

Jordan IP Week

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Judges Workshop

The Framework *for* International Intellectual Property

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Intellectual Property Rights IPRs

1. Patents
2. Industrial Designs
3. Trade & Service Mark & Company Names (Trade Names)
4. Copyright
5. Plant Varieties & Plant Breeder's Rights
6. Trade Secrets
7. Geographical Indications
8. Integrated Circuits

Intellectual Property (IP) law protects the pinnacle of human creativity and ingenuity. IP has gained much significance in recent times and evolved into a major asset for individuals and corporations.

The Three Main Branches of Intellectual Property Law: Copyright, Trademark and Patents.

- **Patents** grants a monopoly right to the inventor (person or corporation) in his new invention.
- **Trademark** law is intended to assist consumers (of goods and services) to identify the source of these products/services and not to be confused when attempting to purchase such branded goods/services. It is also intended to reward brand owners for creating a “goodwill” in their respective brands.
- **Copyright** is more complex, providing economic incentives for creation as well as protecting authors' creativity as embodied in a work. Copyright applies to all original works of authorship that are fixed in a tangible medium of expression these include: literary, dramatic, musical and artistic works that are fixed in one or more of the following forms: books, canvas, records, cassettes, and tapes).

International Protection of IP

Why IP is on the Agenda

- Lack of adequate intellectual property protection and difference in various national legislations.
- Developed countries championed the issue of IP protection because it was they that were primarily losing out on their IP.

1983-1994

- During the Uruguay Round of negotiations of General Agreement on Tariffs & Trade (GATT)
- Developed countries managed (for the first time) to link trade and intellectual property by introducing into the framework of the World Trade Organization, the *Agreement on Trade Related Intellectual Property Rights (TRIPs)* which is considered to be the most far-reaching international instrument ever negotiated on intellectual property rights.

The Paris Convention for the Protection of Industrial Property 1883 (Last Revised 1979).

One of the **Pillars of the international intellectual property system.**

Scope of Application

- Applies to **industrial property in the widest sense**: inventions, marks, industrial designs, utility models, trade names geographical indications and the repression of unfair competition.
- **The “National-Treatment” principle**
- Affords foreigners the same rights and protections as nationals in each signatory country: a court recognizes the judgment of a foreign court.

Weakness

- No enforcement provisions exist. Countries choosing to ignore the Paris Convention standards may do so with no penalties under the Convention.
- **169 Contracting States.**

The Berne Convention for the Protection of Literary and Artistic Works (1886)

- **Sets out/defines minimum standards of protection of the economic and moral rights of authors of literary and artistic works.**
- Aims to assist the nationals of its member states with international protection for: novels, poems and plays, songs and musicals, paintings, sculpture and architectural works.

Number of member states is **154**

World Intellectual Property Organization WIPO

(1970)

- One of 16 specialized agencies of the United Nations system of organizations, Geneva, Switzerland.
- **Promotes worldwide protection of IP through cooperation among states**
- **Administers 23 multilateral treaties dealing with the legal and administrative aspects of intellectual property.**
- Administers the rights of inventors, copyright holders and brand owners and ensures that their respective rights are protected, recognized and rewarded.
- What WIPO does not do:
- Adjudicate disputes that arise under these treaties. However, WIPO's "Arbitration and Mediation Center" is the largest accredited Dispute Resolution Service Provider (DRSP) resolving domain disputes arising under the rules set by the Internet Corporation for Assigned Names and Numbers (ICANN).
- 181 states are WIPO members.

World Trade Organization and General Agreement on Tariffs and Trade Negotiations

Initially pertained solely to the international trade of goods.

- The 1994 Uruguay Round renegotiated the GATT Treaty, which culminated into World Trade Organization.
- The GATT Treaty is still enforced under the auspices of the WTO. In addition to establishing the WTO, the Uruguay Round updated the GATT Treaty and introduced new subject matter (including but not limited to):
- The Agreement on Tariffs and Services (GATS).
- TRIPS. ---Membership in the WTO requires a nation to ratify these trade agreements.

Agreement on Trade-Related Aspects of Intellectual Property Rights TRIPS (1995)

The 1994 Uruguay Round: a large move forward from traditional conventions of intellectual property protection through TRIPs, which links the protection of intellectual property rights with international trade.

- TRIPS: most comprehensive multilateral agreement on intellectual property.
- **Scope of Coverage:**
- Copyright and related rights, trademarks, geographical indications, industrial designs, patents, layout-designs of integrated circuits, and undisclosed information (trade secrets).
- Forms of intellectual property not included in the Paris or Berne Conventions: computer programs and some compilations of data.
- Operates under 3 major principles: "national-treatment" doctrine, right of priority and minimum standards for intellectual property protection.

TRIPS (Cont.)

- WTO member states (or those requesting membership) must abide by and incorporate these provisions into their national legislation.
- Sets a minimum standard for IP protection that all signatories must meet. Standards primarily stem from the Paris Convention (1883) and the Berne Convention for the Protection of Literary and Artistic Works.
- Signatories may opt to protect more IP than required by the minimum.
- Provides for the resolution of disputes between nations (not citizens or corporations) through the WTO.
- Imposes trade sanctions against violating member countries.
- Administered by World Trade Organization (WTO).

Enforcement in TRIPS

- Strongest international protections to date.
- Obligates member states to provide IPR holders an opportunity to obtain injunctions and provisional measures against infringers.
- Authorizes domestic customs authorities to suspend the release of goods into the country's market if suspect of counterfeiting.
- Provides through the WTO a forum for dispute resolutions between Member states. Private IPR holders would need to petition their government to initiate a process against the infringing company in the WTO.

The Patent Cooperation Treaty (PCT) **1970.**

- Allows for simultaneous **patent protection for an invention in contracting states** by filing an **"international" patent application.**
- Application is filed by anyone who is a national or resident of a contracting state.
- The Treaty regulates the formal requirements with which any international application must comply in order to obtain such protection through the PCT.

124 Contracting countries are PCT members.

The Madrid Agreement Concerning the International Registration of Marks (Madrid Agreement -1891) and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol-1989).

- Allows brand owners to file an “international” registration with their home country (“basic registration”) and designate other Member nations for the mark to be registered.
- The national trademarks office then forwards the international portions of the registration to WIPO, which in turn publishes the application in its publication *Les Marques Internationales*.
- WIPO then forwards the requests for registration in other contracting countries that are designated by the brand owner.
- The TMO in each designated country has one year to refuse the application based upon non-compliance with their trademark law.

Madrid Protocol

- Intended to address some of the issues that prevented adoption of the Madrid Agreement: A more flexible system that is more compatible with the domestic legislation of these countries:
- Hinges international registration upon national “*application*” rather than national “*registration*”. Satisfies jurisdictions that have similar lengthy registration processes.
- Eliminates the “Central Attack” provision which provides for international cancellation of a mark if the original basic registration was canceled. Thus, upon the collapse of the marks home registration the mark’s international registrations is converted into separate national registrations.
- Allows applications to be submitted in English (as well as French), and authorizes each Member country may set its own fee schedule.
- 59 contracting states are member to the protocol.

The Trademark Law Treaty (TLT) **1994**

- Aims to streamline trademark registration and break down trade barriers by harmonizing the filing procedures of more than 200 trademark registries in the world hindered international registration of marks.
- Created a standard model forms for: Trademark applications, Powers of Attorney, change of name, address. Unified periods pertaining to duration of registration.
- The number of TLT member states is **34**.

The Patent Law Treaty (2000)

- Intended to **harmonize and streamline formal procedures in respect of national and regional patent applications and patents.**
- Provides maximum sets of requirements which the office of a contracting party may apply.
- The Patent office in a contracting state may not lay down any other formal requirements in respect of matters dealt with by this Treaty. Filing date requirements are excepted.
- PLT provisions apply to applications for (both) patents for invention and for patents of addition.
- PLT does not override the provisions and obligations of the Paris Convention.
- Only 7 countries have become member to this treaty.

**The Geneva Convention for the Protection of Producers
of Phonograms against Unauthorized Duplication of their
Phonograms (1971)**

- Obliges each contracting state to protect:
- producer of phonograms who is a national of another contracting states
- **Protection against?**
- Duplication without the consent of the producer.
- Importation of such duplicates.
- Distribution of such duplicates to the public.

73 countries have joined the Convention.

**The WIPO Copyright Treaty (WCT)
(1996)**

- Extends copyright protection to:
- (i) **computer programs**
- (ii) **compilations of data** or other material ("**databases**")*

- * Compilations of data in any form if the selection or arrangement of their contents constitute intellectual creations.

The number of contracting states is **42**.

The WIPO Performances and Phonograms Treaty (WPPT) 1996

- Deals with intellectual property rights of two kinds of beneficiaries:
 - (i) **Performers** (actors, singers, musicians, etc.), and
 - (ii) **Producers of phonograms** (the persons or legal entities who or which take the initiative and have the responsibility for the fixation of the sounds).*]

* They are dealt with in the same instrument because most of the rights granted by the treaty to performers are rights connected with their fixed, purely aural performances (which are the subject matter of phonograms).

Number of contracting states is 42.

The Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957).

- Establishes a classification of goods and services for the purposes of registering trademarks and service marks.
- The “Nice Classification” consists of a list of classes (based on types of products and services) of which there are 34 (Class 1-34) for goods and (classes 35-45) for services and an alphabetical list of the goods and services.
- 70 countries are members to the agreement.

The Locarno Agreement Establishing an International Classification for Industrial Designs (1968).

- Establishes a classification for industrial designs which consists of 32 classes and 223 subclasses based on different types of products.
- Comprises an alphabetical list of goods with an indication of the classes and subclasses into which these goods fall.
- List contains some 6,600 indications of different kinds of goods.
- 48 states are member of the Agreement.

The Strasbourg Agreement Concerning the International Patent Classification was concluded (IPC) 1971

- Establishes the International Patent Classification (IPC).
- IPC divides technology into 8 sections with approximately 69,000 subdivisions.
- Each subdivisions has a distinctive symbol which is designated by the national or regional industrial property office that publishes the relevant patent claim.
- Total number of contracting states is **57**.

The Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure (1977)

- Contracting states commit to recognize the deposit of microorganisms for the purposes of patent registration, with any **"international depositary authority," even if outside the jurisdiction where the patent application has been filed** (I.e even if deposited in another country).
- Benefit of Treaty: Eliminates the need to deposit in each country in which protection is sought.
- The total number of contracting states is **59**.

The Nairobi Treaty on the Protection of the Olympic Symbol (1981)

- Contracting commit to protect the Olympic symbol (the five interlaced rings) against use for commercial purposes (in advertisements, on goods, as a mark, etc.) without the authorization of the International Olympic Committee.
- The entire treaty revolves around one specific mark.
- Number of contracting states is **46**.

The Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (1999)

- Intends to render the system more responsive to the needs of users and to facilitate adherence by countries whose industrial designs systems do not permit them to accede to the 1960 Hague Act.

9 states are contracting members of the Act.

The International Convention for the Protection of New Varieties of Plants (UPOV) 1961

- Protection of new varieties of plants by an intellectual property right. New varieties of plants have significance in Agriculture and primarily in pharmaceuticals.
- 59 contracting states are member to the convention.

**Rome Convention for the Protection of
performers, Producers of Phonograms and
Broadcasting organizations (1961)**

Grants protection to copyrights owners and owners of related rights:

performers

producers of phonograms

broadcasting organizations.

73 member states are member to this Convention.

**Universal Copyright Convention and
Protocols 1,2 and 3 (1952)**

- Provides for the adequate and effective protection of the rights of authors and other copyright proprietors in literary, scientific and artistic works including:
 - writings
 - musical
 - dramatic and cinematographic works
 - paintings
 - engravings and sculpture.

Shukran!
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