

# Industrial Property

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# INTERNATIONAL UNION

## Appointment of a new Vice-Director

The conditions referred to in Resolution No. 4 adopted on October 25<sup>th</sup>, 1962, by the Permanent Bureau of the Consultative Committee of the Paris Union and the Permanent Committee of the Berne Union (see *Industrial Property*, 1962, p. 236; *Le Droit d'Auteur [Copyright]*, 1962, p. 188) having been fulfilled, the Director of BIRPI appointed, on July 19<sup>th</sup>, 1963, Dr. Arpad Bogsch as Vice-Director of BIRPI.

## CZECHOSLOVAKIA

### Adhesion

#### to the Arrangement of Madrid for the Prevention of False or Misleading Indications of Source

The following communication has been received from the Swiss Federal Political Department:

(Translation)

"The Swiss Embassy presents its compliments to the Ministry of Foreign Affairs and has the honour to refer to its note dated 3<sup>rd</sup> October, 1961, in which it notified the fact that the Czechoslovak Socialist Republic had, *inter alia*, ratified the Arrangement of Madrid for the Prevention of False or Misleading Indications of Source of 14<sup>th</sup> April, 1891, as last revised at Lisbon on 31<sup>st</sup> October, 1958.

In compliance with the instructions of the Federal Political Department, the Embassy informs the Ministry that the afore-mentioned notification should be rectified in that Czechoslovakia did not ratify the Arrangement for the Prevention of False or Misleading Indications of Source, but adhered to it. In the course of translating the Czechoslovak instrument of adhesion, the word 'ratification' was substituted for the word 'adhesion'. Czechoslovakia had not signed the said Arrangement and could not, therefore, ratify it.

In accordance with the provisions of Article 6 (1) of the Arrangement, six ratifications were necessary to bring the Arrangement into force before the 1<sup>st</sup> June, 1963. Consequently, in view of the fact that only five ratifications had been deposited, the Arrangement of Madrid for the Prevention of False or Misleading Indications of Source did not come into force on 17<sup>th</sup> February, 1963, but, according to Article 6 (1) of the Arrangement, on 1<sup>st</sup> June, 1963, in respect of those countries which had ratified it (France, Great Britain and Northern Ireland, Monaco, Federal Republic of Germany and Switzerland). With regard to Czechoslovakia, the Arrangement came into force on that same date, by reason of its adhesion."

## The Future Stockholm Conference

At the time of the last revision of the Berne Convention in 1948, His Excellency Mr. Sture Petré, Ambassador, extended, in the name of the Swedish Delegation, an invitation for the next Diplomatic Conference of Revision to be held in Stockholm. Supported by France, this proposal was unanimously approved by the Delegations present at Brussels<sup>1)</sup>.

In a letter addressed on the 12<sup>th</sup> November, 1955, to the Director of the International Bureau, the Swedish Minister of Justice, confirming this invitation and referring to Article 24 (2) of the Berne Convention, declared himself, in the name of his Government, ready to proceed, in collaboration with the International Bureau, with the preparatory work for the Revision Conference, the date of which would be decided later.

As a result of contacts made by the International Bureau with senior officials nominated by the Swedish Government for this purpose, the Inviting Power envisaged holding the above Conference in 1965.

In accordance with Article 5 of its internal Regulations, the Permanent Committee of the Berne Union, during its 10<sup>th</sup> Session held in Madrid in September 1961, gave the International Bureau its advice on the preparation of the Revision Conference of Stockholm<sup>2)</sup>.

During a Joint Meeting held in Geneva in October, 1962, the Permanent Committee of the Berne Union and the Permanent Bureau of the Consultative Committee of the Paris Union noted with gratitude the invitation extended by the representatives of Sweden to convene in Stockholm, at the same time as the Revision Conference of the Berne Convention, a Diplomatic Conference to draw up an Administrative Convention, and for that purpose to revise some of the administrative clauses of the existing Conventions and Arrangements in the fields of both literary and artistic property and industrial property<sup>3)</sup>.

The Permanent Committee and the Permanent Bureau were of the opinion that the preparation for this second Conference should start immediately.

In this regard the Swedish Government and the United International Bureaux discussed the steps to be taken. The conclusions at which they arrived led to an exchange of correspondence which is set out below:

Royal Ministry of Justice

Stockholm, 13<sup>th</sup> March, 1963

Dear Director,

With reference to the discussions we had in Stockholm on the 11<sup>th</sup> March, 1963, I have the honour to communicate to you the following information.

With reference to the texts adopted by the Permanent Bureau of the Consultative Committee of the International Union for the Protection of Industrial Property (Paris Union) and the Permanent Committee of the International Union for the Protection of Literary and Artistic Works (Berne Union)

1) See *Acts of the Conference*, p. 87.

2) See *Le Droit d'auteur*, 1961, p. 335 *et seq.*

3) See *Le Droit d'Auteur (Copyright)*, 1962, p. 186.

at their Joint Meeting held in Geneva from the 15<sup>th</sup> to 19<sup>th</sup> October, 1962, I hereby confirm that the Swedish Government remains disposed to invite, at the same time as the next Revision Conference of the Berne Convention, hitherto anticipated for the year 1965, a Diplomatic Conference to establish an Administrative Convention by which the supervisory functions, at present incumbent on the Swiss Government, would be transferred to the States Members of the Union as a whole, and the system of contributions of States Members towards the expenses of BIRPI would be modernized.

However, as you have informed me that the preparation of the latter Conference will require careful study which will not be completed in time for the Conference to be held in 1965, the Swedish Government, having in mind the advantage of coordinating these two Conferences, has decided to postpone until 1967 the Revision Conference of the Berne Convention and to invite for the same period the Conference for the establishment of an Administrative Convention.

Yours sincerely,  
Herman KLING  
Minister of Justice

(Translation)

United International Bureaux for the Protection  
of Industrial, Literary and Artistic Property

Geneva, 20<sup>th</sup> March, 1963

Dear Minister,

I have the honour to acknowledge receipt of your letter of the 13<sup>th</sup> March, 1963, by which you confirm that your Government remains disposed to invite, at the same time as the next Revision Conference of the Berne Convention, a Diplomatic Conference for the establishment of an Administrative Convention involving the Berne and Paris Unions. Furthermore, you have been good enough to inform me that, as a result of our discussions, your Government, taking into account the facts I put forward, has decided, in the interest of coordinating these two Conferences, to invite them to meet for the same period in 1967.

I have noted this decision with satisfaction for I am convinced that it will increase the chances of success of the two Diplomatic Conferences of which Sweden is good enough to be the Inviting Power.

I will not fail to communicate very soon the contents of your letter to the States Members of the Berne and Paris Unions and to publish the present exchange of correspondence in our official periodicals.

Yours sincerely,  
G. H. C. BODENHAUSEN  
Director

(Translation)

## LEGISLATION

### IRELAND

#### Trade Marks Act

(No. 9, of 1963)

(Second Part)<sup>1)</sup>

#### *Registration in Part A to be conclusive as to validity after seven years*

21. — (1) In all legal proceedings relating to a trade mark registered in Part A of the register (including applications under section 40 of this Act) the original registration in Part A of the register of the trade mark shall, after the expiration of seven years from the date of that registration, be taken to be valid in all respects, unless:

- (a) that registration was obtained by fraud, or
- (b) the trade mark offends against section 19 of this Act.

(2) Nothing in subsection (1) of section 13 of this Act shall be construed as making applicable to a trade mark, as being a trade mark registered in Part B of the register, the foregoing provisions of this section relating to a trade mark registered in Part A of the register.

#### *Registration subject to disclaimer*

22. — If a trade mark:

- (a) contains any part not separately registered by the proprietor as a trade mark; or
- (b) contains matter common to the trade or otherwise of a non-distinctive character;

the Court or the Controller (as the case may be), in deciding whether the trade mark shall be entered or shall remain on the register, may require as a condition of its being on the register:

- (i) that the proprietor shall disclaim any right to the exclusive use of any part of the trade mark, or to the exclusive use of all or any portion of any such matter as aforesaid, to the exclusive use of which the Court or the Controller (as the case may be) holds him not to be entitled; or
- (ii) that the proprietor shall make such other disclaimer as the Court or the Controller (as the case may be) may consider necessary for the purpose of defining his rights under the registration:

Provided that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

#### *Word trade mark used as name of article or substance*

23. — (1) The registration of a trade mark shall not be deemed to have become invalid by reason only of any use,

<sup>1)</sup> See *Industrial Property*, 1963, p. 118.

after the date of the registration, of a word or words which the trade mark contains, or of which it consists, as the name or description of an article or substance:

Provided that if it is proved either:

- (a) that there is a well-known and established use of the word or words as the name or description of the article or substance by a person or persons carrying on a trade therein, not being use in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark or (in the case of a certification trade mark) goods certified by the proprietor; or
- (b) that the article or substance was formerly manufactured under a patent (being a patent in force on, or granted after, the 1<sup>st</sup> day of October, 1927), that a period of two years or more after the cesser of the patent has elapsed, and that the word or words is or are the only practicable name or description of the article or substance;

the provisions of subsection (2) of this section shall have effect.

(2) Where the facts mentioned in paragraph (a) or (b) of the proviso to subsection (1) of this section are proved with respect to any word or words, then:

- (a) if the trade mark consists solely of that word or those words, the registration of the trade mark, so far as regards registration in respect of the article or substance in question or of any goods of the same description, shall be deemed for the purposes of section 40 of this Act to be an entry wrongly remaining on the register;
- (b) if the trade mark contains that word or those words and other matter, the Court or the Controller (as the case may be), in deciding whether the trade mark shall remain on the register, so far as regards registration in respect of the article or substance in question and of any goods of the same description, may in case of a decision in favour of its remaining on the register require as a condition thereof that the proprietor shall disclaim any right to the exclusive use in relation to that article or substance and any goods of the same description of that word or those words, so, however, that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made; and
- (c) for the purposes of any other legal proceedings relating to the trade mark:
  - (i) if the trade mark consists solely of that word or those words, all rights of the proprietor, whether under the common law or by registration, to the exclusive use of the trade mark in relation to the article or substance in question or to any goods of the same description, or
  - (ii) if the trade mark contains that word or those words and other matter, all such rights of the proprietor to the exclusive use of that word or those words in such relation as aforesaid,

shall be deemed to have ceased on the date at which the use mentioned in paragraph (a) of the proviso to subsection (1) of this section first became well known and established, or at the expiration of the period of two years mentioned in paragraph (b) of that proviso.

(3) No word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark in respect of a chemical substance or preparation, and any such registration in force at the commencement of this Act or thereafter shall, notwithstanding section 21 of this Act, be deemed for the purposes of section 40 of this Act to be an entry made in the register without sufficient cause, or an entry wrongly remaining on the register, as the circumstances may require:

Provided that this subsection shall not have effect in relation to a word which is used to denote only a brand or make of the element or compound as made by the proprietor or a registered user of the trade mark, as distinguished from the element or compound as made by others and in association with a suitable name or description open to the public use.

#### *Effect of limitation as to colour and of absence thereof*

24.— (1) A trade mark may be limited in whole or in part to one or more specified colours, and in any such case the fact that it is so limited shall be taken into consideration by the Court or the Controller (as the case may be) when deciding on the distinctive character of the trade mark.

(2) If and so far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.

#### *Application for registration*

25.— (1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Controller in the prescribed manner for registration either in Part A or in Part B of the register.

(2) Subject to this Act, the Controller may refuse the application, or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think right.

(3) In the case of an application for registration of a trade mark (other than a certification trade mark) in Part A of the register, the Controller may, if the applicant is willing, instead of refusing the application, treat it as an application for registration in Part B and deal with the application accordingly.

(4) In the case of a refusal or conditional acceptance, the Controller shall, if required by the applicant within the prescribed time, state in writing the grounds of his decision and the materials used by him in arriving thereat.

(5) An applicant desiring to appeal under section 57 of this Act against a decision of the Controller under this section shall apply to the Controller under subsection (4) of this section for the statement in writing therein referred to, and on the appeal the Court shall, if required, hear the applicant

and the Controller, and shall make an order determining whether, and subject to what amendments, modifications, conditions or limitations, if any, the application is to be accepted.

(6) Except by leave of the Court no appeal against a decision of the Controller under this section shall be made save within a period of two months from the date of dispatch to the applicant of the statement in writing referred to in subsection (4) of this section or within such further period not exceeding three months as the Controller may allow (upon request received before the expiration of the said period of two months).

(7) Appeals under section 57 of this Act against decisions of the Controller under this section shall be heard on the materials stated as aforesaid by the Controller, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Controller, other than those so stated as aforesaid by him, except by leave of the Court.

(8) The Controller or the Court (as the case may be) may at any time, whether before or after acceptance, correct any error in or in connection with the application, or may permit the applicant to amend his application upon such terms as the Controller or the Court (as the case may be) may think fit.

#### *Opposition to registration*

26. — (1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Controller shall, as soon as may be after acceptance, cause the application as accepted to be advertised in the prescribed manner, and the advertisement shall set forth all conditions and limitations subject to which the application has been accepted:

Provided that the Controller may cause an application to be advertised before acceptance in any case where it appears to him that it is expedient by reason of any exceptional circumstances so to do, and where an application has been so advertised the Controller may, if he thinks fit, advertise it again when it has been accepted but shall not be bound so to do.

(2) Any person may, within the prescribed time from the date of the advertisement of an application, give notice to the Controller of opposition to the registration.

(3) The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(4) The Controller shall send a copy of the notice to the applicant, and within the prescribed time after receipt thereof the applicant shall send to the Controller, in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and, if he does not do so, he shall be deemed to have abandoned his application.

(5) If the applicant sends such a counter-statement as aforesaid, the Controller shall furnish a copy thereof to the persons giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions or limitations,

if any, registration is to be permitted and shall notify the applicant and the opponent accordingly.

(6) The applicant or the opponent may, within the prescribed time after the date of notification of the decision of the Controller, apply to the Controller for a written statement of the grounds of his decision.

(7) A person desiring to appeal under section 57 of this Act against a decision of the Controller under this section shall apply to the Controller under subsection (6) of this section for the written statement therein referred to, and on the appeal the Court shall, if required, hear the parties and the Controller and shall make an order determining whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(8) Except by leave of the Court, no appeal against a decision of the Controller under this section shall be made save within a period of two months from the date of dispatch to the applicant of the statement in writing referred to in subsection (6) of this section or within such further period not exceeding three months as the Controller may allow (upon request received before the expiration of the said period of two months).

(9) On the hearing of an appeal under section 57 of this Act against a decision of the Controller under this section any party may, either in the manner prescribed or by special leave of the Court, bring forward further material for the consideration of the Court.

(10) *a*) On an appeal under section 57 of this Act against a decision of the Controller under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Controller, other than those so stated as aforesaid by the opponent, except by leave of the Court.

*b*) Where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(11) On an appeal under section 57 of this Act against a decision of the Controller under this section the Court may, after hearing the Controller, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity thereof, but in any such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

(12) If a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of such notice, or an appellant, neither resides nor carries on business in the State, the Court (in the case of an appeal) or the Controller (in any other case) may require him to give security for costs of the proceedings and, in default of such security being duly given, may treat the opposition or application, or the appeal, as the case may be, as abandoned.

#### *Registration*

27. — (1) When an application for registration of a trade mark in Part A or in Part B of the register has been accepted, and either:

(a) the application has not been opposed and the time for notice of opposition has expired, or  
 (b) the application has been opposed and the opposition has been decided in favour of the applicant,  
 the Controller shall, unless the application has been accepted in error, register the trade mark in Part A or Part B, as the case may be, and the trade mark, when registered, shall be registered as of the date of the application for registration, and that date shall be deemed for the purposes of this Act to be the date of registration:

Provided that the foregoing provisions of this subsection, relating to the date as of which a trade mark shall be registered and to the date to be deemed to be the date of registration, shall, as respects a trade mark registered under this Act with the benefit of section 70 of this Act, have effect subject to that section.

(2) On the registration of a trade mark the Controller shall issue to the applicant a certificate in the prescribed form of the registration thereof sealed with the official seal of the Controller.

(3) Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Controller may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

#### *Duration and renewal of registration*

28.— (1) The registration of a trade mark shall be for a period of seven years, but may be renewed from time to time in accordance with this section:

Provided that, in relation to a registration as of a date before the commencement of this Act, this subsection shall have effect with the substitution of a period of fourteen years for the said period of seven years.

(2) The Controller shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of the trade mark for a period of fourteen years from the date of expiration of the original registration or of the last renewal of registration, as the case may be, which date is in this section called "the expiration of the last registration".

(3) At the prescribed time before the expiration of the last registration of a trade mark, the Controller shall send notice in the prescribed manner to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with, the Controller may remove the trade mark from the register, subject to such conditions, if any, as to its restoration to the register as may be prescribed.

(4) Where a trade mark has been removed from the register for non-payment of the fee for renewal, it shall, nevertheless, for the purpose of any application for the registration

of a trade mark during one year next after the date of the removal, be deemed to be a trade mark that is already on the register:

Provided that the foregoing provisions of this subsection shall not have effect where the Court or the Controller (as the case may be) is satisfied either:

- (a) that there has been no *bona fide* trade use of the trade mark that has been removed during the two years immediately preceding its removal; or
- (b) that no deception or confusion would be likely to arise from the use of the trade mark that is the subject of the application for registration by reason of any previous use of the trade mark that has been removed.

#### *Registration of parts of trade marks and of trade marks as a series*

29.— (1) (a) Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and any such part as separate trade marks.

(b) Each such separate trade mark must satisfy all the conditions of an independent trade mark and shall, subject to subsection (3) of section 31 and subsection (2) of section 38 of this Act, have all the incidents of an independent trade mark.

(2) Where a person claiming to be the proprietor of several trade marks, in respect of the same goods or description of goods, which, while resembling each other in the material particulars thereof, yet differ in respect of:

- (a) statements of the goods in relation to which they are respectively used or proposed to be used; or
- (b) statements of number, price, quality or names of places; or
- (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or
- (d) colour;

seeks to register those trade marks, they may be registered as a series in one registration.

#### *Powers of and restrictions on assignment and transmission*

30.— (1) Notwithstanding any rule of law or equity to the contrary, and subject to this section, a registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible either in connection with the goodwill of a business or not.

(2) Subject to this section, a registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible in respect either of all the goods in respect of which it is registered, or was registered, as the case may be, or of some (but not all) of those goods.

(3) Subsections (1) and (2) of this section shall have effect in the case of an unregistered trade mark used in relation to any goods as they have effect in the case of a registered trade mark registered in respect of any goods, if at the time of the assignment or transmission of the unregistered trade mark it is or was used in the same business as a

registered trade mark, and if it is or was assigned or transmitted at the same time and to the same person as that registered trade mark and in respect of goods all of which are goods in relation to which the unregistered trade mark is or was used in that business and in respect of which that registered trade mark is or was assigned or transmitted.

(4) Notwithstanding anything in subsections (1), (2) and (3) of this section, a trade mark shall not be, or be deemed to have been, assignable or transmissible in a case in which as a result of an assignment or transmission there would in the circumstances subsist, or have subsisted, whether under the common law or by registration, exclusive rights in more than one of the persons concerned to the use, in relation to the same goods or description of goods, of trade marks nearly resembling each other or of identical trade marks, if, having regard to the similarity of the goods and of the trade marks, the use of the trade marks in exercise of those rights would be, or have been, likely to deceive or cause confusion:

Provided that, where a trade mark is, or has been, assigned or transmitted in such a case as aforesaid, the assignment or transmission shall not be deemed to be, or to have been, invalid under this subsection if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, or were, having regard to limitations imposed thereon, such as not to be exercisable by two or more of those persons in relation to goods to be sold, or otherwise traded in, within the State (otherwise than for export therefrom) or in relation to goods to be exported to the same market outside the State.

(5) The proprietor of a registered trade mark who proposes to assign it in respect of any goods in respect of which it is registered may submit to the Controller in the prescribed manner a statement of case setting out the circumstances, and the Controller may issue to him a certificate stating whether, having regard to the similarity of the goods and of the trade marks referred to in the case, the proposed assignment of the first-mentioned trade mark would or would not be invalid under subsection (4) of this section, and a certificate so issued shall, unless it is shown that the certificate was obtained by fraud or misrepresentation, be conclusive as to the validity or invalidity under subsection (4) of this section of the assignment in so far as such validity or invalidity depends upon the facts set out in the case, but, as regards a certificate in favour of validity, only if application for the registration under section 33 of this Act of the title of the person becoming entitled is made within six months from the date on which the certificate is issued.

(6) Notwithstanding anything in subsections (1) to (3) of this section, a trade mark shall not, on or after the commencement of this Act, be assignable or transmissible in a case in which as a result of an assignment or transmission thereof there would in the circumstances subsist, whether under the common law or by registration, an exclusive right in one of the persons concerned to the use of the trade mark limited to use in relation to goods to be sold, or otherwise traded in, in a place or places in the State, and an exclusive right in another of those persons to the use of a trade mark

nearly resembling the first-mentioned trade mark or of an identical trade mark in relation to the same goods or description of goods limited to use in relation to goods to be sold, or otherwise traded in, in another place or other places in the State:

Provided that, on application in the prescribed manner by the proprietor of a trade mark who proposes to assign it, or of a person who claims that a trade mark has been transmitted to him or to a predecessor in title of his on or after the commencement of this Act, in any such case, the Controller, if he is satisfied that in all the circumstances the use of the trade mark in exercise of the said rights would not be contrary to the public interest, may approve the assignment or transmission, and an assignment or transmission so approved shall not be deemed to be, or to have been, invalid under this subsection or under subsection (4) of this section, so, however, that in the case of a registered trade mark this provision shall not have effect unless application for the registration under section 33 of this Act of the title of the person becoming entitled is made within six months from the date on which the approval is given or, in the case of a transmission, was made before that date.

(7) Where an assignment in respect of any goods of a trade mark that is at the time of the assignment used in a business in those goods is made, on or after the commencement of this Act, otherwise than in connection with the goodwill of that business, the assignment shall not take effect until, in pursuance of an application made by the assignee in the prescribed manner to the Controller within a period of six months from the date on which the assignment is made (or within such extended period, if any, as the Controller may allow) a notice of the assignment is published in the Journal.

*Certain trade marks to be associated so as to be assignable and transmissible as a whole only*

31. — (1) Trade marks that are registered as, or that are deemed by virtue of this Act to be, associated trade marks shall be assignable and transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate trade marks.

(2) Where a trade mark that is registered, or is the subject of an application for registration, in respect of any goods is identical with another trade mark that is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of the same goods or description of goods, or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Controller may at any time require that the trade marks shall be entered on the register as associated trade marks.

(3) Where a trade mark and any part or parts thereof are, by virtue of subsection (1) of section 29 of this Act, registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trade marks.

(4) All trade marks that are, by virtue of subsection (2) of section 29 of this Act, registered as a series in one registration shall be deemed to be, and shall be registered as, associated trade marks.

(5) On application made in the prescribed manner by the registered proprietor of two or more trade marks registered as associated trade marks, the Controller may dissolve the association as respects any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by another person in relation to any of the goods in respect of which it is registered, and may amend the register accordingly.

*Power of registered proprietor to assign and give receipts*

32. — Subject to this Act, the person for the time being entered in the register as proprietor of a trade mark shall, subject to any rights appearing from the register to be vested in any other person, have power to assign the trade mark, and to give effectual receipts for any consideration for an assignment thereof.

*Registration of assignments and transmissious*

33. — (1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall make application in the prescribed manner to the Controller to register his title, and the Controller shall, on receipt of the application and on proof of title to his satisfaction, register him as the proprietor of the trade mark in respect of the goods in respect of which the assignment or transmission has effect, and shall cause particulars of the assignment or transmission to be entered on the register.

(2) Except for the purposes of an appeal under section 57 of this Act against a decision of the Controller under this section or of an application under section 40 of this Act, a document or instrument in respect of which no entry has been made in the register in accordance with subsection (1) of this section shall not be admitted in evidence in any court of law in proof of the title to a trade mark unless that court otherwise directs.

*Removal from the register and imposition of limitations on ground of non-use*

34. — (1) Subject to section 35 of this Act, a registered trade mark may be taken off the register in respect of any of the goods in respect of which it is registered on application by any person aggrieved to the Court or, at the option of the applicant and subject to section 59 of this Act, to the Controller, on the ground either:

- (a) that the trade mark was registered without any *bona fide* intention on the part of the applicant for registration that it should be used in relation to those goods by him, and that there has in fact been no *bona fide* use of the trade mark in relation to those goods by any proprietor thereof for the time being up to the date one month before the date of the application; or
- (b) that up to the date one month before the date of the application a continuous period of five years or longer

elapsed during which the trade mark was a registered trade mark and during which there was no *bona fide* use thereof in relation to those goods by any proprietor thereof for the time being:

Provided that (except where the applicant has been permitted under subsection (2) of section 20 of this Act to register an identical or nearly resembling trade mark in respect of the goods in question or where the Court or the Controller (as the case may be) is of opinion that he might properly be permitted so to register such a trade mark) the Court or the Controller (as the case may be) may refuse an application made under paragraph (a) or (b) of this subsection in relation to any goods, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, *bona fide* use of the trade mark by any proprietor thereof for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered.

(2) Where in relation to any goods in respect of which a trade mark is registered:

(a) the matters referred to in paragraph (b) of subsection (1) of this section are shown so far as regards non-use of the trade mark in relation to goods to be sold or otherwise traded in, in a particular place in the State (otherwise than for export from the State), or in relation to goods to be exported to a particular market outside the State; and

(b) a person has been permitted under subsection (2) of section 20 of this Act to register an identical or nearly resembling trade mark in respect of those goods under a registration extending to use in relation to goods to be sold, or otherwise traded in, in that place (otherwise than for export from the State), or in relation to goods to be exported to that market, or the Court or the Controller is of opinion that he might properly be permitted so to register such a trade mark;

on application by that person to the Court, or, at the option of the applicant and subject to section 59 of this Act, to the Controller, the Court or the Controller (as the case may be) may impose on the registration of the first-mentioned trade mark such limitations as the Court or the Controller (as the case may be) thinks proper for securing that that registration shall cease to extend to such use as last aforesaid.

(3) An applicant shall not be entitled to rely for the purposes of paragraph (b) of subsection (1), or for the purposes of subsection (2), of this section on any non-use of a trade mark that is shown to have been due to special circumstances in the trade and not to any intention not to use or to abandon the trade mark in relation to the goods to which the application relates.

*Defensive trade marks*

35. — (1) Where a trade mark consisting of an invented word or invented words has become so well known as respects any goods in respect of which it is registered and in relation to which it has been used that the use thereof in relation to other goods would be likely to be taken as indicating a con-

nection in the course of trade between those goods and a person entitled to use the trade mark in relation to the first-mentioned goods, then, notwithstanding that the proprietor registered in respect of the first-mentioned goods does not use or propose to use the trade mark in relation to those other goods and notwithstanding anything in section 34 of this Act, the trade mark may, on the application in the prescribed manner of the proprietor registered in respect of the first-mentioned goods, be registered in his name in respect of those other goods as a defensive trade mark and, while so registered, shall not be liable to be taken off the register in respect of those goods under section 34 of this Act.

(2) The registered proprietor of a trade mark may apply for the registration thereof in respect of any goods as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods as a defensive trade mark, in lieu in each case of the existing registration.

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

(4) On application by any person aggrieved to the Court or, at the option of the applicant and subject to section 59 of this Act, to the Controller, the registration of a trade mark as a defensive trade mark may be cancelled on the ground that the requirements of subsection (1) of this section are no longer satisfied in respect of any goods in respect of which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark, or may be cancelled as respects any goods in respect of which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those goods would be taken as giving the indication mentioned in subsection (1) of this section.

(5) The Controller may at any time cancel the registration as a defensive trade mark of a trade mark of which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trade mark.

(6) Except as otherwise expressly provided in this section, this Act shall apply in respect of the registration of trade marks as defensive trade marks and of trade marks so registered as they apply in other cases.

#### *Registered users*

36. — (1) (a) Subject to this section, a person other than the proprietor of a trade mark may be registered as a registered user thereof in respect of all or any of the goods in respect of which it is registered (otherwise than as a defensive trade mark) and either with or without conditions or restrictions, provided that there subsists a prescribed relationship between the proprietor and the proposed registered user.

(b) The use of a trade mark by a registered user thereof in relation to goods with which he is connected in the course of trade and in respect of which for the time being the trade mark remains registered and he is registered as a registered user, being use such as to comply with any conditions or restrictions to which his registration is subject, is in this Act referred to as the permitted use thereof.

(2) The permitted use of a trade mark shall be deemed to be use by the proprietor thereof, and shall be deemed not to be use by a person other than the proprietor for the purposes of section 34 of this Act and for any other purposes for which such use is material under this Act or at common law.

(3) (a) Subject to any agreement subsisting between the parties, a registered user of a trade mark shall be entitled to call upon the proprietor thereof to take proceedings to prevent infringement thereof, and, if the 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 proprietor, making the proprietor a defendant.

(b) A proprietor so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

(4) Where it is proposed that a person should be registered as a registered user of a trade mark, the proprietor and the proposed registered user must apply in writing to the Controller in the prescribed manner and must furnish him with such documents, information or evidence as may be required under the rules or by the Controller.

(5) When the requirements of subsection (4) of this section have been complied with, if the Controller, after considering the information furnished to him under that subsection, 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 any conditions or restrictions which the Controller thinks proper would not be contrary to the public interest, the Controller may register the proposed registered user as a registered user in respect of the goods as to which he is so satisfied subject as aforesaid.

(6) The Controller shall refuse an application under subsection (4) of this section if it appears to him that the grant thereof would tend to facilitate trafficking in a trade mark.

(7) Without prejudice to section 40 of this Act, the registration of a person as a registered user:

(a) may be varied by the Controller as regards the goods in respect of which, or any conditions or restrictions subject to which, it has effect, on the application in writing in the prescribed manner of the registered proprietor of the trade mark to which the registration relates;

(b) may be cancelled by the Controller on the application in writing in the prescribed manner of the registered proprietor or of the registered user or of any other registered user of the trade mark; or

(c) may be cancelled by the Controller on the application in writing in the prescribed manner of any person on any of the following grounds, that is to say:

- (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 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;
- (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.

(8) Provision shall be made by the rules for the notification of the registration of a person as a registered user to any other registered user of the trade mark, and for the notification of an application under subsection (7) of this section to the registered proprietor and each registered user (not being the applicant) of the trade mark, and for giving to the applicant on such an application, and to all persons to whom such an application is notified and who intervene in the proceedings in accordance with the rules, an opportunity of being heard.

(9) The Controller may at any time cancel the registration of a person as a registered user of a trade mark in respect of any goods in respect of which the trade mark is no longer registered.

(10) Nothing in this section shall confer on a registered user of a trade mark any assignable or transmissible right to the use thereof.

(11) Any person who is registered under this Act as a registered user of a trade mark shall be deemed to have been so registered as of the date of the application for his registration as a registered user.

*Proposed use of trade mark by corporation  
to be constituted*

37.— (1) No application for the registration of a trade mark in respect of any goods shall be refused, nor shall permission for such registration be withheld, on the ground only that it appears that the applicant does not use or propose to use the trade mark:

- (a) if the Court or the Controller (as the case may be) is satisfied that a body corporate is about to be constituted, and that the applicant intends to assign the trade mark to the corporation with a view to the use thereof in relation to those goods by the corporation; or
- (b) if the application is accompanied by an application for the registration of a person as a registered user of the trade mark, and the Court or the Controller (as the case may be) is satisfied that the proprietor intends it to be used by that person in relation to those goods and the Court or the Controller (as the case may be) is also satisfied that that person will be registered as a registered user thereof immediately after the registration of the trade mark.

(2) Section 34 of this Act shall have effect, in relation to a trade mark registered under the power conferred by subsection (1) of this section as if for the reference, in paragraph (a) of subsection (1) of section 34 of this Act, to intention on the part of an applicant for registration that a trade mark should be used by him there were substituted a reference to intention on his part that it should be used by the corporation or registered user concerned.

(3) The Controller or (in the case of an appeal) the Court may, as a condition of the exercise of the power conferred by subsection (1) of this section in favour of an applicant who relies on intention to assign to a corporation as aforesaid, require him to give security for the costs of any proceedings before the Controller or the Court (as the case may be), and in default of such security being duly given may treat the application as abandoned.

(4) Where a trade mark is registered in respect of any goods under the power conferred by subsection (1) of this section in the name of an applicant who relies on intention to assign to a corporation as aforesaid, then, unless within such period as may be prescribed, or within such further period not exceeding six months as the Controller may on application being made to him in the prescribed manner allow, the corporation has been registered as the proprietor of the trade mark in respect of those goods, the registration shall cease to have effect in respect thereof at the expiration of that period, and the Controller shall amend the register accordingly.

*Use of one of associated or substantially identical  
trade marks equivalent to use of another*

38.— (1) Where under this Act use of a registered trade mark is required to be proved for any purpose, the Court or the Controller (as the case may be) may accept use of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, was an equivalent for the use required to be proved.

(2) The use of the whole of a registered trade mark shall for the purposes of this Act be deemed to be also a use of any registered trade mark, being a part thereof, registered in the name of the same proprietor by virtue of subsection (1) of section 29 of this Act.

*Use of trade mark for export trade*

39.— The application in the State of a trade mark to goods to be exported from the State, and any other act done in the State in relation to goods to be so exported which, if done in relation to goods to be sold or otherwise traded in within the State, would constitute use of a trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods for any purpose for which such use is material under this Act or at common law.

*General power to rectify entries in register*

40.— (1) Any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry

wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the Court or, at the option of the applicant and subject to section 59 of this Act, to the Controller, and the Court or the Controller (as the case may be) may make such order for making, expunging or varying the entry as the Court or the Controller (as the case may be) may think fit.

(2) The Court or the Controller (as the case may be) may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register.

(3) In case of fraud in the registration, assignment or transmission of a registered trade mark, or in any other case in which he considers it to be necessary in the public interest, the Controller may himself apply to the Court under this section.

(4) Any order of the Court rectifying the register shall direct that notice of the rectification shall be served in the prescribed manner on the Controller, and the Controller shall on receipt of the notice rectify the register accordingly.

(5) The power to rectify the register conferred by this section shall include power to remove a registration in Part A of the register to Part B.

*Power to expunge or vary registration for breach of condition*

41. — On application by any person aggrieved to the Court or, at the option of the applicant and subject to section 59 of this Act, to the Controller or on application by the Controller to the Court, the Court or the Controller (as the case may be) may make such order as the Court or the Controller (as the case may be) may think fit for expunging or varying the registration of a trade mark on the ground of any contravention of, or failure to observe, a condition entered on the register in relation thereto.

*Correction of register*

42. — (1) The Controller may, on request made in the prescribed manner by the registered proprietor:

- (a) correct any error in the name, address or description of the registered proprietor of a trade mark;
- (b) enter any change in the name, address or description of the person who is registered as proprietor of a trade mark;
- (c) cancel the entry of a trade mark on the register;
- (d) amend the specification of the goods in respect of which a trade mark is registered, provided that the amendment does not in any way extend the rights given by the existing registration of the trade mark; or
- (e) enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of the trade mark.

(2) The Controller may, on request made in the prescribed manner by a registered user of a trade mark, correct any error, or enter any change, in the name, address or description of the registered user.

(3) The Controller may, of his own motion, after having given the prescribed notice, correct any error made by him in any entry on the register.

*Alteration of registered trade mark*

43. — (1) The registered proprietor of a trade mark may apply in the prescribed manner to the Controller for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the Controller may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.

(2) The Controller may cause an application under this section to be advertised in the prescribed manner in any case where it appears to him that it is expedient so to do and, where he does so, if within the prescribed time from the date of the advertisement any person gives notice to the Controller in the prescribed manner of opposition to the application, the Controller shall, after hearing the parties if so required, decide the matter.

(3) Where leave as aforesaid is granted, the trade mark as altered shall be advertised in the prescribed manner, unless it has already been advertised, in the form to which it has been altered, in an advertisement under subsection (2) of this section.

*Adaptation of entries in register to amended or substituted classification of goods*

44. — (1) The Minister may from time to time make such rules, prescribe such forms and generally do such things as he thinks expedient, for empowering the Controller to amend the register, whether by making or expunging or varying entries therein, so far as may be requisite for the purpose of adapting the designation therein of the goods or classes of goods in respect of which trade marks are registered to any amended or substituted classification that may be prescribed.

(2) The Controller shall not, in exercise of any power conferred on him for the purpose aforesaid, make any amendment of the register that would have the effect of adding any goods or classes of goods to those in respect of which a trade mark is registered (whether in one or more classes) immediately before the amendment is to be made, or of antedating the registration of a trade mark in respect of any goods:

Provided that this subsection shall not have effect in relation to goods as to which the Controller is satisfied that compliance with this subsection in relation thereto would involve undue complexity and that the addition or antedating, as the case may be, would not affect any substantial quantity of goods and would not substantially prejudice the rights of any person.

(3) A proposal for the amendment of the register for the purpose aforesaid shall be notified to the registered proprietor of the trade mark affected, shall be advertised with any modifications, and may be opposed before the Controller by any person aggrieved on the ground that the proposed amendment contravenes subsection (2) of this section.

(To be continued)

# GENERAL STUDIES

## **International Patenting and the « Draft Convention relating to a European Patent Law »<sup>1)</sup>**

By Ralph Christopher NOYES  
(a Fellow of the Chartered Institute of Patent Agents, London)



**The Bond between the Convention relating  
to a European Patent Law and the Rome Treaty**

By C. M. R. DAVIDSON, The Hague





## CONGRESSES AND MEETINGS

### XXV<sup>th</sup> Congress of the International Association for the Protection of Industrial Property

The XXV<sup>th</sup> Congress of the International Association for the Protection of Industrial Property was held in West Berlin from the 3<sup>rd</sup> to 8<sup>th</sup> June, 1963, and brought together 1600 participants from 41 countries. In addition, there were official representatives from the Industrial Property Administrations of 17 countries.

The International Bureau was represented by its Director, Professor G. H. C. Bodenhausen, and one of its Counsellors, Mr. Ross Woodley, Head of the Industrial Property Division.

The Congress was formally opened in the Congress Hall when Addresses were given by Herr Peter v. Siemens, President of IAPIP, Herr H. G. Heine, President of the German Group of IAPIP, Herr Ewald Bucher, Minister of Justice of the Federal Republic of Germany, Professor Bodenhausen and Herr Wolfgang Kirsch, Senator for Justice of the West Berlin Senate. The Addresses were preceded and followed by a delightful concert by the Radio Symphony Orchestra of Berlin under the Direction of Hans v. Benda.

In his Address, Professor Bodenhausen said:

Mr. President,  
Your Excellency,  
Ladies and Gentlemen,

You will allow me, in officially addressing this Congress on behalf of the International Bureau for the Protection of Industrial Property in Geneva, to speak one of the official languages of this Bureau. The English language has the advantage of being almost universally understood and its use may thus symbolise our efforts towards international cooperation and understanding.

At congresses of IAPIP it has been the custom for the Director of the International Bureau in Geneva, or his representative, to report on the "State of the Union", that is to say, our basic international treaty: the Union of Paris for the Protection of Industrial Property. I should like to depart from this custom in so far as I shall only mention a few facts concerning the present situation of the Union and ask more of your attention for future developments.

The present situation is that our Union now comprises 52 Member States in all parts of the world. The last country to enter is the newly independent African State of Tanganyika. We cordially welcome this new member in our Union and hope that its adherence will be one of the first of a long series of similar acts by other States, so far non-members of the Union, in Africa and elsewhere. I shall come back to this point in a minute.

With respect to the future of the Union, the Secretary of the German Group of IAPIP, Mr. Moser von Filseck, who not only holds this position, but is also a specialist of inter-

national reputation in the field of industrial property, has in a recent and interesting article expressed the opinion that the Union has been forced into a defensive position (“*eine Abwehrstellung*”).

This is no doubt true to some extent, for instance, where customary practices in the exploitation of patents and trade marks and traditional patterns of behaviour in commercial competition are subject to attacks in the name of national and international antitrust regulations. This is one of the important subjects this Congress will discuss.

A possibly defensive position of our Union exists also with respect to a resolution, adopted 18 months ago by the General Assembly of the United Nations under the title “The role of patents in the transfer of technology to under-developed countries”. This Resolution has requested a report of the Secretary-General of the United Nations concerning *inter alia* the advisability of holding an international conference in order to examine the problems regarding the granting, protection and use of patents, taking into consideration the provisions of existing international conventions and the special needs of developing countries, and utilising the existing machinery of the International Union for the Protection of Industrial Property.

Whatever the merits of this Resolution and wherever it may lead, it has had at least the salutary effect of causing action in the Paris Union. Its Bureau fully realised the fact that there are other intergovernmental organisations which may deal with matters of international cooperation in the field of industrial property and that countries outside the Paris Union may also have thoughts about the ways in which industrial property should, or should not be, internationally protected.

The Geneva Bureau is now in close contact with the New York Secretariat of the United Nations: some of the studies called for in the Resolution have been carried out by us and we continue to collaborate on the whole subject.

Nevertheless, these problems and others, to which I shall refer later, seem to call for a reappraisal of the tasks of the Geneva Bureau and of IAPIP, and of the ways and means of our cooperation.

The traditional common field where IAPIP and the Geneva Bureau worked together was the preparation of revisions of the Paris Union and of the special Arrangements belonging to it. However, those of you who have participated in the latest revision conferences of the Union and the Arrangements, in Nice in 1957, in Lisbon in 1958 and at The Hague in 1960 — and perhaps also those of you who followed these conferences from afar and therefore may have an even better perspective than the actual participants — will probably agree that in most matters of substantive law our Conventions have reached a point beyond which one could not go without splitting the Union into factions. The social and economic conditions of our member States are so different — think of the United States and Bulgaria, or the Dominican Republic, or of our newest member, Tanganyika and our host country here, Germany — that it is remarkable that our Union still coheres as it does. Further refinements may endanger this coherence and would possibly frighten away po-

tential new members. These refinements will probably better be sought by way of special Arrangements under the mother Convention.

There remain with respect to matters of substantive law a number of interesting questions to discuss: the programme of this Congress shows this clearly. But the next Conference of revision or addition to our Unions, which would deal with these questions, is still far away.

This is probably one of the reasons why the programme of IAPIP has been directed to a large extent to studies of the possibilities of harmonizing national legislation in our field. Here also very interesting questions are to be studied and, although experience shows that harmonization of national legislations will not easily be achieved without strong economic pressure or common political goals, it will be a good thing to be prepared whenever and wherever these circumstances arise.

However, in my view, more attention than hitherto should be directed to new subjects, for which the cooperation of IAPIP with the International Bureau of Geneva would also be extremely valuable.

Let me briefly mention 4 of these subjects:

(a) The improvement of the situation as to industrial property in newly independent, industrially and commercially less developed countries, should be considered one of our main tasks in the near future. These countries should be helped in understanding their problems and be advised on what to do about them.

Apart from the collaboration with the United Nations in this field, the International Bureau in Geneva has organised in August of this year a Seminar on industrial property in Brazzaville (Congo) and in October, a special Committee of Experts in Geneva to examine these problems. Furthermore, we are trying to organise programmes in which trainees (*stagiaires*) coming from less developed countries, would work, each for several months, in patent and trade mark offices of more developed countries, in order to acquire experience in this field of administration, or to improve the experience they already have. Other measures to the same end will follow.

(b) These measures, however, will not be sufficient to tackle the problem of territorial expansion of the Union. The territory now covered by the Union leaves important gaps, not only among the newly independent States in Africa and Asia, but also among the long established States in Central and South America. One of the most important tasks in our field of interest would seem to be to convince these countries where their real interests are and that in joining the Union they would not only improve the situation of their own nationals, such as inventors, commercial enterprises, etc., but also create the appropriate climate for investments on their territories by licence-contracts from more developed countries, which investments seem to be ardently desired. With respect to these problems, both the International Bureau in Geneva and IAPIP seem to have done far too little in the past and a common effort to recover opportunities, which have been neglected, seems highly desirable.

(c) Another subject, which may seem to interest IAPIP less obviously but which will be of paramount importance for the further development of the international protection of industrial property, is the necessity for modernizing the International Bureau of Geneva and the administrative structure of our Conventions. This calls for a Diplomatic Conference, which is scheduled for 1967 in Stockholm. The preparations for this Conference have already started and in the meantime an enormous work is already being done in our Bureau to modernize its organisation, its finances and its process of policy making on the present basis. The ultimate goal will be to transform our 80 years old Bureau, working now under the control of the Swiss Government as Supervisory Authority, into a modern international secretariat, responsible to a General Assembly of all member States of our Union and more particularly to an Administrative Council, elected by these States. An organisation of this type, an "International Intellectual Property Organisation", could then be admitted by the United Nations as a specialised agency on the same basis as, for instance, the International Labour Organisation or the World Health Organisation. This would greatly improve our international position and facilitate our task in many respects.

(d) The last subject I will mention in this context is the centralisation of studies of international protection of industrial property on the intergovernmental level. Until today — the very valuable reports of the Engi Committee to the Congresses and Meetings of IAPIP show this abundantly — many tasks in this field were undertaken by all kinds of international bodies, not all ideally equipped to deal with these problems. As could be predicted, the results were frequently confusion, waste of time and energy, and projects of very doubtful value. It is my firm belief that studies of this kind, unless they clearly are of regional interest, should be concentrated as much as possible in the International Bureau of Geneva. This Bureau is created and equipped to render these services and is, in fact, the only truly international intergovernmental body whose sole function is to safeguard and develop the protection of industrial property.

The new tasks I have mentioned are far from easy. They will sometimes require working methods different from those used in the past. This is doubtless also true for IAPIP, if it wishes to continue the fruitful assistance it has always given to the International Bureau.

This brings me to the conclusion of my remarks.

It is my earnest wish that we should not, in the field of international protection of industrial property, be afraid of the future. Neither should we consider ourselves too much in a defensive position. On the contrary, many positive tasks of great importance are lying right before us. But we shall have to unite our efforts and not disperse them. This is why I appeal to IAPIP and ask its full cooperation in the difficult problems we have to solve. And in doing so I wish IAPIP the best of success in this Congress.

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The Congress included a number of social functions which fully maintained the high standard which one associates with IAPIP Congresses. These comprised a Reception by the Berlin Senate after the formal Opening of the Congress, a Reception by the Government of the Federal Republic of Germany at Charlottenburg Castle, a brilliant performance of "Salome" in the magnificent Opera House, an Open Air Luncheon at Schildhorn followed by a tour of the Havel Lake by boat, and finally the splendid Closing Banquet at the Palais "Am Funkturm" which was followed by dancing far into the morning.

No description of this Congress would be complete without an appreciation of the admirable qualities of the Congress Hall itself. Modern in style, it brought to the Congress all the advantages of this age — comfort, space and, above all, an excellent system of interpretation and amplification.

The sincere thanks of all the participants are due to the Organising Committee and the German Group of IAPIP for the great effort which must have been put into this undertaking.

At the close of the Conference, Mr. Nakamatsu, on behalf of the Japanese Group, tendered an invitation to the Association to hold its 1966 Congress in Japan.

In the course of the Congress Dr. Rudolf Blum was confirmed in his appointment as Secretary-General in succession to his father, the late Mr. Eugen Blum.

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The work of the Congress was conducted in six Sessions under the Chairmanship of Mr. M. Ashley (United States), Mr. W. Hamburger (Austria), M. G. Marconnet (France), Professor P. J. Pointet (Switzerland), Mr. C. Robinson, Q. C. (Canada), and Mr. G. W. Tookey, Q. C. (United Kingdom). These Working Sessions were very well attended and gave rise to much valuable discussion resulting in the following Resolutions.

#### QUESTION 37 B

##### **Incidence on the rights of industrial property of the national or international provisions guaranteeing free competition**

The Congress adopts the following resolution:

I. — The normal exercise of rights of industrial property is legitimate and is not to be hampered by regulations ensuring freedom of competition.

In effect, the Congress expresses its conviction that the protection of industrial property is an essential means of favouring progress, since the exclusive right of industrial property stimulates research and encourages investment needed for technical development.

II. — Regulations ensuring freedom of competition are only to be decided against:

- clauses not related to the exercise of industrial property rights and not justified by the exercise of such rights, in particular the guarantee required by the licensee,
- or clauses connected with manifest abuse.

In effect any restrictions in a contract in the working of a licence are not to constitute a limitation of competition for example

- in a case where such restrictions relate to activities which the licensee could not undertake without a licence,
- in a case where these restrictions forbid activities to the licensee which he would not have had the right to undertake consistently with the contractual implications of the licence.

The Congress decides to keep the question on the Association's agenda so as to watch progress and express a view when circumstances may bring cases to its notice.

#### QUESTION 39 B

##### Reasons for which the rights of patentees can be restricted

The Congress:

asserts that the fact of making patent rights subject to restrictions not strictly required by the public interest would undermine the very reasons for which a system of patent protection has been created,

and decides to continue the study of the reasons for which the rights of the patentee can be made subject to restrictions.

#### QUESTION 29 A

##### Trade marks or names with extended protection

The Congress expresses the wish that protection be afforded for trade marks or service marks, against use or registration by third parties, even in respect of different goods or services,

- when such marks, even if they are not used in the country where protection is sought, are regarded as enjoying a high reputation, either in that country or internationally;
- and when such registration or such use is liable to mislead the public or be harmful to the proprietor of the mark.

*Note.* — The question of the extended protection of a trade name will be considered later as part of the proposed study by the IAPIP on protection of trade names.

#### QUESTION 25 A

##### Cancellation of the registration of a trade mark at any time upon proof of abandonment

The Congress believes that there is no need to insert any exception in Article 5 C (1) providing that the registration of a mark may be cancelled, without waiting for any time limit to expire, when the mark has been abandoned by its proprietor.

#### QUESTION 35 B

##### Studies on the unification of the patent laws Establishing of patentable inventions and conditions of patentability

The Congress, with the object of achieving harmonisation of patent laws adopts the following resolution:

I. — Protection by patent aims at granting an inventor, for a limited period, an exclusive right to his invention.

This grant of an exclusive right is justified:

- by the general interest which requires the publication of inventions;
- in the interest of progress;
- by the reward due to the inventor.

II. — (1) In principle, all inventions which can be used in the field of industry are capable of being protected by the grant of a patent.

This is the case, in particular, with processes, machines, industrial products, substances, varieties of plants.

(2) An invention is patentable provided:

(a) it is capable of being applied industrially.

By "Capable of being applied industrially" is meant an invention the embodiment of which can be manufactured or used in any of the industries defined in Article 1 (3) of the Convention (which includes agriculture);

(b) it is novel.

An invention is regarded as devoid of novelty when it is contained in the prior art.

The prior art comprises all that has been accessible to the public prior to the date of filing of a national application or of a foreign application on which a priority is based, through a written or oral description, through use or in any other manner.

It is emphasised that formal proof must be required as to the contents and the date of oral publication;

(c) it constitutes an invention.

For example, there cannot be invention if the subject of the patent is obvious having regard to the state of the art.

III. — A patent application must contain, in addition to the description and any drawings which are necessary, one or more claims defining the subject of the protection applied for. The scope of the protection conferred by a patent is determined by the contents of the claims. However, the description and the drawings shall serve to interpret the claims.

The claims are to be construed independently of one another as regards validity.

#### QUESTION 40 B

##### Employees' inventions

The Congress decides to continue the study of the respective rights of employers and employees in respect of inventions:

- on the basis of the Synthesis prepared for the Berlin Congress;
- taking also account of points made during the Congress meeting.

#### QUESTION 38 B

##### The problem of exhibitions

The Congress expresses the wish that Article 11 of the Union Convention be replaced by the following:

“The countries of the Union undertake that the validity of a patent, utility model, or design or industrial model, shall not be hindered by publication occurring in an international exhibition organised in the territory of one of such countries, prior to the filing of an application for protection, provided that the first filing be made within six months from the date of the opening of the exhibition.”

#### QUESTION 23 B

##### Study on the unification of the trade mark law

The Congress, with a view to bringing the law of marks into harmony, adopts the following principles:

I. — A mark is a sign capable of distinguishing the products or services of a person or of a group of persons.

The distinctive character of a mark, in respect of the goods or services designated by it, arises from the nature of the sign or of the use which has been made of it.

II. — The following signs are capable of constituting marks, on the sole condition that they be inherently distinctive or have become distinctive for the products or services which they designate:

- (1) words or collections of words, whether invented or not, including the titles of daily or periodical publications, the titles of collections of works, slogans;
- (2) letters;
- (3) numerals;
- (4) devices including for example signatures, portraits, drawings, pictures and insignia, emblems and monograms;
- (5) the names of persons including surnames (family names), given names and pseudonyms, as well as characteristic parts or abbreviations of trade names;
- (6) the form or any other presentation of products, or their containers and their packages on condition that they should not be exclusively functional in nature;
- (7) colours in combination with signs;
- (8) combinations of colours;
- (9) any combination of signs enumerated above.

*Observations:* The list merely gives examples and is not limiting.

The Congress decides to continue studying points III and IV:

- acquisition of rights in a mark;
- incontestability of marks.

#### QUESTION 32 A

##### Translation of trade marks

The Congress expresses the wish that the following new provision be inserted in the Union Convention:

(a) The countries of the Union will, subject to the provisions of Article 6 of the Convention, allow a mark and translations thereof to be filed and registered in a single act. On the basis of such a registration the mark will acquire full protection in each of the languages in which it has been registered. Such a mark cannot be cancelled for the reason

that it is used only in its original form or in one of its translations.

(b) The foregoing provision applies also to the transcription of a mark into the types of print applicable to other languages or to its phonetic equivalent.

(c) The only priority which may be claimed in respect of a registration of the kind contemplated in (a) and (b) above, is that of a first filing comprising the mark along with translations thereof or transcriptions in the languages of the various countries concerned.

#### QUESTION 34 A

##### Study on the unification of the law on industrial designs and models

The Congress considering that this question requires further study remits it to the Executive Committee for consideration.

At the final Session of the Congress, the following Resolution was proposed by Mr. Peter Siemsen (Brazil) and received by the Congress with acclamation:

The participants of the American countries to the XXV<sup>th</sup> Congress of the IAPIP in a meeting held on this occasion have decided the following:

- (1) to promote the formation of national groups of the IAPIP in each of the Central and South American countries where such groups do not yet exist;
- (2) that these national groups study the matter of the adherence of the respective countries to the Paris Convention in those cases where such situation does not as yet exist and that they should recommend to their Governments, whatever they deem relevant on the subject, bearing in mind the unanimous wish expressed by the said participants to the effect that all the Americas form part of this Convention, which has functioned to everybody's satisfaction for many years and which has been adopted by so many countries;
- (3) to communicate the above to the Congress so that it be duly recorded and receive its support.

\* \* \*

During the week preceding the Congress the Presidents of National Groups of IAPIP devoted three days to an intensive study of the Draft Convention for a European Patent Law. Their views were embodied in a Report by the Rapporteur-Général, M. Paul Mathély, which was presented to the Congress. At this meeting the International Bureau was represented by its Vice-Director, M. Ch.-L. Magnin.

## BOOK REVIEW

**Licenças e Royalties no Brasil** (Licences and Royalties in Brazil), by *Alexandre Gnocchi*. One volume of XII-392 pages, 22 × 14 cm. Published by Oficinas da Empresa Gráfica da "Revista dos Tribunais", 38, Rua Conde de Sarzedas, São Paulo, 1960.

It should first be noted that this work is no ordinary text-book which merely describes, without much colour, the legal practice in Brazil relating to licencing contracts. The reading of this study immediately reveals quite a different element. In the first lines of his preface, the author makes a point of clearly stating the spirit with which he has undertaken this work; this study, the first of a series devoted to industrial property, is the result of long experience; "we have attempted to set out herein ideas which have matured over the past thirty-five years of practice". Each page confirms the depth of thought which takes into consideration national interests in a constant aim to combine the solution with the criticism. The analysis is dynamic and even aggressive and the writer's evidence goes beyond a mere compilation.

If the subject of licences requires a vast amount of specialised knowledge, it nevertheless covers a very vast field, a number of essential elements of which overstep the bounds of criteria and reasoning of a purely legal nature. The practice and the legislation relating to licences are superimposed and interwoven and meet requirements of a social and of a political nature.

M. Gnocchi is not unaware of this interdependence. On the contrary, he continually draws our attention to it. The dominating thought which inspires and appears throughout this study is the necessity firmly to enframe the licence and its effects in a competent institutional body in order that the practice should develop fairly and in harmony with the interests of national economy.

This economy is that of an under-developed country and this fact should be ever present in the mind of the reader of this study. Brazil is a gigantic State possessing potential resources which are as yet far from being turned to the full advantage of its inhabitants and the country is experiencing the difficult process of an industrialisation, the harmonious development of which runs up against a multiplicity of obstacles circumstantial and structural. Such obstacles arise in both the national and international contexts.

A proper study of the problems connected with industrial property could not therefore take refuge in a kind of legal abstraction which would not take into consideration the true existence of such an infrastructure.

The experienced reader may find in M. Gnocchi's study certain points to criticise, but he will not, however, be able to question the fundamental views on which the work is based. Nor does the study attempt to avoid controversies. Each subject is submitted to a close analysis. Moreover, the reader is often invited to study the legislation, writings and case law of different countries. Such comparison is aimed at more clearly defining Brazilian practice and the solutions which the author personally defends.

Furthermore, it should be recognised that the general subject of the study is not lacking in problems which can easily give rise to controversial discussion. Some of the subjects to which particular attention is drawn are, for instance, the burden of licences on Brazilian economy, the increasing importance of licencing contracts as an instrument for international exchanges, the indispensable intervention of the State, the method of controlling royalties, and the different types of licencing contracts, their respective advantages and drawbacks, seen in the light of national requirements.

This simple enumeration already gives an idea of the degree of interest which will be found in M. Gnocchi's book. It should be added that the analysis is further completed by an interesting documentation, and in particular by the addition of two significant annexes relating to licences for trade marks and patents registered by the national Department of Industrial Property between 1946 and April, 1960.

Throughout this closely and concisely written study, which always remains personal, the author develops a general and coherent conception of the many problems connected with licencing contracts. He expounds his opinion in the form of a lively discussion which does not always follow the form of an inflexible statement, but is systematically divided on the two-fold basis under which all the questions are debated — a critical sense to which is added a constructive approach which is both a guide and an indispensable corollary.

The legislation and the Governmental organs are closely examined and submitted to severe judgment. Fraud is strongly denounced, the menace represented by improper practices or merely contrary to the vital interests of Brazilian economy being favoured by the imperfections of the national institutions. Over and above these, a sense of strengthened international solidarity, a more effective legal framework because "we feel that the protection of the inventor, on an international level, requires to be extensive, better understood and more adequately applied", and an economic system in which the licencing contract "straight forwardly applied, will greatly contribute towards progress in the less industrially-developed countries" are advocated.

The concern of the citizen over the future prospects of his country never, in fact, lead to the profession of faith of an uncompromising nationalist. M. Gnocchi is a supporter of wide international exchanges provided such exchanges are judiciously controlled by the competent governmental authorities and include effective, concrete advantages for Brazilian industry. Contractual freedom must give way to a planned degree of State control more concerned with national interests. Pure liberalism is, in effect, not the ideal path for an under-developed country. "To exploit fairly in Brazil, yes. But to exploit Brazil itself, no." This is the key phrase of a vision, open to the outside world, but which is not prepared to neglect the realities and needs of Brazil itself.

The simple but plain figures speak the unvarnished truth and clearly depict the situation; in three years, from 1955 to 1957, the increase in licences has cost Brazil 821 million dollars paid in royalties for contracts acquired from foreign countries! This sum "extraordinary and alarming" is referred to on several occasions. Indeed, it is alarming, as a considerable proportion of these millions flow from a practice which disregards the elementary needs of a healthy economy.

In the mean time, the author draws attention, not without obvious relief, to legislative provisions enforced in 1958 and which "represent a first reaction to the confusion prevailing in licencing contracts". The former law, relating to taxation on revenues, fixed no limit to royalties, which thereby avoided taxation. According to the new regulations, the maximum percentages payable for royalties are determined according to the importance of the different productive industries. It should be noted here that the selective criterium of industrial policy which inspired the new legislation no doubt represents one of the more interesting features in the legislations of under-developed countries.

What still remains to be accomplished, clarified, corrected and made good, still covers a vast field in which M. Gnocchi takes up a number of view points.

The best of conclusions is found at the end of the study — draft provisions for licences in Brazil, the articles of which embody the essential ideas upheld by the author. The main pillar of such regulations is the establishment of a "Federal Licencing Council", the authority of which would even extend over the Industrial Property Department. All licencing contracts, including the fixing of royalties, would be null and void without the prior approval of this Council. This body would exercise a severe control over licencing contracts, both national and international and would exact and canalise such royalties paid in respect of trade mark or patent licences declared invalid, towards a special "Assistance Fund for Inventors".

M. Gnocchi does not claim that his draft plan is without flaws. He invites the reader to discuss and to criticise in order to achieve the "objective in view" which is that the licence should become of a truly technical value among the multiple needs of a country which must mobilise all its vitality in order to overcome the trials of under-development.

