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***Intellectual Property Reform in the  
Palestinian Territories***

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## Intellectual Property Reform in the Palestinian Territories

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## **I. Introduction**

### **A. The Case for Reform**

The signing of the Oslo peace agreements between Israel and the Palestine Liberation Organization opens the road for social, economic and cultural development within Palestinian society. The laws created by the Palestinian Legislative Council must not only reflect this hope but ensure that such progress can take place in a speedy and efficient manner.

There are two primary reasons why countries have laws which protect intellectual property. One is to give statutory expression to the moral and economic rights of creators and rights to the public to those creations. Secondly, legal protection promotes creativity as well as its dissemination and application, and encourages fair trading which in turn contributes to economic and social development. The second of these two reasons is the main motivating factor for protecting intellectual property rights by legislation and common law in developing countries, for several reasons.

Firstly, protection of intellectual property gives these countries greater access to foreign technology in several ways. Many foreign technologies which cannot be copied or pirated require instruction from their owners. The protection provided allows inventors to share their

research without fear of piracy. Such protection will also stimulate foreign investment in research and development.

Secondly, the protection granted to intellectual property provides incentives for domestic researchers to invest their resources and efforts in new innovations and technologies as well as encouraging entrepreneurs and investors in emerging-market countries to focus on problems indigenous to their countries.<sup>1</sup> When strong protection is provided, patents, trademarks and copyrights acquire a status equal to that of real economic assets, thereby encouraging banks and investors to provide capital for start-up or expansion of established ventures.

Thirdly, greater rewards for research are created both within the developing country and throughout the world. On the one hand, researchers and entrepreneurs reap larger profits if their rights are protected in all countries. On the other hand, if a country provides only narrow or weak protection, inventors and other creators will turn to other nations who can better reward their efforts.

Fourth, granting protection to IP is one of the criteria for being recognized as a civilized nation which respects both international comity and international law.

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<sup>1</sup> Griffith B. Price, Jr., *Protecting Intellectual Property: How New Democracies Stand to Gain*, *Economic Reform Today*, Number 3, 1995, The Center for International Private Enterprise, Washington, DC, pp. 23-24.

Finally, competition decreases and efficiency of the economy suffers when individuals are not properly rewarded for research efforts because of piracy and the resulting loss in profits.

For the reasons outlined above, it is of the utmost importance that attention be paid to the reform of intellectual property law in the West Bank and Gaza. These territories cannot, politically and economically, remain dependent on the largess of Western donor nations and the quasi-philanthropic contribution of foreign investors. The establishment of a healthy domestic economy demands the creation of a modern domestic industrial base, and the latter is contingent, in no small measure, on the development of an indigenous pool of inventors, creators and experts devoted to research and development. This human resource will not develop in the West Bank and Gaza unless, and until, adequate intellectual property protection is in place.

#### **B. Analytical and Organizational Structure of the Study**

Intellectual property protection can be conveniently analyzed and organized on two levels: domestic legislation and international protection (treaties, etc.). The domestic legislation now in force in the Palestinian Authority and in Israel will be dealt with in Chapter II. Chapter III will analyze the relevant provisions of the Interim Agreement between Israel and the Palestinian Authority relating to intellectual



property protections. In Chapter IV we will consider international treaties relating to intellectual property law in Israel, Jordan and under the Palestinian Authority and their applicability. Finally, in Chapter V we offer recommendations. For the benefit of our readers, we have included in Chapter VI copies of the laws applicable in the Palestinian autonomous regions as mentioned in Chapter II below.

We proceed on the assumption that the laws in the Gaza Strip and the West Bank will ultimately be unified in those few areas in which they now differ, in order to extend equal and consistent protection to intellectual rights in both regions as a whole.

## **II. The Domestic Legal Regimes**

### **A. Introduction**

Intellectual property refers to the legal rights which result from intellectual activity in the industrial, scientific, literary and artistic fields. This type of property is generally divided into two categories: industrial property, which includes protection of inventions through patents, protection of trade secrets and commercial interests through trademarks and protection of industrial designs and copyright which grants authors and other creators of works of the mind certain rights to authorize or prohibit, for a certain limited time<sup>2</sup>, certain uses made of their works.<sup>3</sup> An additional category of intellectual property rights which has become more important in recent years is neighboring rights which grant certain rights to performers, producers of musical works, producers of audio-visual works, sound broadcasters, cable programmers, owners of databases and developers of semi-conductors, among others.

The statutory basis of intellectual property protection in the West Bank and Gaza Strip has remained virtually unchanged since the

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<sup>2</sup> It should be noted that time limitations are even more substantial in regard to registered designs (generally 15 years) and patents (about 16 to 20 years) than in the case of copyrights.

<sup>3</sup> WIPO: Intellectual Property Reading Material, Part I, Introduction to Intellectual Property, pp. 5, (1995).

Mandatory period. In Gaza, the British Mandatory laws are still in force. The Jordanian statutes which replaced Mandatory legislation in the West Bank are to a great extent simply Arabic translations of the latter. Israeli military legislation regarding intellectual property has been extremely sparse and relegated mainly to procedural matters. Broadly speaking, the legal framework regulating intellectual property in the West Bank and Gaza may be characterized as antiquated on the one hand, but, on the other, marked by a unity and coherence not commonly found in other legislative spheres.

In presenting the legal regimes in force in the West Bank and Gaza we do not seek to provide an exhaustive review of current laws. Our main focus is on the substantive rights granted and the extent and means of their protection. In addition, we call attention to salient administrative issues. Our critique of specific elements of these statutes will appear as each point is discussed, while our more general, global suggestions for reform will be included in Chapter 4 of this report. It is our assumption that the global recommendations will be implemented only in the medium and long range, and our specific critiques are meant to provide immediate remedies for the defects in the extant legal regime which will remain in force in the short term.

## **B. Patents and Designs**

### 1. Applicable Legislation:

The primary patent statutes currently in force in the West Bank and Gaza are the Jordanian Patent and Design Ordinance (no 22) - 1953 (in force in the West Bank) and the Gazan (originally British) Patent and Design Ordinance (no 33) - 1924. Certain administrative provisions of the Jordanian law were amended by two Israeli military orders.

One of these military orders<sup>4</sup> is simply an administrative fee schedule which demands no further attention. The more important of these orders is the Order Regarding Patents and Designs (re-registration)(Judea and Samaria)(no. 555) - 1974. The primary purpose of Order 555 was the establishment of a new independent patent and design registry in the West Bank, since the Israeli occupation had rendered impossible protection in the West Bank of patent rights registered in Jordan. Article 4 of this Order provided for the establishment and maintenance of the new registry, and article 6 laid out guidelines for re-registering patents then registered in the Jordanian registry.<sup>5</sup> In addition, Order 555 transferred all powers enjoyed under the Jordanian law by the registrar, the minister of commerce, the council

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<sup>4</sup> Patent and Design Decree (Amendment no.2)(Judea and Samaria) - 1988.

<sup>5</sup> Article 6 granted holders of Jordanian patents a 12-month period in which to re-register their patent in the West Bank. That period ran from September 1, 1974 until August 31, 1975. In any case, Jordanian patents registered in 1974 would have expired by 1990. For both these reasons, article 6 is of no current effect. New patents may, of course, be registered under article 4, which remains in force.

of ministers and any other person to an official of the military government (later the civil administration). Order 555 also placed all appeal powers granted to any court according to the Jordanian law in the hands of an appeals committee.

The Gazan law has never been amended.

## 2. Definitions:

Both Jordanian and Gazan law<sup>6</sup> similarly define the following terms:

### **Invention:**

A new product or commercial commodity or the application in some new manner for any purpose of industry or manufacture of any means already discovered, known or used.

### **Design:**

The features of shape, configuration, pattern or ornament applied to any article by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appear to and are judged solely by the eye, but does not include any mode or principle of construction which is in substance a mere mechanical device.

### **Article**

Any article of manufacture and any substance, artificial or natural, or partly artificial and partly natural.

Clearly, these definitions limit the protection of these laws to a very specific set of inventions and designs. Rather than create broad, open-ended, catch-all categories of protected inventions and designs, these statutes draw a finite boundary between those inventions and designs within their ambit, and those which will remain unprotected. An invention will be considered as such only when the express statutory criteria are met. A new invention must either be a product or commercial commodity or a new use for an extant means in industry or manufacture. Designs will be recognized only in those cases in which the design is meant to be appreciated solely by the eye<sup>7</sup>.

This definitional problem is the main deficiency of intellectual property laws in force in the West Bank and Gaza, covering patent and design protection. The narrow scope of these definitions effectively serves as a built-in obsolescence factor for the statutes containing

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<sup>6</sup> These provisions, appearing in article 2 of both laws, are identical.

<sup>7</sup> The last proviso of this definition excludes functional features. The Israeli courts have interpreted this qualification to exclude merely functional features, for example, a shape that is dictated solely by the function of the article. If a shape also has some minimal aesthetic value, then it may be registered as a design, even though functionality is the dominant consideration in designing the object.

them. The particularistic terms and categories drafted over 70 years ago cannot possibly be interpreted to include the plethora of new entities which today are commonly recognized as patents and designs<sup>8</sup>. Moreover, the need for clear, statutory definitions is particularly pressing in a legal system whose judiciary has no experience or body of precedent upon which to interpret these definitions. Until the Palestinian judiciary familiarizes itself with the worldwide judicial contribution to intellectual property protection, and develops its own jurisprudential approach, the legislature must take the lead.

The extant laws were designed to be exclusive, and to function within the context of an entire series of intellectual property statutes. For example, inventions that are not industrial in essence, such as cultural and artistic works, are protected by a special law in the West Bank and Gaza dating from the Ottoman period. Most modern nations have such specialty laws on the books as well. Additionally of course, there are laws protecting copyrights, trademarks, tradenames and business names, each with a distinct legislative basis. Ultimately, once the judiciary in the West Bank and Gaza has carved out the application

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<sup>8</sup> Pointedly, the Israeli Copyright Act (1911) which is still in force, has been interpreted by the courts to include much new technology, despite the archaic language of the law itself. The courts have interpreted the law to protect integrated circuits and computer programs under the category of literary works, fictional film characters as engravings and audio-visual works were protected although such works are not recognized as a whole as protected works. However, these interpretations are indeed artificial and legislation is required to provide solutions to the new technological developments.

of each of the various existing laws, the legislature will be required to patch the holes in the legislative cloth, to insure protection of intellectual property rights which slip through these holes.

### 3. Substantive rights and remedies

It would appear at first glance that the scope and force of the rights granted to the patentee under West Bank and Gaza law are broad and right to use, exploit, make, manufacture produce, supply and sell the

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This definition, however, does not reflect the way in which patent rights are perceived by the law. A patent is a negative right. That is, it only confers to the patentee the right to prevent others from exploiting the inventions without authorization. A patent does not confer rights to exploit the invention. The grant of a patent is not a guarantee that the patent is valid, and exploitation of an invention by a patent holder may be an infringement of another patent held by another person. Article 28 of GATT-TRIPS, which will be discussed below in

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<sup>9</sup> Article 4(1) of both the Gaza and West Bank laws.



chapter V serves as a good model for determining the rights of the patent holder.<sup>10</sup>

The laws in force in Gaza and the West Bank contain, however, several undesirable or superfluous obstacles to patent registration. Article 8(5) of the **Gazan Patent and Design Ordinance** provides<sup>11</sup> that:

The registrar shall refuse to accept any application and specification for an invention the use of which would be, in his opinion, contrary to law, morality or public welfare.

On the one hand, patent rights are granted by the state and have no independent existence without registration and enforcement by the state. As such, the state has no obligation to grant protection to inventions which it considers undesirable or harmful. Prohibiting the use of an immoral invention by means of legislation and institutional measures indicates that there is no justification for the state to encourage commercial exploitation of such inventions by granting them

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<sup>10</sup> This as well as many of the recommendations made below are based on suggestions offered by attorney Moshe Goldberg, a legal expert in the field of intellectual property and a lecturer on that subject at the Hebrew University of Jerusalem. The authors wish to thank attorney Goldberg for all of his contributions to this paper.

<sup>11</sup> Unless otherwise noted, references are to provisions identical in content and numbering in both the West Bank and Gaza laws.

protection through registration. In addition, it is questionable whether the public should be required to finance protection for such inventions, and whether the time and energy invested by the appropriate authorities for registration is justifiable.

The primary problem lies in defining morality and public welfare. A great deal of legislation, however, does already contain provisions which refer to just these issues. Such terms require, from time to time, redefinition, as cultural mores change. The authorities must provide a system by which new definitions can be given to extant legislation when circumstances change. In addition, we recommend that damages be paid in such circumstances to the would-be inventor whose patent was denied registration according to the earlier definition.

On the other hand, however, it is difficult to justify the nonregistration (as opposed to the non-manufacture or use) of an invention patent on the basis of the immorality, threat to public welfare or illegality of its use. What is today immoral or illegal may tomorrow be considered otherwise, and the true inventor deserves protection for just such an eventuality. Moreover, as the example of military hardware amply demonstrates, an application which is immoral or illegal for the private individual may well be perfectly legal and even desirable for a government. The registrar of patents cannot foresee or imagine the full spectrum of potential uses of an invention. Nor should he be empowered to determine the bounds of morality and the public welfare.

Preventing illegal manufacture and use of an invention should be left to regular penal legislation and law enforcement authorities, and the registrars authority under article 8(5) should be repealed. This argument is further backed up by article 27(2) of the GATT-TRIPS which will be discussed further in the recommendations section of this report.

A similar situation currently obtains in regard to designs. Article 30(3) of both the Gaza and West Bank laws provide that:

The registrar may, if he thinks fit, refuse to register any design presented to him for registration and shall refuse to register a design of which, in his opinion, the use will be contrary to law, morality or public policy.

This section should be reconsidered in light of the reasons enumerated above, and for the additional reason that it apparently permits the registrar to reject a design without any grounds at all.

Another superfluous restriction on patent registration is contained in article 9 of **the Gazan Ordinance**, which provides that:

If in the opinion of the registrar the invention...concerns instruments of munitions of war or is of any military value, he shall refer the

application to the Minister of Commerce<sup>12</sup> who may, after such inquiry as he thinks fit:

(A) Direct that no patent shall be issued if he is of the opinion that such a course is in the public interest;

(B) Direct that the application shall proceed but that the patent shall be granted subject to such conditions as to the grant of licenses to the government or as to the right of purchase by the government as he may think fit.

It could be argued that this provision ought to be canceled in its entirety. We would of course not dispute the principle of eminent domain, and the authority to expropriate private property which it entails. But such authority is properly codified in specific statutes containing government prerogatives in case of war or emergency periods. Lacking a state of war or other emergency however, there is no justification for granting the executive a veto or broad discretion over the exploitation of a patent of this sort. Specific emergency legislation of this sort usually contains a broad range of provisions extending to rights and property of all types; there is no reason to single out intellectual property, nor for including exceptional and specific government powers in regular civil legislation.

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<sup>12</sup>

Israel Defense Forces.

city was assumed by an Egyptian official, and subsequently by an officer of the

There are, however, considerations which would give validity to this type of limitation in granting a patent. Firstly, the state's interests may be severely damaged not only by the use of certain types of weapons but also through weapon's transactions and the transference of technological know-how concerning them. Although these types of transactions are regulated by governmental license, this process is not sufficient because it may be avoided through the use of foreign patent registrations. Secondly, registration of a patent requires disclosure of the name, at least, of the patent which may alone damage the interests of the state. Finally, emergency legislation cannot be implemented with regard to inventions unless the Patents Registrar reports of them to the authorized, authorities.

In any case, Article 9 is not merely over-protective, but rather grossly obstructive, since it prevents even the initial registration of military patents. The legitimate state interest in preventing the manufacture of the tools of war can be protected, as in the case of patents deemed immoral or against the public welfare, by regular criminal legislation. Preventing the initial registration harms not only the inventor, but potentially society as a whole, since the patent will be unavailable should circumstances change. Moreover, it prevents exploitation of the patent for non-military purposes.

Further, article 9 is over-broad in extending to inventions of any military value. This could be construed to encompass the majority of

inventions. It should also be noted that article 9 contains no provision for compensating the inventor.

The provisions of article 10 establish, *inter alia*, that during the period between the acceptance of the specification until the actual sealing of the patent:

The applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the specification:

Provided that an applicant shall not be entitled to institute any proceedings for infringement until a patent for the invention has been granted to him.

While the inventors full rights in the invention - and with them a cause of action for infringement - should properly commence with the sealing of patent, it would appear unwise to prevent the applicant from taking any pro-active legal action to protect these rights before the patent is sealed.

When the applicant becomes aware, for example, that another party is utilizing the invention and that such use will continue past the anticipated sealing of the patent, giving rise to a cause of action for infringement, he should be entitled to enjoin such use. Indeed, the rule that a victim of tortious conduct must minimize damages and the principle of estoppel might serve to obligate the applicant in such case to seek immediate injunctive relief.

Patent infringement, however, must be considered in a different light from other tortious conduct. Firstly, the procedural right to file a suit for patent infringement should not be confused with the substantial patent right which determines the date on which unauthorized exploitation of the invention is regarded as a patent infringement. The procedural right ripens at the date on which the patent is granted, and in most legal systems the patent is applied retroactively to the date on which the application was originally filed. As a result, after a patent is granted, the patent holder may file an infringement suit for acts which were committed following the application date.

Secondly, in common law countries and under the Israeli Patents and Designs Ordinance, acceptance of the specification means only that the patent application has passed the examination which is conducted by the Patents office. After the specification is accepted, it has to be published so that opposition to the patent may be voiced. This stage is of no less importance than the examination of the application. Therefore, before this period has lapsed, the applicant is not entitled to patent rights. We would recommend that following this stage, the patent holder need not bear the consequences of administrative delays which occur until the patent is formally registered with the registrar or until the patent certificate is granted. The right to file a suit for a patent infringement should commence immediately after the oppositions stage is over. This method would provide greater fairness to both sides. On

the one hand, other interested parties would still have an opportunity to make use of an unregistered patent, up until a specified, reasonable time period. On the other hand, the patent holder is able to limit any potential damage which might otherwise be caused were he required to wait until the patent registration was published. The extant law in Gaza and the West Bank should therefore be amended to permit such interlocutory proceedings.

Article 15(1) provides that patents shall be in force for a period of 16 years. Subsections (2) and (3) of article 15 condition the force of the substantive rights in the patent on the prompt payment of fees:

(2) a patent shall cease if the patentee fails to pay the prescribed fee within the prescribed...;

(3) if any proceedings are taken in respect of an infringement of the patent committed after a failure to pay a fee within the prescribed time...the court...may, if it thinks fit, refuse to award any damages in respect of such infringement.

The rationale for this provision lies in the very goal of patent registration which is the disclosure of the invention to the public, so that the patent may be exploited. It is therefore important that competitors can learn, by a simple and objective inquiry, at what point they may legally exploit the invention, which requires that registration be updated at all times. Furthermore, non payment of the renewal fees is, in many cases, an indication that the patent holder wishes to



abandon his patent rights. Without some type of penalty, there is no incentive for patent holders to give, as recommended, an express notice of cancellation.

Article 15 is indeed extreme in determining that the patent ceases if registration fees are not paid. One possible solution is to enable the patent holder, who failed to pay the renewal fees, to restore the patent during a prescribed period, if the delay can be justified and if the restoration does not damage third parties who acted in good faith.

A second solution would be to completely reverse the rule in these subsections, and expressly state that such non-payment will not affect the rights in the patent unless accompanied by an explicit request by the patentee to cancel the patent. At the same time, a provision should be added which gives patent fees due the status of other debts to the national treasury, such as taxes, which are recoverable using simplified collection procedures.

A third recommendation would be to offer a grace period of some three to six months, during which time the patent holder would be in no way penalized for nonremittance of registration fees. All other potential patent holders would be required to wait this extra period prior to registering their patents. This provides the patent holder who is unable to pay the fees in good faith an opportunity to renew his patent without suffering undue penalties. Simultaneously, no injury is caused to other

patent seekers since the grace period is automatically built into the system. These last two solutions, however, are lacking an incentive for the patent holder to act promptly in remittance of registration fees, which may also discourage would-be inventors from developing new technologies.

Article 17, which supplements article 15(2) and (3) and describes the procedure for re-application following cancellation of the patent for non-payment of fees, should be correspondingly amended or repealed.

Action for the revocation of patents was, prior to 1967, provided for in article 23 of the West Bank law and article 22 of the Gaza law. The original mandatory law (still in force in Gaza) granted jurisdiction, properly, we believe, to the district court, while the Jordanian law transferred jurisdiction to the high court of justice.

Under Israeli rule, until the assumption of powers by the Palestinian Authority, this jurisdiction was in the hands of an Israeli appeals committee. Since the Israeli-established patent registry has never been used by the Palestinians, the Palestinian Authority, as a matter of practical necessity, has not needed to re-assign jurisdiction over revocation actions. We would recommend returning to the arrangement contained in the original mandatory law, i.e., jurisdiction

over revocation actions would be in the district court<sup>13</sup>. The high court of justice, which sits either as an appeals court or as a court of first instance in petitions against legally defective administrative acts and decisions, is not the proper venue for such actions. This becomes apparent from an examination of the specific grounds for such an action as defined in article 22 and article 23 of the respective laws. These include claims of fraud and original use and invention, which entail the type of fact-finding and evidence hearings for which the high court is ill-equipped.

Article 36(2) of the Jordanian law contains a similar provision regarding action to cancel a design license, and there, too, the jurisdiction should be returned to the district court.

Article 24 of the Gaza law and article 25 of the West Bank law contain the following limitation on actions for patent infringement:

The patentee shall not be entitled to recover damages in respect of any infringement of a patent...from any defendant who proves that, at the date of the infringement, he was not aware of the existence of the patent.

This curious and unjustified provision, which seems to take no account of the real damage caused to the patentee by infringements,

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<sup>13</sup> It should be noted that in most patent systems, at least in common law countries, the first instance to which a motion for a patent revocation is filed is the Patents Registrar. This is known as a direct attack. The courts engage in patents revocation only on appeal from the Registrar.

may be explained in the context of punitive damages. We would recommend expressly restricting it to punitive damages, while allowing suit for real damages even where the infringing party was unaware of the existence of the patent. Simultaneously, however, the law should also recognize a defense whereby at the date of the application for a patent the invention was being exploited in good faith by another party, or where actual preparations for its exploitation were made in good faith. Following the date of application, this defense is conditional on the invention being exploited only by the same party in the course of the same business.

Article 37(2) of the West Bank and Gaza laws unfairly both enhance and restrict the patentees remedies for infringement of registered designs:

If any person acts in contravention of this section he is liable for every contravention to pay to the registered proprietor of the design a sum not exceeding fifty pounds [in Jordan - Dinars"] as liquidated damages...

Provided that the total sum recoverable as liquidated damages in respect of any one design shall not exceed one hundred pounds [in Jordan - "Dinars"].

We believe that design infringement ought to be treated as a regular tort, and that real or punitive damages ought to be awarded according to the decision of a court in light of the circumstances of each

case. Liquidated damages should not be statutorily provided, and article 37(2) of both laws should be amended accordingly.

However, it should be pointed out that this section deals with civil damages, since it contains no requirement of criminal intent. It may be advisable to amend this section, so that the penalties mentioned therein (adjusted to reasonable sums) are levied in case of intentional infringement.

### C. Copyrights

#### 1. Applicable legislation:

Copyright law in the West Bank and Gaza consists entirely of British mandatory legislation, since neither Jordan, Egypt nor Israel made any changes to the original mandatory copyright regime. The main component of the mandatory regime was the Copyright Act, 1911, which was applied to Palestine by an Order in Council the Copyright Act, 1911 (extension to Palestine) Order, 1924. The Copyright Act was modified slightly by the High Commissioner in Copyright Ordinance, 1924 (hereinafter in this chapter: the Ordinance). The latter piece of legislation, in addition to adapting the criminal penalties contained in the act to the Palestine legal system, expressly canceled the Ottoman Copyright Law of 1910.

Current copyright law in the West Bank and Gaza is therefore the same complete corpus of laws in force over 70 years ago. Nonetheless, this law is as a whole quite satisfactory; it is drafted clearly and specifically, is relatively exhaustive in scope and detail and its substance is balanced and reasonable. The reason for this state of affairs is fairly obvious: the Copyright Act of 1911 is a regular British statute. By contrast, the ordinances regarding patents and trademarks were drafted as mandatory laws, and they reflect the shortcomings typical of this type of legislation: fragmentary in scope, ill-conceived

and idiosyncratic provisions, unfair or irrational restrictions, unclear language and rigidity. The Copyright Act of 1911, while outdated in some respects, has survived the test of time overall. It is not by chance, we believe, that this law remained unchanged by the Jordanians, Egyptians and Israelis.

## 2. Definitions

The specific points requiring modifications (which we address below in this chapter and in chapter V of this report) are few. The main defect of the act is definitional. This defect affects not just the general definitional provisions, such as article 1<sup>14</sup> and article 35<sup>15</sup>, but the majority of the acts provisions, like copyright laws worldwide, did not anticipate new technologies for creating, storing, copying, transferring and manipulating works. At issue are not only computer and digital technologies, but even magnetic tape and television technologies. Rather than repeat this critique at every relevant point, we address the complex issue of definitional reform in the recommendations section of this report.

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<sup>14</sup> Article 1(1) of the Act states that copyright shall subsist ...in every original literary dramatic musical and artistic work... subject to the conditions of the law.

<sup>15</sup> Article 35 lists the specific terms referred to in this law and their definitions.

Another important, albeit technical, element demanding attention are the dozens of articles in the Copyright Act of 1911 containing provisions unique to the particular political circumstances of Great Britain at the beginning of this century. These include references to the authority of the king, British possessions, protectorates and dominions and the application of orders in council. Simply put, these anachronisms must be removed from the law. Likewise, the *dramatis personae* of both the act and the Copyright Ordinance, 1924, e.g., the high commissioner, the judicial committee of the privy council, and so on, must be replaced by the appropriate PA officials and institutions.

### 3. Substantive Rights and Remedies

Other specific provisions demanding amendment are as follows: Article 2(1)(iv) contains a fair use provision, according to which short passages of copyrighted material may be included in school textbooks:

provided that not more than two of such passages from works by the same author are published by the same publisher within 5 years...

In our opinion this limitation is arbitrary and overly restrictive. If the legislator was content to rely on judicial interpretation of the requirement that such passages be short, he ought to be satisfied with a similar rule regard that such use is restricted to a small number of such passages within a 5



Article 8 of the Act negates recovery of damages for copyright infringement where the defendant had no knowledge of the copyright. In contrast to patents, which may be infringed by a person who was not aware of the patent and the infringing product or process was developed independently, a copyright is infringed only when a substantial part of the work is copied. Therefore, knowledge of the copyrighted work is an element which should be proven by the copyright owner. A fair balance between the parties should enable the copyright owner to enjoin the continuance of the infringing activity, even when committed by an innocent infringer, and perhaps the infringer in good faith should also return to the copyright owner the profits that were gained from the infringement which constitute unjust enrichment. However, this type of infringer should not pay real damages.

Article 10 contains a limitations rule, restricting suits to a period of three years from the infringement. To our mind, this period is unfairly brief, especially as it takes no account of the owners knowledge of the infringement, or lack thereof. A better arrangement would have the limitations period commence with the date the owner of the copyright first becomes aware, or should have become aware, of the infringement.

Article 11(1) provides for criminal penalties for **deliberate** copyright infringement. Aside from the necessity of adjusting the sums

enumerated, the provision for imprisonment with or without hard labour must be struck from the law. Interestingly, in article 3 of the 1924 ordinance, which contains the penal provisions of article 11 of the Act as adapted to the Palestine legal system, (yet does not limit the application of article 11 of the Act), the option of hard labour was omitted.

Article 15 of the Act obligates the publisher of any book to deliver copies to the British Museum and, if so demanded, to a series of additional libraries. While at first glance this article might appear to demand repeal, we believe that its adaptation to libraries in the West Bank and Gaza would be advisable. The long-term aggregate benefit to Palestinian society seems to far outweigh the infinitesimal costs to publishers.

Article 18, which grants copyright protection to government publications, should be repealed. In our opinion, government publications ought to be in the public domain. Or, in other words, the government should not be in the business of publishing for-profit works.

Articles 25-28, 30, 32-34, which deal with application of the Act to British possessions and other issues particular to Great Britain, may be repealed.

#### **D. Trademarks**

##### **I. Applicable legislation:**

The basis of trademark law in both the West Bank and the Gaza strip is the Trade Marks Ordinance, no. 35 of 1938, enacted by the British Mandatory. In Gaza this law is still in effect, while in Jordan it was supplanted by the nearly identical Trademark Law, (no. 33) - 1952. Israeli military legislation in this sphere was limited to Regulations adjusting fee schedules, and the Order Regarding Trademarks (Re-Registration)(Judea and Samaria)(no. 397) - 1970. This latter order effectively parallels the Order Regarding Patents and Designs (Re-Registration)(Judea and Samaria)(no. 555)-1974 discussed above. Like Order 555 regarding patents, the primary purpose of Order 397 was the establishment of a new trademark registry in the West Bank to ensure protection of trademarks registered in Jordan. Article 3 contains the procedure for re-registering trademarks then registered in Jordan.<sup>16</sup> Order 397 also transferred all powers enjoyed under the Jordanian law by the registrar, the minister of commerce, and the council of ministers to an official of the military government (later, the civil administration).

Unlike the patent provisions of Order 555 however, Order 397 does not make any provision for establishing a registry for new

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<sup>16</sup> While Order 555 gave holders of Jordanian patents a 12-month period in which to re-register their patent in the West Bank, Order 397 provided a 2 year grace period.

trademarks, and it is not clear whether the Israeli military government and civil administration were prepared to accept such trademarks. If there was no registry of new trademarks under the Israeli regime, then the Palestinian Authority has as its first task the expansion of the registry maintained by the Israelis for re-registration, to include new trademarks as well.

Despite the fact that the Trademarks Ordinance, 1938 is a Mandatory statute, it is on the whole satisfactory. Trademark law has suffered far less obsolescence with the passage of time and the development of new technologies than patent and copyright legislation. Moreover, it appears that the British mandatory paid special attention to the issues of trademarks, enacting a whole series of trademark ordinances and amendments thereto during its relatively brief rule in Palestine. For our purposes, this means that trademark law reform can be limited primarily to administrative and procedural issues, as described below.

Article 7(5) and (6) of both laws provide that:

(5) A trade mark must be registered in respect of particular goods or classes of goods;

(6) Any question arising as to the class within which any goods fall shall be determined by the registrar, whose decision shall be final.

Granting final discretion to a civil servant is typical of British mandatory legislation (where such officials were carrying out the policies of the mandatory power), but this type of discretion is out of place in a self-governing political system with a strong judiciary. In such circumstances, we would recommend making this and all determinations of the registrar subject to judicial review.

In the case of the Palestinian Authority, however, judicial independence has still not been achieved and until then, it may be preferable to leave such decisions to the discretion of the registrar. In addition, it could be argued that this type of discretion is inevitable. In light of the fact that every application for a trademark registration is submitted to the Trademarks Office, it is natural that this office will also decide how to classify a product or service. Such classification is required for administrative convenience. It does not, however, mean that a trademark is infringed only if it was used with regard to a product or service which is included in the class under which the trademark is registered.

It should also be noted that the registrar has judicial capacities, the implications of which are by far more important than products classification<sup>17</sup>. This fact should be further explored in both the existing West Bank and Gaza law.

Finally, as mentioned above, the registrars decision on this issue should be subject to court review upon appeal.

Article 11(3) of both the Jordanian law and the 1938 Ordinance provide that appeal of refusal to register a trademark shall be made to the high court of justice. As we have noted above in regard to patents, the grounds for refusing registration will in the main require the type of evidentiary hearings that the high court is not able to conduct. The review jurisdiction over refusal by the registrar to register a trademark should therefore be transferred to the district court, and the district

Articles 11(4), 12, 14(5)-(9), 17, 18(2), 19(2) and 22-26 also provide for appeal of the registrars decision to the high court of justice, and these sections ought to be modified in the same way as article 11(3).

In any case, the evidentiary and highly specialized examination demanded by trademark disputes probably militate against regular judicial review. We would advise ultimately removing these issues from the regular courts, and placing jurisdiction in the hands of either review boards or special courts to be established. In chapter V of this report we examine the question of intellectual property courts for trademark, patent and copyrights disputes and questions. The proliferation of provisions for judicial review contained in the extant trademark

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<sup>17</sup> Under Israeli law, the registrar must have the same qualifications as a district court judge.

legislation merely serves to highlight the necessity for such specialized judicial review.

### **III. REGULATION OF INTELLECTUAL PROPERTY IN THE ISRAELI-PALESTINIAN AUTONOMY ARRANGEMENTS**

#### **A. Background: The Israeli-Palestinian Peace Process**

While the first portion of this study has focused on the domestic intellectual property laws currently applicable in the West Bank and the Gaza Strip, the legal regime in these areas includes another important element, namely, the Israeli-Palestinian autonomy arrangements. These arrangements, which will be reviewed and evaluated in this chapter, provide for the creation of a new legal situation in relation to standards and systems of intellectual property protection in the West Bank and Gaza Strip, and therefore must be taken into consideration in the context of any proposed amendment to the existing intellectual property regime.

Of the two agreements currently in force between Israel and the PLO - the Declaration of Principles on Interim Self-Government Arrangements ("the DOP") signed September 1992 and the Israeli-Palestinian Interim Agreement on the West Bank and the Gaza Strip (the Interim Agreement) - only the Interim Agreement contains provisions dealing with intellectual property. The DOP, it may be recalled, is the legal document which establishes the framework of the Israeli-Palestinian peace process. As such, it does not contain any explicit provisions on the question of intellectual property. Still, some of its provisions can be interpreted in a way which may accommodate



intellectual property-related questions, and some of the institutions established by or encouraged in the DOP may have some authority in this field.

For example, Article XI of the DOP establishes an Israeli-Palestinian Economic Cooperation Committee "in order to develop and implement in a cooperative manner the programs identified in ... Annex III and Annex IV."

Annex III, entitled "Protocol on Israeli-Palestinian Cooperation in Economic and Development Programs," provides that the Committee will focus, among other things, on:

...Cooperation in the field of trade, including studies, and Trade Promotion Programs, which will encourage local, regional and inter-regional trade...and cooperation in other areas related to trade and commerce.

...Cooperation in the field of industry, including Industrial Development Programs, which will provide for the establishment of joint Israeli-Palestinian Industrial Research and Development Centers, which will promote Israeli-Palestinian joint ventures...

Similarly, Annex IV, entitled Protocol on Israeli-Palestinian Cooperation Concerning Regional Development Programs", provides in Article 2.A.(1) for the establishment of an Economic Development Program for the West Bank and the Gaza Strip, consisting of, *inter alia*, "A Small and Medium Business Development Plan."

Furthermore, Article VII (4) of the DOP enables the Council to establish, upon its inauguration and "in order to enable [it] to promote economic growth," various boards and authorities, the powers and responsibilities of which are specified in the Interim Agreement. However, these provisions cannot be viewed as arrangements aimed at dealing with intellectual property questions; their impact is, at most, to indicate the appropriate fora and institutions for the sides to raise and deal with questions relating to intellectual property.

The Interim Agreement provides, *inter alia*, for the partial transfer of powers and responsibilities in civil spheres from the Israeli military government and its Civil Administration to the elected Palestinian Legislative Council. Yet this transfer was not devised as a complete and comprehensive substitution of the Israeli military government by the newly-elected Council; for not only was the military government to continue to exist, it was also to continue to exercise various powers and responsibilities which were not transferred to the Council and were retained by Israel. Moreover, powers and responsibilities were transferred to the Council only in relation to non-Israelis, and only in areas which came under the territorial jurisdiction of the Council.

Although nowhere in the agreements can the term autonomy be found, it is clear that, from the point of view of international law, that is

the nature of the regime established by the Oslo Accords. This characterization serves as the basis of our discussion, for it provides the context for the examination of the impact of the accords on the intellectual property laws in the West Bank and Gaza. The fact that the regime provided for in the agreements is an autonomy regime, coupled with the fact that the source of legal authority in the territories is the Israeli military government, as well as the wording of some of the constituent provisions of the various Oslo accords, all lead to the conclusion that the nature of the regime established in the West Bank and the Gaza Strip for the duration of the transitional period is that of a Palestinian autonomy under the supreme authority of the Israeli military government.

This conclusion also serves to support the explicit language used in article I(1) of the Interim Agreement which stipulates that, Israel shall continue to exercise powers and responsibilities not so transferred to the Council. Therefore, where the agreement is silent regarding a particular power, that power is retained by Israel<sup>18</sup>. It is important to bear in mind that where the accords do provide for a transfer of powers and responsibilities in a civil sphere which includes the field of intellectual property, we must carefully check the extent of such a transfer, so as to verify whether and which powers and responsibilities were retained by Israel.

### **B. Intellectual Property Provisions in the Interim Agreement**

In reviewing the Interim Agreement provisions regulating intellectual property issues, it should be borne in mind that the Interim Agreement, in accordance with the Declaration of Principles, contains the legal arrangements applicable in both the Gaza Strip and the entire West Bank for the remainder of the interim period - a five-year period which is scheduled to end in May 1999.

The transfer of powers and responsibilities to the Palestinian Council in civil matters is provided in Article I(4) of the Interim Agreement:

As regards the transfer and assumption of authority in civil spheres, powers and responsibilities shall be transferred and assumed as set out in the Protocol Concerning Civil Affairs attached as Annex III to this Agreement (hereinafter 'Annex III').

Appendix I of Annex III lists civil spheres in which powers and responsibilities were transferred to the Council. Article 23(1) of that Appendix, titled "Legal Administration", provides that:

Powers and responsibilities in the sphere of legal administration shall be transferred from the

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<sup>18</sup> Joe

*Justice*, December 1993, pp.5-18, at 8.

military government and its Civil Administration to  
the Palestinian Side.

According to Article 23(2)(e), this sphere is to include, *inter alia*,

registration of companies and intellectual property rights, including, but not limited to, patents and trademarks.

Paragraph 4 of Article 23 specifies the extent of the transfer and imposes various obligations on the sides. It is worth citing in full:

*4. Intellectual Property Rights:*

*a. Intellectual property rights include, inter alia, patents, industrial designs, trademarks, copyright and related rights, geographical indications and undisclosed information.*

*b. (1) Each side shall use its best efforts to adopt in its legislation standards of protection of intellectual property compatible with those in the GATT Agreement on Trade Related Aspects of Intellectual Property (hereinafter "GATT-TRIPS").*

*(2) Each side will strive to establish an adequate system for the examination of applications for registration of intellectual property rights compatible with those in GATT-TRIPS.*

*c. Each side will recognize the copyright and related rights in original "literary and artistic works", including in particular, musical works, computer programs and audio and visual recordings, legally originating in the areas under the jurisdiction of the other side.*

*d. Each side will recognize the undisclosed information rights originating in the areas under the jurisdiction of the other side.*

*e. (1) In view of the free movement of industrial goods between Israel on the one hand and the West Bank and Gaza Strip on the other, each side when processing applications submitted by any resident or legal entity of the other side for the registration of patents, industrial designs, trademarks and geographic indications (hereinafter "Registered Rights"), shall expedite the examination process including publication for objections, for Registered Rights existing and in force in both areas, on the date of the transfer of powers and responsibilities in the sphere of legal administration.*

*(2) In the event of a dispute between the registration of Registered Rights in Israel and their registration in the West Bank and Gaza Strip the registration of each side will apply in the areas under its jurisdiction.*

*f. In the interest of promoting investment in the region, and in order to facilitate the protection by registration of intellectual property rights, the Palestinian side will, when processing applications for registration, take account of the fact that a particular right has been examined elsewhere.*

*g. Without prejudice to the provisions contained in Annex IV (Protocol concerning Legal Affairs), each side will extend its administrative and judicial protection to intellectual property right-holders of the other side. The purpose of this protection is to permit effective action against any act of infringement of intellectual property rights under this Agreement, including expeditious remedies to prevent*

*infringements, and remedies which constitute a deterrent to future infringements.*

*h. The two sides will provide each other on a case-by-case basis with information regarding the registration of Registered Rights held by their respective Registrars of intellectual property rights.*

*i. Both sides shall ensure that their Registers are open to the public.*

Some of these provisions merit a closer look.

First, the powers and responsibilities concerning intellectual property under the Interim Agreement include the full spectrum of intellectual property rights. Paragraph 4(a) refers explicitly to industrial designs, copyright and related rights, geographical indications, undisclosed information but through the use of the term *inter alia* also provides an inexhaustive list. Such flexibility in intellectual property legislation is necessary if the country at hand is to keep up with new developments and inventions.

No less importantly, paragraph 4(b) specifies a desired legal standard of protection of intellectual property. Although the sides undertook only to make their "best efforts" to adopt, in their respective legislation, standards which are compatible with the GATT-TRIPS rather than to unequivocally adopt these standards, this provision still represents progress, for it both facilitates the bilateral approximation of the laws of the parties, and also sets universal and modern standards



for the two legal systems. Furthermore, the agreement does not specify what those standards of protection are and it could be argued that all provisions of the GATT-TRIPS which in any way provide any type of protection to intellectual property rights should be adopted. The applicable provisions of the GATT-TRIPS will be analyzed in chapter V.

Subsections c - e make an important distinction between copyrights and undisclosed information rights, and industrial rights (trademarks, patents and industrial designs). Subsections c and d provide for mutual recognition of copyrights and undisclosed information rights originating in the areas under the jurisdiction of the other side. Although copyrights are generally internationally recognized, a provision which explicitly recognizes such right serves as even greater protection to authors and artists.

Subsection e(1) - (2) explicitly allows for the registration of industrial rights (referred to in the article as Registered Rights) by a resident of one side with the registry of the other side. IP rights are, by their nature, territorial; they are recognized only in the territory in which they are registered or in which they originate.

The legal systems in the West Bank and the Gaza Strip were never included in the Israeli legal system. Moreover, the aim of the DOP and the Interim Agreement is to facilitate an independent legal system for the Palestinian Authority. Therefore, and in light of the fundamental IP

principles, registration in Israel does not create an automatic right in the Palestinian entity, and vice versa. Double registration is dictated by the nature of the registered rights and by the principle of sovereignty.

Cases in which national registration in one country is automatically recognized by another, are rare (as in Benelux). In both the European Community Trademark, a new and experimental arrangement which enables the registration of one single trademark in all of the EU territory as well as the European Patent, which is, following registration of the patent, a series of national patents governed by the national laws of each country, there are independent ultra-national institutions which are separate from the national authorities, through which the registration process is carried out.

Subsection (f) requires the Palestinian side to use the registration of patents elsewhere (it is unclear whether this means only in Israel or around the world) as a guideline for the registration of patents in the Palestinian autonomous regions in an effort to expedite the registration process. This provision is problematic because it forces one side to utilize a registration process which may not only be vastly different from its own but, more importantly, perhaps completely unknown to it. This problem may also explain why this provision is unilateral and makes no similar demand on the Israeli side. Indeed, application of this type of requirement is desirable only after both legal systems are able, after

investigation and experience, to decide whether the registration process in the other side satisfies their requirements.

Although subsection (g) serves as a theoretical protection to intellectual property right holders in both places, the administrative and judicial protections provided by each side are vastly different. As demonstrated in chapter 1, the protections provided by British Mandatory and Jordanian law are often inadequate and archaic. Furthermore, the mechanisms for enforcing what protections do exist are still not in place. Ultimately, this provision will serve as a useful means of enforcing and protecting intellectual property rights, but at the present time, those seeking remedy through it may face great obstacles.

The importance of attracting foreign investment has been a key assumption underlying the Israel-PLO agreements, and this recognition led the Palestinians to undertake to take account of existing registrations of rights under the examination of the Palestinian authorities.

It should be noted that, additional to the system of approximation of laws, mutual recognition and protection and cooperation established in Article 23, the sides reproduced in Annex V of the Interim Agreement

a Side Letter<sup>19</sup> dated April 29, 1994, which records the agreement of both sides

to continue discussion through the Joint Economic Committee of the following issues with the view of conclusions [sic] agreed arrangement within three months:

1. The mutual recognition and protection of patents, designs and trade marks, and other intellectual property.

While no such agreement was ever signed by the sides, the inclusion of the letter in the Interim Agreement long after the expiration of the aforementioned three month period indicates that the parties are still interested in pursuing through Joint Economic Committee the "mutual recognition and protection" of intellectual property rights.

Protection of intellectual property rights is also addressed by the Interim Agreement from the point of view of cooperation in research. Article VI of Annex VI of the Interim Agreement provides for the promotion of cooperation by the two sides "in scientific research and technological development," and dictates that the sides "shall devote special attention to...development of an environment conducive to research, application of new technologies and adequate protection of intellectual property rights for the results of such research."

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<sup>19</sup> This Side Letter was part of the Paris Economic Agreement of April 29, 1994, then was subsequently adopted as Annex IV of the Gaza-Jericho Agreement, and in turn was incorporated into Annex V of the Interim Agreement.

Two further salient remarks should be made at this stage: First, apart from the specific details of the law-making power of the Council in relation to intellectual property arising out of the above-mentioned Article 23(4) of Appendix I, Annex III, it is clear from Article XVIII of the Interim Agreement that the Council has a **general** legislative power in all intellectual property-related matters under its jurisdiction.

Second, it should be noted that according to Article IX(5)(a) of the Interim Agreement, the Council is not allowed to conduct foreign relations, a restriction that also precludes the signing of international agreements. Even though this article recognizes, by way of an exception, some categories of agreements which the PLO may sign "for the benefit of the Council", these categories do not include intellectual property agreements. The Council cannot, therefore, join international agreements for the protection of patents and trademarks. In the legal regime established under the Interim Agreement then, the Palestinian Council has extensive internal powers to administer and legislate in relation to the registration of intellectual property rights, but does not have the capacity to enter new or existing international agreements.

### **C. Conclusions**

Having reviewed the arrangements agreed upon between Israel and the Palestinians in the field of intellectual property, it is necessary

to assess those arrangements. Naturally, this assessment should concentrate on the following question: To what extent can these arrangements accommodate amendments of the existing intellectual property laws applicable in the West Bank and the Gaza Strip?

The Interim Agreement, which contains the arrangements applicable to both the West Bank and the Gaza Strip for the remainder of the interim period, introduces a progressive system aimed at ensuring mutual protection of intellectual property rights in both Israel and the Palestinian-controlled areas - including cooperation and coordination mechanisms.

The Interim Agreement also records the willingness - albeit in a non-mandatory language - of both sides to approximate their respective intellectual property laws, and in doing so, to conform to the international standards established in the GATT-TRIPS. Indeed, in this respect the Interim Agreement actually requires the amendment of existing laws now applicable in the West Bank and prescribes a limitation on the substance of their amendment.

The introduction of the GATT-TRIPS standard and other provisions contained in the Interim Agreement reflect the realization by both sides of the need to attract foreign investment to the region - and the consequent need to provide strong intellectual property protection. A question which remains unanswered is whether the non-mandatory

nature of the obligation to make the sides' respective laws compatible with the GATT-TRIPS is sufficient in light of that realization. Similarly, one wonders about the potential impact of a Palestinian accession to existing multilateral intellectual property conventions on the Palestinian - and Israeli - economy.

At the moment, this cannot take place anyhow due to Israel's insistence on allowing the Council no powers in the field of foreign relations - which is reflective of the non-independent autonomous nature of the Oslo arrangements.<sup>20</sup> But other exceptions to the rule do exist, and new exceptions may be drawn up in such a manner which will satisfy the Israeli position on foreign relations.

We believe it is in the interest of both parties to find a way to implement those elements of the Interim Agreement, and in particular, those provisions which relate to the GATT-TRIPS, which provide greater scientific cooperation between the parties and stronger protection to intellectual property rights. Similarly, several of the international treaties noted below in chapter IV are worth of serious consideration and it would be in the interests of both sides to find indeed increase foreign investment in the region, particularly in the

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1994) 28 *Israel Law Review* 268, at 269.

Palestinian territories, creating a more stable and prosperous environment for Palestinians and Israelis alike.

#### **IV: Intellectual Property and International Law**

##### **A. Treaties and Organizations Related to Intellectual Property**

It is worth noting several of the many international treaties and organizations which exist in areas such as trademarks, patents, copyrights and designs. The list which follows consists of those treaties and organizations which are central to intellectual property protection on an international level.

##### **1. The Paris Convention for the Protection of Industrial Property (1883)**

The Paris convention addresses various forms of industrial property, including trademarks, appellations, patents, utility models, industrial designs and unfair competition. The Convention obligates members to provide substantive protection for the procurement, maintenance and enforcement of industrial property. Member nations are required to: (1) implement trademark registration systems that offer protection against infringement and unfair competition; (2) recognize a priority filing date, that is a trademark application filed in foreign nations



will be deemed filed as of the home filing date, provided that the applicant files the foreign nation applications within six months of the home application; (3) confer equal rights to all trademark owners, whether foreign or domestic.

Some 128 countries are signatories to this treaty, including both Israel<sup>21</sup> and Jordan.

## **2. The Berne Convention (1886)**

The Berne Convention is one of the more far-reaching agreements dealing with copyright protection. Berne members constitute a union that is open to all countries of the world, so long as certain minimum requirements are met. These requirements include: (1) national treatment (the same protection is granted to works of nationals of, and to works first published in, any other member state as is granted to nationals for works first published in the home territory or to unpublished works created within that territory); (2) the granting of certain moral rights to authors with regard to the exploitation of their works; (3) the granting of certain economic rights, such as exclusive rights of translation or reproduction, and (4) the adoption of certain minimum terms of protection, generally the life of the author plus 50 years. Berne also provides copyright protection without requiring that any formalities be observed. A country is not prohibited from providing

evidentiary benefits as an incentive to registration<sup>21</sup>. Israel became a signatory to this convention in 1951; Jordan has not joined.

### **3. The Patent Cooperation Treaty (1970)**

The PCT was intended to create multinational patent office services, including filing, searching and examining patent applications. The treaty makes it possible to seek patent protection for an invention simultaneously in many countries by filing an international patent application. This application may be filed by anyone who is a national or resident of a contracting state and may generally be filed with the national patent office of the contracting state or with the International Bureau of WIPO in Geneva. The applicant also indicates those contracting states in which he wishes his international application to have effect (designated states). The effect of the international application in each designated state is the same as if a national patent application had been filed with the national patent office of that state. The international application is then subjected to an international search which results in an international search report, that is, a listing of the citations of such published documents that might affect the patentability of the invention claimed in the application. The applicant may then withdraw his application (particularly where the report makes the granting of a patent unlikely). If the application is not withdrawn,

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<sup>21</sup> This is reflected in the 1967 Patents Act, the Trademarks Ordinance (New Version) 5712-1972 and the Patent and Design Ordinance - 1924.

<sup>22</sup> 1996 Update: International Legal Protection for Software, pp. 1-8, at 3-4, [www.software-protection.com](http://www.software-protection.com).

the application as well as the international search report are published by the International Bureau and communicated to each designated office. Following a waiting period of 20 months to commence the national procedure before each designated office by providing a translation of the application in the official language of that office and paying the regular fees. The applicant is given an additional 10 months if he requests an international preliminary examination report which is prepared by one of the major patent offices and which gives a preliminary and non-binding opinion regarding the patentability of the claimed invention.

There are several advantages to both the applicant and the participating countries to joining the Patent Cooperation Treaty. Firstly, the applicant has a significant period during which to reflect on the desirability of seeking protection in foreign countries and for preparing the necessary documents. The applicant is also guaranteed that if the application is in the above form, it cannot be rejected on formal grounds by any designated office during the national phase of the processing of the application. On the basis of the international search report, the applicant can reasonably evaluate the chances of the invention being patented. During the international preliminary examination the applicant has the opportunity to amend the international application.

Secondly, the search and examination work of the patent offices of designated states can be considerably reduced or virtually eliminated

as a result of the international search report and the international preliminary examination report.

Finally, since each international application is published together with an international search report, third parties are in a better position to formulate a well-founded opinion about the patentability of the claimed invention.

The PCT created a union which contains an Assembly in which every state which is a party to the Treaty has membership. Among the more important tasks of the Assembly are the amendment of the regulations issued under the Treaty, adoption of the budget of the union and the fixing of fees connected with the use of the PCT system. The Assembly decided, effective January 1, 1996, to establish a special measure to the benefit of persons who are nationals of and reside in a state whose per capita national income is below \$3,000; this benefit consists of a reduction of 75% on all fees under the Treaty.<sup>23</sup> The PCT was ratified by the Knesset and was implemented on August 10, 1995 by an amendment to the 1967 Patents Act.

#### **4. The World Intellectual Property Organization (WIPO, established 1967)**

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<sup>23</sup> Patent Cooperation Treaty (PCT) (1970), World Intellectual Property Organization, International Protection of Industrial Property, pp. 1-3, [www.wipo.org](http://www.wipo.org).

The origins of WIPO date back to 1883 when the Paris Convention for the Protection of Industrial Property was adopted and to 1886 when the Berne Convention for the Protection of Literary and Artistic Works was adopted. Both conventions provided for the establishment of an International Bureau and these two bureaus were united in 1893, functioning under various names until 1970 when they were replaced by the International Bureau of Intellectual Property by virtue of the WIPO convention.

WIPO is a Geneva-based agency of the United Nations with two primary objectives. Firstly, to promote the protection of intellectual property throughout the world through cooperation among states, and where appropriate, in collaboration with any other international organization. Secondly, it aims to ensure administrative cooperation among the intellectual property unions created by the Paris and Berne Conventions.

WIPO also: encourages the conclusion of new international treaties and the modernization of national legislation; offers technical assistance to developing countries, assembles and disseminates information; maintains services for facilitating obtaining protection of inventions, marks and industrial designs for which protection in several countries is desired and promotes other administrative cooperation among member states. Since January 1, 1996, WIPO has an agreement with the World Trade Organization (WTO). This agreement provides for cooperation between the International Bureau of WIPO and the

Secretariat of the WTO in respect of assistance to developing countries and in respect of the notification and collection of the intellectual property laws and regulations of the members of the WTO. Both Jordan and Israel were party to the convention establishing WIPO on November 15, 1996.

Regarding developing countries, WIPO is guided by the relevant objectives of international cooperation for development, with particular reference to making full use of intellectual property for encouraging domestic creative activity, for facilitating the acquisition of foreign technology and the use of literary and artistic works of foreign origin, and for organizing easier access to the scientific and technological information contained in millions of patent documents.<sup>24</sup>

#### **5. Madrid Agreement Concerning the International Registration of Marks (1891) and Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (1989)**

The Madrid Agreement provides for the international registration of both trademarks and service marks at the International Bureau of WIPO in Geneva. Registrations effected under the Agreement are international since every registration has effect in several countries, potentially, in all the contracting states (except the country of origin).

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<sup>24</sup> World Intellectual Property Organization, p. 1-2, [www.wipo.org](http://www.wipo.org).

Only those states which are party to the Paris Convention may join this Agreement. Israel and Jordan are not signatories to this agreement.

The applicant must be a national of one of the contracting states or must have residence or have a real and effective industrial or commercial establishment in one of the contracting states. The mark must first be registered in the national or regional trademark office of the country of origin and following this, he may apply for international registration.

The international registration, once effected, is published by the International Bureau and those contracting states in which the applicant seeks protection are notified. Each state may, within one year, declare that protection cannot be granted to the mark in its territory. If such a declaration is made, the procedure continues in the refusing national or regional office or before the courts of the contracting state concerned. If such a declaration is not made within the period of one year, the international registration has the effect of a national or regional registration.

There are several advantages for registering the mark internationally. First, after the mark has been registered in the contracting state which is the country of origin, the applicant need only file one application and pay fees to one office (the International Bureau) and in only one language (French), instead of filing separately in the

national or regional trademark offices of the various contracting states. Similar advantages exist when the registration must be renewed or modified.

Second, international registration is advantageous to the national or regional trademark offices because it reduces the volume of the work they would otherwise have to perform. In addition, if the International Registration Service closes its biennial accounts with a profit, the proceeds are divided among the contracting states.

The number of international registrations, including renewals, effected under the Madrid Agreement was 12,338 in 1980 and 22,699 in 1995.

The Madrid Agreement created a Union which in turn has an Assembly to which every state member of the union is a member as well. The more important tasks of the Assembly include the amendment of regulations, the adoption of the budget of the Union and the adoption and modification of the implementing regulations.

The aim of the Madrid Protocol was to introduce new features into the system established by the Madrid Agreement in order to remove the difficulties which prevent certain countries from adhering to that Agreement.



The main features of the Protocol are: (1) an application may be based not only on the registration of a mark in the national or regional office of origin but also on an application for national or regional registration filed in that office; (2) each contracting party in which the applicant seeks protection may, within 18 months instead of one year, declare that protection cannot be granted to the mark; (3) the office of each contracting party may receive higher fees than under the Madrid Agreement; (4) an international registration which is canceled because the application has been rejected or the registration was invalid may be transformed into national (or regional) applications.

In addition, the Protocol establishes links with the trademark system of the European Community. Once the EC is party to the Protocol, it will be possible for an application for international registration under the Protocol to be based on an application filed with, or a registration effected by, the Office for Harmonization in the Internal Market (Trademarks and Designs) of the EC and it will be possible to obtain the effects of an EC registration through an international registration effected under the Protocol. Finally, applications governed by the Protocol may be filed in English as well as French<sup>25</sup>.

#### **6. The Universal Copyright Convention (1971)**

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<sup>25</sup> Madrid Agreement Concerning the International Registration of Marks (1891), World Intellectual Property Organization, p.1-3, [www.wipo.org](http://www.wipo.org).

The UCC is aimed at ensuring copyright protection of literary, scientific and artistic works. Under this agreement, national treatment is granted. The UCC also provides that any member country that requires compliance with formalities (such as registration, deposit, or notice) must treat such formalities as satisfied if all published copies of a work bear the copyright symbol, the name of the copyright owner, and the year of first publication. This provision applies, however, only to works that (1) were first published outside the country requiring the observance of the formalities and (2) were not authored by one of that country's nationals<sup>26</sup>. Israel became a signatory to this convention in 1955.

#### **7. GATT-TRIPS (1994)**

GATT-TRIPS (General Agreement on Tariffs and Trade - Trade Related Aspects of Intellectual Property Rights) establish minimum universal standards on patents, copyrights, trademarks and industrial designs, among others. In general, GATT-TRIPS addresses the following: the applicability of basic GATT principles and of relevant international intellectual property agreements or conventions; the provision of adequate standards concerning the availability, scope and use of trade-related intellectual property rights; the provision of effective and appropriate means for the enforcement of trade-related intellectual property rights, taking into account differences in national

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<sup>26</sup> 1996 Update: International Legal Protection for Software, pp. 1-8, at 2-3, [www.software.protection.com](http://www.software.protection.com).

legal systems; the provision of effective and expeditious procedures for the multilateral prevention and settlement of disputes between governments; and transitional arrangements. This agreement will be further examined in the recommendations sections in chapter V.

#### **B. Applicability of International Conventions**

The plethora of extant international conventions relating to intellectual property would seem certain to proffer a means of regulating the IP relations between the Palestinian Authority and foreign nations, including Israel. In fact, however, the existing international treaties are irrelevant or superfluous in the present situation for several reasons.

Firstly, none of these international treaties applied to the West Bank and Gaza prior to Israeli occupation which began in 1967. While initially Jordan did not impose its own laws on the legal system in the West Bank, between 1952 and 1967, however, the Jordanian Parliament enacted new legislation which allowed for the unification of the Jordanian and West Bank legal systems in most spheres<sup>27</sup>. Jordan, however, became a party to international conventions on intellectual property only beginning in 1972. This situation obtained in the Gaza Strip as well, albeit for a different reason: Gaza was never incorporated

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<sup>27</sup> Richard H. Sines, et al, *Assessment of Legal and Regulatory Policies Constraining Business Activity in Gaza and the West Bank*, Management Systems International, October 1996, p.8.

into Egypt, and Egyptian laws were not applied there directly.<sup>28</sup> It is certain therefore, that at least until the Israeli occupation, no such international intellectual property conventions applied to the West Bank or the Gaza Strip.

Secondly, there is no reason to believe that treaties or conventions to which Israeli is a party were applied to the West Bank and Gaza by reason of the Israeli occupation of these areas. According to Israeli statute and precedent, international treaties are enforceable in Israeli domestic law only following specific enabling legislation by the Knesset; becoming a signatory to a particular convention does not automatically make it enforceable<sup>29</sup>.

Since there has been no Israeli enabling legislation which applied international intellectual property conventions to which Israel is a party to the West Bank and Gaza, it is impossible to view any such agreements as applying to these areas. In other words, because the Knesset views itself as competent to legislate in these areas, and since it has not done so in order to give force in these areas to treaties of the type under discussion, these treaties have therefore not been enabled, i.e. made domestically valid, in the West Bank and Gaza.

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<sup>28</sup> *Ibid.*

Thirdly, this conclusion is also correct under international law, even if we were to dispute the competence of the Israeli Knesset to pass such an enabling act regarding occupied territories<sup>30</sup>.

Under international law, too, an occupying power is empowered to legislate in the occupied areas. While this is normally accomplished by the military commander in the area, it is doubtful whether the occupier is forbidden to exercise this authority through its own legislature or some other governmental branch. This conclusion is strengthened by the fact that while the Jordanian annexation of the West Bank was not internationally recognized as valid, legislation of the Jordanian parliament is universally recognized as having force in the West Bank. Because the Israeli domestic requirement for an enabling act is known to other parties to international agreements, under the rules of customary international law<sup>31</sup>, the validity of these agreements in any are under Israeli sovereignty, control or occupation would be contingent upon such enabling legislation.

Therefore, the Israeli military regime did not bequeath to the West Bank or Gaza any international intellectual property protection.

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<sup>29</sup> The rationale for this rule stems from the lack of a requirement for parliamentary ratification of treaties in Israel. The enforcement in domestic law of a treaty approved only by the Cabinet, which has not been adopted into legislation, or ratified by the Knesset, would conflict with the supreme legislative authority of the Knesset.

<sup>30</sup> From the point of view of Israeli domestic law, there is nothing to suggest such a restriction (as the Knesset legislation annexing or applying Israeli law to occupied areas amply demonstrates).

<sup>31</sup> As reflected in the Vienna Convention on the Law of Treaties, 1969.

Finally, as explained in chapter III, the Palestinian Authority itself is not a party to any international treaties. This is a function of two primary factors, one based on the Israeli-Palestinian agreements, the other on international public law.

As noted above, the Interim Agreement forbids the Palestinian Council from conducting foreign relations. Since, under the Interim Agreement Israel remains the source of authority in the West Bank and Gaza during the interim period, this prohibition is in effect a lack of legal competence to conduct foreign relations. Indeed, this lack of competence is expressly provided in Article IX(5)(a) of the Interim Agreement.

From the perspective of international public law, the Palestinian Authority is neither a state nor an international organization, but an autonomous area deriving its authority from that of the occupying power. In principle, this alone would not necessarily prevent the PA from being party to international agreements; if the source of authority, that is, Israel, had delegated treaty-making powers to the PA, the latter would likely have been recognized as having such authority despite its non-state status<sup>32</sup>. Since, as explained, this is not the case, the PA lacks international legal competence for the purpose of becoming a signatory

to international agreements. In light of the above, any analysis of the application of international intellectual property conventions to the West Bank and Gaza must be prescriptive rather than descriptive.

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<sup>32</sup> Our hesitancy stems from the difficult question, subject to much academic debate, of whether an occupier enjoys, vis-a-vis the occupied, the full array of powers enjoyed by a state including treaty-making power. In the case of Israel and the West Bank this question is further complicated, since these areas were not recognized under international law as belonging to any state. In any case, this issue exceeds the bounds of our discussion.

## **V. Recommendations**

All intellectual property legislation is guided and informed by several general principles. The first of these is that the level of protection for inventions and creations be high enough to encourage investment, innovation, and technology transfer.<sup>33</sup> Additionally, and no less importantly, the protection provided must be clearly defined, unambiguous in scope and reasonably limited in duration. Secondly, the laws must be flexible enough to provide for the growth and development of new technologies. The rights granted should not be so exclusionary as to harm society's legitimate interest in sharing scientific, technological and creative developments and advances, or as to unduly prevent other inventors and entrepreneurs from entering the marketplace.<sup>34</sup>

Indeed, it cannot be overlooked that in the case of intellectual (as opposed to tangible) property, proprietary rights stem not from the practical, natural fact of use or possession of a protective legislative shield to the inventor. Since the main purpose of the protection granted the inventor always remains, the benefit derived by society by encouraging creative advances, it makes little sense to protect the inventor at the undue expense of society.

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<sup>33</sup> *Supra* n. 1, p. 24.



Indeed, striking the correct balance between these two principles - encouraging inventions and ensuring their enjoyment by society at large - is the central test of a sound intellectual property regime.

This balance can be achieved only through a process of legislative trial and error. The empirical effect of intellectual property statutes must be constantly assessed and reassessed by the legislature, with the assistance of input from the judiciary and relevant economic actors. Quite aside from the need to constantly seek the correct legislative balance between encouraging inventions and ensuring their ultimate benefit to society, intellectual property legislation must be flexible for another reason: to provide for the growth and development of new technologies. If the legal system does not provide such flexibility, it will become obsolete in a matter of years.

In the following recommendations, we have attempted to apply the aforementioned general guidelines to the domestic and international legal regimes prevailing in the West Bank and Gaza. Since under the Interim Agreement the PA is expected to adopt legislative standards of intellectual property protection compatible with those in the GATT-TRIPS, relevant provisions of that agreement are also examined and evaluated below. According to the Interim Agreement, the parties are encouraged to: (1) legislate standards of protection compatible with those in the GATT-TRIPS and; (2) establish a system for examining

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<sup>54</sup> *Ibid.*, p. 25.

applications for the registration of intellectual property rights which are also compatible with the GATT-TRIPS.<sup>35</sup>

In keeping with these principles, we would offer the following recommendations regarding the development of Palestinian law and changes in Israeli law as they relate to the Palestinian Autonomous regions.

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<sup>35</sup> Article 28(4)(b).

#### **A. High Level of Protection of Inventions and Creations**

Article 9 of the Israeli Military Order No. 555 (1974) Regarding Patents and Designs, which grants the government the right of purchase of a patent, should be reconsidered in light of the discussion in chapter II.

Article 24 of the Gaza Patent and Design Ordinance No. 33 (1924) and Article 25 of the Jordanian Patent and Design Ordinance No. 22 (1953), applicable in the West Bank, which deny the patent owner the right to recover damages for an infringement of a patent if the defendant can prove that he was not aware of the patent should either be repealed or be restricted to only punitive damages and should include a provision regarding exploitation only by the same party in the same course of business (see chapter II above). It should be noted however, that the GATT-TRIPS make no mention of an exception in a case where the defendant did not know of the existence of the patent.

Furthermore, article 34 of GATT-TRIPS provides an important protection which is worthy of further consideration. If the subject matter of a patent is a process for obtaining a product, the defendant may be ordered to prove that the process used to obtain an identical product is different from the patented process. Therefore, if the product obtained by the patented process is new or if there is a substantial likelihood that the identical product was made by the patented process

and the patent owner has been unable to determine, through reasonable efforts, the actual process used, members shall provide that the product was obtained through the use of the patented process. Furthermore, under these conditions, members have the right to place the burden of proof with the alleged infringer. Such protection serves as a strong deterrent to the illegal use of a patent and insures the protection necessary to encourage innovation.

Article 31 of GATT-TRIPS provides a limitation in the case in which state law permits the use of the subject matter of the patent even without the permission of the patent holder. The article goes on to include some 12 provisions which must be met before use of the subject matter of the patent may be granted to some other body. Such a provision would serve as a valuable protection against the misuse of a patent, while providing the flexibility necessary to allow for further growth and development.

Article 30 of GATT-TRIPS provides very general exceptions to the rights conferred to the patent holder. Where the relevant West Bank and Gaza laws are limited to specific exceptions (i.e. denying registration if it concerns instruments of munitions of war), article 30 is overly general and broad, providing the state vast power to limit the rights of the patent holder. This article allows for

limited exceptions to the exclusive rights conferred by a patent, provided that such exceptions do not

unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties.

We believe that this provision is overly broad and grants too much consideration to the state to determine whether or not a patent may be denied. It is recommended that any changes made to the existing West Bank and Gaza law move in the direction of limiting the exceptions which permit a state to deny a patent, rather than in the direction of the more general provisions laid out in the GATT-TRIPS.

Article 8 of the British Copyright Act of 1911, in force in the West Bank and Gaza, should be changed to provide a fair balance between the copyright owner and the innocent infringer of that copyright. Such a balance would enable the copyright owner to prohibit the continuance of the infringing activity, even when committed by an innocent infringer, and the infringer in good faith would be required to return to the copyright owner those profits which constitute unjust enrichment.

Article 10 of the Copyright Act of 1911, which limits the period during which a suit may be brought to three years from the date of the actual infringement, should be changed. The limitations period should commence only from the date on which the owner of the copyright first became aware, or should have become aware, of the infringement.

Currently there exists a great deal of illegal trademark duplication under the Palestinian Authority. Both local and foreign business people will be encouraged to do business in the Palestinian Autonomous regions only if they are assured that their products are protected<sup>36</sup>

#### **B. Flexibility of the Laws**

The definitions contained in the applicable West Bank and Gaza law on patents and designs, as well as those relating to copyrights, are too limiting. As indicated above in chapter II, these restrictive definitions are the primary deficiency of intellectual property laws in force in the Palestinian Territories.

The restriction on the registration of patents which are illegal, immoral or injurious to public order should be limited. It should be noted that while article 27(2) of the GATT-TRIPS provides for a similar limitation in order to protect public order or morality, member countries are permitted to deny a patent for inventions for these reasons,...provided that such exclusion is not made merely because the exploitation is prohibited by their law. In other words, simply because the use of an invention may be illegal is not justification enough to deny the registration of the patent. Furthermore, according to this provision a patent may be denied only if the commercial exploitation and

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<sup>36</sup> From a conversation between staff attorney Daniel Kallman and Jean-Claude Nidan, Head of Legal Assistance.

not simply the use of, such patent is injurious to public order or morality. This article provides a fair balance between the rights of the patentee and the welfare of the public.

Article 13 of the GATT-TRIPS restricts the exceptions which may be made to the exclusive rights of the copyright holder to certain special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder. Although various terms in this provision are ambiguous and left to the discretion of the particular member (i.e. normal exploitation and unreasonably prejudice), such a provision gives the judiciary the flexibility necessary to protect copyrights and thereby encourage creativity while also guaranteeing that the laws protect the society at large.

### **C. Clearly Defined Protections**

In contrast to the positive right granted to the patent holder according to article 4(1) of the relevant Gaza and West Bank law on patents, article 28 of GATT-TRIPS confers on the patent holder the right to prevent third parties from making, using, offering for sale, selling, or importing, in the case where the subject of the patent is a product. Where the subject of the patent is a process, the owner has the right to prevent third parties from using, offering for sale, selling, or importing. This provision is more in line with the nature of patent rights - that is, a

negative right which denies the rights of others to make use of the patent - than the applicable law in the West Bank and Gaza and it is recommended that this provision serve as a model for Palestinian legislation on IP rights.

Article 15 of the Jordanian and British Patent and Design Ordinances applicable in the West Bank and Gaza, which terminates a patent if the owner fails to pay the registration fee within the prescribed period should be reconsidered in light of the recommendations made in chapter II.

Jurisdiction regarding claims on all types of intellectual property rights should be transferred to the district courts. In addition to the fact that the high court may be ill-equipped to handle the types of claims brought in intellectual property cases, sending such cases to the highest level unnecessarily burdens the courts and delays the proper dispensations of justice. With this in mind, the relevant provisions of the Trade Marks Ordinance as well as the Patent and Design Ordinances should be reconsidered.

Article 7 of the Trade Marks Ordinance gives discretion to the registrar to determine under which category a particular product falls. As mentioned above in chapter II, in a society in which there is a strong judiciary, such determinations should be made by that legal body and not by the registrar or any other civil servant. In the case of the



Palestinian Authority, judicial independence has still not been achieved and until then, it may be preferable to leave such decisions to the discretion of the registrar. Furthermore, this type of classification is required for administrative but the registrar's decision on this issue should be subject to court review upon appeal.

#### **D. Procedures for Applications**

In order to establish an efficient and speedy system for the examination of applications for intellectual property, the relevant provisions of GATT-TRIPS should be considered. Although this agreement does not provide all the necessary details and procedures required for establishing just such an examination process, it lays out general guidelines which should serve as a strong basis for IP legislation under the Palestinian Authority.

In Part IV (Acquisition and Maintenance of Intellectual Property Rights and Related Inter-partes Procedures), general provisions are laid out for the registration of intellectual property rights. Members may require compliance with reasonable procedures and formalities which are to be consistent with the GATT-TRIPS (Article 62(1)). Where the particular right must be granted or registered, this must be done within a reasonable time period (Article 62(2)).

Article 29(1) of GATT-TRIPS lists conditions required for patent applications. The party to the agreement must require the applicant 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 and may require the applicant to indicate the best mode for carrying out the invention...

The party may also require the applicant to provide information on the applicants foreign applications and grants. By making such requirements the nature of the invention is clear and infringement of such a patent will be easier to avoid as well as to prove. Furthermore, information regarding foreign applications and grants will help the office to which the applicant has turned expedite matters more efficiently.

There are several provisions in the GATT-TRIPS which relate to the registration of trademarks.

Article 15(1) provides that any visually perceptible sign which is capable of distinguishing the goods or services of one party from those of another are capable of constituting a trademark. Registration of a trademark may be refused if the sign inherently lacks distinctiveness, unless those signs have acquired distinctiveness through use.

Despite the limitations in the above provision, article 15(2) further allows registration of a trademark to be denied on other grounds,

provided these grounds do not contradict the provisions of the Paris Convention.

Article 15(3) distinguishes between filing an application for registration and actual registrability. Whereas the actual use of a trademark cannot be a condition for filing an application for registration of the trademark, registrability may depend on use. Furthermore, an application cannot be denied simply because a trademark was not used before the expiry period of three years from the date of application.

A very important provision which also serves as a protection to the applicant of a registered trademark is Article 15(4) which states that the nature of the goods or services for which a trademark is requested may not serve as an obstacle to registration.

Finally, Article 15(5) provides for the publication of the trademark and a corresponding period during which petitions to cancel the trademark may be filed or the trademark opposed.

#### **E. Judicial Enforcement and Proceedings**

Part III (Enforcement of Intellectual Property Rights) of the GATT-TRIPS provides for the judicial and administrative means of protecting intellectual property rights holders. Procedures should permit effective action but should also be fair, not unnecessarily complicated or

expensive, and should not entail unreasonable time-limits or delays. There should be judicial review of final administrative decisions.

Of particular relevance to any Palestinian legislation which might be enacted is the power granted to judicial authorities according to this agreement. These authorities would have the power to order the disposal or destruction of infringing goods, and the authority to order prompt and effective provisional measures, in particular where any delay is likely to cause irreparable harm to the holder of the right or where evidence is likely to be destroyed. Significantly, the provision does not require a separate judicial system to be put into place for the enforcement of these laws, nor does it require that priority be given to intellectual property rights.

Article 41(5) states:

It is understood that this Part does not create any obligation to put in place a judicial system for the enforcement of law in general, nor does it affect the capacity of Members to enforce their law in general. Nothing in this Part creates any obligation with respect to the distribution of resources as between enforcement of intellectual property rights and the enforcement of law in general.

It must be remembered that GATT-TRIPS is an international treaty and as such, must be workable in many countries in order to enable the greatest number of them to join. Requiring a separate judicial system for

the enforcement of intellectual property rights requires vast financial and human resources. Circumstances permitting, however, we recommend the establishment of separate or specialized intellectual property courts. As in other fields of law which require deeper knowledge of one particular area (e.g. Taxes, Labor), providing separate courts for intellectual property will provide several benefits. Judges in these courts would be required to have a greater understanding of the technical issues involved with intellectual property, in order that they might adjudicate more fairly and efficiently. IP also involves unique procedural rules which require a judge to have a deeper understanding of the complex issues involved (visits to a factory to compare scientific processes). Finally, by referring IP cases to specialty courts, the workload on regular courts is lessened. Overall, such courts would ensure better enforcement of IP rights and help to create a more efficient judiciary. The United States established a federal circuit court which adjudicates solely on IP issues and England set up special patent courts several years ago. Both of these models should be further investigated for possible future use in the Palestinian autonomous regions.

#### **F. Advances in Canadian Copyright Law**

In recent years, Canadian copyright law has undergone in-depth reevaluation and some new legislation has been enacted. Technological advance, and in particular, the development of the information highway, put great pressure on the Canadian legislature to reexamine many of the

outdated laws on copyright protection. These advances in technology are relevant to all countries which hope to provide effective IP protection, particularly to copyright holders. In our particular case, changes in Canadian copyright law are particularly relevant in light of the fact that the original Canadian law dates back to the same period as the British law in force in the West Bank and Gaza and is therefore useful as a comparison.<sup>37</sup>

Several committees were established in Canada - both parliamentary and nongovernmental - to examine the problems with extant copyright legislation and to offer recommendations for its improvement. Below we examine some of these recommendations and the problems with them.

Among those areas touched upon are "use of works" which includes such items as economic rights, liability for infringement, moral rights, crown copyright, distribution rights, and fair dealing. "Administrative" issues touched upon considered enforcement issues, user access, and rights clearance. Among the other issues covered were public education on copyright, broadcasting policy and regulation<sup>38</sup>. All of these issues will eventually need to be addressed by the Palestinian Council as the society develops and greater weight is given to technological development.

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<sup>37</sup> The relevant Canadian legislation relating to copyright protection is the 1924 Copyright Act.

## 1. Fixation and Reproduction

Under Canadian law, one of the requirements for securing a copyright is "fixation". This requirement is particularly problematic in an age of digitization for several reasons:

...first, binary code is [a] universal medium that collapses the material distinctions between forms of creative works (music, text, and artwork can all be digitized and manipulated with computers); secondly, once digitized and downloaded into a computer, all works can become interactive in the sense that the user can modify them. In a very real sense, the literary matrix of copyright, based in a tangible object that effectively 'packaged' a set of ideas, has become problematic. The contours of a work fade as multimedia productions incorporate a wide range of digitized elements within a framework of interactivity that enables fundamental changes to those elements. As such, the work itself may change over time through a variety of applications and in a number of contexts.<sup>39</sup>

The 1985 Charter of Rights for Creators, the Canadian document which attempts to address the changes required to copyright law in an ever-changing

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<sup>38</sup> Gordon A. Gow, *Copyright Reform in Canada: Domestic Cultural Policy Objectives and the Challenge of Technological Convergence*, University of Calgary, December 1995, pp. 1-25, p. 18.

<sup>39</sup> *Ibid.*, p. 7.

technological era, refers to this problem. According to this Charter, the presence of a particular work in the central memory of a computer, which is lost when the power is turned off, does not suffice as "fixation". This definition is problematic because it severely limits the "range of copyright protection afforded in the digital domain."<sup>40</sup>

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<sup>40</sup> *Ibid.*, p. 16.



## **2. A "sui generis" right**

The Charter recommended that computer programs be granted a "right unto itself" distinct from other literary works.<sup>41</sup> This issue will be further addressed below in the policy approaches section.

## **3. Authorship**

The Charter addresses electronic compilations, such as databases. According to this recommendation, the copyright, for example, in URL sites in an internet search engine would belong to the creators of the collection. The problem with this approach, however, is that some URLs and other electronic compilations are compiled by an automated search engine, making it difficult to determine the copyright holder.<sup>42</sup>

## **4. Policy Approaches**

One of the Canadian research groups presented four general policy approaches for future copyright

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<sup>41</sup> *Ibid.*

reform in Canada. The first approach was to consider traditional notions of copyright as obsolete and to use the extant Copyright Act as supportive legislation which would back private contractual and technological solutions in a free market. In the second approach, the government would act primarily in a leadership role, with the responsibility on those seeking or holding copyrights to change copyright practice and reform in the technological realm. This would also include a federal lobby pushing for an international rights registry.

The third and fourth approaches involve making substantial changes to copyright legislation through an adaptation for digital media, either through the creation of a new category of works with a specific set of rights (the third approach) or by creating sui generis legislation for new media (the fourth approach).<sup>43</sup>

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<sup>43</sup> *Ibid.*, p.17.

<sup>43</sup> *Ibid.*, p. 20.

In contrast to the Canadian model, where the second approach is recommended, we believe that some combination of the last two approaches should be considered. The first two approaches, which depend largely on the initiative of copyright seekers and holders, is inappropriate for a developing society such as the Palestinian one. In a society where the ruling elite has an almost monopolistic control over all developments, and where there is no history or previous experience with lobbying or any other type of democratic involvement in the machinations of government, leaving legislative change in the hands of the people ultimately means that advances in copyright protection will be at the expense of the copyright holder or seeker, and not to his advantage. The third and fourth approaches provide an opportunity to make real changes in the relevant areas, without leaving the weight of this task in the hands of inexperienced and unempowered individuals.

It has been further suggested by some experts in the area of intellectual property rights that the entire gamut of West Bank and Gaza law in this field be

reevaluated and overhauled. In addition to using the Canadian revisions, a sample of which has been provided above, vast changes have taken place in the United States and in some European countries as well. In Israel as well, the entire IP legislation is currently being revised and committees are working to draft new Israeli laws for patents, registered designs, copyright, trademarks and semiconductors. A similar approach might be considered for the Palestinian Authority if it is to provide the tools necessary to keep up with the vast changes and developments taking place throughout the world.

**Appendix A**  
**(up to and including Article 38)**

**Chapter 105**  
**Patents and Designs**

An ordinance to provide for the grant of new patents, the  
registration of patents and designs generally and the  
requirements of international  
conventions relating to industrial property.

[1<sup>st</sup> January, 1925]

Short title:

This Ordinance may be cited as the Patents and Designs  
Ordinance.

**Part I. Preliminary**

Interpretation:

In this Ordinance, unless the context otherwise requires  
*article* means, as respects designs, any article of manufacture  
and any substance, artificial or natural, or partly  
artificial and partly natural;

*copyright* means the exclusive right to apply a design to any  
article in any class in which the design is registered;

*court* means the court having jurisdiction in the matter as prescribed by the provisions of this Ordinance or, where no court is prescribed, the Supreme court sitting as a court of Appeal;

*design* means only the features of shape, configuration, pattern or ornament applied to any article by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to, and are judged solely by the eye, but does not include any mode or principle of construction or anything which is in substance a mere mechanical device.

*district court* means the district court or district courts appointed by order of the High Commissioner to exercise jurisdiction under this Ordinance;

*His Majesty dominions* includes the British Protectorates and Protected states and any territory in respect of which a mandate on behalf of the League of Nations has been accepted by his majesty.

*invention* means a new product or commercial commodity or the application in some new manner for any purpose

of industry or manufacture of any means already discovered, known or used;

*inventor and applicant* includes, subject to the provisions of this Ordinance, the legal representative of a deceased inventor or applicant;

*legal representative* means the executor of a will or administrator appointed by the court or, if there is no executor or administrator, the person or persons who, under the law of succession applicable, are liable for the payment of the debts of the deceased;

*patent* means letters patent for an invention;

*patentee* means the person at the time being entered on the register as the grantee or proprietor of the patent;

*patent agent* means a person, firm or company carrying on for gain the business of applying for or obtaining patents in Palestine or elsewhere;

*proprietor of a new or original design,*

- (a) where the author of the design for good consideration executes the work of some other person, means the person for whom the design is so executed; (b) where any person acquires the design or the right to apply the design to any article, either exclusively for any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired;
- (c ) in any other case, means the author of the design; and, where the property in , or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person.

Registry of patents and designs:

- 3.(1) There shall be a register of patents and a register of designs under this Ordinance which shall be kept at the Law Courts, Jerusalem, or at such other place as may be from time to time appointed by the High Commissioner by order.
- (2) The register of patents shall contain the names and addresses of grantees of patents and of persons registered as patentees in pursuance of the provisions of section 25 and section 54, and shall also contain notifications of assignment, licenses,



amendments and revocations of patents and such other matters as may be prescribed.

- (3) The register of designs shall contain the names and addresses of proprietors of registered designs, notifications of assignment, licenses, cancellations of registration of designs and such other matters as may be prescribed.
- (4) there shall be a registrar of patents and designs (in this Ordinance called the registrar) appointed by the High Commissioner, who shall be assisted by such officers and clerks as the registrar, with the sanction of the High Commissioner, may from time to time determine.
- (5) the register of patents and the register of designs shall, in the absence of proof to the contrary, be evidence of any matters by this Ordinance directed or authorised to be entered therein.

## **Part II Patents**

### *General Provisions*

*Inventor to be entitled to grant of patent:*

4. (1) The true and first inventor of every new invention, subject in all respects to the conditions and provisions of this Ordinance, is entitled to the grant of a patent conferring the exclusive right to use,

exploit make, manufacture, produce, supply and sell the said invention or to grant licenses therefor.

- (2) All grants of patents made under this Ordinance shall be made at the risk of the grantee and without guarantee or responsibility on the part of the Government either as to the novelty or utility or merits of the invention or as to its conformity with the specification.

Application for patents:

5. (1) An application for a patent may be made by such true and first inventor, whether alone or jointly with any other person or persons, and shall be made in the prescribed form to the registrar.
- (2) The application shall contain a sworn declaration to the effect that the applicant is in possession of an invention whereof he or, in the case of a joint application, one at least of the applicants, claims to be the true and first inventor for which he desires to obtain a patent and shall be accompanied by a specification.

Specification:

6. (1) The specification shall particularly describe the nature of the invention and the manner in which it is to be

performed and shall commence with a title and end with a distinct statement of the invention claimed.

- (2) The registrar may require suitable drawings or, in the case of a chemical invention, typical samples and specimens, to be supplied with the specification or any time before acceptance of the specification and any drawings supplied shall be deemed to form part of the specification.

Provisional Protection:

7. (1) Immediately upon the filing of the application and specification, the registrar shall ascertain whether they are in the prescribed form and shall, if he be so satisfied and upon payment of any fees which may be prescribed, give to the applicant a written acknowledgment of the filing.
- (2) Where an acknowledgment of the filing of an application has been given, the invention may, during the period between the date of the application and the date of sealing such patent, be used and published without prejudice to the patent to be granted for the invention and such protection shall be known as provisional protection.

Advertisement of acceptance:

10. (1) where the registrar accept a specification, he shall notify his acceptance to the applicant.
- (2) On the acceptance of the specification, either by the registrar or on appeal from his decision in accordance with section 51, the registrar shall advertise the acceptance, and the application and specifications, with the drawings, if any, shall be open to public inspection.
- (3) After the acceptance of the specifications and until the sealing of a patent in respect thereof or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the specification:

Provided that an applicant shall not be entitled to institute any proceedings for infringement until a patent for the invention has been granted to him.

Opposition to grant of patent:

- 11.(1) Any person may, at any time within two months from the date of the advertisement of the acceptance of the specification, give notice to the registrar of opposition to the grant of the patent on any of the following grounds

- a. that the applicant obtained the invention from him or from a person of whom he is the legal representative;
- b. that the invention has been claimed in any specification for a Palestinian patent which is or will be, of prior date to the patent, the grant of which is opposed;
- c. (No. 42 of 1919) that a patent in respect of the invention claimed has already been registered by the person making the opposition under the Public Notice No. 136 of the 30<sup>th</sup> September, 1919;
- d. that the invention has been made available to the public by the publication in any document published in Palestine prior to the application;
- e. that a person making opposition is the proprietor of an Ottoman patent in respect of the invention claimed which is capable of registration in accordance with the provisions of section 54, and that an application for such registration has been made;
- f. that the nature of the invention of the manner in which it is to be performed is not sufficiently or clearly described and ascertained in the specification;
- g. that, in the case of an application under section 52, a specification describes or claims an invention which has been made available to the public in the interval between the lodging of the application in a foreign state and the lodging of the application in Palestine.

(2) Where notice of opposition is given, the registrar shall communicate the notice to the applicant and shall, on the expiration of the period of two months and after hearing the applicant and opponent if desirous of being heard, decide on the case.

Grant and seal of patent:

12. (1) If there is no opposition or, in the case of opposition, if the determination is in favor of the grant of the patent, the patent, shall, on payment of the prescribed fee, be granted to the applicant or, in the case of joint application, to the applicants jointly, and the registrar shall cause the patent to be sealed with the seal of the registry of patents.

(2) The patent shall be sealed as soon as may be but not after the expiration of eighteen months from the date of application:

Provided that, where the sealing is delayed by appeal or opposition, the patent may be sealed at such time as the district court or the registrar, as the case may be, may direct.

(3) Where an applicant has died before the sealing of the patent and the patent is granted to his legal representative, the patent may be sealed at any time

within twelve months after the date of the applicants death.

- (4) Where for any reason the patent cannot be sealed within the period allowed by this section, the period may, on payment of such fee as may be prescribed and upon compliance with the prescribed conditions, be extended.

Date of patent:

13. Except as otherwise expressly provided by this Ordinance, a patent shall be dated and sealed as of the date of the application:

Provided that no proceedings shall be taken in respect of an infringement committed before the acceptance of the specification.

Effect, extent and form of patent:

14. (1) A patent sealed with the seal of the registry of patents shall have effect throughout all parts of Palestine:

Provided that a patentee may assign his patent for any place in or part of Palestine as effectually as if the patent were originally granted to extend to that place or part only.

(2) Every patent shall be in a prescribed form and shall be granted for more than one invention only but the specification may contain more than one claim and it shall not be competent for any person in an action or proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

*Term of patent:*

15. (1) the term limited in every patent for the duration thereof shall, save as otherwise expressly provided by this Ordinance, be sixteen years from its date.

(2) A patent shall cease if the patentee fails to pay the prescribed fee within the prescribed time:

Provided that the registrar, upon application of the patentee, shall, upon receipt of such additional fee as may be prescribed, enlarge the time to such an extent as may be applied for but not exceeding three months.

(3) If any proceedings are taken in respect of an infringement of the patent committed after a failure to pay a fee within the prescribed time and before any enlargement thereof, the court before which the proceedings are proposed to be taken may, if it thinks fit, refuse to award any damages in respect of such infringement.



Patents of Addition:

16. (1) Where a patent for an invention has been applied for or granted and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement in or modification of, the invention, he may, if he thinks fit, in his application for the further patent request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired.
- (2) Where an application containing such a request is made, a patent (in this Ordinance referred to as a patent of addition) may be granted for such term as aforesaid.
- (3) A patent of addition shall remain in force so long as the patent for the original invention remains in force but no longer and, in respect of a patent of addition, no fees shall be payable for renewal:

Provided that, if the patent for the original invention is revoked, then the patent of addition shall, if the court or registrar so orders, become an independent patent, and the fees payable and the dates when they become payable shall be determined by its date, but its duration shall not exceed the unexpired term of the patent for the original invention.

- (4) The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject for a patent of addition, and the validity of the patent shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.

Restoration of lapsed patents:

17. (1) Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may apply to the registrar in the prescribed manner for an order for the restoration of the patent.
- (2) Every such application shall contain a statement of the circumstances which have led to the omission of the payment of the prescribed fee.
- (3) If it appears from such statement that the omission was unintentional and that no undue delay has occurred in the making of the application, the registrar shall advertise the application in the prescribed manner and, within such time as may be prescribed, any person may give notice of opposition at the registry of patents.
- (4) Where such notice is given, the registrar shall notify the applicant thereof.

- (5) After the expiration of the prescribed period, the registrar shall hear the case and issue an order either restoring the patent or dismissing the application.

Amendments of specification:

- (1) An applicant or a patentee may, at any time by request in writing left at the registry of patents, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction or explanation, stating the nature of, and the reason for, the proposed amendment.
- (2) The request and the nature of the proposed amendment shall be advertised in the prescribed manner and, at any time within one month from its first advertisement, any person may give notice at the registry of patent of opposition to such amendment.
- (3) Where such notice is given, the registrar shall give notice of the opposition to the person making the request and shall hear and decide the case.
- (4) Where no notice of opposition is given or the person so given notice of opposition does not appear, the registrar shall determine whether, and subject to what conditions, if any, the amendment ought to be allowed.
- (5) No amendment shall be allowed which would make specification, as amended, claim an invention

substantially larger than, or substantially different form, the invention claimed by the specification as it stood before amendment.

- (6) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed except in case of fraud, and the amendment shall be advertised in the prescribed manner and shall be deemed to form part of the specification:

Provided that the court shall be entitled, in constructing the specification as amended, to refer to the specification as accepted and published.

- (7) This section shall not apply when and so long as any action for infringement or proceeding before the court for the revocation of the patent is pending.

Amendments of specification by the court:

19. In any action for infringement of a patent or proceeding before a court for the revocation of a patent, the court may, by order, allow the patentee to amend his specification in such manner and subject to such terms as to costs, advertisement or otherwise, as the court may think fit:

Provided that no amendment shall be so allowed that would make the specification, as amended, claim an invention substantially different from the invention claimed by the specification as it stood before the

amendment and, where an application for such an order is made, notice of the application shall be given to the registrar, and the registrar shall have the right to appear and be heard and shall appear if so directed by the court.

Restriction on recovery of damages:

20. Where an amendment of a specification has been allowed under this ordinance, no damages shall be given in any action in respect of the use of the invention before the date of the decision allowing the amendment, unless the patentee established to the satisfaction of the court that his original claim was framed in good faith and with reasonable skill and knowledge.

Exhibition of invention not to prejudice right to a patent:

20A. The exhibition of an invention at an industrial or international exhibition, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by

any person elsewhere, without the privy or consent of the inventor, or the reading of a paper by an inventor before a learned society or the publication of the paper in the society transactions, shall not prejudice the right of the inventor to apply for and obtain a patent in respect of the invention or the validity of any patent granted on the application provided that --

- a. the exhibitor, before exhibiting the invention, or the person reading such paper or permitting such publication, gives the registrar the prescribed notice of his intention to do so; and
- b. the application for a patent is made before or within six months from the date of the opening of the exhibition, or the reading or publication of such paper.

Compulsory licenses and revocation:

21. (1) Any person interested may present a petition to the registrar alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied and praying for the grant of a compulsory license or, in the alternative, for the revocation of the patent.
- (2) The registrar shall consider the petition and, if the parties do not come to an arrangement between themselves,

the registrar, if satisfied that a reasonable case has been made out, shall refer the petition to the district court.

- (3) Where any such petition is referred by the registrar to the court and it is proved to the satisfaction of the court that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by the court to grant licenses on such terms as the court may think just or, if the court is of opinion that the reasonable requirements of the public will not be satisfied by the grant of licenses, the patent may be revoked by order of the court:

Provided that an order of the court under this section shall not be made before the expiration date of the grant of the patent, nor if the patentee gives satisfactory reasons for his default.

- (4) On the hearing of any petition under the section, the patentee and any person claiming an interest in the patent as exclusive licensee or otherwise shall be made parties to the proceedings, and the Attorney General shall be entitled to be heard.
- (5) For the purposes of the section, the reasonable requirements of the public shall not be deemed to have been satisfied --

- a. if, by reason of the default of the patentee to manufacture to an adequate extent and supply on reasonable terms a patented article, any trade or industry or the establishment of any new trade or industry in Palestine is unfairly prejudiced or the demand for the patented article or the article produced by the patented process is not reasonably met;
  - b. if any trade or industry in Palestine is unfairly prejudiced by conditions attached by the patentee to the purchase or use of a patented article or to the working of the patented process.
- (6) An order of the court directing the grant of a license under this section shall operate as if it were embodied in a duly executed license made between the parties to the proceedings.

Revocation of patents:

22. (1) Revocation of a patent may be obtained on petition to the district court.
- (2) A petition for revocation of a patent may be presented
- a. by the Attorney General, or
  - b. by any person, alleging --
    - (i) that the patent was obtained in fraud of the rights or the rights of any



person under or through whom he  
claims; or

(ii) that the petitioner or any person under or through whom he claims was the true inventor of a

(iii) that the petitioner or any person under or through  
whom he claims an interest in any trade, business or  
manufacture had publicly manufactured, used or sold  
within Palestine, before the date of the patent, anything  
claimed by the patentee as his invention.

#### *Legal Proceedings*

Hearing with Assessor:

23. (1) In any action or proceedings for infringement or revocation of a patent, the court may, if it thinks fit, call in the aid of an assessor specially qualified.

(2) The remuneration, if any, to be paid to an assessor under this section shall be determined by the court and paid in the manner prescribed.

Order for Injunction:

24. In an action for infringement of a patent, the plaintiff shall be entitled to relief by way of injunction and damages:

Provided that a patentee shall not be entitled to recover damages in respect of any infringement of a patent granted after the date of the commencement of this Ordinance from any defendant who proves that,

at the date of the infringement, he was not aware of the existence of the patent.

*Miscellaneous*

*Provisions as to anticipation:*

26. A patent shall not be held to be invalid by reason only of the invention in respect of which the patent was granted, or any part thereof, having been published prior to the date of the patent, if the patentee proves to the satisfaction of the court that the publication was made without his knowledge and consent and that the matter published was derived or obtained from him and if he learnt of the publication before the date of his application for the patent, that he applied for, and obtained protection for his invention with all reasonable diligence after learning of the publication.

*Patent on application of legal representative of deceased inventor:*

27. (1) If a person claiming to be the inventor of an invention dies without making an application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

(2) Every such application shall contain a declaration by the legal representative that he believes the deceased person to have been the true and first inventor of the invention.

Loss or destruction patent:

28. If a patent is lost or destroyed or its non-production is accounted for to the satisfaction of the registrar, the registrar may at any time seal a duplicate thereof.

Publication of application and specification in the *Gazette*:

29. The registrar may at any time publish, in the *Gazette* or in any other journal prescribed, a description and particulars of any patented invention and every such advertisement shall be made at the cost of the patentee.

### **Part III - Designs**

Application for registration of designs:

30 (1) The registrar may, on the application made in the prescribed form and manner of any person claiming to be the proprietor of any new or original design not previously published in Palestine, register the design under this Part.

(2) The same design may be registered in more than one class and, in case of doubt as to the class in which a design ought to be registered, the registrar may decide the question.

(3) The registrar may, if he thinks fit, refuse to register any design presented to him for registration and shall refuse to register a design of

which, in his opinion, the use will be contrary to law, morality or public policy.

(4) An application which owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within the prescribed time shall be deemed to be abandoned.

(5) A design, when registered, shall be registered as of the date of the application for registration.

Registration of designs in new classes:

31. Where a design has been registered in one or more class or classes of goods the application of the proprietor of the design to register it in some one or more other class or classes shall not be refused nor shall the registration thereof be invalidated --

- a. on the ground of the design not being a new or original design by reason only that it was
- b. on the ground of the design having been previously published in Palestine by reason only that it has been applied to goods of any class in which it was previously registered:

Provided that such subsequent registration shall not extend the period of copyright in the design beyond that arising from the previous registration.

Certificate of registration:

32. (1) The registrar shall grant a certificate of registration to the proprietor of the design when registered.

(2) The registrar may, in case of loss of the original certificate or in any other case in which he deems it expedient, furnish one or more copies of the certificate.

Copyright of registration:

33. (1) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Ordinance have copyright in the design during five years from the date of registration.

(2) If within the prescribed time before the expiration of the said five years application for extension of the period of copyright is made to the registrar in the prescribed manner, the registrar shall, on payment of the prescribed fee, extend the period of copyright for a second period of five years from the expiration of the original period of five years.

(3) If within the prescribed time before the expiration of such second period of five years application for the extension of the period of copyright is made to the registrar in the prescribed manner, the registrar may, subject to any rules under this Ordinance and on payment of the prescribed fee, extend the period of copyright for a third period of five years from the expiration of the second period of five years.

Requirements before delivery on sale:

34. Before delivery on sale of any articles to which a registered design has been applied, the proprietor shall, --

- a. if exact representations or specimens were not furnished on the application for registration and thereupon the copyright in the design shall cease, and
- b. cause each such article to be marked with the prescribed mark or with the prescribed words or figures denoting that the design is registered, and, if he fails to do so, the proprietor shall not be entitled to recover any pecuniary damages from the person guilty thereof knew or had reason to believe that the person

*Inspection of registered designs:*

35. (1) During the existence of copyright in a design or such shorter period, not being less than two years from the registration of the design as may be prescribed, the design shall not be open to inspection except by the proprietor or a person authorised in writing by him or a person authorised by the registrar or by the court:

Provided that, where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered.

(2) After the expiration of the copyright in a design or such shorter period as aforesaid, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.

(3) Different periods may be prescribed under this section for different classes of designs.

*Cancellation of registration of design:*

36. (1) At any time after the registration of a design, any person interested may apply to the registrar for the cancellation of the registration of the design on either of the following grounds --

a. that the design has been published in Palestine prior to the date of registration;

b. that the design is applied by manufacture to any article in a foreign country and is not so applied by any manufacture in Palestine to such an extent as is reasonable in the circumstances of the case.

(2) If the registrar is of opinion that such application is premature, he may adjourn the application: he may also, in lieu of cancellation, order the grant of a compulsory license or may at any time refer the application to the district court for trial.

Piracy of registered design:

37. (1) During the existence of copyright in any design it shall not be lawful for any person,--

a. for the purposes of sale, to apply to any article in any class of goods in which the design is registered the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or

b. knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article without the consent of the registered proprietor, to publish or to expose for sale that article.

(2) If any person acts in contravention of this section, he is liable for every contravention to pay to the registered proprietor of the design a sum not exceeding fifty pounds as liquidated damages or, if the proprietor elects to bring an action for the recovery of damages for such contravention and for an injunction against the repetition thereof, he is liable to pay such damages as may be awarded and to be restrained by injunction accordingly:

Provided that the total sum recoverable as liquidated damages in respect of any one design shall not exceed one hundred pounds.

Registration of designs registered in the United Kingdom (*No. 13 of 1930*):

38. (1) Any person, being the registered proprietor of a design registered in the United Kingdom under the Patents and Designs Acts, 1907 and 1919 or any Act amending or substituted for these Acts, or any person deriving his right from such design registered in Palestine: where any partial assignment or transmission has been made all proper parties shall be joined in the application for registration.

(2) (*No. 9 of 1933*) An application for registration of a design under this section shall be made to the registrar and accompanied by two representations of the design and a certificate of the Comptroller General of the United Kingdom patent Office, giving full particulars of the registration of the design in the United Kingdom and stating the date at which such design became, or will normally become, open to public inspection:

(3) Upon such application being lodged together with the documents mentioned in subsection (2), the registrar shall issue a certificate of registration.

(4) Such certificate of registration shall confer on the applicant privileges and rights subject to all conditions established by the law of Palestine as though the certificate of registration in the United Kingdom had been issued with an extension to Palestine.

(5) Privileges and rights so granted shall date from the date of registration in the United Kingdom and shall continue in force only so long as registration in the United Kingdom remains in force:



Provided that not action for infringement of copyright in the design shall be entertained in respect of any use of the design prior to the date of issue of the certificate of registration in Palestine.

(6) (*No. 9 of 1933*) The court shall have power, upon the application of any person who alleges that his interests have been prejudicially affected by the issue of a certificate of registration, to declare that the exclusive privileges and rights conferred by such certificate have not been acquired on any of the grounds upon which the United Kingdom registration might be canceled under the law for the time being in force in the United Kingdom: such grounds shall be deemed to include the publication of the design in Palestine prior to the date of registration of the design in the United Kingdom, but not to include the publication of the design in Palestine by some person after the date of the registration of the design in the United Kingdom and prior to the date of the issue of the certificate of registration under subsection (3).

(7) All extensions of the period of copyright in the United Kingdom in a design registered under this section shall be notified to the Registrar who shall, on sufficient evidence thereof and on payment of the prescribed fee, enter them in the register in the prescribed manner.

**APPENDIX B**

(up to and including Article 34)

BRITISH COPYRIGHT ACT, 1911.

1 & 2 Geo. 5, c. 46.

AN ACT TO AMEND AND CONSOLIDATE THE LAW RELATING TO  
COPYRIGHT.

[16<sup>th</sup> December, 1911.]

BE it enacted by the Kings most Excellent Majesty, by and with the  
advice and consent of Lords Spiritual and Temporal, and Commons, in  
this present Parliament assembled, and by the authority of the same, as  
follows:

PART I—IMPERIAL COPYRIGHT.

*Rights.*

Copyright.

**1.** (1) Subject to the provisions of this Act, copyright shall subsist  
throughout the parts of His Majesty dominions to which this Act  
extends for the term hereinafter mentioned in every original literary  
dramatic musical and artistic work, if

a. in the case of a published work, the work was first published  
b. in the case of an unpublished work, the author was at the date  
but in no other works, except so far as the protection conferred by a this  
Act is extended by Orders in Council thereunder relating to self-

within such parts of His Majesty's  
of the making of the work

governing dominions to which this Act does not extend and to foreign countries.

(2

produce or reproduce the work or any substantial part thereof in any material form whatsoever, to perform, or in the case of a lecture to deliver, the work or any substantial part thereof in public; if the work is unpublished, to publish the work or any substantial part thereof; and shall include the sole right,--

a. to produce, reproduce perform, or publish any translation of the work;

b. in the case of a dramatic work, to convert it into a novel or other non-dramatic work;

c. in the case of a novel or other non-dramatic work, or of an artistic work, to convert it into a dramatic work, by way of performance in public or otherwise;

d. in the case of a literary, dramatic, or musical work, to make any record, perforated roll, cinematograph film, or other contrivance by means of which the work may be mechanically performed or delivered,

and to authorise any such acts as foresaid.

(3) For the purposes of this Act, publication, in relation to any work, means the issue of copies of the work to the public, and does not include the performance in public of a dramatic or musical work, the delivery in public of a lecture, the exhibition in public of an artistic work, or the construction of an architectural work of art, but, for the purposes of this provision, the issue of photographs and engravings of works of

sculpture and architectural works of art shall not be deemed to be publications of such works.

infringement

2. (1) Copyright in a work shall be deemed to be infringed by any person who, without the consent of the owner of the copyright, does anything the sole right to which is by this Act conferred on the owner of the copyright:

Provided that the following acts shall not constitute an infringement of copyright:--

- (i) Any fair dealing with any work for the purposes of private study, research, criticism, review
- (ii) Where the author of an artistic work is not the owner of the copyright therein, the use by that work :
- (iii) The making or publishing of paintings, drawings, engravings, or photographs of a work (which are not in the nature of architectural drawings or plans) of any architectural work of art
- (iv) the publication in a collection, mainly composed of non-copyright matter, *bona fide* intended for the use of schools, and so described in the title and in any advertisements issued by the publisher, of short passages from published literary works not themselves published for the use of schools in which copyright subsists :

Provided that not more than two of such passages from works by the same author are published by the same publisher within five years, and that the source from which such passages are taken is acknowledged :

- (v) The publication in a newspaper of a report of a lecture delivered in public, unless the report is prohibited by conspicuous written or printed notice affixed before and maintained during the lecture at or about the main entrance of the building in which the lecture is given, and, except whilst the building is being used for public worship, in a position near the lecturer, but nothing in this paragraph shall affect the provisions in paragraph (i) as to newspaper summaries :

(vi) The reading or recitation in public by one person of any reasonable extract from any published work.

(2) Copyright in a work shall also be deemed to be infringed by any person who

- a. sells or lets for hire, or by way of trade or offers for sale or hire; or
- b. distributes either for the purposes of trade or to such an extent as to affect prejudicially the owner of the copyright; or
- c. by way of trade exhibits in public; or

which this Act extends,

any work which to his knowledge infringes copyright or would infringe copyright if it had been made within the part of His Majesty dominions in or into which the sale or hiring, exposure, offering for sale or hire, distribution, exhibition, or importation took place.

(3) Copyright in a work shall also be deemed to be infringed by any person who for his private profit permits a theatre or other place of entertainment to be used for the performance in public of the work without the consent of the owner of the copyright, unless he was not aware, and had no reasonable ground for suspecting, that the performance would be an infringement of copyright.

*Term of Copyright*

**3.** The term for which copyright shall subsist shall, except as otherwise expressly provided by this Act, be the life of the author and a period of fifty years after his death :

Provided that at any time after the expiration of twenty five years, or in the case of a work in which copyright subsists at the passing of this Act thirty years, from the death of the author of a published work, copyright in the work shall not be deemed to be infringed by the reproduction of the work



for sale if the person reproducing the work proves that he has given the prescribed notice in writing of his intention to reproduce the work, and that he has paid in the prescribed manner to, or for the benefit of, the owner of the copyright royalties in respect of all copies of the work sold by him circulated at the rate of ten per cent on the price at which he publishes the work; and, for the purposes of the provision, the Board of Trade may make regulations prescribing the mode in which notices are to be given, and the particulars to be given in such notices, and the mode, time, and frequency of the payment of royalties, including (if they think fit) regulations requiring payment in advance or otherwise securing the payment of royalties

*Compulsory*

**4.** If at any time after the death of a literary, dramatic, or musical work which has been licenses published or performed in public a complaint is made to the Judicial Committee of the Privy Council that the owner of the copyright in the work has refused to republish or to allow the republication of the work or has refused to allow the performance in public of the work, and that by reason of such refusal the work is withheld from the public, the owner of the copyright may be ordered to grant a licence to reproduce the work or perform the work in public, as the case may be, on such terms and subject to such conditions as the Judicial Committee may think fit.

Ownership of copyright, &c:

5. (1) Subject to the provisions of this Act, the author of a work shall be the first owner of the copyright therein :

Provided that -

(a) where, in the case of an engraving, photograph, or portrait, the plate or other original was ordered by some other person and was made for valuable consideration in pursuance of that order, then, in the absence of any agreement to the contrary, the person by whom such plate or other original was ordered shall be the first owner of the copyright; and

(b) where the author was in the employment of some other person under a contract of service or apprenticeship and the work was made in the course of his employment by that person, the person by whom the author was employed shall, in the absence of any agreement to the contrary, be the first owner of the copyright, but where the work is an article or other contribution to a newspaper, magazine, or similar periodical, there shall, in the absence of any agreement to the contrary, be deemed to be reserved to the author a right to restrain the publication of the work, otherwise than as part of a newspaper, magazine, or similar periodical.

(2) The owner of the copyright in any work may assign the right, either wholly or partially, and either generally or subject to limitations to the United Kingdom or any self governing dominion or other part of His

term of the copyright of for any part thereof, and may grant any interest

in the right by licence, but no such assignment or grant shall be made valid unless it is in writing signed by the owner of the right in respect of which the assignment or grant is made, or by his duly authorized agent :

Provided that, where the author of a work is the first owner of the copyright therein, no assignment of the copyright, and no grant of any interest therein, made by him (otherwise than by will) after the passing of this Act, shall be operative to vest in the assignee or grantee any rights with respect to the copyright in the work beyond the expiration of twenty five years from the death of the author, and the reversionary interest in the copyright expectant on the termination of that period shall, on the death of the author, notwithstanding any agreement to the contrary, devolve on his legal personal representatives as part of his estate, and any agreement entered into by him as to the disposition of such reversionary interest shall be null and void, but nothing in this proviso shall be construed as applying to the

assignment of the copyright in a collective work or a licence to publish a work or part of a work as part of a collective work.

(3) where, under any partial assignment of copyright, the assignee becomes entitled to any right comprised in copyright, the assignee as respects the right so assigned, and the assignor as respects the rights not assigned, shall be treated for the purposes of this Act as the owner of the copyright, and the provisions of this Act shall effect accordingly.

#### *Civil Remedies.*

Civil remedies for infringement of copyright:

6. (1) Where copyright in any work has been infringed, the owner of the copyright shall, except as otherwise provided by this Act, be entitled to all such remedies by way of injunction or interdict, damages, accounts, and otherwise, as are or may be conferred by law for the infringement of a right.

(2) The costs of all parties in a any proceeding in respect of the infringement of copyright shall be in the absolute discretion of the court.

(3) In any action for infringement of copyright in any work, the work shall be presumed to be a work in which copyright subsists and the plaintiff shall be presumed to be the owner of the copyright, unless the defendant puts in issue the existence of the copyright, or as the case may be, the title of the plaintiff, and where any such question is in issue, then

- a. if a name is purporting to be that of the author of the work is printed or otherwise indicated thereon in the usual manner, the person whose name is so printed or indicated shall, unless the contrary is proved, be presumed to be the author of the work;
- b. if no name is so printed or indicated, or if the name so printed

he is commonly known, and a name purporting to be that of the publisher or proprietor of the work is printed or otherwise indicated thereon in the usual manner the person whose name is so printed or indicated shall, unless the contrary is proved, be presumed to be the owner of the copyright in the work for the purposes of proceedings in respect of the infringement of copyright therein.

Rights of owner against persons possessing or dealing with infringing copies, & c:

7. All infringing copies of any work in which copyright subsists, or, of any substantial part thereof, and all plates used or intended to be used for the production of such infringing copies, shall be deemed to be the property of the owner of the copyright, who accordingly may take proceedings for the recovery of the possession thereof or in respect of the conversion thereof.

Exemption of innocent infringer from liability to pay damages & c.

8. Where proceedings are taken in respect of the infringement of the copyright in any work and the defendant in his defence alleges that he was not aware of the existence of the copyright in the work, the plaintiff

shall not be entitled to any remedy other than an injunction or interdict in respect of the infringement if the defendant proves that at the date of the infringement he was not aware and had no reasonable ground for suspecting that copyright subsisted in the work.

Restriction on remedies in the case of architecture:

9. (1) Where the construction of a building or other structure which infringes or which, if completed, would infringe the copyright in some other work has been commenced, the owner of the copyright shall not be entitled to obtain an injunction or interdict to restrain the construction of such building or structure or to order its demolition.

(2) Such of the other provisions of this Act as provide that an infringing copy of a work shall be deemed to be the property of the owner of the copyright, or as impose summary penalties, shall not apply in any case to which this section applies.

Limitation of actions:

10. An action in respect of infringement of copyright shall not be commenced after the expiration of three years next after the infringement.

#### ***Summary Remedies***

Penalties for dealing with infringing copies, &c.

11. (1) If any person knowingly --

(a) makes for sale or hire any infringing copy of a work in which copyright subsists; or

(b) sells or lets for hire, or by way of trade exposes or offers for sale or hire any infringing copy of any such work; or

(c) distributes infringing copies of any such work either for the purposes of trade or to such an extent as to affect prejudicially the owner of the copyright; or

(d) by way of trade exhibits in public any infringing copy of any such work; or

(e) imports for sale or hire into the United Kingdom any infringing copy of any such work:

he shall be guilty of an offence under this Act and be liable on summary conviction to a fine not exceeding forty shillings for every copy dealt with in contravention of this section, but not exceeding fifty pounds in respect of the same transaction; or, in the case of a second or subsequent offence, either to such fine or to imprisonment with or without hard labour for a term not exceeding two months.

(2) If any person knowingly makes or has in his possession any plate for the purpose of making infringing copies of any work in which copyright subsists, or knowingly and for his private profit causes any such work to be performed in public without the consent of the owner of the copyright, he shall be guilty of an offence under this Act, and be liable on summary



conviction to a fine not exceeding fifty pounds, or, in the case of a second or subsequent offence, either to such fine or to imprisonment with or without hard labour for a term not exceeding two months.

(3) The court before which any such proceedings are taken may, whether the alleged offender is convicted or not, order that all copies of the work or all plates in the possession of the alleged offender, which appear to it to be infringing copies or plates for the purpose of making infringing copies, be destroyed or delivered up to the owner of the copyright or otherwise dealt with as the court may think fit.

(4) Nothing in this section shall, as respects musical works affect the provisions of the Musical (Summary Proceedings) Copyright Act, 1906.

Appeals to quarter sessions:

12. Any person aggrieved by a summary conviction of an offence under the foregoing provisions of this Act may in England and Ireland appeal to a court of quarter sessions and in Scotland under and in terms of the summary Jurisdiction (Scotland) Acts.

Extent of provisions as to summary remedies:

13. The provisions of this Act with respect to summary remedies shall extend only to the United Kingdom.

#### *Importation of Copies*

Importation of Copies:

14. (1) Copies made out of the United Kingdom of any work in which copyright subsists which if made in the United Kingdom would infringe copyright, and as to which the owner of the copyright gives notice in writing by himself or his agent to the Commissioners of Customs and Excise, that he is desirous that such copies should not be imported into the United Kingdom, shall not be so imported, and shall, subject to the provisions of this section, be deemed to be included in the table of prohibitions and restrictions contained in section forty two of the Customs Consolidations Act, 1876, and that section shall apply accordingly.

(2) Before detaining any such copies or taking any further proceedings with a view to the forfeiture thereof under the law relating to the Customs, the Commissioners of Customs and Excise may require the regulations under this section, whether as to information, conditions, or other matters, to be complied with, and may satisfy themselves in accordance with those regulations that the copies are such as are prohibited by this section to be imported.

(3) The Commissioners of Customs and Excise may make regulations, either general or special, respecting the detention and forfeiture of copies the importation of which is prohibited by this section, and the conditions, if any, to be fulfilled before such detention and forfeiture, and may, by such regulations, determine the information, notices, and security to be given, and the evidence requisite for any of the purposes of this section, and the mode of verification of such evidence.

(4) The regulations may apply to copies of all works the importation of copies of which is prohibited by this section, or different regulations may be made respecting different classes or such works.

(5) The regulations may provide for the informant reimbursement the Commissioners of Customs and Excise all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent on such detention; and may provide for notices under any enactment repealed by this Act being treated as notices given under this section.

(6) The foregoing provisions of this section shall have effect as if they were part of the Customs Consolidation Act, 1876:

Provided that, notwithstanding anything in that Act, the Isle of Man shall not be treated as part of the United Kingdom for the purposes of this section.

(7) This section shall, with the necessary modifications, apply to the importation into a British possession to which this Act extends of copies of works made out of that possession.

#### *Delivery of Books to Libraries*

Delivery of copies to British Museum and other Libraries:

15. (1) The publisher of every book published in the united kingdom shall within one month after the publication, deliver, at his own expense, a copy of the book to the trustees of the British Museum, who shall give a written receipt for it.

(2) He shall also, if written demand is made before the expiration of twelve months after publication, deliver within one month after receipt of that written demand or, if the demand was made before publication, within one month after publication, to some depot in London, named in the demand a copy of the book for, or in accordance with the directions of, the authority having the control of each of the following libraries, namely: the Bodleian Library, Oxford, the University Library, Cambridge, the Library of the Faculty of Advocates at Edinburgh, and the Library of Trinity College, Dublin, and subject to the provisions of this section the National Library of Wales. In the case of an encyclopedia, newspaper, review, magazine, or work published in a series of numbers or parts, the written demand may include all numbers or parts of the work which may be subsequently published.

(3) The copy delivered to the trustees of the British Museum shall be a copy of the whole book with all maps and illustrations belonging thereto, finished and coloured in the same manner as the best copies of the books are published, and shall be bound, sewed, or stitched together, and on the best paper on which the book is printed.

(4) The copy delivered for other authorities mentioned in this section shall be on the paper on which the largest number of copies of the book is printed for sale, and shall be in the like condition as the books prepared for sale.

(5) The books of which copies are to be delivered to the National Library of Wales shall not include books of such classes as may be specified in regulations to be made by the Board of Trade.

(6) If a publisher fails to comply with this section, he shall be liable on summary conviction to a fine not exceeding five pounds and the value of the book, and the fine shall be paid to the trustees or authority to whom the book ought to have been delivered.

(7) For the purposes of this section, the expression "part or division of a book, pamphlet, sheet of letter press, sheet of music, map, plan, chart or table separately published, but shall not include any second or subsequent edition of a book unless such edition contains additions or alterations either in the letter press or in the maps, prints, or other engravings belonging thereto."

*Special Provisions as to certain Works*

Works of joint authors:

16. (1) In the case of a work of joint authorship, copyright shall subsist during the life of the author who first dies and for a term of fifty years after his death, or during the life of the author who dies last, whichever period is the longer, and references in this Act to the period after the expiration of any specified number of years from the death of the author shall be construed as references to the period after the expiration of the like number of years from the death of the author who dies first or after the death of the author who dies last, whichever period may be the shorter, and in the provisions of this Act with respect to the grant of compulsory licenses a reference to the date of the death of the author who dies last shall be substituted for the reference to the date of the death of the author.

(2) Where, in the case of a work of a joint authorship, some one or more of the joint authors do not satisfy the conditions conferring copyright laid down by this Act, the work shall be treated for the purposes of this Act as if the other author or authors had been the sole author or authors thereof:

Provided that the term of the copyright shall be the same as it would have been if all the authors had satisfied such conditions as aforesaid.

(3)

work produced by the collaboration of two or more authors in which the contribution of one author is not distinct from the contribution of the other author or authors.

(4) Where a married woman and her husband are joint authors of a work the interest of such married woman therein shall be her separate property.

Posthumous works:

17. (1) In the case of a literary dramatic or musical work, or an engraving, in which copyright subsists at the date of the death of the author, or, in the case of a work of joint authorship, at or immediately before the date of the death of the author, who dies last, but which has not been published, nor, in the case of a dramatic or musical work, been performed in public, nor in the case of a lecture, been delivered in public, before that date, copyright shall subsist till publication, or performance or delivery in public, whichever may first happen, and for a term of fifty years thereafter, and the proviso to section three of this Act shall, in the case of such a work, apply as if the author had died at the

date of such publication or performance or delivery in public as aforesaid.

(2) The ownership of an authors manuscript after his death, where such ownership has been acquired under a testamentary disposition made by the author and the manuscript is of a work which has not been published nor performed in public nor delivered in public, shall be prima facie proof of the copyright being with the owner of the manuscript.

Provisions as to Government publications:

18. Without prejudice to any rights or privileges of the Crown, where any work has, whether before or after the commencement of this Act, been prepared or published by or under the direction or control of His Majesty or any Government department, the copyright in the work shall, subject to any agreement with the author, belong to His Majesty, and in such case shall continue for a period of fifty years from the date of the first publication of the work.

Provisions as to mechanical instruments:

19. (1) Copyright shall subsist in records, perforated rolls, and other contrivances by means of which sounds may be mechanically reproduced, in like manner as if such contrivances were musical works, but the term of copyright shall be fifty years from the making of the original plate from which the contrivance was directly or indirectly derived and the person who was the owner of such original plate at the time when such plate as made shall be deemed to be the author of the work, and, where such owner is a body corporate, the body corporate shall be deemed for the purposes of this Act to reside within the parts of His Majesty dominions to which this Act extends if it has established a place of business within such parts.

(2) It shall not be deemed to be an infringement of copyright in any musical work for any person to make within the parts of His Majesty dominions to which this Act extends records, perforated rolls, or other contrivances by means of which the work may be mechanically performed, if such person proves --



- a. that such contrivances have previously been made by, or with the consent or acquiescence of, the owner of the copyright in the work; and
- b. that he has given the prescribed notice of his intention to make the contrivances, and has paid in the prescribed manner to, or for the benefit of, the owner of the copyright in the work royalties in respect

of all such contrivances sold by him, calculated at the rate hereinafter mentioned:

Provided that --

(i) nothing in this provision shall authorise any alterations in, or omissions from, the work reproduced, unless contrivances reproducing the work subject to similar alterations and omissions have been previously made by, or with the consent or acquiescence of, the owner of the copyright, or unless such alterations or omissions are reasonably necessary for the adaptation of the work to the contrivances in question; and

(ii) for the purposes of this provision, a musical work shall be deemed to include any words so closely associated therewith as to form part of the same work, but shall not be deemed to include a contrivance by means of which sounds may be mechanically reproduced.

(3) The rate at which such royalties as aforesaid are to be calculated shall --

- a. in the case of contrivances sold within two years after the commencement of this Act by the person; making the same, be two and one half per cent; and
- b. in the case of contrivances sold as aforesaid after the expiration of that period, five percent on the ordinary retail selling price of the contrivance calculated in the prescribed manner, so however, that the royalty payable in respect of a

contrivance shall, in no case, be less than halfpenny for each separate musical work in which copyright subsists reproduced thereon, and, where the royalty calculated as aforesaid includes a fraction of a farthing, such fraction shall be reckoned as a farthing:

Provided that, if, at any time after the expiration of seven years from the commencement of this Act, it appears to the Board of Trade that such rate as aforesaid is no longer equitable, the Board of Trade may, after holding a public inquiry, make an order either decreasing or increasing that rate to such extent as under the circumstances may seem just, but any order so made shall be provisional only and shall not have an effect unless and until confirmed by Parliament; but, where an order revising the rate has been so made and confirmed, no further revision shall be made before the expiration of fourteen years from the date of the last revision.

(4) If any such contrivance is made reproducing two or more different works in which copyright subsists and the owners of the copyright therein are different persons, the sums payable by way of royalties under this section shall be apportioned amongst the several owners of the copyright in such proportions as, failing agreement, may be determined by arbitration.

(5) When any such contrivances by means of which a musical work may be mechanically performed have been made, then, for the purposes of this section, the owner of the copyright in the work shall, in relation to any person who makes the prescribed inquiries, be deemed to have given his consent to the making of such contrivances if he fails to reply to such inquiries within the prescribed time.

(6) For the purposes of this section, the Board of Trade may make regulations prescribing anything which under this section is to be prescribed, and prescribing the mode in which notices are to be given and the particulars to be given in such notices, and the mode, time, and frequency of the payment of royalties, and any such regulations may, if the Board think fit, include regulations requiring payment in advance or otherwise securing the payment of royalties.

(7) In the case of musical works published before the commencement of this Act, the forgoing provisions shall have effect, subject to the following modifications and additions: -

a. The conditions as to the previous making by, or with the consent or acquiescence of, the owner of the copyright in the work, and the restrictions as to alterations in or omissions from the work shall not apply:

b. The rate of two and one half per cent shall be substituted for the rate of five per cent as the rate at which royalties are to be calculated, but no royalties shall be payable in respect of contrivances sold before the first day of July, nineteen hundred and thirteen, if contrivances reproducing the same work had been lawfully made or placed on sale, within the

before the first day of July, nineteen hundred and ten:

c. Notwithstanding any assignment made before the passing of this Act of the copyright in a musical work, any rights conferred by this Act in respect of the making or authorising the making, of contrivances by means of which the work may be mechanically performed shall belong to the author or his legal personal representatives and not to the assignee, and the royalties aforesaid shall be payable to, and for the benefit of, the author of the work or his legal personal representatives:

d. The saving contained in this Act of the rights and interest arising from, or in connection with, action taken before the

commencement of this Act shall not be construed as authorising any person who has made contrivances by means of which the work may be mechanically performed to sell any such contrivances, whether made before or after the passing of this Act, except on the terms and subject to the conditions laid down in this section:

e. Where the work is a work on which copyright is conferred by an Order in Council relating to a foreign country, the copyright so conferred shall not, except to such extent as may be provided by the Order, include any rights with respect to the making of records, perforated rolls, or other contrivances by means of which the work may be mechanically performed.

(8) Notwithstanding anything in this Act, where a record, perforated roll, or other contrivance by means of which sounds may be mechanically reproduced has been made before the commencement of this Act, copyright shall, as from the commencement of this Act, subsist therein in like manner and for the like term as if this Act had been in force at the date of the making of the original plate form which the contrivance was directly or indirectly derived:

Provided that --

- (i) the person who, at the commencement of this Act, is the owner of such original plate shall be the first owner of such copyright; and
- (ii) nothing in this provision shall be construed as conferring copyright in any such contrivance if the making thereof would have infringed copyright in some other such contrivance, if this provision had been in force at the time of the making of the first-mentioned contrivance.



Provision as to political speeches:

20. Notwithstanding anything in this Act, it shall be an infringement of copyright in an address of a political nature delivered at a public meeting to publish a report thereof in a newspaper.

Provisions as to photographs:

21. The term for which copyright shall subsist in photographs shall be fifty years from the making of the original negative from which the photograph was directly or indirectly derived, and the person who was owner of such negative at the time when such negative was made shall be deemed to be the author of the work, and, where such owner is a body corporate, the body corporate shall be deemed for the purposes of this Act to reside within the

has established a place of business within such parts.

Provisions as to designs registerable under 7 Edw. 7. c. 29:

22. (1) This Act shall not apply to designs capable of being registered under the Patents and Designs Act, 1907, except designs which, through capable of being so registered, are not used or intended to be used as models or patterns to be multiplied by any industrial process.

(2) General rules under section eighty-six of the Patents and Designs Act, 1907, may be made for determining the conditions under which a design shall be deemed to be used for such purposes as aforesaid.

*Works of foreign authors first published in parts of His Majesty dominions to which Act extends:*

23. If it appears to his majesty that a foreign country does not give, or has not undertaken to give, adequate protection to the works of British authors, it shall be lawful for His Majesty by Order in council to direct that such of the provisions of this Act as confer copyright on works first published within the parts of His Majesty dominions to which this Act extends, shall not apply to works published after the date specified in the Order, the authors whereof are subjects or citizens of such foreign country, and are not resident in his Majesty

dominions, and thereupon those provisions shall not apply to such works.

Existing Works:

24. (1) Where any person is immediately before the commencement of this Act entitled to any such right in any work as is specified in the first column of the First Schedule to this Act, or to any interest in such a right, he shall, as from that date, be entitled to the substituted right set forth in the second column of that schedule, or to the same interest in such a substituted right, and to no other right or interest, and such substituted right shall subsist for the term for which it would have subsisted if this Act has been in force at the date when the work was made and the work had been one entitled to copyright thereunder:

Provided that --

a. if the author of any work in which any such right as is specified in the first column of the First Schedule to this Act subsists at the commencement of this Act has, before that date, assigned the right or granted any interest therein for the whole term of the right, then at the date when, but for the passing of this Act, the right would have expired the substituted right conferred by this section shall, in the absence of express agreement, pass to the author of the work, and any interest therein created before the commencement of this Act and then subsisting shall determine; but the person

who immediately before the date at which the right would so have expired was the owner of the right or interest shall be entitled at his option either --

(i) on giving such notice as hereinafter mentioned, to an assignment of the right or the grant of a similar interest therein for the remainder of the term of the right for such consideration as, failing agreement, may be determined by arbitration; or

(ii) without any such assignment or grant, to continue to reproduce or perform the work in like manner as therefore subject to the payment, if demanded by the author within three years after the date at which the right would have so expired, of such royalties to the author as, failing agreement, may be determined by arbitration, or, where the work is incorporated in a collective work and the owner of the right or interest is the proprietor of that collective work, without any such payment;

The notice above referred to must be given not more than one year nor less than six months before the date at which the right would have so expired, and must be sent by registered post to the author, or, if he cannot with reasonable diligence be found, advertised in the London Gazette and in two London newspapers:

b. where any person has, before the twenty sixth day of July nineteen hundred and ten, taken any action whereby he has incurred any expenditure or liability in connexion with the reproduction or performance of any work in a manner which at the time was lawful, or for the purpose of or with a view to the reproduction or performance of a work at a time when such reproduction or performance would, but for the passing of this Act, have been lawful, nothing in this section shall diminish or prejudice any rights or interest arising from or in connexion with such action which are subsisting and valuable at the said date,

unless the person who by virtue of this section becomes entitled to restrain such reproduction or performance agrees to pay such compensation as, failing agreement, may be determined by arbitration.

(2) For the purposes of this section, the expressi includes the legal personal representatives of a deceased author.

(3) Subject to the provisions of section nineteen subsections (7) and (8) and of section thirty-three of this Act, copyright shall not subsist in any work made before the commencement of this Act, otherwise than under, and in accordance with, the provisions of this section.

*Application to British Possessions*

25. (1) This Act, except such of the provisions thereof as are expressly restricted to the United Kingdom, shall extend

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extend to a self-governing dominion, unless declared by the Legislature of that dominion to be in force therein either without any modifications or additions, or with such modifications and additions relating exclusively to procedure and remedies, or necessary to adapt this Act to the circumstances of the dominion, as may be enacted by such Legislature.

(2) If the Secretary of State certifies by notice published in the London Gazette that any self-governing dominion has passed legislation under which works, the authors whereof were at the date of the making of the works British subjects resident elsewhere than in the dominion or (not being British subjects) were resident in the parts of His Majesty dominions to which this Act extends, enjoy within the dominion rights substantially identical with those conferred by this Act, then, whilst such legislation continues in force, the dominion shall, for the purposes of the rights conferred by this Act, be treated as if it were a

dominion to which this Act extends; and it shall be lawful for the Secretary of State to give such a certificate as aforesaid, notwithstanding that the remedies for enforcing the rights, or the restrictions on the importation of copies of works, manufactured in a foreign country, under the law of the dominion, differ from those under this Act.

*Legislative powers of self-governing dominions:*

26. (1) The Legislature of any self-governing dominion may, at any time, repeal all or any of the enactments relating to copyright passed by Parliament (including this Act) so far as they are operative within that dominion: Provided that no such repeal shall prejudicially affect any legal rights existing at the time of the repeal, and that, on this Act or any part thereof being so repealed by the Legislature of a self-governing dominion, that dominion shall cease to be a dominion to which this Act extends.

(2) In any self-governing dominion to which this Act does not extend, the enactments repealed by this Act shall, so far as they are operative in that dominion, continue in force until repealed by the Legislature of that dominion.

(3) Where His Majesty in Council is satisfied that the law of self-governing dominion to which this Act does not extend provides adequate protection within the dominion for the works (whether published or unpublished) of authors who at the time of the



making of the work were British subjects resident elsewhere than in that dominion, His Majesty in Council may, for the purpose of giving reciprocal protection, direct that this Act, except such parts (if any) thereof as may be specified in the Order, and subject to any conditions contained therein, shall, within the parts of His Majesty's dominions to which this Act extends, apply to works the authors whereof were, at the time of the making of the work, resident within the first-mentioned dominion, and to works first published in that dominion; but, save as provided by such an Order, works the authors whereof were resident in a dominion to which this Act does not extend shall not, whether they are British subjects or not, be entitled to any protection under this Act except such protection as is by this Act conferred on works first published within the parts of His Majesty's dominions to which this Act extends:

Provided that no such Order shall confer any rights within a self-governing dominion, but the Governor in Council of any self-governing dominion to which this Act extends, may, by Order, confer within that dominion the like rights as His Majesty in Council is, under the foregoing provisions of this subsection, authorised to confer within other parts of His Majesty's dominions.

includes a dominion which is for the

purposes of this Act to be treated as if it were a dominion to which this Act extends.

Power of Legislatures of British possessions to pass supplemental legislation:

27. The Legislature of any British possession to which this Act extends may modify or add to any of the provisions of this Act in its application to the possession, but, except so far as such modifications and additions relate to procedure and remedies, they shall apply only to works the authors whereof were, at the time of the making of the work, resident in the possession, and to works first published in the possession.

Application to protectorates:

28. His Majesty may, by Order in Council, extend this Act to any territories under his protection and to Cyprus, and, on the making of any such Order, this Act shall, subject to the provisions of the Order, have effect as if the territories to which it applies or Cyprus were part of His Majesty dominions to which this Act extends.

## *Part II. - International Copyright*

Power to extend Act to foreign works:

29.

Application of Part II to British possessions:

30. (1) An Order in Council under this Part of this Act shall apply to all His Majesty dominions to which this Act extends except self-governing dominions and any other possession specified in the Order with respect to which it appears to His Majesty expedient that the Order should not apply.

(2) The Governor in Council of any self-governing dominion to which this Act extends may, as respects that dominion, make the like orders as under this Part of this Act His Majesty in Council is

than self-governing dominions, and the provisions of this Part of this Act shall, with the necessary modifications, apply accordingly.

(3) Where it appears to His Majesty expedient to except from the provisions of any order any part of his dominions not being a self-governing dominion, it shall be lawful for His Majesty by the same or any other Order in Council to declare that such order and this Part of this Act shall not , and the same shall not, apply to such part, except so far as is necessary for preventing any prejudice to any rights acquired previously to the date of such Order.

### *Part III. - Supplemental Provisions*

Abrogation of common law rights:

31. No person shall be entitled to copyright or any similar right in any literary, dramatic, musical, or artistic work, whether published or unpublished, otherwise than under and in accordance with the provisions of this Act, or of any other statutory enactment for the time being in force, but nothing in this section shall be construed as abrogating any right or jurisdiction to restrain a breach of trust or confidence.

Provisions as to Orders in Council:

32. (1) His Majesty in Council may make Orders for altering, revoking or varying any Order in Council made under this Act, or under any enactments repealed by this Act, but any Order made under this section shall not affect prejudicially any rights or interests acquired or accrued at the date when the Order comes into operation, and shall provide for the protection of such rights and interests.

(2) Every Order in Council made under this Act shall be published in the London Gazette and shall be laid before both Houses of Parliament as soon as may be after it is made, and shall have effect as if enacted in this Act.

Saving of university copyright:

33. Nothing in this Act shall deprive any of the universities and colleges mentioned in the Copyright Act, 1775, of any copyright they already possess under that Act, but the remedies and

penalties for infringement of any such copyright shall be under this Act and not under that Act.

Saving of compensation to certain libraries:

34. There shall continue to be charged on, and paid out of, the Consolidated Fund of the United Kingdom such annual compensation as was immediately before the commencement of this Act payable in pursuance of any Act as compensation to a library for the loss of the right to receive gratuitous copies of books:

Provided that this compensation shall not be paid to a library in any year, unless the Treasury are satisfied that the compensation for the previous year has been applied in the purchase of books for the use of and to be preserved in the library.

**Appendix C**

British Mandate  
Trade Marks Ordinance,  
No. 35 of 1938.

AN ORDINANCE TO PROVIDE FOR THE REGISTRATION AND  
PROTECTION OF TRADE MARKS INCLUDING TRADE MARKS  
REGISTERED ABROAD.

BE IT ENACTED by the High Commissioner for Palestine, with the  
advice of the Advisory Council thereof:-

Short title:

1. This Ordinance may be cited as the Trade Marks Ordinance,  
1938.

Interpretation:

2. In this Ordinance, unless the context otherwise requires:-

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connection with goods for the purpose of indicating that they are  
the goods of the proprietor of such trade mark by virtue of  
manufacture, selection, certification, dealing with or offering for  
sale

*Register of Trade Marks:*

3. There shall be kept for the purpose of this Ordinance a record called the register of trademarks wherein shall be entered all registered trade marks with the names, addresses and descriptions of their proprietors, notifications of assignments and transmissions, disclaimers, conditions, limitations and such other matters relating to such trademarks as may from time to time be prescribed. The register shall be kept under the control and management of a registrar appointed by the high commissioner.

*Incorporation of Existing Register:*

4. The register of trademarks existing at the date of the commencement of this Ordinance, shall be incorporated with the form part of the register. Subject to the provisions of section 30 of this Ordinance, the validity of the original entry of any trade mark upon the register so incorporated shall be determined in accordance with the Ordinance in force at the date of such entry, and such trade mark shall retain its original date but for all other purposes it shall be deemed to be a trade mark registered under this Ordinance.

*Inspection of and extract for register:*

5. The register kept under this ordinance shall at all convenient times be open to inspection by the public subject to such regulations as may be prescribed, and certified copies of any entry

in such register shall be given to any person requiring the same on payment of the prescribed fee.

Application for Registration:

6. A person desiring to have the exclusive use of a trade mark in order to distinguish goods of his own production, manufacture, working, selection, certification or which he deals with or offers for sale, or intends to deal with or offer for sale, may apply for registration in accordance with the provisions of this Ordinance.

Marks capable of registration as trade marks:

7. (1) Trade marks capable of registration must consist of characters, devices or marks or combinations thereof which have a distinctive character.
  - (2) adapted to distinguish the goods of the proprietor of the trade marks from those of other persons.
  - (3) In determining whether a trade mark is so adapted, the registrar or the court may, in the case of a trade mark in actual use, take into consideration the extent to which such user has rendered such trade mark in fact distinctive for goods with respect to which it is registered or proposed to be registered.



(4) A trade mark may be limited in whole or in part to one or more specified colours, and in such case the fact that it is so limited shall be taken into consideration by the registrar or court having to decide on the distinctive character of such trade mark. If and so far as a trade mark is registered without limitation of colour it shall be deemed to be registered for all colours.

(5) A trade mark must be registered in respect of particular goods or classes of goods.

(6) Any questions arising as to the class within which any goods fall shall be determined by the registrar, whose decisions shall be final.

Marks not capable as registration as Trade Marks:

8. The following marks are not capable of registration as trade marks:-

(a) public armorial bearings, crests, insignia, or decorations of Palestine or Foreign States or nations, unless authorized by the competent authorities;

(b) official hall marks or signs indicating an official warranty; unless put forward or authorized by the competent authority owning or controlling the mark.

(c) representations of royal arms or royal crests, or arms or crests so nearly resembling them as to lead to mistake, or of

devices calculated to lead persons to think that the applicant has royal patronage or authorisation;

(d) marks in which the following words appear:-

or words like that effect;

(e) marks which are or may be injurious to public order or morality or which are calculated to deceive the public; or marks which encourage unfair trade competition, or contain false indications of origin;

(f) marks consisting of figures, letters or words which are in common use in trade to distinguish or describe goods or classes of goods or which bear direct reference to their character or quality; words whose ordinary signification is geographical or a surname, unless represented in a special or particular manner, provided that nothing herein contained shall be deemed to prohibit the registration of marks of the nature described in this paragraph which have a distinctive character within the meaning of subsections (2) and (3) of section 7.

(g) marks identical with or similar to emblems of exclusively religious significance;

(h) marks which are or contain, or which so nearly resemble as to be calculated to deceive, the representation, name or the trade name of a person, or the name of a body corporate, or of an association, unless the consent of the person or persons concerned has been obtained; in the case of persons recently

dead the registrar may call for consents from their legal representatives;

(i) a mark identical with one belonging to a different proprietor which is already on the register, in respect of such goods or description of goods, or so nearly resembling such trade marks as to be calculated to deceive.

Name or description of goods:

9. Where the name or a description of any goods appears on a trade mark the registrar may refuse to register such mark in respect of any goods other than the goods so named or described. Where the name or description of any goods appears on a trade mark, which name or description in use varies, the registrar may permit the registration of the mark with the name or description upon it for goods other than those named or described, the applicant stating in his application that the name or description varies.

Standardization, etc., trade marks:

10. Where any association or person undertakes to certify the origin, material, mode of manufacture, quality, accuracy, or other characteristics of any goods by mark used upon or in connection with such goods, the registrar if and so long as he is satisfied that such association or person is competent to certify as aforesaid, may, if he shall judge it to the public advantage, permit such association or person to register such mark as a trade mark in respect of such goods, whether or not such association or be a

trading association or trader or possessed of a goodwill in connection with such certifying. When so registered, such trade mark shall be deemed in all respects to be a registered trade mark, and such association or person to be proprietor thereof, save that such trade mark shall be transmissible or assignable only by permission of the registrar.

Applications for Registration:

11. (1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering the same shall apply in writing to the registrar in the prescribed manner.
  - (2) Subject to the provisions of this Ordinance, the registrar may refuse such application, or may accept it absolutely or subject to conditions, amendments, or modifications, or to such limitations, if any, as to mode or place of user or otherwise as he may think right to impose.
  - (3) Any refusal by the registrar to register a mark shall be subject to appeal to the Supreme court sitting as a High Court of Justice.
  - (4) The registrar or the Supreme court sitting as a High Court of Justice, as the case may be, may at any time, whether before or after acceptance, correct any error in or in connection with an application, or may permit an applicant to amend his application upon such terms as they may think fit.

*Disclaimers:*

12. If a trade mark contains matter common to the trade or otherwise of a non-distinctive character, the registrar or the Supreme Court sitting as a High Court of Justice in deciding whether such trade mark shall be entered or shall remain upon the register, may require, as a condition of its being upon the register, that the proprietor shall disclaim any right to the exclusive use of any part or parts of such trade mark, or of all or any portion of such matter, to the exclusive use of which they hold him not to be entitled, or that he shall make such other disclaimer as they may consider needful for the purpose of defining his rights under such registration: Provided always that no disclaimer upon the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

*Advertisement of application:*

13. When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the registrar shall, as soon as may be after such acceptance, and at the expense of the applicant, cause the application as accepted to be advertised in the prescribed manner. Such advertisement shall set forth all conditions and/or limitations subject to which the application has been accepted.

Opposition to registration:

14.(1) Any person may within three months, or within such other time as may be prescribed, from the date of the advertisement of an application for the registration of a trade mark, file with the registrar a notice of opposition to such registration:

Provided that in the case of applications advertised before the commencement of this Ordinance, the period within which, and the manner in which, the notice of opposition thereto may be filed, shall be prescribed under the Trade Marks Ordinance which was in force at the date of the advertisement.

(2) Such notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of the opposition.

(3) The registrar shall send a copy of such notice to the applicant, and within the prescribed time after the receipt of such notice the applicant shall send to the registrar, in the prescribed manner, a counter statement of the grounds on which he relies for the application, and, if he does not do so, he shall be deemed to have abandoned his application.

(4) If the applicant sends such counterstatement the registrar shall furnish a copy thereof to the persons giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions, registration is to be permitted.

(5) The decision of the registrar shall be subject to appeal to the Supreme Court sitting as a High Court of Justice.

(6) An appeal under this section shall be made within thirty days from the date of the decision of the registrar, and on such appeal the Supreme Court sitting as a High Court of Justice shall, if required, hear the parties and the registrar, and shall make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(7) On the hearing of any such appeal any party may either in the manner prescribed or by special leave of the Supreme Court sitting as a High Court of Justice bring forward further material for the consideration of the Supreme Court sitting as a High Court of Justice.

(8) On an appeal under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the registrar other than those stated by the opponent as herein-above provided except by leave of the Supreme Court sitting as a High Court of Justice hearing the appeal. Where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(9) In any appeal under this section, the Supreme Court sitting as a High Court of Justice may, after hearing the registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity of such trade mark, but in

such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

Date of Registration:

15. (1) When an application for registration of a trade mark has been accepted and has not been opposed, and the time for notice of opposition has expired, or having been opposed the opposition has been decided in favour of the applicant, the registrar shall on the payment of the prescribed fee, unless the application has been accepted in error or unless the court otherwise direct, register the said trade mark. The mark when registered shall be registered as of the date of the application for registration or, in the case of an application filed in compliance with the provisions of section 41, as of the date of application for registration in the foreign state, and such date shall be deemed for the purposes of this Ordinance to be the date of registration.

(2) On the registration of a trade mark the registrar shall issue to the applicant a certificate in the prescribed form of the registration of such trade mark.

16. Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in such notice.



Rival claims to identical marks:

17. Where separate applications are made by different persons to be registered as proprietors respectively of trade marks which are identical or nearly resemble each other, in respect of the same goods or description of goods, the registrar may refuse to register any of such persons until their rights in respect of such trademark have been settled either:-

(a) by an agreement between themselves which meets with the approval of the registrar, or

(b) by the Supreme Court sitting as a High Court of Justice to which, failing such an agreement, the registrar shall refer the dispute.

18. (1) In a case of honest concurrent user of or other special circumstances which, in the opinion of the registrar, make it proper so to do, the registrar may permit the registration of trade marks which are identical or nearly resemble each other, for the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as the registrar may think it right to impose.

(2) A decision of the registrar under this section shall be subject to appeal to the Supreme Court sitting as a High Court of Justice and the court shall on appeal have the same powers as are by this section conferred upon the registrar.

(3) An appeal under this section shall be brought within thirty days from the date of the decision by the registrar.

Assignment of trade marks and apportionment on dissolution of partnership:

19.(1) A trade mark when registered shall be assigned and transmitted only in connection with the goodwill of the business concerned in the goods for which it has been registered and shall be determinable with that goodwill.

(2) In any case where from any cause, whether by reason of dissolution of partnership or otherwise, a person ceases to carry on business and the goodwill of such person does not pass to one successor but is divided, the registrar may, on the application of the parties interested, permit an apportionment of the registered trade marks of the person among the persons in fact continuing the business, subject to such conditions, if any, as he may think necessary in the public interest. Any decision of the registrar under this subsection shall be subject to appeal to the Supreme Court sitting as a High Court of Justice.

Duration of Registration:

20. The period of duration of trade mark rights shall be seven years from the date of registration but may be renewed from time to time in accordance with the provisions of the Ordinance; Provided that, in so far as the initial period of duration of trade mark rights is concerned, this section shall only apply to applications made subsequent to the enactment of the Ordinance,

and shall not apply to any registration obtained under any previous Ordinance.

Renewal of registration:

21. (1) The registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of such trade mark for a period of fourteen years from the expiration of the original registration or of the last renewal of the registration, as the case

Procedure on expiry of period of registration:

(2) At the prescribed time before the expiration of the last registration of a trade mark, the registrar shall send notice in the prescribed manner to the registered proprietor of the date at which the existing registration will expire and the conditions as to payment of fees and otherwise upon which a renewal of such registration may be obtained, and if at the expiration of the time prescribed in that behalf such conditions have not been duly complied with, the registrar may remove such trade mark from the register, subject to such conditions, if any, as to its restoration to the register as may be prescribed.

(3) Where a trade mark has been removed from the register for non-payment of the fee for renewal, such trademark shall,

nevertheless, for the purpose of any application for registration during one year next after the date of such removal, be deemed to be a trade mark which is already registered:

Provided that the foregoing provisions of this section shall not have effect where the registrar is satisfied either-

(a) that there has been no bon fide trade use of the trade mark which has been removed during the two years immediately proceeding its removal; or

(b) that no decision or confusion would be likely to arise from the use of the trade mark which is the subject of the application for registration by reason of any previous use of the trade mark which has been removed.

*Cancellation of Registration of Grounds of Non-User:*

22. (1) Without prejudice to the generality of the provisions of section 25 of this Ordinance, application for the cancellation of the registration of a trade mark may be made by any person interested on the ground that there was no bona fide intention to use the trade mark in connection with the goods for which it is registered and that there has in fact been no bona fide user of the trade mark in connection with the goods for which it is registered, or that there had not been any such user during the two years immediately preceding the application for cancellation, unless in either case such non user is shown to be due to special circumstances in the trade, and not to any intention not to use or to abandon such trade mark in respect to such goods.

(2) Application for cancellation may be made by the applicant in the prescribed manner either to the Supreme Court sitting as a High Court of Justice or, at the option of the applicant, may be made in the first instance to the registrar.

(3) The registrar may at any stage of the proceedings, refer any such application to the Supreme Court sitting as a High Court of Justice, or he may, after hearing the parties, determine the question between them subject to the appeal to the Supreme Court sitting as a High Court of Justice.

*Registration of assignment, etc:*

23. (1) Where a person becomes entitled by assignment, transmission or other operation of law to a registered trade mark, he shall make application to the registrar to register his title and the registrar shall, on receipt of such application and on proof of title to his satisfaction, register him as the proprietor of his trade mark, and shall cause an entry to be made in the prescribed manner on the register of the assignment, transmission or other instrument affecting the title. Any decision of the registrar under this section shall be subject to appeal to the Supreme court sitting as a High Court of Justice.

(2) Except in cases of appeals under this section, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of subsection (1) aforesaid shall not be admitted in evidence in any court is proof of the title to a trade mark unless the court otherwise directs.

Alteration of registered trade mark:

24. (1) The registered proprietor of any trade mark may apply in the prescribed manner to the registrar for leave to add or alter such trade mark in any manner not substantially affecting the identity of the same, and the registrar may refuse such leave or may grant the same on such terms and subject to such limitations as he may think fit, but any such refusal or conditional permission shall be subject to appeal to the Supreme Court sitting as a High court of Justice.

(2) If leave be granted, the trade mark as altered shall be advertised in the prescribed manner.

Rectification of register:

25. Subject to the provisions of this Ordinance

(1) Any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may make application in the prescribed manner to the Supreme Court sitting as a High Court of Justice, or may at his option, make such application in the first instance to the registrar.

(2) The registrar may, at any stage of the proceedings refer any such application to the supreme court sitting as a High court

of Justice, or he may, after hearing the parties, determine the question between them subject to appeal to the Supreme Court sitting at a High court of Justice.

(3) The Supreme court may in any proceeding under this section decide any question that it maybe necessary or expedient to decide in connection with the rectification of the register.

(4) In case of fraud in the registration, assignment or transmission of a registered trade mark, the registrar may himself apply to the Supreme Court under the provisions of this section.

(5) Application for the removal from the register of a trade mark on the ground that it is not entitled to registration within the provisions of section 6, 7, or 8 of the Ordinance, or on the ground that the registration of the trade mark creates an unfair competition in respect of the applicants rights in Palestine, must be made within five years of the registration of the mark.

(6) Any order of the Supreme Court rectifying the register shall direct that notice of the rectification shall be served upon the registrar by the successful party and the registrar shall, upon receipt of such notice, rectify the register accordingly.

*Rights of proprietor of trade mark:*

26. Subject to any limitations and conditions entered upon the register, the registration of a person as proprietor of a trade mark shall, if valid, give to such person the right to the exclusive sales

of such trade mark upon or in connection with the goods in respect of which it is registered: Provided always that where two or more persons are registered proprietors of the same (or substantially the same) trade mark in respect of the same goods, no rights of exclusive user of such trade mark shall (except so far as their respective rights shall have been defined by the registrar or by the Supreme Court sitting as a High Court of Justice) be acquired by any one of such persons as against any other by the registration thereof, but each of such persons shall otherwise have the same rights as if he were the sole registered proprietor thereof.

Correction of Register:

27. The registrar may, on request made in the prescribed manner by the registered proprietor, -
- (a) correct any error in the name or address of the registered proprietor of a trade mark; or
  - (b) enter any change in the name or address of the person who is registered as proprietor of a trade mark;
  - (c) strike out any goods or classes of goods from those for which a trade mark is registered; or
  - (d) enter a disclaimer or memorandum relating to a trade mark which does not in anyway extend the right given by the existing registration of such trade mark; or
  - (e) cancel the entry of a trade mark on the register.



Any decision of the registrar under this section shall be subject to appeal to the Supreme Court sitting as a High Court of Justice.

Adaptation of entries in register to amended or substituted classification of goods:

28. (1) The registrar may, with the approval of the High commissioner, from time to time make such rules, prescribe such forms and generally do such things as he thinks expedient for empowering him to amend the register, whether by making or expunging or varying entries therein, so far as may be requisite for the purpose of adapting the designation therein of the goods or classes of goods in respect of which trade marks are registered to any amended or substituted classification that may be prescribed.

(2) The registrar shall not, in exercise of any power conferred on him for the purpose aforesaid, make any amendment of the register that would have the effect of adding any goods or classes of goods to those in respect of which a trade mark is registered (whether in one or more classes) immediately before amendment is to be made, or of antedating the registration of a trade mark in respect of any goods:

Provided that this subsection shall not have effect in relation to goods as to which the registrar is satisfied that compliance with this subsection in relation thereto would involve undue complexity and that the addition or antedating, as the case may be, would not affect any substantial quantity of goods and would not substantially prejudice the rights of any person.

(3) A proposal for the amendment of the register for the purpose aforesaid shall be notified to the registered proprietor of the trade mark affected, shall be subject to appeal by the registered proprietor to the Supreme Court sitting as a High Court of Justice, shall be advertised with any modifications, and may be opposed before the registrar by any person aggrieved on the ground that the proposed amendment contravenes the provisions of the last foregoing subsection, and the decision of the registrar on any such opposition shall be subject to appeal to the Supreme Court sitting as a High Court of Justice.

*Registration to be prima facie evidence of validity:*

29. In all legal proceedings relating to a registered trade mark the fact that a person is registered as proprietor of such trade mark shall be prima facie evidence of the validity of the original registration of such trade mark and all subsequent assignments and transmissions of the same.

*Trade marks registered under previous Ordinances, and transitional provisions:*

30. No trade mark which is upon the register at the commencement of this Ordinance and which under this Ordinance is a registerable trade mark shall be removed from the register on the ground that it was not registerable under the Ordinances in force at the date of its registration. But nothing in this section contained shall subject any person to any liability in respect of any act or thing done

before the commencement of this Ordinance to which he would not have been subject under the Ordinances then in force.

Registrar to have notice of proceeding for rectification:

31. In any legal proceeding in which the relief sought includes alteration or rectification of the register, the registrar shall have the right to appear and be heard, and shall appear if so directed by the court. Unless otherwise directed by the court, the registrar in lieu of appearing and being heard may submit to the court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the office in like cases, or of such other matters relevant to the issues, and within his knowledge as such registrar, as he shall think fit, and such statement shall be deemed to form part of the evidence in the proceeding.

Certificate of registrar to be evidence:

32. A certificate purporting to be under the hand of the registrar as to any entry, matter, or thing which he is authorised by this Ordinance or rules made thereunder to make or do, shall be prima facie evidence of the entry having been made and of the contents thereof, and of the matter or thing having been done or not done.

Penalty on falsely representing a trade mark as registered:

33. (1) Any person who represents a trade mark as registered which is not so registered, shall be liable for every offence on conviction to a fine not exceeding fifty pounds.

(2) A person shall be deemed, for the purposes of this section, to represent that a trade mark is registered if he uses in connection

or implying that registration has been obtained for the trade mark.

Unregistered trade mark:

34. No person shall be entitled to institute any proceedings to recover damages for the infringement of a trade mark not registered in Palestine.

Infringement:

35. In an action for the infringement of a trade mark, the court trying the question of infringement shall admit evidence of the usages of the trade in respect of the get-up of the goods for which the trade mark is registered and of any trade mark or get-up legitimately used in connection with such goods by other persons.

User of name, address, or description of goods:

36. No registration under this Ordinance shall interfere with any genuine use by a person of his own name or place of business, or that of any of his predecessors in business, or the use by any

person of any genuine description of the character or quality of his goods.

Passing-off action:

37. Nothing in this Ordinance shall be deemed to affect the right to bring an action against any person for passing off goods as those of another person or the remedies in respect thereof.

Offences:

38. (1) Any person who with intent to deceive, commits or attempts to commit or aids or abets any other person in committing any of the following acts shall be guilty of an offence against this Ordinance and shall be liable upon conviction to imprisonment for a period not exceeding one year or to a fine not exceeding one hundred pounds, or to both such penalties.

(a) not being the proprietor thereof makes use of a trade mark registered under this Ordinance or of an imitation of such trade mark upon the same class of goods as that in respect of which the trade mark is registered;

(b) sells, stores for the purposes of sale, or exposes for sale, goods bearing a mark the use of which is an offence under paragraph (a);

(c) uses a mark duly registered by another person under this Ordinance for the purpose of advertising in the public press or in any other manner, goods of the same classification as those

for which registration has already been obtained by another person;

(d) makes, engraves, prints, or sells, any plate, die, block or other representation of a duly registered mark or any other imitation thereof for the purpose of enabling any person other than the registered proprietor of such mark to make use of such mark or an imitation thereof in connection with goods of the same classification as those for which registration has already been obtained by another person;

(e) makes or causes to be made a false entry in the register kept under this Ordinance, or writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false;

(2) In all such cases in lieu of or in addition to penalties prescribed by subsection (1), the court shall have power to grant an injunction against a continued repetition or any offence committed under this section.

*Order for confiscation or destruction:*

39. The court before which any person charged under the last preceding section is brought, may order that all goods, wrapping, packing, and advertising material, and blocks, dies and other apparatus and material for printing the mark or packing, wrapping, advertising or other material in respect of which the offence is committed, be confiscated or destroyed.

Exercise of discretionary power by registrar:

40. Where any discretionary or other power is given to the registrar by this Ordinance or rules made thereunder, he shall not exercise that power adversely to that applicant for registration or the registered proprietor of the trade mark in question without (if duly required so to do within the prescribed time) giving such applicant or registered proprietor an opportunity of being heard.

Trade marks registered abroad to be recognised on adhesion of Palestine to International Conventions:

41. (1) If His Majesty on behalf of the Administration of Palestine is pleased to make any arrangement with the Government of any foreign state for mutual protection of trade mark, then any person who has applied for protection for a trade mark in that state, or his legal representative or assignee, shall be entitled to registration of his trade mark under this Ordinance in priority to the other applicants; and the registration shall have the same date as the date of the application in the foreign state

Provided that

- (a) the application is dated within six months from the application for protection in the foreign state, and
- (b) nothing in this section shall entitle the proprietor of the trade mark to recover damages for infringements happening prior to the actual date on which his trade mark is registered in Palestine.

(2) The registration of a trade mark shall not be invalidated by reason only of the use of the trade mark in Palestine during the period specified in this section as that within which the application may be made.

Procedure for registration of marks:

42. The application for the registration of a trade mark under the last preceding section shall be made in the same manner as an ordinary application under this Ordinance.

Declaration of states adhering to the International Conventions:

43. (1) The provisions of section 41 and 42 of this Ordinance shall apply in the case of those foreign states with respect to which the High Commissioner may by Order in Council declare them to be applicable, and so long only in the case of each of such foreign states as the Order continues in force in respect to that state.

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shall include any colony, protectorate or territory subject to the authority or under the sovereignty of a foreign state or any territory in respect of which a mandate of the League of Nations is being exercised by a foreign state.

44. Canceled

Power of the Chief Justice to make rules of court:



45. The Chief Justice may with the approval of the High Commissioner make rules of court for regulating the practice and procedure in appeals, oppositions, applications and references under this Ordinance to the Supreme Court sitting as a High Court of Justice.

Power of registrar to make rules:

46. Subject to the provisions of this Ordinance, the registrar may with the approval of the High Commissioner from time to time make such rules, prescribe such forms, and generally do such things as he may think expedient

- (a) for regulating the practice under this Ordinance;
- (b) for prescribing the fees payable under this Ordinance;
- (c) for classifying goods for the purpose of registration of trade marks;
- (d) for making or requiring duplicates of trade marks and other documents;
- (e) for securing and regulating the publishing and selling or distributing in such manner as the registrar thinks fit, of copies of trade marks and other documents;
- (f) generally, for regulating the business of the office in relation to trade marks and all things by this Ordinance placed under the direction or control of the registrar.

Fees:

47. (1) There shall be paid in respect of application and registrations and other matters under this Ordinance such fees as may be prescribed by rules.

(2) All fees payable in pursuance of such rules shall be paid to the registrar, who will pay them into the Treasury.

Repeal:

48. The Trade Marks Ordinance is hereby repealed:

Provided that all rules and orders lawfully made under the provisions of that Ordinance shall remain in full force and effect until amended, varied or revoked by rules or orders respectively made under the provisions of this Ordinance.