

# Industrial Property

Monthly Review of the United International Bureaux  
for the Protection of Intellectual Property (BIRPI)  
Geneva

3<sup>rd</sup> Year

No. 11

November 1964

---

## Contents

	Pages
<b>INTERNATIONAL UNION</b>	
Interunion Coordination Committee. Second Session (Geneva, September 28 to October 2, 1964) . . . . .	231
Conference of Representatives of the International Union for the Protection of Industrial Property (First Session, Geneva, 1964) . . . . .	233
Committee of Experts to Study a Model Law for Developing Countries on Inventions and Technical Know-How (Geneva, October 19 to 23, 1964) . . . . .	235
<b>LEGISLATION</b>	
Ireland. Patents Act, 1964 (of June 24, 1964), <i>Third Part</i> . . . . .	238
<b>CORRESPONDENCE</b>	
Letter from France (Paul Mathély), <i>First Part</i> . . . . .	245
<b>BOOK REVIEWS</b>	
La protection des marques de haute renommée au regard du droit suisse, by Michel Jatton . . . . .	251
Garantie et responsabilité contractuelles en droit des brevets d'invention, by Jacques Wittmer . . . . .	251
<b>NEWS ITEMS</b>	
Japan. Appointment of new Director-General of the Patent Office . . . . .	251
Calendar of BIRPI Meetings . . . . .	252
Meetings of other International Organizations concerned with Intellectual Property . . . . .	252



# INTERNATIONAL UNION

## Interunion Coordination Committee

### Second Session

(Geneva, September 28 to October 2, 1964)

### Report <sup>1)</sup>

#### Composition, etc.

The second ordinary session of the Interunion Coordination Committee (a body consisting of the Member States of the Permanent Bureau of the Paris Union and the Permanent Committee of the Berne Union) met at Geneva from September 28 to October 2, 1964<sup>2)</sup>.

The following twenty States were invited as members of the Committee: Belgium, Brazil, Czechoslovak Socialist Republic, Denmark, France, Federal Republic of Germany, Hungarian People's Republic, India, Italy, Japan, Morocco, Netherlands, Portugal, Rumanian People's Republic, Spain, Sweden, Switzerland, United Kingdom of Great Britain and Northern Ireland, United States of America, Socialist Federal People's Republic of Yugoslavia. All of these States except Brazil and Morocco were represented.

All the States Members of the International Union for the Protection of Industrial Property (Paris Union) and of the International Union for the Protection of Literary and Artistic Works (Berne Union) which are not already members of the Committee had been invited to be represented by observers. The following States were represented at the session by observers: Austria, People's Republic of Bulgaria, Ceylon, Israel, Mexico, Polish People's Republic, Turkey.

A list of participants is annexed to this report.

The following were elected as officers: Chairman, Mr. I. Anghel (Rumanian People's Republic); Vice-Chairmen, Mr. E. J. Brenner (United States of America) and Mr. M. Bordonaü (Spain). Dr. Arpad Bogsch (Deputy Director, BIRPI) was designated as Secretary of the Committee.

#### Report on the Activities of BIRPI

Professor G. H. C. Bodenhausen, Director of BIRPI, presented a report on the activities of BIRPI since the last session of the Committee, that is, in respect of a period of approximately eleven months.

Among other events, the Director mentioned the following:

- the accessions of Senegal, Nigeria, Cameroon and Trinidad and Tobago to the Paris Convention, and the accession of Cyprus to the Berne Convention;
- the drawing up, by a committee of experts which met in May 1964, of a draft Convention for the establishment of the World Intellectual Property Organization;

<sup>1)</sup> The present report has been prepared by BIRPI on the basis of the official documents of the Interunion Coordination Committee.

<sup>2)</sup> The report of the first session was published in *Industrial Property*, 1964, page 7.

- the resolutions of the United Nations Conference on Trade and Development and the Economic and Social Council of the United Nations concerning the transfer of technology to developing countries, as well as collaboration between the United Nations and BIRPI in these matters;
- the Bogotá Conference for Latin America on Industrial Property, organized in July 1964 by BIRPI and the Colombian Government;
- the drawing up by BIRPI of a draft model law on the protection of inventions and know-how, a draft prepared for the use of developing countries;
- fellowships offered by BIRPI for the training of Government officers who are or will be in charge of the administration of industrial property in developing countries;
- the Study Group, which, on the invitation of BIRPI, and with the participation of the Soviet Union, studied, in January 1964, the question of inventors' certificates;
- the eleventh session of the Permanent Committee of the Berne Union which met at New Delhi in December 1963.

The Committee noted and unanimously approved the report of the Director of BIRPI.

#### Financial Report for the Year 1963

This report constituted a supplement to the Management Report of 1963 and gave details concerning the settlement of accounts of the various Unions administered by BIRPI, an operation which was carried out according to the advice given by the Committee at its previous session.

The Committee noted and approved this report.

#### Financial Rules

The Director submitted to the Committee for advice a draft of the Financial Rules to be promulgated in implementation of the Financial Regulations. The Committee endorsed this draft which in the meantime has been promulgated by the Director.

#### Staff Matters

The Committee examined several questions concerning the staff of BIRPI. Among other things, it noted with satisfaction the progress made towards ensuring better geographical distribution in the recruitment of the staff.

On a proposal made by the Director of BIRPI, the Committee decided to recommend the Supervisory Authority to suspend the application of the Staff Regulations concerning the retirement age in the case of Mr. Charles-L. Magnin, Deputy Director, and to keep him in active service until the end of 1966.

#### Program and Budget of BIRPI for 1965

The main objectives of the 1965 program are: better service to Governments, an increase in the number of Member States, closer cooperation with the United Nations, and technical and legal assistance to developing countries.

The budgets will generally remain the same as in 1964 as far as the Paris, Madrid, The Hague and Nice Unions are concerned. As far as the Berne Union is concerned, an increase in the ceiling of the contributions of the Member States

will be requested. In this latter respect, the Committee, approving the proposals of the Director, expressed the view that the Swiss Government ought to address to the Member States of the Berne Union a circular letter inviting them to contribute to the expenses of the Union on the basis of a yearly ceiling of 700,000 Swiss francs. (The present ceiling is 400,000 Swiss francs.)

As to the other proposals concerning the program and budget, the Committee also expressed a favorable view and recommended the Supervisory Authority to approve them in the form in which they were presented by the Director.

#### Change in the Composition of the Committee

In view of the fact that the Permanent Bureau of the Consultative Committee of the Paris Union has been replaced by the Executive Committee of the Conference of Representatives of the Paris Union, the Interunion Coordination Committee will henceforth consist of the Member States of the Executive Committee (rather than the Permanent Bureau) of the Paris Union and of the Permanent Committee of the Berne Union.

### List of Participants

#### I. States Members of the Committee

##### *Belgium*

- Mr. Pierre Recht, Chairman of the National Copyright Commission, Brussels.  
Mr. Gérard-Louis de San, Director-General, Legal Counselor to the Ministry of National Education and Culture, Brussels.

##### *Czechoslovak Socialist Republic*

- Mr. Jaroslav Němeček, President, Patent Office, Prague.  
Dr. Radko Fajfr, First Secretary, Ministry of Foreign Affairs, Prague.  
Dr. Jiří Kordač, Counsellor, Legislative Division, Ministry of Education and Culture, Prague.  
Dr. Otto Kunz, Maître de recherches, Czechoslovak Academy of Sciences, Prague.

##### *Denmark*

- Mr. Torben Lund, Professor, University of Aarhus, Risskov.

##### *France*

- Mr. Guillaume Finmiss, Inspector-General of Industry and Commerce, Director, National Institute of Industrial Property, Paris.  
Mr. Roger Labry, Counsellor of Embassy, Ministry of Foreign Affairs, Paris.  
Mr. Charles Rohmer, Head, Copyright Service, Ministry of Cultural Affairs, Paris.  
Mr. Marcel Pierre, Civil Administrator, National Institute of Industrial Property, Paris.

##### *Germany (Federal Republic of)*

- Mr. Kurt Haertel, President, Deutsches Patentamt, Munich.  
Mr. Dirk Rogge, Landgerichtsrat, Federal Ministry of Justice, Bonn.  
Mr. Albrecht Krieger, Regierungsdirektor, Federal Ministry of Justice, Bonn.

- Mr. Peter Schönfeld, Consul, Permanent Delegation of the Federal Republic of Germany to International Organizations, Geneva.

##### *Hungarian People's Republic*

- Mr. András Kiss, Vice-President, Patent Office, Budapest.  
Mr. Georges Pálos, Legal Adviser, Patent Office, Budapest.

##### *India*

- Mr. S. Vatsa Purushottam, Consul, Consulate General of India, Geneva.

##### *Italy*

- Mr. Giuseppe Talamo Atenolfi, Ambassador, Ministry of Foreign Affairs, Rome.  
Mr. Valerio De Sanctis, Lawyer, Rome.  
Mr. Gino Galtieri, Inspector-General, Head, Intellectual Property Bureau to the Presidency of the Council of Ministers, Rome.  
Mr. Aldo Pelizza, Inspector-General, Central Patent Office, Rome.  
Mr. Carlo Maria Santoro, Legation Attaché, Ministry of Foreign Affairs, Rome.

##### *Japan*

- Mr. Muneoki Daté, Second Secretary, Permanent Delegation of Japan to International Organizations, Geneva.  
Mr. Hiroshi Iwata, Examiner, Patent Office, Tokyo.

##### *Netherlands*

- Mr. C. J. de Haan, President of the Octrooiraad, The Hague.  
Mr. Willem M. J. C. Phaf, Head, Legislative and Legal Affairs, Ministry of Economic Affairs, The Hague.

##### *Portugal*

- Mr. F. de Alcambar-Pereira, Permanent Representative of Portugal to International Organizations, Geneva.

##### *Rumanian People's Republic*

- Mr. Ion Anghel, Chief Legal Adviser, Ministry of Foreign Affairs, Bucharest.

##### *Spain*

- Mr. Miguel Bordonau, Director General de Archivos, Bibliotecas y Propiedad Intelectual, Madrid.  
Mr. Antonio Fernandez-Mazarambroz, Chief, Industrial Property Registry Office, Madrid.  
Mr. Lorenzo Perales, Chief, External Affairs, Ministry of National Education, Madrid.

##### *Sweden*

- Mr. Torwald Hesser, Counsellor to the Court of Appeal, Ministry of Justice, Stockholm.  
Mr. Claës Uggla, Counsellor, National Patent Office, Stockholm.

##### *Switzerland*

- Mr. Hans Morf, Doctor-at-Law, Attorney, Former Director of the Federal Office of Intellectual Property, Berne.  
Mr. Joseph Voyame, Director, Federal Office of Intellectual Property, Berne.  
Mr. Rudolf Bühler, Division of International Organizations, Federal Political Department, Berne.

*United Kingdom of Great Britain and Northern Ireland*

Mr. Gordon Grant, Comptroller-General of Patents, Designs and Trademarks, Industrial Property Department, Board of Trade, London.

Mr. Ronald Bowen, Principal Examiner, Patent Office, London.

*United States of America*

Mr. Edward J. Brenner, Commissioner of Patents, Washington, D. C.

Mr. Horace B. Fay Jr., Assistant Commissioner, U. S. Patent Office, Washington, D. C.

Mr. P. J. Federico, Examiner in Chief, Board of Appeals, U. S. Patent Office, Washington, D. C.

Mr. George A. Tesoro, United States Mission to International Organizations, Geneva.

Mr. Harvey J. Winter, Assistant Chief, International Business Practices Division, Department of State, Washington, D. C.

*Yugoslavia (Socialist Federal People's Republic of)*

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

*Austria*

## II. Observers

Dr. Thomas Lorenz, Ratssekretär, Patent Office, Vienna.

*Bulgaria (People's Republic of)*

Mr. Penko At. Penev, Engineer, Director, Rationalization Institute, Sofia.

*Ceylon*

Mr. W. M. Sellayah, Registrar of Companies, Trademarks and Designs, Colombo.

*Israel*

Mr. Ze'ev Sher, Registrar of Patents, Designs and Trademarks, Jerusalem.

*Mexico*

Mr. Joaquin Mercado, Third Secretary, Permanent Delegation of Mexico, Geneva.

*Polish People's Republic*

Mr. Ignacy Czerwinski, Engineer, President, Patent Office, Warsaw.

Mr. Bronislaw Bulwicki, Jurist, Patent Office, Warsaw.

Mrs. Natalia Lissowska, Counsellor, Patent Office, Warsaw.

*Turkey*

Mr. Metin Sirman, Deputy Delegate, Permanent Delegation of Turkey, Geneva.

## III. BIRPI

Professor G. H. C. Bodenhausen, Director.

Dr. Arpad Bogsch, Deputy Director.

Mr. Charles-L. Magnin, Deputy Director.

## IV. Officers of the Session

Chairman: Mr. Ion Anghel (Rumanian People's Republic).

Vice-Chairman: Mr. Edward J. Brenner (United States of America).

Vice-Chairman: Mr. Bordonau (Spain).

Secretary: Dr. A. Bogsch (BIRPI).

## Conference of Representatives of the International Union for the Protection of Industrial Property

(First Session, Geneva 1964)

REPORT<sup>1)</sup>

## Organizational Questions

Article 14 (5) of the Paris Convention for the Protection of Industrial Property as revised at Lisbon in 1958 provides that "during the interval between the Diplomatic Conferences of revision, Conferences of Representatives of all the countries of the Union shall meet every three years in order to draw up a report on the foreseeable expenditure of the International Bureau for each three-year period to come and to consider questions relating to the protection and development of the Union".

This text came into force on January 4, 1962.

The first session of the Conference of Representatives was held at Geneva, from September 30 to October 2, 1964.

All States Members of the Paris Union were invited to the Conference. The names of those actually represented at the session appears in the List of Participants reproduced below.

The Conference elected Mr. G. Finnis, Director of the National Institute of Industrial Property, France, as Chairman. Mr. T. Hesser and Mr. I. Czerwinski, Delegates of Sweden and of the Polish People's Republic, respectively, were elected as Vice-Chairmen. Dr. A. Bogsch, Deputy Director, BIRPI, was appointed Secretary.

The Conference noted that, as a consequence of its starting to function, the Consultative Committee of the Paris Union — established by a Resolution of the Lisbon Conference as a transitional body — ceased to exist. The same was noted in connection with the Permanent Bureau of the Consultative Committee.

The Conference adopted its Rules of Procedure. As provided by these Rules, the Conference elected the members of its Executive Committee (which henceforth takes the place of the Permanent Bureau of the Consultative Committee). The following States were elected as members of the Executive Committee: Ceylon, Czechoslovak Socialist Republic, France, Federal Republic of Germany, Hungarian People's Republic, Italy, Japan, Morocco, Netherlands, Nigeria, Portugal, Spain, Sweden, United Kingdom of Great Britain and Northern Ireland, United States of America, Socialist Federal People's Republic of Yugoslavia. Switzerland, as Supervisory Authority of BIRPI, is a member *ex officio*.

### Program and Budget of BIRPI on Account of the Paris Union for the Years 1965 to 1967

As regards the foreseeable expenditure of BIRPI on account of the Paris Union for the years 1965 to 1967 and the questions concerning the protection and development of the

<sup>1)</sup> This Report has been prepared by BIRPI on the basis of the official documents of the Conference.

Paris Union, the Conference noted with approval the report and proposals made by Professor G. H. C. Bodenhausen, Director of BIRPI. The main features of the triennial budget and program are the following:

(a) No raise in the yearly contributions of the Member States is contemplated.

(b) In addition to the recurring activities (publications, information service to Member States, organization of administrative meetings), BIRPI will make special efforts in the field of assistance to developing countries, cooperation between examining Patent Offices, collaboration with the United Nations, territorial extension of the Union, possible revision of the Paris Convention in connection with inventors' certificates, and the administrative structure of the Union and BIRPI.

(c) In respect to developing countries, the three-year plan contemplates (i) the convocation of an Asian Industrial Property Seminar and a general meeting of developing countries, (ii) committees of experts to examine model laws for developing countries on the protection of trademarks and other forms of industrial property, (iii) an African Committee of Experts on the possibility of establishing a common industrial property office for several English-speaking African countries, (iv) the offering of training facilities to Government employees selected for dealing with industrial property questions in their countries, and (v) the organization of courses in the field of industrial property.

#### Working Agreement with the United Nations

The Conference noted with satisfaction the proposal of the United Nations Secretariat concerning a working agreement with BIRPI, as contained in the Secretariat's letter of September 23, 1964.

The Conference recommended the Director of BIRPI to accept this proposal<sup>2</sup>).

#### LIST OF PARTICIPANTS

##### *I. Member States*

##### *Austria*

Dr. Thomas Lorenz, Ratssekretär, Patent Office, Vienna.

##### *Belgium*

Mr. Gérard-L. de San, Director General, Legal Counsellor to the Ministry of National Education and Culture, Brussels.

##### *Bulgaria (People's Republic of)*

Mr. Penko Penev, Engineer, Director, Rationalization Institute, Sofia.

Mr. V. Izmirliiev, First Secretary, Permanent Delegation of the People's Republic of Bulgaria, Geneva.

##### *Ceylon*

Mr. W. M. Sellayah, Registrar of Companies, Trademarks and Designs, Colombo.

##### *Czechoslovak Socialist Republic*

Mr. Jaroslav Němeček, President, Patent Office, Prague.

Dr. Radko Fajfr, First Secretary, Ministry of Foreign Affairs, Prague.

Dr. Jiří Kordac, Counsellor, Legislative Division, Ministry of Education and Culture, Prague.

Dr. Otto Kunz, Master of Research, Czechoslovak Academy of Sciences, Prague.

##### *Denmark*

Mr. Carl Sander, Chief Engineer, Patent Office, Copenhagen.

Mrs. Dagmar Simonsen, Chief of Section, Patent Office, Copenhagen.

##### *France*

Mr. Guillaume Finniss, Inspector-General of Industry and Commerce; Director, National Institute of Industrial Property, Paris.

Mr. Roger Labry, Counsellor of Embassy, Ministry of Foreign Affairs, Paris.

Mr. Marcel Pierre, Civil Administrator, National Institute of Industrial Property, Paris.

Mr. Jean-Louis Jauffre, Financial Expert, Paris.

Mrs. Madeleine Héliard, Doctor at Law, Legal Attaché, Industrial Property Service, Paris.

##### *Gabon*

Mr. Pierre-Marie Logi, Attaché, Embassy, Paris.

##### *Germany (Federal Republic of)*

Mr. Kurt Haertel, President, Deutsches Patentamt, Munich.

Mr. Albrecht Krieger, Regierungsdirektor, Federal Ministry of Justice, Bonn.

Mr. Dirk Rogge, Landgerichtsrat, Federal Ministry of Justice, Bonn.

Mr. Peter Schönfeld, Consul, Permanent Delegation of the Federal Republic of Germany to International Organizations, Geneva.

##### *Hungarian People's Republic*

Mr. András Kiss, Vice-President, Patent Office, Budapest.

Mr. Georges Pálos, Legal Adviser, Patent Office, Budapest.

##### *Ireland*

Mr. J. J. Lennon, Controller of Industrial and Commercial Property, Dublin.

##### *Israel*

Mr. Ze'ev Sher, Registrar of Patents, Designs and Trademarks, Jerusalem.

##### *Italy*

Mr. Giuseppe Talamo Atenolfi, Ambassador, Ministry of Foreign Affairs, Rome.

Mr. Valerio De Sanctis, Lawyer, Rome.

Mr. Gino Galtieri, Inspector-General, Head, Intellectual Property Bureau to the Presidency of the Council of Ministers, Rome.

Mr. Aldo Pelizza, Inspector-General, Central Patent Office, Rome.

Mr. Carlo Maria Santoro, Legation Attaché, Ministry of Foreign Affairs, Rome.

<sup>2</sup> See the full text of the exchange of letters between the United Nations Secretariat and BIRPI, in *Industrial Property*, 1964, p. 207.

*Japan*

Mr. Kosaku Yoshifuji, Director, 2<sup>nd</sup> Examination Division, Patent Office, Tokyo.

Mr. Muneoki Date, Second Secretary, Permanent Delegation of Japan to International Organizations, Geneva.

Mr. Hiroshi Iwata, Examiner, Patent Office, Tokyo.

*Mexico*

Mr. Joaquin Mercado, Third Secretary, Permanent Delegation of Mexico, Geneva.

*Monaco (Principality of)*

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

*Netherlands*

Mr. C. J. de Haan, President of the Octrooiraad, The Hague.

Mr. Willem M. J. C. Phaf, Head, Legislative and Legal Affairs, Ministry of Economic Affairs, The Hague.

Mr. J. F. E. Breman, First Secretary, Permanent Delegation of the Netherlands, Geneva.

*Norway*

Mr. Johan Helgeland, Director, Industrial Property Office, Oslo.

Mr. Arne G. Modal, Chief of section, Industrial Property Office, Oslo.

*Polish People's Republic*

Mr. Ignacy Czerwinski, Engineer, President, Patent Office, Warsaw.

Mr. Bronislaw Bulwicki, Jurist, Patent Office, Warsaw.

Mrs. Natalia Lissowska, Counsellor, Patent Office, Warsaw.

*Portugal*

Mr. F. de Alcambar-Pereira, Permanent Representative of Portugal to International Organizations, Geneva.

*Rumanian People's Republic*

Mr. Ion Anghel, Chief Legal Adviser, Ministry of Foreign Affairs, Bucarest.

Mr. Sanislav Aurel, Third Secretary, Permanent Delegation of Rumania, Geneva.

*Spain*

Mr. Antonio Fernandez-Mazarambroz, Chief, Industrial Property Registry Office, Madrid.

*Sweden*

Mr. Torwald Hesser, Counsellor to the Court of Appeal, Ministry of Justice, Stockholm.

Mr. Claës Uggla, Counsellor, National Patent Office, Stockholm.

*Switzerland*

Mr. Hans Morf, Doctor at Law, Attorney, Former Director of the Federal Office of Intellectual Property, Berne.

Mr. Joseph Voyamec, Director, Federal Office of Intellectual Property, Berne.

Mr. Rudolf Bühler, Division of International Organizations, Federal Political Department, Berne.

*United Kingdom of Great Britain and Northern Ireland*

Mr. Gordon Grant, Comptroller-General of Patents, Designs and Trademarks, Industrial Property Department, Board of Trade, London.

Mr. Ronald Bowen, Principal Examiner, Patent Office, London.

*United States of America*

Mr. Edward J. Brenner, Commissioner of Patents, Washington, D. C.

Mr. Horace B. Fay Jr., Assistant Commissioner, U. S. Patent Office, Washington, D. C.

Mr. P. J. Federico, Examiner in Chief, Board of Appeals, U. S. Patent Office, Washington, D. C.

Mr. George A. Tesoro, Counsellor, United States Mission to International Organizations, Geneva.

Mr. Harvey J. Winter, Assistant Chief, International Business Practices Division, Department of State, Washington, D. C.

*Upper Volta*

Mr. Martial Ouedraogo, Director of Economic Affairs, Ouagadougou.

*Yugoslavia (Socialist Federal People's Republic of)*

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

*II. BIRPI*

Professor G. H. C. Bodenhausen, Director.

Dr. Arpad Bogsch, Deputy Director.

Mr. Charles-L. Magnin, Deputy Director.

Mr. Ross Woodley, Counsellor, Head of the Industrial Property Division.

Mr. Vladimir Dolezil, Counsellor, Industrial Property Division.

*III. Officers of the Session*

Chairman: Mr. Guillaume Finnis (France).

Vice-Chairman: Mr. Torwald Hesser (Sweden).

Vice-Chairman: Mr. Ignacy Czerwinski (Polish People's Republic).

Secretary: Dr. Arpad Bogsch (BIRPI).

### Committee of Experts to Study a Model Law for Developing Countries on Inventions and Technical Know-How

(Geneva, October 19 to 23, 1964)

*Note*

The Committee of Experts to Study Industrial Property Problems of Industrially Less Developed Countries, convened by BIRPI, which met from October 21 to 23, 1963, at Geneva, unanimously recommended "that BIRPI should undertake to prepare a draft of a model law for the protection of inventions and technical improvements, taking into account the various existing systems, and accompanied by explanatory notes" (Report of the Committee, published in *Industrial Property*, 1963, p. 234).

With the authorization of the competent organs of BIRPI, a draft model law and an accompanying explanatory statement were, in due course, prepared by BIRPI, and submitted

for examination and advice to a committee of experts bearing the title "Committee of Experts on a Draft Model Law for Developing Countries on the Protection of Inventions and Technical Know-How".

This Committee met, on the convocation of BIRPI, from October 19 to 23, 1964, in Geneva. It consisted of representatives of developing countries only. However, in June 1964, BIRPI communicated, for possible comments, the texts of the draft model law and explanatory statement to those countries Members of the International Union for the Protection of Industrial Property (Paris Union) which, not being "developing countries" in the sense given to this expression in United Nations circles, were not invited to the Committee. The Governments of some of these countries availed themselves of this opportunity to make comments. The same texts were also communicated, for comments, to the United Nations and six other international organizations which were all represented at the meeting of the Committee as observers, and which took an active part in the discussions of the Committee. The names of these organizations appear in the list of participants.

The countries represented at the meeting were the following: Algeria, Argentina, Ceylon, Chile, Colombia, Dominican Republic, El Salvador, Haiti, India, Indonesia, Iran, Israel, Kenya, Mexico, Nicaragua, Nigeria, Sierra Leone, Sudan, Tanganyika and Zanzibar, Thailand, Uganda, Venezuela.

The Committee worked under the chairmanship of Mr. E. M. Peltzer (Argentina). The three elected Vice-Chairmen were: Mr. A. Jogarao (India), Mr. B. Bendris (Algeria) and Mr. D. Macaulay (Sierra Leone).

The Committee examined, article by article, the draft model law. It expressed its views on possible improvements in both the draft law and the explanatory statement both of which, on the basis of this advice, are being reviewed by BIRPI. The new texts will probably be available early in 1965.

At the conclusion of its work, the Committee unanimously adopted a resolution whose full text is reproduced below.

#### Recommendation

of the Committee of Experts to study a Model Law for Developing Countries on Inventions and Technical Know-How

The Committee of Experts on a draft model law for developing countries on the protection of inventions and technical know-how, convened by the United International Bureaux for the Protection of Intellectual Property (BIRPI) and composed exclusively of representatives of Governments of developing countries<sup>1)</sup>,

Having met at Geneva from October 19 to 23, 1964,

After having examined, together with the observers of international intergovernmental<sup>2)</sup> and non-governmental<sup>3)</sup> organizations, the draft model law and the explanatory statement accompanying it (documents PJ/34/2 and 3) prepared

<sup>1)</sup> Algeria, Argentina, Ceylon, Chile, Colombia, Dominican Republic, El Salvador, Haiti, India, Indonesia, Iran, Israel, Kenya, Mexico, Nicaragua, Nigeria, Sierra Leone, Sudan, Tanganyika and Zanzibar, Thailand, Uganda, Venezuela.

<sup>2)</sup> United Nations, Council of Europe, International Patent Institute.

<sup>3)</sup> Inter-American Association of Industrial Property, International Association for the Protection of Industrial Property, International Chamber of Commerce, International Federation of Patent Agents.

by BIRPI and communicated to the invited Governments and organizations in June 1964,

*Expresses the view* that the draft respects the special needs of developing countries and represents a useful model for legislation in these countries;

*Recommends* that the draft model law and the explanatory statement, as revised on the basis of the discussions of the Committee, should be transmitted to the Governments of developing countries invited to the meeting, to the Governments of the States members of the International Union for the Protection of Industrial Property (if not already falling into the preceding category), to the Secretary-General of the United Nations, and to the other international organizations invited to the meeting;

*Recommends* that BIRPI should keep in touch with the Governments of developing countries and with all international organizations, conferences or other bodies which deal with the problems of developing countries, and should continue to offer to them:

- (i) assistance, on the basis of the revised draft law and its explanatory statement, in connection with the adaptation or adoption of legislation in the field of inventions,
- (ii) assistance in the evaluation of the role that industrial property and its protection play in the industrialization of developing countries,
- (iii) assistance in training qualified personnel to administer industrial property legislation,
- (iv) assistance in the establishment and efficient running of national or regional industrial property offices;

*Notes with satisfaction* that BIRPI plans to establish draft model laws for developing countries on the protection of trademarks and other forms of industrial property and to submit for advice and review such drafts to committees of experts of developing countries to be called in 1965 on trademarks and in 1966 on other forms of industrial property<sup>4)</sup>.

#### LIST OF PARTICIPANTS

##### I. States

##### *Algeria (Democratic and Popular Republic of)*

Mr. Brahim Bendris, Director, National Office of Industrial Property, Algiers.

Mrs. Sellami, Third Secretary, Permanent Mission of Algeria to the European Office of the United Nations, Geneva.

##### *Argentina*

Mr. Enrique Miguel Peltzer, National Director (ad interim) of Industrial Property, Buenos Aires.

##### *Ceylon*

Mr. W. M. Sellayah, Registrar of Companies, Trademarks and Designs, Colombo.

##### *Chile*

Mr. Santiago Larraguibel Zavala, Legal Adviser to the Department of Industry, Santiago.

<sup>4)</sup> Unanimously adopted on October 23, 1964.



*Colombia*

Mr. Reinaldo Mosquera Guzman, Director of Industrial Property, Bogota.

*Dominican Republic*

Mr. Manuel Ramon Sosa Vassallo, Ambassador, Permanent Delegate of the Dominican Republic to the European Office of the United Nations, Geneva.

Mr. Pierre Portas, Secretary to the Permanent Delegation of the Dominican Republic to the European Office of the United Nations, Geneva.

*El Salvador*

Mr. Rodolfo Jimenez Barrios, Legal Adviser, Ministry of Justice, San Salvador.

*Haiti*

Mr. Jean L. Montes Boyer, Legal Adviser, Department of Commerce and Industry, Port-au-Prince.

*India*

Mr. A. Jogarao, Controller-General of Patents, Designs and Trademarks, Bombay.

*Indonesia*

Mr. Sugondo Sumodiredjo, Senior Official, Department of Justice, Djakarta.

*Iran*

Mr. Mehdi Naraghi, Director of the Office for the Registration of Companies and Industrial Property, Teheran.

*Israel*

Mr. Ze'ev Sher, Registrar of Patents, Designs and Trademarks, Jerusalem.

*Kenya*

Mr. D. J. Coward, Registrar-General, Nairobi.

*Mexico*

Mr. Joaquin Mercado, Third Secretary, Permanent Delegation of Mexico to the European Office of the United Nations, Geneva.

*Nicaragua*

Mr. Julian Bendana, Commissioner of Patents, Ministry of Economy, Managua.

*Nigeria*

Mr. D. O. Egbue, Acting Registrar (Commercial Legislation), Federal Ministry of Commerce and Industry, Lagos.

*Sierra Leone*

Mr. Donald Macaulay, Principal Crown Counsel, Acting Solicitor-General, Freetown.

*Sudan*

Mr. Mohamed Mekki Kanani, Commercial Registrar, Ministry of Commerce, Industry and Supply, Khartoum.

*Tanganyika and Zanzibar (United Republic of)*

Mr. D. J. A. Dowdall, Registrar-General, Registrar of Trademarks and Patents, Dar-Es-Salaam.

*Thailand*

Mr. Prayoon Talerngsri, Patent Examination Division, Department of Commercial Registration, Ministry of Economic Affairs, Bangkok.

*Uganda*

Miss B. A. S. Batchelor, Registrar of Patents, Kampala.

*Venezuela*

Mr. Luis Vilorio-Garbati, Director of Industrial Property, Ministry of Fomento, Caracas.

Mr. Euripides Terrero, Lawyer, Caracas.

*II. Observers**(a) International Intergovernmental Organizations**United Nations*

Mr. K. E. Lachmann, Chief, Fiscal and Financial Branch, New York.

Mr. H. W. Singer, Special Adviser to the Under-Secretary for Economic and Social Affairs; Associate Director, U. N. Research Institute for Social Development, New York.

Mr. L. Kopelmanas, Legal Adviser to the Economic Commission for Europe, Geneva.

Mr. C. Benjamin, Deputy Legal Adviser to the Economic Commission for Europe, Geneva.

*Council of Europe*

Mr. Per von Holstein, General Division of the Directorate of Legal Affairs, Strasbourg.

*International Patent Institute (IIB)*

Mr. G. Finnis, President of the IIB, The Hague.

Mr. Alfred van Anbel, Deputy Director of the IIB, The Hague.

Mr. Max Brunier, Administrator of the IIB, The Hague.

*(b) International Non-Governmental Organizations**Inter-American Association of Industrial Property (ASIPI)*

Mr. José Barrera-Moller, Lawyer, President of the ASIPI, Lima.

*International Association for the Protection of Industrial Property (AIPPI)*

Mr. Ernesto D. Aracama-Zorraquin, Lawyer, Professor of Law, Buenos Aires.

Mr. Stephen P. Ladas, Lawyer, Treasurer of AIPPI, New York.

*International Chamber of Commerce (ICC)*

Mr. Pierre-Jean Pointet, Professor, Zurich.

Mr. Stephen P. Ladas, Lawyer, Chairman of the Commission on Industrial Property of the ICC, New York.

*International Federation of Patent Agents (FICPI)*

Mr. Casimir Massalski, Patent Agent, Paris.

### III. Bureau of the Committee

Chairman: Mr. Enrique Miguel Peltzer (Argentina).

Vice-Chairman: Mr. Brahim Bendris (Democratic and Popular Republic of Algeria).

Vice-Chairman: Mr. A. Jogarao (India).

Vice-Chairman: Mr. Donald Macaulay (Sierra Leone).

### IV. BIRPI

Professor G. H. C. Bodenhausen, Director.

Dr. Arpad Bogsch, Deputy Director.

Mr. Charles-L. Magnin, Deputy Director.

Mr. R. Woodley, Counsellor, Head of Industrial Property Division.

## LEGISLATION

### IRELAND

#### Patents Act, 1964

An Act to make new provision in respect of patents and related matters in substitution for the provisions of the Industrial and Commercial Property (Protection) Act, 1927, relating to patents and of other enactments relating to patents, and to provide for other matters connected with the matters aforesaid

(Of June 24, 1964)

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

#### Provisions as to licences

40. — (1) Where the Controller is satisfied, on application made under the last foregoing section of this Act, that the manufacture, use or sale of materials not protected by the patent is unfairly prejudiced by reason of conditions imposed by the patentee upon the grant of licences under the patent, or upon the purchase, hire or use of the patented article or process, he may, subject to the provisions of that section, order the grant of licences under the patent to such customers of the applicant as he thinks fit as well as to the applicant.

(2) Where an application under the last foregoing section is made by a person being the holder of a licence under the patent, the Controller may, if he makes an order for the grant of a licence to the applicant, order the existing licence to be cancelled, or may, if he thinks fit, instead of making an order for the grant of a licence to the applicant, order the existing licence to be amended.

(3) Where on an application under the last foregoing section the Controller orders the grant of a licence, he may direct that the licence shall operate:

- (a) to deprive the patentee of any right which he may have as patentee to make, use, exercise or vend the invention or to grant licences under the patent;
- (b) to revoke all existing licences in respect of the invention.

(4) Subsection (4) of section 37 of this Act shall apply to a licence granted in pursuance of an order under the last foregoing section of this Act as it applies to a licence granted by virtue of the said section 37.

#### Endorsement, etc. on application of a Minister of State

41. — (1) At any time after the expiration of four years after the date of application for a patent or of three years from the date of the sealing of a patent, whichever is the later, any Minister of State may apply to the Controller upon any one or more of the grounds specified in section 39 of this Act for the endorsement of the patent with the words "licences of right" or for the grant to any person specified in the application of a licence under the patent; and the Controller may, if satisfied that any of those grounds are established, make an order in accordance with the application.

(2) Subsections (3) and (6) of section 39 of this Act and section 40 of this Act shall, so far as applicable, apply in relation to an application and an order under the last foregoing subsection as they apply in relation to an application and an order under the said section 39.

#### Inventions relating to food or medicine

42. — (1) Without prejudice to the foregoing provisions of this Act, where a patent is in force in respect of:

- (a) a substance capable of being used as food or medicine or in the production of food or medicine; or
- (b) a process for producing such a substance as aforesaid; or
- (c) any invention capable of being used as, or as part of a medical, surgical or other remedial device,

the Controller shall, on application made to him by any person interested, order the grant to the applicant of a licence under the patent on such terms as he thinks fit, unless it appears to him that, having regard to the desirability of encouraging inventors and the growth and development of industry and to such other matters as he considers relevant, there are good reasons for refusing the application.

(2) In settling the terms of licences under this section the Controller shall endeavour to secure that food, medicines and medical, surgical and other remedial devices shall be available to the public at the lowest prices consistent with the patentees' deriving a reasonable advantage from their patent rights.

(3) A licence granted under this section shall entitle the licensee to make, use, exercise and vend the invention as a food or medicine, or for the purpose of the production of food or medicine or as, or as part of, a medical, surgical or other remedial device, but for no other purposes.

#### Revocation of patent after grant of licence

43. — (1) Where an order for the grant of a licence under a patent has been made in pursuance of an applica-

<sup>1</sup> See *Industrial Property*, 1964, pp. 188, 211.

tion under section 39 of this Act, any person interested may, at any time after the expiration of two years from the date of that order, apply to the Controller for the revocation of the patent upon any of the grounds specified in subsection (2) of the said section 39; and if upon any such application the Controller is satisfied:

- (a) that any of the said grounds are established; and
- (b) that the purposes for which an order may be made in pursuance of an application under the said section 39 could not be achieved by the making of any such order as is authorised to be made in pursuance of such an application,

he may order the patent to be revoked.

(2) An order for the revocation of a patent under this section may be made so as to take effect either unconditionally, or in the event of failure to comply, within such reasonable period as may be specified in the order, with such conditions as may be imposed by the order with a view to achieving the purposes aforesaid; and the Controller may, on reasonable cause shown in any case, by subsequent order extend any period so specified.

#### *Procedure on applications under sections 39 to 43*

44. — (1) Every application under sections 39 to 43 of this Act shall specify the nature of the order sought by the applicant and shall contain a statement (to be verified in such manner as may be prescribed) setting out the nature of the applicant's interest (if any) and the facts upon which the application is based.

(2) Where the Controller is satisfied, upon consideration of any such application, that a *prima facie* case has been made out for the making of an order, he shall direct the applicant to serve copies of the application upon the patentee and any other persons appearing from the register of patents to be interested in the patent in respect of which the application is made, and shall advertise the application in the Journal.

(3) The patentee or any other person desiring to oppose the application may, within such time as may be prescribed or within such further time as the Controller may on application (made either before or after the expiration of the prescribed time) allow, give to the Controller notice of opposition.

(4) Any such notice of opposition shall contain a statement (to be verified in such manner as may be prescribed) setting out the grounds on which the application is opposed.

(5) Where any such notice of opposition is duly given, the Controller shall notify the applicant, and shall, subject to the provisions of the next following section with respect to arbitration, give to the applicant and the opponent an opportunity to be heard before deciding the case.

#### *Appeal and references to arbitrator*

45. — (1) An appeal shall lie from any order made by the Controller in pursuance of an application under sections 39 to 43 of this Act.

(2) On any appeal under this section, the Attorney General or such other counsel as he may appoint shall be entitled to appear and be heard.

(3) Where any such application is opposed in accordance with the last foregoing section, and either:

- (a) the parties consent; or
- (b) the proceedings require a prolonged examination of documents or any scientific or local investigation which cannot in the opinion of the Controller conveniently be made before him,

the Controller may at any time order the whole proceedings, or any question or issue of fact arising therein, to be referred to an arbitrator agreed on by the parties, or, in default of agreement, appointed by the Controller.

(4) Where the whole proceedings are referred as aforesaid, section 35 of the Arbitration Act, 1954 (which relates to the statement of cases by arbitrators for the decision of the High Court), shall not apply to the arbitration; but unless the parties otherwise agree before the award of the arbitrator is made, an appeal shall lie from the award.

(5) Where a question or issue of fact is referred as aforesaid, the arbitrator shall report his findings to the Controller.

#### *Supplementary provisions as to licences*

46. — (1) Any order under this Act for the grant of a licence shall, without prejudice to any other method of enforcement, have effect as if it were a deed, executed by the patentee and all other necessary parties, granting a licence in accordance with the order.

(2) An order may be made on an application under sections 39 to 41 of this Act for the endorsement of a patent with the words "licences of right" notwithstanding any contract which would have precluded the endorsement of the patent on the application of the patentee under section 37 of this Act; and any such order shall for all purposes have the same effect as an endorsement made in pursuance of an application under the said section 37.

(3) No order shall be made in pursuance of any application under sections 39 to 43 of this Act which would be at variance with any treaty, convention, arrangement or engagement applying to the State and any convention country.

#### *Previous publication*

47. — (1) Subject as hereinafter provided, an invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that the invention was published before the priority date of the relevant claim of the specification, if the patentee or applicant for the patent proves:

- (a) that the matter published was obtained from him or (where he is not himself the true and first inventor) from any person from whom he derives title, and was published without his consent or the consent of any such person; and
- (b) that the application for a patent or (in the case of a convention application) the application for protection

in a convention country was made not more than six months after the date of such publication.

Provided that this subsection shall not apply if the invention was before the priority date of the claim commercially worked in the State, otherwise than for the purpose of reasonable trial, either by the patentee or applicant for the patent or any person from whom he derives title or by any other person with the consent of the patentee or applicant for the patent or any person from whom he derives title.

(2) Where a complete specification is filed in pursuance of an application for a patent made by a person being the true and first inventor or deriving title from him, an invention claimed in that specification shall not be deemed to have been anticipated by reason only of any other application for a patent in respect of the same invention, made in contravention of the rights of that person, or by reason only that after the date of filing of that other application the invention was used or published, without the consent of that person, by the applicant in respect of that other application, or by any other person in consequence of any disclosure of the invention by that applicant if the first-mentioned application was made not more than six months after any such use or publication.

(3) Notwithstanding anything in this Act, the Controller shall not refuse to accept a complete specification or to grant a patent, and a patent shall not be revoked or invalidated, by reason only of any circumstances which, by virtue of this section, do not constitute an anticipation of the invention claimed in the specification.

#### *Previous communication, display or working*

48. — (1) An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of the communication of the invention to a Minister of State or to any person authorised by such a Minister to investigate the invention or its merits.

(2) The exhibition of an invention at an international exhibition, certified as such by the Minister, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not be deemed to be an anticipation of the invention:

Provided that:

- (a) the exhibitor, before exhibiting the invention, or permitting such publication, gives the Controller the prescribed notice of his intention to do so; and
- (b) the application for a patent is made before or within six months after the date of the opening of the exhibition.

(3) Notwithstanding anything in this Act, the Controller shall not refuse to accept a complete specification or to grant a patent, and a patent shall not be revoked or invalidated, by reason only of any circumstances which, by virtue of this section, do not constitute an anticipation of the invention claimed in the specification.

#### *Use and publication after provisional specification or foreign application*

49. — (1) Where a complete specification is filed or proceeded with in pursuance of an application which was accompanied by a provisional specification or by a specification treated by virtue of a direction under subsection (4) of section 8 of this Act as a provisional specification, then, notwithstanding anything in this Act, the Controller shall not refuse to grant the patent, and the patent shall not be revoked or invalidated by reason only that any matter described in the provisional specification or in the specification treated as aforesaid as a provisional specification was used or published at any time after the date of filing of that specification.

(2) Where a complete specification is filed in pursuance of a convention application, then, notwithstanding anything in this Act, the Controller shall not refuse to grant the patent, and the patent shall not be revoked or invalidated by reason only that any matter disclosed in any application for protection in a convention country upon which the convention application is founded was used or published at any time after the date of that application for protection.

#### *Priority date in case of obtaining*

50. — Where an application is made for a patent for an invention which has been claimed in a complete specification filed in pursuance of any other such application, then if:

- (a) the Controller has refused to grant a patent in pursuance of that other application on the ground specified in paragraph (a) of subsection (1) of section 19 of this Act; or
- (b) a patent granted in pursuance of that other application has been revoked by the Court or the Controller on the ground specified in paragraph (a) of subsection (1) of section 19 or paragraph (c) of subsection (1) of section 34 of this Act; or
- (c) the complete specification filed in pursuance of the said other application has, in proceedings under section 19, section 34 or section 35 of this Act, been amended by the exclusion of the claim relating to the said invention in consequence of a finding by the Controller or the Court that the invention was obtained by the applicant or patentee from any other person,

the Controller may direct that the first-mentioned application and any specification filed in pursuance thereof shall be deemed, for the purposes of the provisions of this Act relating to the priority date of claims of complete specifications, to have been filed on the date on which the corresponding document was or was deemed to have been filed in the proceedings upon the said other application.

#### *Co-ownership of patents*

51. — (1) Where after the commencement of this Act a patent is granted to two or more persons, each of those persons shall, unless an agreement to the contrary is in force, be entitled to an equal undivided share in the patent.

(2) Subject to the provisions of this and the next following section, where two or more persons are registered as

grantee or proprietor of a patent, then, unless an agreement to the contrary is in force, each of those persons shall be entitled, by himself or his agents, to make, use, exercise and vend the patented invention for his own benefit without accounting to the other or others.

(3) Subject to the provisions of the next following section, and to any agreement for the time being in force, a licence under a patent shall not be granted, and a share in a patent shall not be assigned, except with the consent of all persons, other than the licensor or assignor, who are registered as grantee or proprietor of the patent.

(4) Where an article is sold by one of two or more persons registered as grantee or proprietor of a patent, the purchaser and any person claiming through him shall be entitled to deal with it in the same manner as if the article had been sold by a sole patentee.

(5) Subject to the provisions of this section, the rules of law applicable to the ownership and devolution of personal property generally shall apply in relation to patents as they apply in relation to other choses in action; and nothing in subsection (1) or subsection (2) of this section shall affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.

*Power of Controller to give directions to co-owners*

52. — (1) Where two or more persons are registered as grantee or proprietor of a patent, the Controller may, upon application made to him in the prescribed manner by any of those persons, give such directions in accordance with the application as to the sale or lease of the patent or any interest therein, the grant of licences under the patent, or the exercise of any right under the last foregoing section in relation thereto, as he thinks fit.

(2) If any person registered as grantee or proprietor of the patent fails to execute any instrument or to do any other thing required for the carrying out of any direction given under this section within fourteen days after being requested in writing so to do by any of the other persons so registered, the Controller may, upon application made to him in the prescribed manner by any such other person, give directions empowering any person to execute that instrument or to do that thing in the name and on behalf of the person in default.

(3) Before giving directions in pursuance of an application under this section, the Controller shall give an opportunity to be heard:

- (a) in the case of an application under subsection (1) of this section, to the other person or persons registered as grantee or proprietor of the patent;
- (b) in the case of an application under subsection (2) of this section, to the person in default.

(4) An appeal shall lie from any decision or direction of the Controller under this section.

(5) No direction shall be given under this section so as to affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.

*Disputes as to inventions made by employees*

53. — (1) Where a dispute arises between an employer and a person who is or was at the material time his employee as to the rights of the parties in respect of an invention made by the employee either alone or jointly with other employees or in respect of any patent granted or to be granted in respect thereof, the Controller may, upon application made to him in the prescribed manner by either of the parties, and after giving to each of them an opportunity to be heard, determine the matter in dispute, and may make such orders for giving effect to his decision as he considers expedient:

Provided that if it appears to the Controller upon any application under this section that the matter in dispute involves questions which would more properly be determined by the Court, he may decline to deal therewith.

(2) In proceedings before the Court between an employer and a person who is or was at the material time his employee, or upon an application made to the Controller under subsection (1) of this section, the Court or Controller may, unless satisfied that one or other of the parties is entitled, to the exclusion of the other, to the benefit of an invention made by the employee, by order provide for the apportionment between them of the benefit of the invention, and of any patent granted or to be granted in respect thereof, in such manner as the Court or Controller considers just.

(3) A decision of the Controller under this section shall have the same effect as between the parties and persons claiming under them as a decision of the Court.

(4) An appeal shall lie from any decision of the Controller under this section.

*Avoidance of certain conditions attached to the sale, etc., of patented articles*

54. — (1) It shall not be lawful in any contract in relation to the sale or lease of, or licence to use or work, any article or process protected by a patent to insert a condition which, directly or indirectly, will:

- (a) prevent or restrict the purchaser, lessee, or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licensor or his nominees; or
- (b) require the purchaser, lessee, or licensee to acquire from the seller, lessor, licensor, or his nominees, any article or class of articles not protected by the patent;

and any such condition shall be null and void:

Provided that this subsection shall not apply if:

- (i) the seller, lessor, or licensor proves that at the time the contract was entered into the purchaser, lessee, or licensee had the option of purchasing the article or obtaining a lease or licence on reasonable terms, without such conditions as aforesaid; and
- (ii) the contract entitles the purchaser, lessee, or licensee to relieve himself of his liability to observe any such condition on giving the other party three months notice in writing and on payment in com-

compensation for such relief, in the case of a purchase, of such sum, or in the case of a lease or licence, of such rent or royalty for the residue of the term of the contract, as may be fixed by an arbitrator appointed by the Minister.

(2) In any action, application, or proceedings under this Act no person shall be estopped from applying for or obtaining relief by reason of any admission made by him as to the reasonableness of the terms offered to him under paragraph (i) of the proviso to the foregoing subsection.

(3) Any contract relating to the lease of or licence to use or work any patented article or patented process may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything in the same or in any other contract to the contrary, be determined by either party on giving three-months notice in writing to the other party.

(4) The insertion by the patentee in a contract of any condition which by virtue of this section is null and void shall be available as a defence to an action for infringement of the patent to which the contract relates brought while that contract is in force.

(5) Nothing in this section shall:

- (a) affect any condition in a contract whereby a person is prohibited from selling any goods other than those of a particular person; or
- (b) be construed as validating any contract which would, apart from this section, be invalid; or
- (c) affect any right of determining a contract or condition in a contract exercisable independently of this section; or
- (d) affect any condition in a contract for the lease of or licence to use a patented article, whereby the lessor or licensor reserves to himself or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair.

## PART V

### Proceedings for Infringement of Patents

#### *Restrictions on recovery of damages for infringement*

55. — (1) In proceedings for the infringement of a patent damages shall not be awarded against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable ground for supposing, that the patent existed; and a person shall not be deemed to have been aware or to have had reasonable grounds for supposing as aforesaid by reason only of the application to an article of the word "patent", "patented", or any word or words expressing or implying that a patent has been obtained in the State for the article, unless the number of the patent accompanied the word or words in question.

(2) In any proceeding for infringement of a patent the Court may, if it thinks fit, refuse to award any damages in respect of any infringement committed after a failure to pay any renewal fee within the prescribed period and before any extension of that period.

(3) Where an amendment of a specification by way of disclaimer, correction or explanation has been allowed under this Act after the publication of the specification, no damages shall be awarded in any proceedings in respect of the use of the invention before the date of the decision allowing the amendment, unless the Court is satisfied that the specification as originally published was framed in good faith and with reasonable skill and knowledge.

(4) Nothing in this section shall affect the power of the Court to grant an injunction in any proceedings for infringement of a patent.

#### *Order for account in action for infringement*

56. — In an action for infringement of a patent the plaintiff shall be entitled, at his option, to an account of profits in lieu of damages.

#### *Counterclaim for revocation in action for infringement*

57. — A defendant in an action for infringement of a patent may, without presenting a petition, apply in accordance with rules of court by way of counterclaim in the action for revocation of the patent.

#### *Relief for infringement of partially valid specification*

58. — (1) If in proceedings for infringement of a patent it is found that any claim of the specification, being a claim in respect of which infringement is alleged, is valid, but that any other claim is invalid, the Court may grant relief in respect of any valid claim which is infringed:

Provided that the Court shall not grant relief by way of damages or costs except in the circumstances mentioned in the next following subsection.

(2) Where the plaintiff proves that the invalid claim was framed in good faith and with reasonable skill and knowledge, the Court shall grant relief in respect of any valid claim which is infringed subject to the discretion of the Court as to costs and as to the date from which damages should be reckoned.

(3) As a condition of relief under subsection (1) or subsection (2) of this section the Court may direct that the specification shall be amended to its satisfaction upon an application made for that purpose under section 32 of this Act, and such an application may be made accordingly whether or not all other issues in the proceedings have been determined.

#### *Proceedings for infringement by exclusive licensee*

59. — (1) Subject to the provisions of this section, the holder of an exclusive licence under a patent shall have the like right as the patentee to take proceedings in respect of an infringement of the patent committed after the date of the licence, and in awarding damages or granting any other relief in any such proceedings, the Court shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee as such or, as the case may be, the profits earned by means of the infringement so far as it constitutes an infringement of the rights of the exclusive licensee as such.

(2) In any proceedings taken by the holder of an exclusive licence by virtue of this section, the patentee shall, unless



he is joined as plaintiff in the proceedings be added as defendant:

Provided that a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

*Certificate of contested validity of specification*

60. — (1) If in any proceedings before the Court the validity of any claim of a specification is contested, and that claim is found by the Court to be valid, the Court may certify that the validity of that claim was contested in those proceedings.

(2) Where any such certificate has been granted, then if, in any subsequent proceedings before the Court for infringement of the patent or for revocation of the patent, a final order or judgment is made or given in favour of the party relying on the validity of the patent, that party shall, unless the Court otherwise directs, be entitled to his costs as between solicitor and client so far as concerns the claim in respect of which the certificate was granted:

Provided that this subsection shall not apply to the costs of any appeal in any such proceedings as aforesaid.

*Remedy for groundless threats of infringement proceedings*

61. — (1) Where any person (whether entitled to or interested in a patent or an application for a patent or not) by circulars, advertisements or otherwise threatens any other person with proceedings for infringement of a patent, any person aggrieved thereby may bring an action against him for any such relief as is mentioned in the next following subsection.

(2) Unless in any action brought by virtue of this section the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute, an infringement of a patent or of rights arising from the publication of a complete specification in respect of a claim of the specification not shown by the plaintiff to be invalid, the plaintiff shall be entitled to the following relief, that is to say:

- (a) a declaration to the effect that the threats are unjustifiable;
- (b) an injunction against the continuance of the threats; and
- (c) such damages, if any, as he had sustained thereby.

(3) For the avoidance of doubt it is hereby declared that a mere notification of the existence of a patent does not constitute a threat of proceedings within the meaning of this section.

*Power of Court to make declaration as to non-infringement*

62. — (1) A declaration that the use by any person of any process, or the making or use or sale by any person of any article, does not or would not constitute an infringement of a claim of a patent may be made by the Court in proceedings between that person and the patentee or the holder of an exclusive licence under the patent, notwithstanding that no assertion to the contrary has been made by the patentee or licensee, if it is shown:

- (a) that the plaintiff has applied in writing to the patentee or licensee for a written acknowledgment to the effect of the declaration claimed, and has furnished him with full particulars in writing of the process or article in question; and
- (b) that the patentee or licensee has refused or neglected to give such an acknowledgment.

(2) The costs of all parties in proceedings for a declaration brought by virtue of this section shall, unless for special reasons the Court thinks fit to order otherwise, be paid by the plaintiff.

(3) The validity of a claim of the specification of a patent shall not be called in question in proceedings for a declaration brought by virtue of this section, and accordingly the making or refusal of such a declaration in the case of a patent shall not be deemed to imply that the patent is valid.

(4) Proceedings for a declaration may be brought by virtue of this section at any time after the date of the publication of the complete specification in pursuance of an application for a patent, and reference in this section to the patentee shall be construed accordingly.

PART VI

Register of Patents

*Register of patents*

63. — (1) There shall continue to be kept at the Office a register of patents, in which there shall be entered particulars of patents in force, of assignments and transmissions of patents and of licences under patents, and notice of all matters which are required by or under this Act to be entered in the register and of such other matters affecting the validity or proprietorship of patents as the Controller thinks fit.

(2) Subject to the provisions of this Act and to any rules made by the Minister, the register of patents shall, at all convenient times, be open to inspection by the public; and certified copies, sealed with the seal of the Controller, of any entry in the register shall be given to any person requiring them on payment of the prescribed fee.

(3) The register of patents shall be *prima facie* evidence of any matters required or authorised by or under this Act to be entered therein.

(4) No notice of any trust, whether expressed, implied or constructive, shall be entered in the register of patents, and the Controller shall not be affected by any such notice.

*Registration of assignments, etc.*

64. — (1) Where a person becomes entitled by assignment or transmission, operation of law or any other mode of transfer to a patent or to a share in a patent, or becomes entitled as mortgagee, licensee or otherwise to any other interest in a patent, he shall apply to the Controller in the prescribed manner for the registration of his title as proprietor or co-proprietor, or, as the case may be, of notice of his interest, in the register of patents.

(2) Without prejudice to the provisions of the foregoing subsection, an application for the registration of the title of any person becoming entitled by assignment to a patent or a share in a patent, or becoming entitled by virtue of a mortgage, licence or other instrument to any other interest in a patent, may be made in the prescribed manner by the assignor, mortgagor, licensor or other party to that instrument, as the case may be.

(3) Where application is made under this section for the registration of the title of any person, the Controller shall, upon proof of title to his satisfaction:

(a) where that person is entitled to a patent or a share in a patent, register him in the register of patents as proprietor or co-proprietor of the patent, and enter in that register particulars of the instrument or event by which he derives title; or

(b) where that person is entitled to any other interest in the patent, enter in that register notice of his interest, with particulars of the instrument (if any) creating it.

(4) Subject to the provisions of this Act relating to co-ownership of patents, and subject also to any rights vested in any other person of which notice is entered in the register of patents, the person or persons registered as grantee or proprietor of a patent shall have power to assign, grant licences under, or otherwise deal with the patent, and to give effectual receipts for any consideration for any such assignment, licence or dealing:

Provided that any equities in respect of the patent may be enforced in like manner as in respect of any other personal property.

(5) Rules made by the Minister under this Act may require the supply to the Controller for filing at the Office of copies of such deeds, licences and other documents as may be prescribed.

(6) Except for the purposes of an application to rectify the register under the following provisions of this Act, a document in respect of which no entry has been made in the register of patents under subsection (3) of this section shall not be admitted in any court as evidence of the title of any person to a patent or share of or interest in a patent unless the court otherwise directs.

#### *Power of Court to amend register*

65. — (1) Subject to the provisions of this Act, the Court may on the application in the prescribed manner of 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 in the register, or by an error or defect in any entry in the register, make such order for making, expunging, or varying such entry as it may think fit.

(2) The Court 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) The prescribed notice of any application under this section shall be given to the Controller, who shall have the right to appear and be heard thereon, and shall appear if so

directed by the Court. Unless otherwise directed by the Court, the Controller in lieu of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the Office in like cases, or of such other matters relevant to the issues, and within his knowledge as Controller, as he shall think fit, and such statement shall be deemed to form part of the evidence in the proceeding.

(4) In the case of fraud in the registration or transmission of a patent, the Controller may himself apply to the Court under the provisions of this section.

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

(6) Any application under this section (other than an application by the Controller) may, at the option of the applicant, be made in the first instance to the Controller, and in such case the Controller shall have all the powers of the Court under this section, but his decision shall be subject to appeal.

#### *Power to correct clerical errors, etc.*

66. — (1) The Controller may, in accordance with the provisions of this section, correct any clerical error in any patent, any application for a patent, or any document filed in pursuance of such an application, or, without prejudice to subsection (6) of the last foregoing section, any error in the register of patents.

(2) A correction may be made in pursuance of this section either upon a request in writing made by any person interested and accompanied by the prescribed fee, or without such a request.

(3) Where the Controller proposes to make any such correction as aforesaid otherwise than in pursuance of a request made under this section, he shall give notice of the proposal to the patentee or the applicant for the patent, as the case may be, and to any other person who appears to him to be concerned, and shall give them an opportunity to be heard before making the correction.

*(To be continued)*



# CORRESPONDENCE

## Letter from France

By Paul MATHÉLY  
Barrister at the Court of Paris  
*(First Part)*











## BOOK REVIEWS

**La protection des marques de haute renommée au regard du droit suisse** (The protection of famous marks in regard to Swiss Law), by *Michel Jaton*, Doctor of Law. One volume of 148 pages, 23 × 16 cm. Editions René Thonney-Dupraz, Lausanne, 1961. Price: 13.50 Swiss francs. (In French.)

The author begins by making a clear distinction between "well-known marks" as referred to in Article 6<sup>bis</sup> of the Paris Convention ("used for identical or similar goods") and "famous marks", the protection of which is not conditional upon the identity or similarity of the goods of the infringer. The fact that this distinction has not been universally recognised is revealed by the length of the list of different names used by authors to designate "famous marks" (p. 141).

In the author's opinion, "the famous mark constitutes first a designation for a product which has reached the culminating point in its normal logical development, that is to say, it has acquired a characterising force in the eyes only of interested persons or potential buyers. But fame further implies that such great renown should extend beyond the limits of the afore-mentioned circles to reach the general public".

It can be said to the author's credit that his detailed analysis has helped to make matters clearer in this field. R. W.

\* \* \*

**Garantie et responsabilité contractuelles en droit des brevets d'invention** (Contractual guarantee and responsibility in patent rights), by *Jacques Wittmer*, Doctor of Law. One volume of 147 pages, 23 × 16 cm. Published by Verlag für Recht und Gesellschaft AG., Basel, 1962. Price: 35 Swiss francs. (In French.)

This book is a comparative study on the obligation to provide guarantees in assignment and licence contracts in respect of patents and trade secrets.

The question of the guarantee, especially in connection with patent licence contracts, has given rise to a profusion of court decisions, particularly in the United States and in Germany. Nevertheless, the nature and scope of this obligation remain extremely complex, mainly because of the characteristics of intangible property.

The author attempts to solve this problem by means of a detailed analysis of the main principles of contract law. Part of the work is devoted to a study of the historical development of the basic concepts of contract law, their relation to the obligation to provide a guarantee, and the theory of contractual risks and error.

Though based on dogmatic principles, the work is designed for practical purposes. It takes full account of the development and the different stages of the negotiations which precede the conclusion of contracts relating to patents for inventions and trade secrets.

The study is based mainly on case law and in particular on the findings of the Swiss, German, French and American courts. It concludes with recommendations for conventional rules concerning the guarantee in licence contracts. R. W.

## NEWS ITEMS

### JAPAN

#### *Appointment of new Director-General of the Patent Office*

We are informed that Mr. Tadashi Kurahachi has been appointed Director-General of the Japanese Patent Office as from October 23, 1964. He succeeds Mr. Shigeru Sabashi.

We take this opportunity of congratulating the new Director-General on his appointment.

## Calendar of BIRPI Meetings

Place	Date	Title	Object	Invitations to participate	Observers
Geneva	November 30 to December 4, 1964	Committee of African Experts, convened jointly with Unesco, to study a draft model copyright law	Study of a draft model copyright law for African countries	Congo (Brazzaville), Ethiopia, Ghana, Ivory Coast, Liberia, Morocco, Nigeria	Individual consultants from the European Broadcasting Union, International Confederation of Societies of Authors and Composers, International Literary and Artistic Association
Geneva	March 15 to 19, 1965	Committee of Experts on inventors' certificates	To study the problem of inventors' certificates in relation to the Paris Convention	All Member States of the Paris Union	United Nations, Council of Europe, International Patent Institute, Organization of American States, Inter-American Association of Industrial Property, International Association for the Protection of Industrial Property, International Chamber of Commerce, International Federation of Patent Agents
Geneva	March 22 to April 2, 1965	Committee of Experts on the administrative structure of international cooperation in the field of intellectual property	To study a draft Convention on administrative structure	All Member States of the Paris and Berne Unions	United Nations, International Labour Organization, United Nations Educational, Social and Cultural Organization, World Health Organization, Council of Europe, International Patent Institute, Organization of American States, Inter-American Association of Industrial Property, International Association for the Protection of Industrial Property, International Bureau for Mechanical Reproduction, International Chamber of Commerce, International Confederation of Societies of Authors and Composers, International Federation of Patent Agents, International Literary and Artistic Association

## Meetings of other International Organizations concerned with Intellectual Property

Place	Date	Organization	Title
Tunis	December 16 to 20, 1964	Union of African National Radio and Television Broadcasters (URTNA)	Administrative and Legal Study Group
Tel Aviv	January 31 to February 2, 1965	International Association for the Protection of Industrial Property (IAPIP)	Conference of Presidents
New Delhi	February 6 to 12, 1965	International Chamber of Commerce (ICC)	Congress
Paris	March 1 to 5, 1965	International Confederation of Societies of Authors and Composers (CISAC)	Legislative Committee
Stockholm	August 23 to 28, 1965	International Literary and Artistic Association (ALAI)	Congress