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Contents

LEGISLATION

- Denmark — Finland — Norway — Sweden. The Nordic Design Laws . . . 223
- Norway. I. Patent Act, 1967. Corrigendum 238
- II. Act Concerning the Right to Inventions made by Employees, 1970 . . . 238
- United States of America. Act to provide relief in patent and trademark cases affected by emergency situation, 1971 240
- Italy. Decrees concerning Temporary Protection at Exhibitions 240

GENERAL STUDIES

- The Swedish Design Protection Act (Claës Uggla) 241
- The Employed Inventor as Subject of Legislation (Fredrik Neumeyer) . . 243
- The WIPO Design Model Law 249

LETTERS FROM CORRESPONDENTS

- Letter from Scandinavia (Berndt Godenhielm) 253
- Letter from Lebanon (Fuad S. Saba) 256

BOOK REVIEWS 258

CALENDAR 259

LEGISLATION

The Nordic Design Laws

Introductory Note

As was the case with the Nordic Patent Laws, published in *Industrial Property*, 1968, p. 172, we are presenting the new Danish, Finnish, Norwegian and Swedish Design Acts as a unity.

Where the provisions in the four laws are identically or almost identically worded, they are set out under the heading *Common* in the left-hand margin of the column. In other cases the relevant country or countries have been indicated in the margin above the provision concerned. Minor differences in wording are indicated by the letters ^{DFNS}. This means that the word or words in brackets *only* appear in the Danish (^D), Finnish (^F), Norwegian (^N) or Swedish (^S) Act.

Almost all the provisions in each law has a counterpart in the other laws under the same section number. In the text below, the subsections have been placed in the alphabetical order of the countries. In the few places where the section number does not correspond to the same subject matter in the four laws, the alphabetical order has been abandoned so as to enable provisions dealing with the same subject to be found as close as possible together.

The unified text published below was based on translations of the four laws which were kindly provided by the Danish, Finnish, Norwegian and Swedish Patent Offices.

DENMARK Designs Act 1970 — No. 218 of May 27, 1970

FINLAND Registered Designs Act — No. 221/71 of March 12, 1971

NORWAY Designs Act, 1970 — No. 33 of May 29, 1970

SWEDEN Design Protection Act — No. 485 of June 29, 1970

Chapter I*. General Provisions

Section 1

Common

(1)* In this Act, the term "design" shall mean the prototype for an article's appearance or for an ornament.

Denmark

Norway

(2) The creator of a design, or his assignee, may obtain through registration in accordance with this Act the exclusive right to use the design in the course of trade [(see Section 5)^D] (the right to a design).

* The word "Chapter" followed by its number appears only in the Danish, Finnish and Norwegian Acts. The subsections are numbered only in the Danish Act.

Note: For the explanation of signs see the Introductory Note.

Finland

Sweden

(2) The creator of a design, or his assignee, may obtain through registration the exclusive right to use the design in the course of trade, in accordance with this Act (the right to a design).

Section 2

Common

(1) A design shall be registered only if it substantially differs from what has become known before the date of the application for registration.

(2) In this context, the term "known" shall apply to everything that has been made available to the public, whether as the result of reproduction, exhibition, offering for sale, or otherwise. Even a design that is not available to the public shall be deemed to be known if the design is evident from an application in this country for a patent or for registration of a trademark or a design, where such application has been — or is deemed under the relevant provisions to have been — made before the date stated in subsection (1) and where the design is subsequently, when the application is dealt with, made available to the public.

Section 3

Common

A design may nevertheless be registered where, during the six months before the application for registration was filed, it was made available to the public:

- (i) as a result of a manifest abuse with respect to the applicant or his predecessor in title, or
- (ii) due to the design's display, by the applicant or his predecessor in title, at an official or officially recognized international exhibition.

Section 4

Common

A design shall not be registered:

- (i) if the design or its utilization conflicts with morality or public order,
- (ii) if, without permission, the design includes:

Denmark

- (a) any signs or indications referred to in Section 132 of the Civil Code or any matter likely to be confused therewith;
- (b) anything which may appear to be the name or the trade name or portrait of another person, unless such person has been long dead, or anything which contains the distinctive name or pictorial representation of another person's real property;
- (c) anything that may be interpreted as the distinctive title of another person's protected literary or artistic work or anything which infringes another's exclusive right to such work or his right to a photographic illustration;

- (d) anything that does not substantially differ from a design registered in this country in the name of another person.

Finland

- (a) a national coat of arms, a national flag or other State emblem, an official mark or stamp of inspection or guarantee for the same or similar articles as those for which the design is intended, a Finnish municipal coat of arms, or the flag, coat of arms or other emblem, designation or abbreviation of the designation of an international intergovernmental organization, or a figure, designation or abbreviation of a designation that may be confused with the emblem, indication, designation or abbreviation of a designation of the kind referred to in this paragraph;
- (b) anything which may be understood to be another person's protected trade name, trade symbol or trademark which has become commonly known in this country, or the surname, pseudonym or similar name or the portrait of another person, unless the name or portrait manifestly refers to a person long since deceased;
- (c) anything that may be interpreted as the title of another person's protected literary or artistic work, provided such title is distinctive, or anything which infringes another's copyright to such a work or his right to a photographic illustration;
- (d) anything that does not substantially differ from a design registered in Finland in the name of another person.

Norway

- (a) a public coat of arms, flag or other public emblem or sign, including an official Norwegian or foreign mark of inspection or guarantee or seal that are established for articles of the same or similar kind as those for which registration of the design is sought, or the coat of arms, flag or other emblem, abbreviation or designation belonging to an intergovernmental organization, or any international mark, seal or symbol whose unauthorized use is unlawful, or anything that may be confused with the emblems or marks etc. referred to above;
- (b) anything that may be interpreted as another person's trade name or trademark or as the name or portrait of another person, unless it manifestly refers to a person long since deceased;
- (c) anything that may be interpreted as the distinctive title of another person's protected literary or artistic work or that infringes another's authorship (copyright) to such work or his right to a photographic illustration;
- (d) anything that does not substantially differ from a design registered in Norway in the name of another person.

Sweden

- (a) a national coat of arms, a national flag or other State emblem, a State mark of inspection or guarantee, any

other insignia which by reference to the Swedish State gives the design an official character, a Swedish municipal coat of arms or any international insignia protected under the Act (1970:498) relating to the protection for Coats of Arms and Other Official Insignia, or anything that may easily be confused with a coat of arms, flag, emblem or insignia referred to in this paragraph;

- (b) anything which may be understood to be a designation for a foundation, non-profit-making society, or similar association, or to be another person's trade name or trade symbol, protected in Sweden, or to be some other distinguishing mark which has become commonly known in Swedish trade or business as that of another person;
- (c) the portrait of another person or anything that may be interpreted as another's family name, pseudonym or similar name, unless the portrait or name manifestly refers to a person long since deceased;
- (d) anything that may be interpreted as the title of another person's literary or artistic work, protected in Sweden, provided such title is distinctive, or anything which infringes another's copyright to such work or his right to a photographic illustration enjoying protection in Sweden;
- (e) anything that does not substantially differ from a design registered in Sweden in the name of another person.

Section 5

Common

(1) Subject to the exceptions stated below, the right to a design implies that no one other than the owner of the right [(the registered owner of the design) ^{D N S}] may, without the owner's permission, use the design in the course of trade, by making, importing, offering, offering for sale, assigning or hiring out an article which does not substantially differ [in appearance ^{N S}] from the design or which includes something which does not substantially differ from it.

(2) The right to a design relates only to the articles for which the design has been registered and to articles similar thereto.

Section 6

Common

(1) Any person who has, in the course of trade, been using a design in this country, at the time the application for registration is made, may [notwithstanding the rights registered ^D] [notwithstanding another's right to the design ^F] [notwithstanding the right to the design ^{N S}] continue such use while retaining its general character, provided that such use did not entail a manifest abuse with respect to the applicant for registration or to his predecessor in title. Under similar conditions, any person who has taken substantial steps to use the design in the course of trade in this country shall have the same right of use.

(2) The right defined in subsection (1) may be transferred only together with the business in which it has arisen or in which the design was to be used.

Common

Section 7

The [Minister of Commerce^D] [Government^F] [King^N] [King in Council^S] may order that spare parts and accessories for aircraft may be imported into this country, notwithstanding the right to a design, where such spare parts and accessories are to be used for the repair of aircraft belonging to a foreign country in which corresponding benefits are accorded to this country's aircraft.

Denmark

Section 8

(1) The Minister of Commerce may decree that, in relation to Sections 2 and 6, applications for registration of a design previously filed abroad shall be deemed to have been filed at the same time as the previous application.

(2) The Minister of Commerce shall specify the conditions under which a right of priority may be claimed.

Finland

Sweden

(1) The [Government^F] [King in Council^S] may decree that an application for registration of a design which has previously been stated in an application for protection outside this country shall, at the request of the applicant, be deemed for the purposes of Sections 2 and 6 to have been made at the same time as the application outside this country.

(2) The decree shall specify in more detail the conditions under which such priority may be enjoyed.

Norway

(1) The King may decree that an application for registration of a design for which an application for protection has been filed abroad before the filing date shall, in relation to the provisions of Sections 2 and 6, be deemed upon request to have been made at the same time as the application outside this country.

(2) The King shall specify the conditions under which the right of priority referred to may be claimed.

Chapter II. The Application for Registration and Processing Thereof

Denmark

Section 9

The registering authority shall be the Patent and Trade-mark Office.

Finland

The registering authority shall be the National Patent and Register Board.

Norway

The registering authority shall be *Styret for det industrielle rettsvern* (the Patent Office).

Sweden

The registering authority shall be the National Patent and Registration Office.

Common

Section 10

(1) Applications for registration of designs shall be made in writing to the [registering authority^{D F S}] [Patent Office^N].

(2) The application shall contain information concerning the article for which registration of the design is applied for. The application shall mention the creator of the design. Where the applicant is not the creator, he shall produce evidence of his right to the design.

Denmark

Norway

(3) A representation of the design shall be attached to the application document. Where the applicant, before the application is published in accordance with the provisions of Section 18, also deposits a model, the model shall be deemed to disclose the design. There shall also be attached to the application an attestation, signed by the applicant, confirming that the design to his knowledge has not, before the date when the application is made or is deemed to have been made (see Section 8), become known so as to preclude registration of the design by virtue of Section 2 (see Section 3).

(4) The applicant shall pay the prescribed application fee and additional fees (see Section 48).

Finland

Sweden

(3) A representation of the design shall be attached to the application document. Where the applicant, before the application is published in accordance with the provisions of Section 18, also deposits a model, the model shall be deemed to disclose the design. There shall also be attached to the application an attestation [by the applicant^F] [signed by the applicant on his honor^S] confirming that the design to his knowledge has not, before the date when the application is made or is deemed under the provisions of Section 8 to have been made, become known so as to preclude registration of the design by virtue of Sections 2 and 3.

Finland

(4) When filing the application, the applicant shall pay the application fee and additional fees stated in Section 47.

Sweden

(4) The applicant shall pay the application fee and additional fees stated in Section 48.

Common

Section 11

An application may include more than one design where the articles for which registration of the design is applied for are related with respect to manufacture and use. An application for such multiple registration may comprise not more than 20 designs [and must not concern ornaments^{D N S}].

Finland

(2) Multiple registrations may not concern ornaments.

Common

Section 12

An applicant who is not domiciled in this country shall have an agent resident in the country who is empowered to represent him in all matters concerning the application.

Common

Section 13

(1) An application for registration of a design shall not be deemed to have been made until the applicant has deposited [with the registering authority^F] a representation or a model of the design.

(2) An application must not be altered so as to relate to a design or an article other than the design or article stated in the application.*

Denmark

Section 14

(1) When examining an application for registration of a design, the registering authority shall, within the scope fixed by the Minister of Commerce, establish whether the conditions for registration of the design have been satisfied. Where the applicant has not observed the prescribed requirements, or if the registering authority has other objections to the registration, the applicant shall be notified thereof and be given a time limit to reply or to make the necessary amendments.

(2) Where the applicant fails within the prescribed period to reply or to make the amendments to the application, the application shall be shelved. The notification referred to in subsection (1), second sentence, shall contain information to this effect.

(3) However, the application shall be reinstated upon the applicant's request if, within two months after the expiration of the prescribed period, the applicant makes a reply or amends the application and within the same period pays a prescribed reinstatement fee. Reinstatement may be granted only once.

Finland

(1) When examining an application for registration of a design, the registering authority shall, to the extent decreed by the Government, establish whether the conditions for registration of the design have been satisfied. Where the applicant has not observed the prescribed requirements regarding the application, or where the authority finds that there are other objections to acceptance of the application, the applicant shall be invited by an Office action to answer the objections or to make a correction within a prescribed period.

(2) Where the applicant fails within the prescribed period to submit a statement or to take steps to remedy a defect to which attention has been drawn, the application shall be dismissed as abandoned. A warning to this effect shall be included in the Office action.

(3) However, the application shall be reinstated if, within two months after the expiration of the prescribed period, the applicant so requests and makes a reply to the Office action or takes steps to remedy the defect and within the same period pays the prescribed reinstatement fee. Reinstatement may be granted only once.

* In the Norwegian Act, the text of this Section is contained in a single subsection.

Norway

(1) When examining an application for registration of a design, the Patent Office shall, to the extent determined by the King, establish whether the conditions for registration of the design have been satisfied. Where the applicant has not observed the prescribed requirements, or where the Patent Office has other objections to the registration, the applicant shall be notified accordingly in an official letter and be invited to express his views or to make amendments within a prescribed period.

(2) Where the applicant fails within the prescribed period to express his views or to amend the application so as to remedy a defect to which attention has been drawn, the application shall be shelved. The Patent Office's notification in accordance with subsection (1) shall contain information pointing out this consequence.

(3) However, the processing of the application shall be resumed if, within two months after the expiration of the prescribed period, the applicant submits a statement or makes the amendment and within the same period pays the prescribed reinstatement fee. Reinstatement may be granted only once.

Sweden

(1) When examining an application for registration of a design, the registering authority shall, to the extent decreed by the King in Council, establish whether the conditions for registration of the design have been satisfied. Where the applicant has not observed the prescribed requirements regarding the application, or where the authority finds that there are other reasons why the application should not be accepted, the applicant shall be invited in an official letter to express his views or to make a correction within a prescribed period.

(2) Where the applicant fails within the prescribed period to submit a statement or to take steps to remedy a defect to which attention has been drawn, the application shall be dismissed as abandoned. A warning to this effect shall be included in the official letter.

(3) However, the application shall be reinstated if, within two months after the expiration of the prescribed period, the applicant submits a statement or takes steps to remedy the defect and within the same period pays the prescribed reinstatement fee. Reinstatement may be granted only once.

Denmark

Section 15

If the registering authority still finds any objection to the acceptance of the application after receipt of the applicant's reply and provided that the applicant has had an opportunity to comment on the objection, the application shall be rejected unless the registering authority finds grounds for renewing the request under Section 14(1).

Finland

If there is still any objection to acceptance after the applicant's reply to the Office action and provided that the applicant has had an opportunity to answer the objection, the application shall be rejected unless there are

grounds for delivering a further Office action to the applicant.

Norway

If the Patent Office still finds any objection to the acceptance of the application after receipt of the applicant's reply and provided that the applicant has had an opportunity to comment on the objection, the application shall be rejected unless the Patent Office finds grounds for sending the applicant a further official letter.

Sweden

If there is still any obstacle to acceptance after a statement has been submitted and provided that the applicant has had an opportunity of stating his views on the obstacle, the application shall be rejected unless there are grounds for sending the applicant a further official letter.

Denmark

Section 16

(1) Where anyone claims before the registering authority that he and not the applicant is entitled to a design for which registration has been applied for, the registering authority may, if in doubt, request him to institute legal proceedings within a certain period. If the request is not complied with, the claim may be disregarded. Information to this effect shall be given in the request.

Finland

Sweden

(1) Where anyone claims before the registering authority to have a better right to the design than the applicant, and where the matter is found to be unclear, the authority may instruct him to institute legal proceedings within a certain period, failing which his claim will be disregarded when the application is further examined.

Norway

(1) Where anyone claims before the Patent Office that he and not the applicant is entitled to the design, the Patent Office may, where the matter is found to be unclear, request him to institute legal proceedings within a prescribed period to have the question tried in court, informing him that if the request is not complied with the claim may be disregarded when the application is further examined.

Common

(2) Where a dispute concerning [the title ^{D N}] [a better right ^{F S}] to a design is pending before a court of law, the application for registration may be suspended until the case is finally settled.

Denmark

Section 17

(1) Where anyone proves to the registering authority that he and not the applicant is entitled to the design covered by the application, the authority shall transfer the application to him if he so requests. The transferee shall pay a new application fee.

Finland

Sweden

(1) Where anyone proves to the registering authority that he has a better right to the design than the applicant,

the authority shall transfer the application to him, if he so requests. The transferee shall pay a new application fee.

Norway

(1) Where anyone proves to the satisfaction of the Patent Office that he and not the applicant is entitled to the design, the Office shall transfer the application to him if he so requests. The transferee shall pay a new application fee.

Common

(2) Where transfer is requested, the application must not be altered, shelved, rejected or accepted until the request for transfer has been finally decided.

Denmark

Norway

Section 18

(1) Where the application is in the prescribed form and no objection has been found to registration, the application shall be published in order to give the public an opportunity to enter opposition. On the applicant's request, publication may however be deferred for a period of up to six months counted from the filing date or [if priority is claimed under Section 8 ^N] from the date from which priority is claimed [(see Section 8) ^D]. Request for deferment shall be made on the application form.

(2) Opposition shall be made in writing [to the registering authority ^{D F}] [and must reach the Patent Office ^N] within two months from the date of publication.

Finland

(1) Where the application documents are in the prescribed form and no objection has been found to registration, the registering authority shall publish the application in order to give the public an opportunity to enter any opposition.

(2) On the applicant's request, publication may however be deferred for a period of up to six months counted from the filing date or the date from which priority is claimed under Section 8. Requests for deferment shall be made on the application form.

(3) [See subsection (2) of the Danish and Norwegian text above.]

Sweden

(1) Where the application documents are complete and there are no obstacles to registration, the registering authority shall publish the application in order to give the public an opportunity to enter any opposition. Where, however, a document in the case is to be kept secret in accordance with Section 19, publication shall be deferred until the document is made available to the public.

(2) Opposition shall be entered in writing to the registering authority within two months from the date of publication.

Denmark

Section 19

(1) From the date when the application is laid open for public inspection, the application documents shall be available to everybody.

(2) After six months from the filing date or, if priority under Section 8 has been claimed, from the priority date, the application documents shall be made available to everyone, even where the application has not been laid open for public inspection. However, if it has been decided to shelve or reject the application, the documents shall not be made available unless the applicant requests reinstatement of the application or appeals against the rejection.

(3) If the applicant so requests, the documents shall be made available earlier than the time stated in subsections (1) and (2).

(4) Where the documents are made available under subsection (2) or (3), this fact shall be advertised.

Finland

(1) Unless the application documents are to be kept secret following the applicant's request for deferment under Section 18, they shall be available to the public.

(2) Where deferment of publication has been requested, the application documents shall be available to the public on the expiration of the prescribed period, not later however than six months counted from the filing date or the date from which priority is claimed under Section 8. If, during the prescribed period, the authority decides to shelve or reject the application, the documents shall not be available to the public unless the applicant requests reinstatement of the application for examination or lodges an appeal.

Norway

(1) Unless the applicant has requested deferment of publication under Section 18, all documents in the application shall be made available to the public from the filing date.

(2) Where deferment has been requested, the documents shall be made available to the public at the end of the deferment period, even where publication under Section 18 has not yet been made. However, if at that time the application is shelved or rejected, the documents shall not be made available unless the applicant requests reinstatement of the application or appeals against the decision.

(3) Unless the Patent Office decides otherwise, proposals, drafts, opinions and similar working documents prepared by the Patent Office in the processing of an application shall not be made available to the public.

Sweden

Where, in the case of an application for registration of a design, a document disclosing the design is to be kept secret in accordance with special provisions to that effect, the document may not be issued without the consent of the applicant, until the period requested by him has expired or six months have elapsed since the date when the application was made or, where priority referred to in Section 8(1) is requested, since the date of such request. If the registering authority has decided to cancel or reject the application, before the period of secrecy has expired, the document may be issued only if the applicant requests reinstatement of the application or lodges an appeal.

Section 20

Common

(1) After the expiration of the period prescribed in Section [18(2) ^{D N S}] [18(3) ^F], a further examination of the application shall be carried out. Sections 14, 15, 16 and 17 shall be applicable to such examination.

(2) In the case of opposition the applicant shall be informed thereof. Where the opposition is not manifestly unjustified, the applicant shall be given an opportunity to answer the opposition.

Section 21

Common

(1) An applicant for registration of a design may appeal [to the Board of Appeals of the Patent Office ^N] against a [final ^{F S}] decision of the registering authority [which has gone against him ^{F N S}]. A person who has duly entered opposition may appeal against a decision accepting the application. Where the opponent withdraws his appeal, it may nevertheless be considered if there are special reasons for doing so.

(2) An applicant may appeal [to the Board of Appeals of the Patent Office ^N] against the rejection of a request for reinstatement, provided for in Section 14(3), and against the acceptance of a request for transfer, provided for in Section 17. The person making a request for transfer [under Section 17 ^N] may appeal against the rejection of his request.

Section 22

Denmark

(1) Appeals provided for in Section 21 shall be filed with the Minister of Commerce not later than two months after the registering authority has informed the party concerned of the decision. The fee for the appeal shall be paid within the same period, failing which the appeal will be dismissed.

(2) Appeals shall be decided by a Board of Appeal consisting of a chairman, who shall have a permanent seat on the Board, and two members appointed on the basis of the nature of the case. The permanent chairman shall fulfill the general qualifications for appointment as a High Court judge and be appointed for a period of not more than five years at a time.

(3) The decision of the Board of Appeal may not be contested before a higher administrative authority.

(4) Court proceedings against decisions of the registering authority which are subject to appeal to the Board of Appeal may not be instituted until the Board of Appeal has given its decision (see however Sections 31 and 32). Court proceedings against decisions whereby the Board of Appeal rejects an application for registration shall be instituted within two months after the party concerned has been informed of the decision.

Finland

(1) Appeals provided for in this Act shall be lodged with the Board of Appeals of the National Patent and Register Board within sixty days from the date of legal service of the decision. Within the same period the appel-

lant shall pay the prescribed appeal fee, failing which his appeal will not be considered.

(2) The applicant may appeal against a decision of the Board of Appeals, if the decision has gone against him. The appeal shall be lodged with the Supreme Administrative Court within sixty days from the date of legal service of the decision.

Norway

(1) Appeals shall be lodged with the Patent Office within two months from the day when a notification of the decision was sent to the party concerned. The prescribed fee shall be paid within the same period, failing which the appeal will not be considered.

(2) A decision of the Board of Appeals of the Patent Office rejecting an application may not be contested before the courts after two months following the applicant's notification of the rejection. The notification shall contain information on the time limit for the institution of court proceedings.

(3) There shall be no remedy against failure to comply with the time limits set out in subsections (1) and (2).

(4) The rules in Section 19(3) shall apply correspondingly to documents prepared by the Board of Appeals of the Patent Office.

Sweden

(1) Appeals provided for in Section 21 shall be lodged with the Board of Appeals of the National Patent and Registration Office within two months from the date of the decision. A person wishing to appeal shall, within the same period, pay the prescribed appeal fee, failing which his appeal will not be considered.

(2) The applicant may appeal against a decision of the Board of Appeals, if the decision has gone against him. The appeal shall be lodged with the Supreme Administrative Court within two months from the date of the decision.

Section 23

Common

(1) Where an application for registration of a design is accepted by a decision having force of law, the design shall be entered in the Register of Designs and the registration shall be published.

(2) A decision to shelve or to reject an application that has been published in the manner provided for in Section 18 shall be published after the decision has force of law.

Chapter III. Period of Validity of Registration of a Design

Section 24

Common

Registration of a design shall be valid for five years, dating from the day on which the application for registration was made. Registration may, on request, be renewed for two further periods of five years, each such period running from the expiration of the preceding period.

Denmark

Section 25

Norway

(1) Applications for renewal of registration shall be made in writing [to the registering authority^D] [to the Patent Office^N], at the earliest one year before and at the latest six months after the expiration of a current period of registration. Within the same period, the applicant shall pay the prescribed renewal and additional fees (see Section 48), failing which the application will be rejected.

(2) Renewal of a registration shall be published.

Finland

Sweden

(1) Applications for renewal of registration shall be made in writing to the registering authority, at the earliest one year before and at the latest six months after the expiration of a current period of registration. Within the same period, the renewal and additional fees stated in [Section 47^F] [Section 48^S] shall be paid, failing which the application will be rejected.

(2) Renewal of a registration shall be published.

Chapter IV. Licenses, Assignments, etc.*

Denmark

Section 26

Norway

Sweden

(1) Where the registered owner of a design has given another person the right to use the design in the course of trade (license), the licensee may not assign his right in the absence of an agreement to that effect.

(2) A license included with a business may however be assigned, when the business is assigned, in the absence of an agreement to the contrary. In such a case the assignor shall remain responsible for ensuring the fulfillment of the license agreement.

Finland

(1) The right to a design may be transferred.

(2) [See subsection (1) of the Danish, Norwegian and Swedish text above.]

(3) [See subsection (2) of the Danish, Norwegian and Swedish text above.]

Denmark

Section 27

(1) In the case of the transfer of the right to a design or the grant or transfer of a license, a note to that effect shall — on request and in return for a prescribed fee — be entered in the Register of Designs. If it is proved that a license that has been entered in the Register has ceased to be valid, the entry shall be removed on request.

(2) Subsection (1) shall apply correspondingly to a compulsory license and to the right referred to in Section 32(2).

(3) In the case of multiple registration, a transfer of the right to a design may be entered only with respect to all of the designs.

* In the Finnish Act, this heading reads: *Licenses, Compulsory Licenses, Assignments.*

(4) Legal proceedings regarding a design may always be brought against the person entered as registered owner and notifications from the registering authority need only be sent to such person.

Finland

(1) In the case of the transfer of the right to a design or a license, a note to that effect shall — on request and in return for a prescribed fee — be entered in the Register of Designs. The same shall apply to a mortgage on the right to a design. If it is proved that a license or mortgage that has been entered in the Register has ceased to be valid, the entry shall be removed.

(2) Subsection (1) shall apply correspondingly to a compulsory license and to the right referred to in Section 32(2).

(3) In the case of multiple registration, a transfer of the right to a design may be entered only with respect to all of the designs.

(4) In legal proceedings or other cases regarding the right to a design, the person whose name has last been entered in the Register of Designs as registered owner of the design shall be deemed to be the registered owner thereof.

(5) Any person requesting entry in the Register of an assignment of the right to a design or a license or a mortgage relating to such right shall, provided that he was acting in good faith at the time of such request, be unaffected by an earlier assignment of the right to a design or right relating thereto which had not previously been the object of a request for entry.

Norway

(1) In the case of the transfer of the right to a design or the grant or transfer of a license, a note to that effect shall — on request by one of the parties and in return for a prescribed fee — be entered in the Register of Designs. If a license that has been entered in the Register has ceased to be valid, this fact shall, on request by one of the parties, also be entered in the Register.

(2) Subsection (1) shall apply correspondingly to the transfer and termination of a compulsory license and to the right referred to in Section 32(2).

(3) In the case of multiple registration, a transfer of the right to a design may be entered only with respect to all of the designs.

(4) Legal proceedings regarding a design may always be brought against the person entered as registered owner and notifications from the Patent Office need only be sent to such person.

(5) The voluntary assignment of the right to a design, or a license, for which entry in the Register has been requested, shall, in the case of dispute, have priority over a voluntary assignment or license for which entry has not been requested or was requested later, provided that the owner of the right was acting in good faith at the time of such request.

Sweden

(1) In the case of the transfer of the right to a design or the surrender or grant of a license, a note to that effect shall — on request and in return for a prescribed fee — be entered in the Register of Designs. If it is proved that a license that has been entered in the Register has ceased to be valid, the entry shall be removed.

(2) Subsection (1) shall apply correspondingly to a compulsory license and to the right referred to in Section 32(2).

(3) In the case of multiple registration, a transfer of the right to a design may be entered only with respect to all of the designs.

(4) In a case regarding the right to a design, the person whose name has last been entered in the Register of Designs as registered owner of the design shall be deemed to be the registered owner thereof.

Section 28

Denmark

Norway

Any person who, at the time when an application for registration of a design was made available to the public, had been using the design in the course of trade in this country, may — where the application leads to registration — obtain a compulsory license to use the design, provided that extraordinary reasons exist and that such person had no knowledge of the application [when he began to use the design^N] and could not reasonably have obtained knowledge of it. In the same circumstances, any person who has taken substantial steps to use the design in the course of trade in this country shall have a right to a compulsory license. Such a compulsory license may also relate to a period before the design was registered.

Finland

Sweden

Any person who had, in the course of trade, been using a design, the subject of an application for registration, in this country when a document disclosing the design became available to the public, may — where the application leads to registration — obtain a compulsory license to use the design, provided that extraordinary reasons exist and that such person had no knowledge of the application and could not reasonably have obtained knowledge of it. In the same circumstances, any person who has taken substantial steps to use the design in the course of trade in this country shall have a right to such compulsory license. A compulsory license may also relate to a period before the design was registered.

Sweden

(2) If considerations of extraordinary importance for the public interest so demand, a person wishing to use in the course of trade a design registered in the name of another person may be granted a compulsory license therefor.

Section 29

Common

(1) A compulsory license may not be granted to any person who appears unable to use the design in an acceptable way and in accordance with the terms of the license.

(2) A compulsory license shall not prevent the registered owner of the design from using the design himself or from granting a license. A compulsory license may be transferred only together with the business [in which it is used or ^{D F S}] in which it is intended to be used.

Denmark

Section 30

The Maritime and Commercial Court in Copenhagen shall decide, as the court of first instance, whether or not a compulsory license is to be granted and the extent to which the design may be used and shall determine the compensation and other terms of the license. When a substantial change in circumstances so demands, the Court may, if so requested by either of the parties, revoke the license or stipulate new terms.

Finland

Norway

Sweden

A compulsory license shall be issued by the Court, which shall also decide the extent to which the design may be used and determine the compensation and other terms of the license. When a substantial change in circumstances so demands, the Court may, if so requested [by the person concerned ^F] [by either of the parties ^N], revoke the license or stipulate new terms.

Chapter V. Termination of Registration, etc.*

Denmark

Section 31

Norway

(1) Where a design has been registered contrary to Sections 1 to 4, and there still remains an objection to registration, the registration may be declared invalid by court decision. However, registration may not be declared invalid on the ground that the proprietor is only a part owner of the right to a design.

Finland

Sweden

(1) Where a design has been registered contrary to Sections 1, 2, 3, and 4 and there still remains an obstacle to registration, the Court shall, if an action is brought to that effect, cancel the registration. However, registration may not be cancelled on the ground that the person in whose name the registration was effected is only a part owner of the right to a design.

Common

(2) An action [for cancellation of registration ^F] based on the grant of registration to a person who is not the rightful owner as defined in Section 1 may be brought only by the person who claims to be entitled to the design. Such action shall be brought within one year after the plaintiff has had knowledge of the registration and of the other circumstances on which the action is based. Where the registered owner of the design acted in good faith when the design was registered or when the right to the design was transferred to him, the action may not be instituted later than three years after the registration.

* In the Finnish Act, this heading reads: *Termination of Right to a Design.*

Denmark

(3) Moreover, proceedings for cancellation of a registration may be instituted by anyone having a legal interest therein. An action based on a provision of Section 4(1) or (2) (a) may be brought also by the Patent and Trade-mark Office.

Finland

Sweden

(3) In other cases the action may be brought by anyone who sustains damage as a result of the registration. An action based on a provision of Section 4(1) or (2) (a) may be brought also [by the Public Prosecutor ^F] [by an authority nominated by the King in Council ^S].

Norway

(3) Subject to the exceptions stated in subsection (2), anyone may bring an action in pursuance of this Section.

(4) There shall be no remedy against failure to comply with the time limits set out in subsection (2).

Section 32

Common

(1) Where a design has been registered in the name of a person who is not the rightful owner as defined in Section 1, the Court shall, when an action is brought by the rightful owner, transfer the registration to him. [Where such action is instituted Section 31(2) shall apply. ^D] [The action shall be instituted within the periods stated in Section 31(2). ^{F N S}]

(2) Where a person who has been refused registration of a design has begun in good faith to use the design in the course of trade in this country or has taken substantial steps for that purpose, he may, on payment of reasonable compensation and on the fulfillment of other reasonable terms, continue such use or start the intended use, keeping its general character. In similar circumstances, the holder of a license entered in the Register shall have the same right.

(3) The right defined in subsection (2) may be transferred only together with the business in which [the design is used ^{D F S}] [the right originated ^N] or in which the design is intended to be used.

Section 33

Denmark

Finland

Sweden

(1) Where the registered owner of a design declares in a written statement [addressed to the registering authority ^{D S}] that he renounces his right to a design, the registering authority shall remove the design from the Register.

Norway

(1) A design shall be removed from the Register if the registered owner so requests in writing.

Denmark

(2) Where legal proceedings concerning the transfer of registration have been instituted, the design may not be removed from the Register until there is a final decision in the proceedings.

Finland

(2) Where the right to a design is the subject of attachment or a mortgage relating thereto has been recorded in the Register or where a dispute concerning transfer of registration is pending before a court, the design may not be removed from the Register at the request of the registered owner so long as the attachment or mortgage continues or the dispute has not been finally settled.

*Norway**Sweden*

(2) Where the right to a design is the subject of attachment or where a dispute concerning transfer of registration is pending before a court, the design may not be removed from the Register at the request of the registered owner so long as the attachment continues or the dispute has not been finally settled.

Chapter VI. Obligation to Provide Information

Denmark

Section 34

*Finland**Norway*

(1) Where a person who has applied for registration of a design invokes his application [when making a claim^F] against another person, before the application documents have become available to the public, he shall on request allow such other person to be given access to the documents.

Sweden

(1) Where a person who has applied for registration of a design invokes his application against another person, before a document disclosing the design has become available to the public, he shall allow such other person to be given access to the document.

Common

(2) Any person who by direct representation to another person, in an advertisement or [by the marking of^{D N}] [by an inscription or label on^{F S}] an article or its packaging or otherwise, states that registration of a design has been applied for or granted, without at the same time giving information about the number of the application or of the registration, shall, if so requested, give such information without delay. Where it is not expressly stated that registration has been applied for or granted, but the circumstances are such as to bring about the belief that this is the case, information shall, if requested, be given without delay as to whether registration has been applied for or granted.

Chapter VII *

Section 35

Denmark

(1) Anyone who intentionally infringes the exclusive right to a design (infringement of a design) shall be liable to a fine.

* The heading relating to Sections 35 to 40 is the following: *Penalties and Damages in Infringement Cases, etc.* (Danish Act); *Responsibility and Obligation to Provide Compensation* (Finnish Act); *Rules on Legal Protection, etc.* (Norwegian Act); *Responsibility and Obligation to Provide Compensation, etc.* (Swedish Act).

(2) If the offense is committed by a limited liability company, a cooperative society or the like, the enterprise as such may be liable to a fine.

(3) The prosecution shall be instituted by the aggrieved person.

Finland

(1) Anyone who infringes the right to a design (infringement of a design) may be restrained by the Court from continuing or repeating such act. Where the infringement was intentional he shall be liable to a fine or to imprisonment for a term not exceeding six months.

(2) Prosecution for the offense defined in subsection (1) may be instituted by the Public Prosecutor only if the aggrieved person brings a legal action based on the offense.

Norway

(1) Anyone who intentionally infringes the right to a design (infringement of a design) or contributes thereto, shall be liable to a fine or to imprisonment for a term not exceeding three months.

(2) Prosecution by the Public Prosecutor may take place only upon request of the aggrieved person.

Sweden

(1) Anyone who intentionally infringes the right to a design (infringement of a design) shall be liable to a fine or to imprisonment for a term not exceeding six months.

(2) Public prosecution for the offense defined in subsection (1) may be instituted only if the aggrieved person brings a legal action based on the offense and if there are extraordinary reasons of public interest for the institution of the proceedings.

Section 36

Denmark

(1) Anyone who intentionally or through negligence commits infringement of a design shall be liable to pay reasonable compensation for the use of the design, as well as compensation for the further damage caused by the infringement.

(2) Anyone who commits infringement of a design without intention or negligence and obtains a profit thereby shall be liable to pay compensation in accordance with subsection (1), if and to the extent that this is found reasonable. The amount of compensation shall not however exceed the presumed profit from the design infringement.

*Finland**Sweden*

(1) Anyone who intentionally or through negligence infringes the right to a design shall pay reasonable compensation for the use of the design, as well as compensation for the further damage caused by the infringement. If the negligence was minimal, the amount of compensation may be reduced.

(2) Anyone who infringes the right to a design without intention or negligence shall pay compensation for the use of the design, [if and^S] in so far as such compensation may be found reasonable.

(3) Proceedings for compensation on the grounds of infringement of the right to a design shall be instituted

within five years from the time when the damage was caused, failing which the right to compensation will be forfeited.

Norway

(1) Anyone who intentionally or through negligence commits design infringement shall be liable to pay compensation for the use of the design and for any further damage caused by the infringement. If the negligence was minor, the amount of compensation may be reduced.

(2) Anyone committing infringement without negligence and in good faith may be ordered by the Court to pay such damages as may be found reasonable, but not exceeding the presumed profit from the infringement.

Section 37

Denmark

Norway

(1) In the case of infringement of a design, at the request of the aggrieved person, the Court may order, to the extent that is found reasonable for preventing continued infringement, that goods which have been made or imported into this country illegally, or articles whose use would constitute design infringement, to be altered in a certain way or destroyed [or deposited in safe custody for the remainder of the period of protection ^N] or, in the case of goods made or imported illegally, to be surrendered, against remuneration, to the person whose right has been infringed. This shall not apply to a person who has acquired the goods or articles or rights to them in good faith and who has not himself committed infringement.

(2) Notwithstanding the provisions of subsection (1), the Court may, where special reasons exist and if so requested, give the owner of the goods made or imported illegally a right of disposal over such goods during the remainder of the period of protection or during part thereof in return for reasonable compensation and under other reasonable terms.

Finland

Sweden

(1) If so requested by a person whose right to a design has been infringed, the Court may order, on the basis of what is reasonable for preventing continued infringement, an article that has been made in or imported into this country in conflict with another person's right to a design, or an article whose use would constitute infringement of the right to a design, to be altered in a certain way or to be deposited in safe custody for the remainder of the period of protection, or to be destroyed or, where the article has been illegally manufactured or imported, to be surrendered, against remuneration, to the person whose right has been infringed. This provision shall not apply to a person who has acquired the goods or a special right to them in good faith and who has not himself infringed the right to the design.

(2) The goods defined in subsection (1) may be confiscated if it reasonably appears that an offense under Section 35 has been committed. The provisions of the

general law with respect to confiscation in criminal cases shall be applicable in such cases.

(3) Notwithstanding the provisions of subsection (1), the Court may, where special reasons exist and if so requested, make an order giving the owner of the goods referred to in subsection (1) the right of disposal over the goods during the remainder of the period of protection or during part thereof in return for reasonable compensation and under other reasonable terms.

Section 38

Denmark

(1) If anyone without authorization uses in the course of trade a design that is the subject of an application for registration, after the application documents have been made available to the public, the provisions relating to design infringement with the exception of Section 35 shall apply correspondingly if the application leads to registration. Compensation for damage arising from infringement committed before the application documents were made available to the public shall be payable only to the extent provided for in Section 36(2).

(2) The limitation period for claims to compensation shall not come to an end before one year after registration of the design.

Finland

Sweden

(1) If anyone [without authorization ^F] uses in the course of trade a design that is the subject of an application for registration [after the application documents have become available to the public ^F] [after a document disclosing the design has become available to the public ^S], the provisions of this Act with respect to infringement of the right to a design shall apply correspondingly in so far as the application leads to registration. However, no penalty may be inflicted, and compensation for damage caused by use made before the application has been published in accordance with Section 18 may be determined only in accordance with Section 36(2).

(2) The provisions of Section 36(3) shall not apply where the proceedings for compensation are instituted within one year after registration of the design.

Norway

(1) If anyone without authorization uses in the course of trade a design that is the subject of an application for registration, after the documents have become available to the public under Section 19, Sections 36 and 37 shall apply correspondingly if the application leads to registration. However, compensation for damage caused by use made before the publication under Section 18 shall always be limited as provided under Section 36(2).

(2) The statutory limitation period for claims under this provision shall not begin to run until the design has been registered.

Section 39

Denmark

In proceedings for design infringement, a plea that the registration is invalid may not be made unless an action

for a declaration of invalidity has been brought against the registered owner or he has been summoned under Section 43. If the design registration is declared invalid, Sections 35 to 38 shall not apply.

Finland

Sweden

(1) Where registration of a design has been cancelled as the result of a judgment having force of law, the penalties, compensation or protective measures provided for in Sections 35, 36, 37, and 38 shall not be ordered.

(2) Where the defendant in an action for infringement of the right to a design claims that the registration of the design [is invalid ^F] [should be cancelled ^S], the Court shall, if the defendant so requests, adjourn the case pending a final examination of the question of cancellation of the registration. If no action to that effect has been instituted, the Court shall at the time of adjournment prescribe a fixed period for the institution of such action.

Norway

In civil proceedings for design infringement, a decision in favor of the defendant may not be made on the ground that the registration is invalid or that its transfer may be claimed (see Sections 31 and 32), unless a judgment declaring the registration invalid or ordering its transfer has first been made.

Denmark

Section 40

(1) Anyone who, in the cases referred to in Section 34, fails to fulfill his obligation or gives false information shall be liable to a fine if a heavier penalty is not provided for by other legislation and shall be liable to remedy the damage caused thereby to the extent found reasonable.

(2) Section 35(2) and (3) shall apply correspondingly.

Finland

(1) A fine shall be imposed upon anyone who deliberately or through negligence, where such negligence is not minimal, fails to fulfill his obligations under Section 34.

(2) A fine shall be imposed on anyone who, in any case referred to in Section 34, gives wrong information, if punishment for the act is not provided for in the Criminal Code.

(3) Any person who is guilty of an offense referred to in this Section shall provide compensation for the damage caused. Where the negligence is minimal, the amount of compensation may be reduced.

(4) Proceedings based on the offense defined in this Section may be instituted by the Public Prosecutor only if the aggrieved person brings a legal action based on the offense.

Norway

(1) Any person who deliberately or through negligence infringes the provisions of Section 34 shall be liable to a fine and to provide compensation for the damage caused to the extent found reasonable.

(2) Prosecution by the Public Prosecutor may take place only upon the request of the aggrieved person.

Sweden

(1) A fine shall be imposed upon anyone who deliberately or through negligence, where such negligence is not minimal, —

(i) fails to fulfill his obligations under Section 34;

(ii) in any case referred to in Section 34, gives wrong information, if punishment for the act is not provided for in the Criminal Code.

(2) Any person who deliberately or through negligence is guilty of an omission or act referred to in subsection (1) shall provide compensation for damage caused. Where the negligence is minimal, the amount of compensation may be reduced.

(3) Public prosecution for the offense defined in subsection (1) may be instituted only if the aggrieved person brings a legal action based on the offense and if there are extraordinary reasons of public interest for the institution of the proceedings.

Chapter VIII. Rules Concerning Legal Proceedings *

Section 41

Denmark

In proceedings concerning the right to a design, cancellation of registration or the transfer of the design right, applicants and registered owners of designs who are not resident in this country shall be considered within the jurisdiction of Copenhagen.

Norway

(1) The following actions shall be brought before the City Court of Oslo:

(i) actions relating to the title to a design for which registration is sought under this Act;

(ii) actions for the review of a decision by the Board of Appeals of the Patent Office rejecting an application for registration of a design, see Section 22(2);

(iii) actions relating to the annulment or transfer of a registered design, see Sections 31 and 32.

(2) The City Court of Oslo shall be the forum for applicants and registered owners of designs who are not resident in this country.

Finland

Sweden

(1) The registered owner of a design, or any person who may use the design by virtue of a license [or a compulsory license ^F], may bring an action to determine whether he is protected by the registration against another person, where there is, to his detriment, any uncertainty as to the relationship.

(2) Under the same conditions, any person who carries on or intends to carry on [a business activity ^F] [an activity ^S] may bring an action against the registered owner of a design to determine whether any obstacle to the activity is presented by the particular registration.

* In the Danish Act, this heading reads: *Administration of Justice Provisions.*

(3) Where it is claimed, in a case referred to in subsection (1), that the registration of a design [is invalid^F] [should be cancelled^S], Section 39(2) shall apply correspondingly.

Denmark

Section 42

(1) Anyone bringing an action for cancellation of a design registration, for transfer of the registration or for a compulsory license shall at the same time notify the registering authority accordingly in writing with a view to an entry in the Register of Designs. He shall also notify any registered licensee whose address is recorded in the Register. Any licensee wishing to bring proceedings for design infringement shall similarly notify the registered owner of the design.

(2) If, on the day that the case comes up for trial, the plaintiff does not prove that the notification required by subsection (1) has been made, the Court may give him time for this to be done. If he fails to make use of this time, the action shall be dismissed.

Finland

Sweden

(1) Any person wishing to bring an action for cancellation of the registration of a design, for transfer of registration, or for the granting of a compulsory license shall notify the registering authority accordingly and inform everyone who according to the Register of Designs holds a license to use the design [or a mortgage thereon^F]. A licensee wishing to bring an action for infringement of the right to a design or for a determination referred to in Section 41(1) shall inform the registered owner of the design accordingly.

(2) The obligation to give notification in accordance with subsection (1) shall be deemed to have been fulfilled when notification by means of a [prepaid,^S] registered postal communication has been sent to the address recorded in the Register.

(3) If it is not shown, when the action is brought, that the notification has been made or information given in accordance with subsection (1), the plaintiff shall be given time [by the Court^F] for this to be done. If he fails to make use of this time, his action may not be taken up for examination.

Norway

(1) Anyone bringing an action for annulment or transfer of a registration to himself, or regarding a compulsory license, shall at the same time notify the Patent Office accordingly and give notice of the action by registered mail to any licensee recorded in the Register and having his address therein. Any licensee wishing to bring proceedings for design infringement shall similarly notify the registered owner of the design, provided that the latter's address is recorded in the Register.

(2) If the plaintiff does not prove that the notification required by subsection (1) has been made, the Court may give him time for this to be done. If the time limit is exceeded, the action shall be dismissed.

Denmark

Section 43

(1) Where, in an action for design infringement brought by the registered owner of a design, the defendant intends to claim that the registration should be cancelled, he shall make the notification provided for in Section 42(1) to the registering authority and to registered licensees. Section 42(2) shall apply correspondingly, so that the claim for cancellation shall be dismissed if the time limit is not observed.

(2) Where, in an action for design infringement brought by a licensee, the defendant wishes to claim as against the registered owner of the design that the registration should be cancelled, he may summon the registered owner to appear, irrespective of the latter's place of jurisdiction. Chapter 34 of the Administration of Justice Act shall apply correspondingly.

Finland

The City Court of Helsinki shall have jurisdiction in actions concerning a better right to a design, for cancellation of a registration, for transfer of an application or registration, for design infringement, for a compulsory license or the right referred to in Section 32(2), in criminal proceedings and claims for compensation under Section 40, and in actions for a determination in accordance with the provisions of Section 41.

Sweden

If, under the provisions of the Judicial Procedure Act, there is no competent court of law for an action concerning a better right to a design, for cancellation of the registration of a design, for transfer of such registration, for a compulsory license or the right referred to in Section 32(2), for compensation provided for in Section 40(2), or for a determination in accordance with the provisions of Section 41, the action shall be instituted before the Stockholm Magistrates' Court.

Norway

Copies of judgments in proceedings brought under this Act shall be sent to the Patent Office by the Court.

Denmark

Section 44

Copies of judgments in cases referred to in Sections 16, 31 and 32, and 35 to 38 shall be sent to the Patent and Trademark Office on the initiative of the Court.

Finland

Sweden

A copy of the [judgment or^S] final decision in a case referred to in Section 16, 30, 31, 32, 35, 36, 37, 38 or 41 shall be sent to the registering authority.

Chapter IX. Miscellaneous Provisions^{D N}
Special Provisions^{F S}

Norway

Section 44

Anyone may inspect the Register of Designs and, on payment of a fee, obtain copies thereof as well as certified copies of applications and their attachments as soon as they have been made available to the public under Section 19.

Section 45

Denmark

(1) The registered owner of a design who is not domiciled in this country shall have an agent resident here and entered in the Register of Designs who shall be empowered to receive on his behalf communications and other notifications relating to the design.

(2) Where the registered owner of a design does not have such an agent, communications etc. may be served in the manner prescribed in Section 160(2) of the Administration of Justice Act.

Finland

(1) The registered owner of a design who is not domiciled in Finland shall have an agent resident in Finland who shall be empowered to receive on the registered owner's behalf service of a writ, summons and other documents in cases and matters concerning the right to a design, except a summons for a criminal offense and a subpoena. Such agent shall be notified to the person responsible for the Register of Designs and shall be noted therein.

(2) Where the registered owner of a design does not have an agent as provided for in subsection (1), service may be made by mailing him the document that is to be served in a registered letter to his address entered in the Register of Designs. If no complete address is entered in the Register, service may be made by publication in the Official Finnish Gazette. Service shall be deemed to have been made when the provisions of this subsection have been fulfilled.

Norway

(1) The registered owner of a design who is not domiciled in this country shall have an agent resident here and entered in the Register of Designs who shall be empowered to receive on his behalf writs and other procedural communications relating to the design.

(2) Where the registered owner of a design does not have such an agent, writs may be served by mailing the document concerned in a registered letter to his address entered in the Register of Designs. In such a case, Section 178 of the Law relating to the Courts of Justice shall apply.

(3) If no complete address is entered in the Register, service of a writ or like document, or of any other document when the Court sees fit, may be made by publication of the document or an extract therefrom in *Norsk Lysningsblad* (the Official Gazette) and in the publication issued by the Patent Office, stating that the document may be collected from the office of the Court. In such a case, Section 181(4) of the Law relating to the Courts of Justice shall apply, with the substitution of "the time of posting a notice in the court" by "the time of the notification in the publication issued by the Patent Office."

Sweden

(1) The registered owner of a design who is not domiciled in Sweden shall have an agent resident here who shall be empowered to receive on the registered owner's behalf service of a writ, summons and other documents in

cases and matters concerning the right to a design, except a summons for a criminal offense and a subpoena. Such agent shall be notified to the person responsible for the Register of Designs and shall be noted therein.

(2) Where the registered owner of a design has not notified the agent as provided for in subsection (1), service may instead be made by mailing him the document that is to be served, in a prepaid letter to his address entered in the Register of Designs. If no complete address is entered in the Register, service may be made by posting the notice in the premises of the registering authority. Publication of the service shall be made in the ordinary newspapers. Service shall be deemed to have been made when the provisions of this subsection have been fulfilled.

Section 46

Denmark

The Minister of Commerce may, provided that reciprocity exists, decide that Sections 12 and 45 shall not apply to registered owners of designs who are domiciled in other countries or who have an agent resident in those countries and entered in the Danish Register of Designs in accordance with Sections 12 and 45.

Finland

The Government may, provided that reciprocity exists, decree that the rules set out in Section 12 or 45 shall not be applicable with respect to an applicant or registered owner of a design who is resident in a foreign country or who has in that country an agent entered in the Finnish Register having the powers referred to in those Sections.

Norway

The King may, provided that reciprocity exists, decree that Section 12 or 45 shall not apply to applicants or registered owners of a design who are domiciled in a specific foreign country or who have an agent resident there who has been notified to the registering authorities in this country and has the powers referred to in those provisions. In such a case, the writ or communication shall be served in accordance with the general provisions of Chapter 9 of the Law relating to the Courts of Justice.

Sweden

The King in Council may, provided that reciprocity exists, order that the rules set out in Section 12 or 45 shall not be applicable with respect to an applicant or registered owner of a design who is resident in a foreign country or who has in that country an agent who has been notified to the registering authority in Sweden and who has the powers referred to in those Sections.

Section 47

Denmark

The Minister of Commerce shall lay down rules and regulations for the implementation of this Act, including rules for the filing and examination of design applications, the arrangement and maintenance of the Register of Designs, the contents of the Journal and issue thereof and proceedings before the Patent and Trademark Office and the Board of Appeal. It may be decided that the records

of an application filed with the registering authority shall be available to the public. The Minister of Commerce may also lay down rules relating to the days on which the Patent and Trademark Office is to be closed.

Norway

The King shall draw up further provisions relating to applications for registration and renewal and their processing, the Register of Designs, the publication issued by the Patent Office and the general implementation of this Act. In this connection, it may be decided that the records of the Patent Office for applications filed and their processing shall be available to the public.

Sweden

(1) An appeal against a final decision of the registering authority in accordance with the provisions of this Act, other than a decision referred to in Section 21, shall be lodged with the Board of Appeals of the National Patent and Registration Office within two months from the date of the decision. Any person wishing to appeal shall pay the prescribed appeal fee within the same period, failing which the appeal will not be taken up for examination.

(2) Appeals against the decision of the Board of Appeals shall be lodged with the Supreme Administrative Court within two months from the date of the decision.

Finland

(1) In relation to an application for registration of a design or to renewal of registration of a design, the applicant shall pay an application fee or renewal fee and, if necessary, the following additional fees, namely a class fee for each class of articles beyond the first, a multiple registration fee for each design beyond the first, a storage fee for the storage of a model, a publication fee for publication of each representation beyond the first and a separate fee for other entries in the Register of Designs. An increased renewal fee shall be payable after the expiration of a current period of registration.

(2) The Government shall determine the fees payable in accordance with the provisions of this Act.

Section 48

Denmark

(1) An applicant for registration of a design or for renewal of registration of a design shall, in addition to the application and renewal fees, pay the following fees:

- (i) a class fee for each class beyond the first;
- (ii) a multiple registration fee for each design beyond the first;
- (iii) a storage fee for a model;
- (iv) a publication fee for each representation beyond the first.

(2) Where the renewal fee is paid after the expiration of the registration period, a supplementary fee shall be payable at the same time.

(3) The Minister of Commerce shall determine the fees under this Act and the fees for service, extracts from the Register etc.

Norway

(1) In relation to an application for registration of a design or to renewal of registration of a design, the applicant shall pay an application fee or renewal fee and, if necessary, the following additional fees: a class fee for each class beyond the first, a multiple registration fee for each design beyond the first, a storage fee for the storage of a model, and a publication fee for publication of each representation beyond the first. An increased renewal fee shall be payable after the expiration of a current period of registration.

(2) The King shall determine the fees under this Act as well as detailed rules for their payment. When altering the renewal fees, he may decide that the new fees shall apply also to earlier registrations. The King shall also determine the fees for entries in the Register of Designs and for copies and certificates issued by the Patent Office.

Sweden

In relation to an application for registration of a design or to renewal of registration of a design, the applicant shall pay an application fee or renewal fee and, if necessary, the following additional fees, namely a class fee for each class of articles beyond the first, a multiple registration fee for each design beyond the first, a storage fee for the storage of a model, and a publication fee for publication of each representation beyond the first. An increased renewal fee shall be payable after the expiration of a current period of registration.

DENMARK *

Chapter X. Provisions for Entry into Force and Transitional Provisions

Section 49

(1) This Act shall enter into force on October 1, 1970.

(2) The Designs Act, No. 107 of April 1, 1905, as published in Law Notification No. 193 of September 1, 1936, and as amended in pursuance of Section 2 of Act No. 247 of June 9, 1967, is repealed, see however subsection (3).

(3) Applications pending at the time of this Act's entry into force shall be decided in accordance with the legislation in force hitherto. This shall also apply to registrations resulting from such applications; however, the period prescribed under Section 10(2) of the former Designs Act shall be extended to six months.

Section 50

This Act shall not apply to the Faroe Islands; the Act may, however, by Royal Ordinance, be made to apply to these Islands with such amendments as circumstances in the Faroe Islands may require.

* The final provisions of each of the four Acts are now published consecutively country by country.

FINLAND

Section 48

More detailed regulations for the implementation of this Act shall be notified in a decree by the Government.

Section 49

This Act shall enter into force on April 1, 1971.

NORWAY

Chapter X. Provisions for Entry into Force and Transitional Provisions

Section 49

This Act shall enter into force on October 1, 1970. The Designs Act of July 2, 1910, including its amendments, is hereby repealed. The former Act shall however apply to applications for registration filed on or before September 30, 1970, and to designs which are or will be registered in pursuance of such applications. Nevertheless, Section 1(3) of the former Act shall not apply to literary or artistic works if the design protection therefor expires after September 30, 1971.

Chapter XI. Amendments of Other Acts

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SWEDEN

Section 49

(1) The King in Council shall determine the fees payable in accordance with the provisions of this Act.

(2) More detailed regulations for the implementation of this Act shall be notified by the King in Council or, after authorization by Him, by the registering authority.

This Act shall enter into force on October 1, 1970, when the Act (1899:59) relating to Protection for Certain Industrial Designs shall cease to have effect.

With respect to a design already registered before the new Act comes into force, the earlier laws shall continue to apply. If, when the Act comes into force, an application for registration in accordance with an earlier law is still subject to examination, the earlier law shall govern the continued processing of the application and, if it is accepted, the design. Sections 24 and 25 of the new Act shall however apply with respect to a design registration, based on an application made before the new Act comes into force, which takes effect at the time of, or after, the entry into force of the new Act.

The provisions of Section 43 of the new Act regarding the Stockholm Magistrates' Court shall, for the period ending on January 1, 1971, apply to the Stockholm City Court.

NORWAY

I

Patent Act, 1967

CORRIGENDUM

Section 52 of the Norwegian Patent Act, 1967, published in *Industrial Property*, 1968, p. 172 at p. 179, has four paragraphs, and not three as published. The fourth paragraph, which does not appear in the other Nordic Patent Acts, reads as follows:

There shall be no remedy against failure to comply with the time limits set out in the third paragraph.

II

Act

Concerning the Right to Inventions made by Employees

(No. 21 of April 17, 1970) *

1. — This Act shall apply to inventions, patentable in this country, which are made by employees engaged in public or private employment.

Teachers and the scientific personnel of universities or equivalent institutions of higher education shall not, in such capacity, be regarded as employees within the meaning of this Act.

2. — With those limitations which follow from the provisions of Sections 7(1), 9(2) and 10, this Act shall be applicable only where nothing else has been, or may be regarded as having been agreed.

3. — Employees shall have the same right to their inventions as other inventors unless this Act provides otherwise.

4. — Where an employee whose main work assignment is connected with research or inventions has arrived at an invention in the execution of such assignment, or where the invention results from a specific task to which an employee has been assigned in the course of his employment, the employer may request the transfer to himself of the right to the invention, in whole or in part, if the exploitation of the invention comes within the scope of activity of the enterprise.

Where the invention has been brought about in any connection with the employment other than those mentioned in subsection (1), the employer may, on request, exploit the invention in connection with his enterprise, if such exploitation comes within the scope of activity of the enterprise. Should the employer wish to acquire a more comprehensive right to the invention, he shall have, during the four months following receipt of notice of the invention in accordance with Section 5, a prior right to enter into an agreement on this matter with the employee.

Where the invention has been brought about without any connection with the employment, the employer shall have,

* Translation kindly provided by the Norwegian Patent Office.

during the period mentioned in the last sentence of the preceding subsection, a prior right to enter into an agreement with the employee concerning the acquisition, in whole or in part, of the right to the invention, if such exploitation comes within the scope of activity of the enterprise.

5. — An employee who makes an invention which is covered by the provisions of Section 4 shall, without unnecessary delay, notify the employer in writing giving such particulars as the details of the invention.

6. — An employer who intends to acquire the right to an invention in pursuance of Section 4(1) or the first sentence of Section 4(2) shall notify the employee accordingly in writing within four months after receipt of the notification in accordance with Section 5.

During the four months following receipt by the employer of the notification in accordance with Section 5, the employee shall not, without his employer's written consent, dispose of an invention covered by Section 4, or engage in activities which reduce the possibilities of obtaining a patent or which will permit exploitation by a third party. Nevertheless, after the employee has given the notification referred to in Section 5, he may apply for a patent for the invention in this country so long as this right has not been transferred to the employer. The employer shall be notified in writing before the application is filed.

7. — Even if it was agreed otherwise before the invention was made, where an employer acquires the right to an invention of an employee, in pursuance of Section 4 or on any other basis, the employee may claim reasonable remuneration unless the value of the right which the employer has acquired does not exceed that which the employee may reasonably be expected to contribute in return for the salary and any other benefits due to him in the course of his employment.

In the determination of the remuneration, due regard shall be given to the value of the invention, the extent of the right which the employer has acquired, the terms of employment of the employee and the significance the employment as a whole may have had for the making of the invention.

Legal proceedings for remuneration shall be instituted within five years from the time when the employer acquired the right to the invention. If a patent for the invention has been applied for, proceedings may nevertheless always be instituted within one year after the patent application has been finally decided.

8. — Where during the six months following the termination of the employment an application for a patent is filed, the invention shall — unless the employee proves otherwise — be deemed to have been made while the employment lasted, provided that the exploitation of the invention comes within the scope of activity of the former employer's enterprise and that the invention relates to the research and invention activities which constituted the inventor's main work assignment or results from a specific task assigned to the inventor during his employment.

9. — Terms in an agreement between employer and employee concerning the right to the employee's invention may be annulled, in whole or in part, when it would be unreasonable to apply them.

An agreement between an employer and an employee limiting the employee's right to dispose of an invention shall not be binding on the employee in so far as it applies to inventions made after one year following termination of the employment.

10. — Even if it has been agreed otherwise, remuneration determined in accordance with Section 7 may, at the request of either party, be altered when the circumstances on which the agreement was based have changed significantly. Nevertheless, no restitution may be claimed under this provision of benefits which the employee has received on the basis of a previously determined remuneration.

11. — Anyone who, by wrongful means, wilfully exploits or divulges information on the inventions of others which he obtains under the provisions of this Act shall be liable to a fine or imprisonment for a term not exceeding three months.

Any person who wilfully infringes the provision of Section 6(2), first sentence, shall be liable to the same penalties.

Public prosecution shall take place only at the request of the aggrieved party.

12. — A dispute occasioned by circumstances which are dealt with in this Act may be brought before a Mediation Tribunal by either of the parties.

The Tribunal shall consist of a chairman and two members. They shall be subject to the same rules of disqualification as judges. The chairman, who shall have the qualifications normally prescribed for professional judges, and one of the members, who shall have experience and knowledge of legal questions pertaining to patents and related questions, as well as their deputies, shall be appointed by the King for a period of five years. The other member, who shall possess the technical expertise in the particular field to which the invention belongs, shall for each case be appointed by the Ministry concerned.

If either of the parties so requests or if the Tribunal itself thinks fit, the Tribunal may be increased by two members who shall represent the employer and employee interests respectively. Such members shall be appointed in each case by the Ministry concerned. If one party is a member of an employers' or an employees' organization, the appointment shall be made in consultation with the organization concerned.

13. — The Tribunal shall seek to establish an amicable settlement between the parties, inter alia, by submitting proposals.

If the parties agree, the Tribunal shall act as a Court of Arbitration.

The activities of the Tribunal shall be financed by public funds.

The King shall lay down further rules concerning the Tribunal's activities.

14. — Where a case has been brought before the Mediation Tribunal, such mediation shall, in any legal proceedings, replace the mediation of the Board of Mediation.

Where the Tribunal has referred the case to the Courts, Section 299 of the Civil Procedure Act shall apply correspondingly.

15. — This Act shall enter into force from such date as the King shall decide¹.

The Act shall not apply to inventions made prior to its entry into force.

Section 8 shall not apply to any person whose employment terminates during the six months following the entry into force of the Act.

¹ The Act entered into force on September 1, 1970 in accordance with the Royal Decree of July 3, 1970.

UNITED STATES OF AMERICA

Act

to provide relief in patent and trademark cases affected by the emergency situation in the United States Postal Service which began on March 18, 1970

(of June 30, 1971 (Public Law 92-34 — 85 Stat. 87))

1. — (a) A patent or trademark application shall be considered as having been filed in the United States Patent Office on the date that it would have been received by the Patent Office except for the delay caused by the emergency situation affecting the postal service which began on March 18, 1970, and ended on or about March 30, 1970, if a claim is made for the benefit of an earlier date in accordance with subsections (b) and (c) of this section. Patents issued with earlier filing dates afforded by this section shall not be effective as prior art under subsection 102(e) of title 35 of the United States Code as of such earlier filing dates.

(b) No patent or trademark application, patent, or trademark registration shall be entitled to an earlier filing date under this section unless a verified statement by the applicant or owner of record claiming the filing date to which the application is believed to be entitled is filed in the Patent Office within six months after enactment of this Act. Such statement shall be maintained in the file of the application in the Patent Office and shall be referred to in the patent or trademark registration when practicable.

(c) When a statement filed under subsection (b) of this section appears unreasonable or defective on its face, or when the filing date of the patent or trademark application, patent, or trademark registration is called into question or is material in any inter partes proceeding in the Patent Office or any proceeding in the courts, the applicant or owner of such application, patent, or trademark registration may be required to present evidence establishing the filing date to which the application is entitled. The filing date to which the application is entitled shall be determined on the basis of such evidence

and any evidence introduced by an opposing party. The evidence shall be presented as directed by the Commissioner of Patents in proceedings in the Patent Office or as directed by the courts in proceedings in the courts.

2. — (a) Except for the filing of a patent or trademark application, if any action is taken or any fee is paid in the United States Patent Office later than the end of a time period specified in the statutes set forth in subsection (b) of this section for taking such action or paying such fee, and no provision exists in law for excusing such delay, the delay may be excused if it is determined that it was caused by the emergency situation affecting postal service which began on March 18, 1970 and ended on or about March 30, 1970. Relief under this section must be requested by a verified statement filed in the Patent Office by the patent or trademark applicant or owner within six months after enactment of this Act.

(b) This section is applicable to title 35, United States Code, "Patents"; the Trademark Act of 1946, ch. 540, 60 Stat. 427, as amended; the Atomic Energy Act of 1954, Pub. L. 83-703, 68 Stat. 919, as amended; and the National Aeronautics and Space Act, Pub. L. 85-568, 72 Stat. 426 (1958), as amended. In cases involving the Atomic Energy Act of 1954 or the National Aeronautics and Space Act, determinations of relief shall be made by a Board of Patent Interferences. In other cases determinations shall be made by the Commissioner of Patents.

3. — The Commissioner of Patents may establish regulations for administering this Act.

Approved June 30, 1971.

ITALY

Decrees Concerning the Temporary Protection of Industrial Property Rights at Exhibitions

(of June 18 and 22, and July 8 and 21, 1971) *

Sole Section

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

9^a *Mostra internazionale del marmo e delle macchine per l'industria marmifera* (Valpolicella (Verona), September 4 to 12, 1971);

XXIV^a *Fiera di Bolzano - Campionaria internazionale* (Bolzano, September 11 to 20, 1971);

SITPEL - *Salone italiano della pelletteria* (Naples, September 18 to 21, 1971);

2^a *Mostra nazionale dell'ombrello* (Busto Arsizio, September 19 to 26, 1971);

II^o *OPTICA - Salone dell'ottica, oftalmologia, ingegneria (strumenti), fotografia e cinematografia* (Naples, October 2 to 10, 1971);

* Official communications from the Italian Administration.

I° SICAT - Salone italiano della cartoleria ed articoli tecnici (Naples, October 2 to 10, 1971);

3° Salone internazionale delle attività zootecniche - Eurocarne (Verona, October 6 to 10, 1971);

XI MAC 71 - Mostra internazionale di apparecchiature chimiche (Milan, October 14 to 20, 1971);

I^a Fiera Agricola dell'arco alpino (Bolzano, October 22 to 25, 1971);

II° NAUTICSUD - Salone Nazionale per lo sviluppo della Nautica nel Mezzogiorno d'Italia e nell'Oltremare (Naples, October 23 to November 4, 1971);

Salone mercato dell'abbigliamento « modaselezione » (Turin, October 23 to November 4, 1971);

Salone internazionale macchine per l'enologia e l'imbottigliamento SIMEI (Milan, November 20 to 28, 1971)

shall enjoy the temporary protection provided by Laws No. 1127 of June 29, 1939¹, No. 1411 of August 25, 1940², No. 929 of June 21, 1942³, and No. 514 of July 1, 1959⁴.

¹ See *La Propriété industrielle*, 1939, p. 124; 1940, p. 84.

² *Ibid.*, 1940, p. 196.

³ *Ibid.*, 1942, p. 168.

⁴ *Ibid.*, 1960, p. 23.

GENERAL STUDIES

The Swedish Design Protection Act

By Claës UGGLA, Chairman on the Board of Appeals
of the Swedish Patent and Registration Office

A new Design Protection Act came into force in Sweden on October 1, 1970. The new Act replaces the former rudimentary legislation of 1899. Under the old Act the registration and protection of industrial designs were only possible in respect of ornamental designs within the metal-working industries. The limitation to ornamental designs had been laid down by the courts¹ and was given a very strict interpretation: the ornamental purpose should outweigh the usefulness of the object.

Right from the beginning, dissatisfaction with the 1899 Act was expressed more or less regularly in Parliament and elsewhere and a number of Bills were introduced with a view to obtaining more comprehensive possibilities of design protection. The Bills met with no success, however. It was not until 1954, when a private Member of Parliament, Mr. Sigfrid Löfgren², finally managed to set the heavy lawmaking machinery in motion. As a result of his initiative a Royal Committee was set up in 1958 whose terms of reference were mainly to carry out an allover investigation of the desirability of new legislation on design protection and to elaborate the necessary texts embodying its recommendations. Professor S. Ljungman was appointed Chairman of the Committee. It was foreseen that the work would be conducted in cooperation with committees to be set up for the same purpose in Denmark, Finland and Norway.

The Swedish Committee presented its report towards the end of 1965. The printed report³ entitled *Mönsterskydd* (Design Protection) is a book of 415 pages comprising the

complete text of the proposed new Act together with an extensive commentary setting out the scope and intended interpretation of the various sections.

The report was sent out to interested circles in the usual manner. The proposal was then further elaborated by the Ministry of Justice in due contact with the corresponding ministries in the other Nordic countries. A Government Bill⁴ was laid before Parliament late in 1969 and was passed in the spring of 1970.

The new design legislation should be seen as an integral part of the general revision of Scandinavian law in the field of intellectual property. In the course of this revision, a new Copyright Act and a new Trademarks Act were passed in Sweden in 1960, a new Act on Surnames and Christian Names in 1963, a new Patent Act in 1967, an Act on Improper Marketing (certain forms of unfair competition) in 1970 and an Act on the Protection of New Plant Varieties in 1971. A new Act on Trade Names is under preparation. The extent to which the Scandinavian harmonization has been aimed at or achieved varies in the different Acts. Thus the Scandinavian Patent Acts are very nearly identical, whereas the Names Acts are harmonized only to a small degree. In the degree of harmonization achieved, the new Scandinavian Design Protection Acts⁵ rank second only to the Patent Acts.

For the drafting of the provisions of the new Design Protection Act, a number of principles and ideas were taken over from previous Danish and Norwegian Design Acts as well as from other foreign legislation in the field, particularly in the more important industrial countries. In the context of the general revision of intellectual property laws it was natural to seek models, especially for procedural provisions, in those Acts on industrial property that had recently been

¹ Supreme Court, Nov. 2 1932 (NJA 1932: 639).

² Private Bills I: 351 and II: 461.

³ SOU 1965: 61.

⁴ 1969: 168.

⁵ For the text of the four Acts, see p. 223 above (*Editor's Note*).

adopted in the course of that revision. Thus inspiration was found in the Trademarks Act of 1960 and, perhaps still more, in the Patent Act of 1967. The Design Protection Act gives the necessary implementation to the requirements of the Paris Convention and the Locarno Agreement.

A design is defined in the Act as the prototype⁶ for the appearance of an article or for an ornament. It should be emphasized that the new Act does not limit registration and protection to ornamental designs, as did the old Act. Thus, protection will be given to designs whose features are wholly ascribable to functional reasons. This does not mean, however, that so-called utility models are registrable under the Design Protection Act. The aim of the Act is merely to afford protection to the outward appearance of an object, and it does not concern itself with any technical idea that might underlie that appearance.

As mentioned, the Act allows the registration of mere ornaments. If an ornament can be applied to several different kinds of goods, it will be possible to have it registered in all the classes that cover such goods. This is true also in the case of ordinary designs when the particular shape could serve as a pattern for different sorts of goods. In his application the applicant is required to specify the kind or kinds of goods for which the design is intended. The basic application fee of 150 Swedish crowns (115 Swiss francs) entitles the applicant to registration in one class. For each extra class he will have to pay an additional fee of 50 crowns. Once the registration is granted, the protection will extend not only to goods expressly stated in the Register, but also to similar goods.

Registration is granted for a period of five years and can be renewed for two further five-year periods. The renewal fees are high, 300 crowns for the first renewal and 600 for the second. A progressive fee scale has been adopted in order to ensure that designs no longer of economic importance to their proprietors are not kept on the Register.

During the preparation of the new Act, the question was much debated as to whether design registration should extend to all branches of industry or whether one or several branches should be excluded. The possibility that the new Act should have the same narrow applicability as the 1899 Act was of course immediately discarded. It was felt to be against the spirit of Article 5^{quinquies} of the Paris Convention. But the exclusion of just one or two branches was thought permissible. Most branches of industry wished for the benefits of design protection. It was really only within the textile and clothing and, to some extent, the wallpaper industries that a certain hesitancy or reluctance was voiced. After very careful consideration it was finally decided that no branch of industry should be excluded, but on the plea of the textile industries the fee system was so constructed as to make registration fairly expensive and therefore less attractive to the textile manufacturers, who often place big collections of new patterns on the market yearly or even twice yearly.

⁶ The word "prototype" is perhaps not altogether a happy translation of the Swedish word "*förebild*" (cf. the German word *Vorbild*), but it has not seemed possible to find an exact counterpart in English.

Experience so far under the new Act shows that this was an effective means of tackling the problem. There have been remarkably few applications covering stuffs or other textile goods.

In principle it is the creator of the design who is entitled to the protection. He may assign his rights, however, and in practice applications are to a large extent lodged by enterprises who have acquired the right from the creator. There is no legislation on the rights of employed design creators as there is in the case of employed inventors. The legal situation in that respect is therefore somewhat uncertain, but designers on entering employment are advised to have the necessary provisions embodied in their employment contracts. In drafting such clauses they will have the support of fairly influential trade unions.

As design protection is, from a legal point of view, situated somewhere between patents and copyright, the question has been discussed, internationally as well as nationally, whether in drawing up the novelty requirement one should use the "patent approach" or the "copyright approach." It was decided that the patent approach would be in closer conformity with the subject matter and by far the easier to handle legally. Thus it is a bar to registration if the design does not substantially differ from a design already known. With the patent approach it is quite immaterial whether the applicant had in fact copied the earlier design or whether he is able to prove that he had never seen it and that he had indeed created the design himself, the similarity being purely coincidental. The main reasons for this solution are that the things designers work on are often very simple everyday objects where there is quite a tangible possibility of the same design being created independently by several designers; when the limitation to merely ornamental designs is given up, it is therefore natural to adopt the novelty concept prevailing under patent law.

In order to be considered new, a design must, as already mentioned, differ *substantially* from a previously known design. This requirement is understood to mean that there must be an important difference, not just some insignificant change or variation. The difference must be such as to give the design a general appearance other than the one already known. If the design is new in comparison with one already on the Register — that is to say if it differs substantially from that design — then its use in trade cannot constitute an infringement of the rights of the prior registrant. In other words, the same criteria as to difference apply both when novelty is decided and when the question of infringement is considered.

A characteristic of the Design Protection Act is the preliminary examination system. Such a system was considered a *sine qua non* by Swedish industry, in spite of the fact that Patent Office representatives explained the great difficulties of running an efficient examination system for designs. Still the novelty examination is not too ambitious; it consists mainly in a search among previous design applications and registrations, but the examiners have the possibility of citing other references known to them. The search files are growing

rapidly, and here the Locarno Classification comes in as a very important instrument.

To bring the novelty requirement home to applicants — who frequently apply on their own without the help of an agent — they have to sign an affidavit declaring that to the best of their knowledge the design is new.

The examination ends with publication for opposition. For this reason a special fortnightly Design Gazette is printed. It has proved possible to find offset printing methods that, at quite a modest cost, produce good reproductions of the designs.

Applications for design registration are normally open to public inspection from the date of filing. At the special request of the applicant, documents showing the design may be withheld for a maximum period of six months from the filing date or, if priority is claimed, from the priority date.

The Swedish Design Protection Act has provisions for a compulsory license for a registered design in certain rare situations. This institution may be seen as a safety valve introduced to counteract any danger that might flow from the fact that the Act permits the registration of purely functional designs. Non-use of a design does, of course, not give cause for a compulsory license. Cases regarding compulsory licenses have to be taken to the general courts.

The registration of designs is handled by the Patent Office. Formerly the Trademarks Division was responsible; for registration under the new Act a special Designs Section has been formed. Appeals can be taken by both applicants and opponents to the Board of Appeals. The decisions of the Board can only be appealed by applicants, not by opponents. The case is then taken to the Supreme Administrative Court. As the new Act has only been in force for a short time, there have been very few appeals to the Board and none to the Supreme Administrative Court.

The Employed Inventor as Subject of Legislation An Ideological Survey

By Fredrik NEUMEYER, Dr. Ing., Dr. h. c.
Stockholm, Sweden *

The employed inventor has no established place in the legal theory or practice of most countries and he is rarely the subject of discussion in legal textbooks. He is a long way from the front line of political discussion or planning. In the absence of emphasis on the "human touch" elements of the successful or unsuccessful inventor, he is moreover hardly a subject of popular appeal.

Nevertheless, the question of the employed inventor is important. It is notably recognized as such by research institutions and by divisions of industrial corporations responsible for labor relations and for research and development, which

are considerably more conscious of the problems in this field. The number of people earning their living as salaried employees in engineering and scientific fields is constantly increasing and more and more people of this kind are working in dependence on some employer — be it a government organization, an industrial corporation or a university. At the end of this Study a simplified table is to be found, giving recent figures concerning the total number of civilian employees in eleven countries and showing the number of those employees who are working in industry. The figures are approximate but we can see from them that more than 25 million people are active in industry in the United States of America; more than 17 million in Japan; more than 12 million in Germany (Federal Republic), the Soviet Union and the United Kingdom; about 8 million in France and Italy; more than 2 million in Czechoslovakia; about 1½ million in Sweden and Switzerland, and more than 1 million in Austria. If we assume that only five percent of these armies of industrial employees are capable of making a useful invention at least once in their careers, we have more than 1¼ million employees who are potential inventors in the United States and a total of 5 million in the 11 countries listed. A quantitative approach with regard to inventors and inventions produced does however have its dangers: the number of patentable inventions made is relatively insignificant, and the economic and technological impact of inventions is, as a rule, not dependent upon their number but upon their degree of novelty and actual usefulness.

The subject matter of employees' inventions is therefore important and it is at the same time controversial. There is a tendency in certain circles to minimize its importance, which is in general due to a lack of understanding both of basic concepts and of practical solutions. Conflicting social, economic and political interests of the partners of the labor market meet face to face in this field and only a limited number of nations have found a preliminary solution for an honorable compromise with which both partners are satisfied. Over the years, there seems to have been a trend to silence serious discussion as "premature" or unnecessary or to treat the question as having already been settled by experienced employers on their own terms. It is submitted that such reasons for inactivity are, in the long term, unacceptable.

In recent years, attempts have been made at the international level to come to grips with the problems in this field. In June 1969, the subject was an item on the agenda of the Venice Congress of the International Association for the Protection of Industrial Property, and the regulation of employees' inventions was extensively discussed by twenty-three speakers coming from all parts of the world. Practically all the delegates represented employers' views only and no common cause or new or improved principles or policies could be developed¹. In February 1971, the Duttweiler Institute for Economic and Social Studies in Rüschlikon held a three-day study conference entirely devoted to the question

* Revised and enlarged text of talk given at the opening of the International Study Conference on the Employee as Inventor in Law and Practice at the Duttweiler Institute for Economic and Social Studies, Rüschlikon, Switzerland, February 4, 1971.

¹ AIPPI Annuaire (Nouvelle Série) 1969/I, Congrès de Venise 1969, Rapport de Synthèse, p. 29, and 1969/II, Compte rendu du Congrès de Venise, p. 207.

of the employee as inventor in law and practice. At this meeting, reports were given by eleven national experts (from Austria, Czechoslovakia, France, Germany (Federal Republic), Italy, Japan, Soviet Union, Sweden, Switzerland, United Kingdom and the United States of America)². An ideological survey of the whole field was given by the author (and is substantially the contents of this Study), and representatives from the International Labour Office, the World Intellectual Property Organization and the International Association for the Protection of Industrial Property sketched the outlook for international coordination of national legislation in this field.

The purpose of this Study is restricted to outlining the position of the law on employed inventors in various countries against the *ideological* background. Political systems are founded on differing basic ideologies, which have an important effect on the law relating to employed inventors and lead to different solutions. This Study can only touch on the main types of ideology relevant to a number of specific countries.

The law on employed inventors lies at the crossroad of patent law, labor law (or better labor relations law) and contract law. As we know, patent law is a well established branch of civil law in many countries, having ancestors and legal traditions going further back than 100 years. In addition, what makes discussion and international cooperation relatively easy in patent law is that at least some basic principles — and their application in practice — are similar in most countries. Labor law, as a separate branch, is not as old as patent law and is, of course, dependent upon a country's political and social structure — and thus subject to radical changes or developments. There are, therefore, substantial differences in law and practice and this not only between Western orientated and socialist systems. Moreover, the traditional distinction between “developed” and “developing” countries does not fit here. Some of the large Western industrial nations, such as France, the United Kingdom and the United States of America, have not yet found an overall solution to the legal problems involved; whereas some small countries, like Austria and Sweden, have endeavored to mold their law and practice so as to satisfy what would seem to be reasonable demands of statesmanship and social progress.

The Common Law Approach

First a glance at an important group of industrial countries in which the “Common Law” is the principal legal system. They include Australia, Canada, New Zealand, the United Kingdom and the United States of America. The position of the employed inventor in these countries is largely governed by common law — in the narrower sense of “judge-made” law, as opposed to law by statutory regulation.

The relevant law in the United Kingdom rests basically on the notion of “master and servant” — an aspect of the law that is deeply rooted in traditions and concepts, many of which were formed centuries ago. There has been some statutory law regulating basic mutual relations between employers

and employees in all possible trades and arts in England ever since the Statute of Laborers enacted in 1349. As early as 1765, Sir William Blackstone, in his *Commentaries*, referred to the master and servant relationship as one of the three great relationships in private life³. The problems of interest in this Study start however with the modern factory system in the 18th century, when persons with engineering skill began to work in the service of a “master.” The British concept of “servant” is comprehensive, covering all forms of occupation in which a person for valuable consideration hires out his services in a subordinate capacity to another for the purpose of helping that other in the performance of some duty or object for which assistance is either necessary or desirable⁴. The legal rules regarding master and servant have gained their force of law through long usage and universal acceptance throughout the Kingdom⁵. The oldest court decisions on employees' inventions are probably *Bloxam v. Elsee* in 1825⁶ and *Minter v. Wells* in 1834⁷. The questions decided in these cases centered on whether or not the servant was merely carrying out the instructions of his master — acting as a mere tool for putting his master's ideas into the tangible form which was the subject of a patent. In modern British case law, a dominating concept, applicable unless otherwise agreed, is that an employee who makes a useful and patentable invention which falls within his duty to make holds the invention “in trust” for his master, who may be a company, a government department or any other employer. The trusteeship of an employed inventor has been established in a long series of court decisions, probably beginning with *Worthington Pumping Engine Co. v. Moore* (1902). A “trust,” which is a concept pertaining to the English law of property and having its roots in English landowner law of the 16th century, has never been defined in the many modern court cases on employed inventors⁸. Its meaning as implied in this context is however clear. A good definition of a “trustee” is a person who holds or administers property for the benefit of another and who may not derive any personal benefit from the property; in other words he holds an office of personal confidence. His main duty is to place the trust property in a proper state of security, keep it in safe custody and in a state proper to be invested and distributed⁹. The emphasis on the trusteeship concept and its extensive application in case law seems to reflect a paternalistic view on the part of the British courts. The employer is seen by them as a “master” owning the rights over most employees' inventions, and the question of remuneration remains entirely at his discretion. Recent statements of the principal industrial employers' organization in the United Kingdom, the Confederation of British Industry, confirm this attitude; they are to the effect that there is no reason to consider there to be any problems

³ Vol. I, p. 422.

⁴ *Encyclopaedia Britannica*, Vol. 15 (1956), p. 43.

⁵ F. R. Batt, *The Law of Master and Servant*, 4th ed., London 1953, pp. 20 and 24.

⁶ 1 C. P. 558.

⁷ 1 Web. Pat. Cas. 132.

⁸ See F. Neumeyer, *The Law of Employed Inventors in Europe*, Washington 1963, Chapter V, pp. 84 ff.

⁹ *Encyclopaedia Britannica*, Vol. 22, pp. 510 ff.

² The Conference reports will be published in extenso in Switzerland.

in connection with employees making discoveries or inventions relating to their employment and in the course of it, that the whole matter of remuneration for inventors is not a fit subject for overriding or for detailed statute law and that any proposal to put such a matter on a "compulsory algebraically calculated basis" is unacceptable¹⁰. The general negative position of employers on this point was moreover accepted in the official "Banks Report" on the British patent system¹¹.

In the United States of America the case law on employed inventors, revealing some of the basic attitudes in this field, starts early in the 19th century. Significant ideological guideposts can be found as early as 1843¹². The ideological basis of the law on inventors in general is the Constitution of 1787, Article 1(8), which gives Congress the power "to promote the progress of science and the useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." In a speech to Congress in January 1970 George Washington, the first President of the United States, stressed the expediency of giving effectual encouragement to the exertions of skill and genius in producing new and useful inventions. Thomas Jefferson, the first Secretary of State of the new country, spoke in a similar spirit, not to mention Benjamin Franklin, the inventor among the Founding Fathers of the United States of America. As early as 1829, however, the United States Supreme Court (in *Pennock v. Dialogue* 2 Pet. 1, 19) stated that "such enrichment as authors and inventors may happen to derive from their copyrights and patents is merely incidental, the main object of this Constitutional provision being to promote the progress of science and the useful arts."

A fundamental principle governing the allocation of rights between an inventing employee and his employer, which was developed early in American law, is the "shop right" doctrine. Under this doctrine, where an employee makes an invention in his employer's time with his facilities or other assistance, the employer is entitled to an irrevocable license to use the invention (without payment). The doctrine has been upheld and interpreted in the original spirit in a long series of basic court decisions and was, in 1933, extended to government employees conceiving and perfecting inventions during their hours of employment and working with their employer's materials and appliances¹³. There is, however, currently some tendency in the United States to reexamine the nature, consequences and continuing viability of the shop right doctrine and to explore the desirability of providing special compensation for inventions made during employment¹⁴.

United States ideology, therefore, underlines the public interest "to promote the progress of science and the useful arts" while at the same time judge-made law is allocating

the rights in employees' inventions with little regard to the essential differences in the categories of employees' inventions and to the variety of circumstances under which they can be produced¹⁵. In this connection, a reference might be made to the very high level of research financed by Government in the United States, which gives government policy, government statutes and government regulations in the employee-invention field a much greater impact than in most other countries. This is a complex question which is dealt with by the author in a recent work¹⁶.

In the author's opinion, the decisions and the accompanying "dicta" of the British and American courts contain a mixture of considerable wisdom and retarding conservatism, and lag sometimes behind their times — which are characterized, in the field of employees' inventions, by the dynamics of engineering progress and its social impact. There would seem to be a need for statutory codification in this field¹⁷.

In New Zealand, we find a Section 65 in the Patents Act (No. 64) of 1953 which refers to disputes arising between an employer and a person employed by him who has made a patentable invention during employment. In such a case, the Commissioner of Patents, or the court, may upon application determine the matter in dispute and apportion the benefits of the invention between the parties unless he is satisfied that one of the parties is entitled to the invention "to the exclusion of the other." This procedure corresponds to the British procedure under Section 56 of the Patents Act of 1949. The movement to repeal Section 56(2) in England¹⁸ might perhaps be followed in New Zealand.

In Canada the legal regulation of employees' inventions can be divided into two segments. The first segment concerns the largest employer in Canada, the Federal Government, and here there has been a special law ever since 1923. The Public Servants Invention Act (2-3 Elisabeth II, Chapter 40) of 1954 subordinates the rights of any person employed in a department, including a member of the Canadian Forces or the Royal Canadian Mounted Police Force, to the far-reaching rights vested in "Her Majesty in right of Canada." For the remainder of Canadian employers and employees, the common law of Canada applies in close parallels to the English common law. The dualism of regulation in Canada, in contrast to the United Kingdom system, is hard to explain. There was an excellent and provocative paper on the subject by the Canadian experts, Curphey and Kirby, in 1969¹⁹; but the Economic Council of Canada, in its official report of January 1971²⁰ studying and advising the Government on

¹⁵ See J. Stedman, "The Employed Inventor, The Public Interest, and Horse and Buggy Law in the Space Age," 45 *New York University Law Review*, No. 1, March 1970.

¹⁶ The question is extensively discussed in F. Neumeyer, *The Employed Inventor in the United States*, op. cit. 1971, Chapter 5 (Government Employer Invention Policy), pp. 207 ff.

¹⁷ The court decisions are naturally bound to the specific circumstances of the individual cases and their general validity is limited and subject to interpretation in Anglosaxon law.

¹⁸ See the Banks Report, op. cit. footnote 11, pp. 138 and 139.

¹⁹ "The impotent Canadian, Can the Employee-Inventor be motivated?", 43rd Annual Meeting, Patent and Trademark Institute of Canada, Niagara Falls, October 1969, *Report of Proceedings*, pp. 144 ff.

²⁰ *Report on Intellectual and Industrial Property*, Ottawa, January 1971.

¹⁰ From a letter from the Confederation of March 23, 1970, to the Duttweiler Institute, Rüschlikon.

¹¹ *The British Patent System — Report of the Committee to Examine the Patent System and Patent Law*, July 1970, HMSO London, Cmnd 4407.

¹² In *McClurg v. Kingsland* (1843) 1 How. 202.

¹³ In *US v. Dubilier Condenser Corp.* (1933) 289 US 178.

¹⁴ See G. K. Koenig, "The Shop Right — Time for Limitation," *JPOS*, Vol. 49, No. 9 (1967), p. 658; F. Neumeyer, *The Employed Inventor in the United States, R & D Policies, Law and Practice*, MIT Press, Cambridge (Mass.) 1971.

all branches of industrial property rights, made no recommendations in this field. The question of appropriate incentives for employed creative individuals is left by the Report to the "large companies with major continuing research programs." In the case of any shortcomings in the practice of a "significant number of Canadian companies," the Report speaks of a possible adaptation to Canadian circumstances of provisions in the German special law²¹.

The Approach in Communist Systems

An express interest in the protection and stimulation of the employed inventor has always been shown by the Communist and Socialist Governments in Eastern Europe. Mr. Y. Maksarev, the Chairman of the State Committee for Inventions and Discoveries of the Soviet Union, has said that "the USSR was the first country to have legislation expressly providing for the material encouragement of authors of employees' inventions."²² Legal protection in the form of inventors' certificates was established for the first time, according to Soviet sources, by the Decree on Inventions of the RSFSR Council of People's Commissars, passed on June 30, 1919, and signed by Lenin²³.

The Soviet Statute on Discoveries, Inventions and Rationalization Proposals, adopted in 1959²⁴, did not provide for employees' inventions as a special category. In principle, of course, there was no need for this. As Mr. Maksarev states, the Soviet Government considers "that where an invention was created in furtherance of research or the development of new technology within an enterprise or organization this fact coincided with the main direction of the development of technological progress in the country and should be encouraged."²⁵ In the last resort, there is only one employer of *all* working people in the Soviet Union — the State, which may be represented by various kinds of collectively-owned industries, government agencies, trade unions, scientific and educational academies and institutions and military units. And it is the State which is responsible for the material encouragement of inventors.

A distinguishing characteristic in Soviet law and administration is that the functions of granting legal protection to inventions, selecting the most important inventions and introducing them with priority into the national economy, are centralized in the State Committee for Inventions and Discoveries. In addition, the Committee is responsible for administering an elaborate system of remuneration for inventors who have received inventors' certificates.

Since the main form of legal protection for inventions in the Soviet Union, the inventor's certificate, was placed on an equal footing with the Western patent of invention in the

Stockholm Act of 1967 of the Paris Convention for the Protection of Industrial Property, one can to some extent make a comparison between the system of inventors' certificates and the systems in Western countries having special provisions on employees' inventions. The Soviet system is similar to these other systems in three important respects:

- (i) the name of the employed inventor is always mentioned, as the literal translation "author's certificate" clearly indicates;
- (ii) an employed inventor receives remuneration for his invention, both when a certificate is issued and when the invention is implemented;
- (iii) an employee has a right of appeal to the courts on invention questions.

At the same time, there remain, of course, basic differences due to the centralized planned economy, as applied by the Soviet State. There is, for this reason, no free use or sale of employees' inventions in the Soviet Union and no need for special provisions defining different categories of employees' inventions. However, the Chairman of the State Committee for Inventions and Discoveries has pointed out that "the absence of a clearly formulated concept of an employee's invention caused damage both to the national economy and to the human relations among the personnel of an organization" and a decision was adopted by the Committee in 1962 "expressly providing for certain rules concerning employees' inventions."²⁶

Practically all Eastern European Socialist countries have legal provisions expressly relating to employed inventors. They reflect the Soviet pattern of law, but show a number of individual variations. Legal regulations of this kind were adopted in the German Democratic Republic and Poland in 1950, in Romania in 1951, in Hungary in 1953, in Czechoslovakia in 1957, and in Bulgaria and Yugoslavia in 1961. Most of these national laws have subsequently had amendments²⁷.

The Employed Inventor as a Subject of Special Legislation

There are a number of countries where the property rights and the right to special compensation of employed inventors are recognized in special provisions with a motivation of a clear social character.

From a historical perspective, I have found one country which holds a pioneering position: the Austro-Hungarian Danube Empire. In the 1890s the Austrian Government, under Prime Minister Badeni and a number of aristocratic and clerical government members of Hungarian and Polish descent, showed an outspoken general interest in promoting the legal rights of the Austrian working class. The driving force behind this remarkable trend was the encyclical *De Rerum Novarum* issued by Pope Leo XIII on May 15, 1891, which inter alia exhorted employers to give workers a fair share in the results of their work. In consultation with the Christian labor unions, the Government issued a new Patent Law in January 1897

²⁶ Y. Maksarev, *op. cit.*, p. 286.

²⁷ See, for instance, the recent Hungarian Decree Concerning Fees to be Paid for Employee Inventions, published in *Industrial Property*, 1970, p. 320.

²¹ *Ibid.*, pp. 98 and 99.

²² Y. Maksarev, "The Role of Employees' Inventions in the USSR," *Industrial Property*, 1969, p. 285 at p. 286. There was however legislation emphasizing "material encouragement" of employed inventors as early as 1897 in Austria, 1910 in the Netherlands, and 1911 in Switzerland.

²³ See A. Dorkin and V. Ryasentsev, "The Inventor's Certificate," *Information Bulletin of the Soviet Group of IAPIP*, Moscow 1968, p. 9.

²⁴ The law, as amended on a number of occasions, is published in *Industrial Property*, 1967, p. 79.

²⁵ Y. Maksarev, *op. cit.*, p. 286.

which, for the first time, contained a kind of Magna Charta for the employed inventor, whether a "blue-collar" worker (*Arbeiter*), a "white-collar" worker (*Angestellter*) or a civil servant (*Staatsbedienter*). Section 5 of the Law, inter alia, made invalid contractual or other provisions which deprived an employee in an industrial enterprise (*Gewerbeunternehmung*) of the reasonable benefit of inventions made by him during employment. The government draft of the Law stressed the economic dependence of a person on his employer, referred to the "social regard" (*sozialpolitische Rücksichten*), as the basis for declaring exploiting provisions invalid, and added that the assigning of all employees' inventions to the employer would result in great hardship for the employee and paralyze zeal and inventive activity²⁸.

The countries having legal provisions on employees' inventions which followed most closely in time to those in the Austrian Law of 1897 were the Netherlands (Section 10 of the Patents Act) in 1910 and Switzerland (Section 343 of the Code of Obligations) in 1911. However, these provisions were not expressly based, as in Austria, on the employee's economic dependence, and the scope of the rights expressly accorded to employees was less wide.

If we leap forward in European history, we find that the powerful fascist and national socialist regimes which dominated large parts of Europe during the 1920s and 1930s had a marked influence on the general development of legislation on employed inventors. Both Mussolini and Hitler found it politic to win the sympathies of the working class by enacting a series of radical measures and laws which formally increased their position in the hierarchy of the dictatorial State. Workmen and engineers of all degrees were regarded as useful originators of engineering improvements to increase the industrial power of their nations. The application of this ideology became a tangible necessity when inventors in the two countries were urgently needed to develop efficient weapons before the imminent World War II, and the military chiefs of staff in Italy and Germany pressed for the preferential treatment of national inventors.

Remarkable legal provisions resulted from this in Italy in 1940 and in Germany in 1942, 1943 and 1944. In the two German ordinances of 1942 and 1943, the basic concept of service inventions of employees was created, and the principle of reasonable compensation was provided for. The legislation also reinforced the principle that legal provisions designed to protect the employee cannot be defeated by contract — the *Unabdingbarkeit* principle²⁹. This important principle (as well as the elaborate guidelines for calculating compensation issued in 1944) found its place, after the fall of the Third Reich, in Sections 22 and 23 of the present German Law on Employees' Inventions, 1957³⁰. The parliamentary explanatory commen-

tary relating to the Government's draft of the Law described the *Unabdingbarkeit* principle as the "pivot" of the entire Law and as being part of modern German labor law in general³¹. Moreover, Section 23 declares invalid agreements that are manifestly unreasonable (*"in erheblichem Masse unbillig"*). The official motivation for this is to counteract the disadvantages arising from the employee's dependent position³².

A country whose approach in this field is similar to that of the German legislature is Sweden. The reasons officially given for the adoption of the Law on the Rights in respect of Employees' Inventions of June 18, 1949, were partly because there were gaps in many employment contracts as to the legal relationship between employer and employee in regard to employees' inventions and the parties' respective rights and partly because of the need to safeguard certain essential rights of the weaker party to the contract — the employee³³.

Special laws on employees' inventions now exist in all Scandinavian countries. Following the Swedish law of 1949, they were enacted in Denmark in April 1955, in Finland in December 1967, and finally in Norway in April 1970³⁴. The main contents of these laws correspond very closely. Some differences are that the Danish law, in contrast to the other laws, does not provide for any special board to settle conflicts between employers and employees in the field, and the Norwegian law provides for a mediation tribunal empowered to mediate (*"mekle"*), whereas the Finnish and Swedish boards have power only to make non-binding guiding opinions³⁵. The ideological background of the four special laws, i.e., the criteria governing allocation of invention rights, and the basis for special compensation made to the inventor, are very much alike. An eventual extension of ownership rights of employers in certain cases was the subject of a government report in Sweden in 1964, but did not lead to any government action³⁶. Similar attempts for an extension of rights were made in Norway and led to complex inter-Scandinavian negotiations, but the final solution there adopted the original Swedish solution under which the ownership rights of employers were not extended beyond the provisions of Section 3 of the present Swedish law³⁷.

Origin of Employees' Inventions

With regard to the theory as to where an employee's invention originates and as to how such invention rights are acquired by the employer, three positions can be distinguished in Western legal systems. According to the majority of

²⁸ 1420 der Beilagen zu den stenographischen Protokollen des Abgeordnetenhauses, XI. Session 1896, cited in E. Alder, "Die österreichische Patentnovelle von 1925," *Zeitschrift für das Gesamte Handelsrecht Konkursrecht*, Stuttgart 1926, band 89, p. 118 at 120.

²⁹ The *Unabdingbarkeit* principle had been introduced by the first German collective bargaining agreement for professional employees, the "Chemist Collective Bargaining Agreement" of April 1920.

³⁰ A French translation of the Law is published in *La Propriété industrielle*, 1958, p. 21.

³¹ See Gesetz über Arbeitnehmererfindung, Textausgabe, Köln 1957, p. 219.

³² *Ibid.*, p. 164.

³³ See Statens Offentliga Utredningar 1946: 21, Justitiedepartementet, Stockholm 1946, p. 41.

³⁴ See p. 238 of this issue.

³⁵ An exact survey of the development of the law in Norway is given by Egil M. Hammel, in *Nordiskt Immateriellt Rättsskydd (NIR)*, No. 4, 1970, pp. 357 ff. "Norsk lov om retten til oppfinnelser som er gjort av arbeidstakere."

³⁶ Statens Offentliga Utredningar, Justitiedepartementet, *Rätten till Arbetstagaes Uppfinningar*, Stockholm 1964.

³⁷ For details, see the text of the talk referred to in the introductory footnote to the Study.

systems applicable for instance in Germany and Sweden, an invention always originates with one or more individuals and must, for acquisition purposes, be transferred to the employer by contract, either case by case or under a general service and employment contract. According to a second system, inventions made by an employee in the course of service activity are directly and by operation of law acquired by the employer, the so-called *originärer Erwerb* system, and ownership is not in any way derived through or acquired from the employee. This system is applicable in Switzerland³⁸. A third system is a mixed form of ownership, the so-called *copropriété* of an employee's invention resulting from the united efforts and resources of both parties aiming towards a common goal. This system is applied in France and Brazil.

Categories of Employees' Inventions

In addition, a majority of Western countries are well aware that employees' inventions can arise in practice under strongly varying conditions where the inventive performance and the share of creative work of an employee is shifting from nil to one hundred percent. As a matter of equity and social justice, different *categories of employees' inventions* have been introduced by legislators in many countries, having regard at least to the most common circumstances surrounding such inventions. Four different main groups of legally recognized approaches can be distinguished: one group of countries distinguishing *three* different categories of employees' inventions (for instance, Austria, Finland, Norway and Sweden), one group distinguishing *two* categories of employees' inventions (for instance, Denmark, Germany, Italy, Japan, Portugal and Switzerland), one group distinguishing a *single* category (for instance, Canada, Israel, Netherlands, United Kingdom and the United States of America) and one group recognizing no specific categories (the Soviet Union and the other Socialist countries)³⁹.

Other Legal Approaches Concerning the Employed Inventor

France and Switzerland

A way entirely on its own has been chosen by France. As is known, it was thanks to the French Revolution that the right of the individual to his own intellectual creations (including inventions) received its recognized place in society. The Marquis de Boufflers, in his report to the Committee of Agriculture and Commerce in 1790, set out the basis for a modern patent law giving full protection to the ideas of inventors and their right to the rewards flowing from a successful invention⁴⁰. It was Boufflers who said the proud

words: "C'est au propriétaire de cette idée à la faire valoir; il en a le droit, il ne lui faut plus que la sécurité. Protégez-le donc, et ne le payez point."⁴¹ In the years following the French Revolution, the problem of the employed inventor passed unnoticed. There has however been ample case law in France, since before the turn of the century, relating to employees' inventions.

The original concept created by the French courts, and not adopted in many other countries, is that of "joint ownership" (*copropriété indivise*). Under this concept, an invention made by an employee which is the result of common efforts and resources to reach a common end (*invention mixte*⁴²) becomes the joint property of employer and employee. In a famous case of 1943, this principle was extended to the relations between an employee and the French Government represented by the government owned car manufacturer, Renault⁴³. The French patent law contains a provision (Section 42) which, in the absence of contract, specifies the respective rights of the joint owners.

This principle is heavily opposed by leading French authorities. Inconveniences and dangers of *copropriété* have been referred to⁴⁴. In official debates in the French Senate concerning a Bill on employees' inventions in 1934, Senator Marcel Plaisant criticized the concept as being a "Nessus shirt" on the two parties, ill-fitting on patent rights and disturbing of contractual relations (the Bill contained a paragraph (33) providing that if an invention is expressly part of a contract, or results from working conditions it is the common property of the employee and the employer). A law was never enacted on the basis of this Bill. The concept has also been opposed on the ground that it deprives the inventor of part of the fruits of his discovery and is contrary to the spirit of patent law⁴⁵. The French courts however continue to apply the principle of common patent ownership⁴⁶.

In Switzerland some of the problems of the employed inventor were taken up in 1911, when they were the subject of a single section (s. 343) in the chapter on service contracts in the Code of Obligations, being a code of commercial law. As early as 1911 then, the Swiss Code provided for reasonable compensation to be paid to employed inventors, but only for inventions "of considerable economic importance." Corresponding regulations for Swiss civil servants were promulgated in 1927. In view of the absence of more specific legislation and the paucity of judicial decisions in this field, the works of Swiss legal authorities and commentators have an

⁴¹ "It is for the owner of the idea to make it pay; he has the right to do so and needs only the safeguards. Protect him then and pay him nothing." Appendix to the Procès-Verbal de l'Assemblée Nationale, Onzième Livraison, Tome XL, Paris 1791, p. 14.

⁴² Cour de Lyon, December 26, 1857; Cass. reg. December 1, 1858, Coquerel, S. 1859, 1, p. 763.

⁴³ Trib. civ. Seine 3^e Ch., June 17, 1943, *Magnin v. Soc. Anonyme des Usines Renault, Etat français intervenant*; Cour de Paris, 1^{re} Ch., May 20, 1947; see *La Propriété industrielle*, 1948, p. 76.

⁴⁴ Casalunga, *Traité technique et pratique des brevets d'invention*, Paris 1949, Tome premier, p. 399.

⁴⁵ Rouhier, *Le droit de la propriété industrielle*, Partie spéciale, III, p. 198.

⁴⁶ Common ownership is also provided for in the Brazilian Industrial Property Code (Article 51 of Decree-Law No. 1005, 1969) for employees' inventions which fall outside the employment contract but which are based on the employer's data, resources or installations.

³⁸ H. Truch, "Derivativer und originärer Erwerb der Arbeitnehmererfindung durch den Arbeitgeber im internationalen Privatrecht," in *Gewerblicher Rechtsschutz und Urheberrecht, Auslandsteil*, January 1961, pp. 14 ff.

³⁹ A basic collection of categories made by the author is found in AIPPI, *Annuaire* 1962, Nouvelle Série No. 12, 1^{re} partie, Rapport individuel Neumeyer, Suède, p. 379 at pp. 385 ff. A systematic survey of all categories recognized by law or court precedents in various countries will be worked out by the author.

⁴⁰ See F. Neumeyer, "A Contribution to the History of Modern Patent Legislation in the United States and in France," *Scandinavian Economic History Review*, Uppsala 1957, pp. 139 ff.

impact on interpretation of law and are often referred to by the courts.

Oser-Schönenberger, one of the basic commentators on the Swiss law of obligations, considers that the special provision referred to tries to find an equal balance between two groups of interests both of which have a natural tendency to consider inventive results as their exclusive property (this proposition is of course valid for most other countries). This commentator sees in the provision an implication that employees' inventions belong principally to the inventor and that the employer has a right to the inventions only exceptionally — in the two cases specified in the provision (where inventive activity forms part of the agreed services or where the employer has commissioned the invention) or by contractual agreement⁴⁷. The preference of the rights of the creative individual in the industrial property field over those of society are repeatedly emphasized by the leading Swiss jurist, Professor A. Troller⁴⁸. One earlier commentator had given warnings against a one-sided social view⁴⁹, and others have observed that inventions attributable to a single, individual employee rarely occur in modern industry in their pure form⁵⁰.

In 1967 the Swiss Bundesrat prepared a draft amendment to the relevant chapter in the Code of Obligations, including a draft for a new section (s. 332) on employees' inventions. In the explanatory note, the opinion is expressed that the correct place for the provisions concerned is within the framework of labor contract law. The note stresses, as being essential to Swiss patent law, that an invention is always the creative work of one or more individuals despite the fact that modern research laboratories work systematically with groups of inventors in order to produce inventions⁵¹. Taking, in addition, into regard the Swiss court decisions made in the field, I would like to characterize the Swiss legal approach as not uniform, but with a trend to a paternalistic attitude not unlike the British one.

Conclusion

This brief ideological survey of legislation on the employed inventor should serve to illustrate that the problem is an old one — and here I am thinking of the court decisions made in the beginning of the 19th century in France, the United Kingdom and the United States of America — and that the legislation in the various countries has been shaped over the years in different ways, independently of political system or size of country. There is now, it is submitted, a need for a considerably greater exchange of knowledge concerning national laws on the subject and of practical experi-

ence with them, as well as a need for greater uniformity. In this connection, one may also think of the multinational corporations that carry out research and manufacture in several different countries. They should be able to transfer without difficulty the benefit of the inventions made by their employees in one country to other countries — especially to the country of the parent corporation, where new machines, processes and devices are often planned on a centralized basis.

The aim, it is submitted, should not be to press too much for harmonization of the relevant national laws, but rather to try to assist countries with little or no experience to move towards a more uniform system of recognized legal principles in this field setting out the respective rights and obligations of employers and employees. The attainment of this far-reaching objective will make a substantial contribution to social and engineering progress in the industrial world.

Recent Statistics on Salaried Employees *

Country	Total civilian employees (in millions)	of which in industry (in millions)	Percentage
United States of America	76	25.8	34
Japan	50	17.5	35
Soviet Union	83.8 (?)	12.6 (?)	15
Germany (Federal Republic) . . .	25.9	12.5	48
United Kingdom	24.8	12.1	46.7
France	19.8	8.0	40.4
Italy	18.9	7.9	42
Czechoslovakia		2.4	
Sweden	3.8	1.56	41
Switzerland	2.7	1.41	52.2
Austria	3.2	1.29	40.3

Note: The figures printed in italics are only approximate.

Sources: For Czechoslovakia and the Soviet Union: OECD, *Statistics of the Occupational and Educational Structure of the Labour Force in 53 Countries*, Paris 1969. For the other countries listed: OECD *Observer*, Paris, February 1970.

* These statistics are for the year 1968, except in the case of Czechoslovakia and the Soviet Union, where they relate to 1962 and 1959 respectively.

The WIPO Design Model Law

Introduction

1. The importance of industrial designs in the modern world is undeniable. Everybody has to live with industrial products, which form part of his environment. In this context the design is a factor of individualization since it appeals to human taste and permits a personal choice. In addition, designs have also a great economic importance: the application of a good design often considerably augments the value of a product without causing a substantial increase in the cost of production.

2. The reasons for the legal protection of designs are twofold. In the first place, the design is considered as a creation of the human mind, for which the "designer" deserves remuneration. At the same time legal protection encourages the creation of industrial designs because manufacturers of articles whose value depends on a good design, for instance

⁴⁷ Oser-Schönenberger, *Das Obligationenrecht*, V. Band, 2. Teil, Zurich 1936, p. 1293.

⁴⁸ See, for instance, *Immaterialgüterrecht*, Band II, Basle 1962, Chapter 12, pp. 599 ff.

⁴⁹ Weidlich and Blum, *Schweizerisches Patentrecht*, I, Bern 1934, Note 287, p. 104.

⁵⁰ Blum and Pedrazzini, *Das Schweizerische Patentrecht*, Band I, Bern 1957, pp. 299 ff.

⁵¹ Botschaft des Bundesrates an die Bundesversammlung zum Entwurf eines Bundesgesetzes über die Revision des Zehnten Titels u. des Zehnten Titels bis des Obligationenrechts (Der Arbeitsvertrag) vom 25. August 1967.

furniture, will be interested in applying new designs in which they have an exclusive right, and they will make the necessary investment and employ talented designers, which they probably would not do if others could copy their designs and if they could copy the designs of others.

3. These considerations do not apply only to industrialized countries but also to developing countries which are on their way towards industrialization. Many articles which are manufactured in developing countries incorporate designs of high value, and a great number of such articles have special importance for the economy of the country because they are exported to other countries, for instance rugs and silks. Developing countries therefore have a special interest in an efficient design protection in order to remunerate the efforts of their designers and to encourage the production of high-quality articles.

4. With a view to facilitating the task of drafting a modern design law, which in many developing countries is still lacking, the United International Bureaux for the Protection of Intellectual Property (BIRPI) and its successor, the World Intellectual Property Organization (WIPO), have prepared a Model Law on this subject, the third in a series of Model Laws, the first dealing with inventions and the second with marks, trade names and unfair competition.

5. The procedure for the preparation of the Model Law on Industrial Designs was the same as in the case of the two previous Model Laws: the draft law, together with a draft commentary, was submitted to a Committee of Experts from Developing Countries. This Committee met in October 1969; 20 developing countries were represented: Algeria, Bolivia, Ceylon, Chile, Colombia, Congo (Democratic Republic), Costa Rica, Egypt, Ghana, India, Liberia, Mexico, Pakistan, Philippines, Sierra Leone, Sudan, Thailand, Tunisia, Uganda, Venezuela. Observers from the United Nations and other intergovernmental and international non-governmental organizations participated in the discussions of the Committee. Taking into account the views expressed by the Committee, BIRPI/WIPO prepared the final text of the Model Law on Industrial Designs, which — together with the Commentary — was published in English, French and Spanish between December 1970 and April 1971.

General Features of the Design Model Law

6. Being the third in a series of Model Laws, the Design Model Law naturally had to follow to a certain extent the provisions of the two other Model Laws so that the three texts form a systematic whole. Thus it will be possible for a country to adopt the three Model Laws without having the burden of harmonizing them. On the other hand, the countries interested in adopting the Model Laws are, of course, free to adapt the texts to their preferences and particular conditions. In doing so, they should however note that for systematic reasons a modification of one provision may necessitate changes in other provisions.

7. In its 39 sections, the Design Model Law regulates the principal aspects of design protection, such as the definition

of an industrial design and the conditions for its protection, the administrative procedure for registration of an industrial design, the scope of protection, license contracts and sanctions against infringement. Like the other Model Laws, however, this regulation is far from being complete. In particular, the Model Law does not contain specific provisions on the organization of the Office which registers industrial designs, the power to issue Rules, the entry into force of the Law and the situation during the transitional period, and does not specify the penal sanctions for infringement. All these questions will have to be considered by the legislators of the country interested in using the Model Law, and the answers to these questions will have to be given on the basis of the general constitutional and legal system of the country. Furthermore, certain procedural provisions contained in the Model Law, for instance concerning appeals against decisions of the Designs Office or proceedings for annulment of a registration, will probably have to be modified in view of the particular conditions of such country. In addition, the Rules which will need to be issued in order to complement the provisions of the Law¹ will have to take these conditions into account.

Definition of an Industrial Design

8. Section 2(1) defines an industrial design as "any composition of lines or colors or any three-dimensional form, ... provided that such composition or form gives a special appearance to a product of industry or handicraft or can serve as a pattern for [such a product]." The emphasis of this definition lies in the words "special appearance." This means that the design appeals to the eye. It is an aesthetic creation. Functional elements of a product cannot be protected under the design law. If, however, a functional element of a product constitutes at the same time an aesthetic creation, it could be protected as such under the design law, provided that the particular form is not necessary for a certain technical result (see Section 2(2)). If, for instance, the streamlined shape of an automobile combines aesthetic and aerodynamic functions, it could be protected as an industrial design only in so far as an equivalent technical result (aerodynamic behavior) could be reached by another shape.

9. As regards the purpose of a design, Section 2(2) makes clear that only designs which can serve as a pattern for the manufacture of a product of industry or handicraft are eligible for protection under the law of industrial designs. Thus, for instance, designs for the purposes of stage decoration or architecture are excluded; they may, however, be protected under copyright law (see below paragraph 10). On the other hand, it is irrelevant whether the product is manufactured by industry or handicraft or whether it is manufactured on a large or small scale. The inclusion of handicraft is particularly important for developing countries because a great number of their outstanding products incorporating high-quality designs (for instance, rugs) are manufactured by handicraft.

¹ See Section 39 of the Model Law.

Relationship to Copyright Law

10. As an aesthetic creation, an industrial design could also fall within the scope of copyright law. Should such a design be protected as copyright in addition to its protection under the law of industrial designs? Would the owner of such a design be free to decide which of the two forms of protection to seek? Or would he be restricted to the special protection under the law of industrial designs? These questions receive various answers in existing legislations. They are important particularly in view of the duration of protection: the law of industrial designs provides in general a term of ten to fifteen years, beginning with the filing of an application, while copyright protection in most countries expires only thirty or fifty years after the death of the author of the creation. The Model Law (Section 1(2)) solves this problem by a liberal approach: if a design fulfills the conditions of copyright law, it is in any case protected by that law. Thus it is possible to have a design simultaneously covered by both forms of protection, and even if copyright law is more advantageous in the term of protection given, there may still be an interest in filing an application for registration of the design with the Designs Office because registration facilitates proof of novelty, creates a legal presumption as to the applicant's ownership and confers an exclusive right which — in contrast to copyright — can be exercised to prevent not only imitations but also independent creations.

Novelty

11. Under Section 3 of the Model Law, designs which are not new or are contrary to public order or morality are not protected. Section 4 specifies what is meant by "new." A detailed definition is necessary because the word "new," in itself, could have various meanings, according to the person or persons concerned. From the point of view of the creator, a design is new if it is not an imitation of existing forms known to him. This kind of novelty is sometimes called "subjective novelty"; it corresponds to a large extent, if not completely, to originality in copyright law, and to the idea, recognized in copyright law, that a creator is protected even if the same creation had already been made by another person, unless the later creator was aware of the first creation. From the point of view of the general public, a design is only new if it differs from everything which was made available to the public before the filing of the application for registration of the design. This corresponds to a generally accepted definition of novelty in patent law, and one speaks therefore of a "patent approach" in contrast to a "copyright approach." The "patent approach," however, has a number of variations: the search for previous creations precluding novelty may be limited to creations made in the country where protection is sought or it may relate to creations made anywhere in the world; such a search may moreover be limited in time (not applying for instance to creations made more than fifty years before the application); it may also be limited in regard to the manner in which a previous creation was made available to the public (for instance, limitation to

previously registered designs). On the other hand, even if the "copyright approach" is adopted in principle, it could be formulated in a more objective way, considering everything of which the creator could have had knowledge, even if in reality he did not, as an obstacle to novelty.

12. All these various possibilities of defining novelty have to be carefully evaluated by legislators. The Model Law recommends in Section 4(2), following the views of the Committee of Experts (referred to in paragraph 5 above), the principle of absolute novelty, under which everything which has been made available to the public — no matter where, when or how — is excluded from protection by the law of industrial designs. This provision not only refers to previous industrial designs but includes all previously existing forms. The Committee of Experts was aware that this definition is only one of several possibilities, and the Commentary to the Model Law therefore also mentions other possibilities, in particular, limitations of absolute novelty in respect of time and/or space. On the other hand, it is evident that the principle of absolute novelty has the advantage that it creates clear situations on the market by avoiding coexistence of rights belonging to different persons but concerning the same creation. Moreover, subjective novelty is difficult to apply if the creator is an employee, in a case where the design automatically belongs to the employer as provided for in the Model Law, because then the inexperience of the employee would be to the employer's advantage.

13. In practice, the principle of absolute novelty will be attenuated by Section 4(1) of the Model Law, under which a regular application for registration of a design raises a presumption that the design was new at the time of the application. How far the principle of absolute novelty is applied in reality depends therefore on the knowledge of the adversary of the registered owner or — where an ex-officio examination is made before registration — on the knowledge of the Designs Office. On the other hand, it is in practice important that the Model Law in Section 4(4) excludes novelty where the previous creation is only slightly different or concerns another type of product. This extension of the concept of novelty is necessary in order to avoid close imitations; it furthermore takes into account that many designs could be used for various products (for instance, "pop" designs on furniture, household articles and clothing) and that the mere application of an existing design to a different product should not generally be protected as an exclusive right.

Ownership in Designs

14. The conflict between an applicant for registration and an earlier creator is solved in the Model Law by giving the better right to the applicant even if he created the design after the date of the first creation (Section 7(3)). An exception to this "first-to-file-system," however, applies in the case of usurpation, i. e., if the essential elements of a design have been obtained from the creation of another person without the consent of the rightful owner (Section 8).

15. Many industrial designs are created by employees or pursuant to a commission. For these cases, Section 9(1) of the Model Law provides a rule which applies in the absence of contractual provisions to the contrary according to which the design belongs to the person who has commissioned the work or to the employer. An employed designer should therefore ensure that, under the contract, his creative activity is rewarded. In any case, the creator of an industrial design has to be mentioned as such in the registration; this "moral right" of the creator may not be modified by contract (Section 10). If the creator of the design was not employed for this purpose but he used data or means that his employer had put at his disposal, the same subsidiary rule as in the case of the designer who was so employed applies, namely the design belongs to the employer; but the "occasional designer" will have to be remunerated for his creation by the employer (Section 9(2)). Of course, these provisions may be adapted by countries using the Model Law, taking into account the principles governing employment contracts in the particular country.

Registration Procedure

16. The third Chapter of the Model Law (Sections 11 to 18) is devoted to the registration procedure. Although appearing rather detailed, these provisions represent only a skeleton which will have to be complemented by the special Rules mentioned in Section 39.

17. Applications for registration are to be filed with the "Industrial Designs Office." This, however, does not mean that the Model Law requires registration of designs to be effected by a special Office: a branch of the Patent Office could be responsible. All applications are to be checked by the Office as to formal correctness, inoffensiveness (because the registration is published, the Office may not accept designs contrary to public order or morality) and payment of fees (Section 14). As regards the examination as to substance of the application, the Model Law provides in Section 15 three alternatives: registration without examination as to substance, examination on opposition, and ex-officio examination; there is still a fourth alternative in that the second and third alternatives can be combined. The Commentary explains in detail the advantages and disadvantages of each system. If, in addition to checking whether a given design falls within the definition laid down by the law and does not conflict with a prior right, the examining Office has to decide whether the design is new, the Office will have a great workload. This will be especially true if the principle of absolute novelty is adopted and in fact applied — undiluted — in the case of examinations carried out by the Office (see paragraph 12 above). Of course, no examination can be perfect. Even if the Office has found that the design is new, a court is still free to deny novelty. Moreover, the Model Law provides for a special procedure by which registration can be declared null and void (Sections 33 and 34).

18. If the examination — whatever its scope — leads to the conclusion that the application can be accepted, the Office records the design in a register which is open for public

inspection, issues a certificate of registration and publishes it in an official gazette (Sections 16 and 17). The Committee of Experts did not accept the possibility that an application might be made under sealed cover — a late publication of the registration in order to prevent early piracy — because such a system appeared too complicated and might lead to abuse. Thus, the public will always be fully informed about existing rights, and registered owners will be able to rely on the strong protection given by the law (see below paragraph 20).

Duration and Scope of Protection

19. Like many existing laws, the Model Law fixes the term of protection at five years, beginning with the date of application, which may be renewed for two consecutive five-year periods (Sections 19 and 20).

20. The exclusive right conferred by registration covers the reproduction of the design in the manufacture of a product, the importing, offering for sale and selling a product reproducing the protected design or the stocking of such a product for the purpose of sale (Section 21). The Model Law provides for a strong protection: "reproduction" does not require knowledge of the protected design; moreover, reproductions with minor differences and use of the design for a different kind of product fall within the scope of the exclusive right (Section 21(2)). The infringer has to face not only civil sanctions (injunction and damages) but also penal sanctions (Sections 35 and 36).

Assignment and Licenses

21. Applications for registration or registrations themselves of designs may be assigned (Section 23). Moreover, the registered owner may grant to another person a license to exploit the design (Section 25). In Chapter VII, the Model Law contains a detailed regulation of the obligations of licensor and licensee which applies in the absence of any provision to the contrary in the license contract.

22. Of special importance to developing countries are the provisions concerning invalid clauses in license contracts (Section 26) and license contracts involving payments abroad (Section 30). Under Section 26, clauses in license contracts or relating to such contracts are null and void in so far as they impose upon the licensee restrictions not deriving from the rights conferred by registration of the industrial design or unnecessary for the safeguarding of these rights. This provision may not be modified by contract. It prevents the licensor from using his economic power to obtain, in return for the license, more than what is economically reasonable: an undertaking by the licensee, for instance, to buy raw material or machines for the manufacture of the products incorporating the design only from the licensor. The special provision on payments abroad (Section 30) enables the country adopting the Model Law to control the payment of royalties by foreign licensors, in order to protect the country against excessive foreign influence and to safeguard the balance of payments. The scope of application of these two provisions could be extended also to assignments.

International Design Protection

23. The Model Law does not contain a complete regulation of all questions regarding the protection of designs created by foreigners or belonging to foreign enterprises. For the case where a country is a member of an international convention dealing with these questions (the Paris Convention for the Protection of Industrial Property, for instance, or the Hague Agreement Concerning the International Deposit of Industrial Designs), Section 5 simply says that such conventions apply. As the Commentary explains, it depends on the constitutional system of each country, whether such provision is necessary at all, and, if it is, whether it is sufficient or whether the contents of the international convention concerned have to be reproduced in the law. With regard to foreigners who

cannot invoke an international convention, Section 6 in principle assimilates them to nationals but allows the application of the law to be suspended where adequate reciprocity is not granted in the foreign country.

Conclusion

24. The features of the Model Law that have been described give only a broad picture of its contents. The main purpose of the texts published by WIPO is to give an example of design legislation which is simple and modern and which meets the needs of developing countries. It is understood, however, that the texts will require adaptation in each country, and WIPO is prepared to assist countries in this task.

LETTERS FROM CORRESPONDENTS

Letter from Scandinavia

By Berndt GODENHJELM

At the time of my last Letter from Scandinavia*, the new Scandinavian Patents Acts of 1967 had been in force for only a short time. They were a product of long preparation, and one of the reasons for the joint efforts in this field was the difficulty of the Patent Offices in the Scandinavian countries — as in many others — to solve the problems caused by the increasing number of patent applications. The solution conceived was a system of so-called Nordic patent applications, under which the Patent Office in one Nordic country had the power to grant patents for the same invention which would be valid for the other Scandinavian countries. This was an interesting approach to the problem, but although the system was embodied in the four Patents Acts, it seems clear that it will never receive the necessary implementing measures. It is however of substantial interest in international discussions of the matter. Since the idea of Nordic patent applications was accepted in the Scandinavian laws, there has been a further evolution in the international field which will probably also affect the situation in the Scandinavian countries. However, I will not try to look into the future but report on facts that have occurred in our countries during the past years.

PATENTS

1. In connection with the new legislation on patents, the question of common rules relating to employees' inventions was raised¹. State Committees with the task of reviewing

the matter were set up in Denmark, Finland, Norway and Sweden.

In Finland, a new Act on employees' inventions was necessary, as the Finnish Patents Act of 1943 contained provisions on the subject, but this was not the case with the common Scandinavian Patents Acts of 1967. There were moreover no statutory provisions on the matter in Norwegian law, the relations between employer and employee regarding inventions made by the latter being largely regulated by collective agreements. The Committees worked in close cooperation and the provisions proposed in their reports were very similar. If the proposals had been implemented, the law on employees' inventions in the four countries would have been harmonized to a large extent. Unfortunately the interested circles in Sweden did not wish to change the existing law, which contains rules heavily in favor of the employee, although in practice those rules were set aside in collective agreements giving the employer considerably more than his statutory rights. Sweden therefore did not change its Act of 1949 and Denmark took the same position with regard to its Act of 1953. The Danish Act is based on the Swedish one, but there are considerable differences especially with regard to the employer's rights.

However the Bills presented to the Parliaments of Finland and Norway were to a very large extent harmonized. Both Bills dealt with the employer's rights in the same way — by dividing employees' inventions into three categories.

The first category covered inventions made in the course of employment or essentially attributable to the facilities in the employer's enterprise or to the experience gained there. The employer was entitled to acquire full ownership over inventions in this category provided that they fell within

* *Industrial Property*, 1969, p. 281.

¹ On employees' inventions in general, see Fredrik Neumeyer, "The Employed Inventor as Subject of Legislation," on p. 243 above.

his field of activity (this proviso did not apply if the invention had resulted from a special charge undertaken by the employee). The employer had the option of acquiring all rights in the invention or only a license to work it. The Finnish and Norwegian Bills thus gave the employer considerably more rights than the Swedish Act, which allows the employer to acquire ownership of the invention only when it results from a distinct charge given to the employee.

The second category covered inventions which were made in any other connection with the employment. Here, the employer was entitled to a license to work the invention in his enterprise, again provided that the invention fell within his field of activities. In addition, he had the right applicable in relation to the third category of inventions.

The third category (for which there are corresponding provisions in the Swedish Act) covered inventions made without any connection with the employment but falling within the employer's activities. In this case the employer had a right of priority to negotiate with the employee inventor concerning the rights he wished to acquire in the invention. This right of priority was not however enforceable in the courts. If the parties did not reach agreement within the time limit prescribed, the employee was entitled to the full disposal of his invention, subject to the license in respect of inventions falling into the second category.

The proposed provisions were not intended to be absolute and agreements between the parties with respect to the scope of the employer's rights would have been permissible.

The Finnish Parliament passed the Bill without changes. The new Act came into force on the same day as the new Patents Act — January 1, 1968. In Norway, however, the circles representing employees became more and more opposed to the provisions regarding the scope of the employer's rights. An amendment was accordingly made to the Bill during the parliamentary debates, and the provisions on the employer's rights were modeled on the corresponding Swedish provisions. The Act was finally passed in this form on April 17, 1970². Thus although the Norwegian Act divides employees' inventions into three categories, it gives the employer considerably more limited rights than the Finnish Act. Under the Norwegian and Swedish Acts, the employer is entitled to full ownership over an employee's invention only in very special circumstances. Collective agreements in favor of the employer are thus rather common.

An important aspect of all the Scandinavian Acts on employees' inventions is that the employee is in principle always entitled to remuneration in compensation for the rights acquired by the employer. This right cannot in law be waived before an invention is made and any agreement to that effect is unenforceable.

Both the Finnish and the Norwegian Acts contain provisions on an arbitration body for settling disputes between an employer and employee. The Finnish board however can only give recommendations as to the settlement. The board

was established with effect from the beginning of 1970 and a number of cases have already been submitted to it, which shows the need for such a board.

2. I referred in my last Letter to the problem of the scope of protection of patents under the new Scandinavian Acts³, which provide that the scope of protection is determined by the claims. The earlier Finnish Patents Act of 1943 already contained a provision in that respect. It has therefore been of great interest to see how the courts interpret the provision on the scope of protection. Another question of interest has been the extent to which the new provision in, for instance, the Swedish Act has influenced the courts in deciding cases where the act of infringement had occurred when the earlier law was in force. Should a more restricted interpretation be adopted — to the disadvantage of the patentee? Or should the courts follow a broader interpretation and include, for instance, within the scope of protection of the patented invention the use of equivalents? The doctrine of equivalents had already been applied in earlier cases in Finland and Sweden.

Unfortunately the Scandinavian Patent Committee Report⁴ does not enter very deeply into the problem of claim interpretation. Nor is there any mention of the use of equivalents, although there can be no real patent protection unless there is provision for the prevention of a slight alteration of the elements as described in the patent. It should be emphasized that the explanatory note to the Bills for the new legislation contained an express reference to the idea that the scope of protection is nowadays determined by the claims. This must mean that the proposed rule was in conformity with the current opinion on the interpretation of claims.

In two recent cases, the Supreme Courts of Finland and Sweden have held that patent infringement had been committed even though in both cases there were noticeable differences between the defendant's machine and the machines described in the patent.

The Finnish case⁵, concerned a patent relating to a cultivator, characterized by the combination of a number of parts which were all individually known before the date of the patent application. The defendant had produced and sold two successive types of cultivator: the first type differed slightly from the plaintiff's machine; the second differed in particular with respect to certain details carefully described in the claims of the plaintiff's patent. The defendant argued that there could in no case be infringement in regard to his second type of cultivator, since it had been held in earlier cases that a patent for a combination should be interpreted strictly. In relation to the first type the defendant's arguments were not very strong. Before giving its decision, the Supreme Court sought the opinion of the Patent Office, which — unexpectedly — regarded both the defendant's combinations as infringing the patent. The Supreme Court accepted the

³ The Nordic Patent Laws were published in *Industrial Property*, 1968, p. 172.

⁴ Nordisk Utredningsserie 1963:6.

⁵ Judgment of March 16, 1970 (NIR 1971, p. 79).

² See p. 238 above.

Patent Office's opinion. It should be emphasized that the plaintiff's patent had only been granted after appeal to the Supreme Administrative Court; the Patent Office had held that the invention did not differ from earlier combinations in such a way as to constitute an inventive step.

The case was obviously decided on the basis of the earlier Finnish Patents Act, which — as mentioned — contained a provision similar to Section 39 of the new Scandinavian Patents Acts embodying the principle of the decisive significance of patent claims. The case is therefore of special interest in that it was decided after the entry into force of the new Acts. It shows — even if one disagrees with the decision in so far as it relates to the second type of cultivator — that the Court did not feel itself rigorously bound by what was stated in the claims. The explanatory notes to the Bills for the new patent legislation also emphasized that there was no question of a literal interpretation being adopted in this context.

In the Swedish case⁶, the plaintiff's patent concerned an excavator with a scoop wick was the subject of a detailed description in the claims including geometrical relationships. The court of first instance held that the defendant had not infringed the patent as he had not used tools having the characteristics expressly specified in the claims. The Court of Appeal however ignored the geometrical indications in the claims as such, treating them as guiding principles only, and took note of the functional significance of the elements mentioned in the claims. The defendant's excavator was thus found to fall within the scope of protection of the plaintiff's patent and the manufacture and use of the machine was held to infringe the patent. The defendant then asked the Supreme Court for leave to appeal, but the Court accepted the plaintiff's plea that the decision was in conformity with earlier cases. The Court of Appeal's decision thus acquired force of law.

Here again, the case was obviously decided on the basis of the former Swedish law, but in view of what was said in relation to the Bill for the new legislation the result would have been the same if Section 39 of the Patents Act, 1967, had been applied.

It will be interesting to see how the courts will decide the question when the act of infringement has taken place after the entry into force of the new patent legislation. As Section 39 of the Scandinavian Patents Acts is modeled on a provision in the European Convention on the Unification of Certain Points of Substantive Law on Patents for Invention, 1963, future decisions on the matter will be of greater interest on the comparative level.

TRADEMARKS AND TRADE NAMES

The Supreme Court of Norway has had to decide a case⁷ concerning the interpretation of Article 8 of the Paris Convention for the Protection of Industrial Property, with regard to its application in Norway. In 1959, a Swedish company with

the trade name of "Hennes" (meaning "Hers") which owned shops for ready-made ladies' clothing in several parts of Sweden purchased all the shares in a Norwegian company named "For Henne A/S" ("For Her, Inc.") and changed the company's name in 1960 to "Hennes A/S." This company was then the shareholder of daughter companies in different Norwegian towns, including Bergen. These companies, with the exception of one in Stavanger, had however not yet established shops. In 1965, the Swedish company also acquired the trademark *Hennes*.

Prior to the registration of "Hennes A/S" in Bergen, a Norwegian firm had registered its trade name "Hennes Magasin A/S" on August 31, 1964, and had opened a shop in Bergen on November 2, 1964, which sold, inter alia, ready-made ladies' clothing. The firm then sued "Hennes A/S" in Bergen requesting cancellation of its trade name on the basis that the plaintiff had a prior right to the word "Hennes" and that there was a likelihood of confusion between the two trade names. Referring to Article 8 of the Paris Convention, the defendant in a counterclaim argued that its name was also protected in Norway and had priority; it was therefore the plaintiff's trade name "Hennes Magasin A/S" which should be removed from the Register.

A preliminary point had to be decided by the Supreme Court concerning whether the defendant "Hennes A/S," being a company registered in Norway, was entitled to invoke Article 8 of the Paris Convention. The plaintiff argued that only the company established in Sweden was entitled to do so. The Supreme Court held that since the Swedish company owned all the shares in the defendant company, which in its turn owned all the shares in the daughter company in Bergen, the defendant was fully entitled to invoke Article 8.

On the question of the application of Article 8, the Court was of the opinion that although the trade name "Hennes" was not in very active use in Norway before 1965, Norway was obviously within the sphere of interest of the trade name, so that it was protected in Norway under Article 8 of the Paris Convention. The Court pointed out the legal problems relating to the application of that Article, but took no general position as to how they should be solved. For the present case, it was enough to state that the defendant's trade name was protected in Norway for the reason referred to. However, since the word "Hennes" ("Hers") was not of a distinctive character as used in the general language, the owner of the trade name "Hennes" could not claim an exclusive right to the word to the prejudice of any use that might be made of it in connection with trade names. The lower courts and the Supreme Court therefore held that the trade names "Hennes A/S" and "Hennes Magasin A/S" could coexist. The defendant's counterclaim was accordingly rejected.

The Court also dealt with the question of use of the word "Hennes" as a trademark. It held that the plaintiff was entitled to use the word only in a manner which did not conflict with the defendant's trade name. The plaintiff had used the word in advertisements for ready-made ladies' clothing. The counterclaim was thus in this respect successful.

⁶ Decided in April 1971 (No. SB 425).

⁷ Judgment of March 27, 1971 (L. No. 62/1971, No. 157/1970).

INDUSTRIAL DESIGNS

There has been an important achievement in the legislative field: the new Scandinavian industrial design Acts⁸. These laws are the result of close inter-Scandinavian cooperation and the harmonization realized is considerable.

Finland previously had had no industrial design legislation and its law on unfair competition, despite the general clause, gave little protection against such acts as piracy of designs. Sweden's legislation was of a limited scope, only protecting designs relating to metal goods⁹. Denmark and Norway, on the other hand, had laws containing a full set of rules governing protection of industrial designs, principally for ornamental purposes. The lack of design protection in Finland had, as one of its consequences, prevented Finland from ratifying the Lisbon Act of the Paris Convention. In the 1930s, Finnish industry was predominantly of the opinion that there was no need for design legislation. When Finland became an exporter of such articles as furniture, the need for statutory provisions on the matter became increasingly apparent, and I think Finnish industry is satisfied with the new Act, which came into force on April 1, 1970. On the first day of its entry into force, there were already a number of applications for protection. On the international level it should be noted that the Finnish authorities have interpreted the provision regarding priority of foreign applications in such a way as to prevent priority being claimed from a time prior to the entry into force of the Finnish Act¹⁰.

The right given by the Scandinavian Acts to the owner of an industrial design, which is described as exclusive, arises upon registration in the Patent Office. In principle, only a design which has not previously become known to the public may be registered. However, the Patent Offices do not make a full novelty search since, under the decrees implementing the new Acts, the examination is restricted to earlier registrations in the country concerned. A design may thus subsequently be found not to have been new and its registration declared null by the courts.

A design under the new Acts may be for either ornamental or practical use. Thus a pattern for a piece of furniture or a tool may be registered as an industrial design. But the Acts go even further by making it possible to register — in exceptional cases — an ornament only, such as a pattern for wallpaper, tapestry or cutlery.

The registration period is five years, which may be extended upon request for two further five-year periods, the fees for each further period being higher than the initial registration fee.

Because of the rapid development of the textile industry, it is thought that industrial design registrations in this branch will seldom occur. The branch has a large number of new designs each year and it would be burdensome to have them all registered especially since only a few of them will be actually used. Moreover, since applications are normally

available to the public, the industry is afraid that competitors will be informed too early of what is going on in the field. Although provision is made for secret applications, it is not certain whether this will satisfy the needs of the industry.

I shall end my Letter by mentioning that the Norwegian Committee set up to codify the civil law has, in its Report No. 8 on Mortgages, published in 1970, proposed provisions concerning the mortgage of intellectual property rights by way of registration. The proposed rules are modeled on those relating to the mortgage of industrial equipment. In this connection, I would recall that the Finnish Patents Act, 1967, unlike the corresponding Acts of the other Scandinavian countries, has a provision concerning the mortgage of patents by means of a note entered by the Patent Office in the Patent Register. The solution proposed in the Norwegian report is different. The mortgage of patents and trademarks would become legally binding by registration in connection with other industrial equipment in the ordinary register; it would not be possible for intellectual property rights to be mortgaged separately.

Letter from Lebanon

By Fuad S. SABA

Lebanon is a member of the Paris Union for the Protection of Industrial Property. It is also party to the Madrid Agreement (Indications of Source) and to the Nice Agreement (Classification of Goods and Services for the Registration of Marks). Lebanon's trademark and patent law is based on Order No. 2385, issued by the French High Commissioner on January 17, 1924¹ — before Lebanon had achieved complete political independence —, which was later amended by the Lebanese Law of January 31, 1946². As one might expect, Order No. 2385 was modeled on the French legislation relating to patents, industrial designs, trademarks, the temporary protection at exhibitions, unfair competition, infringement of industrial property rights and sanctions.

TRADEMARKS

Trademarks may be registered for a period of 15, 30, 45 or 60 years — at the option of the applicant. Fifteen years is the usual period of protection. Trademarks are defined by Section 68 of Order No. 2385 as:

"... names in a distinctive form; designations; emblems, seals, stamps and letters; prints, reliefs, vignettes, figures and, in general, all signs which in the interest of the consumer, manufacturer or retailer serve to distinguish the individuality and origin of merchandise or industrial, commercial, agricultural, forest or mining products."

Marks representing national or foreign decorations and words, pictures, signs or emblems which are seditious or contrary to public order or morals are not registrable (Section 71 of the Order).

⁸ See p. 223 above.

⁹ See C. Uggla, "The Swedish Design Protection Act," p. 241 above.

¹⁰ See Section 37 of the Finnish Registered Designs Decree, to be published in a later issue of this review.

¹ See *La Propriété industrielle*, 1941, p. 46.

² See *La Propriété industrielle*, 1946, p. 57.

Registration Procedure

No exclusive rights in a mark may be claimed until it has been duly filed at the Protection Office. The first applicant is entitled to registration, but the rights of prior users are recognized, provided that they produce documentary evidence of their right. The ownership of a mark which has been filed for more than five years may not be contested unless documentary evidence is given that the applicant was aware, at the time of filing, that the mark was already being used. No application for filing is accepted unless the prescribed fees are paid. If a period of protection exceeding fifteen years is desired, the applicant must expressly declare his wish and pay the relevant fee.

A trademark may be transferred on payment of a fee by succession, sale or assignment — gratuitously or for consideration and with or without the goodwill attached. A transferee has one month from the date of transfer in which to notify the Protection Office. If he lives abroad, he benefits from an extension of this period, ranging from one to four months according to the distance of the country concerned. An additional fee is payable for belated notifications of transfer. Foreigners wishing to file their mark are obliged to appoint an agent resident in Lebanon to carry out the formalities of filing.

The application is made to the Director of the Protection Office together with its attachments. After due consideration, the Director transmits the application, together with a detailed report, to the Minister of National Economy, who will then issue an Order, within fifteen days, declaring acceptance or refusal. An applicant may appeal against a refusal to the Conseil d'Etat, within thirty days from when the Order was notified to him.

When the formalities of filing have been completed, a certificate of filing is issued to the applicant, within fifteen full days from the date of entry of the application in the Register of the Protection Office. A printing block, of specified maximum dimensions, is kept at the Office for the purpose of advertising the accepted mark in the Official Gazette.

An application for renewal, on the expiry of the first period of protection, must be submitted in the same way as an application for an initial filing, together with all the attachments that were required for the original filing. A renewal fee is payable in advance — on pain of nullity of the application — according to a prescribed scale. When an application for renewal is accepted and duly registered at the Protection Office, a certificate of renewal is issued within fifteen days from the application date.

For the purpose of guaranteeing the quality of manufacture or origin of goods, provision is made for collective marks, which may be filed in the name of professional, regional, agricultural or industrial groups authorized by the State.

As can be seen, applications relating to trademarks are accepted and filed in Lebanon without any preliminary examination for identicalness or similarity. The publication of an

accepted trademark in the Official Gazette is the only way in which the public is made aware of the registration (or, more accurately, "filing") of the mark. Any disputes connected with the filing procedure, if not settled amicably, are decided by the Lebanese courts. There is at present no provision relating to multiple filing, opposition, appeal against the Office's decisions or amendment of the particulars of a mark entered in the Register.

The absence of provisions in these respects is to some extent a disadvantage, but it has not led to any serious litigation and, as far as the author is aware, there have been no specific proposals for a change in the law.

Legal Actions in Relation to Trademarks

Since Lebanon is not an advanced industrial country, there has not in any event been serious litigation in the trademark field. When a case does come before the courts, it is the subject of a thorough examination and equitable treatment. A recent case might be given as an example: in an action to restrain the defendant from using another person's registered trademark, the defendant contended that the mark was being used only as a trade name for his shop and not to designate the goods which were sold there. The Commercial Court of First Instance held that since the defendant's goods were similar to those covered by the registered mark, the use of the mark as a trade name was most likely to mislead the public. The Court awarded damages to the registered owner, declared the defendant's acts to amount to a crime and handed the case over to the Public Prosecutor for action. The defendant was furthermore ordered to destroy everything that bore the registered mark, whether goods, advertising material or signboards.

The relevant law on infringement and unfair competition in relation to marks is contained in the Criminal Code, which provides penalties not only for the direct use of another person's mark in the course of trade, in a manner that is likely to deceive a purchaser, but also for use of a mark which merely resembles the protected mark and is likely to mislead a purchaser. The question of falsification or imitation of a mark is, in the last resort, assessed by the courts — from the standpoint of the consumer or purchaser; when similarity is considered, the general resemblance of the marks, rather than partial differences, is taken into account.

Infringement proceedings are initiated in the courts by the Public Prosecutor either *ex officio* or upon the application of the injured party or the Director of the Protection Office.

PATENTS

Patents are granted for a period of fifteen years, starting from the date of application; patents of addition are granted for the unexpired term of the principal patent. Annual fees are payable from the application date. Patents may be issued to the inventor or successor in title, whether an individual, firm or legal entity. However, if a successor in title makes an application under the Paris Convention, a legalized instrument of transfer signed by the inventor must be produced. The

application must be filed before the invention is worked, or published in a manner allowing execution, in Lebanon or abroad. The twelve-month period of priority under the Paris Convention is provided for, however.

Applications are not subject to any examination as to novelty; but the following are not patentable in Lebanon: financial combinations, inventions contrary to public order or morality, and pharmaceutical formulae and compounds.

The rights in a patent, whether the property rights or the right of exploitation, may be assigned — gratuitously or for

consideration. To be effective against third parties, assignments must be notified to the Protection Office; for this, a period of grace of three months from the execution of the assignment instrument is allowed. There is no provision for the grant of compulsory licenses; but patents which are not worked in the two years following their issue are forfeited unless the patentee proves that he has endeavored to interest industrialists in the invention by means of direct offers and has not refused, without sufficient grounds, reasonable offers for licences.

BOOK REVIEWS

Van Belgisch naar Benelux Merkenrecht [From Belgian to Benelux Trademark Law], by *Marcel Gotzen*. F. Larcier N.V., Brussels, and Tjeenk Willink N.V., Zwolle, 1969. 309 pages.

The author was a member of an official working group entrusted with the preparation of the Benelux Convention and Uniform Law. This work is an excellent legal textbook and an invaluable manual for those interested in the new Benelux trademark system and its substitution for national trademark law.

It should first be pointed out that a distinction should be made between the Benelux Convention (which entered into force on July 1, 1969), which relates to international law, and the Uniform Law (which entered into force on January 1, 1971), which was introduced into the three national legislations concerned and which now replaces a number of provisions in the national laws. In the case of Belgium, the Uniform Law replaces provisions in several laws and royal decrees including the civil law provisions of the 1879 trademark law.

The different chapters of Mr. Gotzen's book discuss such matters as the scope of protection under the Uniform Law (service marks are not protected); the subdivision of trademarks into "individual" and collective marks; the kind of elements which qualify as trademarks (including a product's shape or packaging as well as surnames) and the conditions for their recognition as marks; the rules governing the right to be registered as the owner of a mark; the filing of a mark (which is fundamental to the new system); assignment and licensing (the Law comes down in favor of the free assignment and licensing of marks); civil and criminal proceedings, actions for a declaration of nullity and the grounds for the lapse of trademark rights (which are all given detailed study). The last chapter deals with the territorial jurisdiction of the courts, the recognition of the judgments of one Benelux country in the two others and the Benelux Court of Justice (not yet in operation), which will be responsible for the interpretation of the Uniform Law.

The work contains in addition a number of relevant basic texts.

H. A. W.

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Bereicherungsansprüche bei Warenzeichenverletzungen und unlauterem Wettbewerb [Unjust Enrichment Claims in Trademark Infringement and Unfair Competition Cases], by *Hartmut Haines*. Carl Heymanns Verlag K. G., Munich 1970. 168 pages.

This book deals with a special problem relating to the civil remedies against trademark infringement and acts of unfair competition in German

law. A plaintiff is often interested in obtaining not only an award of damages for loss he has sustained as a result of the tort but also an order under which the defendant must transfer to him the profit which he made from using the plaintiff's trademark or trade name etc. Since such profit may be greater than the trademark owner's loss, the question whether the plaintiff has a right to such an order is of high practical importance: German law, however, does not give a clear answer. The author thoroughly examines this problem, taking into particular account the concept of unjust enrichment.

L. B.

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The Employed Inventor in the United States — R & D * Policies, Law and Practice, by *Fredrik Neumeyer* with legal analysis by *John C. Stedman*. The MIT Press, Cambridge, Massachusetts, and London, England, 1971. 540 pages.

The importance of the employed inventor problem and the different solutions adopted have been described in the author's comparative ideological survey on page 243 of this review.

This is the first basic book, written by a leading authority in the field, on the legal and practical position of the employee as inventor in the United States. The dimensions of the subject can only really be felt by reading the introductory chapter, which describes the enormous amounts of money spent in the United States on research and development and the gigantic "inventive manpower" in the country working mainly in this field.

Chapter II of the book contains a succinct commentary by Professor Stedman of Wisconsin Law School on the legal position of the employer and employed inventor in the United States. In three separate chapters, Dr. Neumeyer then sets out twenty case studies on invention policy in (1) the industrial sector, (2) the government sector and (3) the university sector of the United States. Each chapter ends with a summary and evaluation of the position and with the author's suggestions for modernizing employee patent policy. A further chapter is concerned with collective bargaining agreements containing patent provisions.

One of the most interesting aspects of the book is its statistical information, which is illustrated by a large number of diagrams and tables.

D. D.

* These letters stand for "Research and Development."

Selection of New Publications

- AGHINA (Giorgio). *La utilizzazione atipica del marchio altrui*. Milan, A. Giuffrè, 1971. - 214 p.
- BERGIER (Jacques). *L'espionnage scientifique*. Paris, Hachette, 1971 - 253 p.
- CALLMANN (Rudolf). *The Law of Unfair Competition, Trademarks and Monopolies*. Mundelein (Illinois), Callaghan, 1967-1970. - 5 vol. + Index.
- COMMITTEE FOR INVENTIONS AND DISCOVERIES ATTACHED TO THE COUNCIL OF MINISTERS OF THE USSR. *Ekspperimental'naya sistema anglo-russkogo avtomaticheskogo perevoda patentnoi dokumentatsii*. Moscow, TSNIPI, 1970. - 132 p.
- ECONOMIC COUNCIL OF CANADA. *Report on Intellectual and Industrial Property*. Ottawa, Economic Council of Canada, 1971. - 236 p.
- EYER (Eckhardt). *Warenzeichenrecht, eine rechtssystematische Darstellung*. Munich, Wila, 1970. - 418 p.

- HUBER (Hugo Eugen). *Vergleichender Warentest und unlauterer Wettbewerb*. Zurich, Schulthess, 1970. - 123 p.
- INTERNATIONAL ASSOCIATION FOR THE PROTECTION OF INDUSTRIAL PROPERTY. HUNGARIAN GROUP. *Correlation between the Protection of Industrial Property and Industrial Development*. Budapest, IAPIP, 1970. - 319 p.
- MAX PLANCK INSTITUTE. *Gewerblicher Rechtsschutz und Urheberrecht, Internationalen Teil*. Vol. 4, April 1971 (issue devoted to the Washington Diplomatic Conference on the Patent Cooperation Treaty, 1970, containing inter alia the texts of the PCT and Regulations in German, English and French).
- MOUREAUX (R.) & WEISMANN (C.). *Les brevets d'invention*. Paris, Dalloz, 1971. - 591 p.
- REMOUCHAMPS (L.). *Octrooien*. Brussels, F. Larcier N. V., 1969. - 331 p.
- RIPPE (Sieghert). *La concurrencia desleal*. Montevideo, A. M. Fernandez, 1970. - 181 p.

CALENDAR

WIPO Meetings

October 4 to 11, 1971 (Geneva) — Committee of Experts on the International Registration of Marks

Object: Preparation of the Revision of the Madrid Agreement or of the Conclusion of a New Treaty — *Invitations:* Member countries of the Paris Union and organizations concerned

October 12 to 15, 1971 (Geneva) — ICIREPAT — Technical Committee for Computerization

October 13 to 15, 1971 (Geneva) — ICIREPAT — Advisory Board for Cooperative Systems

October 18 to 22, 1971 (Geneva) — ICIREPAT — Technical Committee for Shared Systems

October 18 to 29, 1971 (Geneva) — International Conference of States (Diplomatic Conference) on the Protection of Phonograms

Note: Meeting convened jointly with Unesco

October 25 to 29, 1971 (The Hague) — International Patent Classification (IPC) — Working Group V of the Joint ad hoc Committee *

October 25 to 29, 1971 (Geneva) — ICIREPAT — Technical Committee for Standardization

November 1 and 2, 1971 (Geneva) — Intergovernmental Committee Established by the Rome Convention (Neighboring Rights) (3rd Session)

Object: Consideration of various questions concerning neighboring rights — *Invitations:* Brazil, Denmark, Germany (Fed. Rep.), Mexico, Niger, United Kingdom — *Observers:* Costa Rica, Czechoslovakia, Ecuador, Paraguay, People's Republic of the Congo, Sweden; intergovernmental and international non-governmental organizations concerned — *Note:* Meeting convened jointly with the International Labour Office and Unesco

November 3 to 6, 1971 (Geneva) — Executive Committee of the Berne Union — Extraordinary Session

Object: Consideration of various questions concerning copyright — *Invitations:* Canada, Congo, France, Germany (Fed. Rep.), India, Italy, Mexico, Pakistan, Philippines, Poland, Romania, Spain, Switzerland, Tunisia, United Kingdom — *Observers:* All other member countries of the Berne Union; intergovernmental and international non-governmental organizations concerned

November 9 to 12, 1971 (Geneva) — International Patent Classification (IPC) — Bureau of the Joint ad hoc Committee *

November 15 to 18, 1971 (Geneva) — International Patent Classification (IPC) — Joint ad hoc Committee *

November 22 to 26, 1971 (Geneva) — Committee of Experts for the International Classification of the Figurative Elements of Marks

Invitations: Member countries of the Nice Union — *Observers:* Member countries of the Paris Union and international organizations concerned

November 24 to 27, 1971 (Bogotá) — Bogotá Symposium on Patents, Trademarks and Copyright

Object: Discussion of questions of special interest to the countries invited — *Invitations:* Argentina, Bolivia, Brazil, Chile, Colombia, Ecuador, Mexico, Paraguay, Peru, Uruguay, Venezuela — *Observers:* Intergovernmental and international non-governmental organizations concerned — *Note:* Meeting convened in agreement with the Colombian Government

* Meeting convened jointly with the Council of Europe.

December 6 to 8, 1971 (Geneva) — Patent Cooperation Treaty (PCT) — Interim Advisory Committee for Administrative Questions

Members: Signatory States of the PCT

December 8 to 11, 1971 (Geneva) — Patent Cooperation Treaty (PCT) — Standing Subcommittee of the Interim Committee for Technical Cooperation

Members: Austria, Germany (Fed. Rep.), Japan, Soviet Union, Sweden, United Kingdom, United States of America, International Patent Institute
— *Observers:* Brazil; intergovernmental and international non-governmental organizations concerned

December 13 to 18, 1971 (Cairo) — Arab Seminar on Treaties Concerning Industrial Property

Object: Discussion on the principal multilateral treaties on industrial property and the WIPO Convention — *Invitations:* States members of the Arab League — *Observers:* Intergovernmental and international non-governmental organizations concerned — *Note:* Meeting convened jointly with the Industrial Development Centre for Arab States (IDCAS)

January 10 to 12, 1972 (Geneva) — ICIREPAT — Technical Coordination Committee

March 13 to 17, 1972 (Geneva) — Committee of Experts on the Protection of Type Faces

September 25 to 30, 1972 (Geneva) — Coordination Committee of WIPO, Executive Committees of the Paris and Berne Unions

May 7 to June 2, 1973 (Vienna) — Diplomatic Conference on the International Registration of Marks

UPOV Meeting

October 14 and 15, 1971 (Geneva) — Council

Meetings of Other International Organizations Concerned with Intellectual Property

October 4 to 9, 1971 (Paris) — Unesco — Conference on Scientific Information Systems

October 10 to 17, 1971 (Kuwait) — Industrial Development Centre for Arab States — Arab Symposium on Industrial Development

November 3 to 6, 1971 (Geneva) — Unesco — Intergovernmental Copyright Committee

December 13 to 16, 1971 (Brussels) — International Association for the Protection of Industrial Property — Council of Presidents

April 24 to 28, 1972 (Dubrovnik) — *idem* — Council of Presidents

November 12 to 18, 1972 (Mexico) — *idem* — Congress

International Conference for the Setting Up of a European System for the Grant of Patents (Luxembourg):

October 11 to 22, 1971 — Working Party I

November 15 to 19, 1971 — Working Party I

November 29 to December 3, 1971 — Working Party II
