

## **QUESTION 89 D**

### **Prior use**

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Executive Committee of Amsterdam, June 4 - 10, 1989

Q89 D

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#### **Resolution**

The working committee considered the two texts of Article 308 as set out in WIPO papers HL/CE/V/2 and HL/CE/VI/3 add. as well as the reports of the National Groups (Annuaire 1988/V) as summarised in Rapport de Synthèse (Annuaire 1989/I). The reports of the Groups were based on the HL/CE/V/2 text.

It was clear from the reports of the National Groups that any prior use rights should be limited to those activities which were carried out and/or contemplated by the prior user and that any rights or privileges accorded to him should be restricted to those activities.

However, the text of the HL/CE/VI/3 add. drafted by WIPO, prior to the Sixth Session of the Committee of Experts in Geneva (April 1989), introduced in the preamble, the concept of “use of the invention” which needed to be qualified by the subsections to a “restricted” use. The working committee being faced with this new text, chose to simplify it and proposes the following amended text:

#### **Article 308**

##### **Privilege of prior use**

(1) (a) Subject to subparagraph (b), the owner of a patent shall not enjoy, under that patent, rights against activities within the scope of the patent, not authorized by him, of a person (the prior user) who, at the date of the filing of the application, or where priority is claimed, at the priority date of the application on which the patent is granted, and with a view to industrial or commercial exploitation,

(i) was actually engaged in such activities, or

(ii) was engaged in serious preparations, involving, from the viewpoint of the prior user, significant investment, for such activities,

in the territory and any other place or space to which the sovereignty of the Contracting State extends and in or for which State the patent is granted.

It is understood that the expression „industrial or commercial exploitation“ comprises every form of exploitation for useful or economic purposes.

(b) Where the prior user engaged in activities or preparations therefore, obtained knowledge of the invention protected by the patent from or in consequence of acts performed by the owner of the patent or his predecessor in title, subparagraph (a) shall not apply in respect of the said activities.

(2) Paragraph (1) shall not apply to a successor in title of the prior user unless that successor in title is the owner of the enterprise or business, or that part of the enterprise or business, in which the prior user engaged in the activities or preparations referred to in paragraph (1) (a).

AIPPI is of the opinion that the rule should be mandatory.

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