renewal of periods of time.

Such requests shall be admissible only if accompanied by proof of payment of the said fee.

Article 85

A fee shall be payable in respect of any request for the conversion of an application for a patent of addition into an application for a patent.

Article 86

A fee shall be payable in respect of the following:

- (1) any recording or cancellation made in the National Register of Patents pursuant to Articles 45, second paragraph, 55, first paragraph, 63, 65 and 68 of this Decree;
- (2) any recording made in the National Register of Patents pursuant to Article 67 of this Decree;
- (3) the issuance of reproductions of records in the National Register of Patents or of the certificates referred to in Article 70 of this Decree.

Article 87

A fee shall be payable in respect of drawing up the novelty report prescribed in Article 98 of this Decree.

Article 88

Fees or charges shall be collected in respect of the following services:

- (1) issuance of an official copy of a patent application;
- (2) issuance of an official copy of a patent;
- (3) issuance of a reproduction of documents concerning a priority right;
- (4) issuance of a duplicate copy of a document or of an attestation concerning a patent or a patent of addition;
- (5) authentication of a copy of a patent.
- (6) issuance of a statement of account regarding the payment of annual fees.

Article 89

It shall be deemed that payment of the fees and charges prescribed in this Decree is valid if it is made at the rate in force at the date of payment.

The annual fees prescribed in Article 59 of this Decree may, in respect of one patent, be paid in a single payment covering a number of years. In such cases, however, the said fees cannot be refunded, regardless of what the ultimate lot of the patent application or patent may be.

The dates on which, depending on the various terms of payment, the fees and charges prescribed in this Decree will be regarded as duly paid shall be set forth by joint order of the Minister responsible for Industrial Property, the Minister responsible for Finance and the Minister responsible for Posts and Telecommunications.

Article 90

The terms and conditions for collecting the fees and charges prescribed in this Decree and the amounts thereof, as well as the terms and conditions regarding sales of the various publications of the National Institute of Industrial Property and regarding the reproduction of documents relating to French and foreign patents kept on file by that public establishment, shall be laid down in an interministerial order issued pursuant to Article 46, as amended, of the Law of May 24, 1951.

CHAPTER XIV

Appeals from Decisions of the Director of the National Institute of Industrial Property

Article 91

The period during which appeals from decisions of the Director of the National Institute of Industrial Property may be brought before the Court of Appeal shall be one month.

If the appellant resides outside metropolitan France, this period shall be extended by:

- (1) one month if he resides in Europe;
- (2) two months if he resides in any other part of the world.

Article 92

The period for appeal provided for in the foregoing Article shall begin on the date of receipt of the notification, made to the appellant, of the decision of the Director of the National Institute of Industrial Property.

Article 93

The appeal shall be lodged in the form of a petition presented to the first president of the Paris Court of Appeal either by the appellant in person or by an attorney practising at the Court of Appeal or a lawyer called to the bar.

If the appellant does not appear in person, he may be represented or assisted in the manner indicated in the first paragraph of this Article.

Article 94

Where the appeal is lodged by a person other than the owner of the patent application or patent, the chief clerk of the Court of Appeal shall summon the said owner as a party to the suit, by registered letter with a request for advice of receipt.

Article 95

The Court of Appeal shall rule, upon hearing the State Attorney.

Article 96

The clerk of the Court of Appeal shall, within eight days of the lodging of an appeal from a decision of the Director of the National Institute of Industrial Property, give formal notice of such appeal to that Institute, by registered letter with a request for advice of receipt.

The clerk shall, in the same manner, notify the appellant and the National Institute of Industrial Property of the judgment on the appeal delivered by the Court of Appeal.

Article 97

The clerk shall send a copy of the above-mentioned judgment to the National Institute of Industrial Property; this judgment shall be automatically recorded in the National Register of Patents.

The judgment of the Court of Appeal shall be carried out within two months of notification thereof.

CHAPTER XV

Transitional Provisions

Article 98

The novelty report which must be submitted by any plaintiff in an action for infringement of a patent or a patent of addition applied for prior to the coming into operation of this Decree shall be drawn up at the request of the plaintiff, presented in writing to the National Institute of Industrial Property. It shall be admissible only if accompanied by proof of payment of the fee prescribed in Article 87 of this Decree.

In his request, the plaintiff shall specify those parts of the invention, concerned in the patent or patent of addition, which he alleges to be infringed and in respect of which the documentary search should be made.

The novelty report shall consist of a list of the items of the state of the art which may have a bearing on the novelty of the invention exclusively as regards the parts thereof indicated in the request.

In respect of each document cited in this report, references permitting identification thereof shall be given, and the part of the invention that the document concerns shall be indicated.

The novelty report shall be issued to the plaintiff and shall not be subject to the procedure prescribed in Articles 38 to 45 of this Decree.

Article 99

Applications for patents, for special medicine patents or for patents of addition filed prior to the date of coming into operation of this Decree shall be processed with a view to the issuance of the documents incorporating the grants in accordance with the provisions operative prior to the coming into operation of this Decree.

Article 100

The branches of technology, determined with reference to the International Classification of Patents for Invention set up under the Convention of December 19, 1954, within which the provisions of Chapter VI of this Decree will be progressively applied, shall be established by order of the Minister responsible for Industrial Property.

The first of these orders shall be published in the *Journal officiel* of the French Republic concurrently with this Decree and shall take effect on the same date. Subsequent orders shall be published prior to the first of October of each year and shall take effect on the following first of January.

Article 101

During the period in which the provisions of Chapter VI of this Decree are not applied in all branches of technology of the International Classification of Patents for Invention set up under the Convention of December 19, 1954, and notwithstanding Articles 34 and 80 of this Decree, notification shall, where necessary, be made to the applicant:

- either that his patent application is subject to the provisions of Chapter VI of this Decree; in this case, the applicant shall have a period of one month from the

date of receipt of the notification in which to pay the fee prescribed in Article 80 or to submit the request provided for in Article 34;

- or that his patent application is not subject to the provisions of Chapter VI of this Decree; in this case, the fee prescribed in Article 80 shall be refunded or it shall be declared that a request submitted in conformity with Article 34 is without object.

Article 102

The provisions of Articles 77 and 78 of this Decree shall apply to patent applications which are not subject to the provisions of the Articles of Chapter VI of this Decree.

Article 103

The documentary report to be submitted by any plaintiff in an action for infringement of a patent applied for after the date of coming into operation of this Decree and issued without having been subjected to the provisions of Chapter VI of this Decree shall be drawn up at the request of the plaintiff, presented in writing to the National Institute of Industrial Property. It shall be admissible only if accompanied by proof of payment of the fee prescribed in Article 80 of this Decree.

The documentary report shall be drawn up in the manner and subject to the conditions prescribed in Chapter VI of this Decree.

In the case provided for in the foregoing paragraphs, a notice announcing that a documentary report has been drawn up in respect of the granted patent shall be published in the *Bulletin officiel de la propriété industrielle*. As from the date of such publication, any person may take cognizance, free of charge, at the National Institute of Industrial Property, of the papers relating to the drawing up of the documentary report, or may, at his own expense, obtain reproductions of such papers.

Notwithstanding the filing of redrafted claims during the procedure for drawing up the documentary report, the granted patent shall not be amended.

CHAPTER XVI

Miscellaneous Provisions

Article 104

Any notification shall be deemed regular if made to the owner of the patent application last declared to the National Institute of Industrial Property or, after publication of the application, to the owner last recorded in the National Register of Patents.

If the owner is domiciled abroad, the notification shall be made to the agent he last appointed or the domicile he last elected for the purposes of the National Institute of Industrial Property.

It shall be compulsory for the notifications provided for in Articles 16, third paragraph, 29 to 32, 37, 61, 64 and 73, third paragraph, of this Decree to be sent by registered letter with a request for advice of receipt.

Article 105

All periods of time stipulated in this Decree shall be clear. The day of the act or decision opening the period as well as the day on which it ends shall not count.

Any period which would normally expire on a Saturday, Sunday, holiday or non-working day shall be extended to the next succeeding working day.

Article 106

The regulations for the implementation of Chapters I and X of this Decree shall be laid down by order of the Minister responsible for Industrial Property.

Article 107

Any provisions contrary to those of the present Decree are hereby repealed.

Article 108

This Decree shall apply to the overseas territories of New Caledonia, French Polynesia, St. Pierre and Miquelon, Wallis and Futuna, and the French Austral and Antarctic territories.

Article 109

The State Minister responsible for Cultural Affairs, the State Minister responsible for Social Affairs, the Keeper of the Seals and Minister for Justice, the Minister for Foreign Affairs, the Minister for the Armed Forces, the Minister for Economics and Finance, the Minister for Industry, the Minister for Posts and Telecommunications, the State Secretary, under the Prime Minister, responsible for Overseas *Départements* and Territories, and the State Secretary for Economics and Finance are entrusted, each in respect of what concerns him, with the enforcement of this Decree, which shall be published in the *Journal officiel* of the French Republic to take effect as from the first of January, 1969.

II

Decree

Designating the "Tribunaux de grande instance" Called upon to Hear Civil Actions Brought under Law No. 68-1 of January 2, 1968, to Promote Inventive Activity and Revise the Patent System

(No. 68-1098 of December 5, 1968)*

Article 1

The *tribunaux de grande instance* designated in the table attached to this Decree shall be called upon to hear civil actions brought under the above-mentioned Law No. 68-1 of January 2, 1968, in the districts defined in the said table.

Moreover, the Paris *Tribunal de grande instance* shall have jurisdiction over these same civil actions for the overseas territories of New Caledonia, French Polynesia, St. Pierre and Miquelon, Wallis and Fortuna, and the French Austral and Antarctic territories.

* BIRPI translation.

Article 2

This Decree shall come into operation on the same date as the above-mentioned Law No. 68-1 of January 2, 1968.

Article 3

The Keeper of the Seals and Minister for Justice shall be entrusted with the enforcement of this Decree, which shall be published in the *Journal officiel* of the French Republic.

Tribunaux having jurisdiction over civil actions brought under Law No. 68-1 of January 2, 1968

Tribunaux de grande instance	Territorial competency extending to the <i>Départements</i> included within the jurisdiction of the Courts of Appeal of:
Aix Court of Appeal: Marseilles	Aix-en-Provence, Bastia, Nîmes.
Bordeaux Court of Appeal: Bordeaux	Agen, Bordeaux, Poitiers.
Colmar Court of Appeal: Strasbourg	Colmar.
Douai Court of Appeal: Lille	Amiens, Douai.
Limoges Court of Appeal: Limoges	Bourges, Limoges, Riom.
Lyons Court of Appeal: Lyons	Chambéry, Lyons, Grenoble.
Nancy Court of Appeal: Nancy	Besançon, Dijon, Nancy.
Paris Court of Appeal: Paris	Orléans, Paris, Reims, Rouen, Basse-Terre, Fort-de-France, St. Denis (Réunion).
Rennes Court of Appeal: Rennes	Angers, Caen, Rennes.
Toulouse Court of Appeal: Toulouse	Pau, Montpellier, Toulouse.

III

Decree

Concerning Seizure Effected Prior to Initiating Patent Infringement Proceedings

(No. 69-190 of February 15, 1969)*

Article 1

The detailed description, with or without effective seizure, provided for in Article 56 of the Law of January 2, 1968 [to Promote Inventive Activity and Revise the Patent System], shall be ordered by the presiding judge of the *tribunal de grande instance* having jurisdiction in the place where the operation is to be carried out.

The order shall be given upon simple petition and production either of the patent, certificate of utility, patent or certificate of addition, or — in the case provided for in Article 55, first paragraph, second sentence, of the aforesaid Law — of a certified copy of the application for a patent,

* BIRPI translation.

certificate of utility, or patent or certificate of addition. In the latter case, the claimant must further submit proof that the conditions laid down in the said Article 55 have been complied with.

Where the petition is submitted by the grantee of an exclusive right of exploitation or by the holder of a license granted under Article 32 or Article 36 of the Law of January 2, 1968, the claimant must submit proof that the condition laid down in Article 53, second paragraph, of the said Law has been complied with.

Article 2

Where effective seizure is ordered, the judge may require the claimant to put up security which must be lodged before the seizure is undertaken.

On pain of nullity and damages awarded against the hailiff, the latter must, prior to undertaking seizure, turn over to the holders of the articles seized or described a copy of the order and, where applicable, a copy of the document recording the lodging of security. A copy of the seizure report shall be left with the same holders.

Article 3

The period provided for in Article 56, second paragraph, of the aforesaid Law of January 2, 1968, and granted to the claimant for the purpose of petitioning the court shall be 15 days, reckoned from the day on which seizure or description is effected.

Article 4

The provisions of Decree No. 68-1098 of December 5, 1968, issued under Article 68, third paragraph, of the aforesaid Law of January 2, 1968, shall not apply to the competency, provided for in Article 1 of this Decree, of the presiding judge of the *tribunal de grande instance*.

Article 5

The Keeper of the Seals and Minister for Justice and the Minister for Industry shall both be entrusted, each in respect of what concerns him, with the enforcement of this Decree which shall be published in the *Journal officiel* of the French Republic.

IV

Order

Concerning Applications for Patents and for Patents of Addition Involving a Documentary Report

(of December 5, 1968)*

Article 1

Those patent applications, and those applications for patents of addition related to patent applications or patents, which are principally classified in the technical branches of

* BIRPI translation.

the International Classification of Patents for Invention listed in the table appearing below shall be subject to the provisions of Chapter VI of . . . Decree No. 68-1100 of December 5, 1968 [Concerning Applications for, and the Issuance and Maintenance in Force of, Patents and Certificates of Utility].

Classification symbols	Technical branches
A 01 b	Soil working in agriculture or forestry.
A 23 c	Milk, milk products; milk substitutes; manufacturing, pasturizing, sterilizing and preserving same (non-mechanical part).
A 23 d	Butter substitutes; edible oils and fats.
A 23 f	Coffee; tea; their substitutes; manufacture, preparation, and infusion thereof.
A 61 k 9/00 to 27/00	Medicinal preparations.
A 61 l	Methods or apparatus for sterilizing materials other than foodstuffs; chemical purification of air; material for bandages, dressings, or suture materials; skin-protecting agents.
B 22 d 11/00	Continuous casting of metals.
B 29 d 9/00	Producing layered products consisting only of plastics other than rubber.
B 32 b	Layered products.
B 60 v	Air-cushion vehicles.
B 64 b	Lighter-than-air aircraft.
B 64 c	Aeroplanes; helicopters.
B 64 d	Equipment for fitting in or to aircraft; parachutes; arrangements or mounting of power plants or propulsion transmissions.
B 64 f	Ground or aircraft-carrier-deck installations.
B 64 g	Cosmonautics.
B 65 g	Transport or storage devices, e. g. conveyers for loading and tipping.
C 01 f	Compounds of the metals beryllium, magnesium, aluminium, calcium, strontium, barium, radium, thorium and of the rare earth metals.
C 01 g	Compounds of metals other than alkali metals and beryllium, magnesium, aluminium, calcium, strontium, barium, radium, thorium and the rare earth metals.
C 03 b 37/00	Manufacture or treatment of flakes, fibers, or filaments from softened glass, minerals, or slags.
C 03 c 13/00	Chemical composition of glass fibers or slag wool.
C 03 c 21/00	Treatment of glass by diffusing ions or metals in the surface.
C 03 c 25/00	Surface treatment of fibers or filaments from glass, minerals, or slags.
C 05 b	Phosphatic fertilizers.
C 05 c	Nitrogenous fertilizers.
C 05 d	Inorganic fertilizers other than phosphatic or nitrogenous fertilizers; fertilizers producing carbon dioxide.
C 05 f	Organic fertilizers other than phosphatic or nitrogenous fertilizers.
C 08 g 1/00	Polymeric products from saturated aldehydes.
C 08 g 3/00	Polycondensates from aldehydes with ketones.
C 09 b 1/00 to 5/00	Anthracene dyes.
C 09 b 27/00 to 45/00	Azo dyes.
C 10 g	Cracking hydrocarbon oils; production of liquid hydrocarbon mixtures from materials other than hydrocarbons; recovery of hydrocarbon oils from oil-shale, oil-sand, or gases; refining mixtures mainly consisting of hydrocarbons; reforming of naphta; mineral waxes.
C 10 m	Lubricating compositions; the use as lubricants of chemical substances either alone or as lubricating ingredients in a composition.
C 21 c	Processing of pig-iron; treatment in molten state of ferrous alloys.

Classification symbols	Technical branches
D 06 l	Bleaching, e. g. optical bleaching, dry-cleaning, or washing fibers, threads, yarns, fabrics, feathers, or made-up fibrous goods; bleaching leather or furs.
D 06 m	Treatment, other than bleaching, dyeing, printing or decorating, of fibers, threads yarns, fabrics, feathers, or fibrous goods made from such materials (non-mechanical part).
D 06 p	Dyeing or printing textiles; dyeing leather, furs, or solid macromolecular substances in any form.
D 06 q	Decorating textiles (chemical part).
E 04 c	Structural elements; building materials.
F 15 c	Fluid circuit elements predominantly used for computing or control purposes.
F 25 j	Liquefaction, solidification, or separation of gases or gaseous mixtures by pressure and cold treatment.
F 28 d	Heat-exchange apparatus in which the heat-exchange media do not come into direct contact.
F 28 f	Details of heat-exchange and heat-transfer apparatus, of general application.
G 01 t	Measurement of nuclear or X-ray radiation.
G 04 b	Mechanically driven clocks or watches; mechanical parts of clocks or watches in general; time-pieces using the position of the sun, moon or stars.
G 04 c	Electric clocks or watches.
G 04 d	Apparatus or tools specially designed for making or maintaining clocks or watches.
G 04 f	Short time-interval measuring, e. g. precision systems.
G 06 g	Analogue computers.
G 21 c	Nuclear reactors.
H 01 f 15/00 to 41/00	Inductances or transformers.
H 01 l 3/00 to 11/00	Semiconductor devices of a general type.
H 01 m 27/00	Fuel cells or batteries.
H 01 q	Aerials.
H 04 n	Pictorial communication; television.

Article 2

The classification symbols which are assigned by the National Institute of Industrial Property to applications for patents and for patents of addition, and they alone, shall be decisive as regards applying the provisions of Chapter VI of Decree No. 68-1100 of December 5, 1968, subject to the conditions laid down in Article 101 of that Decree.

Article 3

The Director of the National Institute of Industrial Property is entrusted with the enforcement of this Order, which shall be published in the *Journal officiel* of the French Republic to take effect as from the first of January, 1969.

V

Order**Laying Down Regulations Concerning the Filing of Applications for Patents, for Certificates of Utility and for the Entry of Records in the National Register of Patents**

(of December 5, 1968)*

Article 1

(1) The petition provided for in Article 3 (a) of the . . . Decree of December 5, 1968 [Concerning Applications for, and the Issuance and Maintenance in Force of, Patents and Certificates of Utility] shall be drawn up on paper 29 cm to 34 cm long and 20 cm to 22 cm wide and shall indicate:

(a) the nature of the grant sought: patent, certificate of utility, patent or certificate of addition, divisional patent or certificate of utility;

(b) the surname and given names or the business style, the nationality, and the domicile or registered office of the applicant or applicants and the address, if necessary, to which official communications should be sent;

(c) the name and address of the agent, if any;

(d) the title of the invention, composed of a short and precise designation of the latter, to the exclusion of any fancy appellation, name of a person, or trademark or service mark;

(e) the name of the inventor, where applicable.

(2) The petition shall further indicate whether the applicant wishes to avail himself of the provisions of the Decree of December 5, 1968, in respect of:

(a) withholding patent grant under Article 46 thereof;

(b) deferring the drawing up of the documentary report under Article 34 thereof;

(c) deferred payments, provided for in the second paragraph of Article 80 thereof, of the fee for drawing up the documentary report.

(3) The petition shall be signed by the applicant or applicants or by the agent.

(4) Petition forms shall be furnished free of charge by the National Institute of Industrial Property and may be obtained either from the headquarters of that establishment or from the *Préfectures*.

Article 2

The description and claims provided for in Articles 3, 7 and 8 of the Decree of December 5, 1968, shall be filed in triplicate. The text shall be presented legibly in dark, permanent characters on one side of strong, white paper 29 cm to 34 cm long and 20 cm to 22 cm wide. All pages shall be numbered consecutively in Arabic numerals.

The heading of the description shall give the surname and given names or the business style of each applicant and shall repeat the title of the invention.

* BIRPI translation.

The text of the claims shall, under the title "claims," begin at the top of the page following the last page of the description. If there are two or more claims, they shall be numbered consecutively in Arabic numerals.

The description and claims shall contain no drawing figures with the exception of graphic chemical or mathematical formulae, nor shall they contain fancy appellations, names of persons, or trademarks or service marks, unless such indications are required for identification of an article, product or document.

Units of weights and measures shall be in accordance with the metric system. For common units not belonging to the metric system and for setting out chemical or mathematical formulae, the internationally agreed rules shall be observed and internationally recognized notations employed. If more recent units are cited, they shall be accompanied by a definition or by bibliographical references.

One of the three copies of the description and claims shall be signed, after the claims, by the applicant or applicants or by the agent.

Article 3

The drawings provided for in Article 3(c) of the Decree of December 5, 1968, shall be filed in triplicate. They shall be executed in dark, permanent markings, without washes or colors, on smooth, white, non-shiny paper 29 cm to 34 cm long and 21 cm, or exceptionally 42 cm, wide, the surface used being no more than 25.7 cm by 17 cm or 25.7 cm by 35.5 cm. Each sheet shall be numbered in the middle of the upper margin. All of the various figures shall be numbered consecutively in Arabic numerals.

Drawings shall contain no descriptive matter, with the exception of such terms as "water," "steam," "section on AB," "open," "shut," and explanatory matter required for the understanding of certain diagrams or plans involving intricate circuits, graphs or flow sheets. Authorized terms and explanatory matter shall be given in the French language, without prejudice to the provisions of Article 11 of the Decree of December 5, 1968.

The scale shall be such that all details can be seen without difficulty. Where it is shown on the drawing, the scale shall be drawn and not indicated in writing.

One copy of each sheet shall be signed by the applicant or applicants or by the agent.

Drawings shall be filed in such a way as to be free from creases or cracks.

Article 4

Fees due in respect of filing the application, supplementary pages of description, supplementary sheets of drawings, and correcting clerical errors shall be payable at a reduced rate fixed by the ministerial order provided for in Article 90 of the Decree of December 5, 1968, if, notwithstanding Articles 2 and 3 above, the descriptions, claims, drawings and corrections of clerical errors to which they pertain are filed in accordance with the provisions of Articles 5, 6 and 7 below, the purpose of which is to permit reproduction thereof by offset.

Article 5

At least one of the three copies of the description and claims shall be typed or printed on paper 21 cm wide and 29.7 cm long (size A4).

The surface used for the text shall be delimited by a left-hand margin of 3 cm, a right-hand margin of 1 cm and margins of 2 cm at the top and bottom. The type or print shall be black and shall form a single column covering the entire surface to be used, with the exception of the last page of description and the last page of claims. Subject to the same exception, and without prejudice to Article 7 below, there shall be approximately 40 lines per page.

Drawings may be inserted in the description. They shall be numbered consecutively, together with those appearing on the drawing sheets.

In the left-hand margin, about 0.5 cm from the text, every fifth line shall be numbered (5, 10, 15, etc.), the numbering beginning again at five opposite the fifth line of each successive page. All pages shall be numbered in the middle of the upper margin.

In the copy provided for in this Article, the description shall have no heading and there shall be no signatures.

Article 6

At least one of the three copies of the drawings shall be presented on sheets 21 cm wide and 29.7 cm long (size A4).

The surface used for the execution of the drawings shall be delimited by a left-hand margin of 3 cm, a right-hand margin of 1 cm and margins of 2 cm at the top and bottom.

The copy provided for in this Article shall not be signed.

Article 7

If, under Article 24 of the Decree of December 5, 1968, corrections are made either in the original text of the description or claims or in the drawings, the page involving corrections shall be replaced in the copy provided for in Articles 5 and 6 above; in such cases, there may be more than 40 lines of text. It shall not be necessary to file a new page, however, if the correction does not affect the presentation of the text.

Article 8

To facilitate presentation of descriptions and claims in accordance with the provisions of Articles 5, 6 and 7 above and to permit reproduction by offset, the National Institute of Industrial Property shall furnish, free of charge, paper on which a frame is marked in inactic ink; such paper may be obtained either from the headquarters of that establishment or from one of the *Préfectures*.

Article 9

(1) The abstract, provided for in Article 10 of the Decree of December 5, 1968, of the technical content of the invention shall be drawn up in duplicate in accordance with the general requirements as to form prescribed in Articles 2 and 3 of this Order. It shall indicate the title of the invention, the name of the applicant, and the claim to priority, if any.

(2) The text of the abstract shall be comprised of three paragraphs; the purpose of the respective paragraphs shall be:

(a) to situate the invention as precisely as possible in the branch of technology to which it belongs;

(b) to describe the principal technical features of the invention in its preferred embodiment with, where applicable, references to the drawing provided for in the third paragraph of this Article;

(c) to list the principal applications indicated in the description.

(3) Where the patent application includes drawings, the text of the abstract shall further include a sheet bearing a drawing which may be in the form of a figurative or schematic sketch, a diagram, a chemical formula or a wiring diagram. The drawing shall be limited to a single figure, except in the case of chemical formulae; it shall show the references mentioned in the text of the abstract. The indication "drawing for the abstract" shall appear in the upper margin at the right-hand side.

(4) In the abstract, the indications and text provided for in the first and second paragraphs of this Article shall total no more than 18 lines, or no more than 30 lines, of 50 letters or symbols depending on whether or not the abstract includes a drawing.

Article 10

The samples provided for in Article 3(c) of the Decree of December 5, 1968, shall be wrapped when filed. Filing thereof shall be noted in the acknowledgment of filing. Costs incurred in sending the parcel from the *Préfecture* to the National Institute of Industrial Property shall be borne by the applicant. The *Préfecture* or the National Institute may refuse bulky samples or models, or commodities or products that are either dangerous or perishable.

Article 11

The agent's power-of-attorney provided for in Articles 2 and 3(f) of the Decree of December 5, 1968, shall indicate the surname and given names or the business style and the domicile or registered office of the applicant and of the agent. It shall be dated and signed by the applicant.

Article 12

The copies of the description, claims, and abstract, as well as of the drawings and priority documents, if any, shall be filed in a sealed envelope bearing the name of the party soliciting the grant, the title of the invention, a list of the papers contained in the envelope and the number of such papers. Other papers pertaining to the patent application shall be filed outside the envelope.

Article 13

The authorization to claim priority, in the case provided for in Article 13, second paragraph, of the Decree of December 5, 1968, shall be accompanied by a translation if it is in a foreign language other than English or German. The authorization shall not require authentication.

Where the certified copy provided for in Article 13, second paragraph, of the Decree of December 5, 1968, is in a foreign language, the National Institute of Industrial Property may require a translation of that part of such copy which contains the references prescribed in the first paragraph of the same Article.

Article 14*

The applications provided for in Article 63 of the Decree of December 5, 1968, for the entry of records in the National Register of Patents shall be submitted in quadruplicate and shall contain:

- (1) if the patent application was filed before January 1, 1969, the date and place of filing, the number of the filing certificate in the case of an application or the number of the grant in the case of a patent, and the name of the applicant for the patent;
 - (2) if the patent application was filed on or after January 1, 1969, the date of filing, the national registration number provided for in Article 6 of the Decree of December 5, 1968, and the name of the applicant for the patent;
 - (3) the surnames and given names or the business styles, as well as the addresses, of the parties to the deed, the heirs or legatees;
 - (4) the nature and extent of the right transferred, assigned or established;
 - (5) the nature and date of the deed, abstract or document submitted;
 - (6) the date of the application for entry of a record and the signature of the party applying therefor or of the agent.
- One of the copies, bearing a notice of the recording, shall be returned to the party who applied for the entry.

Article 15

The applications provided for in Article 67 of the Decree of December 5, 1968, for the entry of records in the National Register of Patents shall be submitted in quadruplicate and shall contain:

- (1) the indications prescribed in Article 14(1) and (2) above;
- (2) the surname and given names or the business style, as well as the address, of the last owner of the patent application or patent, as they were recorded in the National Register of Patents before the application for the entry;
- (3) the new name, style or address, or the wording of the correction of clerical errors affecting records;
- (4) where applicable, the nature and date of the document in proof submitted;
- (5) the date of the application for the entry and the signature of the party applying therefor or of the agent.

One of the copies, bearing a notice of the recording, shall be returned to the party who applied for the entry.

Article 16

The deed referred to in Article 63, first paragraph, of the Decree of December 5, 1968, shall be accompanied by a

reproduction thereof; the latter shall be kept on file by the National Institute of Industrial Property.

This provision shall also apply to the abstract provided for in Article 63, third paragraph, of the said Decree.

Article 17

The provisions of this Order shall apply to certificates of utility and to certificates of addition. However, as regards certificates of utility and certificates of addition related thereto, the descriptions, claims and drawings shall only be submitted in duplicate.

Article 18

The Director of the National Institute of Industrial Property is entrusted with the enforcement of this Order, which shall be published in the *Journal officiel* of the French Republic to take effect as from January 1, 1969.

ITALY

Decrees

Concerning the Temporary Protection of Industrial Property Rights at Six Exhibitions
(of February 20, 25, 27 and 28, 1969)¹

Single Article

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

- MODA SELEZIONE* (Turin, April 18 to 21, 1969);
Rassegna suinicola internazionale (Reggio Emilia, May 1 to 4, 1969);
III^a Rassegna internazionale della chimica e giornate della chimica (Milan, May 17 to 25, 1969);
XIX^a Fiera di Ancona — Mostra mercato internazionale della pesca, degli sports nautici e attività affini (Ancona, June 26 to July 6, 1969);
VI^o Salone internazionale componenti, strumenti di misura elettronici ed accessori — XXXIV^a Mostra nazionale radio televisione — VI^a Esposizione europea elettrodomestici (Milan, September 6 to 11, 1969);
XLI^a Esposizione internazionale del ciclo e del motociclo (Milan, November 22 to 30, 1969)

shall enjoy the temporary protection provided by Laws No. 1127 of June 29, 1939², No. 1411 of August 25, 1940³, No. 929 of June 21, 1942⁴, and No. 514 of July 1, 1959⁵.

¹ Official communication from the Italian Administration.

² See *La Propriété industrielle*, 1939, p. 124; 1940, p. 84.

³ *Ibid.*, 1940, p. 196.

⁴ *Ibid.*, 1942, p. 168.

⁵ *Ibid.*, 1960, p. 23.

* Including the correction which appeared in the *Journal officiel* of December 29, 1968, p. 12393.

GENERAL STUDIES

The Provisions for the Implementation of the New French Patent Law

By Roger GAJAC
Legal Counsellor, Head of Division
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The Law of January 2, 1968, revising the French legal system on patents came into operation on January 1, 1969.

It is well known that the main innovations of this Law are to be found in the requirement that "claims" [*revendications*] be filed and in the establishment of a novelty examination, which is moreover original inasmuch as the results of the examination are simply given in a "documentary report" attached to the patent document and have no effect, at least from the legal standpoint, on the grant. Alongside the patent proper, which is subject to examination and is granted for a term of 20 years, as was the case hitherto, the new Law has instituted the "certificate of utility," which is not examined and has a term of six years. An applicant for the grant of a patent subject to examination¹ may ask that the examination be deferred for two years, during which time he may opt for either of the two kinds of grant. It should be noted, however, that if the original application was for a certificate of utility, it may not subsequently be converted into a patent application.

As is customary under the French constitutional system, the new Law, despite its numerous provisions (74 articles), is of a rather general nature. In a field such as industrial property, the French Constitution entrusts Parliament with the task of defining "basic principles" and therefore gives a wide rein to the Government which lays down the regulations implementing these principles. This is the reason for the considerable number of legal provisions implementing the Law of January 2, 1968, and for their scope, which justifies some comment in connection with their publication here.

Three decrees, of varying importance, have been issued to date for the implementation of the new Law, namely:

(1) Decree No. 68-1100 of December 5, 1968, "concerning applications for, and the issuance and maintenance in force of, patents and certificates of utility." The provisions of this Decree are in turn defined more explicitly in several orders relating to fees, application formalities, and the progressive application of the novelty examination.

(2) Decree No. 68-1098 of December 5, 1968, designating the courts of first instance [*tribunaux de grande instance*] and courts of appeal called upon to hear civil actions, especially actions for infringement or nullity, concerning patents. This second Decree implements Article 68 of the new Law

which, for the first time, concentrates such proceedings in a limited number of courts, namely, 10 courts of first instance out of the 100 courts of that type in France. It is unnecessary to dwell on the reasons for this centralization, for it has already been effected in a number of other countries and particularly in the Federal Republic of Germany where the extent of the centralization is comparable.

(3) Decree No. 69-190 of February 15, 1969, which defines the procedure termed "*saisie-contrefaçon*." Under this procedure, which is relatively unknown in foreign legislation but traditional in France where it can also be applied in trademark and design cases, the owner of a patent (or of a patent application, since such an owner is empowered, subject to certain conditions, to bring an action for infringement) is able, through expeditious means, to establish proof of infringement before filing the actual suit.

Of all these decrees, the only one that would appear to call for more detailed comment here is Decree No. 68-1100 of December 5, 1968, which, in over a hundred articles, defines the requirements for the filing, grant and maintenance in force of patents or certificates of utility and, accessorially, the formalities for recording all deeds affecting these documents in the "National Register of Patents."

This does not mean, however, that there is any need to comment on all the articles in this Decree, or even on the most important of them. A commentary is only of interest if it concerns new provisions which depart significantly from the earlier ones or from those found in the legislation or rules of foreign countries.

In Chapter I of the Decree, relating to the filing of applications for patents or for certificates of utility, the provisions that merit comment in this respect are those of Articles 7 and 8.

Article 7 defines, with a certain degree of precision, the constituent elements and structure of the description of invention to be given in the patent application. Provisions of this type are completely new in France and it appears that they are also uncommon in other countries. This is the first time, or so it seems, that the work of legal harmonization that has been going on over the past few years — within the framework of the European Economic Community or under the auspices of the Council of Europe or BIRPI, which institutions have moreover collaborated closely with one another — has found expression on the national level. In substance, these provisions of the Decree are naturally very similar to the corresponding provisions (Rule 6) of the Draft Regulations under the Draft Patent Cooperation Treaty (PCT) published on July 15, 1968.

The same comment applies to Article 8 of the Decree, giving the form and contents of the claims, which is also based on certain international studies, in particular those made by the Council of Europe, and which can be compared with Rule 7 of the Draft PCT Regulations.

Details of application formalities for patents and certificates of utility (number, size and presentation of the papers filed) are laid down in an Order of December 5, 1968, issued under Article 108 of the Decree. Attention might be drawn, here, to one particularity of these provisions. The first articles

* BIRPI translation.

¹ Owing to the progressive implementation of the Law, not all patent applications are subject to examination as yet. See the last paragraph of this article.

of the Order define, in conformity with the European Convention of December 11, 1953, the maximum requirements to be complied with so that the documents of the application will be deemed in proper formal order. Stricter requirements, intended to permit direct offset reproduction of the documents, are then set forth in the following articles (4 to 8), as this type of reproduction is to replace the printing process employed up to now for French patents. Reductions in fees are accorded to applicants who, without being legally bound to do so, abide by the provisions of the latter articles. This will, in fact, be the case for nearly all of them.

The provisions of the Decree which relate to the procedures leading to patent grant (Chapters II to VII) are no doubt very important but do not call for a detailed commentary, since they include no major innovation as compared with the earlier provisions or with those appearing in the Law itself.

Article 26 of the Decree, relating to the procedure for the publication of applications might be pointed out, however. It implements Article 17 of the new Law which provides that all applications will automatically be published no later than 18 months following the filing date or priority date, regardless of the stage the application has reached at that time. Attention should also be drawn to Chapter VII which defines in detail the procedure under which the applicant, the administration and interested third parties are able to express their views and which leads to the drawing up of the "documentary report" attached to the granted patent.

The provisions of Chapter VIII of the Decree (naming of the inventor and claim to priority) are totally new in French legislation which, until now, has relied on the Paris Convention as regards the first point and on general law [*droit commun*] as regards the second.

Total or partial renunciation of the patent, as provided for in Article 58, is also a possibility not previously found in French legislation.

In the matter of annual fees, dealt with in the same chapter (IX) of the Decree, there are some innovations which ought to be mentioned.

Article 60 provides that, henceforth, if an annual fee has not been paid at the normal due date, the administration will issue a warning to the patent owner advising him of the sanction he will incur if the payment is not made within the period of grace. It is specified, furthermore, that the absence of such a warning does not involve the responsibility of the National Institute. French legislation has followed certain foreign precedents in this respect.

Another noteworthy innovation (and no doubt a more exceptional one) lies in fixing the last day of the month in which the application was filed as the normal due date for the payment of annual fees. This is the solution that appeared to concord with the common interests of the patent owners and the administration. Moreover, certain exchanges of views made within the Committee of Experts on Patents of the Council of Europe seem to have indicated that this solution is the one most likely to be adopted should national patent practice one day become unified.

Chapter X of the Decree (National Register of Patents) lays down regulations governing the implementation of a very

brief provision of the Law (Article 43, second paragraph). Although French legislation has, from the very beginning, provided that assignments or transfers of rights deriving from patents must be recorded in an official register if they are to be invoked against third parties, the new provisions considerably broaden the function of the National Register and, at the same time, extend the scope of the records it contains.

Chapter XIV on "appeals from decisions of the Director of the National Institute of Industrial Property" deserves special attention, even though the basis of these provisions is to be found in the Law itself (Articles 67 and 68). The latter henceforth invests the Director of the National Institute of Industrial Property himself with the power to take decisions, particularly in regard to the granting of patents or rejection of applications. Such decisions are no longer taken, as was the case in the past, by virtue of power delegated by the ministerial supervisory authority. As a result, the very nature of these decisions has been completely transformed, and they have taken on a true jurisdictional character, as was often pointed out during the elaboration of the Bill and when it was up before Parliament.

This is the consideration which, more than any other, explains why, under Article 68 of the new Law, appeals from decisions of the National Institute of Industrial Property are no longer dealt with by administrative courts but by the Paris Court of Appeal. More specifically, although the legal texts do not mention this, they will be brought before the chamber of that Court which specializes in the handling of industrial property cases.

Outside France, this (relative) integration of the National Institute of Industrial Property into the judicial machinery may come as no surprise to most specialists in patent law. In France, however, it nevertheless represents quite a remarkable innovation for, although the practical reasons for it are fully appreciated, it is clearly not in line with the traditional idea of separation of powers.

Be that as it may, the Decree of December 5, 1968, further underlines the judicial nature of these appeals by fixing time limits and laying down other regulations in accordance with the ordinary provisions of civil procedure.

One last remark might be made in connection with Article 100 of the Decree, which refers to the determination of the branches of technology within which the provisions on novelty examination will be progressively applied. Orders will be issued every year to designate the new branches. The first Order concerning "applications for patents and for patents of addition involving a documentary report" was issued on the same date as the Decree. The branches to be examined initially are designated in this Order by reference to the International Patent Classification. According to estimates, they represent approximately one-fifth of the patent applications expected in 1969.

Principles and Practice in the Application of Industrial Property Law in Cases of Parallel Importation

By J. WOLTERBEEK

I. Introduction *

One thing which the various industrial property rights have in common is their absolute and exclusive nature. There are, however, essential differences.

Patents and Copyrights

The basic reason for patents and copyrights is that it should not be possible for anyone to exploit unrestrictedly for his own benefit the product of someone else's mind, but that the creator should be afforded some sort of advantage. Universal novelty is generally a requirement for obtaining a patent for an invention; absolute originality is indispensable for a copyright. Borrowing will usually mean disqualification from obtaining these rights; they are not essentially bound to a specific territory, although in fact their existence is, of course, governed by laws which apply only within a certain territory. No matter where the invention is made or the work of art is created, there is, in principle, a reason everywhere for protecting it if the owner of the right makes it available to the community. The restrictions of a territorial nature embodied in the relevant national laws, such as the requirement of publication in the country itself, do not arise out of the essence of the exclusive right and could therefore largely be removed by means of international treaties without any harm being done. This has in fact been done in the case of copyrights, so that publication in one country also counts as constitutive action for the right in other countries. The fact that as yet no corresponding patent conventions have been concluded is due solely to practical considerations directed especially at furthering individual national economies. Accordingly, in the various countries the exclusive right both as regards a particular work of art and as regards a particular invention is generally in the hands of one and the same person or his representative.

Another feature of inventions and works of art is that even without the existence of an exclusive right they are meaningful and of intrinsic value; indeed, the public interest will, in principle, be served by the application of an invention or the reproduction or publication of a work of art by as many enterprises as possible. The existence of an exclusive right forms an exception and lasts for only a limited number of years.

The Right to a Trademark and to a Trade Name

The basis of the trademark right, on the other hand, is not so much the special desire to protect an achievement of the mind consisting in the creation of a new mark (by affording a lead in exploiting the mark) as the desire to safeguard the distinctive function of a particular mark for a particular

product, in the interests both of the enterprise and of the public. Indeed, the creative achievement will usually be too insignificant to merit protection, but the need for an exclusive right will nevertheless exist, since the nature of the distinguishing sign in fact implies that, in principle, only one enterprise will be able to use it. The person having the best claim to this privileged position is the one who first used this mark or registered it.

This background contains no universal element. The question who is to acquire the right is less important than the fact that, in a given place, there should be someone who is entitled to an exclusive right. The moral claims of the holder are weak, and there seems to be little point in recognizing the right outside a limited territory. Nor does the public interest in any way require universal protection. The only practical way of defining such a territory is to adopt political standards. Theoretically, it would of course be best to apply standards based on the market, as is suggested by Dr. Hermann Schumacher (*GRUR*, June 1966, pp. 305 *et seq.*), but the term "market" is much too vague and variable to be of any practical use in this respect. The lowest political unit for separate trademark rights could be the municipality. In practice, however, the lowest political unit in which there is an independent need for goods to be effectively distinguished is the federal state (such as Texas, for instance).

If someone else has used the same mark first in another such territorial unit, then this is a stronger reason for obtaining the exclusive right in that place than the earlier use elsewhere. Therefore, it is absolutely normal and very frequently occurs that the right to a particular mark, or marks extremely like it, is in completely different hands from country to country. As a rule, it is then totally irrelevant whether the holder in one country has borrowed the mark from a prior holder in another country. There is also little reason for drawing up international conventions whereby an action establishing a right in one country acquires the force of establishing a trademark right in another country. Conventions of this sort are therefore very few and far between. (The Madrid Agreement includes only a simplified procedure for the registration of trademarks in contracting countries and has no direct bearing on the granting of trademark rights. Also, according to Article 4 of the Paris Convention, a short priority term is granted, when a trademark is filed in one country, for the filing of that mark in other countries and, in Article 6^{bis} of the Paris Convention, dealing with the case where a foreign mark has become well known in a country before it has actually been used there, protection against borrowing is, by way of exception, granted in that country.)

If a mark is not exclusive, it has, in principle, little point and little value, because, generally speaking, it cannot then perform its function as a distinguishing sign. Therefore, the existence of exclusiveness is not an exception but is usual, with the result that the trademark right is basically of a permanent nature. Moreover, not only a trademark but also the right to a trademark is in itself of limited value, even if the mark is suitable for use as a distinguishing sign. In actual fact, the value of the mark depends upon the goodwill of the product it covers, and in most cases this will only be present in a limited area and is acquired through a particular, compara-

* The literature on this subject is extensive and varied. No attempt has been made to make complete reference to it; instead, a limited selection has been made from what is relevant to the major principles at issue.

tively good quality of the product and through the method of selling, advertising, etc. The intrinsic value of a mark rests solely in its suitability to serve as a symbol of that goodwill. Experience has shown that this suitability makes only small demands on the trademark.

The right to a trade name is similar in many ways to the trademark right. Here, too, there is no creativeness but a question of distinction and, therefore, it must be decided for each territory separately who used the name first. One difference is that there is indeed a convention which lends a universal aspect to the right to a trade name. Article 8 of the Paris Convention states: "A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark." In practice, however, this makes very little difference to the territorial aspect of the right to a trade name. At most, the co-existence is accepted of two identical or very similar trade names, one of which was used first abroad and the other first at home, provided additional indications are used so as to avoid confusion to the greatest possible extent.

The Right to Designs

As regards the characteristics mentioned here, the right to a design is a half-way house. Probably it comes closer to the patent and copyright. The right is a reward for creative work; it accrues only to the creator, and the creation must be novel and must also show a certain originality. Universal novelty is, however, only required in some countries, and an equally large number of countries are satisfied with novelty in the country concerned. Other examples of characteristics which the right has in common with the patent and copyright are the presence of an intrinsic value in the creation (therefore, even without an exclusive right), the limited duration of the protection and the possibility of compulsory licenses in many countries.

The similarity between the right to designs and the right to a mark lies in the fact that they both relate to an outward element by means of which the protected products can be distinguished. On the other hand, the primary objective of designs is to impart a certain aesthetic value to the appearance of the product. Any distinguishing capacity which this particular appearance may have is of secondary importance. That is why the right to a design accrues to the designer, whereas the holder of the right to a trademark can only be the firm whose goods it distinguishes. It is true that often the firm whose goods the design characterizes is, in fact, also considered to be the designer of a design, but then this is dependent upon an agreement between the firm and the actual designer.

Importation of a Concern's Own Products

The conclusion can be drawn that rights to a mark and to a trade name are of a much more territorial nature than rights to a patent or copyright are. The remarkable thing is, however, that there is nevertheless a certain tendency in a specific sort of case to deny the trademark right any form of territorial effect, whereas this tendency does not exist in the case of patents.

This is the case of the business proprietor who, on the grounds of his right to a mark in a particular country, wishes

to prevent the importation by third parties of articles marketed by himself abroad under that mark. To many, this import ban seems unacceptable, whereas a ban on the importation of patented articles originating from the patentee himself is generally recognized (with the exception of Koch and Froschmaier in *GRUR*, No. 3, March 1965). How can this be explained and which view is preferable? The problem surrounding the territorial effect of industrial property is indeed not new, but certain facets of it have lately been receiving a great deal of attention again and it is gradually becoming necessary to consider more closely the effect of the radical changes in economic relationship which have taken place in the last few decades.

Topicality

Up to now, import duties and above all regulations, which differ from country to country as regards the composition, packaging and marking of all kinds of products, have prevented these products from being traded between countries, but a great deal of work is going on at present on the reduction of import duties and harmonization of the provisions of the various food and drug laws. Also, there is evidence that matters of trade policy have begun to play a much more important role. In this wider context, trademark interests require a careful solution and one adapted to present-day economic relationships. Whether changes in the law are necessary or whether a satisfactory solution can be found in interpreting the existing laws, a great deal of attention will have to be given to the legal basis of the solution. Too often in this respect, the legal construction is neglected or distorted for the sake of what is considered to be a desirable solution.

For practical reasons, this investigation will be restricted to the scope of the patent and trademark rights, in so far as these are of importance to international trade and particularly to imports, as mentioned above. These rights are of greatest significance to industry and commerce, and theirs is the most pressing case in terms of time. Only as regards patent and trademark rights has any advanced stage been reached in the preparations for the introduction of European legislation. This will probably include provisions relating to the above-mentioned imports. The importance of these regulations will probably extend even beyond the sphere of their immediate application, since they can have a great effect on the general development in this respect. In other words, this is an urgent matter.

Emphasis on Trademark Law

Much more attention will be paid in what follows to the trademark right than to the patent right, since it follows from the very nature of these rights that changes in economic relationships are more significant as regards the scope of trademark rights than as regards that of the patent. Moreover, the problem connected with patented products is simpler. This will be explained below. First of all, the object of these rights will be examined, followed by certain basic principles of existing law, then economic requirements, and finally the manner in which these requirements can be achieved, special attention being given to certain particular aspects such as the principles of free competition.

II. A. The Purpose of the Trademark Right

Protection Not Limited to Use for a Specific Purpose

The trademark right is one of those rights concerning which the legislator, in granting it, had a particular purpose in mind but did not actually grant the right for that purpose alone. This applies to all national trademark laws. The only mention of a purpose in the law, in the Dutch Law in any case, relates to the purpose of the mark itself, namely to distinguish one's own products from those of another. This only means that the trademark must have the quality of distinction; hence, a purely descriptive indication cannot be protected as a trademark. The question of the object by means of which one's "own" goods are so distinguished is irrelevant to the matter of protection. Nor is there any description given of the purpose of the trademark right, that is, of the statutory prohibition, implying that no one other than the person entitled to the mark may use it to distinguish the products of which he is the originator. In other words, the Law does not contain any limitation on this prohibition (for example, "in so far as is necessary in order not to obstruct the distinction of the goods of the trademark owner"). And so the finding of the Netherlands Supreme Court on several occasions has rightly been that the prohibition is normally in force, even though it may not be serving the interest intended by the legislator but an interest which, in itself, is nevertheless proper as was the case formerly with regard to the maintenance of certain consumer prices (Supreme Court, January 12, 1939, *Nederlandse Jurisprudentie (NJ)*, 1939, No. 535, concerning the importation of Bayer products, with a note by Professor E. M. Meyers, and Supreme Court, June 14, 1940, *NJ*, 1941, No. 109, concerning the importation of Pope PBL lamps, with a note by Professor P. S. Scholten).

Meanwhile, it may be useful to ascertain what special purpose the legislator had in mind. This is especially true in connection with cases of abuse of the trademark right, for even a right that has not been granted for a specific purpose only can be abused, and the question whether it has been abused depends in part on the question whether it has been used in accordance with the special purpose the legislator had in mind (see the following chapter under "Abuse of a Trademark Right").

The legislator's special purpose was to protect the most obvious trademark interests. However, he evidently considered that the objections to (complications in) limiting such protection to those interests weighed more heavily than the objections to extending such protection to other interests (not essentially connected with trademarks but perfectly legitimate). The essential trademark interests lie in the indication that the products emanate from one particular source and will therefore generally be identical with one another in all details such as quality, modernity, distinction, and so forth. The trademark thus functions as a symbol of the source of the products and of their exceptional properties. These functions of the trademark are equally obvious, and one must assume that both functions have been reasons for protecting the use of trademarks. An example of other, non-essential, trademark interests, which are protected merely "*pour les besoins de la cause*," is the interest in maintaining the price

of certain products, for it is possible to prescribe a price for certain branded products and then to prohibit imports of articles carrying that trademark only if they are priced differently.

In court rulings and literature, the essential functions of the trademark are usually mentioned without their limited importance being indicated and without proper emphasis on what might be termed their guarantee function. For the sake of completeness, these functions are reviewed here.

Confusion Concerning Origin

Formerly, the opinion was held that the purpose of distinguishing goods by means of a trademark was solely to avoid confusion concerning the true origin of the goods. This has never been an acceptable view and, as long ago as 1957, it was qualified by Professor G. H. C. Bodenhausen as antiquated (Appendix to *Industriële Eigendom*, No. 4, April 15, 1957, p. 44). Bodenhausen gave this qualification in connection with the decision of the Supreme Court of December 14, 1956, *NJ*, 1962, No. 242, which held this antiquated view. Article 10 of the Dutch Trademark Law was amended only six months later, on May 8, 1957, so as to contradict this view explicitly. The Article provides especially for protection even in cases where there is no question of confusion about the origin of the goods. See also the ruling of the *Landgericht* of Hamburg, of August 9, 1967, *GRUR*, 1968, April, p. 138. Accordingly, in a new law such as the Benelux Trademark Law, which has not yet come into force, confusion about the origin is no longer the decisive criterion (see Article 14). The Model Law for Developing Countries on Marks, Trade Names, and Acts of Unfair Competition takes the broader criterion of confusion among the general public. Avoidance of confusion about the origin is incontestably a very important aspect of trademark protection. In practice, it is the decisive factor governing the question whether two conflicting trademarks bear too much similarity to one another, taking into consideration the measure of similarity of the products. If there is no risk of confusion, because the similarity is slight, then there is no infringement. If there is risk of confusion because the similarity is too great, then there is infringement. However, if, in spite of too much similarity, there is no risk of confusion because of special circumstances, then there will still be infringement. The risk of confusion is an aid for measuring similarity, not a *sine qua non* for infringement. When, for instance, the business proprietors have taken sufficient measures as regards two different marks to avoid confusion about the origin, the similarity of these marks or certain components of these marks can nevertheless result in undesirable associations. In the well-known case of the mark *Philips-Biarlita* and *Osram-Biarlita* for lightbulbs (Breda Court, March 3, 1936, *Bijblad Industriële Eigendom (BIE)*, 1937, p. 67), the difference in origin was patently clear owing to the designation of the well-known names of the firms Philips and Osram, so that there could be no question of confusion about this; but nevertheless the favorable impression created by one of these would undoubtedly have had a good effect on the disposition towards the other's product owing to the similar component *Biarlita*. Consequently, there was indeed a certain degree of confusion. It is generally accepted that

this was sufficient to constitute infringement. The same is true of cases where third parties undertake some sort of irregular action concerning the product originating from the owner of the right. For example, the branded product is stolen from the factory of the trademark owner and put on the market, or old original products are cleaned up and the mark is put on them again. In these cases, too, there is no confusion about the true origin of the products, but there is indeed trademark infringement. It follows that protection is not aimed exclusively at commodities originating from someone other than the trademark owner himself, as is sometimes alleged. In the case of the imports mentioned earlier, the product is put on the market in the country of importation against the wishes of the trademark owner, without any confusion about its true origin being possible. There can, on the other hand, be a different sort of confusion, for example, between the domestic and the foreign products of the owner of the mark. The question is then whether this constitutes trademark infringement.

The Guarantee Function

The broader trademark protection mentioned above is entirely compatible with the idea that a trademark has a further function (or that the same function has another aspect), namely to guarantee a particular quality. This guarantee means that the public can be certain that all products of the same sort on the market at a given time under a particular trademark are of the same quality. It has been found that this guarantee function gives rise to difficulties of a systematic nature. The question is raised whether the guarantee function has any significance independently of the function regarding the origin. There would seem here to be considerable danger of *misunderstanding* and pointless argument. In the first place, it is sometimes forgotten that the statutory prohibition against using a trademark belonging to someone else is not restricted to certain categories of cases in which the prohibition serves a particular purpose. It should also be remembered that the trademark offers its owner protection which is laid down in the Law itself and that it is not so that on the one hand he is granted rights and on the other hand he has to fulfill obligations, with the result that the right to use a mark as a guarantee is offset by some sort of obligation to give a guarantee. The use of conflicting marks by third parties is forbidden by law. The owner of the mark merely has to enforce this prohibition if, and to the extent that, he thinks fit. He is obliged neither to maintain a constant quality nor to institute proceedings against infringers. In every country, the statutory prohibition makes it *possible*, not compulsory, for him to ensure that goods bearing the trademark which are on the market in that country originate exclusively from him (as distinct from licensees and infringers who have not been restrained), at the same time making it *possible*, not compulsory, to ensure that such goods are available exclusively in a quality which satisfies certain constant standards. Nor does the prohibition apply only if the trademark owner really suffers a loss. It is quite possible that the conflicting product will not directly affect the trademark owner's turnover because it does not compete with it (a hammer and a chisel are articles of a similar kind, but sales of chisels are

not detrimental to sales of hammers), or affect the goodwill if the quality of the conflicting product is the same. The prohibition is of a general nature in order to ensure that the owner of the trademark will have full control over its use for goods of a specific kind. In Belgium he can, it is true, forfeit his right by failing to maintain exclusiveness, but the Belgian Law is shortly to be replaced by the Benelux Trademark Law, which does not provide for a loss of rights in this way. Elsewhere, too, one's trademark right is not forfeited if infringers are left unchallenged, unless this amounts to relinquishment of the right (which is not usually very readily assumed) or causes the mark to become a name describing a particular class of product. In some other countries, there is also the obligation to stipulate certain safeguards in the event of the transfer of a mark and the issuing of licenses. However, this does not mean that in those countries there is any obligation to maintain the quality in cases other than transfer or licensing. The trademark owner can both change the quality of a single branded article at will and — theoretically — market various qualities simultaneously under the same trademark.

The absence of an obligation to maintain the quality cannot, therefore, be a reason for disregarding the guarantee function, as is suggested, for instance, by Vanzetti (*GRUR Int.*, 1965) and Wertheimer (*The International and Comparative Law Quarterly* of July 1967). It is a fact that most marks are used as a guarantee of quality, regardless of whether or not this function is emphasized to the public. The only question remaining is whether such a use is an abnormal one and protection of the mark, if and to the extent that it is used in this way, is consequently incompatible with the nature of the trademark right, or, conversely, whether the legislator actually did intend to make it possible for the trademark owner to use his mark as a strictly personal indication of quality to the public. It appears hardly contestable that such a use is a perfectly normal one which by no means falls outside the protection granted. This means that use for this purpose is protected by the trademark right, even when objections would otherwise be attached to such a use so as to make the act unacceptable from a point of view independent of trademark law. An example is the shutting off of a national market. Only if such objections exist without the trademark right's being used in accordance with its proper purpose can there be any question of abuse. This is worked out in the next chapter.

Individualization

It could even be said that, in general, the public is not interested in the origin of the product but only in recognizing a particular product as such, with all its peculiarities. This is why, at present, the function of the trademark is often described as individualizing the product, this concept including origin, quality and any other particularities regarding the product. This again is the reason why a mark can also be used to distinguish a particular product from another sort or quality of product originating from the same firm. The public may then well believe that these products have a different origin, but that is irrelevant. The point in question is to distinguish between the products. (In this case, the trademark owner obviously needs protection only in so far as the trade-

mark distinguishes his products from those of others.) At any rate, the real function of the trademark is of a complex nature and cannot be accurately described simply by one or more concise indications such as those discussed here. There is no point in defining this function in a limited or stringent manner. Indeed, a broad, flexible description is obviously called for now that the legislators have described this function merely as serving "to distinguish his goods," and have not actually limited the protection of trademarks.

The inadequacy of the qualification "indication of origin" and the preference merited by the qualification "individualization" are also evident in the aforementioned case where, in addition to the brand, two rival firms include in the packaging of their product a very distinct direct mention of origin. Mention of the origin is as ineffective as using a widely different wrapper to avoid infringing someone else's trademark right if one uses a corresponding trademark. The trademark then obviously does not perform the function of indicating origin, but that of symbolizing particular properties of the products. This is why, despite the fact that the different origin is known, the correspondence between the trademarks continues to give rise to the assumption that there is probably also correspondence between the essential properties. As a result, the imitator would still unjustly benefit from someone else's reputation. This confusion is made even worse by the fact that nowadays, if products originate from two different companies, this does not necessarily imply that they originate from two independent sources. There are numerous instances of different companies belonging to one and the same concern; besides, the institution of trademark licenses has become more developed. The public ought not to have to judge whether or not such relations exist any more than they have to go into other facts not connected with the trademark. *Vis-à-vis* the public, the trademark performs the function of providing the only complete means of identification.

Definition of Purpose

In general, it could therefore be said that the real purpose of trademark protection is to provide the owner of the mark — as well as any holders of licenses — with the possibility of individualizing his products by affixing a mark to them; in other words, he can thus indicate their common origin or their origin from related sources and hence their equality in relation to one another, and the public then is offered the possibility of recognizing this common origin and equality of the products.

The Enterprise Whose Products Are Concerned

A difference of opinion can arise as to who uses the trademark to distinguish "his" products. The mark can be used to distinguish not only the products of the user himself but also someone else's products, and it is not always immediately clear which of these uses we are dealing with at a given moment. This is important in countries where the first use of a trademark is constitutive of the exclusive right. In regard to infringing use, the position is different: infringement occurs not only when a firm not entitled to use a trademark does so in order to distinguish "its" goods, but also if it does so to distinguish the goods of a third party who is not the

owner of the trademark. The question then is merely whether the trademark is used to distinguish the goods of any third party or the goods of the trademark owner. In all cases where a trademark is used, it is necessary, in assessing the legal consequences, to ascertain which of the modes of use indicated has occurred.

During the journey which the product makes from the manufacturer to the consumer, it can belong to a succession of different people. As to the question which of them uses the mark to distinguish "his" products, ownership is not the deciding factor. A wholesaler is indeed the owner of the products; however, he does not use the mark by virtue of a right accruing to himself but only as a means of distinguishing the products of a particular supplier from other products. This particular supplier is the same for all wholesalers but need not necessarily be the manufacturer. Apart from the manufacturer, this supplier can also be a person who has his products made by someone else or the importer who by virtue of a right accruing to himself uses the mark in the country of importation in order to distinguish the imported products. Therefore, the question whose goods are in fact distinguished by the trademark may refer to more than one firm. Both in court decisions and in literature, this obscure question — when it relates to imports — is quite often answered irrespective of the use, with the conclusion that there may or may not be confusion as to origin and that, therefore, there may or may not be infringement. This is quite wrong. In reality, the trademark can serve in any country and upon any sale of a product only to distinguish the product of one of the firms which sells the product or causes it to be sold in that country. Sale by a firm exclusively in a foreign country and for a foreign country is, in principle, irrelevant to the question who uses the trademark in the home country to distinguish whose goods.

The decision as to which of the eligible enterprises uses the mark as its own distinguishing sign in a particular trademark territory is dependent solely upon the mutual relationship between them. If they have the common objective of using the mark to distinguish the products of one of them, then this is the deciding factor. In the event of a difference of opinion concerning the common objective, this will have to be determined by means of interpretation. If there is no question of an agreement determining the nature of everyone's use, the nature is simply determined by the sequence of the sales. Any trademark affixed to a product inevitably serves to distinguish it and functions as the seller's distinguishing mark, unless there is evidence to the contrary. In regard to subsequent sellers, such evidence may derive from the fact that a previous seller has already used the trademark as his distinguishing mark in the same country. In regard to the first seller, it can be drawn only from an agreement between him and his supplier or customer. Therefore, in the absence of such agreement, the trademark will function as the distinguishing mark of the first seller — the one who has marketed the products in the country in question. This seller satisfies all the requirements concerning the use of the trademark to distinguish "his" product, and consequently acquires the legal rights attaching to it. It is, of course, entirely up to him to decide to what extent he wishes to use those rights.

In the case of national manufacture and sales, the manufacturer is the first seller; in the case of importation, the importer is the first seller. This seems self-evident. Nevertheless, the Netherlands Supreme Court recently gave a ruling (*Hoge Raad (HR)*, December 22, 1966, "*Rechtspraak van de Week*," January 14, 1967, No. 2) which in regard to imports may suggest a different view. In particular, without any relevant agreement or any contact between importer and foreign manufacturer, the trademark would serve in the country of importation not only as the manufacturer's distinguishing mark, but resellers in the country of importation would use it on behalf of that manufacturer even though this was never the manufacturer's intention or the importer's. It seems rather strange that the foreign manufacturer should thus be deemed to have used the trademark in the country of importation in the manner prescribed by law for acquiring the trademark right. Such a *tour de force* goes a bit too far. At the end of chapter VI, the writer reverts to the background of this ruling. Actually, this view is not only at variance with the facts, it also violates the territorial system of the national trademark laws. The foreign manufacturer has concluded transactions exclusively abroad and has not caused any transaction to be concluded in the country of importation, nor has he made any arrangement implying that any transaction concluded by someone else in the country of importation would be on his behalf. The system of the present trademark laws implies that every law attaches legal consequences only to actions of use, both constitutive and infringing, performed in the national territory (apart from registrations and subject to the provisions of Article 6^{bis} of the Paris Convention on "*marques notoirement connues*"). The aforementioned view of the Supreme Court is difficult to reconcile with this system without amendment of the law. The territorial system is discussed in detail in the following chapter.

In this connection, another misunderstanding occasionally arises in practice. It is sometimes thought that the impression, if any, made upon the public can have a bearing on the question whether or not a particular use establishes a right (that is, the question whether a particular firm uses a trademark as its own distinguishing mark). This is definitely not so. The public is interested in knowing from whom the product originates, namely, who accepts responsibility for the product by putting his name on it, but not in the legal question who has the right to the trademark. The answer to these two questions can very well be different, for instance if a store has certain goods manufactured under its trademark by a well-known manufacturer whose name is also mentioned on the wrapper. Nor is there any need for it to be apparent to the public which firm's goods are being distinguished by the mark. Thus, there need be no difference at all in the presentation to the public whether an importer uses a mark on behalf of a foreign manufacturer or whether he imports a foreign product with the intention of using the mark it bears as his own distinguishing sign in the country of importation. An example of this sort of use by the importer on his own behalf is where a foreign manufacturer affixes the mark to the product at the request of the importer or, in the case of direct delivery to the importer, agrees to the latter's being granted the trademark right in the country of importation. Another example

of this is where there is no direct contact at all between the manufacturer and the importer, and the latter — as the first user of the mark in the country of importation — has it distinguish the products of his enterprise. Here, too, there is no need whatsoever to indicate to the public which of these situations presents itself and, in reality, the public often does not know.

In practice, the name of a firm is often mentioned on the product. Generally speaking, this is not obligatory in Holland but certain products do have to bear the manufacturer's name. Sometimes it is stated that the product has been manufactured by one firm for another. All this is totally independent of trademark rights. The trademark only indicates that the goods bearing it have a common source; it does not indicate which of the actual common sources is the relevant one under trademark law. The mention of the name is not aimed at giving any indication concerning the trademark right or any intention pertaining to that right and, in fact, is of no significance at all regarding the question to whom the trademark right accrues. It is in no way against the public interest that the name of the manufacturer should be given on the product while the mark belongs to a trader. (The Netherlands Supreme Court has incorrectly found that the name mentioned on the packaging is significant as regards the question to whom the trademark rights accrues. This finding of December 1953 — *NJ*, 1954, No. 94, concerning Aspirin (*Nedigepha*), with a note by Professor Ph. A. N. Houwin — is contrary to the conclusion of the Solicitor-General, Mr. Langemeyer.)

With reference to the subject considered here, the above analyses are particularly relevant in order to determine the notions "use of a trademark" and "confusion about origin."

B. The Purpose of the Patent

Here, too, there have been all manner of developments. The view is still often adopted that the exclusive right relating to an invention is granted in return for the inventor's making his invention public and thus inspiring others to further research. This "reward" is then intended to give the inventor a lead over his competitors, since they may only apply his invention in practice after a certain period of time. Meanwhile, stress is increasingly laid on the purpose of protecting the capital investments needed for research, the further development of the invention, its industrial application, and the sale of the product. There are, however, various answers to the question precisely how great this lead or protection ought to be.

In the first place, it should be remembered that, here again, the national patent laws do not give a specific purpose for which the exclusive right to exploit an invention is granted by law. This means that the statutory prohibition on exploiting a patented invention, in the same way as that relating to trademarks, applies to third parties irrespective of the purpose served by it in each particular case, except when the prohibition is abused. In the latter case, it is important once more to examine the purpose the legislator especially had in mind when recognizing the exclusive right.

More important than the event of abuse are, in practice, problems and questions arising if the patent holder grants a license to a third party. There has lately been a rapid increase

in the need for license contracts. Most national patents laws contain little or no provision concerning the nature and scope of the conditions which these contracts may contain and yet these very conditions can greatly affect the patent position of the inventor, on the one hand, and the desired freedom of trade, on the other. An important factor in assessing whether or not particular conditions are acceptable can, here too, be the real purpose for which the exclusive right was granted.

This purpose, however, can be less specifically defined than the purpose of trademark protection, mostly owing to the fact that the purpose of a mark is much more confined. An invention is a more complex notion than a mark, and the protection is much broader since it relates to the products themselves (to a more limited extent as regards patents on processes). In general, these must not be manufactured, marketed, stored, etc., by anyone other than the patentee. Obviously, the effect of this protection is to grant a monopoly for certain articles which, in principle, is limited in time only. The object of the protection must be to place the inventor, as far as the exploitation of his invention is concerned, in the position he would be in if the invention were still known only to him. Consequently, there is scarcely any question of a broader legal definition than that corresponding to the purpose of the protection.

III. Some Relevant Principles in Various Countries

A. Trademark Law

Principle of Exhaustion

One of the principles to which importance is attached in some countries as regards protection against imports of a trademark owner's own products concerns the exhaustion of the trademark right by the owner's marketing his products that are protected by the exclusive right. Since importing is an international affair, however, the principle of exhaustion is not actually decisive. Even if one accepts the principle country by country, this gives no indication of its possible importance in the case of imported goods marketed abroad by the owner of the trademark in the importing country. The importance of that principle then depends on the prevailing opinion concerning the principle of territoriality, which will be dealt with separately below.

In regard to the national application of the principle of exhaustion, it may be said that in some countries it is accepted as such and in others it is not. Not that this makes much difference in practice. It is more a question of a theoretical construction. Generally, it is recognized on the one hand that the trademark owner should not normally be able to prohibit traders from reselling, under the same trademark, the goods originating from him. On the other hand, it is clear that exhaustion cannot result from the single fact that the goods marketed originate from the trademark owner. After all, if his goods have been marketed by a third party without his permission or cooperation, or if a reseller has, in some way or other, tampered with the trademark, the packaging or the goods themselves, he may take action not only against the guilty party but also, by virtue of his trademark right, against any person in possession of the goods, although they originate from him. In such cases, he cannot be held responsible.

The question whether we can speak of exhaustion of the trademark right or whether some other theoretical principle should be accepted is not expressly answered in any of the national trademark laws. (On the other hand, the principle of exhaustion is expressly laid down in Article 13 of the Benelux Trademark Law, not yet in force, and in Section 20 of the Model Law for Developing Countries on Marks, Trade Names, and Acts of Unfair Competition.) In some countries, such as Belgium and France, the principle of exhaustion is not recognized as such in court rulings either. The same applies to Italy, and in the United Kingdom, too, the principle is not expressly mentioned. In the United States, a Bill was introduced a few years ago (the Quality Stabilization Act) which clearly implied that the trademark right did not become exhausted by the lawful marketing of the goods and, in particular, could be invoked *vis-à-vis* resellers in a number of specified cases. This Bill received considerable support in the House of Representatives but has meanwhile been dropped. In Germany, an interesting legal tussle took place when the Düsseldorf County Court, in a ruling of July 16, 1963 (*Revlon III*, *GRUR*, March 1964), rejected the theory of exhaustion giving the reasons in detail while the Federal Court in a ruling of January 22, 1964 (*Maja*, *GRUR*, April 1964), did accept this principle. In the Netherlands, the principle has frequently been accepted in the literature, but there have been important exceptions, for instance Langemeyer (see the conclusion of the Solicitor-General in the Supreme Court's decision of December 14, 1956; *NJ*, 1962, No. 242).

For the purpose of the subject under discussion, there is little need for a detailed opinion on the correctness or desirability of the principle of exhaustion in national relations. Such relevance was, in a sense, recognized by the German Federal Court in the aforementioned ruling on *Maja*. It is true that the Court invoked the circumstance that neither the origin function nor the guarantee function provided grounds for accepting trademark protection against the importation of *Maja* products, but that in itself would not have been enough for refusal of trademark protection. In addition to this, the ruling was decidedly based in part on the consideration that the trademark right had become exhausted owing to the fact that the products had been marketed abroad. On the other hand, the Federal Court expressly recognizes the territorial nature of the trademark right. It follows that the territorial nature is partly accepted and partly rejected. This prompts closer investigation.

Principle of Territoriality

In keeping with the local nature of trademark rights, practically all national trademark laws attach *fundamental* (that is, generally valid) legal consequences only to actions performed in the national territory of the trademark owner (or to the omission thereof). Indeed, importance is attached to the use of a trademark, either as a constitutive or as an infringing action, only if it takes place in the national territory. This is obviously the system of the national trademark laws. That is why, for example, Article 6^{quater} of the Paris Convention expressly excludes the possibility of the member countries' stipulating — contrary to this system — that with

the transfer of a trademark not only the national business but also any part of it located abroad shall be transferred.

A number of exceptions to this system exist, but only one of these can be regarded as essentially conflicting. According to Article 13 of the Benelux Trademark Law (not yet in force), the trademark owner cannot prevent the resale of a branded article if he himself marketed the article, even though he did this abroad. For the present a unique provision. That it does not merit adoption in other legislation will be explained in detail below. The other deviations from the territorial system are not of a fundamental nature and are certainly compatible. A few neighboring countries (Germany and Switzerland) and a few closely associated countries (the Netherlands and Surinam, Curaçao and the Netherlands Antilles) have agreed that, on certain conditions, the use of a trademark in one of these countries will be regarded as a use in the other. As stated in the introduction, Article 4 of the Paris Convention prescribes a short period of priority for registering a mark in other countries and, under Article 6^{bis} of this Convention, a certain consequence is attached to the use of a trademark abroad if the fame of the trademark had already penetrated from abroad to another country before the foreign owner acquired the right to that mark in such other country. Besides, in Article 6 of the Madrid Agreement, protection in the other countries is made contingent upon protection in the country of origin and, according to many national laws, this contingency also holds with regard to registration by a foreigner.

A consequence of this system is that the validity and scope of the different national trademark rights are, in principle, independent of one other. Thus, the acquisition or loss of a trademark right in one of the countries is totally irrelevant to the right to that trademark in another. The same applies to the transfer of the right and the granting of a license. In view of the basis of the local nature of trademark rights, outlined in the introduction, this purely territorial system is likely to be maintained on the whole. (This is not affected by the tendency to create, side by side with the existing territories, larger territories to which one trademark law applies, by reason of economic integration within these larger territories. In the United States, for example, there are separate trademark laws in the different states, and alongside these there is a federal trademark law for the entire country. Similar plans are in existence for Western Europe.) Of course, it is always possible that extra-territorial circumstances may incidentally affect the validity or scope of a particular trademark right, but this is dealt with further on in this chapter. It is necessary to draw a distinction between such incidental influence and the fundamental influence on the scope of trademark rights which we are concerned with in applying the principle of exhaustion.

In the aforementioned *Maja* ruling, the Federal Court contended that the territoriality principle could not result in leaving out of consideration everything that happened to the goods before their importation. In so far as the Federal Court may have considered any incidental influence of extra-territorial circumstances, this proposition can be accepted. The circumstance mentioned by the Federal Court that neither the origin function nor the guarantee function of the mark

was at issue may indeed have a bearing on the point whether there might be a question of abuse (improper use) of the trademark right. Another such circumstance is a possible treaty promoting free trade between the exporting and the importing country. However, now that the Federal Court has made protection in Germany contingent, in principle, upon the circumstance of the goods' having been marketed abroad, as a result of which the trademark right became exhausted, this is in flat contradiction with the system of national trademark laws outlined above. Since the goods were marketed abroad, this can at most have resulted in exhaustion of the trademark right in force in the foreign country concerned. It is surprising that such a circumstance should be deemed to have any fundamental influence on the extent of the entirely independent and substantive trademark right in Germany which is exclusively attuned to the German territory. The sales abroad in no way had any reference to the German trademark right but took place exclusively on the basis of the foreign trademark right. If the goods had been marketed abroad by an independent third party, everyone would have accepted the principle that the trademark owner in Germany could prohibit importation of the branded articles. Now then, it does not accord with the existing system of the national trademark laws that protection in one country should, in principle, be dependent on the question who marketed the branded goods in another country. If the national trademark owner himself cannot even decide in principle — that is, irrespective of the special, incidental circumstances — whether or not a particular product is to be introduced onto the national market under his own trademark, this conflicts with the existing system of territoriality. The reasoning of the Federal Court is an instance of straining the purity of the legal construction for the sake of achieving a result which is not even generally accepted as a desirable one. Later on in this chapter, we shall demonstrate that, without violating the system of national trademark laws, notably by employing the concept of abuse of right, it is possible to achieve a result which — though equal in many cases — is more graded, so that, in other cases where market conditions by no means demand the same result, a different one is in fact obtained. The *Maja* case quoted here seems to be an instance of such another case, as will be explained.

The territorial system of national trademark laws outlined here is of importance not only as regards the application of the principle of exhaustion, but also as regards the interpretation of such terms as "origin," etc., in cases where a product is sold successively by different firms in different countries. This interpretation, besides being dealt with in the preceding chapter under A, last section, has been given special attention in chapter V under "Trademark Protection."

A Single Variety

There would appear to be reasons for distinguishing between, on the one hand, cases where the trademark owner sells his product in the different countries in one variety only and, on the other, cases where for each country or each group of countries he manufactures a special variety of his product. Let us first consider the category of the single variety. In such cases, neither the origin function nor the quality guaran-

tee will in fact be jeopardized in the event that a third party imports the product. Nevertheless, it follows from what has been said before that, in principle, having regard to the territorial system of the national trademark laws, such importation results in trademark infringement if the trademark right in the importing country is owned by the manufacturer.

Abuse of a Trademark Right

However, this line of argument concerns only the *fundamental* importance of extra-territorial circumstances. Now it should be investigated whether such circumstances can be of incidental importance to the question whether or not there is trademark protection. As stated at the beginning of chapter II, the owner of the trademark will be formally acting within the bounds of his authority if he exercises the trademark right without thereby serving any interest inherent in the trademark right (that is, for a purpose other than that for which it was granted), although that alone does not decide whether or not his action is legitimate. Moreover, if the purpose of this exercise of the trademark right is not improper in itself, independently of the purpose of the trademark law, there can be no question of unlawfulness (see the rulings referred to in regard to *Bayer* and *Pope*, which are not based on specifically Dutch legal provisions or views, so their significance need not be limited to the Netherlands). If, however, the exercise does at the same time serve an improper purpose, it will result in abuse of the trademark right. The mere fact that, in a concrete case, there is no confusion regarding origin (for example, because the origin of the conflicting products is clearly indicated), or regarding quality (for example, because it is equal), and that there is no question of loss (for example, because the goodwill connected with the trademark owner's name and trademark is less than that connected with the other firm's name) is definitely not sufficient indication that a prohibition does not serve a real interest of trademark law. It is possible, however, for a prohibition under the trademark law to serve only an interest that is obviously not connected with the essence of trademarks, e. g., price maintenance. In such an event, the question arises whether there is possibly an improper purpose. In this context, any purpose which conflicts with the principles of social propriety that spring from laws and covenants or are generally accepted is considered improper. For example, it is conceivable that the maintenance of a prohibition under trademark law to import one's "own" products might be aimed exclusively at the separation of two national markets in respect of identical products (without any interest inherent in the trademark right being served), and that the segregation of those markets would, in itself, have to be considered an improper purpose. This might be the case where there was a special relationship between the two countries which conflicted with this segregation, for instance if there was an agreement to promote the economic integration of those countries. (If such an agreement should contain an express and directly applicable prohibition on the use of trademark rights as referred to here, the principle of abuse obviously would not arise. However, such an express prohibition is not likely to be encountered very often.)

Meanwhile, it should not be assumed without very sound reasons that a standard of propriety is thus infringed. In regard to the EEC Treaty, the question what obligations of propriety it imposes upon a trademark owner has not yet been submitted to the European Court; the prohibition to employ the *Gint* brand was based on the nullity of the relevant agreement (for details of the *Grundig-Consten* case, see chapter VII). As far as the *Maja* case is concerned, there does not appear to be any reason why maintenance of the German national law should be improper now that there is no question of any special economic ties between Germany and Spain. Hence, it is debatable whether the ruling of the Federal Court can be qualified as desirable.

Incidentally, it is quite possible for the trademark owner to have a proper interest in a prohibition on the importation of products originating from him, for instance in the case of *Revlon*. The trademark owner in Germany, to whom the American manufacturer had granted the exclusive right to import into Germany, had carefully built up a marketing organization there, taking steps to prevent the sale of *Revlon* products which had been stored too long. As a result of importation by third parties and consequent sales outside his organization, he lost the necessary control with the danger that the goodwill of his trademark might be jeopardized. Once the trademark owner himself has marketed a product in a particular country, he has forfeited the chance of subsequently prohibiting the resale thereof in the same country, even if the product is not handled in accordance with agreements made (exhaustion of the right), but if it has been imported into that country against his will, his trademark right there will still be completely intact. An even more striking case is that in which the quality of the goods has already been seriously impaired abroad owing to special circumstances and the trademark owner is anxious to safeguard the goodwill in the country of importation by means of a prohibition on importation. The approach defended here does at least appear to be more discriminating than the Düsseldorf County Court's ruling of July 16, 1963, in the *Revlon III* case mentioned earlier in this chapter under "Principle of Exhaustion." There, too, the principle of territoriality is expressly accepted for the trademark right, but the County Court considers the prohibition on importation invalid because, in the event that the domestic and the foreign trademarks are identical, it would be impossible to ascertain which territorial trademark right was at issue in each individual case. Apparently the decision would have turned out differently if part of the *Revlon* products — which were identical — had been provided with the inscription: "*Zum Gebrauch in der Bundesrepublik*" (for use in West Germany) and the remainder "*for use in the USA*," which certainly narrows the basis of the decision.

Different Varieties

In any case, the situation changes completely if there are several varieties of a product: one suitable for one particular country, the other for some other country. In such a case, the personal interest of the trademark owner in preserving the good name of his trademark is not the only consideration, but also the public interest; for, in the event of the varieties' being confounded with one another, the guarantee function

of the trademark might be lost completely, so the interest served by a prohibition on importation would be strictly inherent in the trademark right. The problems arising in cases of this kind are elaborated in chapter IV below. In this chapter, which concerns some existing principles, the question arises whether, in the various countries concerned, such a graded ruling would be in danger of clashing with established case law, which is difficult to alter. In general, there does not appear to be any such established case law. The German court rulings relate to cases in which the foreign and the domestic products were identical. Moreover, they accept the principle of the territorial effect of trademark rights.

Flexible Interpretation

The above views concerning the principles of exhaustion and territoriality leave plenty of margin for adapting the incidental scope of the trademark right to the ever-changing economic conditions, in conformity with the margin left by the wording of the different national laws. This absence of precise regulations confers upon the courts the freedom to allow themselves to be guided to a reasonable extent by considerations of practicability, which is all the more fortunate considering that trademark law is pre-eminently linked to economic conditions. On the one hand, legal certainty requires that without amendment of the law there will be no tampering with the legal principles of trademark protection and especially with the principle that protection is not dependent on use of the trademark for specific purposes. On the other hand, the purpose and scope of the protection and also general standards of propriety can, via the institution of abuse, play a part from case to case. Since existing laws contain no precise indications about purpose and scope either, continual modification and adaptation are possible. The special need to define the purpose, in the interpretation of the trademark right, has been stressed repeatedly, for instance by Bodenhausen at the end of his article in *BIE*, 1957, No. 4, p. 46, and by the German Federal Court in the *Maja* ruling of January 22, 1964. This can lead to reasonable, appropriately differentiated solutions also in respect of the imports under discussion.

B. Patent Law

Principle of Exhaustion

As far as has been ascertained, the principle of exhaustion concerning patents is laid down only in Dutch law. (It is also incorporated in the draft European Patent Law (Article 20a) and in the Model Law for Developing Countries on Inventions, Section 23, para. 2.) It is certainly not recognized in the United Kingdom, or in France, Belgium or Italy. In Germany and in the United States, the principle is accepted in jurisprudence. In the Netherlands, it is laid down in Article 30 of the Patent Law. Reference is made to what has been stated under A about the principle of exhaustion in connection with trademark rights. In general, the same applies in connection with patents.

Territoriality

What has been said about trademarks also applies to patents as far as the territorial system of the national laws is concerned. In the case of patents, this system is evident from

the mutual independence of the national patents as regards both their validity and their scope; furthermore, there are other circumstances that strengthen their territorial effect.

As far as is known, there has never yet been a case where the exercise of the patent right has been refused in one country on the ground of exhaustion of the right in another. Only recently, the question has been raised in the Netherlands and in Germany whether such territorial assessment of national patent rights is really correct. There seems to be little reason at present to assume that a Dutch or a German court would deviate from the established views on this. After all, there is not much scope for this since patent rights — unlike trademark rights — are generally defined in the national laws as being an exclusive exploitation right, *viz.*, the exclusive right to manufacture and sell the patented product.

Any such right can apply only to the owner's national territory and directly excludes unauthorized sales by a third party, for instance an importer. Moreover, in each individual country, this right is granted to the owner in return for releasing his invention for publication by the national Patent Office and in order to provide a guarantee for the expenditure needed in that country for the exploitation of the invention. Hence, it is difficult to invoke in one country the possible circumstance that, in regard to a particular product, the owner has already benefited from his exclusive right in another country.

As stated in the introduction, there is a recent instance of a different view being published, namely, by Koch and Froschmaier in *GRUR*, No. 3, March 1965. The answer to this is: whatever the desirability of breaking through the territoriality principle in this respect, in view of the nature of national patents as described in the foregoing, it will not be possible to do so without a change in the national laws (see also Jean Monnet in *GRUR*, June 1965). It should also be mentioned here that the President of the Rotterdam Court, giving a ruling in summary proceedings on May 14, 1963, in the matter of *Constructa* (NJ, 1964-31, and *GRUR Int.*, 1964, 265), left open the possibility that the territorial effect of the exhaustion would no longer be accepted by the ordinary court, whereas the President of the Amsterdam Court, in his ruling in summary proceedings on May 5, 1964, in the matter of *Penicillin* (NJ, 1965-79, and *GRUR Int.*, 1965, 306), expressly rejected that possibility.

IV. Economic Needs

A. Trademark Law

Different Varieties

There can be all manner of valid reasons why an entrepreneur should market different varieties of one and the same product in different countries. These varieties may or may not have been manufactured in one and the same factory. The reasons may lie in the difference between the standards set up for the product by the public or in the circumstances in one country and in another, or in differences between the available raw materials, the skill of the workers, and so forth, from one country to the next. The standards required of the product may differ by reason of technical factors, such as

electricity, gas or water supplies (for example, voltage, cost, purity, hardness of the water, etc.) and as a result of the level of prosperity, national customs, labor conditions, climate, etc., and also on account of differences in taste. Chocolate and cosmetics are obvious examples of this.

In this way, there is a need for different varieties of all kinds of products in different territories, as the following examples illustrate. In some European countries, *Cassata* ice cream is not manufactured, mainly owing to lack of know-how and experience. The Italian manufacturer who plans to make a variety especially suitable for one of these European countries is anxious to ensure that this variety, which does not suit the Italian market, will not be imported there. If he cannot obtain this assurance, he will not undertake the risk of exporting the new variety. Conversely, it must be possible to prevent the export of the Italian variety to that other country. American washing machines are generally designed to take into account the American custom of heating the washing water to no more than about 60° C, whereas, in Europe, a temperature of 90 to 100° C is normal. Consequently, American washing machines exported to Europe outside the official channels may be unsuitable for use there, and these unsuitable machines will severely jeopardize the goodwill for the adapted American machines imported through the official channels under the same trademark.

Cosmetics are sometimes dependent on climatic circumstances. Thus, a particular hair dye may produce a different color effect in different territories, probably on account of climatological differences and varying conditions of pigmentation and skin. Obviously the product has to be aimed at the majority of the users in a particular area. Tastes in chocolate and tobacco differ markedly in the various European countries. In territories where the water is hard, special ingredients have to be added to washing products. In hot climates, products that melt easily have to be packed to take this into account. The special packaging would be a waste of money in temperate climates.

There is no economic justification for marketing these suitable and unsuitable varieties side by side. True, division of the markets in these exceptional cases does, strictly speaking, limit competition, but this only avoids confusing the public and these imports would not serve any rational interest. Generally, there is simply no demand for the unsuitable variety. If it is nevertheless imported, the effect is not only that the unsuitable variety is rejected by the public, but also that the national variety is identified with it. Should the manufacturer not be in a position to prohibit these imports, then he is obliged to look for other, less desirable solutions. This is considered more closely in the following chapter. Suffice it to conclude here that, in the exceptional cases referred to, division of certain national markets can only lead to each of them being better supplied.

So far, confusion has been avoided because the markets are often split anyway, owing to the differences in national statutory regulations concerning composition, packaging and description of the goods, backed by control and inspection requirements, etc. However, as mentioned in the introduction, many of these differences will be disappearing in the foreseeable future, so there will be more and more need for an

alternative way of effecting such a division in these exceptional cases.

B. Patents

In the prevailing circumstances, it follows from the nature of patent legislation that national manufacture, in so far as it falls under national patents, is protected by those patents against imports of corresponding products made abroad. The only effective way of changing this without impairing the patent system would be to introduce one patent law covering a large group of countries jointly. More about this follows in chapter V, under B.

However, the present situation does not present any particular economic difficulties. After all, there is not a single restriction relating to similar products which are not covered by patents. For a limited number of years, those that do come under patents simply stand apart from the range of products that can normally be manufactured and sold, that is, outside the products available to industry. They have, so to speak, been added to the existing possibilities by the inventor, on the understanding that such addition will become unconditional only after a few years, and that in the meantime a number of far-reaching restrictions will apply to those special products, in the interest of the inventor.

V. A. Solution for Trademarks

(no change in legislation required)

Additions to Trademarks

It is sometimes argued that the problem of the impairment of a good reputation by imports of an unsuitable variety can be solved by the addition of different sub-brands for each country or of special indications such as "variant X" or "style Y" (see Michel Waelbroeck in *The Trademark Reporter*, No. 5, May 1964, Volume 54, and Dr. A. Schumacher in *GRUR*, June 1966, p. 310). Such an addendum, however, has nothing to do with trademark law. At most, it is a practical solution that contributes nothing to the solution of the problem of trademark law. Besides, the suggestion has no practical value, either. If anything, it reflects a lack of practical knowledge. Practical experience provides unmistakable evidence that, notwithstanding such additions, the equality of the (main) brand leads to confusion between the varieties, especially in the case of display articles. In the circumstances, keen perception is required on the part of the consumer who, failing this, will be the loser. This would be wrong. For the very reason that such attentiveness cannot reasonably be expected, the mere fact of too much similarity between two trademarks is sufficient to cause trademark infringement, even if in other respects adequate measures have been taken to avoid confusion, for example, by a clear, direct statement of the origin. If, in respect of the said different varieties, very special attention is suddenly required, the result can only be that a section of the public will be let down and that the goodwill of the trademark will be undermined.

Trademark Protection

In this context, national trademark protection offers the entrepreneur sufficient support in the majority of cases. Admittedly, not all products are provided with a trademark, but

all quality products are. The general tendency in international sales is, wherever possible, to employ the same trademark in the different countries. This also applies where various varieties are each sold in a different area. In the cases described in the previous chapter, no economic objection can be leveled against trademark protection. Moreover, the use of only one internationally established trademark confers advantages not only upon the entrepreneur but also from a general point of view. Production and sales will be more efficient and less costly, thus resulting in lower prices, owing to the fact that the same packaging can sometimes be used for several countries and that the advertising campaigns for the different countries can be the same or along similar lines. A further advantage is that the public — not without justification — attaches importance to international reputations. Finally, inadequate protection might lead to the use of a *different trademark* for each country where a different variety is marketed, and that would hardly be a solution consistent with the striving for economic integration. The aforementioned advantages of uniformity of advertising and restriction of costs are more in keeping with these aims.

In the absence of protection, there are two possibilities — apart from the use of different national trademarks — both of which are detrimental to the consumer: either the manufacturer declines to take the risk, where, for instance, differences in taste are concerned, of manufacturing the varieties desired by the public and markets only one basic variety; or the public is exposed to the risk of confusing the various varieties. Now the typical purpose of trademark protection is to prevent the public from confusing two products, similar in kind, as a result of the fact that their trademarks are the same. There may be cases where such confusion is not detrimental to the public, and the owner of the trademark *himself* markets two suitable products in a particular country under the same trademark, for example, milk chocolate and pure chocolate. In such cases, there can obviously be no question of protection. In the event of detrimental confusion, however, there should be protection.

It has already been demonstrated that, in principle, any sale abroad by the trademark owner is not relevant to the protection in the country of importation. Actually, the only relevant point in this context is the question whether or not the foreign variety has been imported by the firm owning the trademark in the home country; only if this is the case could there be any question of — obviously undesirable — protection of the trademark owner against himself. If, in view of the different national requirements, he has marketed a special variety in each country, he has not only not imported the foreign variety himself but, right from the start, has definitely been opposed to the marketing of this variety in the importing country and may have expressly indicated this on the packaging. After all, for each individual territory there are separate trademark rights specifically attuned to that territory, and this, far from being accidental, is deliberate and in accordance with the practical considerations related to the nature of the trademark right, as set out in the introduction. In each of these territories, the trademark owner must be able to pursue an independent trademark policy, adapted to the requirements of that territory. There is cer-

tainly no reason for the fiction that the trademark owner, by marketing his product in some country under a particular trademark, has implicitly also authorized or consented to the sale of that product under that trademark in any other country where he owns the right to the same trademark. Thus, in one country he would be held responsible under trademark law for his trademark policy implemented in another country and directed exclusively toward that other country. This is unacceptable in principle.

Lastly, let us consider the question from the point of view of the public and of trade. In the cases referred to here, trademark protection (prohibition on importation) generally also serves the public interest. Meanwhile, trademark protection should not be viewed too much from the angle of the public. One should always remember that, whereas the trademark performs a function in regard to and even to the advantage of the public, the trademark right accrues exclusively to the trademark owner, not to the public. The trademark owner must certainly be given the opportunity to serve the public interest with his trademark — indeed, it is in his own interest to do so — but he is not compelled to. There are cases where trademark protection serves only the trademark owner's interest and is indifferent to the public. All that matters to the public is that it should not be misled about the origin or otherwise, or, in other words, that a trademark should not be used by various independent enterprises for similar goods. To the public, the question which of the competitors really has the best rights is of no interest whatsoever. The only possible disadvantage to the public of a prohibition on importation is that, in a few cases, there will be a small minority which prefers the foreign variety to the domestic product, especially if the differences in varieties concern flavor. It goes without saying that such an interest can never be a reason for modifying the above conclusions. The consumer does not use the trademark and is always free, therefore, to order the desired variety abroad. The interests of the dealers also do not constitute a decisive objection to the prohibition on importation. If in the importing country the trademark accrues to someone other than the person who has marketed the product in the exporting country, the dealers cannot import the product either, nor can they bring any influence to bear on this circumstance. At most, one might encourage the trademark owner to mark his products "destined for country X" or something along those lines. A proposal to that effect was made by Dr. M. Röttger (*GRUR*, March 1964).

One or More Factories

The question arises whether a distinction should be made according to whether the entrepreneur produces the different varieties in different national factories or in one central factory. There are few reasons for making this distinction, for in the cases mentioned under IVA the circumstances will only exceptionally necessitate spreading production, while also in the other cases there is a practical need to manufacture several varieties.

Trademark Protection for Parts of a Country

Another question is whether the above arguments in favor of trademark protection by country do not apply equally to

protection by part of a country, inasmuch as the relevant circumstances can also differ in various parts of a large country. However, the situation is then still fundamentally different, since there will generally not be separate trademark rights for the different parts of one country. Where such rights do exist, as in the United States, the foregoing arguments will apply to those parts just as they do to countries. Incidentally, it should be remembered that the different parts of one country will, in many cases, have formed an entity long enough to have developed a large measure of unity of conditions and taste. Hence, confusion among the different varieties would be less detrimental to the trademark's position, making protection less essential.

Economic Ties Between Enterprises

Another matter to be investigated is the extent to which economic ties between different firms can affect the trademark position. In chapter VII, this will be considered in connection with those cases where identical products are sold under the same trademark in different countries. As far as the sale of different varieties is concerned, we need only point out that, if both the owner and an associate company sell their own products in their own country under their own — identical — trademark, according to trademark law the importation of products originating from the other country is, of course, prohibited in both countries. Even if the products have a lot in common, they are still products originating from different enterprises.

Common Market

A final question to be answered is whether the special position of an economic community, such as the Common Market, calls for special treatment of the problems under review. There seem to be no grounds for this. At present, the regulations, circumstances and tastes in the different countries of the EEC are still too divergent to make protection of the different varieties superfluous. Gradually these differences will lessen, but that will only mean that there will be a need for protection in fewer cases. As soon as this is possible, the firms will discontinue the different varieties so as to make their business more efficient and to reduce costs. Competition will force them to do so. In cases where in different countries different varieties still continue to be in demand, protection against imports will continue to be necessary.

B. Solution for Patents

(change in legislation necessary)

In chapter III, under B, a possible solution for patents has been given and will now be elucidated briefly. Changing the national laws would not lead to a satisfactory result, for there would still be the complication of the existence of a separate patent in each country. This complication is not necessary. In view of what has been stated in the introduction about the universal nature of patents, it should be possible in principle — in contrast to the situation in respect of trademark rights — ultimately to replace the national laws by laws for groups of countries. Under such legislation, only one single patent would be granted for each invention, and it

would be valid in the joint territory of the respective group of countries. This will forthwith solve the territoriality problems between the individual countries of such a group. They will continue to exist between the individual groups, but these groups may be large.

The national patent laws are generally aimed at furthering the national economy in that the invention must be exploited by manufacture in the country itself; mere importation of the patented product will not suffice. Prohibition on importation will almost always constitute exercise of the right in accordance with the purpose of the law. In the Netherlands, Article 34(2) of the Patent Law was changed by a Law dated May 30, 1963, *Official Gazette*, 260, to the effect that the patentee also fulfills his obligation to exploit the patent by manufacturing outside the Kingdom of the Netherlands in countries to be specified by general Administrative Order. This change was introduced with an eye to Benelux and the EEC. If the obligation to exploit the patent can be fulfilled by means of imports, a prohibition on importation may under certain circumstances result in abuse. On the other hand, as long as economic conditions in the various countries continue to differ considerably, the question of abuse is not likely to arise. This change cannot, therefore, be considered of great importance. Fundamentally the patents continue to operate predominantly along territorial lines. An essential change could be brought about only by the introduction of supranational patent laws as described above.

Know-how

Non-patented articles the manufacture of which involves specialized knowledge are generally quality products and therefore sold under a trademark. If the foreign licensee employs a trademark other than that of the licensor, neither will benefit much from a ban on imports of the other's products. Such a prohibition will be to their advantage if the know-how is of such importance that it gives them a substantial lead over their competitors. In that case, separate protection will be necessary. Failing this, the one who has developed the know-how will not disclose it to licensees or make it available. Such a situation is not likely to arise between a licensor and a licensee who are both established in an industrialized country. Such protection can be of considerable importance, however, if the licensee is established in a developing country.

Protection might consist, for instance, in acceptance of the validity of a chain of contractual conditions by virtue of which imports can be prohibited. Under the current EEC Treaty, such validity would be dubious, and statutory measures would be desirable in the EEC, unless the exemption clause of Article 85, paragraph 3, of the Treaty could be applied with sufficient flexibility.

VI. Objections to the Solution for Trademarks

Abuse of Trademark Right

The principal objections leveled against the solution outlined above are connected with antitrust legislation. In fact it would be possible that an entrepreneur might sell different varieties in different countries, not because he is forced to

do so by circumstances, but simply because in that way frontier crossing can be prevented and he considers this procedure to be to his advantage. He would then split the international market up into national markets by means of trademark rights, and the promoters of free trade are determined to prevent this. However, to that end the trademark owner could, without any difficulty, use different national trademarks. In practice, this almost invariably leads to territorial market division, since in most other countries there is probably a third party who, by virtue of his right to a corresponding trademark, can prohibit importation into his country. Nevertheless, it is desired that, if the entrepreneur employs one trademark, he should in principle be deprived of the right to prohibit imports of products originating from himself. In theory, such deprivation would undoubtedly promote economic integration. From the preceding chapters it is evident, however, that a more gradual solution is needed in practice.

Deprivation in principle would go too far. Incidental deprivation is acceptable, especially if the entrepreneur's purpose really is to keep various national markets segregated, without serving any real trademark interest (as was assumed in the *Grundig-Consten* case, which concerned identical products). Such cases are probably far less common than one imagines. In any event, this question will arise only very rarely if different varieties of a product are involved. As a rule, the interests of the business are served by the lowest possible costs by means of the largest possible market, and only in such exceptional circumstances as described under IV A will the operations be confined to parts of a market. In drafting statutory regulations, it may be useful to realize that the main object of the enterprise does not in itself provide a sufficient basis for predicting its policy. It is customary, nowadays, to include in the aims of a business its long-term continuity as an independently operating enterprise. But even if maximum profit is taken as the prime motive, it would be wrong to expect a business to exploit every opportunity of making profit, irrespective of the consequences in the broadest sense. Especially the need to remain in the front line and go along with modern developments may well inhibit the realization of a temporary advantage in price in a closed market.

Conversely, the common interest can be only slightly affected by territorial maintenance of a trademark right. This will, after all, only result in the exclusion of certain products that bear a particular trademark. Exactly the same products can be sold freely by anyone without that trademark. In practice, this means that the costs of introducing a different trademark have to be incurred. This is quite normal, however, if the older trademark is owned by someone else. As far as the common interest is concerned, it makes little difference whether the older trademark only prevents imports of products originating from third parties, or also products originating from the trademark owner himself.

In the exceptional cases in which a trademark right is used in a manner calculated to prejudice the public interest — as may arise in transactions which conflict with any particular economic integration — such use can always be countered either by incorporating a direct prohibition in the

relevant integration agreement, or by pleading abuse of right, as indicated in chapter III, paragraph A, under "Abuse of Right."

Trademark Right on the Ground of Resale

One of the reasons why, in view of the antitrust laws, there is skepticism about the usual trademark protection probably lies in a structural drawback of existing trademark laws, namely that trademark rights can be acquired on the mere ground of resale, provided that this is effected from one country to another. Resale in a country where the resold product has already been marketed is not a constitutive use of the trademark, so no trademark right is thereby acquired. In several countries, however, the first sale of a branded product does create a right, even if the seller merely acts as importer and reseller (provided that he does not employ the trademark for the benefit of his supplier under an agreement with the latter). This is one of the undesirable consequences of the territorial system of the national trademark laws, and it is hardly surprising that this point gives rise to numerous problems, both within the sphere of the trademark legislation itself and at the point of contact with other areas, such as that of free competition.

Only recently, attention has been focused on this aspect by Dr. Martin Röttger of Leverkusen. He believes that a solution should be sought by decreeing that trademark rights can only be acquired by the manufacturer and the "selector," that is, the dealer who affixes his trademark or has it affixed on products bought by him. If such a change were to be made in trademark legislation, the legal position would become far less confused and the possibility of misuse of a trademark right would be considerably reduced. This should lessen the objection on the part of antitrust interests to the right to prohibit imports.

Perhaps the ruling of the Netherlands Supreme Court of December 22, 1966, mentioned at the end of chapter II under A, should be seen as an attempt to mend the existing system in the direction of the one that has just been suggested, without a change in the law. However, this appears to be a *tour de force* which could rebound in the other direction. The Supreme Court, after all, imputes the use of the trademark by the importer in the importing country to the manufacturer even if there has never been any contact between them and the importer has not had any intention of using the trademark for the manufacturer, so that the importer can thus create a trademark right in favor of the manufacturer without either party having had any such intention. Moreover, in the Netherlands the trademark right accrues to the enterprise that was the first to use the mark in the Netherlands to distinguish its goods. Now, it is an established fact that in such a case the manufacturer has not used the mark in Holland in any way whatsoever, since he has neither performed a single act in that country nor caused a third party to perform one for him. Clearly, the Supreme Court has forced the issue of the existing system in order to obviate certain unsatisfactory consequences. A better system and one more effectively serving legal security would be amendment of the law. Any such change will certainly not take place in such a way that a forced construction regarding the use will be accepted in the law.

VII. Economic Ties Between Enterprises

A Single Variety

One might well ask whether, now that the trademark owner's right to prohibit imports of his own product was not acknowledged in the aforementioned *Maja* and *Revlon* cases, it should be if the articles to be imported do not originate from the trademark owner himself but from an associated enterprise or a licensee. In chapter V, under A, "Economic Ties Between Enterprises," this question was broached in the case of different varieties. Here we shall consider the case where only one variety is sold at home and abroad.

If the enterprises between which a link exists are separate legal entities, the right to prohibit imports does not, for that simple reason, seem to be in doubt in terms of trademark laws. However, in Germany it has been advocated that, if in one country a trademark accrues to a manufacturer and in another to a firm associated with him, the nature of the link between the two enterprises should be examined. If it should be a close link, the two companies should be identified with each other and trademark protection refused. Such identification would be based on the purpose of the mark, namely, the indication of a particular origin. This view is discussed by Dr. Friedrich-Karl Beier in his note in *GRUR* under the *Maja* ruling of January 22, 1964, and recognized by the Swedish Royal Court at Göteborg in its ruling of May 25, 1965, *GRUR*, October 1965, pp. 511 *et seq.* The possibility of identification was, however, expressly rejected by the *Oberlandesgericht* at Hamm in its ruling of January 17, 1964, *Wirtschaft und Wettbewerb* of June 1964, *VII. Rechtspr./Verw.*, p. 535. The Swiss Federal Court in its well-known ruling of October 4, 1960, *GRUR Int.*, 1960, 294, in the *Philips* case, implicitly acknowledged a certain identification between the companies of a concern by observing that there was no question of confusion as to the origin of the goods, since the Swiss public did not look upon the *Philips* trademarks as being a special reference to the trademark owner, a particular company belonging to the Philips concern, but rather as a general reference to any company belonging to that concern. Here one could object — as is evident from chapter II, under A — to the view that trademark infringement arises only if the public is liable to be confused about the origin of the goods. A more clear-cut ruling is that given by the Swiss Federal Court on April 9, 1963, in the matter *Columbia*, *GRUR Int.*, 1964, 27, in which a firm stand is taken against such identification. Lastly, we would refer to the ruling by the *Oberlandesgericht* at Düsseldorf on July 14, 1964, in the matter of *Revlon IV*, *GRUR Int.*, 1965, 204, because this is sometimes regarded as acceptance of this principle of identification. Actually, there is no question of that, since in this case the mark was registered in a single country (West Germany) in the name of the American parent company as well as in the name of the West German subsidiary; the registration of the parent company was the older of the two, and this was, therefore, the true trademark owner in West Germany. The trademark right of the subsidiary was a secondary right and, according to the court ruling, did not feature a more extensive prohibition *vis-à-vis* third parties than the right of the parent company.

The argument in favor of identification, based on the purpose of trademark protection, namely, that in reality there is no need to prevent confusion between two associated businesses, is obviously defective. In principle, trademark protection is not limited on the basis of the purpose it serves.

Moreover, there is no real need, either, to prevent — by means of trademark protection — confusion between two independent enterprises which have already taken effective steps in other directions to prevent confusion or have made agreements on quality or, without agreement, manufacture products of the same quality, as may arise especially in the case of simple products which are manufactured in only slightly varying quality grades. One simply cannot permit oneself so much latitude with the text of the law. If the enterprises are different legal entities, they should also be treated as such in the matter of trademark law and not as a single source of products. With the reservation that the public must not be misled to its disadvantage, there can be no objection from the point of view of trademark law if two separate companies, the shares of which are in the hands of one person or corporation, act as two separate enterprises, or if the opposite happens owing to the fact that the link existing between the two companies is brought to the attention of the public. If one person acquires the majority of the shares in two rival firms, it may well be that he has no desire to intervene in the management of those firms but simply wishes to let the business continue on the old footing. It is equally well possible that he may wish to pursue a fresh, coordinated policy. The position in regard to trademark law should depend exclusively on the actual use made of the trademarks, not on shareholding.

A different situation is encountered in the sphere of administrative law (for example, administrative antitrust law). In this sphere, it should in principle be possible to ignore the legal personality. In such a case, however, special conditions are stipulated; for instance, an unpermitted agreement must have been concluded or a dominant position must be abused. Be that as it may, trademark law should not, especially without explicit legislation, be impregnated by antitrust legislation to the extent that individual legal entities are no longer recognized as such in relations of pure trademark law.

Grundig-Consten

There is no point in dwelling here on the general scope of the term "economic tie." In this context, however, it might be useful to draw attention to the possibility of an agreement between one or more enterprises concerning the use of a trademark, or the prohibition of a relevant concerted practice on grounds of the antitrust laws. In the EEC countries, this may be the case by virtue of Article 85 of the Treaty of Rome, at least if the agreement or concerted practice serves the purpose of or results in restriction of competition (and the restriction of competition does not, therefore, spring entirely from one or more trademark rights). If it is established that such agreement or conduct is prohibited, the crucial question arises what influence this can have on the exercise of certain trademark rights.

In the case of the agreements between Grundig and Consten, the European Commission, having established that those agreements were prohibited, forbade Grundig and Consten to adopt any measures calculated to impede or prevent third parties from freely obtaining certain Grundig products from dealers established in the EEC. In this way, the Commission wanted to ensure primarily that, besides the sole representative Consten, others would also be free to import these articles into France. The prohibition was left intact by the European Court (ruling, July 13, 1966). This probably implies that, in this case, not only actions based on the prohibited agreements are banned, but actually also all kinds of other actions. There are, however, sound reasons for doubting whether this is really intended, so that in this respect the ruling probably has no fundamental significance.

The powers of the European Commission in such matters are recorded in Article 3(1) of Ordinance No. 17 of the EEC Council, which reads: "If upon request or officially the Commission established infringement of Article 85 or Article 86 of the Treaty, it can by decree compel the enterprises and federations of enterprises involved to end the infringement established." The significance does not appear ambiguous: on account of Article 85, the Commission can only prohibit the observance and maintenance of prohibited agreements or prohibited concerted practices. The Commission itself has accordingly always expressly stated that what it prohibited was no more than conduct based on an agreement prohibited by it. Its point of departure was, however, that all the aforementioned measures calculated to impede or prevent the purchase of the said Grundig products are based on the agreements concluded between Grundig and Consten and prohibited by the Commission. In this case, two agreements were concerned, a sole agency agreement and an agreement whereby under certain conditions Grundig permitted Consten to register and use the *Gint* trademark in France. The Commission arrived at this view via the factual interpretation that the two agreements implied the guarantee that Consten would enjoy absolute territorial protection in France.

This interpretation constitutes nothing but a paraphrase of the texts of the agreements. It fails to answer the question what rights and obligations those agreements actually contain. Examining this question in relation to the trademarks, we find that the use of the *Gint* mark is clearly based on those agreements. However, it was not expressly agreed between the parties that the *Grundig* mark should be used by Grundig to prevent imports into France. Any use of that mark could, therefore, be based on the agreements only if these contained any general obligation for Grundig to take all measures within its power to oppose imports by third parties, so as to include invoking any possible industrial property right. In fact, in the documents published, there is nothing to suggest that such a general obligation really existed or even that such existence was alleged. According to those documents, the contract does not offer Consten any grounds for demanding of Grundig that the latter should, if necessary, use its mark in this way. A conclusion to the contrary cannot, of course, be based on the above paraphrase. And yet that is probably exactly what was done, judging by the way in which the Commission's view was presented in the Court's ruling.

The practical implications of this inaccuracy are not easy to assess. Its importance would certainly become evident if the French court were of the opinion that a French trademark right — as distinct from what present case law contains about a Dutch or German trademark right — did include the right to prohibit the importation of identical goods marketed abroad by the French trademark owner himself. Such a judgment appears quite feasible in France. Anyone deploring such a ruling, especially in view of the retarding effect on the economic integration, would have to press for a change in French national trademark legislation. In any case, the national law is decisive in this respect, so that the European Commission should not, independently of that law, look upon such use of a French mark as being alien to the purpose of trademark protection. This is precisely what it has done in this case.

On the one hand, therefore, one can concur with the ruling concerning the *Gint* trademark, which was affixed in an obvious manner to the sets and employed specially for the purpose of maintaining a territorial division of the market, the purpose for which it was acquired by Consten in France. On the other hand, there are various grounds for objecting strongly to the prohibition against the use of the trademark (assuming that under French law prohibition on imports of "original" goods is possible). The first reason is that, in the matter of the use of the *Grundig* mark, nothing had been agreed between the parties; another reason is that the prohibition obviously was not based on a concerted practice, since in this connection the documents contain not even a suggestion to the effect that the *Grundig* trademark was in fact used in France to maintain a territorial division of the market. Incidentally, it is perfectly normal that Grundig should protect its main trademark in France against infringement, for instance in the form of imports, at least if such protection is in accordance with French trademark legislation. Hence, it would be rash to assume that such protection is based on agreement. Even if an agreement had been concluded to employ the *Grundig* trademark against undesirable imports, or there should as yet be concerted practice on these lines, this would in no way conflict with Article 85 of the Treaty. For, in that case, it should be remembered that imports by persons other than the owner of the trademark are already fully prohibited by law through the mere existence of the trademark right (prohibition does not require action by the trademark owner). Hence, such agreement or practice would essentially imply that the statutory prohibition will not be abolished, which can hardly be described as a restriction of competition. Neither can objections be made to the acquisition of the right to the *Grundig* trademark in France as is the case in respect of *Gint*.

VIII. Summary

1. *Nature of rights.* — A trademark, unlike an invention or a work of art, is not of a universal but of a local nature, owing to its essential connection with the product to be distinguished.

2. *Purpose of the trademark right (limited importance of the function of origin and guarantee).* — A misconception still quite often encountered is that the trademark right only

serves (and therefore can only be exercised) to prevent confusion about the origin of the goods. In reality, the trademark right is one of the rights granted by the legislator, admittedly with a particular object in view, but nevertheless without any limitation. Everyone except the trademark owner is, therefore, prohibited by law from using the trademark to distinguish his goods, irrespective of the question what purpose (what interest) this prohibition and its maintenance serve.

The only limitation applying in regard to this purpose is that it must not in itself — that is, independently of the object of the trademark law — be improper. In the case of improper use, there is the question of abuse of the trademark right, as discussed in detail in point 5 of this summary where it is noted that the specific purpose the legislator had in mind does, after all, have some practical significance: there can never be any question of impropriety if the trademark right is employed for that specific purpose.

The prevention of confusion about the origin is by no means the only specific purpose the legislator had in mind. Neither is it the only reason why too much similarity between trademarks should be avoided. Sometimes the guarantee function of the trademark is not regarded as such a reason and, therefore, as a relevant function of the trademark right, whereas in actual fact the symbolization of one of the product's characteristics or a particular complex of them constitutes just as normal and relevant a function of the trademark right as the indication of origin. The circumstance that the trademark owner is not, as a rule, obliged to maintain these characteristics and, for instance, may lower the quality, is of no importance in determining the function of the exclusive right on this point, for this right only provides the trademark owner with certain *possibilities*. Generally, he is also not obliged to prevent confusion as to origin by taking action against all infringements. A complete — if rather broad — definition of the right's purpose is that the trademark should be capable of individualizing the product.

3. *Who distinguishes "his" goods?* — Not everyone using a trademark does so for the purpose of distinguishing his products from someone else's. Here, the word "his" does not so much indicate the ownership of the goods as their origin. The actual origin from a particular manufacturer or dealer is not decisive in terms of trademark law; if the product really originates from both of them, it will still — for the purpose of trademark law — count as originating from one of them. The question is not merely whose goods are in fact distinguished by the trademark, as there can be more than one user of the trademark, but from which of the users of the trademark have the goods come (in practice: which of the sellers of the branded article), in view of the nature of the use by the successive sellers. At the time of the first sale — the marketing — of the product in a particular country, the trademark inevitably functions as the distinguishing mark of the seller in question, unless he has agreed otherwise with the buyer or — in the case of importation — he has agreed otherwise either with his foreign supplier or with his buyer. In the absence of such an agreement and in the case of importation, therefore, the trademark serves in the importing coun-

try to distinguish the products of the importer as being the first seller in that country, not to distinguish the manufacturer's products. A wholly unacceptable proposition is that the manufacturer uses the trademark in the importing country — and, where the law acknowledges constitutive use, establishes a right there — in that, even if there is no question of an agreement or even of contact between the manufacturer and the importer, the latter (and his customers?) use the trademark for the manufacturer's benefit as resellers.

If the name of a company is displayed on the product, this need not be the company that uses the trademark as its own distinguishing mark; the mention of the name is irrelevant in this connection. The trademark of a department store and the name of the manufacturer by whom it has certain articles made can both have their own, good reputation, which justifies displaying them both on the packaging. The mention of the name is not aimed at giving any indication regarding the trademark right or regarding any intent relevant to that right.

A consequence of the territorial nature of the trademark right, as defined in the following point, is that in respect of one particular product, sold from country to country, a different firm in each country can be the one that, by selling this product, uses the trademark in order to distinguish "its" products.

4. *Territorial system of national trademark laws.* — Trademark rights are of a territorial nature, not only because they are based on laws operating in a limited territory, but also because by virtue of those laws legal consequences are attached only to actions performed within this limited territory, notably actions of use or their omission. To this system, there are a limited number of explicit exceptions which — apart from one provision of the impending Benelux Trademark Law — are not of fundamental importance. Accordingly, the validity and scope of the right to a particular trademark in one country is in principle independent of the validity and scope of the right to that trademark in another country. Hence, it would be illogical suddenly to make, in one particular category of cases (*viz*, those relating to imports by third parties of "original" products), the domestic trademark right dependent *in principle* on an action performed abroad, namely, the marketing there of the branded products. Without an explicit statutory provision in that sense, such dependence must not be assumed.

5. *Abuse of trademark rights.* — An entirely different matter is that an action performed abroad may, of course, well have an *incidental* effect on the domestic trademark right. In special circumstances involving both foreign and domestic aspects, the question of abuse of the trademark right could in fact arise. There is abuse if in the first place the exclusive right is employed for a purpose other than the one for which it was specifically granted, and also — independently thereof — this particular use conflicts with a standard of propriety: in other words, the purpose is improper. Such a standard of propriety may spring from an agreement pertaining to economic integration of the associated countries. Circumstances that might well play a part in certain cases could be the fact that the trademark belongs

to the same firm in the various relevant countries, and, in the event of importation by a third party, the further fact that the products marketed by that firm under such trademark in the importing country are identical with the products sold by it in the exporting country. Interpretation of the terms "purpose of the trademark right" and "propriety" enables the scope of the right to be continuously adapted to the prevailing economic circumstances.

6. *Trademark protection against imports of a different variety.* — Should the argument in point not be accepted in full, then he who is entitled to a particular trademark should, by virtue of that right, in any case be able to take action against undesirable imports of "original" goods, if in the importing country he sells not the same but a different variety under the same or a similar trademark. This prohibitive right can simply be based on existing national laws. The territorial system of the national trademark laws implies that the trademark owner should be able to conduct a separate trademark policy in each individual territory, adapted to the requirements of that territory. This should not only be possible by using a different trademark in each territory.

From the economic point of view, a prohibitive right in regard to such imports is fully justified. In the absence of trademark protection, the number of countries where action against such imports would be possible would steadily decrease. Contractual stipulations, in particular, would not help, for such stipulations — which would then exceed the scope of trademark protection — would actually restrict competition and, for that reason, often be forbidden. In practice, one should not attach too much importance to the risk that the different varieties will be marketed especially in order to maintain a territorial (international) division of the market. Moreover, this danger can be averted in those cases where there is an objection to such a market division particularly on account of proposed economic integration; after all, in the relevant agreement such use can simply be prohibited, or else abuse of right can probably be invoked.

7. *Additions to trademarks.* — No legal significance attaches to such indications as "variant X" or "style Y" added to a trademark for the purpose of distinguishing a domestic variety appreciated by the public from an imported, less appreciated, foreign variety marketed under the same trademark. Even as a purely practical measure, such additions have little significance since experience has shown that, especially in the case of display articles, such additions do not prevent the similarity of the trademarks from leading to confusion detrimental to the reputation of the domestic variety.

8. *No identification of affiliated legal entities.* — In civil law relations based on trademark law, different legal entities should be treated as such and not identified with each other, on the ground of, say, share holding (concern relations), as being one source of products (origin). There is no question of such identification in the *Revlon IV* ruling, given by the *Oberlandesgericht* at Düsseldorf on July 14, 1964 (*GRUR Int.*, 1965, 204), in which the decisive feature was that the trademark is registered in the Federal Republic in the names of two different affiliated companies.

9. *Grundig-Consten.* — The prohibition to use the *Grundig* trademark imposed upon Consten in the *Grundig-Consten* case does not appear justified, since there was no evidence of any agreement between Grundig and Consten pertaining to the use of this mark — as distinct from the *Gint* trademark; neither was there any question of concerted practices. The European Commission, without ascertaining whether the French Trademark Law offers the trademark owner protection against imports of "original" products — which may well be the case — quite wrongly regarded use against imports of "original" goods as alien to the purpose of trademark protection.

10. *Purer legal system.* — Trademark protection will have a purer basis, and the tendency to curb trademark protection so as to further free competition will probably decrease, if trademark rights are obtainable exclusively by the manufacturer and the "selector," that is, the dealer who affixes his trademark or has it affixed to commodities bought by him, and no longer by the importer who acts only as reseller. This necessitates amendment of the laws.

11. *Patents.* — In regard to patents, it has been concluded that the existing protection should be maintained in the event that goods covered by a patent and marketed by the patentee abroad are imported against his wish, on the understanding that the ultimate aim should be the introduction of a single patent law for each large group of economically associated countries and that, in the meantime, by changing the national patent laws, it might be possible to ensure that in special cases prohibition of such imports will be treated as an abuse of the patent. Such cases would arise if, upon the repeal of the provision that maintenance of the patent is contingent upon manufacture in the same country, the relevant circumstances in the various integrated countries are approximately identical, or if the patentee has undertaken local production especially in order to be able to maintain a territorial division of the market contrary to the aim of economic integration.

12. *Know-how.* — In regard to know-how, special protection will be necessary in certain cases. Generally, there will not be much need for protection against imports of products originating from a foreign holder of a know-how license, provided that in their presentation those products are entirely independent of the products of the licensor. If this need should arise — for instance, if the know-how represents an important lead over all competitors — the special protection required can be provided by acceptance of the legal validity of a chain of contractual conditions, by virtue of which imports such as those referred to here can be prohibited. It should, in particular, not be possible for the validity of these conditions to be disputed on the score of antitrust rules.

13. *Trade names and designs.* — In regard to trade names and industrial designs, the problem is, in practice, less acute for the moment. It is probably rare for the owner to want to prevent the importation of his own (foreign) goods by invoking his relevant right. For these reasons, the merits of the territorial effect of these rights have not been examined separately in this article.

In regard to the trade name, however, we would point out that, in so far as it is mentioned on the goods, its function is

obviously confined to indicating the origin. Hence, as a rule there does not appear to be any reason for protection against imports of one's "own" foreign products. It would nevertheless seem reasonable that, if the owner of a trade name does not wish to connect this name in a particular country to a foreign variety originating from him, he should be able to prohibit in that country the sale of such product under his name. Meanwhile, he is more likely to prohibit importation on the strength of his trademark right, since imports will mostly relate to branded products and marks lend themselves better to individualization of the products.

As for designs, their nature leads to the conclusion that territorial protection should be accepted in a similar way as in respect of patents.

A New Intellectual Property Union is Born: The International Union for the Protection of New Plant Varieties

By B. LACLAVERIE *

The year 1968 witnessed the birth of a new international union which some authors regard as also belonging to the field of intellectual property, in the broadest sense of the term. It does, in fact, bear a certain likeness to the Paris Union of 1883 for the Protection of Industrial Property.

Readers will remember that, on December 2, 1961, the International Convention for the Protection of New Varieties of Plants was signed in Paris¹. The signatory States were Belgium, France, Germany (Federal Republic), Italy, and the Netherlands. The Convention remained open, until December 2, 1962, for signature by the States represented at the 1961 Paris Conference and was signed on November 26, 1962, by the United Kingdom and Denmark and on November 30, 1962, by Switzerland.

The Convention could not, however, enter into force, nor could the international Union constituted in Article 1(2) thereof begin to function, until three signatory States had ratified the Convention. This third ratification was made by Germany (Federal Republic) on July 10, 1968, and the Convention thus entered into force on August 10, 1968. The first two ratifications were those of the United Kingdom on September 12, 1965, and the Netherlands on August 8, 1967. On September 6, 1968, Denmark became the fourth country to ratify the Convention, which became applicable to that country as from October 6, 1968. Further ratifications are to be expected during the course of 1969.

There are therefore four members of the International Union for the Protection of New Plant Varieties at the present time. It must be stressed, however, that, like that of the Paris Union for the Protection of Industrial Property, the character of this Convention is universal. In addition to the four other signatory States, the Union is henceforth open to the membership of States which did not participate in the

1961 Paris Conference and which may now accede to the Convention direct: any non-signatory State may address a request for accession to the Government of the Swiss Confederation. The request will then be notified to the member States of the Union and will be accepted if the Council of the Union votes in favor of it by a four-fifths majority.

* * *

Not only has the International Union for the Protection of New Plant Varieties entered into force, it has also begun to function. The Government of France, in deference to the desire expressed by the signatory States — both members and non-members of the Union — organized the first meeting of the Council which took place in Paris on November 26 and 27, 1968.

The States invited to participate in this meeting included both the member States and the signatory States (the latter attending as observers) and also, for part of the session, the States which had participated in the 1961 Paris Convention but had not yet signed the Convention, namely: Austria, Finland, Norway, Spain, and Sweden, as well as Luxembourg. That these States, except for Austria which was unable to send a delegation, were represented is indicative of the interest they continue to display in the protection of new plant varieties. From information they gave, it can even be expected that some of them at least will accede to the Convention in the near future.

The Council held a second meeting recently in Berne, on February 11 and 12, 1969, at the invitation of the Government of the Swiss Confederation which is entrusted, under the Convention, with the task of acting as High Supervisory Authority. Another meeting is already planned for 1969, which shows the keen desire of the member States of the Union and of States on the point of becoming members to forge ahead in undertaking joint studies of the problems to which the 1961 Convention provided the starting point of a solution.

* * *

The initial work of the Council is twofold: firstly to set in place material means that will permit the Union to function; and, secondly, to study the technical and legal problems that arise in applying the principles laid down in the Convention.

It is known that the Convention provides for the establishment, under the Council, of a working body called the Office of the Union. Views have been exchanged on the setting up of this Office, its tasks, and its operational costs; a draft budget proportionate to each member State's ability to contribute has even been drawn up.

Article 25 of the Convention provides, moreover, for the possibility of technical and administrative cooperation with BIRPI. Such a provision was adopted in the hope of being able to profit from the experience of that great international institution but also, it must be admitted, with the idea of saving administration costs by operating certain services in common.

However, the situation has evolved to a very considerable extent since the 1950s when those paving the way for the

* BIRPI translation.

¹ See *Industrial Property*, 1962, p. 5, and the articles which appeared in *ibid.*, 1965, pp. 224 and 275.

protection of new varieties of plants made friendly overtures to BIRPI in the provincial tranquillity of that little building imbued with the old-fashioned charm of Berne's Helvetiastrasse. At the time, there were discussions as to whether a special convention should be set up for the protection of new varieties of plants or whether it would suffice simply to amend the Paris Convention for the Protection of Industrial Property on the occasion of the famous Lisbon Revision Conference, forever being announced and then postponed.

Since that time, BIRPI has become an important international organization. It has moved to a modern, functional building in Geneva that is particularly spacious, even though some say it is already too small. Confronted by this imposing institution, the frail young Union, full of enthusiasm but lacking experience, has felt somewhat intimidated. It seems that, thanks to the kind assistance of the High Supervisory Authority, ways may be found to enable this Union to overcome its inferiority complex.

These feelers on the administrative level have not, however, prevented the signatory States of the Convention from going ahead and tackling the legal and technical problems facing them.

As a matter of fact, the experts who had been entrusted by the 1957 Paris Conference with the task of preparing a proposed draft convention indicated, when they finished their work in 1960, that they would like to get together periodically to discuss, not the principles they were proposing for adoption but the practical problems that the implementation of those principles would entail.

In 1963 and again in 1964, France took the initiative in organizing such meetings on a completely unofficial level. The United Kingdom then followed suit in 1965. Small working groups were set up so that, finally, when the first meeting of the Council of the Union was held, it was not merely one of pure form. On the contrary, the Council carefully examined the work that had been accomplished and saw to it that these working groups were given a more official status. Although it is still too early for results, it can be said that one of the most important of the experts' preoccupations has been to seek ways of achieving uniformity as regards the examination to which each new variety in the different countries should be submitted.

* * *

The very general nature of this article has been voluntary, for there are still a great many details to be worked out in the organization of the Union, its functioning and the direction its work will take in the years to come; nevertheless, it has been worth while to point out that the course which was set by the Paris Conference of May 7 to 11, 1957, is now irreversible and that, little by little, the void in protection that has hitherto existed in the judicial institutions of the various States will be filled. Furthermore, it should be stressed that, quite apart from this manner of looking at things, which is that of the jurist, the implementation of the Convention — the ultimate goal of which is, after all, to promote the creation of new plant varieties that are more useful or better adapted to human needs — should contribute to the material betterment of mankind's future.

NEWS ITEMS

UNITED STATES OF AMERICA

Appointment of a New Commissioner of Patents

We have recently been informed that Mr. William E. Schuyler has been appointed Commissioner of Patents of the U.S. Patent Office, with effect from May 1, 1969. Mr. Schuyler succeeds Mr. Edward J. Brenner who has resigned.

We take this opportunity to congratulate Mr. Schuyler on his appointment, and to express our best wishes to Mr. Brenner for the future.

BOOK REVIEWS

World Patent Law and Practice, by J. W. Baxter. 363 pages. Sweet and Maxwell, London. Matthew Bender and Co. Inc., New York, 1968.

This book, written by a practitioner specializing in industrial property questions, is intended as a work of general reference for those dealing in day-to-day patent practice and the international aspects of patent law.

The study takes up in succession the main problems confronting the practitioner and sets forth, for each case, the particular provisions in force in the various countries. Lastly, a final chapter gives a rapid analysis of the new legislation in Germany, France, Israel and the Nordic countries.

So as to make it easy to find all information on an individual country, there is, at the end of the book, a separate index of 25 countries in which there is considerable patent activity.

The author, who has thus made a worth-while contribution to the study of international patent practice, plans to keep his work up to date by publishing annual supplements, thereby adding to its value to specialists.

Brevets et marques au regard du droit de la concurrence en Europe et aux Etats-Unis [Patents and Trademarks in the Face of Competition Law in Europe and the United States]. Free University of Brussels. Institute of European Studies. Legal Theses and Works, 2. 225 pages. Presses Universitaires de Bruxelles, 1968.

Under this title, the Institute of European Studies has published the statements made at the Colloquy held on the following subjects on November 15 and 16, 1966:

- Patents, Trademarks and Free Competition under National Law;
- Trademarks and Free Competition under Community Law;
- Patents and Free Competition under Community Law;
- Patents, Trademarks and Free Competition in Atlantic Relations.

This Colloquy was attended by European and American industrial property specialists, and a comparison of their views will enable the reader to realize just how complicated the problems are that confront industrial property law owing to the rapid development of commercial exchanges between the various States.

The Patent Acts 1949-1961, with a commentary by the Chartered Institute of Patent Agents. Second Edition. Sweet and Maxwell 1968. London. 377 pages.

CALENDAR OF MEETINGS

BIRPI Meetings

- June 9 to 12, 1969 (Abidjan) — African Committee of Experts**
Object: To draft model statutes for societies of authors in African States — *Invitations:* Congo (Kinshasa), Ghana, Ivory Coast, Kenya, Malawi, Nigeria, Senegal, Tunisia — *Observers:* Intergovernmental and non-governmental organizations concerned — *Note:* Meeting convened jointly with Unesco
- June 20 and 21, 1969 (Geneva) — Permanent Committee of the Berne Union (Extraordinary Session)**
Object: Consideration of various questions concerning copyright — *Invitations:* Belgium, Brazil, Denmark, France, Germany (Fed. Rep.), India, Italy, Portugal, Rumania, Spain, Switzerland, United Kingdom — *Observers:* All other member States of the Berne Union; Unesco
- August 29, 1969 (Geneva) — Information Meeting of International Non-Governmental Organizations**
Object: To appoint observers to the International Copyright Joint Study Group — *Invitations:* Interested Organizations — *Note:* Meeting convened jointly with Unesco
- September 17, 1969 (Geneva) — Paris Union Committee for International Cooperation in Information Retrieval Among Patent Offices (ICIREPAT) — Technical Coordination Committee (2nd Session)**
- September 18 and 19, 1969 (Geneva) — Paris Union Committee for International Cooperation in Information Retrieval Among Patent Offices (ICIREPAT) — First Annual Meeting**
- September 22 to 26, 1969 (Geneva) — Interunion Coordination Committee (7th Session)**
Object: Program and Budget of BIRPI for 1970 — *Invitations:* Argentina, Australia, Austria, Belgium, Brazil, Cameroon, Denmark, France, Germany (Fed. Rep.), Hungary, India, Iran, Italy, Japan, Kenya, Morocco, Mexico, Netherlands, Poland, Portugal, Rumania, Soviet Union, Spain, Sweden, Switzerland, United Kingdom, United States of America
- September 22 to 26, 1969 (Geneva) — Executive Committee of the Conference of Representatives of the Paris Union (5th Session)**
Object: Program and Budget (Paris Union) for 1970 — *Invitations:* Argentina, Australia, Austria, Cameroon, France, Germany (Fed. Rep.), Hungary, Iran, Japan, Kenya, Morocco, Mexico, Netherlands, Poland, Soviet Union, Spain, Sweden, Switzerland, United Kingdom, United States of America — *Observers:* All the other member States of the Paris Union; United Nations; International Patent Institute
- September 22 to 26, 1969 (Geneva) — Council of the Lisbon Union for the Protection of Appellations of Origin and their International Registration (4th Session)**
Object: Annual Meeting — *Invitations:* All member States of the Lisbon Union — *Observers:* All other member States of the Paris Union
- September 29 to October 3, 1969 (Washington) — International Copyright Joint Study Group**
Object: To examine all questions concerning international copyright relations — *Invitations:* Argentina, Australia, Brazil, Canada, Ceylon, Czechoslovakia, France, Germany (Fed. Rep.), India, Italy, Ivory Coast, Japan, Kenya, Mexico, Netherlands, Nigeria, Peru, Philippines, Rumania, Senegal, Spain, Sweden, Tunisia, United Kingdom, United States of America, Yugoslavia — *Observers:* Organizations to be designated — *Note:* Meeting convened jointly with Unesco
- September 30 to October 2, 1969 (Geneva) — Committee of Experts on the Establishment of a "Priority Fee" (Paris Convention)**
Object: Implementation of the Recommendation adopted by the Stockholm Conference — *Invitations:* Algeria, Argentina, Austria, France, Germany (Fed. Rep.), Iran, Italy, Japan, Kenya, Netherlands, Rumania, Soviet Union, Spain, Sweden, Switzerland, United Kingdom, United States of America, Yugoslavia — *Observers:* Interested intergovernmental and non-governmental organizations
- October 21 to 24, 1969 (Munich) — Joint Ad Hoc Committee on the International Classification of Patents (2nd Session)**
Object: Practical application of the classification and revision of the European Convention — *Invitations:* Czechoslovakia, France, Germany (Fed. Rep.), Japan, Netherlands, Soviet Union, Spain, Switzerland, United Kingdom, United States of America — *Observers:* International Patent Institute — *Note:* Meeting convened jointly with the Council of Europe
- October 27 to 31, 1969 (Geneva) — Committee of Experts on a Model Law for Developing Countries on Industrial Designs**
Object: To study a Draft Model Law — *Invitations:* Developing countries members of the United Nations — *Observers:* Interested intergovernmental and non-governmental organizations
- November 3 to 8, 1969 (Cairo) — Arab Seminar on Industrial Property**
- December 10 to 12, 1969 (Paris) — Intergovernmental Committee Rome Convention (Neighboring Rights), convened jointly by BIRPI, ILO and Unesco (2nd Session)**
- December 15 to 19, 1969 (Paris) — Permanent Committee of the Berne Union (14th Ordinary Session)**

Meetings of Other International Organizations Concerned with Intellectual Property

- May 19 to 22, 1969 (Prague) — International Federation of Musicians — Executive Committee**
- May 25 to 29, 1969 (Vienna) — International League Against Unfair Competition (LICCD) — 21st Congress**
- May 31 to June 7, 1969 (Istanbul) — International Chamber of Commerce (ICC) — XXIInd Congress**
- June 9 to 14, 1969 (Venice) — International Association for the Protection of Industrial Property (IAPIP) — XXVIIth International Congress**
- June 23 to 27, 1969 (Paris) — Unesco — Subcommittee of the Intergovernmental Copyright Committee**
- June 24 to 26, 1969 (The Hague) — International Patent Institute (IPI) — 101st Session of the Administrative Council**
- July 1 to 5, 1969 (Moscow) — Moscow Jubilee Symposium 1969 (Industrial Property)**
- July 2 to 7, 1969 (Moscow) — International Writers Guild (IWG) — 2nd Congress**
- September 8 to 12, 1969 (Nuremberg) — International Federation of Musicians — 7th Ordinary Congress**