Industrial Property

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Contents

WORLD INTELLECTUAL PROPERTY ORGANIZATION

WIPO Convention

Ratification

NORWAY

The Government of Norway deposited on March 8, 1974 its instrument of ratification of the Convention Establishing the World Intellectual Property Organization (WIPO).

Norway has fulfilled the conditions set forth in Article 14(2) of the Convention by concurrently ratifying the Stockholm Act of the Paris Convention in its entirety and the Paris Act (1971) of the Berne Convention, as provided for in Article 29bis of the Paris Act, with the declaration provided for in Article 28(1)*(b)* to the effect that the ratification shall not apply to Articles 1 to 21 and to the Appendix.

Pursuant to Article 15(2), the WIPO Convention will enter into force with respect to Norway on June 8, 1974.

WIPO Notification No. 52, of March 13, 1974.

INTERNATIONAL UNIONS

Paris Convention

Ratification of the Stockholm Act

NORWAY

The Government of Norway deposited on March 8, 1974 its instrument of ratification of the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Stockholm on July 14, 1967.

Pursuant to Article 20(2)*(c)* and (3), the Stockholm Act of the Paris Convention will enter into force with respect to Norway on June 13, 1974.

Paris Notification No. 50, of March 13, 1974.

Nice Agreement

Ratification of the Stockholm Act

NORWAY

The Government of Norway deposited on March 8, 1974 its instrument of ratification of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957, as revised at Stockholm on July 14, 1967.

Pursuant to Article 9(4)*(b)*, the Stockholm Act of the Nice Agreement will enter into force with respect to Norway on June 13, 1974.

Nice Notification No. 27, of March 13, 1974.

WIPO MEETINGS

WIPO Permanent Legal-Technical Program
for the Acquisition by Developing Countries of Technology Related to Industrial Property

Permanent Committee
First Session

(Geneva, March 18 to 22, 1974)

Note *

The WIPO Conference at its second session (Geneva, November 19 to 27, 1973) adopted [1] a resolution establishing the WIPO Permanent Legal-Technical Program for the Acquisition by Developing Countries of Technology Related to Industrial Property (the "Permanent Program"). The Organizational Rules of the Permanent Program, which formed part of the said resolution, provide for the establishment of a Permanent Committee, which shall keep the Permanent Program under review and shall make recommendations to the Conference, and, between sessions of the Conference, to the Coordination Committee. The Permanent Committee consists of all States members of WIPO (and, until 1976, of all States members of the Paris Union) which inform the Director General of their desire to be members. The Permanent Committee held its first session in Geneva from March 18 to 22, 1974.

The following States declared, before or during the session, their desire to be members: Algeria, Argentina, Austria, Brazil, Chile, Congo, Cuba, Czechoslovakia, Denmark, Egypt, Finland, France, Germany (Federal Republic of), Hungary, Israel, Italy, Ivory Coast, Japan, Jordan, Kenya, Malta, Mauritania, Mexico, Netherlands, Poland, Portugal, Romania, Senegal, Spain, Sri Lanka, Sudan, Sweden, Switzerland, Syrian Arab Republic, Togo, Tunisia, Turkey, United Kingdom, United States of America, Yugoslavia (40).

Thirty-seven of the member States were represented at the session; fifteen observer States were also represented, and six intergovernmental and seven international non-governmental organizations were represented by observers. A list of participants follows this Note.

The Permanent Committee elected Mr. G. E. Larrea Richerand (Mexico) Chairman, and Mr. A. Ringl (Czechoslovakia) and Mr. H. J. Winter (United States of America) Vice-Chairmen. Mr. I. Thiam (Head, WIPO Conference Affairs Section) acted as Secretary of the Permanent Committee.

After an extensive general discussion, the Permanent Committee considered the program and budget of the Permanent Program for 1974 to 1976 and the question of the financing of the Permanent Program from 1975, on the basis of a working document prepared by the International Bureau; it decided to make the following recommendations:

Training in matters of licensing: the International Bureau should hold a licensing seminar in 1974 with the objective of discussing what points prospective licensees should look out for in negotiating contracts concerning licenses for the use of technology protected by industrial property when the prospective licensee is the government of a developing country or a firm in such a country; all developing countries members of the Committee should be invited to send participants.

Model provisions for national industrial property laws: the revision of the BIRPI Model Law for developing countries on inventions and know-how should be carried out in the framework of the Permanent Committee's activities; as a first step, the International Bureau should convene in 1974 a working group consisting of experts from eight to ten developing and five or six developed countries members of the Permanent Committee; at its first meeting, the Working Group should give the highest priority to the provisions on special kinds of patents (see below), the provisions dealing with licensing contracts and those concerned with know-how.

Training in access to patent documentation: the International Bureau should, by paying their expenses, facilitate the participation of persons from a certain number of developing countries members of the Permanent Committee in the Moscow Symposium of October 7 to 11, 1974, on the Role of Patent Information in Research and Development.

Publication of licensing opportunities: a questionnaire should promptly be sent to all developing countries asking them to indicate those sectors of technology in which they would be the most interested to see the publication of a periodical on licensing opportunities start; depending on the replies received, work on such a periodical would continue in 1975.

The Permanent Committee also considered a draft questionnaire on *special types of patents*, which would be sent to member countries in April 1975 with a time limit of five months for replying.

List of Participants *

I. Member States

Algeria: S. Bouzidi; L. Zebdji (Miss); G. Sellali (Mrs.). Argentina: R. A. Ramayón; C. Passalacqua. Austria: O. Leberl; T. Lorenz; G. Karsch. Brazil: A. G. Alencar. Chile: J. Lagos. Cuba: J. M. Rodríguez Padilla; H. Rivero Rosario. Czechoslovakia: A. Ringl; M. Kasaly. Denmark: N. E. Bech. Egypt:

* This Note has been prepared by the International Bureau.

[1] See *Industrial Property*, 1973, p. 370.

* A list containing the titles and functions of the participants may be obtained from the International Bureau.

A. A. Omar; S. A. Abou-Ali; I. Kamel. Finland: E. Wuori. France: J. Fernand-Laurent; P. Pietri; M. Sala; R. Labry; S. Balous (Mrs.). Germany (Federal Republic of): R. von Schleussner (Mrs.). Hungary: E. Tasnádi; G. Pálos. Israel: M. Gabay. Italy: G. Trotta; M. Vitali (Miss); G. Zagrebelsky. Ivory Coast: B. Nioupin; Y. Bakayoko; M. - L. Boa (Miss). Jordan: I. A. Zreikat; K. Hasa. Kenya: J. N. King'Arui. Malta: M. C. Cilia (Miss). Mexico: G. E. Larrea Richerand; J. Alvarez Soheranis; J. E. Gama Muñoz. Netherlands: J. Rottinghuis; W. Neervoort. Poland: A. Szajkowski; T. Antoniewicz; H. Wasilewska (Mrs.). Portugal: J. Mota Maia. Romania: V. Tudor. Senegal: J. P. Crespin. Spain: J. Delicado Montero-Ríos; A. Valles Copeiro del Villar. Sri Lanka: A. Pathmarajah. Sudan: M. O. I. Taha; A. Deng. Sweden: L. O. Assarsson; C. Sandgren. Switzerland: R. Kämpf; J. Mirimanoff-Chilikine; H. Stingelin. Syrian Arab Repuhlic: A. Jouman-Agha. Togo: C. Mathey. Tunisia: K. Gueblaoui. Turkey: A. Erman. United Kingdom: D. L. T. Cadman; O. M. O'Brien. United States of America: H. J. Winter; M. K. Kirk; J. M. Lightman; J. Sheehan; E. W. Lawrence. Yugoslavia: D. Ćemalović.

II. Observer States

Bolivia: V. Banzer López (Mrs.). Canada: A. Gariepy; W. H. Montgomery. Colomhia: A. Morales. Ecuador: W. Herrera. Gnatemala: C. A. Steiger-Tercero. Holy See: R. F. Roch. Iraq: A. M. Al-Khuhaisi. Kuwait: A.- H. Al-Awadhi. Libyan Arab Republic: O. Elfakih. Nicaragua: D. Sansón-Román; E. Lacayo (Mrs.). Saudi Arabia: M. Ahn-Alsamh. Soviet Union: L. A. Inosemtsev; A. S. Zaitsev; V. Mamot. Thailand: N. Snidvongs. Uruguay: R. Larreta de Pesaresi (Mrs.). Veneznela: F. Chalhand (Mrs.).

III. Intergovernmental Organizations

United Nations (UN): F. R. Brusick. United Nations Conference on Trade and Development (UNCTAD): S. J. Patel; P. Roffe; F. R. Fiallo. United Nations Indnstrial Development Organization (UNIDO): H. A. Janiszewski. Organization of African Unity (OAU): C. Egbunike. African and Malagasy Industrial Property Office (OAMPI): D. Ekani. Commission of the European Communities (CEC): H. Kronz.

IV. International Patent Documentation Center (INPADOC)

G. A. Rubitschka.

V. International Non-Governmental Organizations

Council of European Industrial Federations (CEIF): G. Albrechtskirchinger. European Federation of Agents of Industry in Industrial Property (FEMIPI): J.- M. Dopchie. International Association for the Protection of Industrial Property (AIPPI): H. Wichmann. International Chamber of Commerce (ICC): H. Aspden; R. Thompson. International Federation of Inventors' Associations (IFIA): H. Romanus. Licensing Executives Society (LES): Fl. Gevers. Union of Industries of the European Community (UNICE): G. Alhrechtskirchinger.

VI. Officers

Chairman: G. E. Larrea Richerand (Mexico); *Vice-Chairmen:* A. Ringl (Czechoslovakia); H. J. Winter (United States of America); *Secretary:* I. Thiam (WIPO).

VII. WIPO

A. Bogsch *(Director General)*; K. Pfanner *(Director, Industrial Property Division)*; R. Harben *(Counsellor, Acting Head, External and Public Relations Division)*; L. Baeumer *(Counsellor, Head, Legislation and Regional Agreements Section, Industrial Property Division)*; I. Thiam *(Counsellor, Head, WIPO Conference Affairs Section)*.

LEGISLATION

BELGIUM—LUXEMBOURG—NETHERLANDS

Benelux Designs Convention

(Brussels, October 25, 1966) *

Article 1

The High Contracting Parties shall incorporate into their national legislation the Uniform Benelux Designs Law, annexed to this Convention, in either one or both of the original texts, and shall establish an administrative office common to their countries under the name "Benelux Designs Office" *[Benelux-Bureau voor Tekeningen of Modellen* or *Bureau Benelux des dessins ou modèles]*.

Article 2

Implementation of the Uniform Law shall be ensured by way of Executive Rules, laid down by mutual agreement by the High Contracting Parties, upon consultation of the Executive Board, provided for in Article 3, of the Benelux Designs Office, and by way of Administrative Regulations laid down by the said Board.

The Rules and Regulations shall become binding in each country in conformity with the provisions of its domestic law.

The Rules and Regulations shall be published in the Official Journal of each of the High Contracting Parties.

Article 3

The Benelux Designs Office shall be entrusted with the implementation of the Uniform Law and the Rules and Regulations.

The Office shall be administered by an Executive Board composed of members appointed by the High Contracting Parties, namely one administrator and one deputy administrator per country.

The Executive Board shall annually elect its Chairman.

Article 4

The Executive Board shall regulate all matters incidental to the general operation of the Benelux Designs Office.

It shall establish the Rules of Practice and the Financial Regulations of the Office as well as the Administrative Regulations.

It shall advise on and make proposals for the Executive Rules.

It shall appoint the Director of the Office, who must be a national of one of the High Contracting Parties, and shall determine his duties.

It shall annually adopt the budget of income and expenditure, as well as any modifications thereof or additions thereto, and it shall specify, in the Financial Regulations, the manner in which superintendence of the budgets and the execution thereof shall be exercised. It shall approve the accounts drawn up by the Director.

The Board shall take decisions by a unanimous vote.

Article 5

Half of the cost of establishing the Benelux Designs Office shall be borne by the Kingdom of the Netherlands and the other half shall be borne by the Belgian-Luxembourg Economic Union.

The Executive Board may request the High Contracting Parties to make a contribution to cover extraordinary expenses; half of any such contribution shall be borne by the Kingdom of the Netherlands and the other half shall be borne by the Belgian-Luxembourg Economic Union.

Article 6

The operating expenses of the Office shall be defrayed out of its income, namely:

(1) the fees collected under the Uniform Law;

(2) the income accruing to the High Contracting Parties from the Hague Agreement Concerning the International Deposit of Industrial Designs, as signed on November 28, 1960;

(3) proceeds from the sale of publications and copies.

If necessary, the High Contracting Parties shall make a contribution to the Office; half of such contribution shall be borne by the Kingdom of the Netherlands and the other half shall be borne by the Belgian-Luxembourg Economic Union.

Article 7

A percentage of the fees collected in respect of operations performed through the intermediary of the national Offices shall be distributed to the said Offices to cover the costs which such operations entail; the said percentage shall be fixed in the Rules.

No national fees in respect of such operations may be prescribed by national legislation.

Article 8

The Benelux Designs Office shall be placed under the protection of the Government of the Kingdom of the Netherlands; its seat shall be at The Hague.

* The Benelux Trademark Convention was published in *Industrial Property*, 1969, p. 305.

Article 9

The authority of judicial decisions rendered in one of the three States pursuant to Article 15 of the Uniform Law shall be recognized in the two other States, and cancellation ordered by the competent courts of law shall, at the request of the first mover and under the responsibility of the Executive Board, be effected by the Office if:

(1) the transcript of the decision submitted meets, according to the laws of the country where such decision was made, the prescribed requirements as to authenticity;

(2) the decision is no longer open to opposition, appeal, or cassation proceedings.

Article 10

As soon as a Benelux Court of Justice has been established, it shall take cognizance of any questions of interpretation of the Uniform Law.

Article 11

Application of this Convention shall be confined to the territories of the High Contracting Parties in Europe.

Article 12

This Convention shall be subject to ratification. The instruments of ratification shall be deposited with the Government of the Kingdom of Belgium.

Article 13

This Convention shall enter into force on the first day of the month following the deposit of the third instrument of ratification [1].

The Uniform Law shall enter into force one year after the entry into force of this Convention.

Article 14

This Convention is entered into for a period of fifty years. It shall remain in force thereafter for successive periods of ten years, unless one of the High Contracting Parties, within one year prior to the expiration of a given period, notifies the other Contracting Parties of its intention to terminate the said Convention.

Any proposals for revision made after the expiration of a period of ten years from the entry into force of this Convention which have not secured the agreement of all of the High Contracting Parties shall be submitted to the Benelux Interparliamentary Advisory Council.

The right to denounce this Convention shall be conferred on the High Contracting Party on whose proposals for revision the Benelux Interparliamentary Advisory Council has expressed a favorable opinion with which the two other Contracting Parties, or one of them, do not concur. Such right must be exercised within a reasonable period of time.

Denunciation shall not take effect until five years have elapsed from the date of the notice thereof given to the two other Contracting Parties.

In witness whereof the Plenipotentiaries have signed this Convention and affixed their seals thereto.

Done in Brussels this 25th day of October 1966, in triplicate in the Dutch and French languages, both texts being equally authentic.

ANNEX [2]

Uniform Benelux Designs Law

CHAPTER I. — Designs

Article 1

The new appearance of a product having a utility function may be protected as a design.

Article 2

(1) Anything indispensable for the achievement of a technical result shall be outside the protection under this Law.

(2) The appearance of certain categories of products to which the application of the law would give rise to major difficulties may be permanently or temporarily excluded, by the Rules, from the protection under this Law.

Article 3

(1) Without prejudice to the right of priority under the Paris Convention for the Protection of Industrial Property, the exclusive right to a design shall be acquired by the first deposit made within Benelux territory and registered with the Benelux Designs Office (Benelux deposit), or registered with the International Bureau for the Protection of Industrial Property (international deposit).

(2) Where two or more deposits are made for the same design, if the first deposit is not followed by the publication provided for in Article 9(3) of this Law or in Article 6(3) of the Hague Agreement for the International Deposit of Industrial Designs, the succeeding deposit shall acquire the status of first deposit.

Article 4

A design deposit shall not be constitutive of an exclusive right where:

(1) the design is not new, that is, where:

(a) at any time during the fifty years preceding the date of deposit or the date of priority under the Paris Convention, a product identical in appearance with the deposited design or differing only in minor respects has enjoyed a de facto notoriety in the relevant industrial or commercial circles in Benelux territory;

(b) a design identical with the deposited design or differing only in minor respects has been the subject of an earlier

[1] In accordance with this provision, the Convention entered into force on January 1, 1974.

[2] In accordance with Article 13(2) of the Convention, the Uniform Law will enter into force on January 1, 1975.

deposit followed by the publication provided for in Article 9(3) of this Law or in Article 6(3) of the Hague Agreement;

(2) the design is contrary to morality or public order in one of the Benelux countries;

(3) the deposit does not sufficiently disclose the characteristics of the design.

Article 5

(1) During the five years following publication of a deposit, the creator of the design or the person deemed under Article 6 to be the creator may claim the Benelux deposit, or the rights in Benelux territory deriving from an international deposit, of that design if the deposit has been effected by a third party without the creator's consent; he may on the same ground and at any time invoke the nullity of the deposit or of the rights referred to. The action to claim the deposit or the rights shall be registered with the Benelux Office on the plaintiff's request, in the manner prescribed by the Rules and on payment of the fees fixed therein.

(2) If the applicant making the deposit, referred to in the preceding paragraph, has requested the total or partial cancellation of the Benelux deposit or has renounced the rights in Benelux territory deriving from the international deposit, such cancellation or renunciation shall, subject to paragraph (3), not be binding on the creator or the person deemed under Article 6 to be the creator, provided that the deposit has been claimed within one year from the date of publication of the cancellation or renunciation and before the expiration of the five-year period referred to above.

(3) If, during the interval between the cancellation or renunciation referred to in paragraph (2) and the registration of the action to claim the deposit or the rights, a third party, acting in good faith, has exploited a product identical in appearance, that product shall be considered to have been lawfully placed on the market.

Article 6

(1) Where a design has been created by a worker or employee in the course of his employment, the employer shall be deemed to be the creator, unless otherwise agreed.

(2) Where a design has been made pursuant to a commission, the person commissioning the design shall be deemed to be the creator, unless otherwise agreed, provided that the commission was made with a view to the commercial or industrial use of the product embodying the design.

Article 7

Subject to Article 5(2), the exclusive right to a design shall lapse:

(1) on the voluntary cancellation or expiration of the registration of the Benelux deposit;

(2) on the expiration of the registration of the international deposit, or the renunciation of the rights in Benelux territory deriving from an international deposit, or the ex-officio cancellation referred to in Article 6(4)*(c)* of the Hague Agreement.

Article 8

(1) Benelux design deposits shall be made either with the national Offices or with the Benelux Designs Office, in the manner prescribed by the Rules and on payment of the fees fixed therein. The deposits must include a photographic or graphic representation of the appearance of the product, and the means of reproduction used to make the representation; the deposits may, where applicable, also include a claim as to colors and a statement giving the name of the true creator of the design. The representation may be accompanied by a description of the characteristics of the design, within the limits to be determined by the Rules.

(2) Benelux deposits may include one or more designs (respectively, simple or multiple deposits) and shall be subject to the procedure and fees prescribed in the Rules.

(3) The authorities responsible for receiving deposits shall ascertain that the documents submitted meet the requirements as to form and shall draw up the instrument of deposit, indicating the date on which the deposit was effected and the existence of any color claim or description referred to in paragraph (1).

(4) A priority claim under Article 4 of the Paris Convention shall be made in the instrument of deposit or by way of a special declaration filed with the Benelux Office within the month following the deposit, in the manner prescribed in the Rules and on payment of the fees fixed therein. The absence of such a claim shall cause forfeiture of the right of priority.

Article 9

(1) Deposits of designs may not be the subject, as far as substance is concerned, of any examination giving rise to findings which could be held against the applicant by the Benelux Office, without prejudice, in the case of Benelux deposits, to the application of paragraph (3).

(2) The Benelux Office shall register without delay instruments of Benelux deposit and shall issue a certificate of registration to the proprietor; the Office shall also register publications of registered international deposits which have been published in the "International Design Gazette — Bulletin international des dessins ou modèles" where the applicants have requested an extension of their effects to Benelux territory.

The legal date of registration shall be that of the Benelux or of the international deposit.

Where priority is claimed, the registration shall state the date of priority and the basis therefor.

(3) The Benelux Office shall publish, as promptly as possible, registrations of Benelux deposits, in accordance with the Rules. Such publication shall include a representation of the product embodying the design and, where priority is claimed, the date of priority and the basis therefor as well as any color claim or description provided for in Article 8(1).

Publication shall be postponed if the applicant avails himself of the right provided for in Article 11 or if the Office feels that the design falls within Article 4(2). In the latter case the Office shall inform the applicant accordingly and shall invite him to withdraw his deposit within two months. If the applicant has not done so by the end of that period, the Office shall, as promptly as possible, invite the Public Prosecutor to institute an action for the nullity of the deposit. If the Public Prosecutor feels that there is no cause to institute such an action or if the action is dismissed by a court decision having force of law, the Office shall publish the registration of the design without delay.

(4) If the publication does not sufficiently disclose the characteristics of the design as rendered by the means of reproduction referred to in Article 8(1), the applicant may request the Office, within a period to be determined by the Rules, to make another publication without charge.

(5) As from the publication of the design, the public may inspect the registration and the documents submitted at the time of the deposit.

Article 10

International deposits shall be effected in conformity with the provisions of the Hague Agreement.

Article 11

At the time of a Benelux deposit, the applicant may request the postponement of publication of the registration for a period not exceeding twelve months from the date of deposit or, when the applicant has invoked Article 4 of the Paris Convention, from the date of the deposit which gave rise to the right of priority.

Article 12

(1) The registration of a Benelux deposit shall be for a term of five years counted from the date of deposit. The design covered by the deposit may not be modified either during the term of the registration or at the time of its renewal.

(2) The registration may be renewed for two successive terms of five years simply by payment of the renewal fee to the Benelux Office. The amount of the fee and the modes of payment shall be fixed in the Rules.

Payment must be made during the year preceding the expiration of the registration. Subject to payment of a surcharge fixed in the Rules, a period of grace of six months shall be allowed for renewals.

In all cases renewal shall take effect as from the expiration of the registration.

(3) Renewal may be limited to part only of the designs included in a multiple deposit.

(4) Six months prior to the expiration of the first and second terms of registration, the Benelux Office shall remind the proprietor of the design of the exact expiration date by notice sent to him at his residence or address for service and to third parties who claim rights in the design, insofar as their names appear in the Register.

(5) The Office shall dispatch the reminders to the last-known address of the parties concerned. Failure to dispatch or to receive such notices shall not exonerate the said parties from effecting the renewal within the prescribed time limits; no reliance can be placed on such failure either before the courts or before the Office.

(6) The Office shall record the renewals and publish them in accordance with the Rules.

Article 13

(1) The exclusive right to a design may be transferred or may be the subject of a license. The following shall be null and void:

(a) assignments inter vivos which are not evidenced in writing;

(b) assignments or other transfers which are not made for the entire Benelux territory.

(2) No limitation of a license, other than a restriction as to its duration, shall have any effect regarding the application of this Law.

(3) An assignment or other transfer or a license shall be binding on third parties only after an abstract of the instrument evidencing such transfer or license, or a statement relating thereto signed by the parties concerned, has been recorded in the manner prescribed in the Rules and on payment of the fees fixed therein.

(4) A licensee may, jointly with the proprietor of the deposit, claim compensation for any damage sustained by him as a result of the infringement of the exclusive right referred to in Article 14.

Article 14

(1) By virtue of his exclusive right to a design, the proprietor may prevent any of the following acts, performed for industrial or commercial purposes: the manufacture, importation, sale, offering for sale, hire, offering for hire, display, delivery or use, or the holding for any of these objects, of a product identical in appearance with the design as deposited or differing only in minor respects.

(2) A claim to compensation, by virtue of the exclusive right, for the acts listed in paragraph (1) may be made only where such acts are performed after the publication under Article 9, sufficiently disclosing the characteristics of the design, unless the person performing such acts was aware of the deposit's existence.

(3) The exclusive right to a design shall not however include the right to prevent any acts referred to in paragraph (1) performed in relation to products which have been brought into circulation in Benelux territory either by the proprietor or by any other person with his consent or by the persons referred to in Article 17.

(4) The action may not relate to products which have been brought into circulation in Benelux territory prior to the deposit.

(5) Acts which would only constitute infringement of a design may not be the subject of an action under the legislation against unfair competition.

Article 15

Any interested party, including the Public Prosecutor, may invoke the nullity of a Benelux deposit or of the rights in Benelux territory deriving from an international deposit where the deposit does not satisfy the requirements of Articles 1 and 2 or is not constitutive of a right to the design, pursuant to Article 4.

When the action for nullity is instituted by the Public Prosecutor, the courts of Brussels, The Hague and Luxembourg shall have exclusive jurisdiction. The institution of an action by the Public Prosecutor shall stay any other suit instituted on the same grounds.

Article 16

The civil courts shall have exclusive competence to give judgment in proceedings based on this Law; they shall ex officio order the cancellation of registrations of deposits declared null and void.

Article 17

(1) A right of personal possession, whose content is defined hereunder, shall be recognized in favor of any third party who, prior to the date of the deposit of a design or to the date of priority under Article 4 of the Paris Convention, where such priority is claimed, has manufactured in Benelux territory products identical in appearance with the deposited design or differing only in minor respects.

(2) The same right shall be recognized in favor of anyone who, in the same conditions, has started to carry out his intention to manufacture.

(3) This right shall not however be recognized in favor of a third party who has copied the design concerned without the creator's consent.

(4) By virtue of the right of personal possession, the owner thereof may continue or, in the case of paragraph (2), may proceed with the manufacture of the products and, notwithstanding the rights deriving from the deposit, may perform all the other acts referred to in Article 14(1) with the exception of importation.

(5) The right of personal possession may be transferred only together with the establishment in which the acts giving rise to it took place.

Article 18

(1) The proprietor of the registration of a Benelux deposit may at any time request the cancellation of his registration, except where third-party rights exist under a contract or on the basis of court proceedings and have been notified to the Benelux Office.

In the case of a multiple deposit, cancellation may relate to only some of the designs included therein.

If a license has been recorded, cancellation of the registration of the design or of the license may only be requested jointly by the proprietor of the registration and the licensee.

The cancellation shall be effective throughout the Benelux territory notwithstanding any statement to the contrary.

(2) The rules set out in paragraph (1) shall apply also to the renunciation of the protection in Benelux territory resulting from an international deposit.

Article 19

Declarations of nullity, voluntary cancellations or renunciations must relate to the entire design.

Article 20

(1) In addition to the duties conferred on it by the preceding articles, the Benelux Office shall:

(a) make changes in registrations, either at the request of the proprietor, or as a result of notifications by the International Bureau for the Protection of Industrial Property or of court decisions and, where applicable, inform the International Bureau thereof;

(b) publish a monthly publication in the Dutch and French languages in which registrations of Benelux deposits shall appear and which shall contain all other entries prescribed by the Rules;

(c) provide copies of registrations at the request of any interested party;

(d) supply information on registered designs.

(2) The fees to be charged for the services provided for in paragraph (1) and the price of the publication and the copies shall be fixed in the Rules.

CHAPTER II. — Designs of a Marked Artistic Character

Article 21

(1) A design having a marked artistic character may be protected both by this Law and by the copyright laws if the conditions for the application of both such legislation are met.

(2) Designs having no marked artistic character shall be outside the protection under copyright law.

(3) Where the deposit of a design having a marked artistic character is declared null and void or the exclusive right resulting from the deposit of such a design has lapsed, the copyright in that design shall lapse at the same time insofar as both rights belong to the same proprietor; such right shall not lapse, however, if the proprietor of the design makes a special declaration in accordance with Article 24 for the maintenance of his copyright.

Article 22

(1) The authorization given to a third party by the creator of a work protected by copyright to effect a deposit of a design in which his work is embodied shall entail the assignment of the copyright in that work to the extent of its embodiment in the design.

(2) The applicant in the case of a design having a marked artistic character shall be presumed to be also the owner of the copyright therein; this presumption shall not however apply to the true creator or to persons acting under his authority.

(3) The assignment of the copyright in a design having a marked artistic character shall entail the assignment of the design right, and vice versa, without prejudice to the application of Article 13.

Article 23

Where a design having a marked artistic character is created in the conditions referred to in Article 6, the copyright in that design shall belong to the person deemed to be the creator in accordance with that article.

Article 24

(1) The declaration under Article 21(3) must be made, in the manner to be prescribed by the Rules and on payment of the fee to be fixed therein, during the year preceding the lapse of the exclusive right to the design. In the case of the annulment of the right, the declaration must be made within the three months following the date on which the court's declaration of nullity takes on force of law.

(2) The declaration under Article 21(3) shall be recorded and the corresponding entry shall be published.

CHAPTER III. — Transitional Provisions

Article 25

Subject to Article 26, designs which prior to the entry into force of this Law enjoyed protection, in any form, under the national law in any one of the Benelux countries shall continue to enjoy the same protection in that country.

Article 26

Deposits of industrial designs effected in Belgium prior to the entry into force of this Law shall cease to have effect as from the date of such entry into force if, by the end of the year following that date, no confirmatory deposit has been made with the Belgian Industrial Property Office.

Such confirmatory deposits shall not be the subject of any fee.

Article 27

When the exclusive right to a design, maintained in accordance with Articles 25 and 26, belongs to different proprietors in two or three Benelux countries, the proprietor of the right in any one of those countries may not prevent the importation of a product embodying that design, and originating in another Benelux country, or claim compensation for such importation, where the product has been manufactured or brought into circulation by the proprietor of the right to the design in such other country, or with his consent, and where there are economic links between the two proprietors with respect to the exploitation of the product concerned.

CHAPTER IV. — General Provisions

Article 28

In this Law, the expression " Benelux territory " refers to the whole of the territories of the Kingdom of Belgium, the Grand Duchy of Luxembourg and the Kingdom of the Netherlands in Europe.

Article 29

(1) Unless otherwise expressly stipulated by contract, jurisdiction in respect of design cases shall be determined by the domicile of the defendant or by the place where the obligation giving rise to the litigation originated or was or is to be performed.

The place where a design was deposited or registered may on no account serve in itself as a basis for the determination of jurisdiction.

Where the criteria laid down hereinabove are insufficient for the determination of jurisdiction, the plaintiff may bring the action before the court of his domicile or residence or, if he has no domicile or residence in Benelux territory, before the Court of Brussels, The Hague or Luxembourg, at his option.

(2) The courts shall apply the rule set forth in paragraph (1) ex officio and shall explicitly establish and record their competence.

(3) The court before which the principal claim referred to in paragraph (1) is pending shall take cognizance of requests that the plaintiff put up security, requests for intervention, incidental claims and counterclaims, except where it is incompetent *ratione materiae*.

(4) The courts of any one of the three countries shall, at the request of one of the parties, transfer disputes brought before them to the courts of one of the other two countries if such disputes are already pending before the latter courts or are fundamentally related to other disputes submitted to the said latter courts. Such transfer may only be requested if the causes are pending in first instance. It shall be made to the court before which the case was first brought by a declaration instituting action, unless another court has given an earlier judgment in the matter concerned — and such judgment does not merely relate to internal procedure —, in which case the transfer shall be made to such other court.

Article 30

(1) The provisions of this Law shall be without prejudice to the application of the Paris Convention and the Hague Agreement.

(2) Nationals of the Benelux countries and nationals of countries not members of the Union established by the Paris Convention who are domiciled or have real and effective industrial or commercial establishments in Benelux territory may, in the context of this Law, claim the application in their favor, for the entire Benelux territory, of the provisions of the Paris Convention and the Hague Agreement.

BELGIUM

Law

Approving the Benelux Designs Convention, signed at Brussels on October 25, 1966, and its Annex (Uniform Law)

(of December 1, 1970)

1. — The Benelux Designs Convention, signed at Brussels on October 25, 1966, shall have full force and effect.

2. — The Uniform Benelux Designs Law, annexed to the Convention referred to in Section 1, is hereby incorporated into the legislation in its Dutch and French languages.

3. — Sections 1 and 2 of Royal Decree No. 91 of January 29, 1935 governing the measures relating to the protection of industrial designs, approved by the Law of May 4, 1936, shall henceforth apply only to designs protected by those provisions prior to the entry into force of the Uniform Benelux Law.

4. — Sections 3, 4, 5 and 6 of Royal Decree No. 91 of January 29, 1935 are hereby repealed.

Deposits effected under Royal Decree No. 91 of January 29, 1935 or pursuant to Sections 14 to 19 of the Law of March 18, 1806, as amended by the Law of December 30, 1925 and the Royal Decree of June 30, 1933, shall remain in force; however, the evidential value of such deposits shall only be maintained if a confirmatory deposit has been made in accordance with Article 26 of the Uniform Benelux Law.

5. — The King shall designate the department responsible for assuming the tasks entrusted to the national Office by the Uniform Benelux Law.

6. — The provisions of the Convention and of the Uniform Benelux Law which relate to international deposits of industrial designs shall enter into force on the date of entry into force in the three States of Benelux of the Hague Agreement of November 28, 1960 revising the Agreement Concerning the International Deposit of Industrial Designs.

7. — Sections 2, 3 and 4 of this Law shall enter into force on the date fixed in Article 13 of the Convention for the entry into force of the Uniform Benelux Law.

ALGERIA

I

Ordinance establishing the Algerian Institute of Standardization and Industrial Property (INAPI)

(No. 73-62, of November 21, 1973) *

. . . . .

1. — The "Algerian Institute of Standardization and Industrial Property," abbreviated as INAPI, is hereby established as a public institution of an industrial and commercial nature having legal personality and financial autonomy; the Statute of INAPI is annexed to this Ordinance.

2. — INAPI shall be under the supervision of the Minister for Industry and Power.

3. — The functions of the National Industrial Property Office (ONPI) in the field of industrial property, as specified by Section 2*(a), (b), (c), (d), (e), (f), (g)* and *(k)* of Decree No. 63-248 of July 10, 1973, referred to above, shall be carried out by INAPI in accordance with this Ordinance and the Statute annexed hereto.

4. — All the assets, rights and obligations of ONPI, other than those relating to the Central Register of Commerce, shall be transferred to INAPI.

The staff members of ONPI, other than those assigned to the department of the Central Register of Commerce, shall be transferred to INAPI.

5. — All provisions contrary to this Ordinance are hereby repealed.

6. — *[Publication]*

II

Statute

of the Algerian Institute of Standardization and Industrial Property (INAPI)

Title I

Name - Status - Headquarters

Sections **1** *to* **3** . . .

Title II

Objects and Functions

4. — INAPI shall be competent in the field of standardization and industrial property in accordance with the law in force and in the framework of Government policy.

I. General Provisions

5. — INAPI shall be responsible for the implementation of the provisions relating to standardization and industrial property contained in the laws and regulations.

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* The Ordinance entered into force on November 27, 1973.

6. — INAPI shall participate in international and regional organizations concerned with standardization and industrial property and, where applicable, shall represent Algeria at such organizations.

INAPI shall also he responsible for the implementation of international conventions and agreements to which Algeria is party, under the conditions laid down for that purpose.

7. — INAPI shall be responsible for establishing, maintaining and making available to the public authorities and to private persons all documentation relevant to standardization and industrial property.

II. Industrial Property

8. — In the field of industrial property, the functions of INAPI shall include:

(a) receipt and examination of applications for inventors' certificates and patents, registration thereof, issue of the certificates and patents and publication thereof;

(b) receipt and examination of trademark applications, registration of trademarks and publication thereof;

(c) receipt and examination of industrial design applications, registration of industrial designs and publication thereof;

(d) receipt and registration of all instruments affecting the ownership of industrial property rights as well as license and assignment contracts relating to such rights;

(e) application of the provisions on industrial property and its protection, industrial awards, appellations of origin and indications of source.

The application of this Section shall be subject to any special procedures provided for by law.

III. Standardization

Sections **9** *to* **19** . . .

Title III
Management and Administration

Section **20** . . .

I. The Administrative Council

Sections **21** *to* **23** . . .

II. The Director General

24. — The Director General of INAPI shall he appointed by decree, on the proposal of the Minister for Industry and Power.

His appointment shall be terminated under the same procedure.

25. — The Director General of INAPI shall be assisted by one or more Directors, appointed by order of the Minister for Industry and Power, on the proposal of the Director General.

Their appointment shall he terminated under the same procedure.

26. — The Director General of INAPI shall act under the authority of the Minister for Industry and Power and shall be responsible for the general operation of the Institute within the limits of his functions as determined hy the laws and regulations.

For this purpose, the Director General shall have full powers of management and administration to ensure the operation of the Institute, to act in its name, to conclude any contract and to take any action relating to the objects of INAPI.

Within the limits of his powers, the Director General shall, in particular, be responsible:

(a) for exercising hierarchical authority over the staff;

(b) for preparing and implementing the budget of INAPI;

(c) for representing INAPI in all civil transactions.

27. — The Director General may, in the interests of the Institute, delegate his signature to the Directors of INAPI.

Such delegation must he approved hy the Minister for Industry and Power.

Title IV
Financial Provisions

28. — The assets of INAPI shall consist of:

— State subsidies entered annually in the budget of the Ministry of Industry and Power;

— bequests, gifts and endowment funds *[fonds de concours];*

— any contributions or investments from institutes of technology, national enterprises and professional organizations;

— any fees for trials and work carried out on behalf of third parties;

— sale of publications and documents on standards;

— income and fees received in connection with certification marks and quality labels;

— fees, charges and any other funds credited to INAPI.

29. — An account of estimated income and expenditure shall be established for every civil year.

The civil year shall run from January 1 to December 31.

30. — INAPI's annual account of estimates shall he prepared by the Director General. It shall be transmitted for approval to the Minister for Industry and Power and to the Minister for Finance, after the opinion of the Administrative Council has heen heard, three months hefore the beginning of the financial year to which it relates.

Approval of the account shall be deemed to have heen given on the expiration of a period of 45 days from the date of transmittal, except where one of the Ministers has objected to certain items of income or expenditure or has reserved his approval thereof. In such a case the Director General shall, within a period of 30 days from the date on which the reservation was notified, submit a new draft for approval according to the procedure indicated in the foregoing subsection. Approval shall he deemed to have heen given after a period of 45 days following the transmittal of the new draft.

Where approval of the account has not been given hy the starting date of the financial year, the Director General may incur expenditure within the limits of the credit of the preceding financial year.

31. — The accounts of INAPI shall be maintained in accordance with the law in force.

An accountant appointed by the Minister for Finance shall keep the general accounts of the Institute. He shall carry out his duties in accordance with the laws and regulations in force. He shall be responsible to the Director General.

32. — A financial controller designated by the Minister for Finance shall oversee the financial management of the Institute.

Title V
Supervision and Control

33. — The Minister for Industry and Power, in his capacity of supervisory authority, shall have full powers of direction and control with respect to INAPI.

All reports, statements and records of the Institute shall be transmitted to the Minister.

34. — The Minister for Industry and Power shall approve:

(a) the organizational structure of INAPI;
(b) the rules of procedure;
(c) the staff regulations and the salary scale;
(d) statements of the operating accounts, and the profit and loss accounts;
(e) training programs for specialized staff.

Title VI
General Provisions

35. — Any amendment to this Statute shall be the subject of a law; similarly, the dissolution of the Institute may be declared only by means of a law, which shall provide for the liquidation and transfer of the whole of its assets.

JAPAN

Utility Model Law

(Law No. 123 of April 13, 1959, as amended *)

CONTENTS

Chapter I — General Provisions

(Purpose)

1. — The purpose of this Law shall be to encourage devices by promoting the protection and utilization of devices relating to the shape or construction of articles or a combination of articles, so as to contribute to the development of industry.

(Definitions)

2. — (1) "Device" in this Law means the creation of technical ideas by which a law of nature is utilized.

(2) "Registered utility model" in this Law means a device for which a utility model registration has been effected.

(3) "Exploiting" of a device in this Law means any act of manufacturing, using, assigning, leasing, displaying for the purpose of assignment or lease, or importing, of the articles embodying the device.

Chapter II — Utility Model Registration and Applications Therefor

(Registrability of utility models)

3. — (1) Any person who has made a device which is industrially applicable and which relates to the shape or construction of articles or a combination of articles may obtain a utility model registration therefor, except in the case of the following devices:

(i) devices which were publicly known in Japan prior to the filing of the utility model application;

(ii) devices which were publicly exploited in Japan prior to the filing of the utility model application;

(iii) devices which were described in a publication distributed in Japan or elsewhere prior to the filing of the utility model application.

(2) Where a device could very easily have been made, prior to the filing of the utility model application, by a person with ordinary skill in the art to which the device pertains, on the basis of a device or devices referred to in any of the paragraphs of the preceding subsection, a utility model registration shall not be effected for such a device notwithstanding the preceding subsection.

3[bis]. — Where a device claimed in a utility model application is identical with a device or invention (not being a device or invention made by the creator of the device claimed in the utility model application) that has been described in the specification or drawings attached to the request of another application for a utility model registration or a patent and where such other application was filed earlier than the utility model application concerned and underwent publication *(Kôkoku)* or laying-open for public inspection *(Kôkai)* after the filing of the utility model application concerned, a utility

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* By Law No. 140 of 1962, Law No. 161 of 1962, Law No. 148 of 1964, Law No. 81 of 1965, Law No. 91 of 1970 and Law No. 96 of 1971.
Note: This text is the translation of the Patent Office of Japan, published by the Japanese Group of AIPPI. The new provisions of the amended Utility Model Law were translated by Mr. Takashi Ishihara and the full text of the amended Utility Model Law was revised by Mr. Haruo Goto.

model registration shall not be effected for the first-mentioned device notwithstanding Section 3(1). However this provision shall not apply where, at the time of filing of the utility model application concerned, the applicant in the case of such application and the applicant in the case of the other application for a utility model registration or a patent are the same person.

(Unregistrable devices)

4. — Devices which are liable to contravene public order, morality or public health shall not be the subject of a utility model registration notwithstanding Section 3(1).

(Applications for utility model registration)

5. — (1) Any person desiring a utility model registration shall submit a request to the President of the Patent Office stating the following:

(i) the name and the domicile or residence of the applicant for a utility model registration and, in the case of a legal entity, the name of an officer entitled to represent it;

(ii) the date of submission;

(iii) the title of the device;

(iv) the name and the domicile or residence of the creator.

(2) The request shall be accompanied by the specification — and the drawings — stating the following:

(i) the title of the device;

(ii) a brief explanation of the drawings;

(iii) a detailed explanation of the device;

(iv) the claim.

(3) The detailed explanation of the device under paragraph (iii) of the preceding subsection shall state the purpose, construction and effect of the device in such a manner that it may easily be carried out by a person having ordinary skill in the art to which the device pertains.

(4) The claim under subsection 2(iv) shall state only the indispensable constituent features of the device as described in the detailed explanation.

(Unity of application)

6. — An application for utility model registration shall relate to a single device.

(First-to-file rule)

7. — (1) Where two or more utility model applications relating to the same device are filed on different dates, only the first applicant may obtain a utility model registration for the device.

(2) Where two or more utility model applications relating to the same device are filed on the same date, only one such applicant, agreed upon after mutual consultation among all the applicants, may obtain a utility model registration for the device. If no agreement is reached or no consultation is possible, none of the applicants shall obtain a utility model registration for the device.

(3) Where a device claimed in a utility model application is the same as an invention claimed in a patent application and the applications are filed on different dates, the applicant for a utility model registration may obtain registration only if his application was filed before the patent application.

(4) Where a utility model application or a patent application is withdrawn or invalidated, such application shall, for the purposes of the three preceding subsections, be deemed never to have been made.

(5) A utility model application or a patent application filed by a person who is neither the creator nor the inventor nor the successor in title to the right to obtain a utility model registration or patent shall, for the purposes of subsections (1) to (3), be deemed not to be a utility model application or a patent application.

(6) The President of the Patent Office shall, in the case of subsection (2), order the applicants to hold consultations for an agreement under that subsection and to report the result thereof, within an adequate time limit.

(7) Where the report under the preceding subsection is not made within the time limit designated in accordance with that subsection, the President of the Patent Office may deem that no agreement under subsection (2) has been reached.

(8) If no agreement is reached or no consultation is possible under Section 39(4) of the Patent Law (No. 121 of 1959 [1]), the applicant for a utility model registration shall not obtain registration for such device.

(Conversion of applications)

8. — (1) An applicant for a patent may convert his application into a utility model application. However, this provision shall not apply after 30 days from the transmittal of the examiner's first decision that the patent application is to be refused or after four years from the filing date of the patent application (excluding the 30-day period counted from the transmittal of the examiner's first decision that the patent application is to be refused).

(2) An applicant for a design registration may convert his application into a utility model application. However, this provision shall not apply after 30 days from the transmittal of the examiner's first decision that the design application is to be refused or after four years from the filing date of the design application (excluding the 30-day period counted from the transmittal of the examiner's first decision that the design application is to be refused).

(3) Where an application has been converted under the two preceding subsections, the utility model application shall be deemed to have been filed at the time of filing of the patent or design application. However, this provision shall not apply where the utility model application is either " another application for a utility model registration " as referred to in Section 3^{bis} of this Law or " an application for a utility model registration " as referred to in Section 29^{bis} of the Patent Law, for the purposes of those sections as well as Sections 30(4) and 43(1) and (2) of the Patent Law as applied under Section 9(1) of this Law.

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[1] *Industrial Property*, 1974, p. 140.

(4) Where an application has been converted under subsection (1) or (2), the patent or design application shall be deemed to have been withdrawn.

(5) The 30-day period prescribed in the proviso to subsection (1) shall, when the time limit prescribed in Section 121(1) of the Patent Law has been extended in accordance with Section 4(1) of that Law, be deemed to have been extended only for that period as extended.

(6) The 30-day period prescribed in the proviso to subsection (2) shall, when the time limit prescribed in Section 46(1) of the Design Law (Law No. 125 of 1959) has been extended in accordance with Section 4(1) of the Patent Law as applied under Section 68(1) of the Design Law, be deemed to have been extended only for that period as extended.

(Application mutatis mutandis of Patent Law)

9. — (1) Section 30 (exceptions to lack of novelty of invention), Section 37 (joint applications) and Sections 40 to 44 (amendment of specification, etc. and change of gist; declarations of priority claim, and division of patent applications) of the Patent Law shall apply mutatis mutandis to utility model applications.

(2) Sections 33 and 34(1) and (2) and (4) to (7) (right to obtain patent) of the Patent Law shall apply mutatis mutandis to the right to obtain a utility model registration.

(3) Section 35 (employees' inventions) of the Patent Law shall apply mutatis mutandis to devices made by an employee, an executive officer of a legal entity or a national or local public official.

Chapter III — The Examination

(Examination by examiner)

10. — The President of the Patent Office shall have applications for utility model registration and oppositions to the grant of registration examined by an examiner.

(Examination of utility model applications)

10bis. — The examination of utility model applications shall be carried out upon a request for examination.

(Requests for examination)

10ter. — (1) When an application for a utility model registration has been filed any person may, within four years from the date thereof, make a request for examination to the President of the Patent Office.

(2) Section 48ter(2) to (4) (requests for examination) of the Patent Law shall apply mutatis mutandis to requests for examination under the preceding subsection.

(Examiner's decision of refusal)

11. — The examiner shall make a decision that a utility model application is to be refused where it falls under any of the following paragraphs:

(i) the device claimed in the utility model application is not registrable in accordance with Section 3, 3bis, 4 or 7(1) to (3) or (8) of this Law, Section 37 of the Patent Law — as applied under Section 9(1) of this Law — or Section 25 of the Patent Law as applied under Section 55(3) of this Law;

(ii) the device claimed in the utility model application is not registrable in accordance with the provisions of a treaty;

(iii) the utility model application does not comply with the requirements of Section 5(3) or (4) or 6;

(iv) the applicant for a utility model registration who is not the creator has not succeeded to the right to obtain registration for the device concerned.

(Effects of publication of applications, etc.)

12. — (1) After the publication of his application under Section 51(2) of the Patent Law as applied under Section 13 of this Law, an applicant for a utility model registration shall have an exclusive right to commercially exploit the device claimed in the utility model application.

(2) Sections 27 to 30 shall apply mutatis mutandis to the right under the preceding subsection.

(3) Where a utility model application has been abandoned, withdrawn or invalidated after the publication of the application, or where the examiner's decision or a trial decision that the utility model application is to be refused has become final and conclusive, or where the utility model right has been deemed never to have existed under Section 33(4), or where, with the exception of cases coming within the proviso to Section 125 of the Patent Law as applied under Section 41 of this Law, a trial decision that the utility model registration is to be invalidated has become final and conclusive, the right under subsection (1) shall be deemed never to have arisen.

(4) Where a person having the right under subsection (1) has exercised the right and where the utility model application has been abandoned, withdrawn or invalidated or where the examiner's decision or a trial decision that the utility model application is to be refused has become final and conclusive, such person shall be liable to indemnify any damage caused to another party by the exercise of that right. The same shall apply where the right is exercised with respect to a device which, as a result of the amendment or the declining of an amendment to the specification or drawings attached to the request in the utility model application, no longer falls within the scope of the claim at the time of the registration of the establishment of the utility model right.

(Application mutatis mutandis of Patent Law)

13. — Section 47(2) (qualifications of examiners), Section 48 (exclusion of examiners), Sections 48^{quater} to 48^{sexies} (requests for examination, and preferential examination), Section 50 (notification of reasons for refusal), Section 51 (publication of applications) and Sections 52bis to 65 (suspension of litigation proceedings; declining of amendments; filing of oppositions to grant of patent; formal requirements of examiner's decision; amendment after ruling for the publication of applications, and relationship with litigation) of the Patent Law shall apply mutatis mutandis to the examination of utility model applications.

Chapter III[bis] — Laying-Open of Applications

(Laying-open of applications)

13[bis]. — (1) After one year and six months from the filing date of an application for a utility model registration [or — in the case of a utility model application claiming priority by virtue of Section 43(1) of the Patent Law as applied under Section 9(1) of this Law — after one year and six months from the filing date of the first application or the application considered to be the first application in accordance with Article 4C(4) of the Paris Convention (meaning the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934 and at Lisbon on October 31, 1958) or from the filing date of an application recognized as the first application in accordance with A(2) of the said article], the President of the Patent Office shall lay the application open for public inspection, unless the application has already been published.

(2) The laying-open for public inspection of a utility model application shall be effected by publishing the following in the Utility Model Gazette:

(i) the name and the domicile or residence of the applicant;

(ii) the number and the date of the application;

(iii) the name and the domicile or residence of the creator;

(iv) the title of the device, the brief explanation of the drawings and the claim contained in the specification as well as the contents of the drawings attached to the request (with the exception of those whose publication in the Utility Model Gazette is, in the view of the President of the Patent Office, liable to contravene public order or morality);

(v) the number and the date of the laying-open of the application;

(vi) other necessary particulars.

(3) The President of the Patent Office shall make available for public inspection at the Patent Office the documents containing the contents (with the exception of anything which, in the view of the President of the Patent Office, is liable to contravene public order or morality) of the specification and drawings attached to the request of a utility model application which has been laid open for public inspection. However, this provision shall not apply where the application has been published or is no longer pending at the Patent Office.

(Effects of laying-open of applications)

13[ter]. — (1) After the laying-open of his utility model application and following a warning by the applicant in the form of a document describing the contents of the device claimed in the application, the applicant may require a person who has commercially exploited the device, after the warning but before publication of the application, to pay in compensation a sum of money equivalent to what he would normally be entitled to receive for the exploitation of the device if it were a registered utility model. Even in the absence of the warning, the same shall apply to a person who commercially exploited the device before the publication of the application, knowing that the device was the one claimed in the utility model application laid open for public inspection.

(2) The right to require compensation under the preceding subsection shall not be exercised until after publication of the application.

(3) The exercise of the right to require compensation under subsection (1) shall not preclude the exercise of the right under Section 12(1) of this Law or the right under Section 52(1) of the Patent Law as applied *either* under Section 159(3) or 161[ter](3) of the Patent Law as applied under Section 41 of this Law *or* under Section 159(3) of the Patent Law as applied under Section 174(1) of the Patent Law as applied under Section 45 of this Law, and the exercise of the utility model right.

(4) Sections 12(3) and (4) and 28 of this Law, Sections 52[bis] and 105 (suspension of litigation proceedings, and production of documents) of the Patent Law and Sections 719 and 724 (tort) of the Civil Code (Law No. 89 of 1896) shall apply mutatis mutandis to the exercise of the right to require compensation under subsection (1). In such a case, where the person having the right to require compensation became aware, before publication of the utility model application concerned, of the fact that the device claimed in the application was being exploited and of the identity of the person exploiting it, " the time when the injured party or his legal representative became aware of such damage and of the identity of the person causing it " in Section 724 of the Civil Code shall read " the date of publication of the application for a utility model registration. "

Chapter IV — The Utility Model Right

1. *The Utility Model Right*

(Registration of establishment of utility model right)

14. — (1) A utility model right shall come into force upon registration of its establishment.

(2) The establishment of a utility model right shall be registered when the annual fees for the first to the third years under Section 31(1)(i) have been paid or exemption or deferment of such payment has been granted.

(3) Upon registration under the preceding subsection, the name and the domicile or residence of the owner of the utility model right, the registration number as well as the date of registration of the establishment shall be published in the Utility Model Gazette.

(Term of utility model right)

15. — (1) The term of the utility model right shall be ten years counted from the date of publication of the utility model application. Provided however that such term shall not exceed 15 years from the filing date of the utility model application.

(2) Where a utility model application is deemed to have been filed at the time of submission of an amendment in accordance with Section 40 of the Patent Law as applied

under Section 9(1) of this Law or in accordance with Section 53(4) of the Patent Law as applied *either* under Section 13 of this Law *or* under Section 159(1) or 161[ter](1) of the Patent Law as applied under Section 41 of this Law *or* under Section 159(1) of the Patent Law as applied under Section 174(1) of the Patent Law as applied under Section 45 of this Law, the 15 years fixed in the proviso to the preceding subsection shall be counted from the day following the filing date of the original utility model application, notwithstanding the said proviso.

(Effects of utility model right)

16. — The owner of a utility model right shall have an exclusive right to commercially exploit the registered utility model. However, where the utility model right is the subject of an exclusive license, this provision shall not apply to the extent that the exclusive licensee exclusively possesses the right to exploit the registered utility model.

(Relationship with another's registered utility model, etc.)

17. — When a registered utility model would utilize another person's registered utility model, patented invention or registered design or design similar thereto under an application filed prior to the filing date of the utility model application concerned, or when the utility model right conflicts with another person's design right under an application for registration of a design filed prior to the filing date of the utility model application concerned, the owuer of the utility model right, exclusive licensee or non-exclusive licensee shall not commercially exploit the registered utility model.

(Exclusive licenses)

18. — (1) The owner of a utility model right may grant an exclusive license on such right.

(2) An exclusive licensee shall have an exclusive right to commercially exploit the registered utility model, to the extent laid down in the license contract.

(3) Section 77(3) to (5) (transfer etc.), Section 97(2) (surrender) and Section 98(1)(ii) and (2) (effects of registration) of the Patent Law shall apply mutatis mutandis to exclusive licenses.

(Non-exclusive licenses)

19. — (1) The owner of a utility model right may grant a non-exclusive license on such right.

(2) A non-exclusive licensee shall have the right to commercially exploit the registered utility model, to the extent prescribed in this Law or laid down by the license contract.

(3) Section 73(1) (joint ownership), Section 97(3) (surrender) and Section 99 (effects of registration) of the Patent Law shall apply mutatis mutandis to non-exclusive licenses.

(Non-exclusive license due to exploitation prior to registration of demand for invalidation trial)

20. — (1) When a person coming within any of the paragraphs set out below has been commercially exploiting a device or invention in Japan or has been making preparations therefor, prior to the registration of a demand for a trial under Section 37(1) of this Law or Section 123(1) of the Patent Law, without knowing that the utility model registration or patent falls under any of the paragraphs of the two subsections referred to, such person shall have a non-exclusive license on the utility model right or on the exclusive license existing at the time when the utility model registration or the patent was invalidated, such non-exclusive license being limited to the device or invention which is being exploited or for which preparations for exploitation are being made and to the purpose of such exploitation or the preparations therefor:

(i) the original owner of the utility model right, where one of two or more utility model registrations granted for the same device has been invalidated;

(ii) the original patentee, where a device registered as a utility model and a patented invention are the same and the patent has been invalidated;

(iii) the original owner of the utility model right, where his utility model registration has been invalidated and a utility model registration for the same device has been granted to the person entitled;

(iv) the original patentee, where his patent has been invalidated and a utility model registration for the same device as the invention has been granted to the person entitled;

(v) in the cases referred to in the four preceding paragraphs, a person, who, at the time of registration of the demand for a trial under Section 37(1) of this Law or Section 123(1) of the Patent Law, has *either* an exclusive license on the utility model right that has been invalidated *or* a non-exclusive license which is effective, under Section 99(1) of the Patent Law as applied under Section 19(3) of this Law, against the utility model right or the exclusive license *or* an exclusive license on the patent that has been invalidated *or* a non-exclusive license that is effective under the said subsection against the patent right or the exclusive license.

(2) The owner of the utility model right or the exclusive licensee shall have a right to a reasonable remuneration as consideration for the non-exclusive license under the preceding subsection.

(Arbitration decision on grant of non-exclusive license in case of failure to exploit)

21. — (1) Where a registered utility model has not been sufficiently and continuously exploited during a period of three years or more in Japan, a person who intends to exploit the registered utility model may request the owner of the utility model right or the exclusive licensee to hold consultations on the grant of a non-exclusive license thereon. However, this provision shall not apply unless four years have elapsed since the filing date of the application corresponding to the registered utility model.

(2) If no agreement is reached or no consultation is possible under the preceding subsection, a person who intends to exploit the registered utility model may request the President of the Patent Office for an arbitration decision.

(3) Sections 84 to 91[bis] (arbitration procedure etc.) of the Patent Law shall apply mutatis mutandis to arbitrations under the preceding subsection.

(Arbitration decision on grant of non-exclusive license on one's own registered utility model)

22. — (1) Where a registered utility model falls under any of the cases provided for in Section 17, the owner of the utility model right or the exclusive licensee may request the other person referred to in that section to hold consultations on the grant of a non-exclusive license to exploit the registered utility model or of a non-exclusive license on the patent right or the design right.

(2) If no agreement is reached or no consultation is possible under the preceding subsection, the owner of the utility model right or the exclusive licensee may request the President of the Patent Office for an arbitration decision.

(3) If, in the case of the preceding subsection, the grant of a non-exclusive license would unduly injure the interests of the other person referred to in Section 17, the President of the Patent Office shall not render an arbitration decision ordering a non-exclusive license to be granted.

(4) Sections 84, 85(1) and 86 to 91bis (arbitration procedure etc.) of the Patent Law shall apply mutatis mutandis to arbitrations under subsection (2).

(Arbitration decision on grant of non-exclusive license in public interest)

23. — (1) Where the exploitation of a registered utility model is particularly necessary in the public interest, a person who intends to exploit the utility model may request the owner of the utility model right or the exclusive licensee to hold consultations on the grant of a non-exclusive license.

(2) If no agreement is reached or no consultation is possible under the preceding subsection, a person who intends to exploit the registered utility model may request the Minister for International Trade and Industry for an arbitration decision.

(3) Sections 84, 85(1) and 86 to 91bis (arbitration procedure etc.) of the Patent Law shall apply mutatis mutandis to arbitrations under the preceding subsection.

(Transfer etc. of non-exclusive license)

24. — (1) A non-exclusive license, with the exception of one which results from an arbitration under Section 21(2) or 22(2) of this Law, Section 92(2) of the Patent Law or Section 33(2) of the Design Law, may be transferred, but only together with the business in which it is exploited or only with the consent of the owner of the utility model right (or the owner and the exclusive licensee in the case of a non-exclusive license on an exclusive license) or in the case of inheritance or other general succession.

(2) A non-exclusive licensee may, except in the case of a non-exclusive license resulting from an arbitration under Section 21(2) or 22(2) of this Law, Section 92(2) of the Patent Law or Section 33(2) of the Design Law, establish a pledge on the non-exclusive license, but only with the consent of the owner of the utility model right (or the owner and the exclusive licensee in the case of a non-exclusive license on an exclusive license).

(3) A non-exclusive license resulting from an arbitration under Section 21(2) may be transferred only together with the business in which it is exploited or in the case of inheritance or other general succession.

(4) A non-exclusive license resulting from an arbitration under Section 22(2) of this Law, Section 92(2) of the Patent Law or Section 33(2) of the Design Law shall be transferred together with the utility model, patent or design right to which the non-exclusive licensee is entitled and shall be extinguished at the same time as the utility model, patent or design right.

(Pledges)

25. — (1) Where a utility model right or an exclusive or non-exclusive license is the subject of a pledge, the pledgee may not exploit the registered utility model except as otherwise provided by contract.

(2) Section 96 (attachment) of the Patent Law shall apply mutatis mutandis to pledges on a utility model right, exclusive license or non-exclusive license.

(3) Section 98(1)(iii) and (2) (effects of registration) of the Patent Law shall apply mutatis mutandis to pledges on a utility model right or exclusive license.

(4) Section 99(3) (effects of registration) of the Patent Law shall apply mutatis mutandis to pledges on a non-exclusive license.

(Application mutatis mutandis of Patent Law)

26. — Sections 69 to 71 (limits of patent right, and technical scope of patented inventions), Section 73 (joint ownership), Section 76 (extinguishment of patent right in absence of heir), Section 79 (non-exclusive license by virtue of prior use), Sections 81 and 82 (non-exclusive license after expiration of design right), Section 97(1) (surrender) and Section 98(1)(i) and (2) (effects of registration) of the Patent Law shall apply mutatis mutandis to utility model rights.

2. *Infringement*

(Injunctions)

27. — (1) The owner of a utility model right or exclusive licensee may require a person who is infringing or is likely to infringe the utility model right or exclusive license to discontinue or refrain from such infringement.

(2) The owner of a utility model right or an exclusive licensee who is acting under the preceding subsection may demand the destruction of the articles by which the act of infringement was committed, the removal of the facilities used for the act of infringement, or other measures necessary to prevent the infringement.

(Acts deemed to be infringement)

28. — Acts of manufacturing, assigning, leasing, displaying for the purpose of assignment or lease, or importing, in the course of trade, of elements to be used exclusively for the manufacture of an article covered by a registered utility model shall be deemed to be an infringement of the utility model right or exclusive license.

(Presumption etc. of amount of damage)

29. — (1) Where the owner of a utility model right or exclusive licensee claims, from a person who has intentionally or negligently infringed the utility model right or exclusive license, compensation for damage caused to him by the infringement, the profits gained by the infringer through the infringement shall be presumed to be the amount of damage suffered by the owner or exclusive licensee.

(2) The owner of a utility model right or exclusive licensee may claim, from a person who has intentionally or negligently infringed the utility model right or exclusive license, an amount of money which he would normally be entitled to receive for the exploitation of the registered utility model, as the amount of damage suffered by him.

(3) The preceding subsection shall not preclude a claim to damages exceeding the amount referred to therein. In such a case, where there has been neither willfulness nor gross negligence on the part of the person who has infringed the utility model right or the exclusive license, the court may take this into consideration when awarding damages.

(Application mutatis mutandis of Patent Law)

30. — Section 103 (presumption of negligence), Section 105 (production of documents) and Section 106 (measures for recovery of reputation) of the Patent Law shall apply mutatis mutandis to the infringement of a utility model right or exclusive license.

3. *Annual Fees*

(Annual fees)

31. — (1) A person who obtains registration of a utility model right or the owner of a utility model right shall pay as annual fees the amount specified below, for each case and for each of the ten years under Section 15(1):

.....

(2) The preceding subsection shall not apply to utility model rights belonging to the State.

(Time limit for payment of annual fees)

32. — (1) The annual fees for each year from the first to the third years under Section 31(1)(i) shall be paid in a lump sum within 30 days from the transmittal of the examiner's decision or trial decision that the utility model registration is to he effected.

(2) The annual fee for the fourth and subsequent years under Section 31(1)(ii) or (iii) shall be paid during the preceding year or prior thereto. However, where three years or more have passed between the date of publication of the application and the transmittal of the examiner's decision or trial decision that the utility model registration is to be effected, the annual fee for each year from the fourth year to the year in which the examiner's decision or trial decision was transmitted (or to the year following the year when such decision was transmitted, where there are less than 30 days between the transmittal of the decision referred to and the last day of the year concerned) shall be paid in a lump sum within 30 days from the transmittal of the examiner's decision or trial decision referred to.

(3) Upon the request of a person liable to pay an annual fee, the President of the Patent Office may extend the period prescribed in subsection (1) or the proviso to the preceding subsection by a period not exceeding 30 days.

(Late payment of annual fees)

33. — (1) Where the owner of a utility model right is unable to pay an annual fee within the time limit prescribed in the principal sentence of Section 32(2) or within the time limit for deferred payment under Section 109 of the Patent Law as applied under Section 34 of this Law, he may pay the annual fee belatedly within six months from the expiration of that time limit.

(2) In the case of late payment of an annual fee in accordance with the preceding subsection, the owner of the utility model right shall, in addition to the annual fee provided for in Section 31(1), pay a surcharge of the same amount as the annual fee.

(3) Where the owner of a utility model right fails to pay an annual fee for the fourth year or a subsequent year under Section 31(1)(ii) or (iii) as well as the surcharge under the preceding subsection within the time limit for late payment under subsection (1), the utility model right shall be deemed to have been extinguished retroactively from the moment that the time limit prescribed in the principal sentence of Section 32(2) expired.

(4) Where the owner of a utility model right fails to pay an annual fee whose payment has been deferred under Section 109 of the Patent Law as applied under Section 34 of this Law, and the surcharge under subsection (2), within the time limit for late payment under subsection (1), the utility model right shall be deemed never to have existed.

(Application mutatis mutandis of Patent Law)

34. — Sections 109 to 111 (reduction or deferment of payment of annual fees or exemption therefrom; payment of annual fees by an interested person, and refund of annual fees) of the Patent Law shall apply mutatis mutandis to the annual fees under this Law.

Chapter V — Trial

(Trial against examiner's decision of refusal)

35. — (1) A person who has received the examiner's decision that his application is to be refused and is dissatisfied may demand a trial thereon within 30 days from the transmittal of the examiner's decision.

(2) Where, due to reasons outside his control, a person is unable to demand a trial under the preceding subsection within the time limit prescribed therein, he may, notwithstanding that subsection, make the demand within 14 days from the date when the reasons ceased to be applicable but not later than six months following the expiration of the said time limit.

(Trial against ruling to decline amendment)

36. — (1) A person who has received a ruling to decline an amendment under Section 53(1) of the Patent Law as applied *either* under Section 13 of this Law *or* under Section 161[ter](1) of the Patent Law as applied under Section 41 of this Law and is dissatisfied may demand a trial thereon within 30 days from the transmittal of the ruling. However, this provision shall not apply when a new application for a utility model registration has been filed under Section 53(4) of the Patent Law as applied *either* under Section 13 of this Law *or* under Section 161[ter](1) of the Patent Law as applied under Section 41 of this Law.

(2) Section 35(2) shall apply mutatis mutandis to demands for the trial under the preceding subsection.

(Trial for invalidation of utility model registration)

37. — (1) In the following cases, a trial may be demanded for the invalidation of a utility model registration:

(i) where the registration has been effected contrary to Section 3, 3[bis], 4 or 7(1) to (3) or (8) or to Section 37 of the Patent Law as applied under Section 9(1) of this Law or to Section 25 of the Patent Law as applied under Section 55(3) of this Law;

(ii) where the registration has been effected contrary to the provisions of a treaty;

(iii) where the registration has been effected in respect of a utility model application which does not comply with the requirements of Section 5(3) or (4);

(iv) where the registration has been effected in respect of a utility model application filed by a person who is not the creator and has not succeeded to the right to obtain a utility model registration for the device concerned;

(v) where, after the registration, the owner of the utility model right has become a person who can no longer enjoy such right under Section 25 of the Patent Law as applied under Section 55(3) of this Law or the registration no longer complies with a treaty.

(2) Even after the extinguishment of a utility model right, a trial under the preceding subsection may be demanded.

(3) Where a trial under subsection (1) has been demanded, the trial examiner-in-chief shall notify the exclusive licensee with respect to the utility model right and other persons who have any registered rights relating to the utility model registration.

38. — Where a utility model registration has been effected for a device which was described in a publication distributed in a foreign country prior to the filing of the utility model application or for a device which could very easily have been made on the basis of such device by a person with ordinary skill in the art to which such device pertains, a trial on the utility model registration may not be demanded under Section 37(1) after three years from the registration of the establishment of the utility model right.

(Trial for correction)

39. — (1) The owner of a utility model right may demand a trial for correction of the specification or drawings attached to a request only where such correction has any of the following objects:

(i) the restriction of the claim;

(ii) the correction of errors in the description;

(iii) the clarification of an ambiguous description.

(2) The correction of the specification or drawings under the preceding subsection may not be such as to substantially enlarge or modify the claim.

(3) In the case of subsection (1)(i), a device constituted by the features described in the corrected claim must be one which could independently have been registered as a utility model at the time of filing of the utility model application.

(4) A trial under subsection (1) may be demanded even after the extinguishment of the utility model right. However, this provision shall not apply after the registration has been invalidated on a trial under Section 37(1).

(Trial for invalidation of correction)

40. — (1) Where the specification or the drawings attached to a request have been corrected contrary to Section 39(1) to (3), a trial for the invalidation of the correction may be demanded.

(2) Section 37(2) and (3) shall apply mutatis mutandis to demands for the trial under the preceding subsection.

(Application mutatis mutandis of Patent Law)

41. — Sections 125, 127, 128, 130 to 154, 155(1) and (2) and 156 to 170 (effects of trial decision; demands for trial; trial examiners; trial proceedings; relationship with litigation, and costs of trial) of the Patent Law shall apply mutatis mutandis to trials under this Law.

Chapter VI — Retrial and Litigation

(Demand for retrial)

42. — (1) Any party may demand a retrial against a final and conclusive trial decision.

(2) Sections 420(1) and (2) and 421 (grounds for retrial) of the Code of Civil Procedure (Law No. 29 of 1890) shall apply mutatis mutandis to demands for a retrial under the preceding subsection.

43. — (1) Where the demandant and the defendant in a trial have in collusion caused a trial decision to be rendered, with the purpose of injuring the rights or interests of a third person, such person may demand a retrial against the final and conclusive trial decision.

(2) In such a retrial, the demandant and the defendant shall be made joint defendants.

(Restriction on effects of utility model right restored by retrial)

44. — (1) Where a utility model right relating to an invalidated utility model registration has been restored through a retrial or where the establishment of a utility model right with respect to a utility model application which was refused by a trial decision has been registered through a retrial, the effects of the utility model right shall not extend

to any article covered by the registered utility model which was imported into Japan, or manufactured or acquired there, in good faith after the time when the trial decision became final and conclusive but before the demand for a retrial was registered.

(2) Where a utility model right relating to an invalidated utility model registration has been restored through a retrial or where the establishment of a utility model right with respect to a utility model application which was refused by a trial decision has been registered through a retrial, the effects of the utility model right shall not extend to the following acts:

(i) the exploitation of the device in good faith after the trial decision became final and couclusive but before the registration of the demand for a retrial;

(ii) acts of manufacturing, assigning, leasing, displaying for the purpose of assignment or lease, or importing, in good faith, of elements to be used exclusively for the manufacture of articles covered by the registered utility model, after the trial decision became final and conclusive but before the registration of the demand for a retrial.

(Application mutatis mutandis of Patent Law)

45. — Section 173 (time limit for demand for retrial), Section 174 (application of provisions on trial, etc.) and Section 176 (non-exclusive license due to working before registration of demand for retrial) of the Patent Law shall apply mutatis mutandis to retrials under this Law.

46. — *Deleted*

(Actions against trial decisions, etc.)

47. — (1) An action against a trial decision or a ruling to decline an amendment under Section 53(1) of the Patent Law as applied under Section 159(1) of the Patent Law as applied *either* under Section 41 of this Law *or* under Section 174(1) of the Patent Law as applied under Section 45 of this Law or an action against a ruling of dismissal of a demand for a trial or retrial shall come under the exclusive jurisdiction of the Tokyo High Court.

(2) Section 178(2) to (6) (time limit for institution of action, etc.) and Sections 179 to 182 (defendant in the action; notification of institution of action; annulment of the trial decision or ruling, and sending of certified copy of the judgment) of the Patent Law shall apply mutatis mutandis to actions under the preceding subsection.

(Action on amount of remuneration)

48. — (1) Where a person who is concerned in an arbitration decision under Section 21(2), 22(2) or 23(2) is dissatisfied with the amount of remuneration fixed in the decision, he may institute an action for the increase or decrease of the remuneration.

(2) Section 183(2) (time limit for institution of action) and Section 184 (defendant in the action) of the Patent Law shall apply mutatis mutandis to actions under the preceding subsection.

(Relationship between administrative appeal and litigation)

48bis. — Section 184bis (relationship between administrative appeal and litigation) of the Patent Law shall apply mutatis mutandis to actions for the annulment of measures (with the exception of measures under Section 55(6)) taken under this Law or an order or ordinance thereunder.

Chapter VII — Miscellaneous Provisions

(Registration in Utility Model Register)

49. — (1) The following matters shall be registered in the Utility Model Register kept in the Patent Office:

(i) the establishment, transfer, extinguishment or restriction on disposal of a utility model right;

(ii) the establishment, maintenance, transfer, modification, extinguishment or restriction on disposal of an exclusive or non-exclusive license;

(iii) the establishment, transfer, modification, extinguishment or restriction on disposal of rights in a pledge upon a utility model right or an exclusive or non-exclusive license.

(2) The Utility Model Register, either in whole or in part, may be prepared by means of magnetic tapes (including other materials on which matters can be accurately recorded by an equivalent method — hereinafter referred to as " magnetic tapes ").

(3) Other matters relating to registration that are not provided for in this Law shall be prescribed by Cabinet Order.

(Issuance of utility model registration certificate)

50. — (1) When the establishment of a utility model right has been registered or when a trial decision to the effect that the specification or drawings attached to the request are to be corrected has become final and conclusive and such decision has been registered, the President of the Patent Office shall issue a utility model registration certificate to the owner of the utility model right.

(2) Re-issuance of the certificate shall be prescribed by ordinance of the Ministry of International Trade and Industry.

(Indication of existence of utility model registration)

51. — The owner of a utility model right or an exclusive or non-exclusive license shall take steps, as prescribed in an ordinance of the Ministry of International Trade and Industry, to mark the articles covered by a registered utility model or their packaging with a statement to the effect that the articles are covered by a registered utility model (hereinafter referred to as " indication of a utility model registration ").

(Prohibition of false marking)

52. — The following acts shall be unlawful:

(i) the marking of an article not covered by a registered utility model, or the packaging of such article, with an indication of a utility model registration or confusingly similar indication;

(ii) the assignment, lease or display for the purpose of assignment or lease of an article not covered by a registered utility model, where such article or its packaging is marked

with an indication of a utility model registration or confusingly similar indication;

(iii) the inclusion in an advertisement of an indication that an article is covered by a registered utility model or a confusingly similar indication, for the purpose of causing others to manufacture or use the article or of assigning or leasing the article, where it is not covered by a registered utility model.

(Utility Model Gazette)

53. — (1) The Patent Office shall publish the Utility Model Gazette *(Jitsuyôshinan Kôhô)*.

(2) Section 193(2) (matters to be published in the Patent Gazette) of the Patent Law shall apply mutatis mutandis to the Utility Model Gazette.

(Fees)

54. — (1) The persons specified in the left-hand column of the attached table [2] shall pay the fee prescribed by Cabinet Order within the limit of the amounts specified in the right-hand column of the table.

(2) The preceding subsection shall not apply where the person specified in the left-hand column of the table is the State.

(3) A fee paid by mistake or in excess shall be refunded upon the request of the person making the payment.

(4) No request for a refund of a fee under the preceding subsection may be made after one year from the date of payment.

(5) Section 195bis (reduction of fee for requests for examination or exemption therefrom) of the Patent Law shall apply mutatis mutandis to the fee for requests for examination with respect to a utility model application.

(Application mutatis mutandis of Patent Law)

55. — (1) Sections 3 to 5 (time limits and dates) of the Patent Law shall apply mutatis mutandis to the time limits and dates prescribed in this Law.

(2) Sections 6 to 24 and 194 (proceedings) of the Patent Law shall apply mutatis mutandis to utility model applications, demands and any other proceedings relating to utility model registrations.

(3) Section 25 (enjoyment of rights by aliens) of the Patent Law shall apply mutatis mutandis to utility model rights and other rights relating to utility model registrations.

(4) Section 26 (effect of treaties) and Section 186 (request for certification, etc.) of the Patent Law shall apply mutatis mutandis to utility model registrations.

(5) Sections 189 to 192 (transmittal) of the Patent Law shall apply mutatis mutandis to transmittal under this Law.

(6) Section 195ter (restriction on appeals under Administrative Appeal Law) of the Patent Law shall apply mutatis mutandis to rulings to decline an amendment, examiners' decisions, trial decisions and rulings of dismissal of a demand for trial or retrial under this Law as well as to measures from which no appeal lies under this Law.

Chapter VIII — Penal Provisions

(Offense of infringement)

56. — (1) Any person who has infringed a utility model right or an exclusive license shall be liable to imprisonment with labor not exceeding three years or to a fine not exceeding 300,000 yen.

(2) Any person who has infringed the right under Section 12(1) or the right under Section 52(1) of the Patent Law as applied *either* under Section 159(3) or 161ter(3) of the Patent Law as applied under Section 41 of this Law *or* under Section 159(3) of the Patent Law as applied under Section 174(1) of the Patent Law as applied under Section 45 of this Law shall be liable to imprisonment with labor not exceeding three years or to a fine not exceeding 300,000 yen, but only where the establishment of the utility model right has been registered.

(3) The prosecution for the offenses under the two preceding subsections shall be initiated upon complaint.

(Offense of fraud)

57. — Any person who has obtained a utility model registration or a trial decision by means of a fraudulent act shall be liable to imprisonment with labor not exceeding one year or to a fine not exceeding 100,000 yen.

(Offense of false marking)

58. — Any person infringing Section 52 shall be liable to imprisonment with labor not exceeding one year or to a fine not exceeding 100,000 yen.

(Offense of perjury, etc.)

59. — (1) A witness, expert witness or interpreter who, having taken an oath under this Law, has made a false statement or has given a false expert opinion or has interpreted falsely before the Patent Office or a court commissioned thereby shall be liable to imprisonment with labor for a term of not less than three months nor more than ten years.

(2) Where a person committing the offense in the preceding subsection has made a voluntary confession before the examiner's decision or trial decision concerning the case has become final and conclusive, his sentence may be reduced or suppressed.

(Offense of divulging secrets)

60. — Where any present or former official of the Patent Office has divulged or made surreptitious use of the secrets relating to a device in a utility model application to which he had access in the course of his duties, he shall be liable to imprisonment with labor not exceeding one year or to a fine not exceeding 50,000 yen.

(Dual liability)

61. — Where an officer representing a legal entity or a representative, employee or any other servant of a legal entity or of a natural person has committed an act in violation of

[2] This table is not published here.

Section 56(1) or (2), 57 or 58, with regard to the business of the legal entity or natural person, the legal entity or the natural person shall, in addition to the offender, be liable to the fine prescribed in those sections.

(Administrative penalties)

62. — Where a person who has taken an oath under Section 267(2) or 336 of the Code of Civil Procedure — as applied under Section 151 of the Patent Law as applied *either* under Section 41 of this Law *or* under Section 59 of the Patent Law as applied under Section 13 of this Law *or* under Section 59 of the Patent Law as applied under Section 161ter(3) of the Patent Law as applied under Section 41 of this Law *or* under Section 174(1) to (4) of the Patent Law as applied under Section 45 of this Law — has made a false statement before the Patent Office or a court commissioned thereby, he shall be liable to an administrative penalty not exceeding 5,000 yen.

63. — Where a person who has been summoned by the Patent Office or a court commissioned thereby in accordance with this Law has failed to appear or has refused to take an oath, to make a statement, to testify, to give an expert opinion or to interpret, without a legitimate reason, he shall be liable to an administrative penalty not exceeding 5,000 yen.

64. — Where a person who has been ordered by the Patent Office or a court commissioned thereby to produce or show documents or other evidence in accordance with the provisions of this Law relating to the examination or preservation of evidence has failed to comply with the order, without a legitimate reason, he shall be liable to an administrative penalty not exceeding 5,000 yen.

Supplementary Provision
(Law No. 123 of 1959)

The entry into force of this Law shall be established by another law.

Supplementary Provisions
(Extract from Law No. 91 of 1970)

(Entry into force)

1. — This Law shall enter into force on January 1, 1971.

. . .

(Transitory measures incident to revision of Utility Model Law)

6. — Sections 2 to 5 of these Supplementary Provisions [3] shall apply mutatis mutandis to the transitory measures that are incident to the revision of the Utility Model Law under Section 2.

. . .

(Delegation to Cabinet Order)

9. — In addition to those provided for in the preceding sections, the transitory measures necessary for the implementation of this Law shall be prescribed by Cabinet Order.

[3] See *Industrial Property*, 1974, p. 165.

ITALY

Decrees concerning the Temporary Protection of Industrial Property Rights at Exhibitions

(of November and December 1973, and January 1974) *

Sole Section

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

VIII° ESPOSUDHOTEL — Salone internazionale delle attrezzature alberghiere, turistiche e di pubblico esercizio per il Mezzogiorno e l'Oltremare (Naples, January 19 to 27, 1974);

VI° SIVEL — Salone italiano dei vini e dei liquori (Naples, January 19 to 27, 1974);

Mostra internazionale dell'oreficeria, gioielleria e argenteria (Vicenza, January 20 to 27, 1974);

XII° Salone internazionale del giocattolo (Milan, January 24 to 31, 1974);

Salone mercato internazionale dell'abbigliamento "SAMIA" e di "MODASELEZIONE" (Turin, February 8 to 11, 1974);

MACEF Primavera 1974 — Mostra mercato internazionale degli articoli casalinghi, cristallerie, ceramiche, argenterie, articoli da regalo, ferramenta e utensileria (Milan, February 9 to 12, 1974);

Salone internazionale della ceramica (Vicenza, February 9 to 14, 1974);

XI° Salone internazionale macchine per movimenti di terra, da cantiere e per l'edilizia — SA.MO.TER (Verona, February 10 to 17, 1974);

MODA-MAGLIA — Salone della maglieria italiana and *MODA-INTIMA — Salone dell'abbigliamento intimo* (Bologna, February 19 to 22, 1974);

II° EXPOMOTOR (Milan, February 28 to March 4, 1974);

XV^a Mostra convegno internazionale riscaldamento, condizionamento refrigerazione idrosanitaria (Milan, March 1 to 7, 1974);

VIII° Salone internazionale delle vacanze e del turismo vacanze '74 (Turin, March 1 to 11, 1974);

Mostra-Convegno "I controlli numerici" (Milan, March 4 to 8, 1974);

MIAS — Mercato internazionale dell'articolo sportivo (Milan, March 9 to 12, 1974);

I° EUROCUCINA — Salone internazionale biennale dei mobili per cucina (Milan, March 9 to 12, 1974);

XXVIII^a Presentazione internazionale moda della calzatura (Bologna, March 9 to 12, 1974);

* Official communications from the Italian Administration.

Rassegna internazionale elettronica nucleare e teleradiocinematografica (Rome, March 12 to 24, 1974);

LXXVI^a Fiera internazionale dell'agricoltura e della zootecnia and *XXVII^o Salone della macchina agricola* (Verona, March 14 to 24, 1974);

XI^o Salone internazionale delle arti domestiche — CASA '74 (Turin, March 28 to April 8, 1974);

IV^o EXSPORT LEVANTE — Fiera internazionale dello sport e del tempo libero (Bari, March 30 to April 7, 1974);

XI^a Fiera internazionale del libro per ragazzi, VIII^a Mostra internazionale degli illustratori and *II^o Salone internazionale dell'editoria scolastica* (Bologna, April 4 to 7, 1974);

LII^a Fiera di Milano — Campionaria internazionale (Milan, April 14 to 25, 1974);

XXXVIII^a Mostra-mercato internazionale dell'artigianato (Florence, April 23 to May 5, 1974);

III^o Salone internazionale bottoni ed affini — SIBA (Piacenza, April 26 to 29, 1974);

VII^o COSMOPROF — Salone internazionale della profumeria e cosmesi (Bologna, April 27 to May 1, 1974);

Rassegna suinicola internazionale (Reggio Emilia, April 28 to May 1, 1974);

I^o ENVIRONMENT '74 — Salone internazionale sull'uomo e l'ambiente (Turin, May 4 to 12, 1974);

II^o MARMOLEVANTE — Salone internazionale del marmo, delle macchine e degli accessori (Bari, May 4 to 12, 1974);

IV^a Mostra internazionale di ottica, optometria ed oftalmologia — MIDO (Milan, May 10 to 14, 1974);

IV^o INTERBIMALL — Biennale internazionale delle macchine ed accessori per la lavorazione del legno (Milan, May 18 to 25, 1974);

XXIX^a Fiera del Mediterraneo — Campionaria internazionale (Palermo, May 25 to June 9, 1974);

VI^o MOBILEVANTE — Fiera internazionale del mobile e dell'arredamento per il Mezzogiorno d'Italia e i Paesi del Levante (Bari, May 30 to June 4, 1974);

XXI^a Mostra internazionale avicola (Varese, June 1 to 5, 1974);

XXXVIII^a Fiera campionaria internazionale di Bologna (Bologna, June 5 to 16, 1974);

XVII^o S. I. A. — Salone internazionale dell'alimentazione (Bologna, June 5 to 16, 1974);

Mostra internazionale dell'oreficeria, gioielleria e argenteria (Vicenza, June 9 to 16, 1974);

VI^a Fiera del tempo libero (Messina, June 19 to 30, 1974);

XXXV^a Fiera di Messina — Campionaria internazionale (Messina, August 3 to 18, 1974);

Mostra nazionale delle sementi ed attrezzature sementiere (Vicenza, September 6 to 8, 1974);

MODA MAGLIA — Salone della maglieria italiana and *MODA INTIMA — Salone dell'abbigliamento intimo* (Bologna, September 12 to 15, 1974);

XXIV^o Salone internazionale della tecnica and *XI^o Salone internazionale della montagna* (Turin, September 28 to October 7, 1974);

VI^o Salone internazionale delle attività zootecniche — EUROCARNE (Verona, October 3 to 7, 1974);

X^o SAIE — Salone internazionale dell'industrializzazione edilizia (Bologna, October 5 to 13, 1974);

MIAS — Mercato internazionale dell'articolo sportivo (Milan, October 6 to 8, 1974);

IX^a Biennale italiana della macchina utensile — BI-MU (Milan, October 6 to 13, 1974);

Mostra nazionale specializzata della conceria, pelli e cuoio (Vicenza, November 29 to December 1, 1974);

VIII^e Giornate del vino italiano — VINITALY (Verona, December 4 to 8, 1974)

shall enjoy the temporary protection established by the decrees mentioned in the preamble [1].

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[1] Royal Decrees No. 1127 of June 29, 1939, No. 1411 of August 25, 1940, No. 929 of June 21, 1942 and Law No. 514 of July 1, 1959. (See *La Propriété industrielle*, 1939, p. 124; 1940, pp. 84 and 196; 1942, p. 168; 1960, p. 23.)

LETTERS FROM CORRESPONDENTS

Letter from Switzerland

Edouard PETITPIERRE *

Since my last Letter, published in 1969 [1], there have been developments in the industrial property decisions of the Federal Court. The purpose of this Letter is to give an outline of this new case law.

PATENTS

1. Under Section 7(1)*(b)* of the Swiss Patent Law of 1954 [2] an invention is considered new when, prior to the filing of the patent application, " it has not been disclosed, by writing or illustration, in any publication in such a way as to enable it to be carried out by a person skilled in the art. "

What is to be understood by " disclosed "?

In the view of the Federal Court, the purpose of Section 7 of the Patent Law is to prevent technology which is part of the common heritage from being removed for the benefit of a particular individual. The novelty of an invention and the idea of disclosure must therefore be viewed from an objective standpoint. An invention will be disclosed when it is accessible to an indeterminate number of people, irrespective of the manner of publication, the place and the language; there is no need for a printed publication and a single copy is sufficient. In France, for example, anyone may seek information from the Patent Office as soon as a patent has been granted: the fact that such information may be difficult to obtain before publication in the official gazette is irrelevant [3].

2. In the context of the constituent elements of technical advance and inventive level, the Federal Court has rendered an interesting decision concerning a patented invention resembling the description of a watch which had appeared in a periodical over 50 years before the patent application was filed.

For the subject of a patent to be an invention, it is not sufficient that it is new: it must also represent a *technical advance* and be the product of a creative idea having a certain degree of originality *(inventive level)*. The court of first instance had felt that the patent concerned did not represent any technical advance and did not have sufficient inventive level, in view of the watch described earlier. The Federal Court noted that, in order to determine whether an invention was new, reference was sometimes made to earlier achievements or publications which were outside the knowledge or at least the memory of persons working in the field. Thus, the prior art considered in the case of *novelty* was of a fictitious character. On the other hand, in the case of *technical advance* and *inventive level*, the prior art to be considered must be based on the *actual* knowledge of persons skilled in the art; an earlier invention must be taken into consideration only where it had actually had an impact on the prior art.

Where a periodical widely distributed in professional circles described a new process or device, it could be assumed that persons in the trade had noted it and that the process or device had become part of the prior art. No such assumption could be made, however, where the description was a very old one, having no impact on technology. In the case before the Federal Court, the publication in which the earlier description had appeared was a scientific review of a general nature and was not therefore the kind of technical documentation used by watchmakers. Moreover, the review had had no impact on technology, or at least no longer had at the time when the patent application had been filed. On this point, therefore, the decision appealed against was based on an erroneous conception of prior art [4].

3. Section 27(1) of the Patent Law provides that, " when only part of an invention is affected by nullity, the court shall restrict the patent accordingly. "

As mentioned in my last " Letter, " [5] the Patent Law does not specify how a court should proceed in order to restrict a patent but, according to case law, it may apply Section 24(1) by analogy. This provision allows a patentee to make a partial surrender of his patent, in other words to request *(a)* the removal of a claim or dependent claim, *(b)* the restriction of a claim by joining to it one or more dependent claims, or *(c)* the restriction of a claim in another way, provided that the claim thus restricted relates to the same invention and specifies a form of carrying it out which is to be found both in the published disclosure of the invention and in the description lodged with the Industrial Property Office at the time the application was filed.

The Federal Court has ruled that when a patent is being restricted under alternative *(c)* above, the court must start from the idea that the scope of protection of an invention is determined by the claim or claims, and that the description and drawings serve only to interpret, and not to supplement, the claims (Sections 50 and 51 of the Patent Law). A restriction will only be admissible where a person skilled in the art can deduce from the complete disclosure of the invention that an essential element is constituted by a statement contained only in the description or in the drawings and now introduced in the claim. The claim, thus restricted, must relate to the same invention; in other words, it must solve the same problem using the same kind of means.

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1 *Industrial Property*, 1969, p. 313.

2 *La Propriété industrielle*, 1955, p. 200.

3 *Bertil Wigemark A. G.* v. *Traber*, December 3, 1968, Arrêts du Tribunal fédéral (ATF) 94 II 285, Journal des Tribunaux (JT) 1969 I 630.

4 *Fabrique de montres Vulcain and Studio S. A.* v. *Charles Aerni S. A. and Others*, December 10, 1968, ATF 94 II 319, JT 1969 I 631.

5 See *Industrial Property*, 1969, p. 314.

Section 24(1)*(c)* of the Patent Law must be interpreted restrictively: the invention protected by the patent as restricted must have been included in the original claim. Moreover the court may not raise to the status of a patentable invention an element mentioned incidentally in the description or drawings which a person skilled in the art would not clearly recognize as an essential feature of the invention [6].

4. Under Section 66*(b)* of the Patent Law, civil and criminal proceedings may be brought against " any person who refuses to disclose to the competent authority the source of unlawfully manufactured goods in his possession. "

The Federal Court has ruled that this duty to provide information also applies to a supplier who is no longer in possession of the goods, even if they were lawfully manufactured abroad but unlawfully imported into Switzerland [7].

5. In the case of infringement a patentee may bring an action for damages against the infringer, under Section 73 of the Patent Law, provided that he proves the extent of the damage. He may also demand the restitution of the profits gained, by virtue of Section 423 of the Code of Obligations. The Federal Court has ruled that these two claims are mutually exclusive. However, a patentee who decides to sue for damages may, for the assessment of the damage, invoke the profits gained by the defendant provided that he is able to establish that he himself could have made the same transactions as the defendant and would have made at least the same amount of profits [8].

6. Section 66 of the Patent Law makes unlawful not only the infringement (in a narrower sense) of a patented invention but also its imitation.

According to the Federal Court, infringement (in this narrower sense) is constituted not only by the slavish reproduction of a form mentioned in the patent of carrying out the invention or the slavish reproduction of an article marketed by the patentee, but also by the concretization of all the elements characterizing the invention according to the letter or the spirit of the claim, which determines the scope of protection conferred (Section 51(2)).

On the other hand, there is an imitation when the product concerned deviates from the technical teaching of the invention only in secondary respects, in such a way that a person skilled in the art with a good professional training could make a similarly differing product on the basis of such teaching without having any new creative idea [9]. Imitation, as the Federal Court has said in another case [10], has not been defined by the legislature, which seeks to give an inventor protection beyond the bounds of infringement in the narrow sense by covering the full extent to which the inventor has enriched technology. The courts must therefore not confine their examination to the question whether an alleged imitation contains all the elements of the claim. They must rather isolate the essential features of the invention in the claim and ascertain whether they have been used by the alleged imitator.

7. In the field of licensing, mention should be made of the case of *Parke Davis and Co.* v. *Lamar S. A. and Arco S. A.* [11]. The problem raised was whether a licensee who did not work the patent was bound to pay royalties when the license contract contained no provision in this respect.

The defendants, holders of a non-exclusive license granted by the plaintiff, had informed the latter that they were not going to exercise their rights under the license during a specified period and that they would suspend payment of royalties during that period. They maintained that a non-exclusive licensee was under no obligation to make use of his license or to pay royalties if he in fact did not make use of it.

Rejecting this argument, the Federal Court first pointed out that in principle any license, whether exclusive or not, might or might not carry an obligation to exploit it. All that could be said for certain was that, in the case of an exclusive license, where there was doubt regarding the obligation to exploit, there would be a tendency to presume such an obligation existed, whereas the opposite presumption would be made in the case of a non-exclusive license. It could not therefore be argued, without more, that a non-exclusive license could not carry the obligation to exploit: everything would depend on the contract and its interpretation.

If there was an obligation to exploit and the licensee failed to comply with it, it was obvious that, even in the case of a non-exclusive license, royalties would continue to be payable. But what if there was no obligation to exploit? According to the defendants, they were no longer liable for royalties. " But this, " the Federal Court declared, " would be to overlook the fact that a license, even if it is non-exclusive and even if it contains no obligation to exploit, gives the licensee a right (Section 34 of the Patent Law: " may authorize third parties to use the invention " — in German, *einen anderen zur Benützung der Erfindung ermächtigen*). The consideration furnished by the licensor is indeed this right of use which he grants to the licensee . . .; it is irrelevant whether the license is or is not exclusive or whether or not it entails an obligation to exploit. By carrying out his obligation the patentee transfers an economic asset and is thereby entitled to some consideration in return, irrespective of any actual exploitation. "

The decision deduces from this that the right to royalties is in principle not subject to the exercise of the right granted, unless otherwise agreed by the parties. In particular, where there is a license contract containing no obligation to exploit and providing for fixed royalties — even periodical royalties as in the case in point — such royalties must be unconditional, that is, unrelated to the use of the patent. The Federal Court added that the continuing liability to pay royalties was all the more justified since in most cases the stipulation for

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[6] *YGNIS Kessel A. G.* v. *Aktiengesellschaft IDAG*, March 26, 1969, ATF 95 II 364, JT 1969 I 633.

[7] *Merck et Co* v. *Hansgeorg Leisinger*, March 16, 1971, ATF 97 II 169, JT 1971 I 612.

[8] *Merck et Co* v. *Hansgeorg Leisinger*, March 16, 1971, ATF 97 II 169, JT 1971 I 612; *Charles Aerni S. A. and Others* v. *Vulcain and Studio S. A.*, June 27, 1972, ATF 98 II 325.

[9] *Stamm* v. *Carl Sigerist & Co.*, February 10, 1971, ATF 97 II 85, JT 1971 I 611.

[10] *Charles Aerni S. A. and Others* v. *Vulcain and Studio S. A.*, June 27, 1972, ATF 98 II 325.

[11] Of February 10, 1971, ATF 96 II 154.

royalties was based on the need for a contribution by the licensee to the investment made in the patent.

8. Another question which has already arisen several times in connection with licensing is whether a licensee may bring an action against his licensor for a declaration of nullity of the patent. The Federal Court has had occasion to reaffirm its earlier decisions on this subject.

In *Arquint* v. *Tüscher frères et Cie* [12] the Court had held that the question whether a licensee could sue the patentee for a declaration of nullity had to be decided on a case-by-case basis. It had added that where a license created a legal relationship between the parties comparable to that of a partnership contract, the rules of good faith in principle prevented the licensee from bringing revocation proceedings. However, in addition to the specific interests of the partnership, there were the individual interests of each of the partners, as was shown by the action for dissolution of a partnership for legitimate reasons. Depending on the circumstances therefore, the interests of a partner might take precedence over those of the partnership.

In the *Arquint* case the licensee, who had a legitimate interest in having the matter of the validity of the patent clarified, had asked the patentee in vain to take proceedings against a number of infringers. The Federal Court had recognized his right to bring a revocation action, as the licensor had been visibly reluctant to take proceedings himself.

On March 22, 1949, the Federal Court had added [13] that, even in the absence of a fiduciary relationship, the action of the licensee was inadmissible if the license had been granted because the validity of the patent seemed questionable and the patentee had wished to avoid any discussion on the subject. In such a case the licensee's action would be inadmissible, even without an express renunciation on his part.

The Federal Court confirmed all these principles in *Werner Von Puell* v. *Charles H. R. Wunderly* on June 24, 1969 [14].

TRADEMARKS

1. Trademarks are still under the system established by the Law on the Protection of Trademarks of 1890 [15].

Section 14(1)(ii) of the Trademark Law provides that registration of a trademark may be refused inter alia where it is contrary to morality or includes, as its essential feature, a sign to be considered as coming within the public domain.

According to established case law, trademarks are in particular considered contrary to morality where they are liable to mislead as to the origin of a product, for instance those which contain a geographical indication bringing to mind a country which is not the country of origin of the product, unless it is immediately clear that the mark is a fanciful name having nothing to do with the origin of the goods.

Marks or components of marks that suggest a source which is not the place of manufacture have thus been held inadmissible by the Federal Court [16]. Moreover, it has held that if the average Swiss purchaser has always associated a geographical term with a given country, a mark incorporating such a term and used for goods originating elsewhere will be unregistrable even though the term may also be indicative of a region in the country of origin of the goods and the mark itself is in fact protected there [17].

Finally the Federal Court has held that such geographical names, belonging to the public domain, should be kept free for any person who wishes to market goods coming from the town or region bearing that name [18]. The Court has also held marks that are indicative of the properties or quality of the goods to which they relate to belong to the public domain and not to be capable of monopolization by a particular person [19].

In another context, an international mark of German origin, "Santi deutsches Erzeugnis," was found to be both deceptive and also to contain a fictitious trade name contrary to Section 14(1)(iv) of the Trademark Law. The Federal Court held that the word "Santi" was a surname and led to the assumption that the applicant or his goods were in some way related to a person with the surname of Santi. The mark was therefore not accepted for registration in Switzerland [20].

2. Swiss Law makes unlawful not only the reproduction of another's mark, but also its imitation in such a way as to mislead the public (Section 24*(a)* of the Trademark Law). In a number of recent decisions the Federal Court has repeated some of the principles applicable here:

In judging whether two marks are so likely to be confused as to be misleading, account is taken of the overall impression created by the two marks on the memory of the average purchaser. As he generally does not have both marks before him at the same time, account is taken of the fact that the memory does not usually record details. What also has to be considered is the set of circumstances in which the purchase of articles of the same kind generally takes place. Any figurative elements in a mark usually prevail over the word elements. The purchasers of common articles produced in large quantities for everyday use make their purchases without paying much attention, so that the possibility of confusion must be examined particularly strictly where those articles are concerned [21].

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[12] Decision of February 20, 1935, ATF 61 II 138, JT 1935 I 537.
[13] *Solca* v. *Rosenberger and Hollinger*, ATF 75 II 166, JT 1950 I 9.
[14] ATF 95 II 271, JT 1969 I 634.
[15] *La Propriété industrielle*, 1890, p. 123.

[16] *Bauer* v. *Federal Bureau of Intellectual Property*, July 8, 1969, ATF 95 I 472, JT 1970 I 623 (inadmissibility of the component "Slivowitz Herzegowina" of an international mark for slivowitz manufactured in Austria and not in Yugoslavia).
[17] *Th. G. Mautner Markhof* v. *Federal Bureau of Intellectual Property*, May 20, 1970, ATF 96 I 251, JT 1970 I 625 (refusal to register the international mark "Pussta Senf" for mustard manufactured in Austria and not in Hungary).
[18] *Interfood S. A.* v. *Federal Bureau of Intellectual Property*, January 26, 1971, ATF 97 I 79, JT 1971 I 513 (unregistrability of the mark "Cusco" or "Cusko" for chocolate and cocoa: Cuzco — or Cusco — being the name of one of the principal cities of Peru, having a chocolate factory and with cocoa cultivated in its neighborhood, must be kept free for any person wishing to manufacture cocoa products from that city or its region).
[19] *Sektkellerei Carstens A. G.* v. *Federal Bureau of Intellectual Property*, February 3, 1970, ATF 96 I 248, JT 970 I 624 (refusal of protection to the international mark "Dominant" for wine and other beverages).
[20] *André Hofer-Lebensmittel Gesellschaft m. b. H.* v. *Federal Bureau of Intellectual Property*, February 22, 1972, ATF 98 I b 6, JT 1972 I 624.
[21] *A. G. Chocolat Tobler* v. *Rast A. G.*, April 1, 1969, ATF 95 II 191, JT 1969 I 627; *F. J. Burrus et Cie* v. *S. A. Laurens Le Khédive extension suisse*, May 6, 1969, ATF 95 II 461, JT 1970 I 619.

For cosmetics in everyday use, it bas in particular been held that differences between marks must be especially striking, since these articles are bougbt by a wide public, who cannot be expected to pay very great attention [22].

It is worth mentioning two more cases in which the Federal Court held that there was a risk of confusion.

The firm Luwa A. G. had had the mark "Luwa," and then "Luwair," "Uniluwa," "Luwag," "Luwers" and "Luwette" registered for ventilation and heating appliances. Another firm subsequently filed the mark "Lumatic" for humidifiers. The Federal Court held that the new mark infringed the "Luwa" mark, as the syllable "tic" was too weak to distinguish "Lumatic" from the mark "Luwa," and that the public might easily be led to believe that the new mark was an addition to Luwa's series of registered marks [23].

The second case, to be dealt with in a little more detail, is that of a French firm which had filed the mark "Sheila Diffusion," for ladies' clothing, first in France and then with the International Bureau. Registration in Switzerland was refused by the Federal Court on three grounds:

The first was that the word "diffusion" combined with the name "Sheila" conveyed the impression (false in the case concerned) that the person selling the articles bearing the mark was called Sheila or had included that name in her (or his) trade name. Tbus the case involved a fictitious trade name, contrary to Section 14(1)(iv) of the Trademark Law.

Second, the same provision also prohibits the use of a mark which imitates or reproduces another person's trade name, except where tbis is justified by a link between the owner of the mark and the third party. In January 1964, with the support of tbe singer Annie Chancel, better known today under her pseudonym Sheila, a firm was set up in Paris under the name "La Boutique de Sheila S. A." The Court considered that the mark "Sheila Diffusion" was clearly an imitation or usurpation of that trade name. The fact that the firm in question was not entered in the Swiss Register of Commerce was irrelevant; the purpose of Section 14(1)(iv) was to prevent deception of the public, not to protect the right to a trade name.

Finally, the reaction of many of the Swiss customers to the name Sheila was immediately to think of the pseudonym of Annie Chancel; there was tbus a risk that the public might consider the articles bearing the mark to be in some way related to the singer. The risk of deception was all the greater in that the singer had given her support to an enterprise dealing in ladies' clothing [24].

It is interesting to compare this decision with the one rendered by the Federal Court in 1966 in the case *Chancel* v. *Société anonyme des produits Clermont et Fouet* [25]. In that action Annie Chancel, whose pseudonym Sheila had not yet become as widely known as it is today, failed to obtain the cancellation of the mark "Sheila" for perfumes, filed in 1963 by the firm Clermont and Fouet.

3. Swiss law allows the owner of a mark who is being sued for infringement of an earlier mark to plead as an effective defense that the plaintiff's mark is itself not sufficiently distinguishable from a still earlier mark belonging to a third party [26].

There is a well-established case law here. However, the Federal Court has rejected this defense where the third party's mark relied upon by the defendant is in fact the original mark of a group to which the plaintiff belongs [27].

4. When are goods of a totally different nature?

The need to remove all risk of confusion between two marks does not apply to those intended for use in connection with goods of a totally different nature (Section 6(3) of the Trademark Law). For this to be the case, it is not sufficient that it is impossible to confuse the goods, that they serve different purposes or that they do not belong to the same classes: there must not be any affinity between them whicb migbt make the end purchaser attribute them to the same manufacturer or dealer [28].

5. Under Article 5C(1) of the Paris Convention, if, in any country, use of a registered mark is compulsory, tbe registration may be cancelled only after a reasonable period, and then only if the person concerned does not justify his inaction.

To take account of this provision, a Section 9(1) was inserted in tbe Swiss Trademark Law in 1939; it provides tbat, if the owner of a mark does not use it during tbree consecutive years, the courts may, at the request of another interested party, order the cancellation of the mark, unless the owner is able to justify his failure to use it.

Under tbe system still in force in Switzerland filing and registration are not constitutive of a right to a mark; they are merely necessary for its enforcement in the courts and valuable as evidence (Sections 4 and 5 of the Trademark Law); a mark is protected only insofar as the owner uses it. Section 9(1) is therefore an exception to the rule in that it affords provisional protection to unused marks, whether registered marks whose use has been temporarily discontinued or marks which have been filed and registered but not yet used.

Tbe Federal Court has recently ruled, however, that if at the time of filing the owner is found to have no serious intention of using the mark within the three-year waiting period laid down in Section 9 of the Trademark Law, the Office must

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[22] *Stabilimenti Chimici Arlem di Levi Gino* v. *Elizabeth Arden GmbH*, June 17, 1969, ATF 95 II 354, JT 1970 I 622; *Helena Rubinstein S. A. Paris and Helena Rubinstein S. A. Spreitenbach* v. *Denner Vereinigte Filialunternehmen A. G. Zürich and Denner Supermarkt A. G. Zürich*, December 1, 1970, ATF 96 II 400, JT 1971 I 604; *Chesebrough-Pond's Inc.* v. *Colgate-Palmolive Company*, February 16, 1971, ATF 97 II 78, JT 1971 I 605.

[23] *Plascon A.G.* v. *Luwa A.G.*, May 30, 1972, ATF 98 II 138, JT 1972 I 622.

[24] *Productions Claude Carrère* v. *Federal Bureau of Intellectual Property*, July 11, 1972, ATF 98 I b 188, JT 1972 I 625.

[25] See *Industrial Property*, 1969, p. 316.

[26] See *Industrial Property*, 1967, p. 91.

[27] *Helena Rubinstein S. A. Paris and Helena Rubinstein S. A. Spreitenbach* v. *Denner Vereinigte Filialunternehmen A. G. Zürich and Denner Supermarkt A. G. Zürich*, December 1, 1970, ATF 96 II 400, JT 1971 I 604; *Stabilimenti Chimici Arlem di Levi Gino* v. *Elizabeth Arden GmbH*, June 17, 1969, ATF 95 II 354, JT 1970 I 622.

[28] *Cataphote Corporation* v. *Jenaer Glaswerk Schott & Gen*, July 14, 1970, ATF 96 II 257, JT 1971 I 600.

refuse registration, as the obligation to use the mark admits of no exception in favor of defensive or reserve marks [29].

6. Under the system in Switzerland, the first applicant for registration of a mark is presumed to be the person entitled to it. A third party can rebut this presumption by proving that he has already used the mark.

But what is to be understood by use of the mark in this context? For instance, does use outside Switzerland apply? The Federal Court has held that use of the mark in terms of the Trademark Law should be taken to mean the affixing of the mark on the article or on its packaging and the marketing of the article, the use beginning only when the mark appears on the market. It might be pointed out in passing that this is a valuable indication for those who wish to save their marks from lapsing as a result of non-use (Section 9 of the Trademark Law). At the same time, only use in Switzerland is determinative, as the principle of territoriality has to be adhered to. Use of the mark abroad is no obstacle to registration of the same mark in Switzerland. This is naturally subject to Article 6[bis] of the Paris Convention, which makes an exception to the rule in the case of a well-known mark [30].

INDUSTRIAL DESIGNS

Industrial designs are still governed by the Law on Industrial Designs of March 30, 1900 [31].

The courts have held that only "aesthetic" designs are protected, to the exclusion of so-called utility designs. In this respect the Swiss system differs from the German one.

Recently the Federal Court has again stated what constitutes a design. It is any arrangement of lines or any three-dimensional shape, with or without colors, intended for use as a pattern for the production of an article on an industrial scale. The design need not be the product of creative activity: it is only required to have a certain originality and represent a minimum of inventiveness so that its form is not one which comes immediately to mind. This form must also have an aesthetic orientation, appealing to taste. For it to enjoy legal protection it must not be conditioned by the method of its manufacture, by the use for which the article is intended or by the technical effect which is sought.

In the examination of the features of an article, the courts will first eliminate those dictated by technical considerations which enable it to be manufactured or used. It would be far from accurate to say that the technical considerations and purpose of an article necessarily lead to one and the same solution: it is generally possible to make a choice, from the aesthetic standpoint, as is shown by the existence of different styles of furniture.

By the same token the courts will disregard at the outset all elements which have fallen into the public domain, such as geometrical figures and colors, at least insofar as their combination, arrangement or decoration is not original.

After this pruning the courts will examine whether the remaining elements qualify for protection [32].

TRADE NAMES

In recent years the Federal Court has applied itself extensively to the question of the choice of trade names by corporations. This Letter will be confined to an examination of these decisions.

The trade name of a corporation must be clearly distinguishable from any other trade name already registered in Switzerland (Section 951(2) of the Code of Obligations).

The legal provisions on trade names are not designed to regulate competition but to protect both the public and the owner of an earlier name against confusion. There can be a danger of confusion, therefore, even where the owners of the two names do not have their registered office in the same place and are not competitive businesses.

The courts will base their decision on the overall impression. There are however certain elements which, by their meaning or sound, stand out from the others and thus acquire greater importance in the assessment of the risk of confusion, being more easily memorized and often used on their own in business life, either by the corporation itself or by third parties. The courts will be all the more strict where the owners of the trade names involved have their registered offices in the same place, where they are competitors or where for other reasons they operate in the same circles, since there are wide possibilities of confusion here.

Moreover, it is not sufficient for the two trade names to be distinguishable when they are read or heard one after the other; the memory too must be able to tell them apart. Finally, there must be no cause to believe, on the basis of an impression created by the resemblance between the two names, that the two enterprises are affiliated or have some other legal or economic link [33].

The obligation to eliminate all risk of confusion applies even if the first-registered trade name contains a generic term, which is in principle in the public domain. The owner of that name cannot reserve its use for himself, but he has the right to prevent the use of the same generic term by a third party where this would create confusion with his own trade name. In such a case the common element could be supplemented in the more recent name by a secondary element sufficiently striking to give it a certain distinguishing power of its own. Such an addition will have no effect, however, if the generic term is one which long use has established

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[29] *Farbenfabriken Bayer A.G.* v. *Federal Bureau of Intellectual Property*, July 4, 1972, ATF 98 I b 180, JT 1972 I 626 (refusal of protection to the similar marks "Nitraban" and "Nitraran": the owner did not intend to use both marks concurrently for identical goods, and its intention to select, but only at a later date, one of the marks was considered insufficient for either of them to enjoy the special protection afforded by Section 9 of the Trademark Law).

[30] *Krikor Simonian* v. *Serexa Watch Co., S.A. and Victor Serex*, January 23, 1973, not yet published.

[31] *La Propriété industrielle*, 1901, p. 40.

[32] *Kehrer* v. *Metallbau A.G. Zürich*, September 30, 1969, ATF 95 II 470, JT 1970 I 626.

[33] *Aquafiltro A.G.* v. *Filtro S.A.*, July 9, 1968, ATF 94 II 128, JT 1969 I 635; *Interim Service S.A.* v. *Adia Interim S.à r.l.*, September 15, 1969, ATF 95 II 568, JT 1970 I 634; *Elektrisola Feindraht A.G.* v. *Schweizerische Isola-Werke (A.G.)*, March 30, 1971, ATF 97 II 153, JT 1971 I 618; *Intershop Holding A.G.* v. *Intershop A.G.*, October 26, 1971, ATF 97 II 234, JT 1972 I 627.

to such an extent that it alone has come to identify the older enterprise [34].

UNFAIR COMPETITION

1. Our Law on Unfair Competition of 1943 [35] defines unfair competition as any abuse of economic competition resulting from deception or other act contrary to good faith. It provides that it is contrary to the rules of good faith, in particular, to take measures intended or likely to give rise to confusion with another's goods or business activity (Section 1(2)*(d)*).

The courts have held that imitation, even slavish imitation, of an unprotected design or get-up does not in principle constitute an act of unfair competition. The Federal Court has recently reaffirmed that, in competition, the results of another's efforts and work may in principle, subject to the protection afforded by special laws (patents, marks or industrial designs), be imitated by any competitor and that such use is not contrary to the rules of good faith. The situation is different if the effect of the imitation is to create confusion in the mind of the buyer as to the origin or quality of the goods. A risk of confusion may for instance arise from elements not protected by trademark law. Even if trademark law does not apply in a given case, there may therefore still be a remedy under the Unfair Competition Law [36].

2. Article 8 of the Paris Convention provides that " a trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark. "

According to the most recent decisions of the Federal Court, this provision does not mean that a foreign trade name that is not entered in the Swiss Register of Commerce must be given the same protection as a trademark which is on the Register. It simply means that each member State of the Union must afford nationals of other member States whose trade names are not registered the same protection as it grants to its own nationals in the same circumstances.

In Switzerland the owner of an unregistered trade name has no exclusive right to use that name, as has the owner of a registered trade name. He can however prevent the usurpation or the imitation of his trade name if, in doing so, the third party concerned is guilty of an act of unfair competition or prejudices the owner's particular interests [37].

There was an interesting case in which this case law was applied:

In 1969 a bank was set up in Lucerne and entered in the register of commerce there under the name " Standard Commerz Bank. " Considering the creation in Switzerland of a bank under this name to be prejudicial to their interests, the Commerzbank Aktiengesellschaft of the Federal Republic of Germany and the Standard Bank Limited of London took proceedings before the Swiss courts, even though neither of them was entered in the Swiss Register of Commerce. The Federal Court held that the parties were in a competitive relationship and that the trade name used by the Lucerne bank therefore constituted an act of unfair competition in relation to the two foreign banks, as the public might well imagine that there were legal or economic links between the Swiss bank and the two foreign banks. The latter were successful in having the name of the Lucerne bank removed from the register, on the basis of the Unfair Competition Law [38].

[34] *Standard Commerz Bank* v. *Commerzbank Aktiengesellschaft*, February 1, 1972, ATF 98 II 57, JT 1972 I 632.

[35] *La Propriété industrielle*, 1944, p. 169.

[36] *A. G. Chocolat Tobler* v. *Rast A. G.*, April 1, 1969, ATF 95 II 191, JT 1969 I 627; *F. J. Burrus et Cie* v. *S. A. Laurens Le Khédive extension suisse*, May 6, 1969, ATF 95 II 461, JT 1970 I 619; *Kehrer* v. *Metallbau A. G. Zürich*, September 30, 1969, ATF 95 II 470, JT 1970 I 626; *Chesebrough-Pond's Inc.* v. *Colgate-Palmolive Company*, February 16, 1971, ATF 97 II 78, JT 1971 I 605.

[37] In this connection, see *Industrial Property*, 1967, pp. 92 to 95.

[38] *Standard Commerz Bank* v. *Commerzbank Aktiengesellschaft*, February 1, 1972, ATF 98 II 57, JT 1972 I 632; *Standard Commerz Bank* v. *The Standard Bank Limited*, February 1, 1972, ATF 98 II 67, JT 1972 I 633.

Letter from India

By S. B. SHAH *

Trade Marks and the Foreign Exchange Regulation Act, 1973

Section 28(1)*(c)* of the Foreign Exchange Regulation Act, 1973, hereafter referred to as " the Act ", came into force on January 1, 1974, and brings within its purview the permitted use of a trade mark in India. The Act repeals the Foreign Exchange Regulation Act, 1947.

One of the means of leakage of foreign exchange from India was traced to the dealings between the owner of a trade mark and its permitted user in India. Where the permitted use of a registered trade mark was created in favour of a registered user through the machinery of Section 48 of the Trade and Merchandise Marks Act, 1958, the Government was in a position to investigate into the modus operandi between the registered user and the registered proprietor of the trade mark. Where, however, the permitted use of a registered trade mark was established outside the machinery of Section 48 of that Act, or such use related to an unregistered trade mark, the relationship between the owner of the mark and the permitted user was governed by the agreement between the parties, which did not come under the examination of the Government.

Section 28(1)*(c)* of the Act provides, inter alia, that (i) a person resident outside India (whether a citizen of India or not), or (ii) a person who is not a citizen of India but is resident in India, or (iii) a company (other than a banking company) which is not incorporated under any law in force in India or in which the non-resident interest is more than 40 per cent or any branch of such company, shall not, except with the permission of the Reserve Bank of India (hereafter referred to as " the Reserve Bank "), permit hereafter any trade mark, which he or it is entitled to use, to be used by any person or company for direct or indirect consideration. " Company " in this context means any body corporate and includes

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Note: This Letter is an addendum to the Letter from India by the same author, published in *Industrial Property*, 1973, p. 358.

a firm or any association of individuals. This section applies to both registered and unregistered trade marks. The use of a trade mark by a person other than its proprietor without the sanction of the Reserve Bank is declared void, that is to say, of no legal effect whatsoever. As a necessary consequence, the agreement between the owner and the user of the trade mark will not be enforceable in India unless the Reserve Bank had accorded its sanction under Section 28(1)*(c)* of the Act.

Where a person or company to whom Section 28(1)*(c)* applies has granted to another person or company permission to use his or its trade mark and such permission is valid on January 1, 1974, he or it must apply to the Reserve Bank, within six months or such further time as the Reserve Bank may allow in that behalf, for the permission of the Reserve Bank to continue to permit the use of his or its trade mark by the permitted user. This provision apparently applies to the registered users of registered trade marks existing on January 1, 1974. The Reserve Bank is entitled to make such inquiries as it deems fit concerning the application of the owner of the trade mark. The Reserve Bank may allow the application subject to such conditions as it may think fit to impose or reject the application after giving the party likely to be affected by the rejection a reasonable opportunity to make a representation to it in that behalf. Upon the rejection of the application, the permission to use the trade mark will be void on the expiry of 90 days, or such further time as the Reserve Bank may allow, from the date of the receipt of the communication of rejection by the owner of the trade mark.

When no application is made to the Reserve Bank as mentioned above, the Reserve Bank may, by order, direct the person or company to whom Section 28(1)*(c)* applies to desist from permitting the use of his or its trade mark on the expiry of such period as may be specified in the direction. This provision will apply to the use of an unregistered trade mark and of a registered trade mark by a non-registered user. No direction will, however, be issued unless the party affected thereby is given an opportunity to make a representation in the matter. Where the direction of the Reserve Bank is not complied with by the person or company, the permission to use the trade mark will be void from the expiry of the period specified in the direction.

It is rather too early to assess the exact implications of these important provisions. It appears that a registered trade mark used in contravention of Section 28(1)*(c)* of the Act will be a trade mark whose use is contrary to law within the meaning of Section 11*(b)* of the Trade and Merchandise Marks Act, 1958, and its entry on the Register of Trade Marks will be an entry wrongly remaining there within the meaning of Section 56(2) of that Act. Such an entry will be liable to be removed from the Register of Trade Marks.

The provisions of Section 28(1)*(c)* of the Act override those of Section 48(1) of the Trade and Merchandise Marks Act, 1958. However, a permission under Section 28(1)*(c)* will not render legal what is illegal under the Trade and Merchandise Marks Act, 1958, or under the common law of trade marks.

ACTIVITIES OF OTHER ORGANIZATIONS

Organisation for Economic Co-operation and Development (OECD)

Council

Recommendation of the Council Concerning Action Against Restrictive Business Practices Relating to the Use of Patents and Licences

(Adopted by the Council at its 348th Meeting on January 22, 1974) [1]

The Council,

Having regard to Article 5*(b)* of the Convention on the Organisation for Economic Co-operation and Development of 14th December, 1960;

Having regard to the Resolution of the Council of 5th December, 1961, concerning Action in the Field of Restrictive Business Practices and the Establishment of a Committee of Experts [OECD/C(61)47(Final)];

Having regard to the Recommendation of the Council of 5th October, 1967, concerning Co-operation between Member Countries on Restrictive Business Practices Affecting International Trade [C(67)53(Final)];

Having regard to the Recommendation of the Council of 14th and 15th December, 1971, concerning Action against Inflation in the Field of Competition Policy and, in particular, Section I, paragraph 1, sub-paragraph (i)*(c)* thereof [C(71)205(Final)];

Having regard to the Recommendation of the Council of 3rd July, 1973, concerning a Consultation and Conciliation Procedure on Restrictive Business Practices Affecting International Trade [C(73)99(Final)];

Having regard to the Report by the Committee of Experts on Restrictive Business Practices of 11th September, 1972, on Restrictive Business Practices relating to Patents and Licences and, in particular, paragraph 49 thereof [RBP (71)3(2nd Revisiou)];

Recognising that it is desirable to scrutinize and remedy the harmful effects of abusive restrictive business practices relating to the use of patents and licences since economic development is dependent on the dissemination of scientific and technological innovation through patents and that by granting licences subject to unjustifiable restrictions firms can use the rights attaching to the patents to exercise excessive economic power;

I. RECOMMENDS to the Governments of Member countries:

1. That they should be particularly alert to harmful effects on national and international trade which may result from abusive practices in which patentees and their licensees may engage, and, in particular, from the following:

(a) when negotiating or operating patent pools or cross-licensing agreements, unjustifiably imposing territorial, quantity or price restrictions or attempting to dominate an industry, market or new industrial process;

(b) by means of territorial restrictions in patent licences affecting international trade, unjustifiably prohibiting exports of patented products or unjustifiably restricting trade in or exports of the patented products to specified areas;

(c) by means of clauses concerning tied sales, obliging the licensee to obtain goods from the licensor or his designated sources, when the tied sales are not justified, for instance, by technical reasons concerning the quality of the goods manufactured under the licence;

(d) by means of grant-back clauses, unjustifiably requiring the licensee to assign or grant back to the licensor exclusively all improvements discovered in working the patents when the effect of this practice is to reinforce the dominant position of the licensor or to stifle the licensee's incentive to invent;

(e) by means of clauses unjustifiably limiting competition, preventing one or more parties to the patent licensing contract from competing with other parties to the contract, or with third persons, in other industrial fields not covered by the licensed patent;

(f) arbitrarily grouping and licensing all patents in a particular field and refusing to grant licences for only some of the patents or using other forms of package licensing when these practices are coercive in character and when the selection of the patents is not negotiated for the convenience of the parties;

(g) contrary to national law, fixing the prices of patented products by means of patent licences.

2. That they should give consideration to the desirability and feasibility of compulsory licensing of patents and, where possible, related know-how as a remedy to restore competition where such patents have been misused contrary to their restrictive business practices laws, when such a remedy is not already provided for in their legislation.

3. That they should give consideration to the desirability and feasibility of making available to the competent authorities procedures for the registration of international licensing agreements, when such procedures are not already provided for in their legislation.

II. INSTRUCTS the Committee of Experts on Restrictive Business Practices to keep under review the application of the present Recommendation and to report to the Council when appropriate.

[1] This Recommendation does not apply to Switzerland.

BOOK REVIEWS

Rechtsvergleichung, Interessenausgleich und Rechtsforthildung. Festschrift für Eugen Ulmer zum 70. Geburtstag [Comparative Law, Harmonization of Interests and Development of Law. Collection in honor of Eugen Ulmer on his 70th hirthday]. *Gewerblicher Rechtsschutz und Urheberrecht* (GRUR), International Part, No. 6/7, June/July 1973, Verlag Chemie GmhH, Weinheim/Bergstrasse. - 326 pages.

Gewerblicher Rechtsschutz - Urbeberrecht - Wirtschaftsrecht. Mitarbeiterfestschrift für Eugen Ulmer [Industrial Property, Copyright and Economic Law. Collection of works hy associates in honor of Eugen Ulmer]. Carl Heymanns Verlag KG, Cologne, Berlin, Bonn and Munich, 1973. - 587 pages.

Two "Festschriften" were puhlished in 1973 to celehrate the 70th birthday of Eugen Ulmer, the eminent German lawyer. The first of these, which forms a special issue of the review GRUR, International Part, features articles written hy authors who are among the foremost specialists in intellectual property and economics, and finishes with a list of Professor Ulmer's innumerahle publications. The second of the two works comprises contributions hy present or former staff memhers or associates of the Max-Planck-Institute for Foreign and International Patent, Copyright and Competition Law, from which Professor Ulmer has recently resigned as Director.

Most of the 112 articles which make up this two-volumc collection are written in German; others are in English or French. In the very amount and variety of the suhjects they cover, not only in the various sectors of intellectual property, but also in other fields of law, these "Festschriften" are a signal trihute to the exceptional breadth of Professor Ulmer's learning. F. C.

Lindenmaier — Das Patentgesetz [The Patent Law]. 6th edition, revised aud expanded. Edited by *Weiss*, adapted hy *Weiss*, *Zeunert* and *Röhl*. Carl Heymanns Verlag KG, Cologne, Berlin, Bonn and Munich, 1973. - 1612 pages.

"Lindenmaier" needs no introduction, as it has for years been an authority in the Federal Repuhlic of Germany. The authors of this sixth edition — Dr. Ulrich Weiss, President of the German Patent Court, Dr.-Ing. Gerhard Zeunert, President of a Chamher of the Patent Court, and Dr. Hellmut Röhl, Judge of the Patent Conrt — have endeavored to describe and explain the Patent Law of the Federal Repuhlic of Germany, taking into account the textbooks and case law, in an extremely comprehensive and detailed form, and yet as concisely as possihle.

More than three years have passed since the fifth edition of 1970, during which time there has heen a host of new developments in case law and legal thinking, owing to the radical changes in the patent law of the Federal Repuhlic hrought ahout hy the 1967 amending legislation. This was the reason for the sixth edition, covering the literature and court decisions up to May 1973, and the development of international or regional trends in the unification of law.

Like its predecessors, this monumental sixth edition will he indispensahle to German-speaking specialists in industrial property.

G. R. W.

Selection of New Publications

AUTERI (Paolo). *Territorialità del diritto di marchio e circolazione di prodotti "originali"*. Milan, Dott. A. Giuffrè Editore, 1973. - 483 p.

BLANCO WHITE (T. A.). *Patents for Inventions*, 4th edition. London, Stevens and Sons, 1974. - 816 p.

BUCELLE (Jacques). *Le contrat de franchise* (dissertation). Montpellier University, 1970. - 163 p.

GRÉAUX EL SIRGANY (Dorothée). *Les brevets d'invention en Egypte* (thesis). Lyons University, 1972. - 635 p.

HINTERMEISTER-RÉMY (Yvonne). *Der Schutz der ausländischen Marke in der Schweiz* (thesis). Zurich University, 1972. - 231 p.

JORDAN (Jacques). *La brevetabilité des procédés informatiques*, 1st and 2nd parts (thesis). University of Social Sciences of Grenoble, 1973. - 554 p.

La copropriété des brevets (report on the second Meeting on Industrial Property, Lyons, May 1972). Paris, Lihrairies techniques, 1973. - 172 p.

LIEBESNY (F.), HEWITT (J. W.), HUNTER (P. S.), HANNAH (M.). *The Scientific and Technical Information contained in Patent Specifications — The Extent and Time Factors of its Publication in Other Forms of Literature*. The Polytechnic of North London, School of Lihrarianship, 1973. - 57 p.

LISIECKI (Piotr) and SZAJKOWSKI (Andrzej). *Zalozemia nowego prawa wynalazczego*. Union of Socialist Youth, Administration of the district of Poznan, and Association of Enterprises concerned with Technology and Rationalization, Professional Trade Union of Health Employees in Poznan, 1973. - 181 p.

NEBEL (Etienne). *Les contrats de recherche scientifique et technique — Leur structure et la dévolution de leurs résultats*. Geneva, Etudes juridiques et techniques, 1973. - 216 p.

PASTOR (Wilhelm L.). *Der Wettbewerbsprozess*, 2nd edition (revised). Cologne, Berlin, Bonn and Munich, Carl Heymanns Verlag KG, 1973. - 833 p.

RICHTER (Bruno). *Warengleichartigkeit*, 5th edition. Cologne, Berlin, Bonn and Munich, Carl Heymanns Verlag KG, 1973. - 160 p.

CALENDAR

WIPO Meetings

May 6 and 11, 1974 (Brussels) — International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations — Intergovernmental Committee (extraordinary session)

Note: Meeting convened jointly with the International Labour Organisation and Unesco

May 6 to 21, 1974 (Brussels) — Convention Relating to the Distribution of Programme-Carrying Signals Transmitted by Satellite — Diplomatic Conference (jointly organized with Unesco)

May 13 and 14, 1974 (Rijswijk) — International Classification of Search Files according to International Patent Classification — Group of Consultants

May 13 to 17, 1974 (Geneva) — International Patent Classification (IPC) — Working Group IV of the Joint ad hoc Committee

May 28 to 31, 1974 (New York) — Joint meeting of negotiators appointed by the Economic and Social Council of the United Nations and WIPO

June 4 to 10, 1974 (Addis Ababa) — Conference on Industrial Property Laws of English-speaking Africa

Note: Meeting organized jointly with the United Nations Economic Commission for Africa

June 10 to 14, 1974 (Geneva) — Nice Classification — Committee of Experts

June 17 to 20, 1974 (Geneva) — Protection of Computer Programs — Advisory Group

June 17 to 21, 1974 (Geneva) — Madrid Union — Assembly and Committee of Directors (Extraordinary Session)

June 25 to July 1, 1974 (Geneva) — WIPO Coordination Committee (Extraordinary Session)

June 26 to 28, 1974 (Geneva) — ICIREPAT — Technical Coordination Committee (TCC)

July 1 to 5, 1974 (Geneva) — International Patent Classification (IPC) — Working Group II of the Joint ad hoc Committee

July 8 to 10, 1974 (Geneva) — Industrial Property Statistics — Working Group

September 2 to 6, 1974 (Geneva) — International Patent Classification (IPC) — Working Group V of the Joint ad hoc Committee

September 9 to 13, 1974 (Geneva) — International Patent Classification (IPC) — Working Group III of the Joint ad hoc Committee

September 9 to 13, 1974 (Geneva) — PCT Interim Advisory Committee for Administrative Questions — Working Group on Forms

September 18 to 20, 1974 (Geneva) — ICIREPAT — Plenary Committee

September 24 to October 1, 1974 (Geneva) — WIPO Coordination Committee and Executive Committees of the Paris and Berne Unions — Ordinary Sessions

September 30 to October 4, 1974 (Geneva) — International Patent Classification (IPC) — Working Group I of the Joint ad hoc Committee

October 2 to 4, 1974 (Geneva) — Scientific Discoveries — Working Group

October 7 to 11, 1974 (Moscow) — "Role of Patent Information in Research and Development" — Symposium

Participation open to all interested persons subject to a registration fee — *Note:* Meeting organized in cooperation with the State Committee for Inventions and Discoveries of the Council of Ministers of the USSR

October 16 and 17, 1974 (Vienna) — Meeting of INPADOC Users

October 21 to 25, 1974 (Geneva) — ICIREPAT — Technical Committee for Search Systems (TCSS)

October 28 to November 1, 1974 (Geneva) — ICIREPAT — Technical Committee for Standardization (TCST)

November 4 to 8, 1974 (Geneva) — International Protection of Appellations of Origin — Committee of Experts

November 4 to 8, 1974 (Geneva) — International Patent Classification (IPC) — Working Group IV of the Joint ad hoc Committee

November 12 to 19, 1974 (Geneva) — PCT Interim Committees — Annual Sessions

November 18 to 22, 1974 (Geneva) — Licensing Seminar

November 25 to 29, 1974 (Geneva) — Revision of the Model Law on Inventions — Committee of Experts

December 2 to 6, (Yaoundé) — Francophone African Seminar on Intellectual Property

December 9 to 13, 1974 (Geneva) — International Patent Classification (IPC) — Bureau of the Joint ad hoc Committee

December 16 to 18, 1974 (Geneva) — ICIREPAT — Technical Coordination Committee (TCC)

January 22 to 24, 1975 (Geneva) — Publication of Licensing Opportunities — Group of Consultants

February 17 to 28, 1975 (Munich) — International Patent Classification (IPC) — Working Group II of the Joint ad hoc Committee

March 17 to 21, 1975 (Geneva) — WIPO Permanent Legal-Technical Program for the Acquisition by Developing Countries of Technology Related to Industrial Property — Permanent Committee (2nd Session)

April 14 to 25, 1975 (Rijswijk) — International Patent Classification (IPC) — Working Group III of the Joint ad hoc Committee

May 12 to 23, 1975 (Washington) — International Patent Classification (IPC) — Working Group I of the Joint ad hoc Committee

June 9 to 13 (or 20), 1975 (Geneva) — International Patent Classification (IPC) — Working Group V of the Joint ad hoc Committee

September 15 to 26 (Rijswijk) — International Patent Classification (IPC) — Working Group IV of the Joint ad hoc Committee

September 23 to 30, 1975 (Geneva) — WIPO Coordination Committee and Executive Committees of the Paris and Berne Unions — Ordinary Sessions

November 3 to 14, 1975 (Berne) — International Patent Classification (IPC) — Working Group II of the Joint ad hoc Committee

December 1 to 12, 1975 (Munich) — International Patent Classification (IPC) — Working Group III of the Joint ad hoc Committee

December 8, 9 and 16, 1975 (Geneva) — International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations — Intergovernmental Committee — Ordinary Session jointly organized with International Labour Organisation and Unesco)

December 10 to 16, 1975 (Geneva) — Executive Committee of the Berne Union (Extraordinary Session)

UPOV Meetings

October 21 to 23, 1974 (Geneva) — Meeting of Member and Non-Member States

October 23, 1974 (Geneva) — Consultative Working Committee

October 24 to 26, 1974 (Geneva) — Council

November 5 and 6, 1975 (Geneva) — Technical Steering Committee

November 7, 1974 (Geneva) — Working Group on Centralized Examination

Meetings of Other International Organizations concerned with Intellectual Property

May 6 to 9, 1974 (Rijswijk) — International Patent Institute — Training Seminar

May 13 and 14, 1974 (Chicago) — Inter-American Association of Industrial Property — Administrative Board

June 19 to 21, 1974 (Rijswijk) — International Patent Institute — Administrative Board

July 2 to 5, 1974 (Monte Carlo) — International Writers Guild — Congress

September 11 to 13, 1974 (Brussels) — International Patent Institute — Administrative Board

October 6 to 10, 1974 (Rome) — International League Against Unfair Competition — Congress

October 21 to 23, 1974 (Rijswijk) — International Patent Institute — Administrative Board

November 11 to 16, 1974 (Santiago) — Inter-American Association of Industrial Property — Congress

December 9 to 11, 1974 (Rijswijk) — International Patent Institute — Administrative Board

May 3 to 10, 1975 (San Francisco) — International Association for the Protection of Industrial Property — Congress

ANNOUNCEMENT OF VACANCY

Competition No. 234

Head, PCT Section
(Industrial Property Division)

Category and grade: P. 5/P. 4, according to qualifications and experience of the selected candidate.

Principal duties:

Under the supervision of the Director of the Industrial Property Division, the incumbent will be responsible for directing the activities of the PCT Section in the definition and carrying out of the WIPO program in relation to the implementation and execution of the Patent Cooperation Treaty. The principal duties of the post may be summarised as follows:

(a) participation in the development of the program and in the preparation of proposals for consideration in WIPO and by the various committees of the PCT and the administrative bodies of WIPO;

(b) implementation and follow-up of such program and proposals, when approved, including studies, drafting of documents, preparation of meetings and representation of WIPO therein, and preparation of reports of such meetings;

(c) maintaining relations with governmental and non-governmental organizations, consultants and experts dealing with matters of interest to the PCT.

Qualifications required:

(a) University degree in law or in another relevant field, or equivalent qualification.

(b) Wide experience in industrial property including its international aspects as well as a thorough knowledge of the procedures in different countries concerning industrial property rights (in particular patent procedures).

(c) Ability to supervise and direct a group of highly-qualified officials of different nationalities and to coordinate efficiently their activities.

(d) Capacity for critical analysis and for the preparation of documents relating to industrial property rights.

(e) Ability to act as a representative of WIPO in international meetings.

(f) Excellent knowledge of either Englisb or French and a good knowledge of the other. Ability to work in other languages would be an advantage.

Nationality:

Candidates must be nationals of one of the Member States of WIPO or of the Paris or Berne Unions. Qnalifications being equal, preference will be given to candidates wbo are nationals of States of which no national is on the staff of WIPO.

Type of appointment:

Fixed-term appointment of two years, with possibility of renewal; or probationary period of two years, after satisfactory completion of which a permanent appointment will be offered.

Age limit applicable to appointment for a probationary period:

Candidates must be less than 50 years of age at date of appointment at P. 4 level; or less than 55 years of age at date of appointment at P. 5 level.

Date of entry on duty: To be agreed.

Applications:

Application forms and full information regarding the *conditions of employment* may be obtained from the Director, Administrative Division, WIPO, 32, chemin des Colombettes, 1211 Geneva 20, Switzerland. Please refer to the number of the Competition and enclose a brief cnrriculum vitae.

Closing date for receipt of applications: June 30, 1974.