



## QUESTION 39

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

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Yearbook 1963, New Series No. 13, 1st Part, 66th Year, page 85  
25th Congress of Berlin, June 3 - 8, 1963

Q39

#### Question Q39

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

#### Resolution

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

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

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Yearbook 1964/II, 67th Year, pages 112 - 113  
Executive Committee of Salzburg, September 14 - 18, 1964

Q39

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#### Resolution

The Executive Committee proposes to the Congress of Tokyo to express the wish that the text of Article 5 of the Convention be amended to read as follows:

#### Article 5 A

- 1. The patent shall give to the proprietor the right to prevent others from exploiting his invention during the duration of the patent**
2. Each country of the Union shall have the right to take legislative measures providing for a restriction of this right, not however in general but only for an Individual patent and only in the following cases:
  - a) where such a measure is necessary for satisfying an important public interest;
  - b) where such a measure is necessary to prevent the abuses which might result from the exercise of the exclusive rights conferred by the patent, for example failure to work;
  - c) where the proprietor of a patent which is dependent upon a patent enjoying an earlier date and the invention of which represents a notable advance over the invention of the prior patent cannot exploit his invention without infringing the prior patent; the proprietor of that prior patent may be compelled to grant a licence under his patent to the proprietor of the dependent patent limited to the extent which is absolutely necessary for the exploitation of the invention of the dependent patent; and on the other hand, in this case, the proprietor of the prior patent shall have the right to obtain licence from the proprietor of the dependant patent to exploit the said patent.
3. a) The compulsory licence shall be non-exclusive and shall not be transferable, even in the form of the grant of a sub-licence, except with that part of the enterprise or goodwill using such licence.

b) An application for a compulsory licence on the ground of failure to work or insufficient working may not be made before the expiration of a period of four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period last expires; it shall be refused if the patentee justifies his inaction by legitimate reasons.

**4. Revocation of the patent shall not be provided for except in case where the granting of compulsory licence has proved to be insufficient.** No proceedings for the cancellation or revocation of a patent may be instituted before the expiration of two years from the granting of the first compulsory licence. The importation into the country where the patent has been granted of articles manufactured in any of the countries of the Union shall not entail revocation of the patent.

**5. All restrictive measures other than revocation shall give rise to a claim to equitable compensation for the benefit of the patentee. All restrictive measures shall entail access to a judicial tribunal by the patentee, at least in the final instance.**

**6. A compulsory licence shall not be granted until an agreement has proved to be impossible.**

7. The foregoing provisions shall be applicable, mutatis mutandis, to utility models.

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## QUESTION 39

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Yearbook 1966/II a, 69th Year, pages 46 -47  
26th Congress of Tokyo, April 11 - 16, 1966

Q39

#### Question Q39

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#### Resolution

The Congress

formulates the wish that Art. 5A of the Paris Convention be amended as follows:

I. Each country of the Union shall recognize the exclusive rights conferred by the patent to the owner.

II. Each country of the Union shall have the right to take legislative measures providing for a restriction of the patentee's right, but only for an individual patent and not in general, and only in the following cases:

a) when such restriction is necessary for satisfying an exceptional public interest.

b) when such restriction is necessary to prevent an abuse which might result from the exercise of the exclusive right conferred by the patent, for instance failure to work.

c) when the proprietor of a patent which is dependent upon a patent enjoying an earlier date and the invention of which represents a notable advance over the invention of the prior patent, cannot exploit his invention without infringing the prior patent.

d) In the case in which there exists a right of prior working.

The importation by the patentee into the country, where the patent has been granted, of articles manufactured in any of the countries of the Union shall not entail forfeiture of the patent.

III. a) Any restrictive measure more severe than the grant of a licence, such as the forfeiture of the patent, shall not be provided for except in the case where the granting of a compulsory licence has proved to be insufficient. No proceedings for the forfeiture or

revocation of a patent may be instituted before the expiration of two years from the grant of the first compulsory licence.

Any restrictive measure other than revocation shall give rise to equitable compensation for the benefit of the patentee.

Any restrictive measure shall entail access to a judicial tribunal by the patentee, at least in the final instance.

b) In the case of a dependent patent, the proprietor of the prior patent may be compelled to grant a licence under his patent to the proprietor of the dependent patent to the extent which is absolutely necessary for the exploitation of the invention protected under the dependent patent.

Inversely, the proprietor of the prior patent shall have the right to obtain a licence from the proprietor of the dependent patent to exploit the latter patent.

c) An application for a compulsory licence may not be made on the ground of failure to work or insufficient working before the expiration of a period of four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period last expires; it shall be refused if the patentee justifies his inaction by legitimate reasons.

IV. A compulsory licence shall not be granted until an agreement has proved to be impossible.

The compulsory licence shall be non-exclusive and shall not be transferable, even in the form of the grant of a sub-licence, except with that part of the enterprise or goodwill using such licence.

V. The foregoing provisions shall be applicable, mutatis mutandis, to utility models.

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