

Industrial Property

Monthly Review of the
WORLD INTELLECTUAL PROPERTY
ORGANIZATION (WIPO)

and the United International Bureaux for the
Protection of Intellectual Property (BIRPI)

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The breeder shall at all times keep a vegetative collection of the plant variety.

A description of the new plant variety shall be appended to the new plant variety certificate.

The certificate shall be enforceable against third parties from the date of its publication.

The denomination in the certificate shall be binding from the date of publication of the certificate for any commercial transaction, even following expiry of the certificate.

The denomination given to the variety may not be the subject of a trademark application in a State party to the Paris Convention of December 2, 1961. Such an application may however be made as a precautionary measure, without prejudicing the issue of a new plant variety certificate, provided that, prior to the issue of the certificate, evidence of renunciation of the effects of the application in States party to the Convention is produced.

The provisions of the preceding paragraph shall not prevent the addition of a trademark to the denomination of the variety concerned, in respect of one and the same variety.

Section 10

(I) Any person possessing the nationality of a State party to the Paris Convention of December 2, 1961, or domiciled or established in such State may apply for a new plant variety certificate in respect of varieties belonging to the genera or species mentioned in the list annexed to the Convention or in a supplementary list drawn up under the provisions of the Convention.

When an application is filed in France for a new plant variety certificate, any person referred to in the preceding paragraph may claim the priority of the first application previously filed in respect of the same variety by himself or by his predecessor in title, in one of the States referred to, provided that the application in France is made not more than twelve months after the first application.

Such matters as the filing of another application, the publication or exploitation of the subject of the application, occurring within the period of priority, shall not constitute grounds for contesting the validity of a new plant variety certificate for which an application has been filed in accordance with the preceding paragraph.

(II) In addition to the cases provided for in subsection (I) above, any foreigner may enjoy the protection of this Law provided that, in respect of the genera or species concerned, French citizens are accorded reciprocal protection in the State of which that foreigner is a national or in which he is domiciled or established.

Section 11

Fees for services rendered shall be charged in respect of preliminary examination, issue of the certificate and all entries or deletions.

A fee shall be payable annually throughout the period of validity of the certificate.

The scale of such fees shall be fixed by order of the Minister of Agriculture and the Minister of Economics and Finance.

The income from such fees shall be credited to a special section of the budget of the National Agronomic Research Institute.

CHAPTER II

Licenses of Authority and Obligations on the Breeder

Section 12

By decree issued upon the advice of the *Conseil d'Etat* or, where public health is affected, by joint order of the Minister of Agriculture and the Minister of Public Health, a variety essential to human or animal life may be declared subject to licensing by authority (*soumise au régime de la licence d'office*).

Section 13

From the date of publication of the order or decree declaring a new plant variety certificate subject to licensing by authority, any person offering appropriate technical and professional guarantees may apply to the Minister of Agriculture for a license to exploit the variety.

Such license shall be non-exclusive. It shall be granted by order subject to specified terms governing duration and scope in particular, but without reference to the royalties payable.

The license shall take effect on the date on which the parties are notified of the order.

In the absence of a friendly settlement, the amount of royalties shall be fixed by the courts determined in accordance with Section 33 below.

Section 14

Where the holder of a license of authority (*licence d'office*) has not fulfilled the conditions prescribed, the Minister of Agriculture may, upon the advice of the Committee for the Protection of New Plant Varieties, declare the license forfeited.

Section 15

For the purposes of national defense, the State may at any time obtain, on its own authority, a license to exploit a new plant variety in respect of which a new plant variety certificate has been applied for or issued, whether the variety is to be exploited by the State or on its behalf.

Such license of authority shall be issued, at the request of the Minister responsible for National Defense, by order of the Minister of Agriculture. The said order shall fix the terms of the license except those relating to royalties in respect of its use. The license shall take effect on the date of application for a license of authority.

In the absence of a friendly settlement, the amount of royalties shall be fixed by the courts determined in accordance with Section 33 below.

Section 16

The rights under a license of authority may not be assigned or transferred.

Section 17

The Minister responsible for National Defense is empowered to take cognizance, on a strictly confidential basis, of applications for certificates with the Committee for the Protection of Plant Varieties.

Section 18

A joint order by the Minister responsible for National Defense and the Minister of Agriculture shall list plant species in the case of which any new varieties covered by an application for a certificate may not be made available or freely exploited without special authorization.

Subject to Section 19, such authorization may be granted at any time. It shall be obtained as of right five months after the application for a certificate is filed.

Section 19

Before the expiry of the period provided for in the last paragraph of Section 18, the prohibition laid down in the first paragraph may be maintained, on instructions from the Minister responsible for National Defense, for a further period of one year, which may be renewed. A prohibition which has been extended may be lifted at any time, under the same procedure.

The applicant for a certificate shall be entitled to compensation in proportion to the loss suffered as a result of the maintenance of the prohibition under this Section. In the absence of a friendly settlement, the amount of compensation shall be fixed by the courts.

Section 20

A certificate owner may request review of the amount of compensation provided for under Section 19, after one year has elapsed since the final judgment fixing the compensation.

The certificate owner shall submit evidence showing that the loss sustained by him is in excess of the assessment of the court.

Section 21

For the purposes of national defense, the State may by decree, at any time, expropriate all or part of a new plant variety in respect of which a certificate has been applied for or issued.

In the absence of a friendly settlement, the amount of compensation for expropriation shall be fixed by the *tribunal de grande instance*².

CHAPTER III

Forfeiture of Rights

Section 22

The rights of the owner of a new plant variety certificate shall be forfeited where —

- (1) he is unable at any time to furnish the administration with the elements of reproduction or vegetative propagation such as seeds, cuttings, grafts, rhizomes and tubers, whereby the protected variety may be reproduced with its morphological and physiological characteristics as defined in the new plant variety certificate;
- (2) he refuses to submit to inspections to check the measures he has taken to maintain the variety;
- (3) he fails to pay, within the prescribed period, the annual fee provided for in the second paragraph of Section 11.

² A higher first instance court dealing with major civil cases.

Such forfeiture shall be ascertained by the Committee for the Protection of New Plant Varieties. Where the Committee's decision is based on subsection (3) above the owner of the certificate may, within the six months following the prescribed period, make an appeal for restoration of rights provided he justifies by legitimate reasons his failure to pay the fee. Such appeal shall not, however, prejudice any third-party rights. The final decision declaring forfeiture of rights shall be published.

CHAPTER IV

Infringement, Legal Proceedings and Penalties

Section 23

Any violation of the rights of the owner of a new plant variety certificate as set forth in Section 3 above shall constitute an infringement for which the offender shall be liable. However, violations committed by a third party other than the person carrying out the reproduction or propagation shall constitute infringement only if they were committed with knowledge of the facts.

Subject to Section 3, use of the protected variety as a source of initial variation with a view to obtaining a new plant variety shall not constitute violation of the rights of the certificate owner.

The holder of a license of authority under Sections 12 and 15 and, unless otherwise stipulated, any person having an exclusive right of exploitation may bring proceedings under the first paragraph above where the certificate owner fails, after a summons, to do so.

The certificate owner shall be entitled to take part in proceedings brought by the licensee in accordance with the preceding paragraph.

Any licensee shall be entitled to take part in proceedings brought by the certificate owner to obtain compensation for loss that he has personally sustained.

Section 24

Any intentional infringement of the rights of the owner of a new plant variety certificate as set forth in Section 3 shall constitute an offense punishable by a fine of from 2,000 to 15,000 francs. In the event of recidivism, a sentence of imprisonment, of from two to six months, may also be passed. Recidivism shall have occurred, within the meaning of this Section, when the offender has been convicted of the same offense within the five preceding years.

Section 25

Proceedings by the public prosecutor for the imposition of the sentences provided for in Section 24 shall be brought only upon formal complaint of the injured party.

The *tribunal correctionnel*³ hearing the case shall make no decision until the civil court, by a decision amounting to *res judicata*, has found the offense committed. The defense of nullity of the new plant variety certificate or those relating to ownership of the certificate may only be pleaded before the civil court.

³ Criminal court for less serious offenses.

Section 26

Events occurring before the issue of a certificate is published shall not be considered to infringe the rights under the certificate. Events occurring after a true copy of the application for a certificate has been served on the party presumed liable shall however be relevant and may be the object of proceedings.

Section 27

The owner of an application for a certificate or of a certificate is entitled, with the court's authorization, to cause a detailed description to be made, with or without seizure of goods, of any plant or part of a plant or of any element in vegetative reproduction or propagation alleged to have been obtained in violation of his rights. This right shall also be available to the assignee of an exclusive right of exploitation or the holder of a license of authority subject to the conditions stated in Section 23, third paragraph.

If the plaintiff fails to bring proceedings within the prescribed period, the said description or seizure shall be null and void, without prejudice to any damages which may be claimed.

Section 28

At the request of the injured party, the civil court may order on his behalf the confiscation of any plant or part of a plant or of any element in vegetative reproduction or propagation obtained in violation of the rights of the certificate owner and, where applicable, the confiscation of the instruments specifically intended for use in the reproductive cycle.

Section 29

The limitation period for bringing a civil or criminal action under this Law shall be three years starting from the events giving rise to the right of action.

The limitation period for criminal proceedings shall be suspended by the institution of civil proceedings.

Section 30

Where a variety for which a certificate has been applied for or granted is exploited for the purposes of national defense by the State or its suppliers, contractors or subcontractors without a license for exploitation of the variety having been issued, the court hearing the case may order neither the discontinuance nor the interruption of exploitation, nor confiscation as provided for in Section 28.

If an official appraisal or description, with or without seizure of goods, is ordered by the presiding judge of the court bearing the case, the appointed law official shall, for the time being, refrain from proceeding with the seizure, description and any investigation of the enterprise if the contract for research or reproduction or propagation has a national security classification.

The same shall apply where research, reproduction or propagation is carried out in a military establishment.

The presiding judge of the court hearing the case may, if so requested by the interested party, order an official appraisal, to be carried out only by persons approved by the

Minister responsible for National Defense and in the presence of his representatives.

The provisions of Section 26 shall not apply to applications for a certificate the subject matter of which is being exploited under the conditions set forth in this Section so long as such applications are subject to the prohibition provided for in Sections 18 and 19.

The persons carrying out such exploitation shall incur, without more, any liability arising from this Section.

Section 31

Any person improperly claiming to be the owner of a certificate or of an application for a new plant variety certificate shall be liable to a fine of from 2,000 to 5,000 francs. In the event of recidivism, the fine may be doubled. Recidivism shall have occurred, within the meaning of this Section, when the offender has been convicted of the same offense within the five preceding years.

Section 32

Without prejudice to any heavier penalties for offenses against national security, any person who knowingly infringes a prohibition under Sections 18 and 19 shall be liable to a fine of from 3,000 to 30,000 francs. Where such violation has been damaging to national security a sentence of one to five years' imprisonment may also be passed.

Section 33

Any disputes arising under this Law shall fall within the jurisdiction of the *tribunaux de grande instance* and the corresponding courts of appeal, with the exception of appeals from decrees and ministerial orders and decisions which fall within the jurisdiction of the administrative court.

Appeals from decisions of the Committee for the Protection of New Plant Varieties made under this Law shall be dealt with directly by the Paris Court of Appeal.

The *tribunaux de grande instance* empowered to hear civil actions shall be determined by decree. The number of such courts shall not be less than ten. The sphere in which each of the said courts shall perform its functions shall be laid down by the same decree.

Section 34

(I) Section 7, second paragraph, of Law No. 68-1 of January 2, 1968, to Promote Inventive Activity and Revise the Patent System⁴ shall be amended so as to include the following:

“The following, in particular, shall not be considered industrial inventions:

.....

(4) new plant varieties of a genus or species protected under Law No. 70-489 of June 11, 1970, on the Protection of New Plant Varieties.”

(II) Section 16 of the same Law shall be amended as follows:

“Any patent application shall be rejected:

.....

⁴ See *Industrial Property*, March 1968, p. 67.

- (7) which relates to a new plant variety of a genus or species protected under Law No. 70-489 of June 11, 1970, on the Protection of New Plant Varieties.”

Section 35

The provisions of Sections 42 and 43 of the Law of January 2, 1968, shall apply to applications for new plant variety certificates and to new plant variety certificates.

The same shall apply to Sections 44, 46 and 47 of the Law referred to, the Committee for the Protection of New Plant Varieties being substituted for the National Institute of Industrial Property.

CHAPTER V

Miscellaneous Provisions

Section 36

Where a new plant variety has lost its character of novelty at the time of application, the breeder may apply for a certificate protecting his rights, provided that, for less than twenty or twenty-five years, depending on the cases provided for in Section 6, and in any event before the entry into force of the decree provided for in Section 39 concerning the procedure for the issue of a certificate and the organization of the Committee for the Protection of New Plant Varieties, the variety in question—

has been the subject of a patent issued in a State party to the Paris Convention of March 20, 1883, or has been entered in an official catalog of one of the States party to the Paris Convention of December 2, 1961, or has been registered with a French professional association approved by the Committee for the Protection of New Plant Varieties.

The authenticity of the variety shall be determined by the date of deposit of the patent application, the date of entry in the official catalog or the date of registration by the professional association.

Where a new plant variety certificate is granted, it shall take effect from the date of application. Its duration shall be reduced by the period which has elapsed since the deposit of the patent application, entry in the official catalog or registration by the professional association.

Where the breeder of the variety concerned has at different times fulfilled more than one of the above conditions, only the date of the earliest such condition shall apply.

Section 37

Assignments of a new plant variety certificate and of the right of exploitation shall be registered at a fixed rate of 50 francs.

Section 38

This Law shall apply to the overseas territories of New Caledonia, French Polynesia, St. Pierre and Miquelon, Wallis and Futuna and the French Southern and Antarctic Territories.

Section 39

The detailed application of this Law shall be fixed by decree issued upon the advice of the *Conseil d'Etat*.

ITALY

Decrees Concerning the Temporary Protection of Industrial Property Rights at Eleven Exhibitions

(of December 11 and 19, 1970) *

Single Article

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

Mostra nazionale dell'oreficeria, gioielleria ed argenteria (Vicenza, January 24 to 31, 1971);

V° *EXPOSUDHOTEL - Salone internazionale delle attrezzature alberghiere, turistiche e di pubblico esercizio per il mezzogiorno e l'oltremare* (Naples, January 30 to February 7, 1971);

III° *SIVEL - Salone nazionale vini e liquori* (Naples, January 30 to February 7, 1971);

X° *Salone nautico internazionale* (Genoa, January 30 to February 8, 1971);

IX° *Salone internazionale del giocattolo* (Milan, January 31 to February 7, 1971);

VII° *Salone internazionale della chincaglieria, bigiotteria, cartoleria ed articoli da regalo* (Milan, January 31 to February 7, 1971);

VIII° *Salone internazionale delle macchine per movimenti di terra da cantiere e per l'edilizia - SAMO.TER* (Verona, February 7 to 14, 1971);

Salone internazionale della ceramica (Vicenza, February 21 to 28, 1971);

XII° *Mostra-convenio internazionale riscaldamento condizionamento refrigerazione idrosanitaria* (Milan, March 1 to 7, 1971);

XXV° *Presentazione internazionale "Moda della calzatura"* (Bologna, March 6 to 10, 1971);

LXXIII° *Fiera internazionale dell'agricoltura e della zootecnia* (Verona, March 14 to 21, 1971)

shall enjoy the temporary protection provided by Laws No. 1127 of June 29, 1939¹, No. 1411 of August 25, 1940², No. 929 of June 21, 1942³, and No. 514 of July 1, 1959⁴.

* Official communications from the Italian Administration.

¹ See *La Propriété industrielle*, August 1939, p. 124; May 1940, p. 84.

² *Ibid.*, November 1940, p. 196.

³ *Ibid.*, October 1942, p. 168.

⁴ *Ibid.*, February 1960, p. 23.

GENERAL STUDIES

**The French Law
on the Protection of New Plant Varieties**

By B. LA CLAVIÈRE

Revision of the Swiss Law on Trademarks

By Edouard PETITPIERRE
Attorney-at-Law and Doctor of Law, Lausanne

LETTERS FROM CORRESPONDENTS

Letter from Canada

By Christopher ROBINSON, Q. C., and Donald A. HILL

trade name, a symbol or any other identifying sign of the enterprise.

The distinctiveness of a trade name is based on the nature of the designation or on its use.

2. The trade name is the object of an exclusive right entitled to protection. This right is acquired by use, by registration of the trade name or by making it sufficiently known. Any one of these bases will suffice to afford trade name protection. If the trade name is neither used nor registered in the country for which protection is sought, nor sufficiently known there, protection shall be accorded if the trade name is sufficiently known internationally and if definite indications exist that the respective enterprise is extending its business activity to that country.

3. (a) The trade name is protected against any use or any registration by another party of the same or of a similar designation which is likely to give rise to a risk of confusion or which is likely to mislead the public.

- (b) If a trade name is well-known then it is also protected against use or registration for the purpose of designating enterprises that are active in other fields, to the extent that such use or registration is likely to mislead the public or to cause a prejudice to the owner of the trade name.

II. The International Association for the Protection of Industrial Property,

further requests that the aforementioned principles, independent of their inclusion in the Paris Convention, be considered by national legislatures and the courts in the countries of the Union as minimum requirements to protect trade names.

Question 42 — The inventor's certificate

The Executive Committee,

decides to continue the study of this question on the basis of the report of the Soviet Group (Annuaire 1970, p. 215).

Question 45 — Industrial property in the developing countries

The Executive Committee,

after having heard the report submitted by Mr. O'Farrell on behalf of the Committee for the study of the question of industrial property in developing countries.

1. decides to continue the study of the question;
2. charges the Committee to proceed with its study, primarily by collecting information from the UNO and the WIPO, and by consulting the national Groups in taking account of the report which has been presented by the Swiss Group;
3. charges the Committee to submit a preliminary report to one of the next meetings of the Council of Presidents.

Question 47 — Effect of the territoriality of trademark rights in case of unauthorized importation of products

The Executive Committee,

decides to remove Question 47 from the list of questions to be studied by IAPIP.

Question 48 — Application of Articles 2 and 15 of the Union Convention

The Executive Committee,

adopts the following resolution:

The International Association for the Protection of Industrial Property,

considering that the application of national treatment to nationals of countries of the Union constitutes the fundamental basis of the Convention,

holds that any national of a country of the Union shall enjoy in any other country of the Union the advantages granted to the nationals in their own country not only by national law, but also by international agreements.

Question 50A — Revision of the Statutes in view of the introduction of the Spanish language as a working language

The Executive Committee,

decides to place on the agenda of the next General Assembly a proposition for the revision of Article X of the Statutes to introduce the Spanish language as a working language which may be used for the debates in the plenary sessions of the General Assembly, the Congress and the Executive Committee, whereas documents may not be drawn up in Spanish.

Question 51 — Application of the International Convention on the Protection of Plant Varieties of 1961

The Executive Committee,

adopts the following resolution:

The International Association for the Protection of Industrial Property,

welcomes the increased and improved possibilities for protecting new plant varieties brought about by the Convention for the Protection of New Varieties of Plants of 1961 which entered into force in 1968.

However, the interpretation of Article 13(9) causes some concern.

It seems that it has been interpreted to mean that the producer or seller of a new variety is entitled to add a trademark to the denomination of that variety, only if that trademark is used for a range of varieties originating from him.

After careful consideration, IAPIP has reached the conclusion that this is not the proper interpretation.

The word "product" in Article 13(3) and (9) means any merchandise sold under a trademark and in case of Article 13(9) is wide enough to include a single plant variety. When a category of products is involved the words "species" and "genus" are used in the Plant Variety Convention.

The aim of Article 13(9) is to preserve the basic right of any trademark owner to use a trademark for a particular

product, just as much as he would be entitled to use it for a range of products which includes the particular product.

Moreover, any prohibition against the use of a trademark for a single variety only, would contravene Article 7 of the Industrial Property Convention, wherever use or intention to use is prerequisite for a valid trademark registration.

IAPIP accordingly draws this matter to the attention of the Council of UPOV and asks it to take such measures as may be appropriate.

Question 52 — Possible revision of the Madrid Agreement Concerning the International Registration of Trademarks

The Executive Committee,

- I. considering that it is not expedient at the present time to take a new decision on the question of independence of the international registration with regard to the national registration of origin, decides to pursue the study of this question.
- II. As to the points III, IV, V, VI and X of the list of questions of BIRPI (MM/I/2) the Executive Committee of IAPIP approves the following report of the Working Committee:

(a) Territorial limitation

With regard to question III on territorial limitation, a majority has expressed itself in favour of a generalized limitation, that is in favour of an obligation for the applicant of choosing already at the filing of the international application, those countries in which he wishes to protect his mark.

A majority has also spoken in favour of an obligation for the applicant to designate at least three countries at the filing of the application.

(b) Number of classes of goods or services covered by the filing

With regard to question IV, the national groups were agreed that the fees would be increased in one way or the other, in order to avoid a cluttering up of the registers. The majority has spoken in favour of the obligation to pay a fee for each class. A minority of delegates proposed that a supplementary fee should be paid, some of them from the third class and others from the fourth class, in order to take into account the fact that certain products fall in several classes simultaneously.

(c) Transmittal of the documents to the national offices

With regard to question V which concerns the transmission of certain documents to the national patent offices and the obligation of the WIPO to require such documents as a condition of the international registration, a majority has expressed itself against the introduction of provisions of this kind into the text of the Agreement.

(d) Time limit for refusing protection

With regard to question VI which concerns the term within which the protection should be refused, the majority has expressed itself in favour of retaining the present term of one year, although counted from the date the international registration was published.

(e) English as the second working language

With regard to question X, which concerns the possibility of adopting English as a second working language, a majority of the groups has spoken in favour of introducing English as a working language into the Madrid Agreement.

Countries which are members of the Agreement shall state which of the two working languages they wish to use.

As to the language to be used for the list of products, the following system has been considered and approved unanimously by the delegates.

- If among the countries indicated by the applicant, there appear only countries having chosen French as a working language, the list of products shall be published in French only;
- If among the countries indicated by the applicant, there appear only countries having chosen English as a working language, the list of products shall be published in English only;
- If the applicant indicates countries falling in both preceding categories, the list shall be published both in French and English.

Question 53 — Know-how

The Executive Committee,

decides to continue the study of the question based on the report of the Working Committee and on the comments submitted during the session of October 23, 1970.

Meetings of Other International Organizations Concerned with Intellectual Property

April 17 to 24, 1971 (Vienna) — International Chamber of Commerce — Congress

May 18 to 21, 1971 (Caracas) — Inter-American Association of Industrial Property — 3rd Congress

May 18 to 22, 1971 (Stockholm) — International Federation of Patent Agents — General Assembly

May 25 to 29, 1971 (Leningrad) — International Association for the Protection of Industrial Property — Council of Presidents

June 21 to 28, 1971 (Toronto - Montreal) — International Writers Guild — 3rd Congress

July 5 to 24, 1971 (Paris) — Unesco — Diplomatic Conference for the Revision of the Universal Copyright Convention

International Conference for the Setting Up of a European System for the Grant of Patents (Luxembourg):

April 20 to 30, 1971 — Conference

September 13 to 17, 1971 — Working Party I

October 11 to 22, 1971 — Working Party I

November 15 to 19, 1971 — Working Party I
