PRESENTATIONS SUBMITTED BY THE PARTICIPANTS

Presentations Submitted by the Invited Professors and Researchers from Outside the Asia and the Pacific Region

DRAFT OF A MODEL CURRICULUM FOR THE TEACHING OF INDUSTRIAL PROPERTY LAW AND RELATED RIGHTS

by
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SUMMARY

This document contains the draft of a model curriculum for the teaching of industrial property law and related rights. The draft was initially prepared for meetings of the International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP), held in Munich and Geneva, in 1983 and 1984, respectively.

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Industrial Property and Transfer of Technology

GENERAL PART

I

Fundamental notions

1. Industrial Property and Industrial Property Law. 2. Terminology. 3. Historical evolution of Industrial Property Law. 4. Basis of Industrial Property Law. 5. Elements of said law. a) economic data; b) juridicial basis. 6. Contents of Industrial Property Law. The problem in a) the authors; b) comparative legislation; c) in Argentina. 7. Juridicial nature of the rights of Industrial Property. The various doctrines. The problem in domestic law. a) The law; b) the authors; c) the rulings of the courts. 8. Basic principles of Industrial Property Law. 9. Specific characteristics of Industrial Property Law. 10. Autonomy of Industrial Property Law. Various criteria. 11. Relationship amongst Industrial Property Law and other juridicial disciplines. 12. Industrial Property Law, economics and political regimes: a) Industrial Property Law and Capitalistic Countries; b) Industrial Property Law and Developing Countries; c) Industrial Property Laws Socialist Countries. 13. Industrial Property law and the moral rule. 14. Sources of Industrial Property Law: a) production sources; b) knowledge sources. 15. Methodology of Industrial Property Law. 16. Interpretation and applications of Industrial Property Rules.

II

Administrative and Fiscal

Regime of Industrial Property Law

a)

Administrative regime

1. General notions. 2. The administrative regime of industrial property Law. Organization of the Patent Office in: a) national law; b) comparative law. 3. Functions of the Patent Office. 4. Industrial Property attorneys. The Elzaburu Survey.

b)

Fiscal regime

5. The fiscal regime of industrial property law: a) at national level; b) at international level. Applicable Rules. Legal fees and taxes.

III

The International Regime of Industrial Property

1. Industrial Property Law and International Law. 2. The Paris Convention for the Protection of Industrial Property. Its historical development. Its importance. 2. The general principles and principal rules of union law. Its technic. Its competence. 3. Organization of the Union: a) its members; b) its organs; c) provisions of an administrative character. 4. Its present revision. Its scope. Present status. The WIPO Convention of 1967. 5. International Agreements within the frame of Paris Convention: a) The Madrid Agreement of 1891 concerning the International Registration of Marks and its revisions; b) The Madrid Agreement of 1891 for the repression of False or Deceptive Indications of Source on goods and its revisions; c) The Hague Agreement of 1925 concerning the International Deposit of Industrial Designs and its revisions; d) The Nice Agreement of 1957 concerning the International Classification of goods and services for the Purpose of the Registration of Marks and its revision; e) Lisbon Agreement of 1958 for the Protection of appellations of Origin and the International Registration and its revision; f) The Paris Agreement of 1961 for the protection of new varieties of Plants and its revisions; g) Locarno Agreement of 1968 establishing an International classification for Industrial Designs; h) Washington Patent Cooperation treaty (PCT) of 1970; i) Strasbourg Agreement of 1971 concerning the International Patent classification; j) Vienna Agreement of 1973 establishing an International classification of the Figurative Elements of Marks; k) Vienna Agreement of 1973 for the Protection of type faces and their International deposit; l) Budapest Treaty of 1977 on the International Recognition of the deposit of microorganisms for the Purposes of Patent Procedure and m) Geneva Treaty of 1978 on the International Recording of Scientific Discoveries. 6. Agreements outside the frame of the Paris Union: a) European Convention of 1953 elaborated by the Council of Europe relating to the formalities Required for Patent applications; b) The European convention of 1954 on the International Classification of Patents for Invention; c) The Hague Agreement of 1962 establishing the International Patent Institute; d) The Munich Convention of 1973 concerning the European Patent. 7. Regional agreements: I) Regional convention: a) The American System of Industrial Property; b) The Mexico convention of 1902, The Río de Janeiro convention of 1966; The Buenos Aires convention of 1910; The Santiago de Chile convention of 1923 and the Washington convention of 1929. II) Sub-regional conventions: a) The Montevideo convention of 1889; b) The Bolivian convention of 1911; c) The Central American convention for the Protection of Industrial Property of San José (Costa Rica) of 1968; d) Decisions 24 and 85 of the Cartagena Agreement. 8. Regional Agreements in other continents: a) The African and Magalasy Organization. b) The Lusacka Agreement. 9. The Work of International Governmental Organizations - WIPO; UNTACD; INIDO. The work of international private organizations. AIPPI; FICPI; LICCD; ATRIP; etc.

SPECIAL PART

A

Theory of Industrial Property rights

I. Industrial creations of utilitarian character

IV

Industrial Inventions

1. General Notions. Various meaning of the word "invention". 2. The definition of the invention. Different criteria. 3. Invention and copyright. 4. Invention and discovery. 5. General Notions on inventor's rights. 6. Legitimacy of its protection. Its economic and political basis. 7. Juridicial nature of the right of the inventor. Different doctrines. 8. Historic development of the protection of inventor's rights. The XIX Century Controversy. The present erosion of inventor's rights. Importance of patents for industrial progress and developing countries. Patents and transfer of technology. Patents between past and future.

V

The patent for invention and the substanstive conditions of protection

1. The protection of the invention and the patent for inventions. 2. Definition of patent for invention. 3. Its characteristics. 3. Different classes of patents: a) in national law; b) in comparative law. 4. Patentable inventions. 5. Sustantive conditions of patentability. 6. Exceptions to Patentability. 7. The question of inventive step. 8. Applicability of International Conventions. 9. Rights of foreigners. 10. Right of the true inventor to be mentioned as such.

VI

Acquisition and loss of the right to the patent

1. Acquisition of the right on the patent. Various systems. 2. The inventor and the patentee. 3. Who can apply for a patent. Various systems. 8. Inventions made pursuant to a commission or by an employee. 9. Inventions made at a University. The question in comparative law. 10. Title, specification claims, abstracts of a Patent. Its contents. II. Unity of invention. II. Issuance and Registration of Patents and acts relating thereto. Publication of patents. 18. Surrender nullity and lapsing of a Patent. 19. Effects of declaration of nullity and caducity. 20. Expropriation of Patents.

VII

Rights conferred by a Patent

1. Nature of rights conferred by the Patent. 2. Scope of Protection. Limitation of Rights under the Patent. Rights derived from prior use and manufacture. Duration of Patent: a) in national Law; b) in comparative Law.

VIII

Maintenance and transfer of Patents

1. Maintenance of a Patent: The question in a) national law and b) comparative law. 2. Lapsing of patents because of non-working. Remedies. The question in a) national Law; b) in comparative Law. Lapsing of patents and the Paris Convention. Present state of the problem. 3. Assignment and transfer of Patent applications and Patents. Joint ownership of patents.

IX

License of patents

1. Contractual Licenses. General Notions. 2. Contractual licenses and transfer of technology. License Contract Rights of Licensor to grant further Licenses. Rights of Licensee. 3. Assignability of Licenses. 4. License contracts involving payments abroad. 5. Invalid clauses in License contracts. The position of developing countries on the subject. Registration of contractual license. Procedure. 3. Compulsory Licenses. Compulsory Licenses for non-working of Patents. Compulsory Licenses for Products and Processes declared to be of Vital Importance for the defence or Economy of the country or for Public Health. Scope of compulsory Licenses. Guarantee required from applicant for a compulsory license. Compensation. Transfer of compulsory Licenses. Registration of a compulsory License at Patent Office. Amendments and cancellation of compulsory License. Procedure. 4. Licenses of Right.

X

Legal protections of the patent

1. Civil Sanctions. Procedure. 2. Penal Sanctions Procedure. 3. The action replevin. 4. Presumption of use of a patented Process. Legal procedure by patentee. The question of the "possession antérieure". Theory and practice. Recovery of damages. Proceedings.

XI

Utility models

1. Definition. 2. Terminology. 3. Historical evolution. 4. Importance of utility models, particularly for Developing Countries. Its critics. 4. Relationship between utility models, patents for inventors, industrial design and "certificats d'utilité". 5. Substantive conditions for the protection of utility models; a) in domestic Law; b) in comparative law. 6. Acquisition of rights on a utility model. Procedure and contents of the right. 8. Transfer and assignments of utility models. 9. Licensing. 10. Maintenance and loss of the rights on a utility model. 11. Civil and penal protection of utility models. Procedure.

XII

New Varieties of Plants

1. General notions. Their importance. New varieties of Plants and Trademarks. New varieties of Plants and patents of invention. Protection of new varieties of Plants: a) in domestic law; b) in international law. The Paris Agreement of 1961 and its revisions.

XIII

Entrepreneurial Secrets

1. General notions. Their importance. 2. Structural elements and requirements of industrial and commercial secrets. 3. Juridicial nature. 4. Industrial and commercial secrets and patents for inventions, "know how" and "tour de main". 5. Substantive conditions for the protection of industrial and commercial secrets. 6. Transmission of an industrial or commercial secret. 7. Maintenance and loss of industrial and commercial secrets. 8. Their civil and penal protection. Procedure.

XIV

Know-how

1. Definitions. 2. Various classes. 3. Its characteristics. 4. Importance and meaning of know-how. 5. Juridicial nature. Various doctrines. 6. Know-how and other industrial property creations. 7. Conditions of protection of know-how. 8. Acquisition and transmission of know-how. 9. Know-how agreements. 10. Civil and penal protection of know-how. Procedure.

XV

Inventor's certificates

1. Definitions. 2. Juridicial nature. 3. Characteristics. Its economical importance. 4. Inventor's certificates, patents of invention "certificados de invención" and "le certificat d'utilité". 5. Acquisition and Loss of inventor certificates rights. 6. Rights and obligations of the applicant or the holder of the certificate. 7. Rights and obligations of the State. 8. Limitations of the rights. 9. Duration. 10. Transfer "mortis causa" of the application for an inventor's certificate or of the inventor's certificate. 11. Co-property of inventors certificates. Compensation to the holder of the certificate. 12. Nullity of the inventor's certificate. Effects. 13. Civil and penal protection of inventor's certificates. 14. Procedure.

XVI

Transfer of Technology Patents

1. Definition. 2. Economical importance. 3. Inventions which can be object of a Transfer of Technology Patent. 4. Right to a Patent of Transfer of Technology. 5. Acquisition of a Transfer of Technology Patent. Proceedings. 6. Rights and obligations of the applicants or the holders of a Transfer of Technology Patent. 7. Duration. 8. Assignment. Its limitations. 9. Contractual licenses. 10. Exploitation by the Government or by a third party authorized by the Government. 11. Loss of the rights on a Transfer of Technology Patent. Surrender. Nullity. Its effects. Lapsing. 12. Civil and penal protection of Transfer of Technology. Patents. Procedure.

XVII

Innovations

Rationalization Proposals

Tecnorations

1. Definition of each one of these institutions. Similarities and differences. 2. Economical Importance. 3. Right to a certificate of any one of them. Procedure. 4. Use of the insititutions. Remuneration. 5. Controversies.

B

Industrial creations

with ornamental character

XVIII

Industrial Designs

1. General Notions. 2. Definition of an Industrial design. 3. Terminology. 4. Specific characteristics of Industrial designs. 5. Pure art. Applied art. Ornamentality. 6. Industrial design and artistic creations. 7. Industrial designs and trademarks. 8. Industrial designs and utility models. 9. Substantive conditions for Protection. 10. Acquisition of the rights on an Industrial design. Various systems. 11. Who can apply for an Industrial design. Industrial designs created by employees. 12. Non patentable designs. 13. Duration and renewal of registration of Industrial designs. 14. Rights conferred by the Registration of an Industrial design. Its limitations. 15. License agreements. 16. Assignment and transfer of Application or regulations. 17. Joint ownership of Rights conferred by Registration. 18. Surrender and nullity of Regulations. 19. The action of replevin. 20. Civil and penal protection of Industrial designs. Procedure.

Distinctive Signs

XIX

Trademarks

1. Ownership marks and trademarks. 2. Definitions. 3. Historical background. Specific factors of trademark law evolution. 4. Juridicial and economical conception of trademarks. 5. Trademarks in capitalistic and socialist countries. 6. The role of trademarks in the economic development of developing countries. 7. Functions of trademarks. 8. Juridicial nature of trademarks. 9. Comparison between trademarks and other industrial property rights. 10. Various types of trademarks. 11. The question of notorious trademarks. 12. Who can apply for a trademark registration. 13. Goods and services that may be object of trademarks. 14. Signs and means that may constitute a trademark. 15. Marks inadmissible on objective grounds. 16. Marks inadmissible by reason of Third Party Rights. 17. Substantive conditions for protection. 18. The question of acquired novelty. The "secondary meaning" doctrine.

XX

Acquisition, maintenance and loss of the right to a mark

1. Acquisition of the right to a mark. Various systems. 2. Maintenance of the right to a mark. 3. The question of the use of a mark: a) in domestic law; b) in comparative law. 4. Registered users. 5. The loss of the right to a mark. Renunciation of registration. Nullity of registration. Its causes. Lapsing of trademarks because of non use. Effects of nullity and lapsing of trademarks registrations. 6. Duration and expiration of trademarks rights. 7. Expropriation of trademarks. 8. The exhaustion of the rights of trademarks. 9. Trademarks and economic unions. The subject of the European trademarks and of the Cartegena Agreement.

XXI

Licensing and transfer of trademarks rights

1. Licenses agreements. General Notions. 2. The problem of licensing of foreign owned trademarks for use on domestic products in developing countries. 3. License contracts involving payments abroad. Governmental intervention. Various systems. 4. Invalid clauses in license agreements. 5. Exclusivity and non-exclusivity of license agreements. 6. Rights and obligations of Licensor and Licensee. 7. Assignments and transfer of applications and registrations. Various systems. The problem in a) domestic law, b) international law. 8. Requirements of Assignments and Transfers as to form. 9. Recording of Assignments and Transfers. Effects of the recording. 10. Joint ownership of the marks. Rights of the joint owners.

XXII

Trademark protection

1. Civil and penal protection of non-registered trademarks. Application of unfair competition rules. 2. Civil protection of trademarks. Various actions according to the different legal systems. Procedure provisions and rules Statute of limitations. 3. Penal protection of trademarks. Infringements. Procedure provisions and rules. 4. Penalties. Recovery of damages.

XXIII

Tradenames or Trade styles

1. Civil name. Social name. Tradename and trade style. Definitions. 2. Historical evolution of tradenames. 3. Subjective and objective functions of tradenames. 4. Juridicial nature of tradenames. Various doctrines. 5. Substantive conditions for the protection of tradenames. 6. Acquisition, maintenance and transfer of tradenames and trade styles. 7. Loss to tradename and trade style rights. 8. Civil protection of tradenames and trade styles. 9. Conflicts between trademarks, tradenames and trade styles. 10. Penal Protection. 11. Civil and penal procedural provisions and rules.

XXIV

The "Estilo commercial" and the slogans

a) "Estilo commercial"

1. Definition and characters. 2. The provisions of the Cuban Law of 1936. 3. Elements which may make part of the "Estilo commercial". 4. Functions of the "Estilo Commercial" a) as a distinctive sign; b) as an advertising means. 5. The "Estilo commercial" and the other distinctive signs. 6. Protection of the "Estilo commercial". a) in domestic law, b) in comparative law.

b) The slogans

1. Definition and terminology. 2. Elements and characteristics. 3. Historic evolution. 4. Double function of the slogans a) as a dinctive sign; b) as an advertising means. 5. The slogan and the other distinctive signs. 6. Civil and penal protection of slogans: a) application of trademark law; b) copyright law; c) unfair competition law. 7. The question in a) domestic law, b) in comparative law.

XXV

Collective Marks

1. Definition. 2. Characteristics. 3. Historical Evolution. 4. Juridicial nature. Various doctrines. 5. Various types of collective marks. 6. Rights and obligations of collective marks users. 7. Scope and functions of collective marks. 8. Acquisition of collective marks. 9. Regulations concerning the use of collective marks. Their contents. 10. Use of collective marks. 11. Transfer of registration of collective marks. 12. Nullity of registration of collective mark. 13. Civil and penal protection of collective marks. Procedure.

XXVI

Geographic denominations

1. Definition and General notions. 2. Economic and juridicial importance. Protection of competitors and consumers. 3. Various types of Geographic denominations. Various categories. 4. Characteristics. 5. General Principles of protection. 6. The standard of civil protection. 7. The standard of penal protection. 8. Indications incapable of Protection. 9. Special form of misuse of geographical denominations. 10. Domestic protection. 11. International protection: a) Multilateral treaties. The Paris convention. The Madrid Agreement. The Lisbon Agreement. b) Bilateral Treaties. 12. Interference of Geographic denomination protection with Trademark Law. 13. Geographical denominations and unfair competition law.

XXVII

Unfair competition

1. General notions. 2. Historical background and evolution of the notions of unfair competition. 3. Unfair competition and the various economic systems. 4. Unfair competition, unlawful competition and forbidden competition. 5. Basic examples of unfair competition. Economic competition. The act of unfair competition. What is unfair. Various methods to define it. 6. Classes of acts of unfair competition. 7. Action to prevent or repress the acts of unfair competition, the action to prevent or repress infringement of Industrial Property Rights and the action to collect damages. 8. Other forms of abnormal trade practices. "Concurrence parasitaire" and "Agissements parasitaires". 9. Unfair competition and antitrust laws. 10. Unfair competition in domestic and comparative law. Provisions of the Paris Convention. 12. Civil and penal actions to prevent or repress unfair competition. 13. The problem in domestic law and in comparative law. 14. Procedure.

XXVIII

Industrial Property

and consumer protection

1. General considerations. 2. Consumer Protection and marks and tradenames. 3. Confusion of trademarks and tradenames. The Dilution Doctrine. 4. Parallel Importation. Doctrine of international exhaustion of rights. 5. Deceptive marks. 6. Generic names. 7. Different problems in assignment and licensing of trademarks. 8. Foreign owned trademarks particularly in developing countries. 9. Mandatory use of marks and labelling. 10. Restrictions in conditions with respect to the use of marks. 11. Marketing of the same product by the same manufacturer under different marks or with or without a mark. 12. Consumer protection and collective and certification marks. 13, Consumer protection and tradenames. 14. Consumer protection and Geographical indications. 15. Consumer protection and different acts contrary to honest practices. 16. Actions and remedies. Government Role. Consumer's Role. The Role of Industry and Trade. 17. Consumer Information and Education, testing and self regulation. 18. Judicial and administrative proceedings.

XXIX

Industrial Property

and

Transfer of Technology

1. General notions and importance of Technology, particularly for developing countries. 2. Definitions. 3. Creation acquisition and adaptation of technology. 4. The problematic of the acquisition by developing countries of Technology: a) economical, b) technical, c) juridicial, d) cultural and e) political aspects of the transfer of technology to developing countries. 5. Methods for the transfer of technology to developing countries. 6. Transfer of Technology Agreements. Juridicial nature. Characteristics. a) Licensing of patents for inventions, trademarks and other Industrial Property Rights. Various aspects. Rights and obligations of Licensor and Licensee. Other questions. 7. Transfer of information or technical know-how agreements. Technical services and assistance agreements. Various aspects. Rights and obligations of grantor and recipient. Other questions. 8. The problem of agreements which require payments abroad. 9. Specific nature of such Agreement. Its problematic. 10 Governmental intervention and different systems related to it. 11. Permitted and forbidden clauses in transfer of technology agreements. 12. Transfer of Technology Agreements in national law and in comparative law. 13. Applicable Law.

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