

Industrial Property

Monthly Review of the International Bureau
for the Protection of Industrial Property
Geneva

1st Year

No. 6

June 1962

Contents

| | Pages |
|---|-------|
| INTERNATIONAL UNION | |
| Belgium. Ratification of the Arrangement of Madrid (Trade Marks). Text of Nice (7 th June, 1962) | 142 |
| Hungary. Adhesion to the London texts of the Convention of Paris, the Arrangement of Madrid (False Indications of Source) and the Arrangement of Madrid (Trade Marks) (14 th June, 1962) | 142 |
| First Meeting of the Committee of Experts of the Arrangement of Nice (Geneva, 7 th -11 th May, 1962) | 142 |
| Meeting of the Working Group of the Permanent Bureau of the Paris Union . . . | 143 |
| LEGISLATION | |
| Australia. Patents Act 1952-1960 (Part two) | 144 |
| CORRESPONDENCE | |
| Letter from Belgium (Antoine Braun) | 150 |
| CONGRESSES AND MEETINGS | |
| International Typographic Association. Resolution adopted at Verona, 22 nd May, 1962 | 160 |
| BOOK REVIEW | |
| New works (C. E. Mascareñas) | 160 |

INTERNATIONAL UNION

BELGIUM

(Translation)

Note

of 7th June, 1962, from the Swiss Federal Council (Political Department) relating to the ratification by Belgium of the Arrangement of Madrid concerning the International Registration of Trade Marks of 14th April, 1891, as last revised at Nice on 15th June, 1957

In compliance with the instructions dated 7th June, 1962, issued by the Swiss Federal Political Department, the Swiss Embassy has the honour to inform the Ministry of Foreign Affairs that according to the terms of a Note addressed to the Swiss Embassy in Paris, on 15th March, 1962, by the French Ministry of Foreign Affairs, Belgium deposited in Paris on 8th March, 1962, its instrument of ratification to the Arrangement of Madrid concerning the International Registration of Trade Marks of 14th April, 1891, as last revised at Nice on 15th June, 1957.

HUNGARY

(Translation)

Note

of 14th June, 1962, from the Swiss Federal Council (Political Department) concerning the adhesion of the Hungarian People's Republic to: (1) the Convention of Paris for the Protection of Industrial Property, as revised at London on 2nd June, 1934; (2) the Arrangement of Madrid for the Prevention of False Indications of Source on Goods, as revised at London on 2nd June, 1934; (3) the Arrangement of Madrid concerning the International Registration of Trade Marks, as revised at London on 2nd June, 1934

In compliance with the instructions dated 14th June, 1962 issued by the Swiss Federal Political Department, the Swiss Embassy has the honour to communicate ¹⁾ to the Ministry of Foreign Affairs French translations of the instruments of adhesion of the Hungarian People's Republic to the following Acts of the Union of Paris for the Protection of Industrial Property:

- (1) Convention of Paris for the Protection of Industrial Property of 20th March, 1883, as revised at London on 2nd June, 1934;
- (2) Arrangement of Madrid for the Prevention of False Indications of Source on Goods of 14th April, 1891, as revised at London on 2nd June, 1934;
- (3) Arrangement of Madrid concerning the International Registration of Trade Marks of 14th April, 1891 as revised at London on 2nd June, 1934.

¹⁾ Omitted. (Ed.)

These instruments reached the Federal Political Department on 8th March, 1962.

In compliance with Article 16 (para. 3) of the Convention of Paris, to which Article 6 (para. 2) of the first mentioned Arrangement of Madrid and Article 11 (Para. 2) of the second Arrangement refer, the adhesion of Hungary to the three conventions shall take effect one month after the date of the instructions issued by the Political Department, that is to say the 14th July, 1962.

(Translation)

First Meeting of the Committee of Experts of the Arrangement of Nice

concerning the International Classification of Goods and Services to which Trade Marks apply

(Geneva, 7th-11th May, 1962)

The Committee of Experts, set up under the terms of Article 3 (1) of the Arrangement of Nice concerning the International Classification of Goods and Services to which Trade Marks apply, met in Geneva from 7th to 11th May, 1962 for the first time since the Arrangement came into force on 8th April, 1961.

The meeting was held under the Chairmanship of M. J. J. de Reede, Vice-President of the Dutch Patent Council. M. C. Uggla (Sweden) was appointed Vice-Chairman and M. T. Lorenz (Austria) Rapporteur général.

The following countries were represented: Australia, Austria, Czechoslovak Socialist Republic, Denmark, France, Italy, Monaco, Norway, Netherlands, Portugal, Rumanian People's Republic, Spain, Sweden, Switzerland, United Kingdom of Great Britain and Northern Ireland, and Turkey.

The International Bureau was represented by M. Ch.-L. Maguin, Vice-Director and M. H. Buri, Secretary.

In compliance with Article 3 (1) of the Arrangement of Nice, the Committee of Experts adopted Internal Regulations.

The Committee then examined the problem of additional classes for various services to the present Classification of goods.

After having heard the representatives of the Scandinavian group and of Italy on the entirely satisfactory results obtained in their respective countries with regard to the application of a classification of services in eight classes similar to that in use in the United States of America, the majority of the experts declared themselves in favour of adopting eight service classes numbered from 35 to 42, the last class being reserved for those services which could not be classified in the other classes. The representative of the Czechoslovak Socialist Republic was however in favour of a more limited number of classes (i. e. the system of a single class with possible subdivisions) and therefore reserved for himself the right to communicate, at a later date, the final opinion of his Government.

The Committee of Experts then constituted itself into a Working Commission with a view to examining the proposals

for amendments to be made to the Alphabetical List of Goods of 1935, as submitted by the Administrations of the United Kingdom and Spain and by the International Bureau. This Commission was presided over by Mr. R. L. Moorby, with the assistance of Mr. J. E. Cuthbert. M. L. Egger (Switzerland) was appointed Vice-President and M. M. Bierry (France) Rapporteur.

Meeting again in Plenary session, the Committee of Experts was invited by its Chairman to set up the Sub-Commission provided for by Article 7 (1) of the Internal Regulations. The following were appointed members of this Sub-Commission: M. Miosga (German Federal Republic), Mrs. Olsen (Denmark), M. Bierry (France), Mr. Moorby (United Kingdom) and M. Chlunn (Czechoslovakia).

The Committee then proceeded to an exchange of views with regard to the Memorandum presented by the United Kingdom Delegation, relating to the procedure applicable with respect to the additions to be made to the Alphabetical List of Goods and Services.

Mr. Moorby underlined in particular how important it was to provide for an accelerated procedure in order to ensure the effectiveness of the work of the Sub-Commission charged with examining the classification of new products which would be submitted by the national administrations.

For its part, the International Bureau would hold itself at the disposal of the Sub-commission in order to transmit to all its Members in the shortest possible time such communications as it received to this effect; the International Bureau would also communicate the result of the consultation to the Administration which first made the request.

It would thus seem possible, in these circumstances, to obtain the required answers within the period of one month, as envisaged in the Memorandum submitted by the United Kingdom Delegation.

The wording of the index of classes of the International Classification of goods as published in 1935 has been slightly modified with a view to adding plastic materials (synthetic resins) which did not exist in 1935.

The modified list will be completed by the addition of the eight classes reserved for services once the six month-period provided for in Article 4 (1) of the Nice Arrangement has elapsed.

It was agreed that the first task of the International Bureau was to publish a new edition of the Alphabetical List of Goods and Services.

This publication will be a revised and completed edition of that published in 1935 and will contain all the amendments and additions adopted by the Committee of Experts including those which could not be examined during the meeting because of lack of time. The decision to publish this list was adopted without opposition.

In conformity with the provisions of Article 1 (6) of the Nice Arrangement, it is understood that the list of classes and the alphabetical list of goods and services shall be established in the French language. With regard to official translations in other languages, it shall be the task of the International Bureau to ask each country concerned if it wishes a translation to be made for its own particular use. To a ques-

tion raised by one of the delegates asking whether the cost of publishing such translations would be covered by the countries concerned, the Vice-Director, M. Magnin, replied that this would in fact be the case.

M. Buri (International Bureau) also announced that the International Bureau intended to supplement the general Alphabetical List (goods listed from A to Z) with another list in which the same goods would be grouped according to classes. This additional list had already been envisaged in 1935 but its publication had had to be postponed.

Meeting of the Working Group of the Permanent Bureau of the Paris Union

Implementing a resolution of the Permanent Bureau of the Consultative Committee of the Paris Union, adopted on 30th March, 1962, the Working Group set up under that resolution met in Geneva on June 12, 13 and 14.

The meeting had before it working papers signed by M. Guillaume Finmiss, Director of the French *Institut de la Propriété industrielle*, and Mr. David L. Ladd, U. S. Commissioner of Patents. These papers dealt with the reorganisation of the United International Bureaux and their programme and finances in 1963, 1964 and 1965.

The following persons participated in the conference of the Working Group:

M. Guillaume Finmiss, Chairman, accompanied by Messrs. R. M. N. Labry and M. Pierre (France), M. Marcello Roscioni, accompanied by M. G. Trotta (Italy), M. C. J. de Haau (Netherlands), Mr. Gordon Grant (United Kingdom), Mr. Arpad Bogsch, accompanied by Mrs. V. Westfall (United States of America).

The Czechoslovak Member of the Working Group, Mr. Josef Nemecek, was unable to attend.

The Supervisory Authority of the United International Bureaux, that is, the Government of Switzerland, was represented by M. Hans Morf.

The United International Bureaux were represented by Professor Jacques Secretan, Director.

The Working Group adopted three working papers which will be submitted for consideration to Governments in the near future.

LEGISLATION

AUSTRALIA

Patents Act 1952-1960

(Part two) *

Acceptance of application and complete specification

52. — (1) If the Commissioner is satisfied that there is no lawful ground of objection to an application and complete specification, or that the grounds of objection to an application and complete specification have been removed, the Commissioner shall, subject to subsection (3) of this section, accept the application and complete specification.

(2) If the Commissioner is not so satisfied, he may refuse to accept the application and complete specification.

(3) The Commissioner shall, if the applicant so requests, postpone acceptance of an application and complete specification until such date, not being after the time for acceptance as provided by section fifty-four of this Act, as the applicant specifies.

(4) When an application and complete specification have been accepted, the Commissioner shall forthwith:

- (a) give notice in writing of the acceptance to the applicant; and
- (b) advertise the acceptance in the *Official Journal*.

(5) Where:

- (a) a period of two years has elapsed since a complete specification was lodged in respect of an application; and
- (b) the application and complete specification have not been accepted,

the Commissioner shall forthwith publish in the *Official Journal* a notification that the complete specification is open to public inspection.

(6) ⁶ When:

- (a) acceptance of an application and complete specification has been advertised in the *Official Journal* in pursuance of sub-section (4) of this section; or
- (b) a notification that the complete specification is open to public inspection has been published in the *Official Journal* in pursuance of the last preceding sub-section,

the following documents shall, subject to this Act, be open to public inspection:

- (c) the application as lodged;
- (d) if the application as lodged has been amended, that application as so amended;
- (e) the provisional specification (if any);
- (f) the complete specification as lodged;

* See *Industrial Property*, 1962, p. 112.

⁶ Section 30 (1) of the *Patents Act* 1960 reads as follows:

"(1) Where an application, complete specification and provisional specification (if any) have become open to public inspection under the *Patents Act* 1952 or under that Act as amended, the additional documents referred to in sub-section (6) of section fifty-two of the *Principal Act* as amended by this Act shall also be open to public inspection."

- (g) if the complete specification as lodged has been amended, that specification as so amended;
- (h) the declaration lodged in respect of the application under sub-section (3) of section thirty-five of this Act; and
- (i) in the case of a Convention application, the documents referred to in sub-sections (3) and (4) of section one hundred and forty-three of this Act.

(7) When a complete specification has become open to public inspection under the last preceding sub-section, it shall be deemed to have been published.

(8) An appeal lies to the Appeal Tribunal from a decision of the Commissioner under this section.

Lapsing of application

53. — Where an application and complete specification have not been accepted within the time for acceptance as provided by the next succeeding section, the application shall lapse.

Time for acceptance

54. ⁷ — (1) Subject to this section, the time within which an application and complete specification may be accepted is twenty-one months from the date on which the first report of the Examiner on the complete specification was sent to the applicant.

(2) Where:

- (a) an appeal under any of the provisions of this Act has been instituted in respect of an application; or
- (b) in the case of an application for a patent of addition, an appeal under any of the provisions of this Act has been instituted in respect of either that application or the application for the original patent,

the time within which the application and complete specification may be accepted is extended until the expiration of three months after the determination of the appeal or until the expiration of such further time as the Appeal Tribunal allows.

(3) Where the applicant has died, the Commissioner may extend, until the expiration of such further time as he determines, the time within which the application and complete specification may be accepted.

(4) Where an Examiner reports adversely to a complete specification under paragraph (a) of sub-section (1) of section forty-eight of this Act, the Commissioner may defer acceptance of the application and complete specification until the expiration of three months after:

- (a) the date on which a patent was sealed on the other application referred to in that paragraph; or
 - (b) the date on which that other application lapsed or was refused or withdrawn,
- as the case may be.

⁷ Section 30 (2) of the *Patents Act* 1960 reads as follows:

"(2) The enactment of section fifty-four of the *Principal Act* as amended by this Act does not operate so as to extend the time for acceptance of an application and complete specification which, before the commencement of this section, had lapsed under section fifty-four of the *Principal Act*."

Certain documents not to be published

55. — (1) Subject to this Act:

- (a) an Examiner's report on an application or complete specification;
 - (b) an application or a provisional specification:
 - (i) in respect of which a complete specification has not been lodged; or
 - (ii) in respect of which a complete specification has been lodged but the complete specification has not become open to public inspection; or
 - (c) a complete specification which has not become open to public inspection,
- shall not:
- (d) be published or be open for public inspection; or
 - (e) be liable to be inspected or produced before the Commissioner or in a legal proceeding, unless the Commissioner, court, or officer having power to order inspection or production, directs that the inspection or production ought to be allowed.

(2) Notice of an application for the production in a legal proceeding of a report, an application or a specification, under the last preceding sub-section, shall be served on the Commissioner, who shall be entitled to be heard on the application.

Result of search may be disclosed

56. — The Commissioner may disclose the result of a search made under section forty-eight of this Act.

Effect of publication of complete specification

57. — After the publication of a complete specification and until the sealing of a patent on the application, the applicant has, subject to section sixty-seven of this Act, the like privileges and rights as he would have had if a patent for the invention had been sealed on the date of the publication of the complete specification.

Validity of patent not guaranteed

58. — The investigation and reports referred to in this Act do not in any way guarantee the validity of a patent and the Commonwealth, the Commissioner, or an officer or person employed in the Patent Office, is not liable, by reason of, or in connexion with, any such investigation or report or any proceedings consequent on any such investigation or report.

Part V. Opposition*Opposition to grant of patent*

59. — (1) The Attorney-General or a person interested may, at any time within three months after the date of the advertisement of the acceptance of an application and complete specification, or within such further period, not exceeding three months, as the Commissioner, on an application made to him within the first-mentioned period, allows, by notice in writing lodged at the Patent Office, oppose the grant of the patent on one or more of the following grounds, but on no other ground:

- (a) that the invention, so far as claimed in any claim, was obtained from the opponent, or from a person of whom the opponent is the legal representative, assignee, agent or attorney;
- (b) in the case of an invention communicated from abroad, that the invention was not communicated to the applicant by the actual inventor or his legal representative or assignee;
- (c) that the invention, so far as claimed in any claim, is the subject of a claim of the complete specification of another application for a patent lodged in Australia, being a claim the priority date of which is earlier than the priority date of the first-mentioned claim;
- (d) that the invention, so far as claimed in any claim, is the subject of a claim of earlier priority date contained in the complete specification of a patent;
- (e) that the invention, so far as claimed in any claim, was published in Australia before the priority date of that claim;
- (f) that the invention, so far as claimed in any claim, is not a manner of manufacture within the meaning of section six of the Statute of Monopolies;
- (g) that the invention, so far as claimed in any claim, was obvious and did not involve an inventive step, having regard to what was known or used in Australia on or before the priority date of that claim;
- (h) that the invention, so far as claimed in any claim, was, before the priority date of that claim, otherwise not novel in Australia; and
- (i) that the complete specification does not comply with the requirements of section forty of this Act.

(2) The reference in paragraph (c) of the last preceding sub-section to an application does not include a reference to an application which has lapsed or has been refused or withdrawn or to an application upon which a patent has been granted and the reference in paragraph (d) of that sub-section to a patent does not include a reference to a patent which is not in force.

(3) For the purposes of this section, no account shall be taken of any secret use.

(4) This section is subject to section one hundred and fifty-eight of this Act.

Notice of opposition to applicant and hearing

60. — (1) Where notice of opposition is given under the last preceding section, the opponent shall serve a copy of the notice on the applicant, and the Commissioner shall, after hearing the applicant and the opponent, if desirous of being heard, decide the case.

(2) In so deciding the case:

- (a) the Commissioner may take into account a ground of opposition specified in the last preceding section whether relied upon by the opponent or not; and
- (b) the Commissioner may direct that a date other than the date indicated in a claim be the priority date of that claim.

(3) Where the Commissioner finds that the invention, so far as claimed in any claim of the complete specification, was obtained from the opponent, he may, on application made in accordance with the provisions of this Act, grant to the applicant a patent for the invention, so far as so claimed, and the claims of the complete specification of that patent shall have the same priority date as the priority date of the first-mentioned claim.

(4) The grant of a patent shall not be refused on the ground specified in paragraph (c) of sub-section (1) of the last preceding section if a patent has not been sealed on the application mentioned in that paragraph.

(5) The applicant, and an opponent who, in the opinion of the Appeal Tribunal is entitled to be heard in opposition to the grant, may appeal to the Appeal Tribunal from a decision of the Commissioner under this section.

Notice of opposition may be given on basis that indicated priority date is incorrect

61. — (1) An opponent may, in a notice of opposition under section fifty-nine of this Act, specify a ground of opposition by reference either to the priority date indicated in the relevant claim or by reference to a date which the opponent alleges to be the priority date of that claim as determined by this Act.

(2) If the Commissioner finds that a date other than the date indicated in the claim (whether that other date is the date alleged in the notice of opposition or not) is the priority date of the claim as determined by this Act, he shall, in deciding the case, treat the first-mentioned date as the priority date of the claim.

Part VI. Patents and their Sealing

Sealing of patent

62. — If there is no opposition to the grant of a patent, or, in case of opposition, if the Commissioner's decision, or the decision on appeal from that decision, is that a patent should be granted, the Commissioner shall cause a patent, in accordance with the prescribed form, to be sealed with the seal of the Patent Office.

Refusal of assignee or joint applicant to proceed

63. — (1) Where:

- (a) an applicant or his legal representative has agreed in writing to assign a patent, or a part interest in a patent, when granted, to another person, and refuses to proceed with the application;
- (b) two or more applicants have lodged a complete specification under section fifty of this Act, and one or more of those applicants refuses to proceed with his application;
- (c) one of two or more joint applicants refuses to proceed with the application; or
- (d) a person who has filed an attested copy of an agreement under the next succeeding section refuses to proceed with the application,

the Commissioner may determine the person who may be allowed to proceed with the application and may grant a patent to him.

(2) Where a dispute arises between:

- (a) joint applicants or their assignees; or
- (b) an applicant and an assignee,

as to the manner of proceeding with an application, the Commissioner may determine the manner in which the application shall proceed.

(3) The Commissioner shall, if so required, hear a person interested in the application.

(4) An appeal lies to the Appeal Tribunal from a decision of the Commissioner under this section.

Assignment of patent before grant

64. — Where an applicant has agreed in writing to assign the patent, or a part interest in the patent, when granted, the patent may, upon proof of the agreement to the satisfaction of the Commissioner, and upon an attested copy of the agreement being filed in the Patent Office, be granted to the assignee, or, in the case of an assignment of a part interest in the patent, to the assignee jointly with the other applicant in whom the remaining interest in the patent is vested.

Death of applicant

65. — (1) If an applicant dies before the sealing of a patent on his application, the patent may be granted to his legal representative.

(2) Where, at any time after a patent has been sealed on an application, the Commissioner is satisfied that the patentee had died, or, in the case of a body corporate, had ceased to exist, before the patent was sealed, the Commissioner may amend the patent by substituting for the name of the patentee the name of the person to whom the patent ought to have been granted.

(3) Where the Commissioner has amended a patent under the last preceding sub-section, the patent has effect, and shall be deemed always to have had effect, accordingly.

Time for sealing

66. — (1) Subject to this section, a patent shall be sealed as soon as may be, and not after six months from the date of the advertisement of the acceptance of the application and complete specification or after the expiration of such further period as is provided by the succeeding sub-sections of this section, or as the High Court allows.

(2) Where the Commissioner has allowed an extension of time within which notice of opposition to the grant of the patent may be given and notice of opposition has not been given, an extension of time for the same period, or the aggregate of the periods, if more than one, after the period of six months referred to in the last preceding sub-section shall be allowed for the sealing of the patent.

(3) Where the sealing of a patent is delayed by:

- (a) opposition to the grant of the patent;

(b) the taking of proceedings for obtaining the decision of the Commissioner under section sixty-three of this Act;

or

(c) an appeal to the Appeal Tribunal, that patent, and any patent of addition the sealing of which is delayed in consequence of the delay in the sealing of the first-mentioned patent, may be sealed at such time as:

(d) in a case to which paragraph (a) or (b) of this sub-section applies — the Commissioner directs; or

(e) in a case to which paragraph (c) of this sub-section applies — the Appeal Tribunal directs.

(4) Where an applicant dies before the expiration of the time which would otherwise be allowed for sealing the patent, the patent may be sealed at any time within twelve months after his death or within such further period as the Commissioner directs.

(5) Where the Commissioner is satisfied that hardship would arise in connexion with the prosecution by an applicant of an application for a patent in a country outside Australia unless the period for sealing the patent is extended, the Commissioner may extend the period for such time as appears to him to be necessary in order to prevent that hardship arising.

(6) Where a patent cannot be sealed within the period allowed by or under this section, that period may, on application made to the Commissioner within the prescribed time, but subject to the regulations, be extended for such further period as is prescribed.

Date of patent

67. — (1) Subject to this Act, a patent shall be dated as of the day on which the complete specification was lodged.

(2) Subject to this Act, a patent granted on an application made under sub-section (3) of section forty-nine of this Act or under sub-section (1) of section fifty-one of this Act shall be dated as of the date of lodgement of the complete specification in which the invention the subject of the application was first disclosed.

(3) Where two or more applications are lodged for patents for the same invention, the sealing of a patent on one of those applications does not prevent the sealing of a patent on any of the other applications.

(4) A person is not entitled to institute proceedings for infringement unless and until a patent for the invention has been sealed or in respect of an infringement committed before the publication of the complete specification.

Term of patent

68. — (1) Subject to this Act, the term of a patent shall be sixteen years, reckoned from the date of the patent.

(2) Subject to the next succeeding sub-section, every patent shall cease if the patentee fails to pay a renewal fee within the prescribed time.

(3) If a patentee fails to pay a renewal fee within the prescribed time, he may apply to the Commissioner for an extension of the time for making that payment, and the Commissioner shall extend the time accordingly, but the time for

making a payment shall not be extended for more than six months.

Effect of patent

69. — Subject to this Act, the effect of a patent is to grant to the patentee the exclusive right, by himself, his agents and licensees, during the term of the patent, to make, use, exercise and vend the invention in such manner as he thinks fit, so that he shall have and enjoy the whole profit and advantage accruing by reason of the invention during the term of the patent.

Extent of patent

70. — A patent has effect throughout Australia.

Loss or destruction of patent

71. — If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the Commissioner, the Commissioner may cause a duplicate of the patent to be sealed.

Part VII. Patents of Addition

Application for patent of addition

72. — Where a patent for an invention has been applied for or granted and a person (being the applicant or patentee or some other person with the consent of the applicant or patentee) applies for a further patent in respect of an improvement in, or modification of, the invention (in this Part referred to as "the main invention"), the first-mentioned person may, in his application for the further patent, request that the term of that patent shall be the same as that of the patent for the main invention or so much of that term as is unexpired.

Grant of patent of addition

73. — (1) Where an application containing such a request is made, the Commissioner may, subject to this Part, grant a patent, and the term of the patent so granted shall, subject to this Part, be the term referred to in the last preceding section.

(2) A patent shall not be granted as a patent of addition unless the date of lodging of the complete specification was the same as, or later than, the date of lodging of the complete specification in respect of the main invention.

(3) A patent of addition shall not be sealed before the sealing of a patent for the main invention.

(4) An appeal lies to the Appeal Tribunal from a decision of the Commissioner under this section.

Revocation of patent and grant of patent of addition in lieu

74. — Where an invention, being an improvement in, or modification of, an original invention, is the subject of an independent patent and the patentee in respect of the independent patent is also the patentee in respect of the patent for the original invention, the Commissioner may, on an application made by the patentee, revoke the independent patent and grant a patent of addition in respect of the improvement or modification bearing the same date as the date of the independent patent so revoked.

Duration of patent of addition

75. — (1) A patent of addition shall remain in force so long as the patent for the main invention remains in force, and no longer, but may be extended under Part IX for any period for which the patent for the main invention is extended.

(2) A fee is not payable in respect of the renewal of a patent of addition.

(3) If the patent for the original invention is revoked or surrendered, the patent of addition shall, unless the High Court in the case of revocation, or the Commissioner in the case of surrender, otherwise orders, become an independent patent, and the fees payable after the patent of addition becomes an independent patent, and the dates when they become payable, shall be determined by its date, but its duration shall not exceed the unexpired term of the patent for the main invention.

Validity of patent of addition

76. — Objection shall not be taken to an application for a patent of addition, so far as the invention is claimed in any claim of the complete specification, and a patent of addition, so far as the invention is so claimed, is not invalid, on the ground only that the invention, so far as claimed in any claim of the complete specification, is obvious and does not involve an inventive step, having regard to:

- (a) the publication of the main invention before the priority date of that claim but after the priority date of the claim of the specification of the main invention defining the invention the improvement in which, or the modification of which, is the subject of the first-mentioned claim, or, if there are two or more claims defining that invention, after the priority date of whichever of those claims has the earlier or earliest priority date; or
- (b) the use of the main invention during that period.

Part VIII. Amendment of Specifications*Amendment of complete specification*

77. — (1) An applicant or patentee may, by a request in writing lodged at the Patent Office, seek leave to amend his complete specification.

(2) The request shall specify the nature of, and the reasons for, the proposed amendment.

(3) Where a person has been registered as the mortgagee or exclusive licensee of a patent, an amendment shall not be allowed unless the mortgagee or licensee has consented, in writing, to the amendment.

(4) If the mortgagee or licensee refuses to consent to the proposed amendment, the Commissioner may, on the application of the applicant or patentee, if the Commissioner is of opinion that consent has been unreasonably refused, direct that the consent of the mortgagee or licensee shall not be necessary.

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

Nature of amendments allowable

78. — (1) Except for the purpose of correcting a clerical error or an obvious mistake, an amendment of a specification under this Part is not allowable:

- (a) after publication of the complete specification — if a claim of the specification as amended would not in substance fall within the scope of the claims of the specification before amendment; and
- (b) at any time — if the specification as amended would claim matter not in substance disclosed in the specification as lodged.

(2) An amendment of a specification under this Part is not allowable after acceptance if, by reason of making the amendment, the specification would not comply with the requirements of section forty of this Act.

Examination of request for amendment

79. — An Examiner shall ascertain and report whether:

- (a) the request for leave to amend is as prescribed;
- (b) the priority date of each claim as proposed to be amended is the priority date of that claim as determined by this Act; and
- (c) the amendment is or is not otherwise allowable.

Action on Examiner's report

80. — If the Examiner reports adversely to the request for leave to amend, the applicant or patentee may amend his request so as to remove the grounds of objection and the amended request shall be reported on in the like manner as the original request.

Advertisement of request

81. — (1) The Commissioner may, if he is of opinion that the request for leave to amend should not be allowed, refuse the request.

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

(3) If the Commissioner does not refuse the request, or if, on appeal from a decision of the Commissioner refusing the request, the Appeal Tribunal reverses the decision of the Commissioner, the Commissioner shall, unless the complete specification has not been published, advertise particulars of the request in the *Official Journal*.

Notice of opposition

82. — Where particulars of the request have been advertised, the Attorney-General or a person interested may, at any time within three months after the date of the advertisement, or within such further period, not exceeding three months, as the Commissioner, on application made to him within the first-mentioned period and on payment of the prescribed fee, allows, give notice to the Commissioner of opposition to the granting of the request on the ground that:

- (a) the priority date of a claim as proposed to be amended is not the priority date of that claim as determined by this Act; or

(b) the amendment is not allowable under section seventy-eight of this Act, but on no other ground, and shall serve a copy of the notice on the applicant or patentee.

Determination of request

83. — (1) The Commissioner shall, after hearing the person making the request and a person who has given notice of opposition, if desirous of being heard, determine whether, and subject to what conditions (if any), the amendment ought to be allowed.

(2) Where notice of opposition is not given, or the person so giving notice does not appear, the Commissioner shall determine whether, and subject to what conditions (if any), the amendment ought to be allowed.

Appeal to Appeal Tribunal

84. — The applicant or the patentee, as the case may be, and an opponent who, in the opinion of the Appeal Tribunal, is entitled to be heard in opposition to the request, may appeal to the Appeal Tribunal from a decision of the Commissioner under the last preceding section.

No amendment where action pending

85. — The preceding provisions of this Part do not apply, in the case of a request by a patentee for leave to amend his complete specification, when, and so long as there is pending:

- (a) an action for infringement of the patent;
 - (b) a proceeding for revocation of the patent; or
 - (c) a proceeding in which the validity of the patent or of a claim of the complete specification is disputed,
- whether commenced before or after the lodging of the request for leave to amend.

Court may direct amendment

86. — (1) In an action for infringement of a patent, in a proceeding for revocation of a patent or in a proceeding in which the validity of a patent, or of a claim of a complete specification, is disputed, the court, Justice or Judge may, at any time, by order made on the application of the patentee, subject to such terms (if any) as to costs, advertisements or otherwise as the court, Justice or Judge imposes, direct the amendment of the specification in the manner specified in the order.

(2) The patentee shall give notice of an application for an order under the last preceding sub-section to the Commissioner, who shall be entitled to appear and be heard and shall appear if the court, Justice or Judge so directs.

(3) The court, Justice or Judge shall not direct an amendment which is not allowable under section seventy-eight of this Act.

(4) A copy of an order made under sub-section (1) of this section shall be lodged by the patentee at the Patent Office within fourteen days after the sealing of the order and thereupon the specification shall be deemed to have been amended in the manner specified in the order.

Restriction on recovery of damages

87. — Where an amendment is made under this Act to a complete specification after publication, damages shall not be given, and order shall not be made for an account of profits, in an action for an infringement of the patent occurring before the date of the decision or order allowing or directing the amendment, unless the patentee establishes to the satisfaction of the court that the specification without the amendment was framed in good faith and with reasonable skill and knowledge.

Effect of amendment

88. — (1) A complete specification as amended, or as last amended, under this Part, shall, in all courts and for all purposes, be conclusively accepted as, and be deemed to be, the complete specification.

(2) Except in the case of an amendment made in contravention of section eighty-five of this Act, it is not competent for a person in an action or other proceeding to take an objection to an amended specification on the ground that an amendment has been made which was not allowable under this Part.

(3) A court, the Appeal Tribunal or the Commissioner, may, in construing a specification as amended, refer to the specification without the amendment.

Advertisement of amendment

89. — An amendment under this Part (not being an amendment of a specification which has not been published) shall be advertised in the *Official Journal*.

Part IX. Extension of Patents

Petition to High Court for extension of term of patent

90. — (1) A patentee who considers that he has been inadequately remunerated by his patent may, after advertising, as prescribed, his intention to do so, present to the High Court, at least six months before the expiration of the term of the patent, or within such further period as the High Court allows, a petition praying that his patent be extended for a further term.

(2) A petition for the extension of the term of a patent may be presented under this section notwithstanding that the patent has previously been extended, or a new patent for the invention has previously been granted, on the ground of loss or damage suffered by reason of hostilities between Her Majesty and a foreign state but a petition may not be presented under this section if the patent has previously been extended, or a new patent for the invention has been granted, on the ground of inadequate remuneration.

Caveat

91. — A person interested may file in the High Court a caveat against the extension and shall serve a copy of the caveat on the Commissioner.

Hearing

92. — On the hearing of the petition, a person who has filed a caveat shall be made a party respondent to the peti-

tion, and the Commissioner shall be entitled to appear and be heard, and shall appear if so directed by the High Court.

Matters to be considered by Court

93. — The High Court shall, in considering its decision, have regard to:

- (a) the nature and merits of the invention in relation to the public;
- (b) the profits made by the patentee as such; and
- (c) all the circumstances of the case.

Extension on ground of inadequate remuneration

94. — (1) If the High Court is of opinion that the patentee has been inadequately remunerated by his patent, the Court may:

- (a) order the extension of the term of the patent, subject to such restrictions, conditions and provisions (if any) as the Court thinks fit, for a further term not exceeding five years, or, in exceptional cases, ten years; or
- (b) order the grant of a new patent for such term, not exceeding five years, or, in exceptional cases, ten years, as the Court thinks fit, and containing such restrictions, conditions and provisions (if any) as the Court thinks fit.

(2) This section applies although the patentee does not present to the Court a complete account of his receipts and expenditure as patentee if the Court is nevertheless satisfied that the patentee has been inadequately remunerated by the patent.

(3) The patentee shall serve on the Commissioner an office copy of an order of the Court under this section and the Commissioner shall insert in the Register a reference to the order.

(To be continued)

CORRESPONDENCE

Letter from Belgium

by Antoine BRAUN, Brussels

CONGRESSES AND MEETINGS

International Typographic Association

Resolution

unanimously adopted by the
International Typographic Association at its General Assembly
at Verona 22nd May, 1962¹⁾

The International Typographic Association expresses to the United International Bureaux for the Protection of Industrial, Literary and Artistic Property

its appreciation for the work so far accomplished with a view to the international protection of type faces and would like to suggest that all the Members of the Union be informed of the next conference which will be held in September in Geneva²⁾ so as to enable those countries interested to participate.

¹⁾ See *Prop. ind.*, 1960, p. 206; 1961, p. 144; 1962, p. 89.

²⁾ The third meeting of the Committee of Experts charged with the study of the international protection of type faces has been postponed to October 1962. (*Ed.*)

BOOK REVIEW

Los delitos contra la propiedad industrial, by Prof. C. E. Mascareñas.
One volume of 223 pages 21 × 14 cm. Published by the Libreria Bosch, Barcelona, 1960.

As indicated by its title, the work of Professor Mascareñas deals with infringements against industrial property rights.

Though this work is mainly concerned with Spanish law, and is therefore based on the industrial property laws and the Spanish Penal Code, it is nevertheless of particular interest to all lawyers interested in the general problem of the protection of industrial property; in effect, the work makes constant reference to both the solutions built up by International Conventions for the Protection of Industrial Property and to theory and principles of case law established in the principle industrial countries.

The work generally covers all infringements of industrial property rights and studies in detail such problems as offences, penalties, falsification of trade marks, usurping of industrial property titles in respect of trade marks, industrial designs and models, indications of source and appellations of origin, trade names, titles, etc.

There is no doubt that the work of Professor Mascareñas will contribute towards clarifying both to Spanish and Latin American readers the vast problem of industrial property and will greatly facilitate the studies of Spanish speaking specialists in this field.

C. R. W.