



Marginalia
International

International Intellectual Property

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Konomark
Most rights sharable

General Principles

- “territoriality”
- Dependence, independence, central attack
- Procedural harmonization
- Substantive agreements
 - National treatment
 - Minima

International Aspects of Patents

- “territoriality”
- Paris Convention
 - national treatment
- Patent Cooperation Treaty
 - procedural harmonization
- TRIPS
 - substantive minima

Paris Convention

- Convention of Paris for the Protection of Industrial Property of 1884
- 177 signatories today
 - Cf. 195 internationally recognized sovereign countries
- Requirements:
 - national treatment, independence of patents, international priority

National Treatment

- Must treat foreign inventors who are nationals of a signatory no worse than domestic inventors
- E.g.:
 - No higher fees
 - No shorter durations

Independence of patents

- Before the Paris Convention, some countries applied foreign dependence against foreign inventors.
- Foreign dependence: If any foreign patent expired or was invalidated, the domestic patent was invalidated as well.
- Effect of independence: Victories and defeats in the courts of one country have no effect on validity in other countries

International Priority

- If a patent application is filed in any signatory, all subsequent applications in other signatories within one year are given priority back to the first-country filing date.

Patent Cooperation Treaty

- “PCT”
- 152 signatories today
- Procedural
- Provides a partially internationalized process
- One international application begins prosecution in all signatories.

TRIPS

- “Agreement on Trade-Related Aspects of Intellectual Property Rights”
- Negotiated during the the Uruguay Round of General Agreement on Tariffs and Trade (GATT) in 1994
- Covers other IP forms, as well as patent
- Agreement to TRIPS is a requirement of WTO membership
- 164 WTO members today
- Creates substantive “minimum standards” obligations for national patent laws

Minimum Standards of TRIPS

- 20 years from filing date is the minimum term
- Applicants must provide an enabling disclosure
- Protectible subject matter: inventions in “all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application”
 - Exceptions: certain methods of medical treatment, macro-organisms, immoral inventions
 - Pharmaceuticals, not patentable in many countries prior to TRIPS, are not an exception.
- Judicial review

Compulsory Licenses

- Compulsory licenses are essentially not used in the U.S. for inventions.
- Historically important in other countries, including for pharmaceuticals
- TRIPS has substantive limits on countries powers to grant compulsory licenses:
 - Must have made unsuccessful efforts to license
 - Compulsory license must be revocable
 - Remuneration must be adequate
 - Must be predominantly for the domestic market

TRIPS and Drugs in LDCs

- TRIPS effectively denies new drugs to poor populations and countries to some extent, including those for large-scale public-health problems such as AIDS, malaria, and other diseases.
- Despite the downside of TRIPS patent rules, most countries sign TRIPS, as it is required for WTO membership and thus needed for exports.
- Many smaller, lesser developed countries cannot manufacture pharmaceuticals on their own, so the domestic-market limitation effectively eviscerates the compulsory licensing scheme for them.
- Many very poor countries have already acceded.
- While WIPO and developed-countries pressure LDCs to provide monopoly privileges on pharmaceuticals, the WHO is helping LDCs to navigate the red tape to provide cheap generics.

International Aspects of Copyright

- No “international copyright”
- The major treaty is the Berne Convention
- The Universal Copyright Convention was begun by the U.S. as an alternative to Berne. It has less stringent provisions. But U.S. acceded to Berne in 1988, effective March 1, 1989.
- TRIPS, NAFTA, and other agreements also concern copyright to some degree.

The Berne Convention

- Established 1886
- Revised six times, most recently the Paris Revision in 1971
- U.S. did not join until March 1, 1989
- Requirements:
 - National treatment
 - Certain minima of protection
- Euro-centric
- Also called the “Berne Union”

National treatment

- Must treat foreign authors no worse than domestic authors
- But can treat domestic authors at a disadvantage

Minima Under Berne

- Subject-matter:
 - “every production in the literary and artistic domain whatever may be the mode or form of its expression”
 - Includes architecture
 - Includes compilations and derivatives
 - Does not include “news of the day” or facts
- Moral rights
- Preclusion of formalities
- Minimum term of life + 50, 50 for anonymous
- Allows fair use and cover-version compulsory license limitations

Delayed U.S. Acceptance of Berne

- “Back-door to Berne” for U.S. authors
 - Simultaneous publication in the U.S. and Canada
 - Many old books say they were published simultaneously in the U.S. and Canada.
- Changes to U.S. copyright law for joining:
 - Deletion of notice requirement
 - Deletion of registration requirement
- Not changed in 1989:
 - Moral rights (deemed covered by unfair competition law)
 - Architectural works
- Later changes in Berne’s spirit
 - Coverage of architectural works
 - Visual Artists Rights Act of 1990
 - Retroactive protection for foreign works then in the public domain in the U.S. (NAFTA, TRIPS)

International Aspects of Trademark

- Paris Convention
- Trademark Law Treaty
- Madrid Agreement and Madrid Protocol

Paris Convention

- Procedural
- Works for trademark registration like it does for patents
- Priority period is six months instead of one year
- U.S. is a signatory

Trademark Law Treaty

- Harmonizes and simplifies application requirements, such as filing requirements, recordation of assignments, physical dimensions of paperwork, etc.
- U.S. is a signatory

Madrid Agreement

- U.S. not a signatory
- Effectively an “international trademark”
- Registration provides automatic protection in all signatories
- Use not required
- Allows “central attack”
- U.S. objects to because of central attack availability and because American use requirement puts domestic firms at a disadvantage

Madrid Protocol

- Eliminates central-attack and use-requirement problems to ease U.S. entry into Madrid framework.
- Effective in the U.S. in November 2003.

Forms of IP Not Recognized in the U.S.

- Database protection
- Geographical indications

Geographical indications

- Not recognized in the U.S.
- Well used in Europe
- Allows a monopoly for appellations of geographic origin
- Monopoly privileges inure to a place (not a firm, as with TM)
- Examples:
 - Champagne (a.k.a. “sparkling wine”)
 - Parmesan cheese
- Might be protected in the U.S. as collective marks or certification marks, if not currently generic