



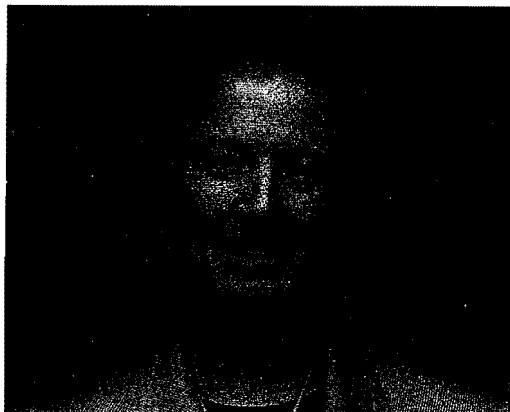
THE NEW YORK PATENT, TRADEMARK AND COPYRIGHT LAW ASSOCIATION

NYPTC BULLETIN

Volume 33

January/February 1993

Number 3



The Patent Harmonization Debates, to be held in conjunction with Fordham University, are scheduled for March 25-26, 1993. The program will feature a day and a half of excellent debates on the important issues relating to patent harmonization. Senator Dennis DeConcini has agreed to be a luncheon speaker on Thursday, March 25. Brochures, including registration information, will be included in upcoming mailings from this Association, as well as mailings from the American Intellectual Property

Law Association. This promises to be an excellent preparation for the WIPO Diplomatic Conference, which is scheduled for July 12-30, 1993 in Geneva and to which we will send a delegate.

The Annual Dinner in Honor of the Federal Judiciary is to be held back-to-back with this event, and with Edward I. Koch as our speaker, this too should be an interesting event.

— M. Andrea Ryan

PRESIDENT'S CORNER

The 1993 new Administration in Washington has brought a flurry of new activity to the Association. By the time this column appears, we should know who the new Commissioner of Patents and Trademarks is. As of this time, there are at least five people being considered for the position. This Association has recommended Robert A. Armitage, Vice President, Corporate Intellectual Property Law, The Upjohn Corporation. Time will tell.

Several hats are also in the ring for the vacancy on the Court of Appeals for the Federal Circuit. John Pegram of Davis, Hoxie, Faithfull and Hapgood, a past President of the Association, is actively seeking the position, as is Professor Donald S. Chisum of Morrison and Foerster, Seattle, Washington. These names have been referred to the Committee on Public and Judicial Personnel and we intend to take a position on the qualifications of these candidates as soon as we have a report from the Committee and the Clinton Administration names a person to deal with recommendations for these vacancies.

CALENDAR OF EVENTS

February 7-10, 1993

Patent Resources Group: Advanced U.S. Patent Practice—CAFC Current Awareness 1991-93; Contingent Fee Patent Litigation & Licensing. Steamboat Springs, Colorado

February 21-26, 1993

Patent Resources Group: Advanced Patent Application & Amendment Writing Workshop. Alexandria, Virginia

February 25-26, 1993

John Marshall Law School: 37th Conference on Developments in Intellectual Property Law. Chicago, Illinois

March 6-12, 1993

PLI: Patent Bar Review Course. New York City

March 18-19, 1993

USTA Forum: The Art and Strategy of Successful Trademark Licensing and Franchising. Chicago, Illinois

March 25-26, 1993

NYPTC/Fordham University School of Law Patent Harmonization Debates. Fordham University School of Law, New York, NY

March 26, 1993

NYPTC Annual Dinner in Honor of the Judiciary. Waldorf-Astoria Hotel

March 31 - April 2, 1993

ABA-PTCS: Litigation and Corporate Practice. Arlington, Virginia

PATENT HARMONIZATION ISSUES TO BE DEBATED

by William J. Brunet

On March 25 and 26, 1993, a series of debates on patent harmonization will be held at Fordham Law School. These debates are being sponsored by the NYPTC and Fordham Law School in cooperation with the AIPLA and the NCIPLA.

The Patent Harmonization Treaty may be a reality in 1993; and, if approved, it will change our patent laws more significantly than at any time in the last 150 years. In addition to changing from a first-to-invent system to a first-to-file system, the treaty will require changes in the definition of prior art, the grace period, the term of patents, secrecy of patent applications and rights of prior users. In addition, the treaty will require foreign countries to recognize a grace period, to eliminate pre-grant oppositions, to conduct examination with greater dispatch and to recognize a doctrine of equivalents. Whether these and other provisions of the treaty provide a *balanced package* in the interests of the United States is a question of importance to all practitioners and their clients.

The Association has arranged for well recognized experts to speak for and against each of several important issues raised by the treaty. For maximum effect in bringing out the benefits and consequences of the treaty, a rigid debate format has been selected, with a period for questions and comments after each speaker's presentation, followed by a period for summations by the speakers. About one and one half hours will be assigned to each issue. Reference materials, including copies of the treaty and summaries of the main points to be argued on each issue will be provided to those who attend.

Introductory comments will be provided by Michael K. Kirk, Assistant Commissioner for External Affairs of the USPTO and Ludwig Baeumer, Director, Industrial Property Division of WIPO.

The issues to be debated and the main speakers for and against each issue are as follows:

ISSUE NO. 1

Patent Harmonization will provide changes in the laws of other countries that will be of significant benefit to U.S. inventors and their assignees.

Speaker For: William L. Keefauver
(President IIPA – New Vernon, NJ)

Speaker Against: Thomas E. Fisher
(Watts, Hoffman, Fisher & Heinke –
Cleveland, OH)

ISSUE NO. 2

If the United States adopts a first-to-file system, it should provide for the publication of pending patent applications eighteen or twenty-four months after their filing or priority date.

Speaker For: Jerome G. Lee
(Morgan & Finnegan – New York, NY)

Speaker Against: Paul H. Heller
(Kenyon & Kenyon – New York, NY)

ISSUE NO. 3

If the United States adopts a first-to-file system, it should accept a limitation on the scope of its grace period to acts of the inventor and assignees and derivers from the inventor.

Speaker For: Nancy J. Linck
(Cushman, Darby & Cushman –
Washington, D.C.)

Speaker Against: Joseph A. DeGrandi
(Beveridge, DeGrandi & Weilacher –
Washington, D.C.)

ISSUE NO. 4

If the United States adopts a first-to-file system, it should grant prior user rights to those who, before the filing or priority date, commercially used or made serious and effective preparations for use of the invention in the United States.

Speaker For: Roger S. Smith
(IBM Corporation – Purchase, NY)
Speaker Against: Douglas W. Wyatt
(Wyatt, Gerber, Burke & Badie –
New York, NY)

ISSUE NO. 5

A U.S. patent or application which was published subsequent to the filing or priority date of another's application shall be effective as prior art, for novelty purposes only, as of its own filing or priority date.

Speaker For: Michael J. Pantuliano
(Pfizer Corporation – New York, NY)

Speaker Against: Howard W. Bremer
(Wisconsin Alumni Research Foundation
– Madison, WI)

ISSUE NO. 6

If the United States adopts a first-to-file system, it should consider as part of prior art, publicly available information anywhere in the world even if not published or patented.

Speaker For: William S. Thompson
(Caterpillar Incorporated – Peoria, IL)

Speaker Against: John B. Pegram
(Davis Hoxie Faithfull & Hapgood –
New York, NY)

ISSUE NO. 7

The United States should adopt a first-to-file system as part of a balanced package in the interest of achieving worldwide patent harmonization.

Speaker For: Robert A. Armitage
(The Upjohn Corporation –
Kalamazoo, MI)

Speaker Against: Donald W. Banner
(Banner, Birch, McKie & Beckett –
Washington, D.C.)

At the forthcoming debates
on Patent Harmonization
on March 25 and 26, 1993
at Fordham Law School under
the auspices of the NYPTC,
the WIPO Treaty on
Harmonization
will be discussed.
A copy of the Treaty is included
as an insert in this issue
of the *Bulletin*.

This event is timed to coincide with the annual dinner in honor of the Federal Judiciary which will be held at the Waldorf Astoria Hotel on Friday, March 26, 1993. This will enable Association members and their guests to combine an educational program with a social function. We are advised that the program should qualify for CLE credit.

Flyers for the program are being mailed out separately to Association members and to AIPLA members. For further information, please contact William J. Brunet (Fitzpatrick, Cella, Harper & Scinto) at 212/758-2400 or Michael N. Meller (Meller & Associates) at 212/953-3350. ■

STEPHEN KING v. INNOVATION BOOKS: GIVING CREDIT WHERE CREDIT'S NOT DUE

by Richard S. Mandel

The following is a summary of a speech which Richard Mandel gave at a recent luncheon meeting of the Association.

In an industry where the typical dispute involves a battle for bigger and bolder credits, the recent case of *King v. Innovation Books*, 976 F.2d 824 (2d Cir. 1992) presented the reverse situation. The lawsuit involved an attempt by the world renowned author Stephen King to have all his credits removed from the motion picture "The Lawnmower Man" on the grounds that they were false and misleading under Section 43(a) of the Lanham Act and applicable state law. King's objections were

directed in particular against two types of credits: 1) a possessory credit, in which the movie was entitled "Stephen King's The Lawnmower Man"; and 2) a "based upon" credit which represented the movie as having been "based upon a short story by Stephen King."

King had written his ten page short story "The Lawnmower Man" back in 1970 before he had achieved his famed status, and he had assigned the adaptation rights to the story to a predecessor of defendant Allied Vision, Ltd. in 1978. The agreement gave broad rights to the producer to do what it saw fit with the story, but was silent on the question of credits except for a provision that required that King receive credit for any movie based "wholly or substantially" on his story. King himself played no role at all in the making of the film.

The movie in its final format included the climactic scene of King's short story in which a lawnmower directed solely by the power of the human mind chases a man through his house before chopping him to death. However, according to King's testimony, that scene had been "cynically" dropped into a movie which otherwise had nothing to do with his short story solely to justify the use of his name in selling the movie.

At the district court level, Judge Motley of the Southern District of New York accepted King's arguments across-the-board and entered a preliminary injunction prohibiting any use of his name in connection with the movie. As to the possessory credit, she found it to be false on its face because King had not participated in any way in the making of the film, and had not even given his approval to the film at any point in the creative process (as he had done with other movies in which a possessory credit had been used). With respect to the "based upon" credit, Judge Motley found that while it afforded the defendants more leeway in describing King's relationship to the movie, such a credit "grossly exaggerated" the relationship between the movie and his short story in a way that would likely mislead the public.

On appeal, a unanimous panel of the Second Circuit affirmed as to the possessory credit, finding ample evidence to support Judge Motley's conclusion, but reversed as to the "based upon" credit. Although it was the possessory credit that

constituted the major emphasis of the lawsuit, it is the "based upon" credit that presents the more challenging legal question.

The Second Circuit ruled that Judge Motley had erred in finding the "based upon" credit misleading because she had focused on the small amount of the film that was derived from the short story (about two minutes out of a nearly two hour film), rather than the relatively larger amount of the short story that was used in the film (approximately three pages out of a ten page story representing the climactic scene of the story). The Court held that the starting point in the analysis was a copyright test: if under principles of copyright law, the movie would — without a license from King — be considered an infringing derivative work, then the movie could accurately be said to be "based upon" the short story, in the absence of "persuasive countervailing facts and circumstances." Applying this copyright standard, the Court concluded that the movie was "based upon" the short story since regardless of how much other material was contained in the movie, the inclusion of the climactic scene of the short story would have to be considered both qualitatively and quantitatively significant.

The question arises whether in the context of King's Lanham Act claim, the copyright standard is an appropriate test. There are arguably differing policies underlying the copyright and trademark principles at work, and it may well be that the transfer of copyright principles is not the best way to analyze the question. For example, there are certainly important reasons from a copyright perspective why one would look to the amount of material taken from the underlying work itself in determining infringement. Certainly, the law would not want to insulate infringers from liability by encouraging them to take substantial portions of a relatively short work and have them bury it within a much larger work. To use a crude example, the fact that one had plagiarized all of a five page short story and reproduced it within a five hundred page novel involving completely different characters and themes should not protect one from a finding of infringement.

Applying that same example in the context of the Lanham Act, however, it would still appear to be false advertising to claim in such a situation that the novel had been "based upon" the short story, even

assuming that the necessary rights to use the short story had been obtained. The critical point is that the Lanham Act is concerned with the public's perception, and it is doubtful that the words "based upon" will be understood by the public in a way having anything to do with the nuances of the copyright law. To return to the language of Judge Motley's opinion below, it would appear likely that the public will be misled by the use of "based upon" language into believing some connection between King and the short story going beyond the inclusion of one scene from the story occupying only two minutes of screen time and "used in a manner fundamentally inconsistent with the essential plot, characters and theme of the short story." 24 USPQ 2d at 1280.

Now in fairness to the Second Circuit, it did qualify the copyright standard it imposed with a caveat: that the use of "based upon" would not be misleading where it was accurate in a copyright law sense, "*absent persuasive countervailing facts and circumstances.*" 976 F.2d at 830 (emphasis added). And since the preliminary injunction hearing took place on a highly expedited schedule with the major focus on the possessory credit, there was little in the record from which to extrapolate the public's perception of the "based upon" language. In fact, there was even some expert testimony in the record arguably supporting the Second Circuit's approach at least insofar as industry standards are concerned. Nevertheless, the question remains for future cases (and perhaps the final trial on the merits in this case) whether the copyright law is the appropriate starting point for claims of this nature, with evidence of consumer understanding reduced to mere "countervailing" facts to be weighed in the balance. I would suggest that for purposes of the Lanham Act, the proper focus should be the public's understanding since it is, after all, the public that the Lanham Act is ultimately designed to protect. ■

NEWS FROM THE BOARD OF DIRECTORS

by William H. Dippert

At the October 13 Board meeting, Howard Barnaby, who distributed the Treasurer's Report, commented that the Association's bank balance is higher than usual because the Nassau Inn had not yet been paid for the recent CLE Weekend. In addition, Mr. Barnaby distributed a list of members who had not responded to a third notice for dues. He was authorized to send a follow-up letter.

Andrea Ryan advised that at the next Board meeting Edward Vassallo would present a report concerning the CLE Fall Weekend Program. This was followed by discussion among the Board concerning (1) reasons for disappointing attendance and (2) possible changes to the present CLE program to encourage additional attendance, such as holding the program in New York City. John Murnane reported that Fordham Law School may be receptive to hosting a CLE Weekend, and Ms. Ryan asked him to convey this to Mr. Vassallo.

Michael Meller discussed efforts to conduct a harmonization program next spring prior to the Judges' Dinner. He reported that he and William Brunet had met with representatives from Fordham Law School and had reviewed the facilities that FLS is willing to make available. Also, he reported that if about \$300 is charged per attendee, the program should at least break even. There was extensive discussion concerning the structure of the program, particularly the extent of participation by patent agents or attorneys from outside the U.S. It was finally determined that Mr. Meller and Mr. Brunet would meet, in conjunction with their respective committees, to reach an agreement as to the format of the program.

Theresa Gillis reported on behalf of the U.S. Patent Practice Committee. She indicated that her committee has been asked to consider whether the U.S. Patent and Trademark Office should be an independent agency, which consideration will involve reviewing a formal report prepared

by the AIPLA. In addition, Ms. Gillis reported about the NIH Gene Sequence patent application. Ms. Ryan asked that Ms. Gillis' committee continue to monitor the NIH application, perhaps in coordination with Thomas Creel.

Andrea Ryan reported on her efforts to secure a speaker for the 1993 Judges Dinner. She indicated that there is an outstanding invitation to a Supreme Court Justice and that a Second Circuit Judge is her next choice.

Pasquale Razzano reported that he will be meeting shortly with Horizon and the Waldorf-Astoria concerning the Judges Dinner. It was agreed that bankruptcy judges and the chairman of the Patent Section of the NYSBA would be invited again this year.

Mr. Barnaby reported that he had met with Wayne Kennard and his Public Forum Committee. Among the items discussed was the possibility of a permanent telephone number in Manhattan for the Association. Mr. Razzano offered to ask Horizon about having them answer any such telephone line.

Ms. Ryan commented that with regard to the Federal Circuit, nothing concerning proposed candidates was expected until the end of the year. Mr. Smith commented that the Association should be pro-active in this regard.

By unanimous vote, twenty-six applicants were elected to membership.

Greg Battersby commented that Prentice-Hall may be interested in forming a relationship with an intellectual property association. The extent of the possible relationship is not clear, but it could include having Prentice-Hall sponsor the *Greenbook*. Also, perhaps there may be a publication that could be published on a royalty basis.

At the November 20 Board meeting, Howard Barnaby reported that notices were sent to Association members who had not responded to a third notice for dues. Any member who does not respond within thirty days to this letter will be deleted from the mailing list. Mr. Barnaby expressed some concern about any deposit that may be required in connection with the August, 1993 function for the ABA. He recommended that any deposit requirement be minimized and/or deferred.

Edward Filardi reported on the Host

DRAFT TREATY SUPPLEMENTING THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY AS FAR AS PATENTS ARE CONCERNED (PATENT LAW TREATY)

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PREAMBLE

The Contracting Parties

Alternative A

DESIRING to strengthen international cooperation in respect of the protection of inventions,

CONSIDERING that such protection is facilitated by a harmonization of patent law,

RECOGNIZING the need to take into consideration the public policy objectives underlying national patent law,

TAKING INTO ACCOUNT development, technological and public interest objectives of the Contracting Parties.

HAVE CONCLUDED the present Treaty, which constitutes a special agreement within the meaning of Article 19 of the Paris Convention for the Protection of Industrial Property.

Alternative B

Note: Same text as Alternative A, without the third and fourth paragraphs.

Article 1

Establishment of a Union

The States and intergovernmental organizations party to this Treaty (hereinafter called "the Contracting Parties") constitute a union for the purposes of this Treaty.

Article 2

Definitions

For the purposes of this Treaty, unless expressly stated otherwise:

(i) references to an "application" or "application for a patent" shall be construed as references to an application for a patent for invention;

(ii) "priority date" means the fil-

ing date of the application for a patent, utility model or other title protecting an invention which has been filed with another or, where the Contracting Party so provides, the same Office and the priority of which is claimed; where the priorities of two or more such applications are claimed, the priority date,

(a) for the purpose of computing time limits, shall be the filing date of the earliest-filed of those applications,

(b) for any other purpose, shall be, for each element of the invention, the filing date of the earliest-filed of those applications which contain that element;

(iii) "prescribed" means prescribed in the Regulations under this Treaty that are referred to in Article 29;

(iv) references to a "patent" shall be construed as references to a patent for invention;

(v) "Office" means the governmental or intergovernmental agency entrusted with the granting of patents by a Contracting Party;

(vi) references to a "person" shall be construed as references to both a natural person and a legal entity;

(vii) "Director General" means the Director General of the World Intellectual Property Organization;

(viii) "published" means made accessible to the public;

(ix) "substantive examination" means the examination of an application by an Office to determine whether the invention claimed in the application satisfies the conditions of patentability referred to in Article 11(2) and (3);

(x) references to an "instrument of ratification" shall be construed as including references to instruments of acceptance and approval;

(xi) "Assembly" means the Assembly of the Union;

(xii) "Union" means the Union referred to in Article 1;

(xiii) "Organization" means the World Intellectual Property Organization;

(xiv) "Regulations" means the Regulations under this Treaty that are referred to in Article 29.

Article 3 Disclosure and Description

(1) [Disclosure] (a) The application shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

(b) Where the application refers to biologically reproducible material which cannot be disclosed in the application in such a way as to enable the invention to be carried out by a person skilled in the art and such material is not available to the public, the application shall be supplemented by a deposit of such material with a depositary institution. Any Contracting Party may require that the deposit be made on or before the filing date or, where priority is claimed, the priority date of the application.

(2) [Description] (a) The application shall contain a description.

(b) The description shall have the prescribed contents, and such contents shall be presented in the prescribed order.

(3) [Prohibition of Other Requirements] In respect of the disclosure or the description, no requirement additional to or different from those provided for in this Article and in the relevant provisions of the Regulations may be imposed.

Article 4 Claims

(1) [Requirement of Claims in the Application] The application shall contain one or more claims.

(2) [Contents of the Claims] The claims shall define the matter for which protection is sought.

(3) [Style of the Claims] Each claim shall be clear and concise.

(4) [Relation of the Claims with the Description] The claims shall be supported by the description.

(5) [Manner of Presentation of the Claims] (a) The claims shall be presented in the prescribed manner.

(b) A Contracting Party shall be free not to require compliance with all of the requirements prescribed under subpara-

graph (a).

(6) [Prohibition of Other Requirements] In respect of the claims, no requirement additional to or different from those provided for in paragraph (1) to (4) and (5)(a) may be imposed.

Article 5 Unity of Invention

(1) [Requirement of Unity of Invention] The application shall relate to one invention only or to a group of inventions so linked so as to form a single general inventive concept ("requirement of unity of invention").

(2) [Validity of Patent Not Affected by Lack of Unity of Invention] The fact that a patent has been granted on an application that did not comply with the requirement of unity of invention shall not be a ground for the invalidation or revocation of the patent.

Article 6 Identification and Mention of Inventor: Declaration Concerning the Entitlement of the Applicant

(1) [Identification of the Inventor in the Application] (a) The application shall, as prescribed, identify the inventor or, where there are several inventors, all of them.

(b) No patent may be granted on an application that does not identify an inventor.

(2) [Mention of the Inventor in Publications of the Office] Any publication of the Office, containing the application or the patent granted thereon, shall mention the inventor or inventors as such, provided that any inventor may request, in a declaration signed by him and filed with the Office, that such publications should not mention him as inventor, in which case the Office shall proceed accordingly.

(3) [Indication of the Applicant's Entitlement] Any Contracting Party may require that the application indicate the legal grounds of his entitlement to file the application.

(4) [Prohibition of Other Requirements] In respect of the identification or mention of the inventor or in respect of the indication of the applicant's entitlement, no requirement additional to or

different from those provided for in the preceding paragraphs may be imposed.

Article 7 Related Claiming of Priority

(1) [Delayed Submission of Priority Claim] Where the application ("the subsequent application") could have claimed the priority of an earlier application but, when filed, did not contain such priority claim, the applicant shall have the right to claim such priority in a separate declaration submitted to the Office within a period to be fixed by the Contracting Party which shall be at least two months from the filing date of the subsequent application and not more than four months from the date on which a period of 12 months from the filing date of the earlier application expired.

(2) [Delayed Filing of the Subsequent Application] Where the application ("the subsequent application") which claims or could have claimed the priority of an earlier application is filed after the date on which a period of 12 months from the filing date of the earlier application expired but before the expiration of a period of two months from the date on which that 12-month period expired, the Office shall restore the right of priority upon an express request submitted to the Office before the expiration of the said two-month period, if the request states and the Office finds that, in spite of all due care required by the circumstances, the subsequent application could not have been filed within the said 12-month period. The request for restoration shall state the grounds on which it is based, and the Office may require the production of corresponding evidence.]

Article 8 Filing Date

(1) [Absolute Requirements] The filing date of the application shall be the date of receipt by the Office of at least the following elements:

- (i) an express or implicit indication that the granting of a patent is sought;
- (ii) indications allowing the identity of the applicant to be established;
- (iii) a part which, on the face of it, appears to be a description of an invention.

(2) [Permitted Additional Requirement] (a) A Contracting Party may provide that the filing date may be refused if either of the following requirements is not satisfied within the prescribed time limit:

(i) the application contains a part which, on the face of it, appears to be a claim or claims;

(ii) the required fee is paid.

Where a Contracting Party provides for any of the foregoing requirements and the requirements are complied with later than the date of receipt by the Office of the elements referred to in paragraph (1), but within the prescribed time limit, the filing date of the application shall be the date of receipt by the Office of the said elements.

(b) A Contracting Party may apply a requirement referred to in subparagraph (a) only if

(i) it applied such requirement at the time of becoming party to this Treaty, or

(ii) it has, after having become party to this Treaty, to apply such requirement in order to comply with an obligation under a treaty concluded before the date of entry into force of this Treaty.

(3) [Drawings] If the application refers to drawings but such drawings are not received by the Office at the date of receipt of the elements referred to in paragraph (1), at the option of the applicant either any reference to the drawings shall be deemed to be deleted or the filing date of the application shall be the date on which the drawings are received by the Office.

(4) [Replacing Description Claims and Drawings by Reference to Another Application] Notwithstanding paragraphs (1), (2) and (3),

Alternative A: each Contracting Party shall

Alternative B: any Contracting Party may

provide that a reference in the application to another previously filed application for the same invention by the same applicant or his predecessor in title may, for the purposes of the filing date of the application, replace any of the following elements:

(i) the part which, on the face of

it, appears to be a description of an invention,

(ii) the part which, on the face of it, appears to be a claim or claims, or

(iii) any drawings,

provided that the said parts and drawings and, where the other application was not filed with the same Office, a certified copy of the other application are received by the Office within the prescribed time limit. If the said parts and drawings, and, where required, the certified copy, are received by the Office within the said time limit, the filing date of the application shall, provided that the other requirements concerning the filing date are fulfilled, be the date on which the application containing the reference to the previously filed application was received by the Office.

(5) [Language] (a) Any Contracting Party may require that the indications referred to in paragraph (1)(i) and (ii) be in the official language.

(b) Any Contracting Party may, if any of the parts referred to in paragraph (1)(iii) and paragraph (2)(a)(i) or any text matter contained in any drawings is in a language other than the official language, require that a translation thereof in the official language be received by its Office within the prescribed time limit. If the translation is so received, the filing date of the application shall be the date of receipt by the Office of the elements referred to in paragraph (1) in the language in which they were first received.

(c) Any Contracting Party may require that the parts referred to in paragraph (4)(i) and (ii) and any text matter contained in drawings referred to in paragraph (4)(iii) be furnished in the official language within the time limit referred to in paragraph (4).

(d) For the purposes of this paragraph, "official language" means the official language of the Office or, if there are several such languages, any of them.

(6) [Prohibition of Other Requirements] (a) In respect of the filing date, no requirement additional to or different from those provided for in the preceding paragraphs may be imposed.

(b) Notwithstanding subparagraph (a), a Contracting Party may, for the purposes of any treaty providing for the grant of regional patents, require that an appli-

cation for a regional patent contain the designation of at least one State party to that treaty.

Article 9 Right to a Patent

(1) [Right of Inventor] The right to a patent shall belong to the inventor. Any Contracting Party shall be free to determine the circumstances under which the right to the patent shall belong to the employer of the inventor or to the person who commissioned the work of the inventor which resulted in the invention.

(2) [Right Where Several Inventors Independently Made the Same Invention] Where two or more inventors independently have made the same invention, the right to a patent for that invention shall belong,

(i) where only one application is filed in respect of that invention, to the applicant, as long as the application is not withdrawn or abandoned, is not considered withdrawn or abandoned, or is not rejected, or

(ii) where two or more applications are filed in respect of that invention, to the applicant whose application has the earliest filing date or, where priority is claimed, the earliest priority date, as long as the said application is not withdrawn or abandoned, is not considered withdrawn or abandoned, or is not rejected.

Article 10 Fields of Technology

Alternative A

(1) Patent protection shall be available for inventions in all fields of technology which are new, which involve an inventive step and which are industrially applicable, except for:

(i) inventions whose use would be contrary to public order, law or morality or injurious to public health;

(ii) plant or animal varieties or essentially biological processes for the production of plants or animals;

(iii) discoveries and materials or substances already existing in nature;

(iv) methods of medical treatment for humans or animals;

(v) nuclear and fissionable material.

(2) Contracting States may, on grounds of public interest, national security, public health, nutrition, national development and social security, exclude from patent protection, either in respect of products or processes for the manufacture of those products, certain fields of technology, by national law.

(3) Contracting States shall notify the Director General of such exclusions by a written declaration. Any such declaration may be withdrawn at any time totally or partially by notification addressed to the Director General.

Alternative B

Patent protection shall be available for inventions, whether they concern products or processes, in all fields of technology.

Article 11 Conditions of Patentability

(1) [Patentability] In order to be patentable, an invention shall be novel, shall involve an inventive step (shall be non-obvious) and shall be, at the option of the Contracting Party, either useful or industrially applicable.

(2) [Novelty] (a) An invention shall be considered novel if it does not form part of the prior art. For the determination of novelty, items of prior art may only be taken into account individually.

(b) The prior art shall consist of everything which, before the filing date or, where priority is claimed, the priority date of the application claiming the invention, has been made available to the public anywhere in the world.

(c) Notwithstanding subparagraph (b), any Contracting Party shall be free to exclude from the prior art matter made available to the public, by oral communication, by display or through use, in a place or space which is not under its sovereignty or, in the case of an inter-governmental organization, under the sovereignty of one of its member States.]

(3) [Inventive Step (Non-Obviousness)] An invention shall be considered to involve an inventive step (be non-obvious) if, having regard to the prior art as defined in paragraph (2), it would not have been obvious to a person skilled in the art at the filing date or, where priority

is claimed, the priority date of the application claiming the invention.

Article 12 Disclosures Not Affecting Patentability (Grace Period)

(1) [Circumstances of Disclosure Not Affecting Patentability] Disclosures of information which otherwise would affect the patentability of an invention claimed in the application shall not affect the patentability of that invention where the information was disclosed, during the 12 months preceding the filing date or, where priority is claimed, the priority date of the application,

(i) by the inventor,

(ii) by an Office and the information was contained (a) in another application filed by the inventor and should not have been disclosed by the Office, or (b) in an application filed without the knowledge or consent of the inventor by a third party which obtained the information direct or indirectly from the inventor,

(iii) by a third party which obtained the information direct or indirectly from the inventor.

(2) ["Inventor"] For the purposes of paragraph (1), "inventor" also means any person who, at the filing date of the application, had the right to the patent.

(3) [No Time Limit for Invoking Grace Period] The effects of paragraph (1) may be invoked at any time.

(4) [Evidence] Where the applicability of paragraph (1) is contested, the party invoking the effects of that paragraph shall have the burden of proving, or of making the conclusion likely, that the conditions of that paragraph are fulfilled.

Article 13 Prior Art Effect of Certain Applications

(1) [Principle of "Whole Contents"] (a) Subject to subparagraph (b), the whole contents of an application (the former application) as filed in, or with effect for, a Contracting Party shall, for the purpose of determining the novelty of an invention claimed in another application filed in, or with effect for, that Contracting Party, be considered as prior art from the

filing date of the former application on condition that the former application or the patent granted thereon is published subsequently by the authority competent for the publication of that application or patent. Any Contracting Party may consider the whole contents of the former application to be prior art also for the purpose of determining whether the invention satisfies the requirement of inventive step (non-obviousness).

(b) Where the former application referred to in subparagraph (a) claims the priority of an earlier application for a patent, utility model or other title protecting an invention, matter that is contained in both the former application and such earlier application shall be considered as prior art in accordance with subparagraph (a) from the priority date of the former application.

(c) For the purposes of subparagraph (a), the "whole contents" of an application consists of the description and any drawings, as well as the claims, but not the abstract.

(2) [Applications No Longer Pending] Where the former application referred to in paragraph (1)(a) has been published in spite of the fact that, before the date of its publication, it was withdrawn or abandoned, was considered withdrawn or abandoned, or was rejected, it shall not be considered as prior art for the purposes of paragraph (1)(a).

(3) [International Applications Under the PCT] As regards international applications filed under the Patent Cooperation Treaty, any Contracting Party may provide that paragraph (1) shall apply only if the acts referred to in Article 22 or, where applicable, Article 39(1) of that Treaty have been performed.

(4) [Self-Collision] [(a)] Paragraph (1) shall not apply when the applicant of, or the inventor identified in, the former application, and the applicant of, or the inventor identified in, the application under examination, is one and the same person.

[(b)] Any Contracting Party that considers the whole contents of the former application to be prior art only for the purpose of determining the novelty of the invention shall be free not to apply subparagraph (a).]

Article 14

Amendment or Correction of Application

(1) [Amendments or Corrections Following Office Findings] Wherever the Office finds that the application does not comply with any requirements applicable to it, it shall give the applicant at least one opportunity to amend or correct the application or to comply with the said requirements. Such an opportunity need not be given before the application has a filing date.

(2) [Amendments or Corrections on Applicant's Initiative] The applicant shall have the right, on his own initiative, to amend or correct the application or to comply with a requirement applicable to the application up to the time when the application is in order for grant; however, any Contracting Party which provides for substantive examination may provide that the applicant shall have the right to amend or correct, on his own initiative, the description, the claims and any drawings, only up to the time allowed for the reply to the first substantive communication from the Office.

(3) [Limitation of Amendments or Corrections] No amendment or correction of the application may go beyond what has been disclosed in the application as filed.

Article 15

Publication of Application

(1) [Requirement to Publish the Application] (a) Subject to paragraphs (2) to (4), the Office shall publish the application as soon as possible after the expiration of 18 months from the filing date or, where priority is claimed, the priority date.

(b) Notwithstanding subparagraph (a), any Contracting Party that, at the time of depositing its instrument of ratification of, or accession to, this Treaty, does not provide for the publication of applications as provided in subparagraph (a) may notify the Director General at the said time that it reserves the right to publish applications as soon as possible after the expiration of 24 months, rather than 18 months, from the filing date, or, where priority is claimed, the priority date.

(2) [Earlier Publication at Applicant's Request] If, before the expiration of the time limit referred to in paragraph (1), the applicant requests that the application be published, the Office shall, without delay after the receipt of the request, publish the application.

(3) [National Security] Any Contracting Party shall be free not to publish an application for reasons of national security.

(4) [Circumstances in Which Publication May Not Take Place] (a) No application may be published if it is withdrawn or abandoned or is considered withdrawn or abandoned

(i) earlier than two months before the expiration of the time limit applicable under paragraph (1) or,

(ii) where the Office completes the technical preparations for publication later than two months before the expiration of the time limit applicable under paragraph (1), prior to the completion of such preparations.

(b) No application may be published if it has been rejected.

Article 16

Time Limits for Search and Substantive Examination

(1) [Time Limits for Search] (a) If a Contracting Party provides for substantive examination, its Office shall publish, at the same time as the application is published under Article 15, a report, established by or on behalf of that Office, citing any documents that reflect the prior art relevant to the invention claimed in the application (hereinafter referred to as "the search report").

(b) Notwithstanding subparagraph (a), where Article 15(2) applies, the search report need not be published at the same time as the application, provided that it shall be published as soon as possible, but not later than the expiration of the time limit applicable under Article 15(1).

(c) If, notwithstanding subparagraphs (a) and (b), for any exceptional reason, the search report cannot be published as provided for in those subparagraphs, it shall be published as soon as possible and in no case later than six months after the expiration of the time limit applicable under Article 15(1).

(2) [Time Limits for Substantive Examination] (a) If a Contracting Party provides for substantive examination, its Office shall start the substantive examination of the application not later than three years from the filing date of the application.

(b) Notwithstanding subparagraph (a), a Contracting Party shall be free to provide that no substantive examination shall be carried out and the application shall be considered withdrawn or abandoned, or shall be rejected, if a request is not made, within three years from the filing date of the application, to its Office by the applicant or any third party that substantive examination should start. Where such a request is made, the Office shall start the substantive examination promptly after receipt of the request.

(c) The Office shall, wherever possible, reach a final decision on the application not later than two years after the start of substantive examination.

Article 17

Changes in Patents

(1) [Limitation of Extent of Protection] The owner of a patent shall have the right to request the competent Office to make changes in the patent in order to limit the extent of the protection conferred by it.

(2) [Obvious Mistakes and Clerical Errors] The owner of a patent shall have the right to request the competent Office to make changes in the patent in order to correct obvious mistakes or to correct clerical errors.

(3) [Additional Changes That May Be Allowed] Each Contracting Party may provide that the owner of a patent shall have the right to request the competent Office to make changes in the patent in order to correct mistakes or errors, other than those referred to in paragraph (2), made in good faith, provided that, where the change would result in a broadening of the extent of protection conferred by the patent, no request may be made after the expiration of two years from the grant of the patent and the change shall not affect the rights of any third party which has relied on the patent as published.

(4) [Changes Affecting the Disclosure] No change in the patent shall be

permitted under paragraphs (1) or (3) where the change would result in the disclosure contained in the patent going beyond the disclosure contained in the application as filed.

(5) [Decision in Respect of the Request and Publication of the Changes] If, and to the extent to which, the competent Office changes the patent according to paragraphs (1), (2) or (3), it shall publish the changes.

Article 18 Administrative Revocation

(1) [Administrative Revocation] (a) Where a patent was granted after substantive examination, any person shall have the right to request the competent Office to revoke the patent, in whole or in part, at least on the ground that, because of one or several documents available to the public, the conditions of novelty or inventive step are not satisfied.

(b) The request for revocation may be presented during a period to be fixed by the Contracting Party which shall commence from the announcement in the official gazette of the grant of the patent and shall not be less than six months.

(c) No request for revocation may be based on grounds of non-compliance with formal or procedural requirements.

(d) No decision may be made by the Office departing from the request unless the person having made the request has had at least one opportunity to present his arguments on the grounds on which the Office intends to depart from the request.

(e) The Office may not revoke the patent, in whole or in part, at the request of a third party, unless the owner of the patent has had at least one opportunity to present his arguments on the grounds on which the Office intends to revoke the patent.

(2) [Prohibition of Pre-grant Opposition] (a) No Contracting Party may allow any party to oppose, before its Office, the grant of patents ("pre-grant opposition").

(b) Notwithstanding subparagraph (a), any Contracting Party which, at the time of becoming party to this Treaty, provides for the possibility of pre-grant opposition may, for a period not exceeding the expiration of the tenth calendar year after the year in which this Treaty

was adopted, continue to do so and, for the same period, it shall not be obliged to apply paragraph (1).

(c) Any Contracting Party that wishes to avail itself of the faculty provided for in subparagraph (b) shall address a corresponding notification to the Director General. As long as the notification has effect, any reference in this Treaty or in the Regulations to the time when the application is in order for grant shall be replaced, with respect to that Contracting Party, by a reference to the time when the application is in order for publication for the purposes of pre-grant opposition.

Article 19 Rights Conferred by the Patent

Alternative A

Note: No article on the rights conferred by the patent.

Alternative B

(1) [Products] Where the subject matter of the patent concerns a product, the owner of the patent shall have the right to prevent third parties from performing, without his authorization, at least the following acts:

(i) the making of the product,
(ii) the offering or the putting on the market of the product, the using of the product, or the importing or stocking of the product for such offering or putting on the market or for such use.

(2) [Processes] Where the subject matter of the patent concerns a process, the owner of the patent shall have the right to prevent third parties from performing, without his authorization, at least the following acts:

(i) the using of the process,
(ii) in respect of any product directly resulting from the use of the process, any of the acts referred to in paragraph (1)(ii), even where a patent cannot be obtained for the said product.

(3) [Exceptions to Paragraphs (1) and (2)] (a) Notwithstanding paragraphs (1) and (2), any Contracting Party may provide that the owner of a patent has no right to prevent third parties from performing, without his authorization, the acts referred to in paragraphs (1) and (2) in the following circumstances:

(i) where the act concerns a prod-

uct which has been put on the market by the owner of the patent, or with his express consent, insofar as such act is performed after that product has been so put on the market in the territory of that Contracting Party or, where the Contracting Party is a member of a group of States constituting a regional market, in the territory of one of the member States of such group;

(ii) where the act is done privately and on a non-commercial scale or for a non-commercial purpose, provided that it does not significantly prejudice the economic interests of the owner of the patent;

(iii) where the act consists of making or using exclusively for the purpose of experiments that relate to the subject matter of the patented invention [or for the purpose of seeking regulatory approval for marketing];

(iv) where the act consists of the preparation for individual cases, in a pharmacy or by a medical doctor, of a medicine in accordance with a medical prescription or acts concerning the medicine so prepared.

(b) The provisions of paragraphs (1) and (2) shall not be interpreted as affecting the freedom that Contracting Parties have under the Paris Convention for the Protection of Industrial Property to allow, under certain circumstances, the performance of acts without the authorization of the owner of the patent.

(4) [Contributory Infringement] (a) Subject to subparagraph (b), a patent shall also confer on its owner [at least] the right to prevent a third party from supplying or offering to supply a person, other than a party entitled to exploit the patented invention, with means, relating to an essential element of that invention, for carrying out the invention, when the third party knows, or it is obvious in the circumstances, that those means are suitable and intended for carrying out that invention. This provision shall not apply when the means are staple commercial products and the circumstances of the supply of such products do not constitute inducement to infringe the patent.

(b) Persons performing the acts referred to in paragraph (3)(a)(ii), (iii) and (iv) shall not be considered to be parties entitled to exploit the invention within the meaning of subparagraph (a).

Alternative C

(1) [Products] Where the subject matter of the patent concerns a product, the owner of the patent shall have the right to prevent third parties from performing, without his authorization, at least the following acts:

- (i) the making of the product,
- (ii) the offering for sale of the product, and the using of the product.

(2) [Processes] Where the subject matter of the patent concerns a process, the owner of the patent shall have the right to prevent third parties from performing, without his authorization, the using of the process.

(3) [Exceptions to Paragraphs (1) and (2)] (a) Notwithstanding paragraphs (1) and (2), any Contracting State shall be free to provide that the owner of a patent has no right to prevent third parties from performing, without his authorization, the acts referred to in paragraphs (1) and (2) in the following circumstances:

- (i) where the act concerns the offer for sale or the use of a product which has been offered for sale by the owner of the patent, or with his express consent, insofar as such an act is performed after the product has been so offered for sale in the territory of that Contracting State;

- (ii) where the act is done privately and on a non-commercial scale;

- (iii) where the act consists of making or using for exclusively experimental, academic or scientific research purposes;

- (iv) where the act consists of the preparation for individual cases, in a pharmacy or by a medical doctor, of a medicine in accordance with a medical prescription or acts concerning the medicine so prepared.

(b) The provisions of paragraphs (1) and (2) shall not be interpreted as affecting the freedom that Contracting States have under the Paris Convention for the Protection of Industrial Property, to allow, under certain circumstances, the performance of acts without the authorization of the owner of the patent.

(c) Persons performing the acts referred to in paragraph (3)(a)(ii), (iii) and (iv) shall not be considered to be parties entitled to exploit the invention within the meaning of subparagraph (a).

**Article 20
Prior User****(1) [Rights of Prior User]****Alternative A**

Any Contracting Party may provide that, notwithstanding Article 19,

Alternative B

Notwithstanding Article 19,

a patent shall have no effect against any person (hereinafter referred to as "the prior user") who, in good faith, for the purposes of his enterprise or business, before the filing date or, where priority is claimed, the priority date of the application on which the patent is granted, and within the territory where the patent produces its effect, was using the invention or was making effective and serious preparations for such use; any such person shall have the right, for the purposes of his enterprise or business, to continue such use or to use the invention as envisaged in such preparations.

(2) [Successor-in-Title of the Prior User] The right of the prior user may only be transferred to devolve together with his enterprise or business, or with that part of his enterprise or business in which the use or preparations for use have been made.

**Article 21
Extent of Protection and
Interpretation of Claims**

(1) [Determination of the Extent of Protection] (a) The extent of protection conferred by the patent shall be determined by the claims, which are to be interpreted in the light of the description and drawings.

(b) For the purposes of subparagraph (a), the claims shall be so interpreted as to combine fair protection for the owner of the patent with a reasonable degree of certainty for third parties. In particular, the claims shall not be interpreted as being confined to their strict literal wording. Neither shall the claims be considered as mere guidelines allowing that the protection conferred by the patent extends to what, from a consideration of the description and drawings by

a person skilled in the art, the owner has contemplated, but has not claimed.

(2) [Equivalents] (a) Notwithstanding paragraph (1)(b), a claim shall be considered to cover not only all the elements as expressed in the claim but also equivalents.

(b) An element ("the equivalent element") shall generally be considered as being equivalent to an element as expressed in a claim if, at the time of any alleged infringement, either of the following conditions is fulfilled in regard to the invention as claimed:

- (i) the equivalent element performs substantially the same function in substantially the same way and produces substantially the same result as the element as expressed in the claim, or

- (ii) it is obvious to a person skilled in the art that the same result as that achieved by means of the element as expressed in the claim can be achieved by means of the equivalent element.

(c) Any Contracting Party shall be free to determine whether an element is equivalent to an element as expressed in a claim by reference to only the condition referred to in subparagraph (b)(i) or to only the condition referred to in subparagraph (b)(ii), provided that, at the time of depositing its instrument of ratification of or accession to this Treaty, it so notifies the Director General.

(3) [Prior Statements] In determining the extent of protection, due account shall be taken of any statement limiting the scope of the claims made by the applicant or the owner of the patent during procedures concerning the grant or the validity of the patent,

(4) [Examples] If the patent contains examples of the embodiment of the invention or examples of the functions or results of the invention, the claims shall not be interpreted as limited to those examples; in particular, the mere fact that a product or process includes additional features not found in the examples disclosed in the patent, lacks features found in such examples or does not achieve every objective or possess every advantage cited or inherent in such examples shall not remove the product or process from the extent of protection conferred by the claims.

(5) [Abstract] The abstract of a patent

shall not be taken into account for the purpose of determining the protection conferred by the patent.

Article 22 Term of Patents

Alternative A

Note: No article on the term of patents.

Alternative B

(1) [Minimum Duration of Protection] The term of a patent shall be at least 20 years.

(2) [Starting Date of Term] (a) The starting date of the term of a patent shall be the filing date of the application on which the patent is granted, whether or not the application claims the priority of another application.

(b) Notwithstanding subparagraph (a), where an application (the subsequent application) invokes one or more earlier applications without claiming the priority of any of those earlier applications, the starting date of the term of the patent granted on the subsequent application shall be the filing date of the earliest-filed application invoked in the subsequent application.

Article 23 Enforcement of Rights

(1) [Enforcement Based on Patents] The owner of the patent shall have at least the right

(i) to obtain an injunction to restrain the performance or the likely performance, by any person without his authorization, of any of the acts referred to in Article 19(1), (2) and (4);

(ii) to obtain damages, adequate under the circumstances, from any person who, without his authorization, performed any of the acts referred to in Article 19(1), (2) and (4), where the said person was or should have been aware of the patent.

(2) [Enforcement Based on Published Applications] (a) The applicant shall at least have the right to obtain reasonable compensation from any person who, without his authorization, performed any of the acts referred to in Article 19(1), (2) and (4) in relation to any invention, claimed in the published application, as if

a patent had been granted for that invention, provided that the said person, at the time of the performance of the act, had

(i) actual knowledge that the invention that he was using was the subject matter of a published application, or

(ii) received written notice that the invention that he was using was the subject matter of a published application, such application being identified in the said notice by its serial number.

(b) Any Contracting Party may provide that, with respect to the compensation referred to in subparagraph (a), an action may not be initiated or a decision may not be made until after the grant of a patent on the published application, provided that, if an action may be initiated only after the grant of the patent, the owner of the patent shall have reasonable time to initiate such action.

(c) For the purposes of subparagraphs (a) and (b), the extent of the protection shall be determined by the claims as appearing in the published application. However, if the claims are amended after the initial publication of the application, the extent of the protection shall be determined by the amended claims in respect of the period following their publication. Furthermore, if the claims of the patent as granted or as changed after its grant have a narrower scope than the claims in the application, the extent of the protection shall be determined by the claims with the narrower scope.

Article 24 Reversal of Burden of Proof

Alternative A

Note: No article on the reversal of the burden of proof.

Alternative B

(1) [Conditions for the Reversal of the Burden of Proof] (a) For the purposes of proceedings, other than criminal proceedings, in respect of the violation of the rights of the owner of the patent referred to in Article 19(2), where the subject matter of the patent is a process for obtaining a product, the burden of establishing that a product was not made by the process shall be on the alleged infringer if either of the following conditions is fulfilled;

(i) the product is new, or

(ii) a substantial likelihood exists that the product was made by the process and the owner of the patent has been unable through reasonable efforts to determine the process actually used.

(b) Any Contracting Party shall be free to provide that the burden of proof indicated in subparagraph (a) shall be on the alleged infringer only if the condition referred to in subparagraph (a)(i) is fulfilled or only if the condition referred to in subparagraph (a)(ii) is fulfilled, provided that, at the time of depositing its instrument of ratification of or accession to this Treaty, it so notifies the Director General.

(2) [Manufacturing and Business Secrets] In requiring the production of evidence, the authority before which the proceedings referred to in paragraph (1) take place shall take into account the legitimate interests of the alleged infringer in not disclosing his manufacturing and business secrets.

Article 25 Obligations of the Right Holder

Alternative A

Note: No article on obligations of the right holder.

Alternative B

(1) The owner of a patent shall have at least the following obligations in addition to any other provided for in this Treaty:

(i) to disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art; the description shall set forth at least one mode for carrying out the invention claimed; this shall be done in terms of examples, where appropriate, and with reference to the drawings, if any; however, any Contracting Party may provide that the description set forth the best mode for carrying out the invention known to the inventor at the filing date or, where priority is claimed, priority date of the application;

(ii) to provide such information and supporting documents in his possession as is requested by the competent Office concerning corresponding foreign application and grants;

(iii) to work the patented inven-

*New York Patent, Trademark & Copyright Law Association
(Host Association)*

Connecticut Patent Law Association

Philadelphia Patent Law Association

New Jersey Patent Law Association

April 20, 1993

Grand Hyatt Hotel

*Grand Central Station
42nd Street and Park Avenue*

9:15 a.m. to 5:00 p.m.

\$125 Registration Fee

*(This Fee includes a Luncheon, Bus Transportation to/from Penn Station and all
Seminar Materials)*

(A \$15 late registration fee will be added to the price of admission if you register at the door)

RESERVATION FORM

PATENT PRACTICE UPDATE

Robert E. Rigby, Jr., Esq.
Fitzpatrick, Cella, Harper & Scinto
277 Park Avenue
New York, New York 10172

Enclosed is a reservation check for \$ _____ payable to
the "NYPTCLA" for _____ attendees at \$125.00 each.

Name (please print)

Firm or Company

tion in the territory of the Contracting State for which it is granted within the time limits as provided by national law;

(iv) to pay, or cause to be paid, such fees as prescribed by national law in relation to the application and the maintenance of the patent granted on it;

(v) in respect of license contracts and contracts assigning patents, to refrain from engaging in abusive, restrictive or anticompetitive practices adversely affecting the transfer of technology.

(2) The applicant or holder of a patent shall comply with any other obligations established in the national law of the State in which the patent was granted in connection with the acquisition and the exercise of the rights conferred by the patent and with the exploitation of the patented invention.

Article 26

Remedial Measures Under National Legislation

Alternative A

Note: No article on remedial measures under national legislation.

Alternative B

(1) Any Contracting State is free to provide appropriate measures to ensure compliance with the obligations referred to in the Article entitled "Obligations of the Right Holder," and for measures to remedy non-compliance with such obligations, including the grant of non-voluntary licenses and the revocation or forfeiture of the patent,

(2) A non-voluntary license under paragraph (1) shall be refused if the owner of the patent proves, to the satisfaction of the national authorities competent to grant non-voluntary licenses, that there are circumstances which justify the non-working or insufficient working of the patented invention.

(3) Any Contracting State is free to provide, at any time, on grounds of public interest, national security, nutrition, health, or the development of other vital sectors of national economy, for the grant of non-voluntary licenses or for the exploitation of the patented invention by the government of that country or by third persons authorized by it.

Article 27 Assembly

(1) [Composition] (a) The Union shall have an Assembly consisting of the Contracting Parties.

(b) Each Contracting Party shall be represented by one delegate, who may be assisted by alternate delegates, advisors and experts.

(c) The Union shall not bear the expenses of the participation of any delegation in any session of the Assembly.

(2) [Tasks] (a) The Assembly shall:

(i) deal with all matters concerning the maintenance and development of the Union and the implementation of this Treaty;

(ii) modify, where it considers it desirable, any time limit provided for in Articles 3 to 26 of this Treaty and make any consequential amendments necessitated by any such modification; the adoption of any such modification shall require unanimous consent;

(iii) adopt, where it considers it desirable, guidelines for the implementation of provisions of this Treaty or the Regulations under this Treaty;

(iv) exercise such rights and perform such tasks as are specifically conferred upon it or assigned to it under this Treaty;

(v) give directions to the Director General concerning the preparations for any conference referred to in Article 31 or Article 32 and decide the convocation of any such conference;

(vi) review and approve the reports and activities of the Director General concerning the Union, and give him all necessary instructions concerning matters within the competence of the Union;

(vii) establish such committees and working groups as it deems appropriate to achieve the objectives of the Union;

(viii) determine which States and intergovernmental organizations, other than Contracting Parties, and which non-governmental organizations shall be admitted to its meetings as observers;

(ix) take any other appropriate action designed to further the objectives of the Union and perform such other functions as are appropriate under this Treaty.

(b) With respect to matters which

are of interest also to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization.

(3) [Representation] A delegate may represent one Contracting Party only.

(4) [Voting] (a) Subject to subparagraph (e), each Contracting Party that is a State shall have one vote and shall vote only in its own name.

(b) Any intergovernmental organization referred to in Article 33(1)(ii) that is a Contracting Party may exercise the right to vote of its member States that are Contracting Parties [whether] present [or absent] at the time of voting. The intergovernmental organization may not, in a given vote, exercise the right to vote if any of its member States participates in the vote or expressly abstains.

(c) Provided that all its member States that are Contracting Parties have notified the Director General that their right to vote may be exercised by it, any intergovernmental organization referred to in Article 33 (1) (iii) that is a Contracting Party may so exercise the right to vote of its member States that are Contracting Parties, [whether] present [or absent] at the time of voting. The intergovernmental organization may not, in a given vote, exercise the right to vote of any of its member States if any of them participates in the vote or expressly abstains.

(d) The right to vote of a State that is a Contracting Party may not, in a given vote, be exercised by more than one intergovernmental organization.

(e) No Contracting Party shall have the right to vote on questions concerning matters in respect of which it has made a declaration under Article 35.

(5) [Quorum] (a) One-half of the Contracting Parties that have the right to vote shall constitute a quorum, provided that, for the purposes of determining whether there is a quorum in respect of any question concerning any matter on which a declaration under Article 35 has been made, any Contracting Party not having the right to vote on that question shall not be counted.

(b) In the absence of the quorum, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions

shall take effect only if the quorum and the required majority are attained through voting by correspondence.

(6) [Majorities] (a) Subject to paragraphs (2)(a)(ii) and (9)(b) of this Article and to Articles 29(2) and (3) and 30(4), the decisions of the Assembly shall require a majority of the votes cast.

(b) Abstentions shall not be considered as votes.

(7) [Sessions] (a) The Assembly shall meet once in every second calendar year in ordinary session upon convocation by the Director General and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization.

(b) The Assembly shall meet in extraordinary session upon convocation by the Director General, either at the request of one-fourth of the Contracting Parties or on the Director General's own initiative.

(8) [Rules of Procedure] The Assembly shall adopt its own rules of procedure.

(9) [Guidelines] (a) In the case of conflict between the guidelines referred to in paragraph (2) (a)(iii) and the provisions of this Treaty or the Regulations, the latter shall prevail.

(b) The adoption by the Assembly of the said guidelines shall require three-fourths of the votes cast.

Article 28 International Bureau

(1) [Tasks] The International Bureau of the Organization shall:

(i) perform the administrative tasks concerning the Union, as well as any tasks specifically assigned to it by the Assembly;

(ii) provide the secretariat of the conferences referred to in Articles 31 and 32, of the Assembly, of the committees and working groups established by the Assembly, and of any other meeting convened by the Director General under the aegis of the Union.

(2) [Director General] The Director General shall be the chief executive of the Union and shall represent the Union.

(3) [Meetings Other than Sessions of the Assembly] The Director General shall convene any committee and working group established by the Assembly and

all other meetings dealing with matters of concern to the Union.

(4) [Role of the International Bureau in the Assembly and Other Meetings] (a) The Director General and any staff member designated by him shall participate, without the right to vote, in all meetings of the Assembly, the committees and working groups established by the Assembly, and any other meetings convened by the Director General under the aegis of the Union.

(b) The Director General or a staff member designated by him shall be ex officio secretary of the Assembly, and of the committees, working groups and other meetings referred to in subparagraph (a).

(5) [Conferences] (a) The Director General shall, in accordance with the directions of the Assembly, make the preparations for any conference referred to in Article 31 or Article 32.

(b) The Director General may consult with intergovernmental and international and national non-governmental organizations concerning the said preparations.

(c) The Director General and staff members designated by him shall take part, without the right to vote, in the discussions at any conference referred to in subparagraph (a).

(d) The Director General or a staff member designated by him shall be ex officio secretary of any conference referred to in subparagraph (a).

Article 29 Regulations

(1) [Content] The Regulations annexed to this Treaty provide rules concerning

(i) matters which this Treaty expressly provides are to be "prescribed";

(ii) any details useful in the implementation of the provisions of this Treaty;

(iii) any administrative requirements, matters or procedures.

(2) [Amending the Regulations] (a) The Assembly may amend the Regulations and shall determine the conditions for the entry into force of each amendment.

(b) Subject to paragraph (3), any amendment of the Regulations shall require three-fourths of the votes cast.

(3) [Requirement of Unanimity] (a) The Regulations may specify rules which may be amended only by unanimous consent.

(b) Exclusion, for the future, of any rule designated as requiring unanimous consent for amendment from such requirement shall require unanimous consent.

(c) Inclusion, for the future, of the requirement of unanimous consent for the amendment of any rule shall require unanimous consent.

(4) [Conflict Between the Treaty and the Regulations] In the case of conflict between the provisions of this Treaty and those of the Regulations, the former shall prevail.

Article 30 Settlement of Disputes

(1) [Consultations] (a) Where any dispute arises concerning the interpretation or implementation of this Treaty, a Contracting Party may bring the matter to the attention of another Contracting Party and request the latter to enter into consultations with it.

(b) The Contracting Party so requested shall provide, within the prescribed time limit, an adequate opportunity for the requested consultations.

(c) The Contracting Parties engaged in consultations shall attempt to reach, within a reasonable period of time, a mutually satisfactory solution of the dispute.

(2) [Other Means of Settlement] If a mutually satisfactory solution is not reached within a reasonable period of time through the consultations referred to in paragraph (1), the parties to the dispute may agree to resort to other means designed to lead to an amicable settlement of their dispute, such as good offices, conciliation, mediation and arbitration.

(3) [Panel] (a) The Assembly shall adopt rules for the establishment of a body of experts, any candidate having to be presented by a Contracting Party. It shall adopt rules concerning the manner of selecting the members of each panel, each panel having three members, none of which shall, unless the parties to the dispute agree otherwise, be from either party to the dispute. The Assembly shall

also adopt rules for the conduct of the panel proceedings, including provisions to safeguard the confidentiality of the proceedings and of any material designated as confidential by any participant in the proceedings. Each panel shall give full opportunity to the parties to the dispute and any other interested Contracting Parties to present to it their views.

(b) If the dispute is not satisfactorily settled through the consultations referred to in paragraph (1), or if the means referred to in paragraph (2) are not resorted to, or do not lead to an amicable settlement within a reasonable period of time, the Director General, at the written request of either of the parties to the dispute, shall appoint members of a panel to examine the matter.

(c) The terms of reference of the panel shall be agreed upon by the parties to the dispute. However, if such agreement is not achieved within the prescribed time limit, the Director General shall set the terms of reference of the panel after having consulted the parties to the dispute and the members of the panel.

(d) If both parties to the dispute so request, the panel shall stop its proceedings.

(e) Unless the parties to the dispute reach an agreement between themselves prior to the panel's concluding its proceedings, the panel shall promptly prepare the draft of a written report containing a statement of the containing recommendations for the resolution of the dispute and provide it to the parties to the dispute for their review. The parties to the dispute shall have a reasonable period of time, the length of which shall be fixed by the panel, to submit any comments on the report to the panel, unless they agree to a longer time in their attempts to reach a mutually satisfactory resolution to their dispute.

(f) The panel shall take into account the comments and shall promptly transmit its final report to the Assembly, which report shall be accompanied by the written comments, if any, of the parties to the dispute.

(4) [Recommendation by the Assembly] The Assembly shall give the report of the panel prompt consideration. The Assembly shall make recommendations to the parties to the dispute, based upon its

interpretation of this Treaty and the report of the panel. Any recommendation by the Assembly shall require consensus among the members of the Assembly other than the parties to the dispute.

Article 31 Revision of the Treaty

This Treaty may be revised by a conference of the Contracting Parties.

Article 32 Protocols

For the purposes of further developing the harmonization of patent law, protocols may be adopted by a conference of the Contracting Parties, provided that the provisions of any such protocol shall not contravene the provisions of this Treaty. Only Contracting Parties may become party to any such protocol.

Article 33 Becoming Party to the Treaty

(1) [Eligibility] The following may become party to this Treaty:

(i) any State which is a party to the Paris Convention for the Protection of Industrial Property and in respect of which patents may be obtained either through the State's own Office or through the Office of another Contracting Party;

(ii) any intergovernmental organization which is competent in matters governed by this Treaty and which has established, on such matters, norms that are binding on all its member States, provided that all those States are party to the Paris Convention for the Protection of Industrial Property;

(iii) any intergovernmental organization which maintains an Office granting patents with effect in more than one State, provided that all of its member States are party to the Paris Convention for the Protection of Industrial Property.

(2) [Signature: Deposit of Instrument] To become party to this Treaty, the State or the intergovernmental organization shall:

(i) sign this Treaty and deposit an instrument of ratification, or

(ii) deposit an instrument of accession.

(3) Condition as to Effect of Instru-

ment] (a) Any instrument of ratification or accession (hereinafter referred to as "instrument") may be accompanied by a declaration making it a condition to its being considered as deposited that the instrument of one State or one intergovernmental organization, or the instruments of two States, or the instruments of one State and one intergovernmental organization, specified by name and eligible to become party to this Treaty according to paragraph (1)(i) or (iii), is or are also deposited. The instrument containing such a declaration shall be considered to have been deposited on the day on which the condition indicated in the declaration is fulfilled. However, when the deposit of an instrument specified in the declaration is, itself, accompanied by a declaration of the said kind, that instrument shall be considered as deposited on the day on which the condition specified in the latter declaration is fulfilled.

(b) Any declaration made under paragraph (a) may be withdrawn, in its entirety or in part, at any time. Any such withdrawal shall become effective on the date on which the notification of withdrawal is received by the Director General.

Article 34 Effective Date of Ratifications and Accessions

(1) [Entry Into Force of the Treaty] This Treaty shall enter into force three months after eight States or intergovernmental organizations have deposited their instruments of ratification or accession.

(2) [Ratifications and Accessions Subsequent to the Entry Into Force of the Treaty] Any State or intergovernmental organization not covered by paragraph (1) shall become bound by this Treaty three months after the date on which it has deposited its instrument of ratification or accession, unless a later date has been indicated in the instrument. In the latter case, the said State or intergovernmental organization shall become bound by this Treaty on the date thus indicated.

Article 35 Reservations

Alternative A

Note: No article on reservations.

Alternative B

(1) [Possibility of Making Reservations] (a) Any instrument of ratification of, or accession to, this Treaty that is deposited not later than the end of the eighth calendar year after the year in which this Treaty has been adopted may be accompanied by a declaration making reservations to this Treaty as provided for in paragraphs (2) to (5).

(b) No reservations to this Treaty other than the reservations allowed under paragraphs (2) to (5) are permitted.

(2) [Fields of Technology] (a) Any State or intergovernmental organization may declare that, notwithstanding the provisions of Article 10, patents will not be granted by the competent Office in the fields of technology specified in its declaration, provided that such a declaration may only specify those fields of technology which, at the time of making the declaration, are fields for which that State or intergovernmental organization provides for the exclusion of the grant of patents.

(b) Any declaration made under subparagraph (a) by a developing country or by an intergovernmental organization all the members of which are developing countries shall lose its effect at the end of the fifteenth calendar year after the year in which this Treaty has been adopted. Any declaration made under subparagraph (a) by any other State or intergovernmental organization shall lose its effect at the end of the tenth calendar year after the year in which this Treaty has been adopted.

(3) [Certain Rights Conferred by Process Patents] (a) Any State which is a developing country or any intergovernmental organization all the members of which are developing countries and which, at the time of making the declaration, does not provide for the right referred to in Article 19(2)(ii) may not declare that it will not apply that provision.

(b) Any declaration made under subparagraph (a) shall lose its effect at the end of the fifteenth calendar year after the year in which the Treaty has been adopted.

(4) [Term of Patent] (a) Any State or intergovernmental organization which, at the time of making the declaration, provides for a term of the patent other than that referred to in Article 22 may declare that it will not apply that provision.

(b) Any declaration made under subparagraph (a) by a developing country or by an intergovernmental organization all the members of which are developing countries shall lose its effect at the end of the fifteenth calendar year after the year in which the Treaty has been adopted. Any declaration made under subparagraph (a) by any other State or intergovernmental organization shall lose its effect at the end of the tenth calendar year after the year in which the Treaty has been adopted.

(5) [Reversal of Burden of Proof] (a) Any State which is a developing country or any intergovernmental organization all the members of which are developing countries and which, at the time of making the declaration, does not provide for the reversal of the burden of proof referred to in Article 24 may declare that it will not apply that provision.

(b) Any declaration made under subparagraph (a) shall lose its effect at the end of the fifteenth calendar year after the year in which the Treaty has been adopted.

Article 36 Special Notifications

(1) [States] (a) Any State in respect of which patents may be obtained only through the Office of another Contracting Party shall notify this fact and shall identify such Contracting Party.

(b) Any change in the fact notified by a State under subparagraph (a) shall be promptly notified by such State.

(2) [Intergovernmental Organizations Referred to in Article 33(1)(ii)] (a) Any intergovernmental organization referred to in Article 33(1)(ii) shall notify the list of its member States and, if its norms deal with only some of the matters covered by Articles 3 to 26, shall notify this fact and shall, among the provisions of the said Articles, identify those provisions with which its norms deal. The other provisions of the said Articles shall not bind the intergovernmental organization.

(b) If the norms of any intergov-

ernmental organization referred to in subparagraph (a) later deal with any matter covered by Articles 3 to 26 concerning which the intergovernmental organization has not made a notification under subparagraph (a), the intergovernmental organization shall be bound by the corresponding provisions of this Treaty and shall promptly notify the relevant changes in its norms.

(3) [Intergovernmental Organizations Referred to in Article 33(1)(iii)] (a) Any intergovernmental organization referred to in Article 33(1)(iii) shall notify the list of its member States and, if its norms do not deal with any of the matters covered by Articles 19 to 26, shall notify this fact and shall, among the provisions of the said Articles, identify those provisions with which its norms do not deal. The latter provisions shall not bind the intergovernmental organization.

(b) If the norms of any intergovernmental organization referred to in subparagraph (a) later deal with any matter concerning which the intergovernmental organization has made a notification under subparagraph (a), the intergovernmental organization shall be bound by the corresponding provisions of this Treaty and shall promptly notify the relevant changes in its norms.

(4) [Time of Notification] (a) Any notification under paragraphs (1)(a), (2)(a) or (3)(a) shall accompany the instrument of ratification or accession.

(b) Any change under paragraphs (1)(b), (2)(b) or (3)(b) shall be notified promptly in a declaration addressed to the Director General.

Article 37 Denunciation of the Treaty

(1) [Notification] Any Contracting Party may denounce this Treaty by notification addressed to the Director General.

(2) [Effective Date] Denunciation shall take effect one year from the date on which the Director General has received the notification. It shall not affect the application of this Treaty to any application pending or any patent in force in respect of the denouncing Contracting Party at the time of the expiration of the said one-year period.

Article 38**Languages of the Treaty: Signature**

(1) [Original Texts: Official Texts]
(a) This Treaty shall be signed in a single original in the English, Arabic, Chinese, French, Russian and Spanish languages, all texts being equally authentic.

(b) Official texts shall be established by the Director General, after consultation with the interested Governments, in such other languages as the Assembly may designate.

(2) [Time Limit for Signature] This Treaty shall remain open for signature at the headquarters of the Organization for one year after its adoption.

Article 39**Depositary**

The Director General shall be the depositary of this Treaty.

**DRAFT REGULATIONS UNDER
THE TREATY SUPPLEMENTING
THE PARIS CONVENTION FOR
THE PROTECTION OF
INDUSTRIAL PROPERTY AS FAR
AS PATENTS ARE CONCERNED
(PATENT LAW TREATY)**

Contents

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Rule 1**Definitions****(ad Article 2)**

(1) ["Treaty"; "Article"] (a) In these Regulations, the word "Treaty" means the Treaty Supplementing the Paris Convention for the Protection of Industrial Property as far as Patents Are Concerned (Patent Law Treaty).

(b) In these Regulations, the word "Article" refers to the specified Article of the Treaty.

(2) [Expressions Defined in the Treaty] The expressions defined in Article 2 for the purposes of the Treaty shall have the same meaning for the purposes of these Regulations.

(3) [Means of Publication] For the purposes of Article 2(viii), an application, a search report, a patent or any change in a patent shall be deemed to be "accessible to the public" if any person so wishing, against payment or free of charge can

(i) obtain from the Office paper copies of the application, the search report, the patent or the document reflecting the change,

(ii) inspect, at the Office, the application, the search report, the patent or the document reflecting the change and, on request, obtain from the Office paper copies thereof, or

(iii) take cognizance, by means of electronic communication, of the application, the search report, the patent or the change and make, if he so wishes, paper copies thereof.

Rule 2**Contents and Order of Description
(ad Article 3(2))**

(1) [Contents of Description] The description shall, after stating the title of the invention,

(i) specify the technical field or fields to which the invention relates;

(ii) indicate the background art which, as far as known to the applicant, can be regarded as useful for the understanding, searching and examination of the invention, and, preferably, cite the documents reflecting such background art;

(iii) describe the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state the advantageous effects, if any, of the invention with reference to the background art;

(iv) where a deposit of biologically reproducible material is required under Article 3(1)(b), indicate the fact that the deposit has been made and identify at least the name and address of the depositary institution, the date of the deposit and the accession number given to the deposit by that institution, as well as describe to the extent possible, the nature and the characteristics of such material, relevant to the requirement of disclosure of the invention;

(v) briefly describe the figures in the drawings, if any;

(vi) set forth at least one mode for carrying out the invention claimed; this shall be done in terms of examples, where appropriate, and with reference to the drawings, if any; however, any Contracting Party may provide that the description set forth the best mode for carrying out the invention known to the inventor at the filing date or, where priority is claimed, priority date of the application;

(vii) indicate explicitly, when it is not otherwise obvious from the description or nature of the invention, the way or ways in which the invention satisfies the requirement of being useful or industrially applicable.

Alternative A

(2) [Manner and Order of Presentation of Contents] (a) The contents of the description shall be presented in the order specified in paragraph (1), unless, because of the nature of the invention, a different order would afford a better understanding or a more economical presentation.

(b) Any Contracting Party may accept a description which does not contain the matters specified in paragraph

(1)(i), (ii) and (v), or which contains, in lieu of the matter specified in paragraph (1)(iii), a description of the invention in any terms that satisfy the requirement of a disclosure of the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

Alternative B

(2) [Manner and Order of Presentations of Contents] The contents of the description shall be presented in the manner and order specified in paragraph (1), unless, because of the nature of the invention, a different manner or a different order would afford a better understanding or a more economical presentation.

(3) [Nucleotides and Amino Acid Sequences] Any Contracting Party may, where the application contains disclosure of a nucleotide sequence, provide for special requirements concerning the place, mode and format of such disclosure.

Rule 3 Manner of Claiming (ad Article 4(5))

(1) [Consecutive Numbering] Where the application contains several claims, they shall be numbered consecutively in Arabic numerals.

(2) [Method of Definition of Invention] The definition of the matter for which protection is sought shall be in terms of the technical features of the invention.

(3) [Form of Claim] Claims shall be written either

(i) in two parts, the first part consisting of a statement indicating those technical features of the invention which are necessary in connection with the definition of the claimed subject matter and which, in combination, appear to be part of the prior art, the second part ("the characterizing portion"), introduced by the words "characterized in that," "characterized by," "wherein the improvement comprises," or other words to the same effect, consisting of a statement indicating those technical features which, in combination with the features stated in the first part, define the matter for which protection is sought; or

(ii) in a single statement containing a recitation of a combination of

several elements or steps, or a single element or step, which defines the matter for which protection is sought.

(4) [References in the Claims to the Description and Drawings] (a) No claim may contain, in respect of the technical features of the invention, a reference to the description or any drawings, for example, such references as: "as described in part . . . of the description," or "as illustrated in figure . . . of the drawings," unless such a reference is necessary for the understanding of the claim or enhances the clarity or the conciseness of the claim.

(b) No claim may contain any drawing or graph. Any claim may contain tables and chemical or mathematical formulas.

(c) Where the application contains a drawing, the mention of any technical feature in a claim may, if the intelligibility of that claim can thereby be enhanced, include a reference sign to that drawing or to the applicable part of that drawing; such a reference sign shall be placed between square brackets or parentheses; it shall not be construed as limiting the claim.

(5) [Dependent and Multiple Dependent Claims] (a) Any claim which includes all the features of another claim of the same category or several other claims of the same category (hereinafter referred to as "dependent claim" and "multiple dependent claim," respectively) shall, preferably in the beginning, refer to the other claim or the other claims, as the case may be, by indicating the number of the other claim or the numbers of the other claims and shall then state those features claimed that are additional to the features claimed in the other claim or the other claims.

(b) A dependent claim may depend on another dependent claim or on a multiple dependent claim. A multiple dependent claim may depend on a dependent claim or another multiple dependent claim. Multiple dependent claims may refer in the alternative or in the cumulative to the claims on which they depend.

(c) All dependent claims referring back to the same claim, and all multiple dependent claims referring back to the same claims, shall be grouped together in the most practical way possible.

Rule 4 Details Concerning the Requirement of Unity of Invention (ad Article 5(1))

(1) [Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled] Where a group of inventions is claimed, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of those inventions, considered as a whole, makes over the prior art.

(2) [Determination of Unity of Invention Not Affected by Manner of Claiming] The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Rule 5 Divisional Applications (ad Article 5(1))

(1) [Time Limit] (a) The applicant may file one or more divisional applications at any time up to at least the time when the initial application is in order for grant.

(b) Notwithstanding subparagraph (a), any Contracting Party which establishes a time limit for compliance by the applicant with all requirements for the grant of a patent may provide that no divisional application may be filed during the six months preceding the expiration of that time limit.

(2) [Priority Documents] Priority documents and any translations thereof that are submitted to the Office in respect of the initial application shall be considered as having been submitted also in respect of the divisional application or applications.

Rule 6 Manner of Identification and Mention of Inventor (ad Article 6)

(1) [Manner of Identification and Mention] (a) The identification of the

inventor referred to in Article 6(1)(a) shall consist of the indication of the inventor's name and address.

(b) The mention of the inventor referred to in Article 6(2) shall consist of at least the indication of the inventor's name.

(2) [Procedure in Case of Non-Compliance with Requirements] (a) If the application and the documents accompanying it do not comply with the requirements provided for under Article 6(1)(a) and, where applicable, Article 6(3), the Office shall invite the applicant to comply with the said requirements within a reasonable time limit.

(b) the application may not be rejected for failure to comply with the said requirements where such an invitation has not been extended to the applicant.

(3) [Corrections] The applicant may correct, at any time, the identification of the inventor given in accordance with Article 6(1)(a). Any Contracting Party may require the consent of any previously identified inventor before accepting such a correction.

Rule 7

Details Concerning the Filing Date Requirements (ad Article 8)

(1) [Time Limits] (a) The time limit referred to in Article 8(2)(a) shall be at least two months from the date on which the elements referred to in Article 8(1) have been received by the Office.

(b) The time limit referred to in Article 8(4) shall be at least two months from the date on which the application containing the reference to the previously filed application has been received by the Office.

(c) The time limit referred to in Article 8(5) shall be at least two months from the date on which the item requiring translation has been received by the office.

(2) [Procedure in Case of Non-Compliance with Requirements] If the application does not, at the time of its receipt by the Office, comply with any of the requirements of Article 8(1) or the applicable requirements, if any, of Article 8(2)(a), Article 8(4) or Article 8(5)(b) that the application must satisfy either on receipt or within the time limit applicable

under paragraph (1), the Office shall promptly invite the applicant to comply with such requirement within a time limit fixed in the invitation, which time limit shall be at least one month from the date of the invention or, where the non-compliance relates to a matter for which a time limit for compliance is established by paragraph (1), the time limit referred to in paragraph (1), whichever expires later. Compliance with the invitation may be subject to the payment of a special fee. Failure to send an invitation shall not alter the said requirements.

(3) [Filing Date in Case of Correction] If, within the time limit fixed in the invitation referred to in paragraph (2), the applicant complies with the invitation and pays the required special fee, if any, the filing date shall be the date on which the elements referred to in Article 8(1) have been received by the Office. Otherwise, the application shall be treated as if it had not been filed.

(4) [Date of Receipt] Each Contracting Party shall be free to determine the circumstances in which the receipt of a document by a branch or sub-office of an Office, by a national Office on behalf of an intergovernmental organization having the power to grant regional patents, or by an official postal service, shall be deemed to constitute receipt of the document by the Office concerned.

(5) [Correction of Translations] Any translation of the parts of the application, or of the text matter, referred to in Article 8(5)(b) and (c) may be corrected at any time up to the time when the application is in order for grant in order to conform to the wording of those parts or that text matter furnished in a language other than the official language.

Rule 8

Announcement in the Gazette of the Publication of an Application (ad Article 15(1))

The publication of an application shall be announced in the official gazette with an indication of at least the following data:

- (i) the name of the applicant,
- (ii) the title of the invention,
- (iii) the filing date and the serial number of the application

(iv) where priority is claimed, the filing date and the serial number of the application the priority of which is claimed and the name of the Office with which that application was filed,

(v) if available, the symbols of the International Patent Classification.

Rule 9

Announcement in the Gazette of the Publication of a Change in a Patent (ad Article 17(5))

The publication of a change in a patent shall be announced in the official gazette with an indication of at least the following data:

- (i) the name of the owner of the patent,
- (ii) the serial number of the patent,
- (iii) the date of the change,
- (iv) the nature of the change.

Rule 10

Announcement in the Gazette of the Grant of a Patent (ad Article 13(1)(b))

The grant of a patent shall be announced in the official gazette with an indication of at least the following data:

- (i) the nature of the owner of the patent,
- (ii) the title of the invention,
- (iii) the filing date and the serial number of the application,
- (iv) where priority is claimed, the filing date and the serial number of the application the priority of which is claimed and the name of the Office with which that application was filed,
- (v) the serial number of the patent,
- (vi) if available, the symbols of the International Patent Classification.

Rule 11

Absence of Quorum in the Assembly (ad Article 27)

In the case provided for in Article 27(5)(b), the International Bureau shall communicate the decisions of the Assembly (other than those concerning the Assembly's own procedure) to the Contracting Parties having the right to vote

which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiration of that period, the number of Contracting Parties having thus expressed their vote or abstentions attains the number of Contracting Parties which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

Rule 12

Requirement of Unanimity for Amending Certain Rules (ad Article 29(3))

Amendment of Rule 2(1)(vi) or Rule 3(3) of these Regulations shall require that no Contracting Party having the right to vote in the Assembly vote against the proposed amendment.

Rule 13

Settlement of Disputes (ad Article 30)

(1) [Time Limit for Consultations]
The time limit referred to in Article 30(1)(b) shall be two months from the date of the request to enter into consultations.

(2) [Time Limit for Reaching Agreement on the Terms of Reference of the Panel]
The time limit referred to in article 30(3)(c) shall be three months from the date on which the Director General appointed the members of the panel.

Committee's efforts concerning the reception for the August, 1993 ABA Meeting. He said that preparations are well under way and predicted an attendance of 400-450. Arrangements are being coordinated with Hazel Mathews of the ABA.

Peter Saxon reported on efforts concerning the Harmonization Program scheduled for March, 1993. He circulated a proposed schedule showing the various questions to be discussed and tentative speakers. According to Mr. Saxon, the AIPLA and the NAPC have expressed interest in limited participation. The AIPLA will probably permit use of its mailing list. The NAPC will also permit use of its mailing list and may provide some materials. Mr. Saxon indicated that the maximum exposure for the Association should not exceed \$5500.

Randy Rasmussen made a presentation concerning a disability insurance program that may be of interest to the membership. As an adjunct to his presentation there was discussion whether the Association should continue to be an indirect sponsor of such a disability program. A motion to refer the question of disability to the Committee on Economics for study and report was made by Mr. Terzian. The motion passed unanimously.

Pasquale Razzano made a report concerning negotiations with the Waldorf-Astoria for the 1993 Judges Dinner. Mr. Barnaby indicated that he would contact Horizon to get a profit and loss statement concerning last year's dinner. Ms. Ryan reported on her efforts to secure a speaker.

Mr. Gilbreth commented that table assignments have been a problem due to the preferences within firms in combination with the requests for specific honored guests. Ms. Ryan suggested that Horizon should contact the firms involved if the requests for honored guests affect the table priorities.

Virginia Richard reported on her attendance with John Olson at the Madrid Protocol. It was suggested that information concerning the Madrid Protocol should be furnished to the membership to get the membership's "sense" concerning the outstanding issues. Mr. Mugford recommended an article in the *Bulletin* with such information, perhaps with a sheet to be returned for polling purposes. Ms. Richard agreed to generate such an article.

In addition, it was suggested that Bill Lawrence, the Chairman of the Committee on Meetings and Forums, should be contacted to see if a luncheon date could be made available to present a "debate" on the Madrid Protocol. Mr. Dippert agreed to do this. ■

PENDING LEGISLATION

by Edward P. Kelly

Numerous bills introduced in the 102nd Congress became law in 1992. The President signed bills that eliminated state immunity from patent infringement, established a royalty scheme for digital audio taping, increased criminal penalties for copyright infringement and clarified the fair use defense as applied to unpublished works. The 103rd Congress will continue to consider additional bills affecting intellectual property law. The first bill to be introduced this year relates to the amortization of trademarks.

TAX CONSEQUENCES OF BUSINESS ACQUISITIONS

The acquisition of an entire business usually involves the purchase of both tangible (buildings, inventory) and intangible (patents, copyrights, trademarks, goodwill) assets. For the buyer, the IRS currently provides an amortization deduction for acquired intangible assets if they have an identifiable value separate from goodwill and a determinable useful life. Under current law, goodwill, and in most instances trademarks and tradenames, are not depreciable because they are deemed to have an indeterminable useful life. Trademarks which have no known useful life may be amortized over 10 years for costs up to \$100,000 and over 25 years for costs over \$100,000. Acquired patents and copyrights, however, are depreciable if they are assigned an identifiable value in the course of

the transaction. Generally, the value of copyrights and patents cannot be amortized when they are acquired in a bulk transfer of business assets.

The buyer's primary incentive is to maximize the amount of the purchase price allocated to allowable depreciable intangible assets, thereby resulting in more depreciation deductions to reduce taxable income over the life of the assets. The nature of this tax treatment has led to disputes with the IRS over the type of intangible assets acquired as well as disputes over the amount of the purchase price attributable to particular intangible assets.

Several bills that would alleviate these controversies by simplifying the amortization rules when a business is acquired were introduced during the 102nd Congress. The bills would have allowed amortization of acquired intangible assets such as goodwill, trademarks, patents and copyrights acquired in a bulk transfer over a single 14-year period. The provisions of R.R. 11 had previously been contained in an overall tax package that President Bush vetoed.

One of the first bills (H.R. 13) introduced during the 103rd Congress is essentially a re-introduction of H.R. 11. The bill introduced by Dan Rostenkowski (D.-Ill.) contains essentially the same provisions as H.R. 11. Representative Rostenkowski stated that the bill may become part of a larger tax bill to be introduced later this year.

Several bills introduced last year but not enacted may be reconsidered this year. Congress will likely conduct hearings on the following bills.

TRADEMARKS

The United States is currently *not* a signatory to the century old Madrid Agreement concerning the international registrations of marks. United States trademark law has not been compatible with this agreement because U.S. law provides for extensive examination and opposition proceedings. Two years ago, however, a new protocol to the Madrid Agreement was adopted to attract the U.S. and other countries as members. It now appears that the U.S. will adhere to the Madrid Protocol.

Rep. William Hughes introduced a bill (H.R. 6211) last fall that would amend the Lanham Act to conform to the Madrid

Protocol in anticipation of the U.S. becoming a member. The bill would add a new Title XII to the Lanham Act. Under the bill, the owner of a U.S. registration or application could file an international application by submitting the application to the U.S. Trademark Office which would forward it to the international bureau of WIPO. The bill also provides that international applications received by the U.S. Trademark Office will be accepted, provided that the application is accompanied by a declaration of a bonafide intent to use the mark in commerce. Under the bill, requests for extension of protection in the U.S. would be subject to opposition proceedings.

PATENT HARMONIZATION

The harmonization of certain nation's patent laws have been discussed and negotiated in two venues in recent years. Harmonization has been proposed under the World Intellectual Property Organization (WIPO) and the trade negotiations involved in the General Agreement on Tariffs and Trade (GATT). GATT is a multilateral treaty that defines fair trade among its 108-member nations and settles disputes.

The PTO recently charted an Advisory Commission on Patent Law Reform to advise the Secretary of Commerce on necessary changes to the U.S. patent laws, should the U.S. decide to harmonize its laws with other nations. The Commission has recommended that the U.S. convert to a first to file rather than a first to invent system, but only as part of a harmonization agreement with other countries.

Two bills were introduced in the Senate (S.2605, DeConcini, D-Ariz.) and House (H.R. 4978 Hughes D-N.J.) last year that would harmonize U.S. patent laws with that of other countries. The bills provide for a first to file system with a twenty-year patent term and publication of a patent eighteen months after filing. The bill also provides for prior user rights. A prior user right is the right of a person to continue using an invention he or she independently developed prior to the issuance of a patent on that invention to another. These rights would allow a U.S. manufacturer using a secret process to continue to use that process without infringement liability to a subsequent patentee.

DESIGN PROTECTION

The House has held numerous hearings in recent years on the adoption of a statutory scheme that would fill the void between patent and copyright law and grant protection for useful industrial designs. Bills introduced in the House in past years, if adopted, would have added a new Chapter 10 to the Copyright Statute to grant protection to industrial designs of useful articles. The protection would be afforded to those designs that fall outside the scope of the traditional protections afforded by design patents, copyrights and trade dress law.

The bills all were similar to the extent that they provided for ten years of protection and excluded protection for commonplace designs or designs that are dictated solely by utilitarian functions. In past years, this legislation has faced opposition from certain industry groups. For instance, the aftermarket automobile replacement parts industry has feared that if design protection were afforded to the various parts of a car, i.e., fenders, the original equipment manufacturers would control the industry for replacement parts. The insurance industry also was not satisfied with that result because replacement parts are generally cheaper when purchased from an aftermarket supplier than from an original equipment manufacturer. The publishing industry also feared that if protection were afforded to certain typeface designs, publishers could be liable for reproduction and distribution of materials using protected typefaces. The last bill introduced on this subject was H.R. 1790. ■

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PATENT HARMONIZATION DEBATES

at

Fordham University
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RECENT DECISIONS OF INTEREST

by Thomas A. O'Rourke

PATENTS — PRIOR ART

The Federal Circuit Court of Appeals has recently held in *In re Carlson*, 45 PTCJ 137 (Fed. Cir. 1992), that a German design patent qualifies as prior art under 35 USC 102(a).

During a reexamination proceeding, the examiner cited, *inter alia*, a German design patent (Geschmacksmuster) against the patentee's design patent for a dual compartment bottle. The examiner noted that the German design patent constitutes prior art under Section 102(a). The board of Patent Appeals and Interferences, citing caselaw dealing with Section 102(d) affirmed.

Although it has long been settled that a German design patent, which gives a patentee rights more akin to copyright protection is prior art for section 102(d) purposes, whether it constitutes prior art for section 102(a) purposes was an issue of first impression.

Section 102(d) bars the issuance of a patent if the invention was patented by the applicant in a foreign country more than twelve months prior to the U.S. filing date. Under section 172 the twelve-month period is reduced to six months in the case of design patents. Section 102(b) bars the issuance of a patent if the invention was patented by another in a foreign country prior to the invention thereof by the applicant.

In affirming the Board of Patent Appeals and Interferences, the Federal Circuit stated:

We recognize that Geschmacksmuster on display for public view in remote cities in a far-away land may create a burden of discovery for one without the time, desire, or resources to journey there in person or by agent to observe that which was registered and protected under German law. . . . Moreover, actual knowledge of the Geschmacksmuster is not required for the disclosure to be considered prior art. To determine patentability, a hypothetical per-

son is presumed to know all the pertinent prior art, whether or not the applicant is actually aware of its existence. . . .

In conclusion, we hold that because the Geschmacksmuster fully discloses the design upon which German law conferred the exclusive rights attendant to the registration, the Geschmacksmuster qualifies as a foreign patent for purposes of section 102(a), and therefore constitutes prior art for use in the obviousness analysis under section 103.

COPYRIGHTS

In *Lish v. Harper's Magazine Foundation*, 45 PTCJ 71, (S.D.N.Y. 1992), the U.S. District Court for the Southern District of New York held that unauthorized publication of 52 percent of an unpublished letter did not constitute fair use.

Plaintiff Gordon Lish conducts writing seminars. In December 1990, Harper's Magazine published an article entitled "A Kind of Magnificence." The article comprised excerpts from a letter that Mr. Lish had sent to prospective students for his seminars detailing and phrasing the structure of the seminars.

The original letter was edited from 2,308 words to 1,206 words. The article contained the prefatory statement: "From introductory letter sent last summer by Gordon Lish to students enrolled in his fall fiction writing workshop." Deletions from the original were not marked. Mr. Lish sued Harper's for, *inter alia*, copyright infringement. Harper's contended its unauthorized publication was a fair use.

Harper's argued that its use of substantial amounts of the content was necessary to demonstrate Mr. Lish's character or teaching style and to disseminate facts about the way the seminars were run. However, the court rebutted Harper's argument. Judge Lasker stated:

Harper's knew that because Lish was a famous writer and teacher of writing, its readers — who, it should be noted, buy an average of 23 books a year — would be interested in reading the Letter as an example of his manner of expression, . . .

citing *New Era Publications Int'l v. Henry Holt & Co.*, 873 F.2d 576 (2d Cir. 1989) and *Salinger v. Random House, Inc.*, 811 F.2d 90 (2d Cir. 1989).

The Court stated:

It is true that since *New Era* and *Salinger*, the Second Circuit has refined its rule on use of

an author's unpublished expression and now seems to permit an exception when a direct quotation of the author is necessary to report a fact accurately and fairly. *** This view appears to have gained favor in recent decisions. *** *Wright v. Warner Books Inc.* *** However, *** Harper's published a substantially greater portion of the Letter than was required to achieve that purpose. The decisions which allow limited copying of unpublished expression emphasize that only minimal copying is permissible. ***

Harper's maintains that no more was taken than was necessary to convey the facts. However, Harper's used an unprecedented amount of unpublished material — over 1,200 words which amounted to 52% of the original and which, as published, took up more than a full page of the magazine. Such a taking was far more than that necessary to report factual information fairly and accurately.

PATENTS —OBVIOUSNESS

The Federal Circuit Court of Appeals in *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 44 PTCJ 387 (Fed. Cir. 1992), held that when determining obviousness-type double patenting, claims must be read as a whole.

Studiengesellschaft Kohle mbH (SKM) owns U.S. Patent no. 3,806,619 ('619 patent) entitled "Process for the Decaffeination of Coffee." The '619 patent referenced the '639 patent as supplying the source of caffeine. General Foods, a licensee under the patent, brought a declaratory judgment suit for a declaration of non-infringement, invalidity and unenforceability.

The District Court held the '639 patent invalid for "obviousness-type double patenting" in view of the earlier issued '619 patent. The Federal Circuit reversed. Writing for the Court, Judge Rich stated:

It should be amply clear by now that the decaffeination invention and the caffeine recovery invention are separate and distinct inventions, directed to different objectives, and patentably distinguishable one from the other. Neither is statutory "prior art" to the other because the patent applications were copending and, further because there can be no "prior invention by another" . . . because both are inventions of Zosel.

The Court determined that although the patents concern related subject matter, the '639 patent concerns a process aimed at producing decaffeinated coffee from raw coffee, while the '619 patent concerns a process for producing caffeine from raw coffee. The Court stated:

Claims must be read as a whole in analyzing a claim of double patenting. *** These two inventions, decaffeination of coffee and recovery of caffeine, are separate, patentably distinct inventions between which there cannot be double patenting. Clearly the two patents do not claim the same invention, and this is not argued. Under an obviousness-type double patenting analysis, neither claimed process is a mere obvious variation of the other. No other kind of "double patenting" is recognized, so there is no double patenting.

The Court further instructed:

Where there is a second patentable invention, as there is here, because the difference is not an obvious one, it is important to bear in mind that comparison can be made only with what invention is claimed in the earlier patent, paying careful attention to the rules of claim interpretation to determine what invention a claim defines and not looking to the claim for anything that happens to be mentioned in it as though it were a prior art reference. This was not done by the trial court. Rather, it was carefully misguided by GF's arguments into doing exactly the opposite, as we shall now show.

It should suffice, we feel, to point out the principal error into which the trial court was led which resides in a complete misinterpretation of claim 1 *** of the '619 patent on the caffeine recovery process, now expired. *** The gist of it is that claim 1 of patent '639 in suit is "obvious from claim 1(a)" of patent '619. Of course, there is no such thing as "claim 1(a)," a term used no less than 11 times throughout the Findings of Fact and Conclusions of Law. There is a claim 1 and the first step of its recited steps is designated "(a)." And that step recites the essence of the very same process claim in the '639 patent in suit, but, in accordance with the principles of claim construction ***, step (a) is not "claimed" in the '619 patent, nor is it "patented" or "covered" as the trial court seems to have thought it was as shown in its Finding of Fact 58 which says: "It was obvious to one of ordinary skill in the art that supercritical carbon dioxide would substantially decaffeinate coffee, as otherwise it would not be claimed in claim 1 of the '619 patent. . . ." *** This concept violates the fundamental rule of claim construction, that what is claimed is what is defined by the claim taken as a whole, every claim limitation (here each step) being material. What is patented by claim 1 of '619 is a 9-step caffeine recovery process, nothing more and nothing less.

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The New York Patent, Trademark and Copyright Law Association, Inc.
January/February 1992
Volume 32 Number 3

The BULLETIN is published periodically for the members of the New York Patent, Trademark and Copyright Law Association. Annual Non-Member Subscription is \$15.00/yr. Single copies \$2.00. Correspondence may be directed to the Bulletin Editor, Gregory J. Battersby, P.O. Box 1311, Three Landmark Square, Stamford, CT 06904-1311. Telephone No. (203) 324-2828.

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