

International IP

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General Principles

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

International Aspects of Patents

- “territoriality”
- Foreign filing licenses
- Paris Convention
 - national treatment
- Patent Cooperation Treaty
 - procedural
- TRIPS
 - substantive
- European Patent Convention

Foreign Filing Licenses

- To advance national security interests, the Invention Secrecy Act requires for inventions made in the U.S. a foreign filing license, issued by the USPTO, before application can be made to a foreign country.
- A U.S. patent application is deemed to include an application for a foreign filing license.
- If the USPTO denies the license, it will issue a secrecy order, in which case the inventor can seek compensation.

Paris Convention

- Convention of Paris for the Protection of Industrial Property of 1884
- 173 signatories today
 - Cf. 193 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.
- In the U.S., per § 119(a), foreign applicants get an early constructive filing date for purposes of § 102(a) (novelty) and 102(g) (interferences), but not § 102(b) (statutory bars).

Patent Cooperation Treaty

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

Filing the International Application

- First, file an “international application”
- Can file this as the first application, or secondarily, claiming priority back based on Paris Convention
- The international application is treated as if the inventor has filed in all PCT signatories

Chapter I proceedings

- Applicant receives:
- An international search report, and
- “International Preliminary Report on Patentability”
 - Non-binding preliminary examination
 - Includes determination of novelty and nonobviousness based on international principles
- Next, at applicant’s option, proceed to:
 - National stage
 - Chapter II proceedings

National stage

- Elect in which signatories applicant will pursue prosecution, and begin local prosecution
- Many countries effectively start over at this stage

Chapter II proceedings

- A chance to make amendments and engage in dialogue with examiner before obtaining a second report
- Used by those who received an unfavorable report under Chapter I
- Still non-binding

European Patent Convention

- Optional single application and prosecution process through the European Patent Office
- The European Patent Office can issue patents for all 34 European signatories
- Not a single European patent, though the phrase “European patent” is sometimes used
- A slate of patents, one for each signatory, with legal effect only in that country, under that country’s laws.
- The independence principle applies.

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
- 153 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
- 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.
- Some of the poorest countries have been given an extension until 2016 to implement pharmaceutical patent protection.
- Exclusive marketing rights (“EMRs”) allow five-year terms of patent-like protection even where implementation is delayed.
- “Mailbox rule” or pipeline protection reduces long-term benefit of delayed implementation.
- 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.

EEJ Arguments Regarding TRIPS and the Calibrating of Patent Incentives

- Assuming R&D costs are static, as markets and patent-respecting jurisdictions increase, patent term should decrease.
- As macro-economic variables become more favorable, and general global wealth increases, patent term should decrease.
- As non-obviousness thresholds are lowered, patent term should decrease.
- Certain new fields of technology (software, internet) should have lower patent terms. (Bezos argues this.)
- TRIPS locks all technical fields and all countries into 20-year patent terms. This causes economic losses.

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. With less stringent provisions, it still applies to some countries not in Berne.
- 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
- 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.

Non U.S. forms

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

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

WIPO



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**Parmesan – The King of Cheeses**

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Known as the "King of Cheeses", Parmesan, or *Parmigiano Reggiano* was first produced by Benedictine and Cistercian monks a thousand years ago. Over the centuries, it has acquired global prominence and is now a hugely popular choice for food-lovers the world over. While this popularity translates into a persistent and healthy demand, it has also resulted in *parmesan* becoming one of the most imitated agricultural products in the world. As consumers, how can we be sure that we have purchased "the real deal"? In this article, *WIPO Magazine* explores how the producers of *Parmigiano Reggiano* have acquired legal recognition that their cheese is the "one and only" Parmesan.

About Parmesan

The method of producing this hard, grainy cheese, which is cooked and not pressed, has changed little over the centuries. Cheese-makers today use the same natural ingredients as their predecessors did (raw milk, rennet and salt) and employ "the same care and craftsmanship". An iconic Italian food, *Parmigiano Reggiano* is produced in a well-defined area of northern Italy – the provinces of Parma, Reggio Emilia, and Modena and Bologna (on the left bank of the Reno River) and Mantova (on the right bank of the Po River). Many different factors determine the unique quality of *Parmigiano Reggiano* cheese – from the soils used to produce the fodder on which the cows graze to the skills used in the cheese-making process. Made from a mixture of full fat and skimmed milk, Parmesan is quickly digested and easily assimilated. Vaunted as "a miniature storehouse of concentrated" nourishment, it is rich in proteins, lipids, calcium and phosphorus and low in fat and cholesterol compared to other cheeses.

"The secret of the goodness originates in the place of origin, in the natural feed, and in the high quality milk with no additives." (Conorzio del Formaggio *Parmigiano-Reggiano*)

AN HISTORICAL PRODUCT

Literary references to Parmesan date back to the 14th century. Boccaccio's 1348 work *The Decameron* relates "... and there was a whole mountain of *Parmigiano* cheese, all finely grated, on top of which stood people who were doing nothing but making macaroni and ravioli".

An entry by British diarist, Samuel Pepys during the Great Fire of London in 1666 notes that he buried his "Parmesan cheese" to save it from the advancing fire.



Only cheeses produced according to the rules of the Production Regulation may bear the distinctive *Parmigiano Reggiano* marks. (Photo: Consorzio del Formaggio *Parmigiano-Reggiano*)