

Industrial Property

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Contents

	Pages
INTERNATIONAL UNIONS	
The Industrial Property Unions in 1966	3
Member States of the Unions for the Protection of Industrial Property as on January 1, 1967	6
Paris Union. Accession to the Lisbon Act. Argentina	11
Madrid Union. Ad Hoc Conference of Directors of the National Industrial Property Offices of the Madrid Union (Trademarks) (Geneva, December 13 and 14, 1966). Report	11
Committee of Directors of National Industrial Property Offices of the Madrid Union (Trademarks) (Geneva, December 15 and 16, 1966). General Report . . .	12
CONVENTIONS AND TREATIES	
African and Malagasy Industrial Property Office (OAMPI). Convention relating to the validation of formalities completed outside the prescribed time-limits under the transitional provisions of the Agreement of Libreville of September 13, 1962, and to the opening of a supplementary period of six months	15
LEGISLATION	
Australia. Trade Marks Act 1955-1958 (<i>Second Part</i>)	16
Italy. Decrees concerning the Temporary Protection of Industrial Property Rights at Eight Exhibitions (of November 21, 1966)	22
GENERAL STUDIES	
Report on the Patent System of the Commission Appointed by the President of the United States of America (Summary)	22
CALENDAR	
BIRPI Meetings	31
Meetings of Other International Organizations concerned with Intellectual Property	32

INTERNATIONAL UNIONS

The Industrial Property Unions in 1966

The Union for the Protection of Industrial Property (Paris Union)

State of the Union

New Members. During the year 1966, the following countries became members of the Paris Union and are bound by the Lisbon Act of the Paris Convention with effect from the dates appearing after their names:

Algeria	March 1, 1966 (p. 239, 1965) ¹⁾
Cyprus	January 17, 1966 (p. 270, 1965)

These new adhesions brought to a total of 74²⁾ the membership of the Union as at December 31, 1966. The adhesion of Dahomey (p. 270) will become effective in 1967 (January 10, 1967).

Accessions to the Lisbon Act. During 1966, Bulgaria (p. 54) and Israel (p. 130) acceded to the Lisbon Act of the Paris Convention with effect from March 26 and July 18, 1966, respectively.

Selection and Change of Class. For the purposes of the computation of their contributions to the expenditure of the International Bureau, *Uganda* (which acceded in 1965) designated Class III (p. 11), whereas *Austria* declared that it wished to be placed, as from 1966, into Class IV (instead of Class VI; p. 183).

Acts in Force at the End of 1966. Of the 74 Member States of the Paris Union as at December 31, 1966, forty three are bound by the 1958 Lisbon Act, 28 by the 1934 London Act, and 3 by the 1925 Hague Act (see list of Member States at page 6, below).

BIRPI Meetings

Executive Committee of the Conference of Representatives of the Paris Union. The second ordinary session of the Executive Committee of the Conference of Representatives of the Paris Union was held at Geneva from September 26 to 29, 1966.

Mexico was co-opted as a Member.

The Committee examined a report on the activities of BIRPI since October 1965 as far as the Paris Union was concerned.

With regard to the plan for the "World Patent Index," BIRPI reported to the Committee on the results of a survey, which it had conducted in cooperation with the International Patent Institute, and the possible usefulness of the proposed plan. The Committee noted that BIRPI would go ahead with the plan only if the coverage of the initial investment was secured.

With regard to the question of establishing an international classification for the purposes of the registration of industrial designs, the Committee decided that it would be desirable to convene a diplomatic conference for the drafting and adoption of a treaty on this subject.

As far as possible future BIRPI action in the field of patents is concerned, the Committee adopted a resolution recommending "that the Director of BIRPI undertake urgently a study on solutions tending to reduce the duplication of effort both for applicants and national patent offices . . . with a view to making specific recommendations for further action, including the conclusion of special agreements within the framework of the Paris Union."

The Committee examined the Director's proposals concerning the program and budget of BIRPI for 1967 as far as the Paris Union is concerned and expressed a favorable opinion on these proposals (p. 228).

Interunion Coordination Committee. The fourth ordinary session of the Interunion Coordination Committee met at Geneva from September 26 to 29, 1966. In the course of the session, Mexico, having become a member of the Executive Committee of the Paris Union, became the twenty-fourth member of the Interunion Coordination Committee.

The Committee heard and noted its approval of the Director's report on the activities of BIRPI since the last session of the Committee. A financial report for the year 1965, constituting a supplement to the 1965 Management Report, was also approved. Regarding staff matters, the Committee examined and expressed a favorable opinion on several changes effected or proposed in the BIRPI staff rules and regulations. The Committee noted with approval the program proposals and budget of BIRPI for 1967 (p. 226).

Second Committee of Governmental Experts on Administration and Structure. This Committee met at Geneva from May 16 to 25, 1966. Of the Member States of the Paris and Berne Unions, 39 were represented. Draft texts based on the results of the deliberations of the First Committee of Experts (which met in 1965) and established by BIRPI in consultation with Experts of the Swedish Government, were presented to the Committee. The drafts contained proposals for the revision of the administrative provisions and final clauses of the Paris and Berne Conventions, the Special Agreements concluded under the former, as well as for the establishment of a new international intellectual property organization. The discussions resulted in a series of proposals for changes in the various draft texts (p. 159).

Asian Seminar on Industrial Property. This Seminar, organized by BIRPI with the assistance of the Government of Ceylon, met in Colombo, Ceylon, from February 7 to 10, 1966.

There were thirty-four participants. Ceylon, India, Indonesia, Israel, Malaysia, Philippines, Singapore, Thailand, Turkey, and the Soviet Union were represented as members. Five States from outside Asia, the United Nations, and two non-governmental organizations were represented by observers. The discussions dealt with patents, trademarks, other forms of industrial property, and international protection (p. 54).

¹⁾ Unless otherwise indicated, all page numbers in parentheses in the present report refer to the pages of *Industrial Property*, 1966.

²⁾ Or 75, if East Germany or the German Democratic Republic is also considered as a party. States disagree on this question.

Second Meeting of the Committee of Experts on the International Classification of Industrial Designs. This Committee held its second meeting from May 2 to 5, 1966, at the Headquarters of BIRPI. Nineteen Member States of the Paris Union and two international non-governmental organizations were represented. The Committee revised the draft international classification of goods for the purposes of the registration of industrial designs, draft which had been drawn up at its first meeting in October 1964.

As to the form to be given to the international classification, the majority of the Committee recommended BIRPI to propose to the Member States of the Paris Union that it take the form of a treaty establishing a special Union, under the Paris Union (p. 103).

BIRPI East-West Industrial Property Symposium. This Symposium was organized by BIRPI in cooperation with the Hungarian Authorities. It met in Budapest from October 30 to November 4, 1966. The Symposium consisted of twenty-four lectures each followed by a general discussion. The lecturers, who were known specialists in the subject matter and equal in number from Western countries and the Socialist countries of Eastern Europe, dealt with the practical aspects of patent and trademark protection. The number of registered participants was 469 (p. 271).

Committee of Experts on a Model Law for Developing Countries on Marks, Trade Names, Indications of Source, and Unfair Competition. This Committee met at the Headquarters of BIRPI from November 7 to 11, 1966. Thirty-two countries — all "developing" according to the criteria of the United Nations — were represented. The United Nations and seven other international organizations attended as observers. The Committee examined, and recommended modifications in, the draft model law which had been prepared by BIRPI to serve as a basis for discussion.

At the conclusion of its work, the Committee unanimously adopted a recommendation expressing the view that the draft reflected the special needs of developing countries and represented a useful model for legislation in these countries. The recommendation urges the developing countries which are not yet parties to the Paris Convention to consider acceding thereto (p. 274).

Other Matters

Preparatory Documents for the Intellectual Property Conference of Stockholm. In the course of 1966, BIRPI published the ten first preparatory documents for the Stockholm Conference scheduled for the Summer of 1967. One of them (S/2) contains proposals for amending Article 4 of the Paris Convention, introducing into it the notion of inventor's certificate. Seven documents deal with administrative reforms and the revision of final clauses in the Paris and Berne Conventions, the two Madrid Agreements, and the Agreements of The Hague, Nice and Lisbon (S/3 to 8). One document contains proposals for the establishment of a new intellectual property organization (S/10). Finally, one deals with the proposed revision of the clauses of substantive law in the Berne Copyright Convention (S/1). Documents S/1 and S/2 were prepared by the Gov-

ernment of Sweden, host country of the Stockholm Conference, with the assistance of BIRPI. Documents S/3 to S/10 were prepared by BIRPI, at the request of the Swedish Government.

Publications. Among the publications issued in the course of 1966, are the following: (a) a volume containing the *Documents relating to the Diplomatic Conference of Monaco (1961)* which adopted an Additional Act to the Hague Agreement for the International Deposit of Industrial Designs; (b) a *BIRPI Bibliography of the Official Publications of National Industrial Property Offices*; (c) a bilingual (English and French) volume containing the texts of the lectures given at the *BIRPI Lecture Course on Industrial Property (Geneva, 1965)*.

Contacts in India and the United States. The Director of BIRPI was heard by the Joint Parliamentary Committee of India on the Patent Bill, 1965, and by the U.S. President's Commission on the Patent System.

Working Agreement. BIRPI concluded a Working Agreement with the Latin American Free Trade Association (ALALC) (p. 103).

United Nations

During 1966, BIRPI continued and extended its cooperation in industrial property matters with the United Nations and its subsidiary bodies, in accordance with the working agreement between BIRPI and the United Nations, established in 1964.

United Nations meetings at which BIRPI was represented included the Trade and Development Board and its subsidiary bodies, the Economic and Social Council, the Committee for Industrial Development, the Advisory Committee on the Application of Science and Technology to Development, and the Twenty-first Session of the General Assembly.

The most important feature of the year from BIRPI's point of view was the establishment of a new organ, the United Nations Industrial Development Organization (UNIDO), whose headquarters will be in Vienna. One of the functions of this Organization will be to propose "in cooperation with the international bodies or intergovernmental regional bodies concerned with industrial property" measures for the improvement of the international system of industrial property. During the debates on the resolution establishing this new Organization, many delegations emphasized that any implementation of this function should be in consultation with BIRPI.

A fuller note on the above meetings will appear in the February issue of the present periodical.

BIRPI Training Program

BIRPI has continued, during 1966, its technical assistance program in cooperation with various national Industrial Property Offices by granting fellowships for the training of nine Governmental officials of developing countries who are working or expect to work in the Industrial Property Office of their countries. Training periods average from two to three months.

**Madrid Agreement
for the Repression of False or Deceptive Indications
of Source**

State of accessions. No new accession to this Agreement was effected in 1966.

At the end of 1966, the Agreement grouped 29 countries¹⁾ of which 8 are bound by the 1958 Lisbon Act, 18 by the 1934 London Act, and 3 by the 1925 Hague Act (see list of parties to the Agreement at page 8 below).

**Madrid Union
for the International Registration of Trademarks**

State of the Union. No new accession to the Madrid Union was effected in 1966.

San Marino deposited its instrument of accession (p. 130) and Yugoslavia its instrument of ratification (p. 251) to the Nice Act of 1957. Rumania (p. 270), the United Arab Republic (p. 206), and Italy (p. 270) invoked the benefits of Article 3^{bis} of that Act, whereas Czechoslovakia, which had previously invoked the benefits of Article 3^{bis} (see 1964, p. 187), has withdrawn its former declaration (p. 270).

The 1957 Nice Act of the Madrid Agreement came into force on *December 15, 1966*.

At the end of 1966, of the 21²⁾ Member States of the Madrid Union, six remain bound by the 1934 London Act, whereas 15 have become bound by the 1957 Nice Act. Of the 15 countries bound by the latter, the following 9 have invoked the benefits of Article 3^{bis} (the effective dates of the application of Article 3^{bis} are indicated in parentheses): Belgium (December 15, 1966), Italy (June 14, 1967), Luxembourg (December 15, 1966), Monaco (December 15, 1966), Netherlands (December 15, 1966), Portugal (December 15, 1966), Rumania (June 10, 1967), Spain (December 15, 1966), United Arab Republic (March 1, 1967). (See list of Member States at page 9 below).

Ad Hoc Conference of the Directors of the National Industrial Property Offices. This Conference met twice during 1966: on May 6 and 7, and on December 13 and 14, both times at Geneva. It amended the draft Transitional Regulations of December 15, 1966 (p. 131). See also p. 11 of this issue.

The Committee of Directors of the National Industrial Property Offices, established under Article 10 of the Nice Act, met at Geneva on December 15 and 16, 1966. It adopted the Transitional Regulations of the Madrid Agreement, and expressed its opinion and advice on several questions concerning the implementation of the Nice Act. See p. 11 of this issue.

Statistics. During the year 1966, the number of international trademark registrations amounted to 24,259 which is the highest figure thus far attained in any year. It should be noted, however, that a considerable number of registrations represent anticipated renewals recorded prior to the entry into force of the Nice Act on December 15, 1966.

¹⁾ Or 30, if East Germany or the German Democratic Republic is also considered as a party. States disagree on this question. See *Industrial Property*, 1964, p. 254.

²⁾ Or 22, if East Germany or the German Democratic Republic is also considered as a party. States disagree on this question. See *Industrial Property*, 1964, p. 254.

**The Hague Union
for the International Deposit of Industrial Designs**

State of the Union. No new accession to the Hague Union was effected in 1966.

Liechtenstein ratified both the Hague Act of 1960 and the Additional Act of Monaco of 1961 (p. 130).

At the end of 1966, all the 14¹⁾ countries Members of the Union were bound by the 1934 London Act, while Belgium, France, the Federal Republic of Germany, Liechtenstein, Monaco, Netherlands, and Switzerland, were also bound by the Monaco Additional Act (see list of Member States at page 9).

Three States have so far ratified the 1960 Hague Act: France, Liechtenstein, and Switzerland.

Statistics. During the year 1966, the number of international deposits was 2,434 as against 2,129 in 1965. Open deposits numbered 1,324 and sealed deposits 1,110. A total of 34,524 objects were deposited of which 1,353 were simple deposits and 33,171 were multiple deposits. Of the 34,524 objects deposited, 13,104 were two-dimensional (*dessins*) and 21,420 three-dimensional (*modèles*).

**Nice Union
for the International Classification of Goods and Services
to which Trademarks are Applied**

State of the Union. During the year 1966, the following countries became members of the Nice Union with effect from the dates appearing after their names:

Ireland	December 12, 1966 (p. 251)
Morocco	October 1, 1966 (p. 206)
Yugoslavia	August 30, 1966 (p. 159)

At the end of 1966, the Nice Agreement grouped 21²⁾ Member States (see list of Member States at page 10 below).

Publication. During 1966, BIRPI published a provisional edition of the Spanish translation of the "Classification."

**Lisbon Union
for the Protection of Appellations of Origin and their
International Registration**

State of the Union. The Agreement establishing this Union was concluded on October 31, 1958, at Lisbon. It entered into force on September 25, 1966, among the following seven States: Cuba, Czechoslovakia, France, Germany (Fed. Rep.), Israel, Mexico, Portugal (p. 231). At the end of 1966, the same seven States were Members of the Union.

Meeting. The Council established by the Lisbon Agreement held its first session on September 29, 1966, at the Headquarters of BIRPI. It adopted its own Statutes and Rules of procedure, examined and expressed a favorable opinion on the draft budget of the Registration Service of the Union, and decided to revise the administrative provisions and the final clauses of the Lisbon Agreement at the Stockholm Conference of 1967.

¹⁾ Or 15, if East Germany or the German Democratic Republic is also considered as a party. States disagree on this question. See *La Propriété industrielle*, 1956, p. 21.

²⁾ Or 22, if East Germany or the German Democratic Republic is also considered as a party. States disagree on this question. See *Industrial Property*, 1964, p. 254.

Table of Contracting States

The following table shows the situation of the Acts in force at the end of 1966 (see also "Member States of the Industrial Property Unions." as listed below).

Instrument	Number of Contracting States				
	Total	Bound by the Act of			
		Lisbon 1958	Nice 1957	London 1934	The Hague 1925
Paris Convention for the Protection of Industrial Property	74 *	43	NA	28	3
Madrid Agreement for the Repression of False or Deceptive Indications of Source	29 *	8	NA	18	3
Madrid Agreement for the International Registration of Trademarks	21 *	NA	15	6	0

Instrument	Number of Contracting States				
	Total	bound by the Act of			
		Lisbon 1958	Nice 1957	London 1934	The Hague 1925
The Hague Agreement for the International Deposit of Industrial Designs	14 *	NA	NA	14 **	0
Nice Agreement for the International Classification of Goods and Services to which Trade-marks are Applied	21 *	NA	21	NA	NA
Lisbon Agreement for the Protection of Appellations of Origin and their International Registration	7	7	NA	NA	NA

* Or one more, if East Germany or the German Democratic Republic is also considered as a party. States disagree on this question.

** Additional Act of Monaco (1961): 7.

NA: Not applicable.

Member States of the Unions for the Protection of Industrial Property as on January 1, 1967

International Union for the Protection of Industrial Property (Paris Union)

founded by the Paris Convention (1883), revised at Brussels (1900), Washington (1911), The Hague (1925), London (1934), and Lisbon (1958)

Member States *)	Date on which adhesion to the Union took effect	Latest Act by which the State is bound and date on which the ratification of or accession to such Act became effective
Algeria	March 1, 1966	Lisbon: March 1, 1966
Australia ^{1) 2)}	October 10, 1925	London: June 2, 1958
Austria	January 1, 1909	London: August 19, 1947
Belgium	July 7, 1884	Lisbon: August 21, 1965
Brazil	July 7, 1884	The Hague: October 26, 1929
Bulgaria	June 13, 1921	Lisbon: March 28, 1966
Cameroon ¹⁾	May 10, 1964	Lisbon: May 10, 1964
Canada ¹⁾	June 12, 1925	London: July 30, 1951
Central African Republic ¹⁾	November 19, 1963	Lisbon: November 19, 1963
Ceylon ¹⁾	December 29, 1952	London: December 29, 1952
Chad ¹⁾	November 19, 1963	Lisbon: November 19, 1963
Congo (Brazzaville) ¹⁾	September 2, 1963	Lisbon: September 2, 1963
Cuba	November 17, 1964	Lisbon: February 17, 1963
Cyprus	January 17, 1966	Lisbon: January 17, 1966
Czechoslovakia	October 5, 1919	Lisbon: January 4, 1962
Denmark ³⁾	October 1, 1894	London: August 1, 1938
Dominican Republic	July 11, 1890	The Hague: April 6, 1951
Finland	September 20, 1921	London: May 30, 1953
France ⁴⁾	July 7, 1884	Lisbon: January 4, 1962
Gabon ¹⁾	February 29, 1964	Lisbon: February 29, 1964
Germany (Federal Republic)	May 1, 1963	Lisbon: January 4, 1962
Greece	October 2, 1924	London: November 27, 1953
Haiti	July 1, 1958	Lisbon: January 4, 1962
Holy See	September 29, 1960	London: September 29, 1960
Hungary	January 1, 1909	London: July 14, 1962
Iceland	May 5, 1962	London: May 5, 1962
Indonesia ¹⁾	December 24, 1950	London: December 24, 1950
Iran	December 16, 1959	Lisbon: January 4, 1962
Ireland	December 4, 1925	London: May 14, 1958
Israel ¹⁾	March 24, 1950	Lisbon: July 18, 1966

Member States *)	Date on which adhesion to the Union took effect	Latest Act by which the State is bound and date on which the ratification of or accession to such Act became effective
<i>Italy</i>	July 7, 1884	London: July 15, 1955
Ivory Coast ¹⁾	October 23, 1963	Lisbon: October 23, 1963
Japan	July 15, 1899	Lisbon: August 21, 1965
Kenya	June 14, 1965	Lisbon: June 14, 1965
Laos ¹⁾	November 19, 1963	Lisbon: November 19, 1963
<i>Lebanon</i>	September 1, 1924	London: September 30, 1947
<i>Liechtenstein</i>	July 14, 1933	London: January 28, 1951
<i>Luxembourg</i>	June 30, 1922	London: December 30, 1945
Madagascar ¹⁾	December 21, 1963	Lisbon: December 21, 1963
Malawi ⁵⁾	July 6, 1964	Lisbon: July 6, 1964
Mauritania	April 11, 1965	Lisbon: April 11, 1965
Mexico	September 7, 1903	Lisbon: May 10, 1964
Monaco	April 29, 1956	Lisbon: January 4, 1962
<i>Morocco</i>	July 30, 1917	London: January 21, 1941
<i>Netherlands</i> ⁸⁾	July 7, 1884	London: August 5, 1948
<i>New Zealand</i> ¹⁾	July 29, 1931	London: July 14, 1946
Niger ¹⁾	July 5, 1964	Lisbon: July 5, 1964
Nigeria	September 2, 1963	Lisbon: September 2, 1963
Norway	July 1, 1885	Lisbon: May 10, 1964
Philippines	September 27, 1965	Lisbon: September 27, 1965
Poland	November 10, 1919	The Hague: November 22, 1931
<i>Portugal</i> ⁷⁾	July 7, 1884	London: November 7, 1949
Rhodesia ⁵⁾	April 6, 1965	Lisbon: April 6, 1965
Rumania	October 6, 1920	Lisbon: November 19, 1963
<i>San Marino</i>	March 4, 1960	London: March 4, 1960
Senegal ¹⁾	December 21, 1963	Lisbon: December 21, 1963
South Africa	December 1, 1947	Lisbon: April 17, 1965
<i>Spain</i>	July 7, 1884	London: March 2, 1956
<i>Sweden</i>	July 1, 1885	London: July 1, 1953
Switzerland	July 7, 1884	Lisbon: February 17, 1963
<i>Syrian Arab Republic</i>	September 1, 1924	London: September 30, 1947
Tanzania ¹⁾	June 16, 1963	Lisbon: June 16, 1963
Trinidad and Tobago ¹⁾	August 1, 1964	Lisbon: August 1, 1964
<i>Tunisia</i>	July 7, 1884	London: October 4, 1942
<i>Turkey</i>	October 10, 1925	London: June 27, 1957
Uganda	June 14, 1965	Lisbon: June 14, 1965
Union of Soviet Socialist Republics	July 1, 1965	Lisbon: July 1, 1965
<i>United Arab Republic</i>	July 1, 1951	London: July 1, 1951
United Kingdom of Great Britain and Northern Ireland	July 7, 1884	Lisbon: January 4, 1962
United States of America ⁸⁾	May 30, 1887	Lisbon: January 4, 1962
Upper Volta ¹⁾	November 19, 1963	Lisbon: November 19, 1963
<i>Viet Nam</i> ¹⁾	December 8, 1956	London: December 8, 1956
Yugoslavia	February 26, 1921	Lisbon: April 11, 1965
Zambia	April 6, 1965	Lisbon: April 6, 1965

(Total: 74 States)⁹⁾

*) Explanation of type:

Heavy type: States bound by the Lisbon Act (1958).

Italics: States bound by the London Act (1934).

Ordinary type: States bound by the Hague Act (1925).

- 1) The Convention has been applied, by virtue of Article 16^{bis} of the Convention, on the territories of the following States before their accession to full independence as from the dates indicated: Australia (August 5, 1907), Canada (September 1, 1923), Ceylon (June 10, 1905), Indonesia (October 1, 1888), Israel (Palestine, except Transjordan, September 12, 1933 to May 15, 1948), New Zealand (September 7, 1891), Tanzania (except Zanzibar, January 1, 1938), Trinidad and Tobago (May 14, 1908). The Convention was applied by France, under Article 16^{bis}, to the following States from various dates: Cameroon, Central African Republic, Chad, Congo (Brazzaville), Gabon, Ivory Coast, Laos, Madagascar, Niger, Senegal, Upper Volta, Viet Nam.
- 2) The Convention has been applied to Papua and New Guinea since February 12, 1933, and to Norfolk Island, since July 29, 1936 (the London Act has applied since February 5, 1960); the Hague Act has been applied to Nauru since July 29, 1936.
- 3) Including the Faroe Islands.
- 4) Including the Departments of Guadeloupe, Guiana, Martinique and Reunion; also applied to Overseas Territories.
- 5) The Convention had applied to Malawi and Rhodesia (as component parts of the former Federation of Rhodesia and Nyasaland) since April 1, 1958.
- 6) The Convention has been applied to Curaçao and Surinam since July 1, 1890 (the London Act has applied since August 5, 1948).
- 7) Including the Azores and Madeira.
- 8) The Lisbon Act has been applied to Puerto Rico, Virgin Islands, Samoa and Guam since July 7, 1963.
- 9) Or 75 if East Germany or the German Democratic Republic is also considered as a party (see *Industrial Property*, 1964, p. 254). States disagree on this question.

Separate Agreement for the Repression of False or Deceptive Indications of Source (Madrid Agreement)
founded by the Madrid Agreement (1891), revised at Washington (1911), The Hague (1925), London (1934), and Lisbon (1958)

Member States *)	Original date on which the State became bound by the Agreement	Latest Act by which the State is bound and date on which the ratification of or accession to such Act became effective
Brazil	October 3, 1896	The Hague: October 26, 1929
Ceylon ¹⁾	December 29, 1952	London: December 29, 1952
Cuba	January 1, 1905	Lisbon: October 11, 1964
Czechoslovakia	September 30, 1921	Lisbon: June 1, 1963
Dominican Republic	April 6, 1951	The Hague: April 6, 1951
France ²⁾	July 15, 1892	Lisbon: June 1, 1963
Germany (Federal Republic)	June 12, 1925	Lisbon: June 1, 1963 ³⁾
Hungary	June 5, 1934	London: July 14, 1962
Ireland	December 4, 1925	London: May 14, 1958
Israel ¹⁾	March 24, 1950	London: March 24, 1950
Italy	March 5, 1951	London: March 5, 1951
Japan	July 8, 1953	Lisbon: August 21, 1965
Lebanon	September 1, 1924	London: September 30, 1947
Liechtenstein	July 14, 1933	London: January 28, 1951
Monaco	April 29, 1956	Lisbon: June 1, 1963
Morocco	July 30, 1917	London: January 21, 1941
New Zealand ¹⁾	July 29, 1931	London: May 17, 1947
Poland	December 10, 1928	The Hague: December 10, 1928
Portugal ³⁾	October 31, 1893	London: November 7, 1949
San Marino	September 25, 1960	London: September 25, 1960
Spain	July 15, 1892	London: March 2, 1956
Sweden	January 1, 1934	London: July 1, 1953
Switzerland	July 15, 1892	Lisbon: June 1, 1963
Syrian Arab Republic	September 1, 1924	London: September 30, 1947
Tunisia	July 15, 1892	London: October 4, 1942
Turkey	August 21, 1930	London: June 27, 1957
United Arab Republic	July 1, 1952	London: July 1, 1952
United Kingdom of Great Britain and Northern Ireland	July 15, 1892	Lisbon: June 1, 1963
Viet Nam ¹⁾	December 8, 1956	London: December 8, 1956
(Total: 29 States) ⁴⁾		

*) Explanation of type:

Heavy type: States bound by the Lisbon Act (1958).

Italics: States bound by the London Act (1934).

Ordinary type: States bound by the Hague Act (1925).

1) The Agreement has been applied, by virtue of Article 5 of the Agreement, on the territories of the following States before their accession to full independence as from the dates indicated: Ceylon (September 1, 1913), Israel (Palestine, except Transjordan, September 12, 1933, to May 15, 1948), New Zealand (June 20, 1913), Viet Nam (date under verification).

2) Including the Departments of Guadeloupe, Guiana, Martinique and Reunion; also applied to Overseas Territories.

3) Including the Azores and Madeira.

4) Or 30 if East Germany or the German Democratic Republic is also considered as a party (see *Industrial Property*, 1964, p. 254). States disagree on this question.

Separate Union for the International Registration of Trademarks (Madrid Union)

founded by the Madrid Agreement (1891), revised at Brussels (1900), Washington (1911), The Hague (1925), London (1934), and Nice (1957)

Member States *)	Date on which adhesion to the Union took effect	Latest Act by which the State is bound and date on which the ratification of or accession to such Act became effective
<i>Austria</i>	<i>January 1, 1909</i>	<i>London: August 19, 1947</i>
Belgium	July 15, 1892	Nice: December 15, 1966¹⁾
Czechoslovakia	October 5, 1919	Nice: December 15, 1966
France ²⁾	July 15, 1892	Nice: December 15, 1966
Germany (Federal Republic)	December 1, 1922	Nice: December 15, 1966
<i>Hungary</i>	<i>January 1, 1909</i>	<i>London: July 14, 1962</i>
Italy	October 15, 1894	Nice: December 15, 1966¹⁾
<i>Liechtenstein</i>	<i>July 14, 1933</i>	<i>London: January 28, 1951</i>
Luxembourg	September 1, 1924	Nice: December 15, 1966¹⁾
Monaco ³⁾	April 29, 1956	Nice: December 15, 1966¹⁾
<i>Morocco</i>	<i>July 30, 1917</i>	<i>London: January 21, 1941</i>
Netherlands	March 1, 1893	Nice: December 15, 1966¹⁾
Portugal ⁴⁾	October 31, 1893	Nice: December 15, 1966¹⁾
Rumania	October 6, 1920	Nice: December 15, 1966¹⁾
San Marino	September 25, 1960	Nice: December 15, 1966
Spain ⁵⁾	July 15, 1892	Nice: December 15, 1966¹⁾
Switzerland	July 15, 1892	Nice: December 15, 1966
<i>Tunisia</i>	<i>July 15, 1892</i>	<i>London: October 4, 1942</i>
United Arab Republic ³⁾	July 1, 1952	Nice: December 15, 1966¹⁾
<i>Viet Nam</i> ⁶⁾	<i>December 8, 1956</i>	<i>London: December 8, 1956</i>
Yugoslavia	February 26, 1921	Nice: December 15, 1966
(Total: 21 States)⁷⁾ ⁸⁾		

*) Explanation of type:

Heavy type: States bound by the Nice Act (1957).

Italics: States bound by the London Act (1934).

1) The following States have declared, under Article 3^{bis} of the Nice Act, that the protection resulting from international registration shall not extend to them unless the proprietor of the mark expressly requests it: Belgium (December 15, 1966), Italy (June 14, 1967), Luxembourg (December 15, 1966), Monaco (December 15, 1966), Netherlands (December 15, 1966), Portugal (December 15, 1966), Rumania (June 10, 1967), Spain (December 15, 1966), United Arab Republic (March 1, 1967). The dates in parentheses indicate the effective date of the declaration.

2) Including the Departments of Guadeloupe, Guiana, Martinique and Rennion; also applied to Overseas Territories.

3) Monaco and the United Arab Republic only recognize trademarks registered under the Agreement after the date of their accession to the Union.

4) Including the Azores and Madeira.

5) Spain has declared that it no longer wishes to be bound by the texts earlier than the Nice Act. This declaration became effective on December 15, 1966.

6) This Agreement has been applied, by virtue of Article 11 of the Agreement, on the territory of Viet Nam before its accession to full independence since July 15, 1892 (date under verification).

7) Turkey withdrew from the Union with effect from September 10, 1956. International registrations in effect on that date continue to be recognised by Turkey until they expire.

8) Or 22 if East Germany or the German Democratic Republic is also considered as a party (see *Industrial Property*, 1964, p. 254). States disagree on this question.

Separate Union for the International Deposit of Industrial Designs (The Hague Union)

founded by the Agreement of The Hague (1925), revised at London (1934) and The Hague (1960)¹⁾, and supplemented by the Additional Act of Monaco (1961)

Member States *)	Date of Adhesion to the Union	Date on which the State became bound by the London Act of the Agreement	Date on which the State became bound by the Additional Act of Monaco
Belgium	July 27, 1929	November 24, 1939	November 13, 1964
France ²⁾	October 20, 1930	June 25, 1939	December 1, 1962
Germany (Federal Republic)	June 1, 1928	June 13, 1939	December 1, 1962
<i>Holy See</i>	<i>September 29, 1960</i>	<i>September 29, 1960</i>	—

Member States *)	Date of Adhesion to the Union	Date on which the State became bound by the London Act of the Agreement	Date on which the State became bound by the Additional Act of Monaco
<i>Indonesia</i> ³⁾	<i>December 24, 1950</i>	<i>December 24, 1950</i>	—
Liechtenstein	July 14, 1933	January 28, 1951	July 9, 1966
Monaco	April 29, 1956	April 29, 1956	September 14, 1963
<i>Morocco</i>	<i>October 20, 1930</i>	<i>January 21, 1941</i>	—
Netherlands ⁴⁾	June 1, 1928	August 5, 1948	September 14, 1963
<i>Spain</i>	<i>June 1, 1928</i>	<i>March 2, 1956</i>	—
Switzerland	June 1, 1928	November 24, 1939	December 21, 1962
<i>Tunisia</i>	<i>October 20, 1930</i>	<i>October 4, 1942</i>	—
United Arab Republic	July 1, 1952	July 1, 1952	—
<i>Viet Nam</i> ³⁾	<i>December 8, 1956</i>	<i>December 8, 1956</i>	—
(Total: 14 States) ⁵⁾			

*) Explanation of type:

Heavy type: States bound by the London Act (1934) and the Additional Act of Monaco (1961).

Italics: States bound by the London Act (1934).

- 1) The Act revised at The Hague on November 28, 1960, has been signed by Belgium, France, Federal Republic of Germany, Holy See, Italy, Liechtenstein, Luxembourg, Monaco, Netherlands, Switzerland and Yugoslavia. *This Act is not yet in force.*
- 2) Including the Departments of Guadeloupe, Guiana, Martinique and Reunion; also applied to Overseas Territories.
- 3) The Agreement has been applied, by virtue of Article 22 of the Agreement, on the territories of Indonesia and Viet Nam before their accession to full independence since June 1, 1928.
- 4) Including Curaçao and Surinam.
- 5) Or 15 if East Germany or the German Democratic Republic is also considered as a party (see *La Propriété industrielle*, 1956, p. 21). States disagree on this question.

Separate Union for the International Classification of Goods and Services to which Trademarks are Applied (Nice Union)

founded by the Nice Agreement (1957)

Member States	Date on which adhesion to the Union took effect
Australia	April 8, 1961
Belgium	June 6, 1962
Czechoslovakia	April 8, 1961
Denmark	November 30, 1961
France ¹⁾	April 8, 1961
Germany (Federal Republic)	January 29, 1962
Ireland	December 12, 1966
Israel	April 8, 1961
Italy	April 8, 1961
Lebanon	April 8, 1961
Monaco	April 8, 1961
Morocco	October 1, 1966
Netherlands	August 20, 1962
Norway	July 28, 1961
Poland	April 8, 1961
Portugal	April 8, 1961
Spain	April 8, 1961
Sweden	July 28, 1961
Switzerland	August 20, 1962
United Kingdom of Great Britain and Northern Ireland	April 15, 1963
Yugoslavia	August 30, 1966
(Total: 21 States) ²⁾	

1) Including the Departments of Guadeloupe, Guiana, Martinique and Reunion; also applied to Overseas Territories.

2) Or 22 if East Germany or the German Democratic Republic is also considered as a party (see *Industrial Property*, 1964, p. 254). States disagree on this question.

**Separate Union for the Protection of Appellations of Origin and their International Registration
(Lisbon Union)**

founded by the Lisbon Agreement (1958)

Member States	Date on which ratification or adhesion to the Union took effect
Cuba	September 25, 1966
Czechoslovakia	September 25, 1966
France	September 25, 1966
Haiti	September 25, 1966
Israel	September 25, 1966
Mexico	September 25, 1966
Portugal	September 25, 1966
(Total: 7 States)	

Paris Union

Accession to the Lisbon Act

REPUBLIC OF ARGENTINE

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

(Translation)

“In compliance with the instructions of the Federal Political Department, dated January 10, 1967, the Swiss Embassy has the honour to inform the Ministry of Foreign Affairs that on December 27, 1966, the Embassy of the Argentine Republic in Berne deposited with the Swiss Government a declaration of adhesion by Argentina to the International Convention for the Protection of Industrial Property of 1883, as last revised at Lisbon in 1958.

In conformity with Article 16 (3) of the said Convention, this adhesion will take effect on February 10, 1967.

With regard to its contribution to the expenses of the International Bureau of the Union, this State is placed, at its request, in the Third Class for the purposes of Article 13 (8) and (9) of the Paris Convention as revised at Lisbon.”

* * *

This adhesion will bring the Membership of the Paris Union to 76¹⁾.

¹⁾ Or 77 if East Germany or the German Democratic Republic is also considered as a party (see *Industrial Property*, 1964, p. 254). States disagree on this question.

Madrid Union

**Ad Hoc Conference of Directors
of the National Industrial Property Offices
of the Madrid Union (Trademarks)**

(Geneva, December 13 and 14, 1966)

Report

1. The Ad Hoc Conference of Directors of National Industrial Property Offices of Member countries of the Madrid Union met in Geneva, on December 13 and 14, 1966.

2. The participants at the session of the Ad Hoc Conference were the same as those who participated in the meeting of the Committee of Directors of National Industrial Property Offices of the Separate Madrid Union, which met in Geneva on December 15 and 16, 1966. The list of participants is annexed to the General Report of the Committee.

3. At its first session, the Ad Hoc Conference elected as Chairman, Mr. F. Savignon (France), and as Vice-Chairmen, Mr. K. Haertel (Federal Republic of Germany) and Mr. V. Savić (Yugoslavia).

4. The Ad Hoc Conference, in preparing the first meeting of the Committee, discussed certain amendments to the draft Transitional Regulations of the Madrid Agreement, the draft Internal Rules of Procedure of the Committee, and certain questions of a legal or administrative nature on which BIRPI requested advice. The results of the debates are recorded in the General Report of the Committee and in its annexes.

5. The Ad Hoc Conference unanimously decided that, should the surplus receipts for the financial year 1966, in respect of the Madrid Union, exceed 220,500 Swiss francs, (a) the application of its decision of November 1963 (quoted in paragraph 1 of Document MJ/DO/VIII/4) would be suspended; (b) that the same sum would be distributed for 1966 as was distributed for 1965; (c) that the balance of the surplus receipts for the year 1966 would be paid into the reserve fund of the Madrid Union.

6. *This report was unanimously adopted by the Ad Hoc Conference.*

Committee of Directors of the National Industrial Property Offices of the Madrid Union (Trademarks)

(Geneva, December 15 and 16, 1966)

General Report

Introduction

1. The Committee of Directors of National Industrial Property Offices of the Separate Madrid Union, set up under Article 10 of the Madrid Agreement, as revised at Nice on June 15, 1957, and which came into force on December 15, 1966, met for the first time on December 15 and 16, 1966, at the Headquarters of BIRPI, in Geneva.

2. The Industrial Property Offices of the following countries, Members of the Separate Madrid Union, were represented: Austria, Belgium, Czechoslovakia, France, Federal Republic of Germany, Hungary, Italy, Luxembourg, Monaco, Netherlands, Portugal, Rumania, San Marino, Spain, Switzerland, Yugoslavia.

3. The Industrial Property Offices of the following countries, Members of the Paris Union but not members of the Separate Madrid Union, were represented by observers: Algeria, Norway, Poland, United States of America.

4. The African and Malagasy Industrial Property Office (OAMPI) was also represented by an observer.

5. The list of participants is annexed to this General Report (Annex I).

6. The session was opened by Professor G. H. C. Bodenhausen, Director of BIRPI.

7. The Committee elected as Chairman by acclamation Mr. François Savignon (France), and, as Vice-Chairmen, Messrs. Kurt Haertel (Federal Republic of Germany) and Vladimir Savić (Yugoslavia).

8. Professor Bodenhausen, Director of BIRPI, appointed Deputy Director Ch.-L. Magnin as Secretary of the Committee.

Internal Rules of Procedure

9. The Committee unanimously adopted its Internal Rules of Procedure, the text of which is reproduced in an Annex ¹⁾.

Transitional Regulations for Implementing the Madrid Agreement

10. By way of amendment to the Transitional Regulations, the Committee unanimously decided to adopt the text according to the decision contained in Annex II. The Austrian delegation abstained from voting.

11. Before adopting the Regulations, the Committee rejected, by a majority vote, a proposal designed to insert in the Regulations, the following text as a second paragraph to Article 31: “ (2) Within the limits provided for by Articles 3 (4) and 8 (3) of the Nice Act and by the provisions of these Regulations, a registration may bear a date prior to December

15, 1966, if the application for registration has reached BIRPI on or after that date.”

Reserve Fund

12. The Committee unanimously confirmed the decision taken by the Ad Hoc Conference of Directors, at its session of December 13 and 14, 1966, providing that if the surplus receipts for the financial year 1966, in respect of the Madrid Union, exceeds 220,500 Swiss francs, (a) the application of its decision of November 1963 (quoted in paragraph 1 of Document MJ/DO/VII/4) would be suspended; (b) that the same sum would be distributed for 1966 as was distributed for 1965; (c) the balance of the surplus receipts for the year 1966 would be paid into the reserve fund of the Madrid Union.

13. The Austrian delegation abstained from voting.

Opinion Relating to Certain Provisions of the Nice Act

14. The Committee expressed its opinion on certain questions of a legal and administrative nature relating to certain provisions of the Nice Act. The Committee agreed with the opinion expressed by BIRPI in Documents MJ/DO/VIII/7 and 9 ¹⁾.

¹⁾ Text of Document MJ/DO/VIII/7:

NOTE

concerning the validity in the country of the assignee of an international registration previously recorded in the name of an assignor established in another country

1. BIRPI has been asked whether, in the event of a transfer of an international registration by an assignor established in one country to an assignee established in another country, the international registration would be valid in the country of the assignee, under the Nice Act of the Madrid Agreement.

2. This question did not arise under the London Act.

3. In effect, although under both the London Act and, for that matter, the Nice Act, an international registration is not valid in the country of origin, under the London Act the country of origin changed when an international registration was transferred by an assignor established in one country to an assignee established in another country. In this case, the country of the assignee became the new country of origin and, as a result, the international registration was no longer valid there after its transfer. The mark which was the subject of the transferred international registration had to be protected in the new country of origin by means of a national registration intended to serve as a basis for the international registration transferred to the name of the assignee.

4. On the other hand, under the Nice Act, in the case of a transfer of an international registration, the country of origin never changes but remains that of the assignor, that is to say, the country where the national registration which served as a basis for the first international registration of the mark was effected. It is therefore in the country of the assignor, which remains the sole country of origin, that the international registration is not valid. It will, on the other hand, be valid in the country of the assignee which, under the Nice Act, is not a new country of origin and which the Act calls the country of the person in whose name the international registration stands, or the country of the proprietor.

5. Such will be the position during the period of five years fixed by Article 6 of the Nice Act, during which an international registration will be dependent on the national registration in the country of origin. This position will continue on the expiration of the period of five years, because although, after its expiration, the country of origin will cease to have any effect as far as the validity of the international registration in the hands of the assignee is concerned, it will nevertheless remain the sole country of origin and, consequently, the only country where the international registration is not valid.

Text of Document MJ/DO/VIII/9:

NOTE

concerning the effect of Article 9^{quater} of the Nice Act on the application of Article 8 (4), (5) and (6)

1. Article 9^{quater} of the Nice Act of the Madrid Agreement contains the following provisions:

“ If several countries of the Special Union agree to effect the unification of their domestic laws relating to marks, they may notify the Government of the Swiss Confederation:

¹⁾ Omitted. (Ed.)

15. With regard to Document MJ/DO/VIII/6, the Committee was of the opinion that when an international registration was transferred by an assignor established in one country to an assignee established in another country, the period of five years during which, under Articles 9^{bis} and 9^{ter}, BIRPI shall seek the consent of the Administration of the country of the new owner, should be calculated in the following manner:

- (a) for international registrations effected prior to December 15, 1966, date on which the Nice Act came into force, the period would be calculated as from that date;
- (b) for registrations effected after December 15, 1966, the period would be calculated as from the date of such registrations.

16. The Committee was also of the opinion that this consent should be sought even after the expiration of this period, as long as a country, party to the Agreement, had not acceded

- (a) that a common Administration is substituted for the national Administration of each of them, and
- (b) that the whole of their respective territories must be considered as a single country for the purposes of the application of all or part of this Agreement.

2. BIRPI has been asked whether, in the event of the accession to the Madrid Agreement of the twelve member countries of the African and Malagasy Industrial Property Office (OAMPI) which severally pay their contributions towards the expenses of BIRPI, pursuant to Article 13 of the Paris Convention, these countries would each be entitled to receive a share in the distribution of receipts from the international registration of marks, according to the provisions of Article 8 (4), (5) and (6) of the Nice Act, or whether, on the contrary, under the provisions of Article 9^{quater} of the Act, they would be entitled, as a whole, to only a single share of the receipts referred to in the above-mentioned paragraphs of Article 8.

3. It is to be noted in this connection that Article 9^{quater} does not impose any obligation on countries which have effected the unification of their domestic laws relating to marks. It simply offers them a possibility, namely, that of addressing to the Government of the Swiss Confederation a notification in two mutually independent parts.

4. They may notify the Government of the Swiss Confederation that a common Administration is substituted for the national Administration of each of them, and they may also add, if they so wish, that the whole of their respective territories must be considered as a single country for the purposes of the application of all or part of the Madrid Agreement.

5. Several courses are thus open to the OAMPI countries:

- (1) they may not address any notification to the Swiss Government;
- (2) they may notify the Swiss Government that a common Administration is substituted for the national Administration of each of them;
- (3) they may notify the Swiss Government that the whole of their respective territories must be considered as a single country for the purposes of the application of part of the Madrid Agreement, which part they may choose as they wish;
- (4) they may notify the Swiss Government that the whole of their respective territories must be considered as a single country for the purposes of the application of all of the Madrid Agreement.

6. From the foregoing it follows that:

- (a) if no notification is addressed to the Swiss Government, each OAMPI country will receive its share of the returns from the international registration of marks (case No. 1);
- (b) the situation will be the same if only the notification provided for under (2) is addressed to the Swiss Government; the sole consequence of this notification will then be that all administrative communications of BIRPI will have to be addressed to the common Administration;
- (c) the situation will also be the same in the case of the notification provided for under (3), if the countries notify that the whole of their respective territories must be considered as a single country for the purposes of that part only of the Agreement which does not concern the distribution of receipts from international registration;
- (d) lastly, in the case provided for under (4), the OAMPI countries as a whole would receive only a single share in the distribution of receipts from the international registration of marks.

7. It may therefore be concluded from the foregoing that if the OAMPI countries contemplated acceding to the Madrid Agreement it would be possible, if they so wished, for each of them to receive its share in the distribution of receipts from the international registration of marks, just as each of them shares in the expenses of BIRPI, pursuant to Article 13 of the Paris Convention.

to the Nice Act, in order to prevent the validity of the transfer being contested in that country, for which the consent of the new country of "origin" would still be required, in accordance with the London Act.

17. It was understood that the question of the interpretation of the provisions of Article 6 (2) of the Agreement should remain within the competence of the courts of each Member country.

Recommendation

18. With regard to the problem contained in Document MJ/DO/VIII/8 and 12, the Committee, on a proposal made by the French Delegation, unanimously adopted the following Recommendation:

"Where the date — as indicated in the application for international registration referred to in Article 2 (2) (k) of the Regulations — on which the application for international registration is received by the Administration of the country of origin is prior to December 15, 1966, the international registration shall bear the date on which BIRPI received the application for registration.

"The date of reception of this application by the national Administration shall be recorded for information in the international register and shall be mentioned in *Les Marques internationales*."

Possible Revision of the Nice Act

19. On a proposal made by Mr. Hoffmann (Luxembourg), and supported by Mr. Labry (France), the Committee requested the Director of BIRPI to study the advisability of revising the Nice Act at the next Conference of Vienna if the Austrian Authorities agreed. The results of this study would be submitted to the Committee, which, if necessary, could meet for this purpose in extraordinary session.

20. *This General Report was unanimously adopted by the Committee on December 16, 1966.*

ANNEX I

List of Participants

I. States Members of the Madrid Union

Austria

Mr. Gottfried Thaler, President of the Patent Office, Vienna.
Dr. Thomas Lorenz, Ratssekretär, Patent Office, Vienna.

Belgium

Mr. A. Schurmans, Director of the Industrial Property Service, Brussels.

Czechoslovakia

Dr. Miloslav Špunda, Head of the Trademarks Department, Office of Patents and Inventions, Prague.
Dr. Vladimír Šulc, Head of the International Trademarks Section, Office of Patents and Inventions, Prague.

France

Mr. François Savignon, Director of the National Institute of Industrial Property, Paris.
Mr. Roger Labry, Counsellor of Embassy, Ministry of Foreign Affairs, Directorate of Economic and Financial Affairs, Paris.
Mr. Maurice Bierry, Civil Administrator in the Ministry of Industry, Paris.

Germany (Fed. Rep.)

Dr. Kurt Haertel, President, Patent Office, Munich.
 Dr. Romuald Singer, Senatsrat, Federal Patent Tribunal, Munich.
 Mr. Willy Miosga, Regierungsdirektor, Patent Office, Munich.
 Mr. Peter Schönfeld, First Secretary, Permanent Delegation of the Federal Republic of Germany, Geneva.

Hungary

Mr. Emil Tasnádi, President, National Office of Inventions, Budapest.
 Dr. Georges Pálos, Legal Advisor, National Office of Inventions, Budapest.

Italy

Mr. Aldo Pelizza, Inspector-General, Ministry of Industry, Patent Office, Rome.

Luxembourg

Mr. Jean-Pierre Hoffmann, Head of the Industrial Property Service, Luxembourg.

Monaco

Mr. Jean-Marie Notari, Director of the Industrial Property Service, Monaco.

Netherlands

Mr. Enno Van Weel, Member of the Patent Council, The Hague.
 Mr. A. M. de Geus, Assistant Chief of the Trademarks Section, Industrial Property Office, The Hague.

Portugal

Mr. Ruy Serrão, Director of the Industrial Property Office, Lisbon.

Rumania

Mr. Nicolai Gheorghiu, Director-General, National Office of Inventions, Bucharest.
 Mr. Costel Mitran, Second Secretary, Permanent Mission of Rumania, Geneva.

San Marino

Mr. Jean Charles Munger, Chancellor, Permanent Delegation of the Republic of San Marino to the United Nations Office, Geneva.

Spain

Mr. Antonio Fernandez Mazarambroz y Martin-Rabadán, Director of the Industrial Property Registration Office, Madrid.

Switzerland

Mr. Joseph Voyame, Director of the Federal Office of Intellectual Property, Berne.
 Mr. Paul Braendli, Federal Office of Intellectual Property, Berne.

Yugoslavia

Mr. Vladimir Savić, Director, Patent Office, Belgrade.

II. Observers*Algeria*

Mr. Azzedine Bendiab, Head of the Industrial Property Division, National Industrial Property Office, Algiers.
 Mr. Salah Bouzidi, Head of the Trademarks Office, National Industrial Property Office, Algiers.

Norway

Mr. Roald Røed, Assistant Comptroller, Patent Office, Oslo.

Poland

Mr. Jan Dalewski, Head of the Legal Section, Patent Office, Warsaw.

United States of America

Mr. David B. Allen, Acting Director, Office of International Patent and Trademark Affairs, U. S. Patent Office, Washington, D. C.

African and Malagasy Industrial Property Office (OAMPI)

Mr. Richard Raparson, Chief of the Patent Service, African and Malagasy Industrial Property Office, Yaoundé.

III. BIRPI

Professor G. H. C. Bodenhausen, Director.
 Dr. Arpad Bogsch, Deputy Director.
 Mr. Ch.-L. Magnin, Deputy Director.
 Mr. L. Egger, Counsellor.
 Mr. E. Margot, Head of the Registration Service (Marks).

IV. Bureau of the Committee

Chairman: Mr. François Savignon (France).
 Vice-Chairmen: Dr. Kurt Haertel (Federal Republic of Germany).
 Mr. Vladimir Savić (Yugoslavia).
 Secretary: Mr. Ch.-L. Magnin (BIRPI).

ANNEX II**Decision relating to the Transitional Regulations**

The Committee of Directors of the National Industrial Property Offices of the Madrid Union concerning the international registration of trademarks, within the framework of which, under Article 30 (1) of the Transitional Regulations, the Directors of National Industrial Property Offices of countries in respect of which the Nice Act has not yet come into force, also participate,

Considering that the Regulations, of December 16, 1966, came into force at the beginning of that day,

Desiring to amend the Regulations on certain points,

Unanimously decides, by way of amendment of the said Regulations, to establish the text as contained in the document annexed to this decision.

Annex to the Decision Relating to the Transitional Regulations

Subject to the modifications indicated hereafter, the Transitional Regulations are those reproduced in the *Guide du déposant* (Provisional edition of June 1, 1966), pp. 75 to 95¹⁾.

Article 20*Entry in the Register*

(1) [no change]

(2) Nevertheless, renewals for which the application has been transmitted by the Administration of a country party to the Nice Act shall be entered in respect of all the countries to which they apply, on the date provided for by the said Act.

Article 28*Fees and Other Charges*

(1) to (10) [no change]

(11) The fee for entry in the International Register of a change made to the entry of a mark in the national register and which also affects the international registration [Article 9 of the Agreement; Article 22 (1) of these Regulations], and

¹⁾ The Transitional Regulations as reproduced in the *Guide du déposant* (provisional edition of June 1, 1966) were published in the June 1966 issue of *Industrial Property*, pages 131 to 140. (Ed.)

the fee for entry of a transfer or assignment of an international mark (Article 9^{bis} and 9^{ter} of the Agreement; Article 21 of these Regulations) is 40 francs per entry and per mark; figures (8), (9), (12) and (13) of this article are reserved.

(12) to (21) [no change]

CHAPTER X

Distribution of Certain Fees and Surplus Receipts

Article 29

Distribution of Certain Fees and Surplus Receipts

(1) The coefficient referred to in Article 8 (5) of the Agreement shall be three ²⁾.

(2) (a) Any surplus receipts from the Registration Service shall be divided equally among the member countries of the Separate Union; however, the share of any country which is not bound on July 1 of the financial year by the Nice Act shall be reduced by 25 per cent and the total of the amounts thus deducted shall be distributed equally among the countries which, on the said date, are bound by the Nice Act.

(b) The provisions of the preceding sub-paragraph shall be put into effect for the financial year 1967; any surplus receipts from the financial year 1966 shall be distributed equally among the member countries of the Separate Union.

Article 31

[Paragraph (2) is suppressed]

²⁾ The following nine countries are "countries which make a preliminary examination" for the application of Article 8 (5) of the Nice Act: Austria, Czechoslovakia, Federal Republic of Germany, Hungary, Netherlands, Portugal, Spain, United Arab Republic, Yugoslavia.

CONVENTIONS AND TREATIES

AFRICAN AND MALAGASY INDUSTRIAL PROPERTY OFFICE (OAMPI)

Convention relating to

- the validation of formalities completed outside the prescribed time-limits under the transitional provisions of the Agreement of Libreville of September 13, 1962 ¹⁾;
- the opening of a supplementary period of six months.

The Government of the Federal Republic of Cameroon,
The Government of the Central African Republic,
The Government of the Republic of Congo,
The Government of the Republic of Ivory Coast,
The Government of the Republic of Dahomey,
The Government of the Republic of Gabon,

¹⁾ See *Industrial Property*, 1963, pp. 66 et seq.

The Government of the Republic of Upper Volta,
The Government of the Republic of Malagasy,
The Government of the Islamic Republic of Mauritania,
The Government of the Republic of Niger,
The Government of the Republic of Senegal,
The Government of the Republic of Chad.

Considering that the annexes of the Agreement relating to the establishment of an African and Malagasy Industrial Property Office, signed at Libreville on September 13, 1962, entered into force on January 1, 1964;

Considering that a period of one year commencing on this date of entry into force was opened, by virtue of the transitional provisions of the annexes, to the owners of acquired rights for the purposes of completing the formalities prescribed for the maintenance or exercise of these rights;

Having observed that certain owners failed to transmit their applications or declarations to the Office before January 1, 1965, and have requested the validation of formalities completed after the time-limit of one year as well as the opening of a supplementary period.

Have resolved to conclude a convention for the purpose of giving satisfaction to these requests and have designated plenipotentiaries to this end who have agreed upon what follows:

Article 1

The formalities prescribed under articles 60, 61 and 62 of annex I, 35, 36 and 37 of annex II and 31, 32 and 33 of annex III of the Agreement of Libreville of September 13, 1962, and completed after the expiry of the period of one year referred to above up to March 31, 1965, shall be deemed to be valid.

Article 2

A supplementary period of 6 months for the purposes of the completion of the formalities referred to in Article 1 may be opened at the latest September 30, 1966. The date from which such period shall run shall be fixed by the Office and notified to the Member States.

Article 3

The annual patent fees due since the date of entry into force of the annexes of the Agreement up to the end of the period specified in Article 2 may be validly paid during the supplementary periods stipulated in Articles 1 and 2.

Article 4

This Convention shall be ratified and the instruments of ratification shall be deposited with the Government of the Federal Republic of Cameroon.

Article 5

This Convention shall enter into force on the date of deposit of the instruments of ratification by at least $\frac{2}{3}$ of the States party to the Agreement of Libreville of September 13, 1962.

Article 6

This Convention shall be open to the adhesion of any non-signatory State which is party to the Agreement of Libreville.

The instruments of adhesion shall be deposited with the Government of the Federal Republic of Cameroon.

The adhesion shall take effect on the date of entry into force of this Convention. If the instrument of adhesion is deposited after this date, adhesion shall take effect on the date of such deposit.

Article 7

The Government of the Federal Republic of Cameroon shall notify the signatory States and the Office of the deposit of the instrument of ratification and adhesion as well as the date of entry into force of this Convention and the date on which the adhesions took effect.

LEGISLATION

AUSTRALIA

Trade Marks Act 1955-1958

An Act relating to Trade Marks

(Second Part)¹⁾

PART VIII

Renewal of Registration

Renewal of registration

69. — The Registrar shall, on application made by the registered proprietor of a trade mark within the prescribed period, renew the registration of the trade mark for a period of fourteen years from the expiration of the last registration of the trade mark.

Procedure on expiry of period of registration

70. — (1) At the prescribed time before the expiration of the last registration of a trade mark, the Registrar shall send notice to the registered proprietor or his agent in Australia of the date at which the existing registration will expire and the conditions as to payment of fees and otherwise upon which a renewal of the registration may be obtained.

(2) If, at the expiration of the time prescribed in that behalf, those conditions have not been complied with, the Registrar may remove the trade mark from the Register.

(3) An appeal lies to the Appeal Tribunal from a decision of the Registrar under the last preceding sub-section.

Restoration of trade mark removed for non-payment of renewal fee

71. — (1) Where a trade mark has been removed from the Register for non-payment of the prescribed fee, the Registrar may, within twelve months from the date of expiration

of the registration of the trade mark, if satisfied that it is just so to do, restore the trade mark to the Register, and renew the registration of the trade mark, either generally or subject to such conditions or limitations as he sees fit to impose, for a period of fourteen years from the expiration of the last registration.

(2) An appeal lies to the Appeal Tribunal from a decision of the Registrar under the last preceding sub-section.

(3) Section one hundred and thirty of this Act does not apply in relation to sub-section (1) of this section.

Status of un-renewed trade mark

72. — Where a trade mark has been removed from the Register for non-payment of the fee for renewal, the trade mark shall, for the purpose of an application for registration by another person lodged not later than twelve months next after the expiration of the last registration, be deemed to be a trade mark which is already registered, unless it is shown to the satisfaction of the Registrar that—

- (a) there has been no use in good faith of the trade mark during the two years immediately preceding the expiration of the last registration; or
- (b) no deception or confusion would be likely to arise from the use of the trade mark which is the subject of the application for registration by reason of any previous use of the trade mark which has been removed.

PART IX

Registered Users

Application of Part

73. — This Part applies only in relation to trade marks registered in Part A or Part B of the Register.

Registered users

74. — (1) Subject to this section, a person other than the registered proprietor of a trade mark may be registered as a registered user of that trade mark for all or any of the goods in respect of which the trade mark is registered.

(2) Where it is proposed that a person shall be registered as a registered user of a trade mark, the registered proprietor and the proposed registered user shall apply in writing to the Registrar and shall furnish him with a statutory declaration made by the registered proprietor, or by some person authorized to act on his behalf and approved by the Registrar—

- (a) giving particulars of the relationship, existing or proposed, between the registered proprietor and the proposed registered user, including particulars showing the degree of control by the registered proprietor over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed registered user will be the sole registered user or that there will be any other restriction as to persons for whose registration as registered users application may be made;
- (b) stating the goods for which registration is proposed;

¹⁾ See *Industrial Property*, 1966, p. 276.

- (c) stating any conditions or restrictions proposed with respect to the characteristics of the goods, to the mode or place of permitted use or to any other matter; and
- (d) stating whether the permitted use is to be for a period or without limit of period, and, if for a period, the duration of the period,
- and with such further documents, information or evidence as is required under the regulations or by the Registrar.

(3) Where the requirements of the last preceding sub-section have been complied with and the Registrar, after considering the documents, information and evidence furnished to him under that sub-section, is satisfied that, in all the circumstances, the use of the trade mark in relation to the proposed goods or any of them by the proposed registered user, subject to conditions or restrictions which the Registrar thinks appropriate, would not be contrary to the public interest, the Registrar may register the proposed registered user as a registered user for the goods as to which he is so satisfied, subject to those conditions or restrictions.

(4) The Registrar shall not register a person as a registered user of a trade mark if it appears to him that the registration would tend to facilitate trafficking in the trade mark.

(5) The Registrar may determine that the registration of a person as a registered user of a trade mark shall be for such period as, having regard to the information referred to in paragraph (d) of sub-section (2) of this section, the Registrar thinks fit.

(6) The Registrar may determine that the period of the registration of a person as a registered user of a trade mark shall commence on the date on which the application by that person for registration as a registered user was made.

(7) The Registrar shall, if so required by an applicant under sub-section (2) of this section, ensure that any document, information or evidence furnished for the purpose of that application (other than matter entered in the Register) is not disclosed to any other person except by order of the High Court.

Variation, etc., of registration

75. — Without affecting the operation of section twenty-two of this Act, the registration of a person as a registered user —

- (a) may be varied by the Registrar, on the application in writing of the registered proprietor, with respect to the goods for which, or with respect to any conditions or restrictions subject to which, the registration has effect;
- (b) may be extended by the Registrar, on the application in writing of the registered proprietor, for such period as the Registrar thinks fit;
- (c) may be cancelled by the Registrar on the application of the registered proprietor or of the registered user or of any other registered user of the trade mark; or
- (d) may be cancelled by the Registrar on the application of a person on the ground —
- (i) that the registered user has used the trade mark otherwise than by way of the permitted use, or in

such a way as to cause, or to be likely to cause, deception or confusion;

- (ii) that the registered proprietor or the registered user misrepresented, or failed to disclose, some fact material to the application for the registration or that the circumstances have materially changed since the date of the registration; or
- (iii) that the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested.

Cancellation of registration

76. — The Registrar may at any time cancel the registration of a person as a registered user of a trade mark for any goods in respect of which the trade mark is no longer registered.

Effect of permitted use

77. — (1) The permitted use of a registered trade mark shall be deemed to be use by the registered proprietor of the trade mark and shall be deemed not to be use by a person other than the registered proprietor, for the purposes of section twenty-three of this Act and for any other purpose for which use by the registered proprietor of the trade mark is material under this Act.

(2) Where —

- (a) a person is registered as a registered user of a trade mark;
- (b) there has been previous use (whether before or after the commencement of this Act) of the trade mark by that person; and
- (c) that use is in relation to goods in respect of which that person is registered and, where he is registered subject to conditions or restrictions —
- (i) that use complied substantially with those conditions or restrictions; or
- (ii) did not so comply but was not such as to be contrary to the public interest,

the last preceding sub-section has effect as if that previous use had been permitted use.

(3) Neither the registration of a person as a registered user of a trade mark, nor the use by that person of the trade mark as a registered user, prejudices any of the rights arising at common law of the person who is the registered proprietor of the trade mark.

(4) For the purpose of determining the rights arising at common law of the person who is the registered proprietor of a trade mark, the use of the trade mark by a registered user shall be deemed to be use by that person and shall be deemed not to be use by a person other than that person.

Infringement proceedings

78. — (1) Subject to any agreement subsisting between the registered user of a trade mark and the registered proprietor of the trade mark, the registered user is entitled to call upon the registered proprietor to take proceedings for infringement of the trade mark, and, if the registered proprietor refuses or

neglects to do so within two months after being so called upon, the registered user may institute proceedings for infringement in his own name as if he were the registered proprietor and shall make the registered proprietor a defendant.

(2) A registered proprietor so added as a defendant is not liable for costs unless he enters an appearance and takes part in the proceedings.

Rights of registered user not assignable

79. — This Part does not confer on the registered user of a trade mark an assignable or transmissible right to the use of that trade mark.

Hearing by Registrar

80. — The Registrar shall not exercise a discretionary power under this Part adversely to a person without, if so required, giving to each person who will be affected by the exercise of the power an opportunity of being heard.

Appeals

81. — An appeal lies to the Appeal Tribunal from a decision of the Registrar under this Part.

PART X

Assignment of Trade Marks

Assignment and transmission of trade marks

82. — (1) Subject to this section, a registered trade mark may be assigned and transmitted with or without the goodwill of the business concerned in the goods in respect of which the trade mark is registered or of some of those goods.

(2) Subject to the next three succeeding sub-sections, an assignment of a registered trade mark without goodwill, whether before or after the commencement of this Act, is invalid if —

- (a) the trade mark was not at any time in use in good faith in Australia by the assignor or his predecessor in title; or
- (b) a substantially identical or deceptively similar trade mark continues to be used by the assignor, after the assignment, in relation to other goods, where there exists a connection in the course of trade between those goods and the assignor and where those goods are of the same description as those in respect of which the trade mark has been assigned, or of such a description that the public is likely to be deceived by the use of the trade mark by the assignor and assignee upon their respective goods.

(3) Paragraph (a) of the last preceding sub-section does not apply where —

- (a) the trade mark was registered with the intention that it should be assigned to a body corporate to be formed and the trade mark has been so assigned; or
- (b) the trade mark was registered with the intention that a person should be permitted to use it as a registered user and a registered user has been registered in respect of the trade mark within six months after the registration of the trade mark and has used the trade mark within that period.

(4) An assignment of a trade mark is not invalid if, at the date of the institution of the proceedings in which the validity of the assignment is called in question, the trade mark has come to denote to the public a connection in the course of trade between the goods and the assignee to the exclusion of all other persons, or, if the registration is limited to a territory, to the exclusion of all other persons within that territory.

(5) An assignment of a trade mark shall not be held to be invalid except in proceedings instituted within three years after the registration of the assignment.

(6) If goods bearing a registered trade mark are purchased or acquired by a person, the sale of or other dealing in those goods by that person, or by a person claiming under or through him, is not an infringement of the trade mark by reason only of the trade mark having been assigned by the registered proprietor to some other person after the purchase or acquisition of those goods.

(7) All rights subsisting in a trade mark (being a registered trade mark), whether under this Act or otherwise, shall be deemed to be assigned upon the registration of the assignment of the trade mark.

PART XI

Certification Trade Marks

Certification trade marks

83. — (1) Where a mark is adapted in relation to goods to distinguish in the course of trade goods certified by a person, or by another person authorized by the first-mentioned person, in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic from goods not so certified, the mark may, upon the application of the first-mentioned person, be registered in Part C of the Register, in the name of the applicant as proprietor, as a certification trade mark in respect of those goods.

(2) A mark is not so registrable upon the application of a person who carries on a trade in goods of the kind certified.

(3) In determining whether a mark is adapted so to distinguish in relation to goods, regard may be had to the extent to which —

- (a) the mark is inherently adapted so to distinguish; and
- (b) by reason of the use of the mark or of any other circumstances, the mark has become adapted so to distinguish.

Rights given by registration

84. — (1) Subject to this Act, the registration of a certification trade mark in Part C of the Register, if valid, gives to the registered proprietor the right to the exclusive use of the mark in relation to the goods in respect of which the mark is registered and to obtain relief in respect of infringement of the mark in the manner provided by this Act.

(2) The right to the exclusive use of a certification trade mark given by registration is subject to any conditions or limitations entered in the Register and is not infringed by the use of the mark in relation to goods to be sold or otherwise traded in in a place, in relation to goods to be exported to a market, or in any other circumstances, to which, having regard

to those conditions or limitations, the registration does not extend.

(3) The right to the exclusive use of a certification trade mark given by registration is not infringed by the use of the mark by a person in relation to goods certified by the registered proprietor of the certification trade mark if —

- (a) as to those goods or a bulk of which they form part, the registered proprietor, or another person in accordance with his authority under the rules governing the use of the mark, has applied the mark and has not subsequently removed or obliterated it; or
- (b) the registered proprietor has expressly or impliedly consented to the use of the mark.

(4) The last preceding sub-section does not have effect in the case of use consisting of the application of a certification trade mark to goods, notwithstanding that they are such goods as are mentioned in that sub-section, if the application of the mark is contrary to the rules governing the use of the mark.

Rules governing the use of certification trade marks

85. — (1) An application for the registration of a mark as a certification trade mark under this Part shall be accompanied by draft rules for governing the use of the mark.

(2) The rules shall include provisions as to the cases in which the goods are to be certified and use of the certification trade mark authorized and may contain any other provisions which the Registrar requires or permits to be inserted in the rules (including provisions referring to a right of appeal to the Registrar against a refusal to certify goods or to authorize the use of the mark in accordance with the rules).

Matters to be considered before acceptance

86. — (1) Before accepting an application under this Part, the Registrar shall consider —

- (a) whether the applicant or person authorized by him is competent to certify the goods in respect of which the mark is to be registered;
- (b) whether the draft rules are satisfactory; and
- (c) whether the registration applied for would be to the public advantage.

(2) Before accepting the application, the Registrar may require the applicant to make such amendments or modifications of the draft rules as he thinks proper.

(3) An appeal lies to an Appeal Tribunal from a decision of the Registrar under the last preceding sub-section.

Alteration of rules

87. — (1) The rules governing the use of a certification trade mark may, on the application of the registered proprietor, be altered by the Registrar.

(2) An application under the last preceding sub-section shall be advertised as prescribed and is subject to opposition as prescribed.

Rectification of Register

88. — (1) The power to order the rectification of the Register conferred by section twenty-two of this Act extends,

in relation to a certification trade mark, to rectification on the ground —

- (a) that the registered proprietor or person authorized by him is no longer competent, in relation to any of the goods in respect of which the mark is registered, to certify those goods;
- (b) that it is no longer to the public advantage that the mark should be registered as a certification trade mark;
- (c) that the registered proprietor has failed to observe a provision of the rules governing the use of the mark which he is required to observe; or
- (d) that it is necessary, for the public advantage, that if the mark remains registered as a certification trade mark, the rules governing the use of the mark should be varied.

(2) The High Court may, on the application of a person aggrieved or of the Registrar, make such order as it thinks fit for varying the rules governing the use of a certification trade mark.

(3) Notice of an application to the High Court under this section (other than an application by the Registrar) shall be given to the Registrar, who may appear and be heard and shall appear if so directed by the High Court.

(4) An office copy of an order under this section shall be served on the Registrar, who shall, upon receipt of the order, take such steps as are necessary to give effect to the order.

Certification trade marks not assignable

89. — A certification trade mark may be assigned or transmitted with the consent of the Registrar.

Transitional provisions

90. — (1) The repealed Acts apply, notwithstanding their repeal, to and in relation to applications for the registration of standardization trade marks made before the commencement of this Act.

(2) A mark registered on such an application shall be registered as a certification trade mark in Part C of the Register and this Act applies to and in relation to a certification trade mark so registered.

(3) The Registrar may require an applicant under an application referred to in sub-section (1) of this section to lodge at the Trade Marks Office such rules as the Registrar permits or requires governing the use of the mark.

(4) Marks which, immediately before the commencement of this Act, were registered under the repealed Acts as standardization trade marks shall be deemed to be registered as certification trade marks in Part C of the Register.

(5) The registered proprietor of such a mark may lodge, or may be required by the Registrar as a condition of the continuance of the registration to lodge, at the Trade Marks Office such rules as the Registrar permits or requires governing the use of the mark.

(6) Where no rules have been lodged at the Trade Marks Office in respect of a certification trade mark registered under this section, this Part has effect in relation to that mark as if references in this Part to rules had been omitted.

Rules to be open for inspection

91. — Rules governing the use of certification trade marks shall be open to inspection in like manner as the Register.

Application of Act to certification trade mark

92. — The provisions of this Act (other than sections twenty-three, twenty-four, twenty-five, twenty-six, thirty-six, thirty-seven and thirty-eight, sub-section (1) of section forty, sections forty-five, fifty-eight, sixty and sixty-one, sub-section (2) of section sixty-two, section sixty-three and Parts IX, X and XII) apply in relation to the registration of a mark as a certification trade mark under this Part and to a mark registered as a certification trade mark.

PART XII

Defensive Trade Marks

Defensive registration of well-known trade marks

93. — (1) Where a trade mark registered in Part A of the Register has been used to such an extent in relation to all or any of the goods in respect of which it is registered that the use of the trade mark in relation to other goods would be likely to be taken as indicating a connection between those other goods and the registered proprietor, the trade mark may, upon the application of the registered proprietor of the trade mark, be registered as a defensive trade mark in Part D of the Register, in the name of the applicant as proprietor, in respect of all or any of those other goods notwithstanding that he does not use or propose to use the trade mark in relation to those other goods and notwithstanding anything in section twenty-three of this Act.

(2) A trade mark registered as a defensive trade mark in respect of goods is not liable to be removed from the Register under section twenty-three of this Act in respect of those goods.

(3) A trade mark may be registered as a defensive trade mark in respect of goods notwithstanding that the trade mark is already registered in the name of the applicant in respect of those goods otherwise than as a defensive trade mark or may be registered in respect of goods otherwise than as a defensive trade mark notwithstanding that the trade mark is already registered in the name of the applicant in respect of those goods as a defensive trade mark.

(4) A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same person shall, notwithstanding that the respective registrations are in respect of different goods, be deemed to be, and shall be registered as, associated trade marks.

Rectification of Register

94. — (1) The High Court may, on the application of a person aggrieved or of the Registrar, cancel the registration of a defensive trade mark in respect of all or any of the goods in respect of which it is registered, on the ground that the requirements of sub-section (1) of the last preceding section are no longer satisfied.

(2) Notice of an application to the High Court under this section (other than an application by the Registrar) shall be given to the Registrar, who may appear and be heard and shall appear if so directed by the High Court.

(3) An office copy of an order under this section shall be served on the Registrar, who shall, upon receipt of the order, take such steps as are necessary to give effect to the order.

(4) The powers conferred on the High Court by this section are in addition to the powers conferred by section twenty-two of this Act.

Cancellation by Registrar

95. — The Registrar may cancel the registration of a defensive trade mark where there is no longer a registration in the name of the registered proprietor of the defensive trade mark otherwise than as a defensive trade mark.

Rights given by registration

96. — Subject to this Act, the registration of a defensive trade mark in Part D of the Register, if valid, gives to the registered proprietor of the mark the right to obtain relief in respect of infringement of the mark in the manner provided by this Act.

Application of Act

97. — Subject to this Part, the provisions of this Act apply in relation to the registration of a trade mark as a defensive trade mark and to a trade mark registered as a defensive trade mark but it is not necessary for the registered proprietor of a defensive trade mark to prove use of the trade mark for the purpose of obtaining renewal of the registration.

PART XIII

Protection of Trade Marks

Forgery, etc., of trade marks

98. — (1) A person shall not —

- (a) forge a registered trade mark;
- (b) falsely apply a registered trade mark to goods;
- (c) make a die, block, machine or instrument for the purpose of forging, or of being used for forging, a registered trade mark; or
- (d) dispose of or have in his possession a die, block, machine or instrument for the purpose of forging, or of being used for forging, a registered trade mark.

Penalty: Imprisonment for three years.

(2) It is a defence in proceedings for an offence against the last preceding sub-section if the defendant proves that he acted without intent to defraud.

Selling, etc., goods with false marks

99. — (1) A person shall not sell or expose for sale, or have in his possession for sale or for the purpose of trade or manufacture, goods to which a forgery of a registered trade mark is applied or to which a registered trade mark is falsely applied.

Penalty: One hundred pounds.

(2) It is a defence in proceedings for an offence against the last preceding sub-section if the defendant proves that he acted without intent to defraud.

Importing goods with false marks

100. — A person shall not knowingly import into Australia goods to which a forgery of a registered trade mark is applied or to which a registered trade mark is falsely applied.

Penalty: One hundred pounds.

Forfeiture of articles, etc., on conviction

101. — A person convicted of an offence against any of the last three preceding sections is liable, in addition to the punishment provided by those sections, to forfeit to the Commonwealth all goods by means of which, or in relation to which, the offence was committed.

Aiding and abetting offences

102. — (1) A person shall not aid, abet, counsel or procure, or be in any way, directly or indirectly, knowingly concerned in or party to the commission of an act outside Australia which, if it were committed in Australia, would be an offence against this Act.

Penalty: One hundred pounds.

(2) The last preceding sub-section does not affect the operation of section five of the *Crimes Act* 1914-1955.

Prohibition of importation of goods bearing Australian trade marks

103. — (1) Goods manufactured outside Australia and having applied to them a trade mark, being, or being substantially identical with, a registered trade mark the registered proprietor or a registered user of which is a manufacturer, dealer or trader in Australia, are, if the registered proprietor or registered user notifies the Comptroller-General of Customs in writing that he objects to the importation of the goods, prohibited to be imported and, if imported, may be seized as forfeited to the Commonwealth.

(2) Subject to the regulations, the Comptroller-General of Customs, or on appeal from him the Minister of State for Trade and Customs, may, if in his opinion the contravention has not occurred either knowingly or negligently, permit goods which are liable to be or have been seized as forfeited under this section to be delivered to the owner or importer upon security being given to the satisfaction of the Comptroller-General—

- (a) that the improper marks will be effectually removed from the goods;
- (b) that such additions will be made as will render unobjectionable any mark applied to the goods; or
- (c) that the goods will be forthwith exported.

(3) The provisions of the *Customs Act* 1901-1954 apply to the seizure and forfeiture of goods under this section as if the goods were prohibited imports under that Act.

(4) Before taking action under this section or permitting an officer to take action under this section, the Comptroller-General of Customs may require the person requesting the action to give security in accordance with the regulations.

Power to require information in respect of imported goods bearing fraudulent marks

104. — (1) Where goods which are liable to forfeiture under the last preceding section are imported into Australia and the Comptroller-General of Customs is, upon representations made to him, satisfied that the use of the trade mark is fraudulent, an officer of Customs may require the importer of the goods, or his agent, to produce any documents in his possession relating to the goods and to furnish information as to the name and address of the person by whom the goods were consigned to Australia and the name and address of the person to whom the goods were sent in Australia.

(2) The importer or his agent shall, within fourteen days, comply with the requirement.

Penalty: One hundred pounds.

(3) Information obtained from the importer of the goods or his agent under this section, or from any other source, may be communicated by the Comptroller-General to the registered proprietor or registered user of the trade mark which is alleged to have been used or infringed.

Modification in relation to Territories

105. — The regulations may provide for the modification or adaptation of the provisions of the last two preceding sections in relation to a Territory of the Commonwealth to which the *Customs Act* 1901-1954 does not apply.

What deemed forgery of trade mark

106. — (1) A person shall be deemed to forge a registered trade mark—

- (a) if, without the assent of the registered proprietor of the trade mark or of a registered user of the trade mark, or the authority of this Act, he makes the trade mark or a mark substantially identical with it; or
- (b) if he falsifies a registered trade mark, whether by alteration, addition, effacement or otherwise.

(2) In a prosecution for forging a trade mark, the burden of proving the assent of the registered proprietor or registered user lies on the defendant.

When trade mark deemed applied

107. — (1) A trade mark shall be deemed to be applied to goods if it is woven in, impressed on, worked into, or annexed or affixed to, the goods.

(2) A trade mark shall be deemed to be applied to goods if—

- (a) it is applied to the goods themselves;
- (b) it is applied to a covering, label, reel or thing in or with which the goods are sold or exposed or had in possession for a purpose of trade or manufacture;
- (c) it is used in a manner likely to lead to the belief that it refers to or describes or designates the goods; or
- (d) it is used in a sign, advertisement, invoice, wine list, catalogue, business letter, business paper, price list or other commercial document and goods are delivered to a person in pursuance of a request or order made by reference to the trade mark as so used.

(3) For the purposes of this section, "covering" includes a stopper, glass, bottle, vessel, box, capsule, case, frame or wrapper, and "label" includes a band or ticket.

(4) A registered trade mark shall be deemed to be falsely applied to goods if, without the assent of the registered proprietor of the trade mark or of a registered user of the trade mark, or the authority of this Act, the trade mark or a mark substantially identical with it is applied to the goods.

(5) In a prosecution for falsely applying a registered trade mark to goods, the burden of proving the assent of the registered proprietor or a registered user lies on the defendant.

(To be continued)

ITALY

Decrees

concerning the Temporary Protection of Industrial Property Rights at Eight Exhibitions
(Of November 21, 1966)¹⁾

Single Article

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

Mercato internazionale della pelletteria MIPEL (Milan, January 21 to 25, 1967);

V° Salone internazionale del giocattolo (Milan, February 4 to 12, 1967);

VI° Salone nautico internazionale e VII° Salone internazionale rimorchio campeggio (Genova, February 4 to 14, 1967);

IV° Salone internazionale della macchine per movimenti di terra, da cantiere e per l'edilizia rurale SA.MO.TER (Verona, February 8 to 13, 1967);

XXIV° Salone-mercato internazionale dell'abbigliamento (Turin, February 17 to 20, 1967);

VIII° Mostra-convegno internazionale riscaldamento condizionamento refrigerazione idrosanitaria (Milan, March 1 to 7, 1967);

LXIX^a Fiera internazionale dell'agricoltura e della zootecnia (Verona, March 12 to 20, 1967)

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

¹⁾ Official communication from the Italian Administration.

²⁾ See *Prop. ind.*, 1939, p. 124; 1940, p. 84.

³⁾ *Ibid.*, 1940, p. 196.

⁴⁾ *Ibid.*, 1942, p. 168.

⁵⁾ *Ibid.*, 1960, p. 23.

GENERAL STUDIES

Report on the Patent System of the Commission Appointed by the President of the United States of America

(Summary)

On November 17, 1966, the U. S. President's Commission on the Patent System presented its Report. This Report contains a series of recommendations to reform the U. S. Patent Law, but it also deals with international patent law matters. In view of the importance of this Report, an attempt has been made to summarize the essential proposals contained therein, and to deal in greater length with the parts devoted to international collaboration.

I. Summary of Introduction

1. The Introduction to the Report first raises the question of the value of a patent system to-day. The members of the Commission unanimously agree that a patent system is capable of continuing to provide an incentive to research, development and innovation, and that there is no practical substitute for the unique service it renders. It provides an incentive to invent by offering the possibility of reward to the inventor, thus encouraging expenditure of time and money in research and development; it stimulates early public disclosure of technological information and promotes the international exchange of goods and information by protection of industrial property rights of foreigners.

2. The Report then outlines the following objectives of the Commission's study:

1. To raise the quality and reliability of the U. S. patent.
2. To shorten the period of pendency of a patent application from filing to final disposition by the Patent Office.
3. To accelerate the public disclosure of technological advances.
4. To reduce the expense of obtaining and litigating a patent.
5. To make U. S. patent practice more compatible with that of other major countries, wherever consistent with the objectives of the U. S. patent system.
6. To prepare the patent system to cope with the exploding technology foreseeable in the decades ahead.

To reach these aims, the Commission proposes a series of changes described below, all as part of one interrelated and coherent plan.

II. Summary of Recommendations

Patentability of Inventions

1. *Recommendation I* relates to the concept of novelty: "Prior art shall comprise any information, known to the public, or made available to the public by means

of disclosure in tangible form or by use or placing on sale, anywhere in the world, prior to the effective filing date of the application.

"A disclosure in a U. S. patent or published complete application shall constitute prior art as of its effective (U. S. or foreign) filing date."

This Recommendation entails significant changes:

- (a) when two or more persons separately apply for a patent on the same invention, the patent would issue to the one who is first to file his application;
- (b) there would be no grace period;
- (c) foreign knowledge, use and sale would be included as prior art;
- (d) there would be revised criteria for the form of prior art.

The respective dates of "conception" and "reduction to practice" of the invention would no longer be relevant; interference proceedings would be abolished. This would bring U. S. practice into harmony with that prevailing in almost all other industrial nations. The proposed definition of prior art is a step towards conformity with European patent laws. Availability to the public in a tangible form means that oral disclosures would not constitute prior art.

2. *Recommendation II* proposes a preliminary application as a substitute for the advantages of the grace period, the abolition of which is suggested:

"A preliminary application may be used to secure a filing date for all features of an invention disclosed therein, if the disclosure subsequently appears in a complete application. Requirements as to form shall be minimal and claims need not be included.

"One or more preliminary applications may be consolidated into one complete application filed within twelve months of the earliest preliminary or foreign application relied on."

The preliminary application would only consist of a written description of the invention permitting filing by somebody having little knowledge of patent law. An application complying with present formal requirements must be filed within 12 months of the earliest preliminary application relied on.

3. *Recommendation III* deals with exhibition and unauthorized public disclosure as exceptions to the rule of prior art:

"Prior art shall not include, as to the inventor concerned, disclosures of an invention resulting from:

- 1. a display in an official or officially recognized international exhibition, or
- 2. an unauthorized public divulcation of information derived from the inventor,"

under certain conditions specified in the Report.

If the proposed preliminary application should not comply with Article 11 of the Paris Convention, the Report suggests a notice, filed with the Patent Office not later than the public opening of the display, containing the information disclosed by the display and followed by a complete application within

6 months. To be excluded from prior art, unauthorized public disclosure must be followed by a complete application within 6 months. This application, however, would not receive the benefit of the priority of the date of unauthorized disclosure. Rather, any intervening disclosure occurring between the date of the unauthorized public disclosure and the application filing date would constitute prior art.

4. *Recommendation IV* relates to patentable subject-matter:

"The classes of patentable subject matter shall continue as at present, except:

- 1. All provisions in the Patent Statute for design patents shall be deleted, and another form of protection provided.
- 2. All provisions in the Patent Statute for plant patents shall be deleted, and another form of protection provided.
- 3. A series of instructions which control or condition the operation of a data processing machine, generally referred to as a 'program,' shall not be considered patentable regardless of whether the program is claimed as: (a) an article, (b) a process described in terms of the operations performed by a machine pursuant to a program, or (c) one or more machine configurations established by a program."

The Commission believes that all inventions should meet the statutory provisions for novelty, utility and obviousness. The above-mentioned subjects generally do not fulfil these requirements. Other means of protection have to be found.

5. *Recommendation V* relates to the right of either the inventor or the assignee to file and sign the applications:

"1. Either the inventor or assignee may file and sign both the preliminary and complete applications.

Any application filed by the assignee shall include a declaration of ownership at the time of filing and, prior to publication of the application, shall include a declaration of originality by the inventor and evidence of a recorded specific assignment.

- 2. Every application shall include, at the time of filing, the name of each person believed to have made an inventive contribution.
- 3. Omission of an inventor's name or inclusion of the name of a person not an inventor, without deceptive intent, shall not affect validity, and can be corrected at any time."

The intent of this Recommendation is to simplify the formalities for filing an application by permitting the owner of the patent rights to sign and file the necessary papers. Furthermore, the Recommendation tends to simplify the initial determination of who should be named as inventors in a given application and to facilitate later correction of applications and patents.

6. *Recommendation VI* relates to the time for claiming the priority right:

“Claim for priority date must be made when a complete application is filed.”

Early knowledge of the priority date becomes more important with the adoption of a first to file system. Therefore, it is recommended to discontinue the present practice allowing a claim for priority to be delayed until the final fee is paid.

7. *Recommendation VII* proposes a system of early publication of the application:

“Publication of a pending application shall occur eighteen to twenty-four months after its earliest effective filing date, or promptly after allowance or appeal, whichever comes first.

“An applicant, for any reason, may request earlier publication of his pending complete application.

“An application shall be ‘republished’ promptly after allowance or appeal subsequent to initial publication, and again upon issuance as a patent, to the extent needed to update the initially published application and give notice of its status.”

The Report stresses the advantages of an early publication system which could prevent needless duplication of work, promote additional technological advances based on the information disclosed and apprise entrepreneurs of their potential liability. The republication in case of amendments to claims or specification after the first publication could consist merely of a notice published in the *Official Gazette* with copies of the allowed claims prepared and made available to the public.

8. *Recommendation VIII* is intended to prevent the repetitive filing of dependent applications:

“Unless a later filed application is:

1. a continuation application and is filed before the occurrence of any of the following events: (a) the abandonment of, (b) the allowance of all pending claims in, or (c) the filing of an appeal to the Board of Appeals as to any claim in, the original parent application; or
2. a continuation-in-part application and is filed before the publication of any of its parent applications; or
3. a divisional application filed (a) on one of the inventions indicated to be divisible in a restriction requirement and is filed during the pendency of the application in which the restriction was first required, or (b) during the pendency of the original parent application;

the later filed application shall not be entitled to the effective filing date of a parent application for matter disclosed in the parent, and the parent, if published, shall constitute prior art against the later filed application.”

This proposal shall eliminate undue postponement of the publication of the scope of protection granted, bring the United States into accord with international practice, and permit more efficient Patent Office examination. It shall re-

place the present practice allowing the applicant to serially file continuing applications for an unlimited period of time and maintain his invention in secrecy.

Exceptions are only provided for the filing of a continuation application during a certain time of the pendency of the original parent application, for the filing of a continuation-in-part application before publication of the parent application and for the filing of divisional applications during the pendency of the original parent application.

9. *Recommendation IX* relates to deferred examination:

“Statutory authority should be provided for optional deferred examination.

“An optional deferred examination system shall include the following provisions:

1. The examination shall be deferred at the option of the applicant, exercised by his election not to accompany the complete application with an examination fee.

Request for examination, accompanied by payment of an examination fee, may be made anytime within five years from the effective filing date of the application.

2. A deferred application shall be promptly inspected for formal matters and then published.
3. Any party, without being required to disclose his identity, may provoke an examination upon request and payment of the fee.
4. Unless made special upon the request of any party, an application initially deferred shall be inserted in the queue of applications set for examination in an order based on the date of payment of the examination fee.
5. Examination of pending parent or continuing applications shall not be deferred beyond the time when examination is requested of any of the parent or continuing applications.”

The Report indicates that the Commission clearly favours a high quality immediate examination system if it can be maintained without a constantly increasing backlog. Nevertheless the Commission makes the unanimous suggestion to provide for statutory authority to introduce a deferred examination system if deemed necessary.

However, the view of the Commission as to when and how deferred examination shall be introduced is split. One view favours optional deferred examination going into effect, on a pilot basis, as soon as appropriate legislation can be enacted. This could apply to applications filed within a given period of time or concerned with some given subject-matter. The other view favours the institution of optional deferred examination only if the Statutory Advisory Council (*Recommendation XXVI*) should find that a high quality immediate examination system no longer could be maintained.

The Report justifies optional deferred examination mainly with the argument that it is not good economic practice for the Patent Office to devote substantial effort to applications having little value. The proposed system should reduce the number of applications requiring prompt examination. The

five-year period is supposed to balance the interests of the public, the applicants and the Patent Office. No prior art search shall be made before a full examination is requested since otherwise, according to the Report, the saving of examiners' time would be minimal.

10. *Recommendation X* tends to definitely exclude a practice whereby the examiner shall resolve all reasonable doubts in favour of the applicant:

"The applicant shall have the burden of persuading the Patent Office that a claim is patentable."

The principle of resolving doubt in favour of the applicant is inconsistent with the desire to give a patent a strong presumption of validity. Since doubts which may exist are not indicated in the patent, all patents may be questioned. The elimination of doubt as an element favouring patentability should raise the overall standards of patentability.

11. *Recommendation XI* proposes a citation period after publication of the application in which the public could submit publications for *ex parte* consideration by the Patent Office:

"The Patent Office shall consider all patents or publications, the pertinency of which is explained in writing, cited against an application anytime until six months after the publication which gives notice that the application has been allowed or appealed to the Board of Appeals. If the Patent Office, after the citation period, determines that a claim should not be, or have been, allowed, the applicant shall be notified and given an opportunity *ex parte* both to rebut the determination and to narrow the scope of the claim. The identity of the party citing references shall be maintained in confidence.

"Public use proceedings, as at present, may be instituted during the citation period."

Both the applicant and the public could benefit from such procedure since patents would become more reliable as to their validity. The applicant has an opportunity to narrow his claim before he gets into litigation. The public has an opportunity to cite prior art to the Patent Office in a way which is inexpensive and does not reveal the identity of the party citing references.

12. *Recommendation XII* envisages the establishment of an objective technique for measuring the quality of the examiner's work:

"The Patent Office shall develop and maintain an effective control program to evaluate, on a continuing basis, the quality of the patents being issued by the examining groups and art units therein, and to furnish information for the publication of an annual rating of the overall quality of the patents issued each year."

The Recommendation tends to encourage and expand the present efforts of the Patent Office to put a quality control program into operation. Such a system should permit an effective quality measurement of the patents being issued by each of the examining groups and art units.

Direct Review of Patent Office Decisions

13. *Recommendation XIII* tends to give more weight to Patent Office decisions:

"A Patent Office decision refusing a claim shall be given a presumption of correctness, and shall not be reversed unless clearly erroneous."

Currently the weight given on appeal to a Patent Office decision denying a patent seems to depend upon which Court reviews the decision. The Recommendation is intended to settle the conflict over "scope of review" by defining the Courts' responsibility to review the Patent Office decision rather than substitute its own judgement.

14. *Recommendation XIV* proposes a single Court of general jurisdiction as final reviewing authority:

"Either the applicant or the Patent Office may appeal from a decision of the Court of Customs and Patent Appeals to the United States Court of Appeals for the District of Columbia Circuit, and from a decision of the latter Court either may petition the Supreme Court for a writ of certiorari."

The reason for this proposal is that at present the applicant may seek review by two alternative routes from a decision by the Board of Appeals of the Patent Office, namely, either to the Court of Customs and Patent Appeals or to the United States District Court for the District of Columbia. This had led to conflicting decisions and "to a notorious difference between the standards applied by the Patent Office and by the Courts" (Supreme Court in *re Graham v. John Deere Co.*). The proposed solution should lead to decisions wherein interpretation and application of substantive law are more akin to that in infringement suits.

Procedure for Amending and Cancelling Patents

15. *Recommendation XV* provides an *ex parte* administrative procedure in the Patent Office for cancellation of claims:

"The Patent Office, upon receipt of a relatively high fee, shall consider prior art of which it is apprised by a third party, when such prior art is cited and its pertinency explained in writing within a three-year period after issuance of the patent. If the Patent Office then determines that a claim should not have been allowed, the patent owner shall be notified and given an opportunity *ex parte* both to rebut the determination and to narrow the scope of the claim. Failure to seek review, or the affirmance of the Patent Office holding, shall result in cancellation of the claim.

"When the validity of a claim is in issue before both the Patent Office and a Court, the Tribunal where the issue was first presented shall proceed while the other shall suspend consideration, unless the Court decides otherwise for good cause.

"Anyone unsuccessfully seeking Patent Office cancellation of claims shall be required to pay the patent owner's reasonable cost of defending such claims, including attorney's fees. The Commissioner shall require

an appropriate deposit or bond for this purpose at the start of the action.”

Presently there is no provision for the Patent Office administratively to cancel any claim in an issued patent. This has led to a situation where the patent owner can continue to assert even clearly unpatentable claims because no one is willing or able to obtain a costly Court decision. The proposed solution will be faster and less costly than Court proceedings.

16. *Recommendation XVI* tends to somewhat limit the present practice of broadening the scope of the invention during procedure before the Patent Office:

“A claim shall not be broadened in a reissue application.”

The Commission thinks it generally desirable that claims should never be broadened after publication, whether presented in the published application or a related continuing or reissue application. The Report comes to the conclusion that an all-inclusive prohibition to this effect might be impossible to enforce. Therefore the Recommendation is limited to reissue applications where broadening of claims can be prohibited effectively.

Liability and Enforcement

17. *Recommendation XVII* proposes a protection for the patent owner for the period from publication to grant of the patent:

“For infringement of a claim which appears in both an application as initially published and in the issued patent, damages may be obtained for an interim period prior to issuance. Such period shall be measured from after the occurrence of all of the following events: (1) the initial publication, (2) a Patent Office holding that the claim is allowable, and (3) a transmittal to the alleged infringer of actual notice reasonably indicating how his particular acts are considered to infringe the claim.

“The applicant’s election to create such interim liability, by his transmittal of notice, shall constitute the granting of a reasonable royalty, nonexclusive license, (1) extending only until the issuance of the patent for any infringement involving a process, and (2) extending to and beyond issuance for any infringement involving a machine, manufacture or composition of matter, which is made prior to the issuance of the patent.

“In exceptional cases, damages for interim infringement up to treble reasonable royalties may be assessed.”

Since the Commission proposes a system of early publication of the application (*Recommendation VII*) that Recommendation has to be supplemented by some sort of protection to prevent a free use of the invention after publication possibly exhausting its commercial value. The protection recommended is limited in several respects. It can only be based on claims appearing both in the published application and in the patent granted. Suit can therefore not be brought before issuance of the patent. The protection normally only gives the right to recover a reasonable royalty for infringing acts occur-

ring prior to grant. This system of protection should not only encourage applicants to present claims they consider patentable, but also reduce the uncertainty of the competitor as to possible interim liability.

18. *Recommendation XVIII* relates to the term of the patent:

“The term of patent shall expire twenty years after its earliest effective U. S. filing date.”

The term of a U. S. patent is at present 17 years from the date of issuance. This system encourages deliberate delays in the prosecution of applications and the use of continuing applications for the purpose of delay. Measuring the patent term from the earliest domestic filing date will not only avoid these disadvantages but also bring U. S. practice into closer conformity with most foreign systems.

19. *Recommendation XIX* proposes to extend the term of a patent in case of a secrecy order:

“The term of a patent, whose issuance has been delayed by reason of the application being placed under secrecy order, shall be extended for a period equal to the delay in issuance of the patent after notice of allowability.”

At present, compensation for damages caused by a secrecy order issued for a patent application is determined by taking into account that under the present system the applicant will have the benefits of a full patent term as soon as the secrecy order is lifted and a patent granted. Since these benefits, according to the Commission, should be retained under the new system to measure the patent term, an appropriate extension of the term of patent is suggested.

20. *Recommendation XX* tends to exclude double patenting, even in the case of a terminal disclaimer:

“The filing of a terminal disclaimer shall have no effect in overcoming a holding of double patenting.”

The Commission supports the position that the granting of more than one patent on a single invention would constitute an undue extension of monopoly. A terminal disclaimer whereby the owner of a younger patent renounces the term of his patent in so far as it exceeds the term of a conflicting older patent would prevent the extension of monopoly in time but it would not preclude the undue extension of monopoly in scope. Therefore it is proposed to exclude the possibility of avoiding the consequences of double patenting by filing a terminal disclaimer.

21. *Recommendation XXI* relates to the importation of a product made abroad by a process patented in the United States:

“The importation into the United States of a product made abroad by a process patented in the United States shall constitute an act of infringement.”

Unauthorized importation of such a product does not now constitute infringement. The Recommendation tends to exclude the possibility to go around the process patent owner’s rights by working his process abroad and importing the product.

22. *Recommendation XXII* tries to clarify the relationship between the patent system and anti-trust laws:

“The licensable nature of the rights granted by a patent should be clarified by specifically stating in the Patent Statute that: (1) applications for patents, patents, or any interests therein may be licensed in the whole, or in any specified part of, the field of use to which the subject matter of the claims of the patent are directly applicable, and (2) a patent owner shall not be deemed guilty of patent misuse merely because he agreed to a contractual provision or imposed a condition on a licensee, which has (a) a direct relation to the disclosure and claims of the patent, and (b) the performance of which is reasonable under the circumstances to secure to the patent owner the full benefit of his invention and patent grant. This Recommendation is intended to make clear that the ‘Rule of reason’ shall constitute the guideline for determining patent misuse.”

The Commission thinks that the patent system and the anti-trust laws are not mutually exclusive but on the contrary fully compatible, one checking and preventing undesirable monopolistic power and the other encouraging and promoting certain limited beneficial monopolies. The Commission does not favour any proposal which would curtail the power of the Courts to deny relief to a patent owner misusing his patent. However, uncertainty exists as to the precise nature of the patent right and the definition of the patent misuse rule. The Commission believes that a statutory definition of the nature of the patent right is required, defining it as a right to exclude others from making, using and selling the patented invention. The mere exercise, conveyance or license of these rights should not in itself constitute misuse of the patent. A patent owner should not be denied relief against infringers because he either refused to grant a license or because he has exercised, transferred or licensed any of the conferred patent rights himself. However a number of conditions usually associated with the transfer of licenses, such as improvement grant-backs, patent pools, no contest clauses and others should not be immunized from anti-trust laws or the application of the misuse rule since they do not fall under the exclusive right conferred by the patent. The Report states clearly that a patent may not be used to control commerce in subject-matter beyond the scope of the patent.

23. *Recommendation XXIII* advocates effect *erga omnes* for final Federal Court decisions invalidating a patent or part of its claims:

“A final federal judicial determination declaring a patent claim invalid shall be *in rem*, and the cancellation of such claim shall be indicated on all patent copies subsequently distributed by the Patent Office.”

Under the present law, even though one or more claims of a patent have been held invalid by a Federal Court, the patentee may still pursue a different defendant for infringement of the same claims. However, a patentee having been afforded the opportunity to exhaust his remedy of appeal from a hold-

ing of invalidity “has had his day in Court,” and should not be allowed to harass others on the basis of an invalid claim. Therefore it is proposed to treat a claim, once held invalid, as cancelled from the patent.

24. *Recommendation XXIV* deals with the high cost of patent litigation:

“Offices of ‘Civil Commissioner’ shall be created in those U. S. District Courts where justified by the volume of patent litigation. In patent cases, unless otherwise ordered by a District Court judge for good cause, a Commissioner shall conduct pretrial hearings, preside at depositions of parties, supervise discovery proceedings upon an accelerated and abbreviated basis, make preliminary rulings upon the admissibility of proofs, and be empowered to vary the burdens of proof for good cause in secrecy cases.”

The high cost of patent litigation results in good and valid patents being defied and going unenforced, in invalid patents being kept from Court scrutiny and in compromises only justified by the avoidance of enormous litigation expenses. Adoption of the Recommendation should considerably reduce the time and expenses to litigants in patent cases.

25. *Recommendation XXV* is also concerned with the problem of expensive litigation.

“A party to a patent case seeking to reduce his litigation costs, with the consent of the adverse party, may submit his case to the Court on a stipulation of facts or on affidavits without the usual pretrial discovery. This procedure may be used where no injunctive relief is asked and only limited damages are sought. Incentives shall be provided to consent to this procedure, as set forth below.”

The Commission believes that a truly just patent system should provide all patentees with a fair opportunity for ‘a day in Court.’ All alleged infringers should also have an opportunity to test judicially the validity and scope of patents asserted against them. The expedited procedure recommended should remedy on this situation. To induce the alleged infringer to consent to this procedure, a subsequent judgment under this procedure should omit any injunctive relief and should be confined to reasonable licenses for past and future infringement.

Statutory Advisory Council

26. *Recommendation XXVI* advocates the institution of a standing advisory body to the Secretary of Commerce composed of members representing the principal areas served by the patent system:

“A Statutory Advisory Council, comprised of public members selected to represent the principal areas served by the patent system, and appointed by the Secretary of Commerce, shall be established to advise him, on a continuing basis, of its evaluation of the current health of the Patent system, and specifically, of the quality of patents being issued and the effectiveness of any internal patent quality control program then in

operation, and whether an optional deferred examination system should be instituted or terminated.

“Every fourth year the Council shall publish a report on the condition of the patent system including recommendations for its improvement.

“The membership shall consist of not less than twelve nor more than twenty-four. The term of appointment shall be four years, with a maximum tenure of eight years. An Executive Director, and other support as deemed necessary, shall be provided.”

The evaluation of the patent system in a time of rapid development cannot be left entirely to those preoccupied with its daily administration, or to examination by a once-in-a-generation Commission. The patent system needs continuous review in the light of the nation's changing needs and the capacity of the system to respond to these needs.

Patent Office Operations

27. *Recommendation XXVII* deals with adequate staffing, housing and financing of the Patent Office:

“The Patent Office should be supported adequately to insure first-class staffing, housing and equipment, and

“Patent Office financing should be established on the following basis:

1. The Patent Office should not be required to be entirely self-sustaining.
2. The Commissioner of patents should be authorized to set fees for Patent Office services within broad guidelines established by Congress. Such fees shall be apportioned in accordance with the cost of providing the services.
3. The Patent Office should be authorized to establish a ‘revolving fund’ of all its receipts to support its operation.”

The primary requirement for optimum Patent Office operation is a dedicated corps of career employees possessing a unique combination of scientific and engineering knowledge and the ability to make sound legal judgments. To recruit and retain such personnel in a competitive man-power market requires an increasing expenditure and a working environment conducive to intellectual output. The best available equipment must be provided for obtaining, storing and retrieving pertinent prior art.

The substantial fee increase necessary to recover one hundred percent of Patent Office operating expenses could reduce inventive activity. Limited subsidization of the Patent Office has substantial justification. The economic advantages of the patent system more than justify the relatively small expenditure of tax funds required. However, the present form of Patent Office fee legislation periodically enacted by Congress is not sufficiently flexible. Therefore authorization for the Commissioner of Patents is recommended to set fees for types of services and change them as conditions may demand. This would provide a more equitable fee structure directly related to the cost of particular services and permit recovery of any desired percentage of expenses. Instead of turning all fees promptly over to the treasury, as under the present system,

the Report proposes a recovering fund in the Patent Office consisting of the fees paid. Congressional appropriations could supplement this fund as necessary.

28. *Recommendation XXVIII* tends to give the applicant a fair opportunity to reshape his claims to meet new rejections of the Patent Office:

“The applicant should be permitted to amend his case following any new ground of objection or rejection by the Patent Office, except where the new ground of objection or rejection is necessitated by amendment of the application by the applicant.”

The desirable goal of reducing the backlog of patent applications reasonably should be balanced with the opportunity for an inventor to obtain a valid patent of proper scope. The Recommendation seeks to reconcile the interest of the applicant with the aim to avoid prolonged pendency caused by successive amendments which shift the subject-matter area claimed.

29. *Recommendation XXIX* deals with an international classification system and a rapid and effective retrieval of information including a fully mechanized search system:

“A study group comprising members from industry, technical societies and Government should be established to make a comprehensive study of the application of new technology to Patent Office operations and to aid in developing and implementing the specific recommendations which follow.

1. The United States, with other interested countries, should strive toward the establishment of a unified system of patent classification which would expedite and improve its retrieval of prior art.

The United States should expand its present reclassification efforts.

2. The Patent Office should be encouraged and given resources to continue, and to intensify, its efforts toward the goal of a fully mechanized search system.
3. The Patent Office should acquire and store machine-readable scientific and technical information as it becomes available.

The Patent Office should encourage voluntary submission by patent applicants of copies of their applications in machine-readable form.

4. The Patent Office should investigate the desirability of obtaining the services of outside technical organizations for specific, short-term classification and mechanized search projects.”

(a) Until the advent of fully automated searching, when all prior art can be retrieved readily, a classification system will continue to be one of the important tools for conducting a prior art search. The present diversity among national patent laws and classification systems results in a substantial amount of duplicative effort in examining applications on the same invention filed in more than one country. A common classification system would move the world closer to the desired international patent, if principles of patentability are similar (*Recommendation No. XXXV*), since each country would know

what segment of prior art was previously searched by another patent office on a application for the same invention filed in that country. Moreover, it would insure that specialized data banks would be more complete by providing common guidelines as to what information should be included in each of these data banks.

(b) As the amount of scientific and technical information continues to grow at a pace which makes the information unmanageable manually, mechanization appears to be the only solution to obtaining reliable, quality searches of prior art. Hence, it is imperative to utilize fully the existing techniques of mechanized searching and to study new ones as they become available.

(c) Obtaining as much information as possible in the form of perforated or magnetic tape, or the like, would permit continuous build-up of a data bank suitable for automated searching, thus avoiding the future necessity of transcribing huge amounts of printed information into computer usable form.

(d) Use of experience of outside organizations specializing in mechanized information retrieval technologies could serve as an economical means for solving problems which otherwise would require very expensive proper experimentation.

30. *Recommendation XXX* relates to microform reproduction of search files and the plan for a world patent index studied by BIRPI:

“The Patent Office should:

1. proceed vigorously with the implementing of its plan for microform reproduction of all search files; and
2. cooperate with foreign national patent offices and international patent organizations to develop a worldwide index of patents and published applications for patents.”

1. The Commission recognizes that any visual microform system is intended only as a bridge between the present methods of information storage and retrieval, and future fully automated mechanized search systems (*Recommendation No. XXIX*). Meanwhile, however, there is the possibility of storing great amounts of information on small quantities of film or cards, which can be readily inspected with semi-automatic reading devices. This not only increases the capability of the searcher to scan more material in a given time but also makes economically feasible the placing of complete copies of classified search files in locales outside the Patent Office. This would permit establishment of satellite public search facilities throughout the United States, resulting in greatly improved dissemination of the technological and legal information contained in patents.

2. On an average, patents now are granted in three different countries for each invention, and an average of 650,000 patent applications are filed each year in eighty different patent offices. These figures lend substantial weight to the desirability of a worldwide patent index. Such an index would provide prompt and reliable means for obtaining information relative to the existence and status of particular patents or applications in any country in the world.

Transition

31. *Recommendation XXXI* advocates a solution by which the appropriate time to implement the statutory changes proposed by the Commission most effectively is determined according to the circumstances of the case:

“The legislation implementing the proposed recommendations of the Commission should become effective as soon as practical with regard to both patents and pending applications.”

Government Patent Policy

32. Under *XXXII* the Commission refrains from a recommendation concerning the question of the distribution of rights in inventions resulting from research and development work financed wholly or in part by the Government. It notes, however, the increasing participation of the Federal Government in the financing of research, development, testing and engineering, and the many problems related to the ownership of patents resulting from such work. The Commission hopes that any action Congress may take in this regard will promote the purposes of the patent system to encourage invention and innovation and the resulting economic development and benefits.

International Action

33. *Recommendation XXXIII* urges favourable position by the United States as to the inclusion of inventors' certificates in the Paris Convention:

“The United States should take a position in favor of the proposed revision of the Paris Convention whereby a right of priority may be based on an application for an inventor's certificate.”

Some member countries of the Paris Convention, in particular the USSR and some Eastern European countries, issue inventors' certificates as well as patents. While some Convention countries voluntarily recognize inventors' certificates for priority purposes, there is no obligation under the Convention to do so. At present, the U. S. patent statute prevents the recognition for priority purposes of anything but an application for patent in another Convention country.

The proposal for revision is on the agenda of the Stockholm Conference, which is to be held in 1967. According to the proposal, the date of an application for an inventor's certificate in one Convention country would be recognized for priority purposes in all Convention countries. It is noted that the proposed revision is limited to inventors' certificates from countries in which inventors have the right to apply for either a patent or an inventor's certificate.

34. *Recommendation XXXIV* concerns calculation of the term of patent from a foreign filing date:

“Efforts should be made to have the Paris Convention modified to remove any obstacle to measuring the term of a patent from an effective foreign filing date.”

The present text of the Paris Convention requires that “Patents obtained with the benefit of priority shall have in the various countries of the Union a duration equal to that

which they would have had if they had been applied for or granted without the benefit of priority.”

Since the Convention forbids calculation of the term of a patent from the foreign filing date, it prevents measurement of the term from the effective filing date when foreign priority is claimed. Thus a foreign applicant who can claim a foreign priority date would receive a longer period of protection than an applicant who filed a domestic application on such date. Of course, a corresponding advantage is accorded to U. S. inventors filing abroad.

Movement toward a universal patent system (Recommendation No. XXXV) would be promoted if an entire international family of related patents expired at the same time. This requires a common measuring point for the patent term. The effective (foreign or domestic) filing date, unlike the earliest domestic filing date, would constitute such a common measuring point.

35. *Recommendation XXXV* relates to international collaboration in the patent field:

“The Commission believes that the ultimate goal in the protection of inventions should be the establishment of a universal patent, respected throughout the world, issued in the light of, and inventive over, all of the prior art of the world, and obtained quickly and inexpensively on a single application, but only in return for a genuine contribution to the progress of the useful arts.

“To this end the Commission specifically recommends the pursuit of: (1) international harmonization of patent practice, (2) the formation of regional patent system groups, and (3) a universal network of mechanized information storage and retrieval systems.”

There are great differences today among the patent systems of the various countries. The inventor who desires worldwide or even multi-national patent protection for his discovery must file a multitude of applications, each governed by a separate and distinct system of laws, rules, regulations and procedures.

Even after the patent has been obtained, the inventor is confronted with diverse systems of maintaining patent protection.

These factors increase the cost of securing multi-national patent protection and often cloud the status of an invention in a particular country, thus discouraging foreign investment and marketing.

If change is to be achieved, nations must adopt a single set of long-range goals to guide their intermediate and short-range movements. Any attempt by revolutionary change, to scrap present systems in favor of new ones, in the United States or abroad, is neither feasible nor desirable. It is, however, both possible and advantageous to promote and direct interim steps toward the ultimate goal — a universal patent.

To the extent that harmonization of U. S. practice with prevailing foreign practice can be attained without injury to the quality of the U. S. patent system, such harmonization should be introduced as a first step toward the desired goal. This consideration applies both to the substantive law and to the forms and procedures for implementing it. Other recommendations in this report are responsive to this general objective.

Where, however, U. S. practice appears to be the superior one, it is recommended that appropriate Federal agencies make efforts to secure harmonization compatible with U. S. practice.

As an intermediate step toward attainment of a universal patent, the formation of regional patent system groupings should be encouraged. Within such groupings there will inevitably develop a mutual respect for the search and judgment capabilities of the members. This should lead to cooperative searching and, beyond that, to mutually recognized patents among the members of the group. The avoidance of the duplication of effort, expense and delay is a clearly attainable benefit from such a development.

Finally, as an adjunct to achieving the ultimate goal of a universal patent, the Commission envisages the establishment of a universal network of mechanized information storage and retrieval systems involving all of the patents and other technical literature of the world.

CALENDAR

Meetings of BIRPI

Date and Place	Title	Object	Invitations to Participate	Observers Invited
March 14 to 17, 1967 Geneva	Extraordinary Session of the Permanent Committee of the Berne Union	Consideration of various questions concerning copyright	Belgium, Brazil, Denmark, France, Germany (Fed. Rep.), India, Italy, Portugal, Rumania, Spain, Sweden, Switzerland, United Kingdom of Great Britain and Northern Ireland	All other Member States of the Berne Union; United Nations; International Labour Office; Unesco; Council of Europe; Unidroit
April 10 to 12, 1967 Geneva (Headquarters of ILO)	First meeting of the Intergovernmental Committee (Neighbouring Rights). Meeting convened jointly with ILO and Unesco	Adoption of the rules of procedure; election of officers; various questions	Congo (Brazzaville), Czechoslovakia, Ecuador, Mexico, Sweden, United Kingdom of Great Britain and Northern Ireland	
April 18 to 21, 1967 Geneva	Committee of Experts for the Classification of Goods and Services	To bring up to date the international classification	All Member States of the Nice Union	—
June 12 to July 14, 1967 Stockholm	Intellectual Property Conference of Stockholm, 1967	<p>(a) General Revision of the Berne Convention (Copyright)</p> <p>(b) Revision of the Paris Convention (Industrial Property) on the question of inventors' certificates</p> <p>(c) Revision of the administrative and final clauses of the Berne and Paris Conventions and of the Special Agreements concluded under the latter</p> <p>(d) Establishment of a new Organization</p>	<p>For (a), (b) and (c): Member States of the various Unions</p> <p>For (d): States Members of the United Nations or any of the UN Specialized Agencies</p>	<p>States: States not members of the Unions [for (a), (b) and (c)]</p> <p><i>Intergovernmental Organizations:</i> United Nations; International Labour Organization; World Health Organization; United Nations Educational, Scientific and Cultural Organization; General Agreement of Tariffs and Trade; International Institute for the Unification of Private Law; International Olive Oil Council; International Patent Institute; International Vine and Wine Office; African and Malagasy Industrial Property Office; Council of Europe; Latin-American Free Trade Association; Organization of American States</p> <p><i>Interested Non-Governmental Organizations</i></p>
December 12 to 15, 1967 Geneva	Thirteenth Ordinary Session of the Permanent Committee of the Berne Union	Consideration of various questions concerning copyright	Belgium, Brazil, Denmark, France, Germany (Fed. Rep.), India, Italy, Portugal, Rumania, Spain, Switzerland, United Kingdom of Great Britain and Northern Ireland	All other Member States of the Berne Union; interested international inter-governmental and non-governmental organizations
December 18 to 21, 1967 Geneva	Interunion Coordination Committee (5 th Session)	Program and Budget of BIRPI	Belgium, Brazil, Ceylon, Czechoslovakia, Denmark, France, Germany (Fed. Rep.), Hungary, India, Italy, Japan, Mexico, Morocco, Netherlands, Nigeria, Portugal, Rumania, Spain, Sweden, Switzerland, Union of Soviet Socialist Republics, United Kingdom of Great Britain and Northern Ireland, United States of America, Yugoslavia	All other Member States of the Paris Union or of the Berne Union
December 18 to 21, 1967 Geneva	Conference of Representatives of the International Union for the Protection of Industrial Property (2 nd Session)	Program and Budget for the next three-year period	All Member States of the Paris Union	—

Date and Place	Title	Object	Invitations to Participate	Observers Invited
December 18 to 21, 1967 Geneva	Executive Committee of the Conference of Representatives of the Paris Union (3rd Session)	Program and Budget (Paris Union)	Ceylon, Czechoslovakia, France, Germany (Fed. Rep.), Hungary, Italy, Japan, Mexico, Morocco, Netherlands, Nigeria, Portugal, Spain, Sweden, Switzerland, Union of Soviet Socialist Republics, United Kingdom of Great Britain and Northern Ireland, United States of America, Yugoslavia	All other Member States of the Paris Union
December 18 to 21, 1967 Geneva	Council of the Lisbon Union for the Protection of Appellations of Origin and their International Registration	Annual Meeting	All Member States of the Lisbon Union	All other Member States of the Paris Union

Meetings of Other International Organizations concerned with Intellectual Property

Place	Date	Organization	Title
Paris	February 17, 1967	International Literary and Artistic Association (ALAI)	Ordinary General Assembly
Strasbourg	March 13 to 17, 1967, and April 3 to 7, 1967	Council of Europe	Working Group of the Committee of Experts on Patents
Basle	March 29 to April 4, 1967	International Literary and Artistic Association (ALAI)	52nd Congress
Montreal	May 13 to 20, 1967	International Chamber of Commerce (ICC)	21st Congress
Helsinki	from August 27, 1967	International Association for the Protection of Industrial Property (IAPIP)	Executive Committee
Stockholm	September 18 to 29, 1967	Committee for International Cooperation in Information Retrieval among Examining Patent Offices (ICIREPAT)	7th Annual Meeting