

International Intellectual Property

Introductory Unit

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Agenda

- Quick review of IP rights, which treaty goes with which right

Module 1

- Module Learning Objectives
- Upon completion of this module you will be able to (at a high, general level):
 - Distinguish the various types of IP
 - Identify which treaty goes with which right

	What's Protected (Subject Matter)	How to Obtain	Rights of Owners	Infringement Standard	Term/Duration	Remedies	Examples	Notes	Major Treaties
Trademark	The business, "custom" or goodwill of a company, as embodied in <i>distinctive</i> symbols such as words, names, symbols, sounds, colors, or product shapes.	In US, UK and other common law countries: Use/Registration hybrid system. In other jurisdictions: Registration only.	Prevent others from misappropriating goodwill by using the same or confusingly similar trademarks	Typically, likely to cause consumer to mistake the source of goods or services. In US, "likelihood of confusion."	As long as the mark remains in use and/or registration fees are paid.	Injunction usually most important. Damages or lost profits typically available.	APPLE, NIKE, MCDONALDS Nike Swish Coca Cola bottle shape		Paris; Madrid; TRIPS
Copyright	Expressive works: books and other writings, music, movies and other audiovisual works, art computer software code.	Must be an original work by the author fixed in a physical medium (i.e., tangible medium of expression). Rights exist upon creation--no registration required.	Right to reproduce, distribute, create derivative works, perform, display, or digitally stream. May also include as "neighbouring rights," anti-circumvention; prevention of bootlegging of live performance, signal theft.	Copying, distribution, display, performance without prior authorization and payment. For non-literal infringement or derivative works, substantial similarity (taking of recognizable, valuable portions)	Generally lasts for the author's lifetime plus fifty or seventy years. Corporate-authored works 95 years.	Injunctions Damages "Statutory," fixed, or pre-determined damages.	<i>Harry Potter</i> in books and film. Music, as composed and as recorded.	In US, all rights fall under "copyright." In other countries, rights are organized into "author's rights"—right to prevent copying, distribution, and derivative works; and "neighbouring rights"—right to prevent unauthorized performance etc.	Berne, TRIPS, Rome; WIPO copyright treaties

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Trade Secret	Any secret business information that provides a competitive advantage.	Must be valuable, must not be generally known and must be kept secret.	Right to prevent use and disclosure by those that improperly obtain the trade secret.	Information is obtained by illegitimate means—crime, tort, espionage, or other illicit means that owner could not prevent with commercially reasonable efforts.	As long as the information remains secret, valuable, and not generally known.	Injunctive relief most important.	Formula for Coke. McDonald's recipes. Apple product plans. Manufacturing techniques.	Protected by combination of contracts, civil laws. Some common law protection.	TRIPS
Patent	Machines, articles of manufacture, processes and compositions of matter; Plants; Product designs	Requires examination, approval, and grant from government. Must be new, useful and not obvious (i.e., an inventive step).	Right to prevent others from making, using, offering to sell or selling the invention.	Every element of the patent claims (which are in the patent grant) is present in the infringing invention. (OR an equivalent is present)	For a utility patent: twenty years from the filing date.	Injunctive relief and damages essential.	Pharmaceuticals, such as antiretroviral (anti-HIV) drugs; Technological patents, such as on various aspects of mobile phone technology.		Paris, TRIPS

	What's Protected (Subject Matter)	How to Obtain	Rights of Owners	Infringement Standard	Term/Duration	Remedies	Examples	Notes	Major Treaties
Moral rights	Author's "dignitary" or personality interests	Same as copyright.	Attribution (or non-attribution); integrity; <i>Droit de suite</i> (resale royalty)	Failure to recognize author; "distortion, mutilation or other modification of, or other derogatory action in relation to the said work, which would be prejudicial to the author's honor or reputation"	Inalienable, and often perpetual.	Injunctive relief key.		Very limited in US. VARA, 106A limits to works of fine art	Berne, TRIPS
Traditional or Indigenous Knowledge	A newly-developing right. Traditional cultural expressions such as folklore Traditional knowledge, such as herbal remedies Biological resources	TBD, but requires long-standing existence, identification with a particular group	TBD. Most likely a community right or a right administered by government to prevent others from misusing and/or to obtain payment.	TBD. Misappropriation, typically.	TBD. May be limited or perpetual.	TBD. May be injunctive, or merely compensatory.	Hoodia.	A work in progress, but an important part of international IP discussion.	Various regional protocols (e.g. Swakopmund); Working proposal in WIPO Intergovernmental Committee on TK

Quick Review

- Which type of intellectual property protects original expressions?
- Which type of intellectual property protects consumers from being confused as to the source of a product?
- Which type of intellectual property protects novel, non-obvious inventions?

Problem 1

1. Bill starts a company that monitors real-time electricity flows in the national electricity grid he sells the data to customers. His company, Friedwire (Bill likes humorous names and slogans), has built a compelling free website to market its protect with lots of interesting graphics and charts. His chief technology officer has developed a new method for “scraping” data that she considers superior to all previous methods.

Which forms of IP are **best** used to protect:

- a. The Friedwire Data
- b. The Friedwire name and slogans
- c. The contents of the Friedwire website
- d. The method for scraping data

Provide one or two sentences as to why for each one.

Module 2

- Upon completion of this module you will be able to:
 - Identify issues with cross-border application of IP laws
 - Solve very basic problems regarding choice of law, jurisdiction, and cross border enforcement
 - Explain the concepts of **territoriality** and **national treatment**

Territoriality

- Most countries apply most laws only within their own borders
 - They don't remedy wrongs like infringement that happen in another country
- They don't, in other words, apply their laws “extraterritorially”

Territoriality without Treaties

- Pre-treaties, many countries would not allow foreign nationals to sue for infringements
 - *US: no protection for British authors*
- Early treaties based on reciprocity: we'll protect your guys (in our country) the same way you protect our guys (in your country)
 - *Not very satisfactory: court has to understand foreign law*

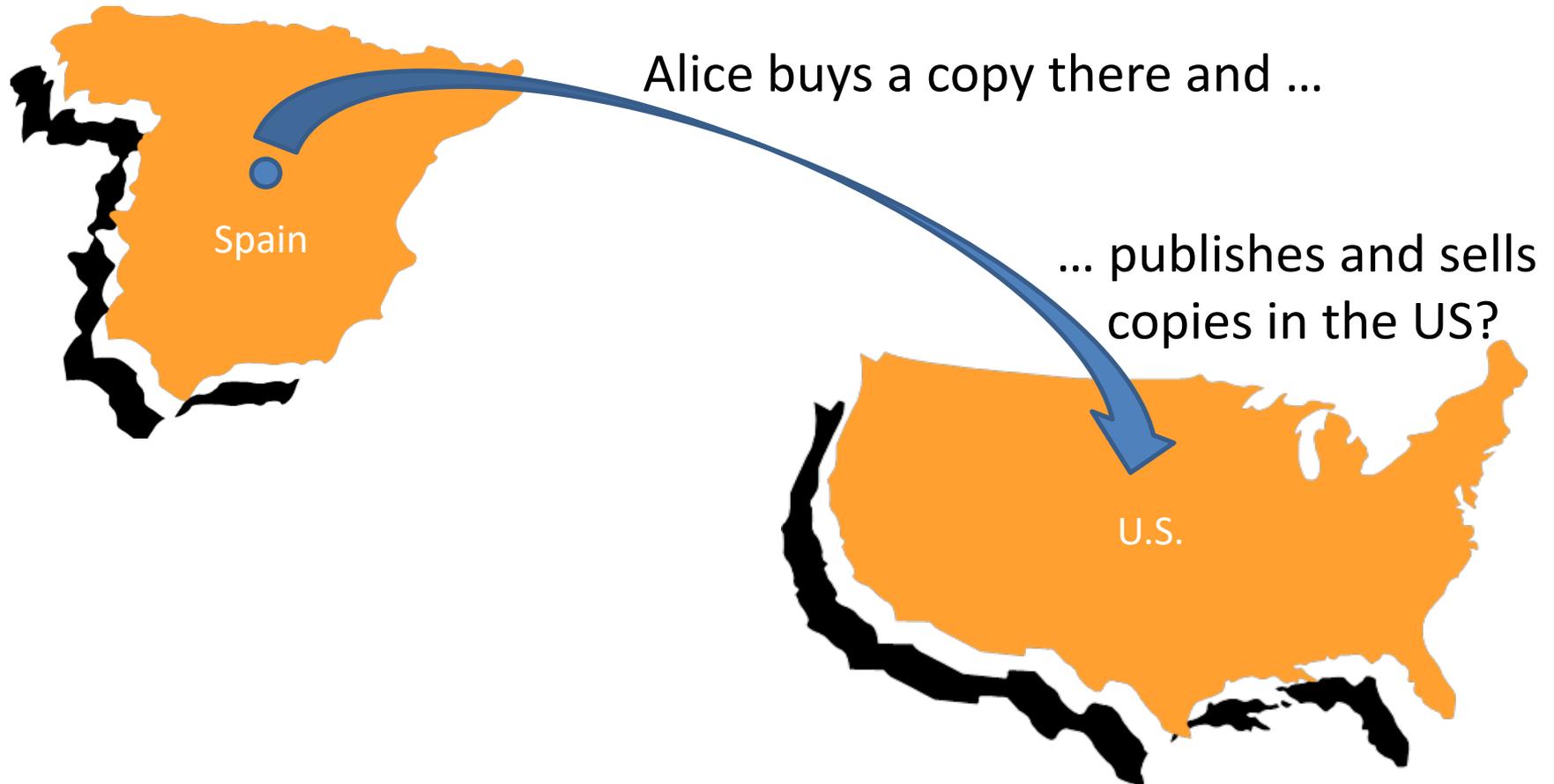
Territoriality with Treaties

- ***National treatment*** is now the basis for most IP treaties:
 - *We 'll protect your guys in our country, the same way that we protect our guys in our country*



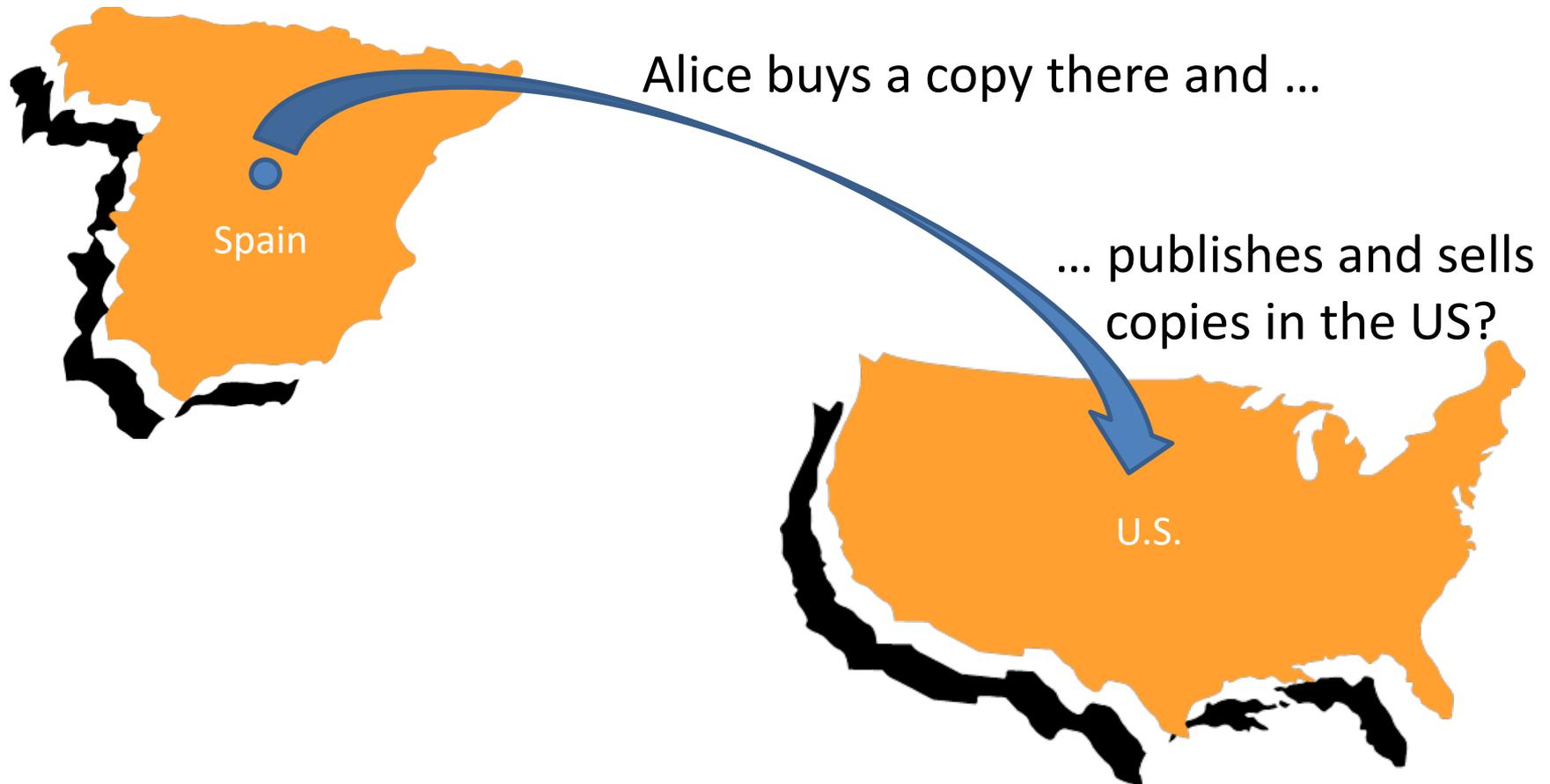
Suppose these facts:

Spanish Bob writes and publishes novel in Spain.



What if Bob sues Alice *in the US*?

Spanish Bob writes and publishes novel in Spain.





In 19th century US ...

- ... US copyright applied to US nationals
 - *British novelists (e.g., Dickens, Thackeray) were widely copied and sold cheaply in US*
- Why would US favor such a rule?
- Who would oppose such a rule?
- Why wasn't the rule the other way around?



Suppose ...

- ... US and Spain want to cooperate
- What are the two basic types of international IP agreements?
- What are the pros and cons of each?



Bob v. Alice in the US

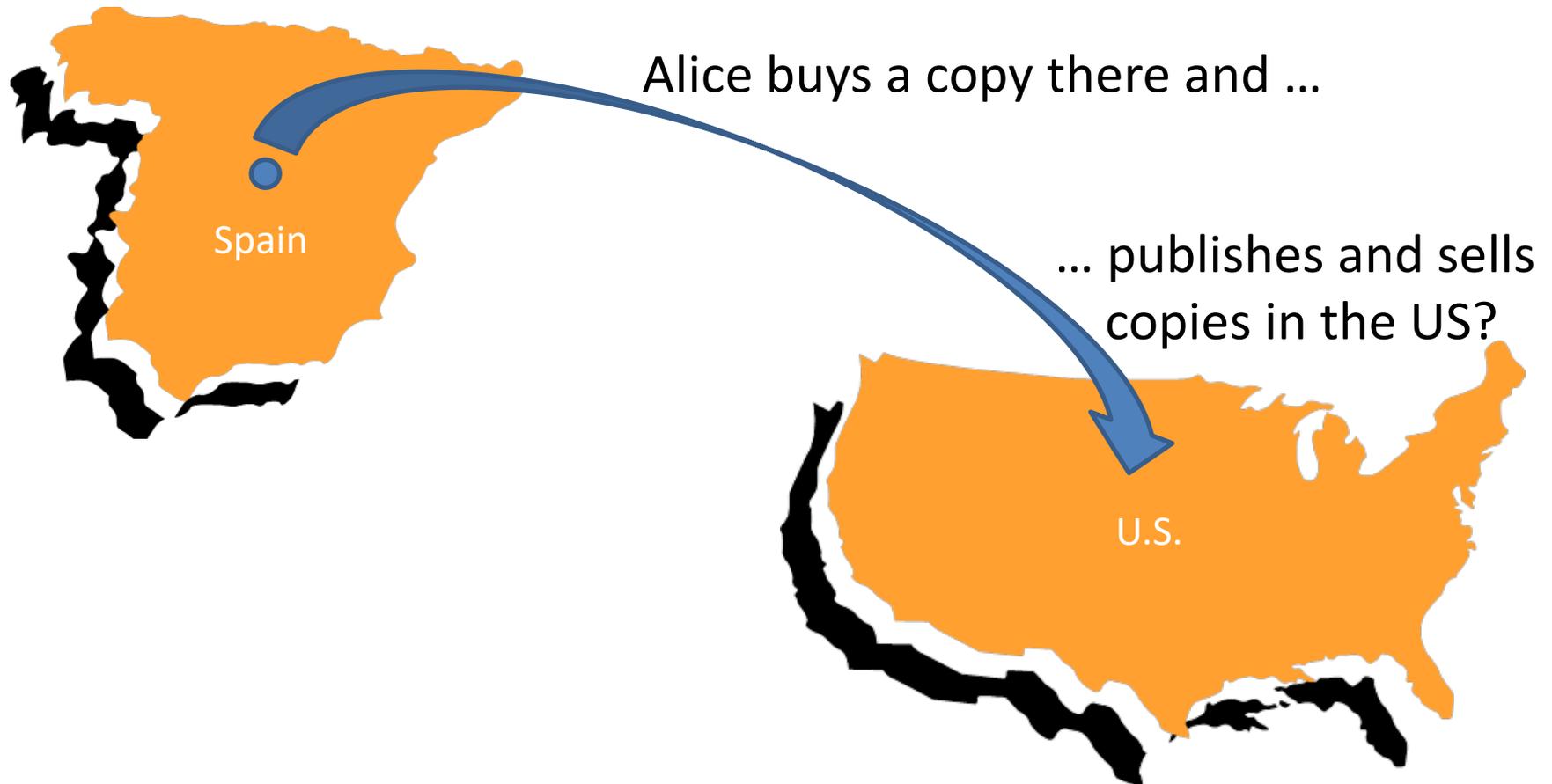
- Suppose Spain only allows injunction, but no damages.
- What remedy can Bob get:
 - Under reciprocity?
 - Under national treatment?

Today ...

- Nearly all multilateral IP agreements require ***national treatment***.
- Note: TRIPs (trade-related aspects of IP) adds “***Most Favored Nation***” requirement
- These are both different from the issue of ***extraterritoriality***

What if Bob sues Alice *in Spain*?

Spanish Bob writes and publishes novel in Spain.



Module 3

- Upon completion of this module, you will be able to:
 - Identify the major treaties that comprise the international IP system
 - Identify the subject matter of each treaty, its role in the system and basic enforcement mechanisms
 - Identify the major institutions in the international IP system (e.g., WIPO, WTO), and the role that they play
 - Describe history and rationale underlying TRIPS
 - Describe and apply principles of national treatment and MFN under TRIPS

Primary IP multi-lateral treaties

- **Paris Convention (1883)** – on “industrial property,” i.e., patents, trademarks, trade secrets
- **Berne Convention (1886)**– on copyrights
- **Madrid Agreement (1891), Madrid Protocol** – on trademarks
- **Rome Convention (1961)** – on recorded sounds (“phonograms”) and performances
- **TRIPs Agreement (1994)** – see next slide

IP treaties

- All these treaties have been amended over the years, often several times
- Lots more in existence than listed above
- Nearly all IP treaties call for both:
 - National treatment (for member nations)
 - Certain minimum levels of protection

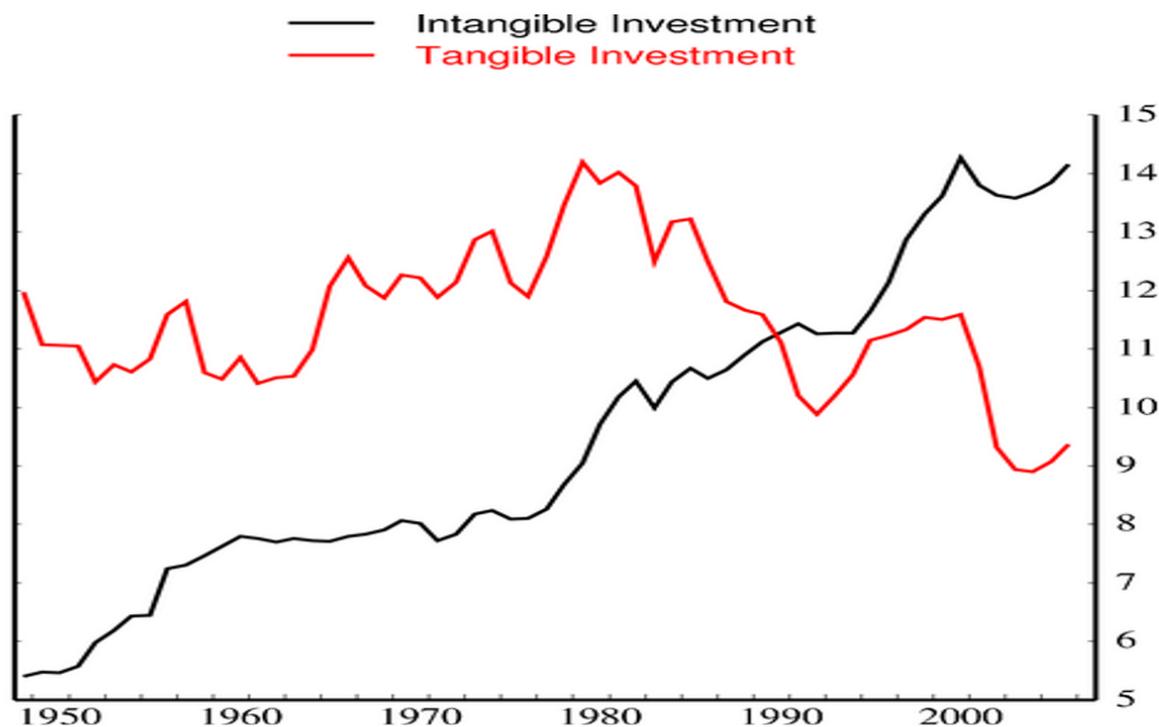


TRIPs

- “TRIPs” is major international treaty, part of international trade agreements (GATT)
 - Trade-Related aspects of Intellectual Property rights
- Covers nearly all forms of IP
- Unique among IP treaties in that:
 - Part of a larger *trade* agreement
 - Contains enforcement provisions
 - Includes “most favored nation” clause

Business investment in the US, tangible and intangible investment

(% business output)



TRIPs adds “MFN”

- Many trade agreements include a “most-favored nation” clause:
 - If member country A extends a specially favorable trade deal to member country B, then A is obliged to extend the same favorable treatment to all other member countries
- TRIPs, for the first time, includes a “MFN” clause for IP

TRIPS adds Dispute Resolution

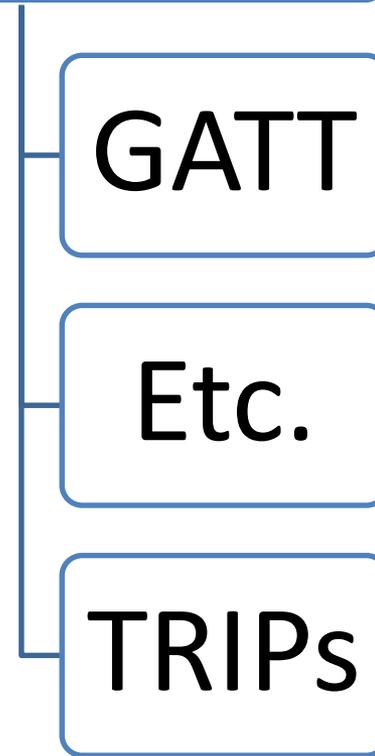
- The first international IP Agreement with “teeth”
- WTO members can bring complaint over failure to comply with WTO rules including TRIPS
- If guilty, country can retaliate

Who administers IP treaties?

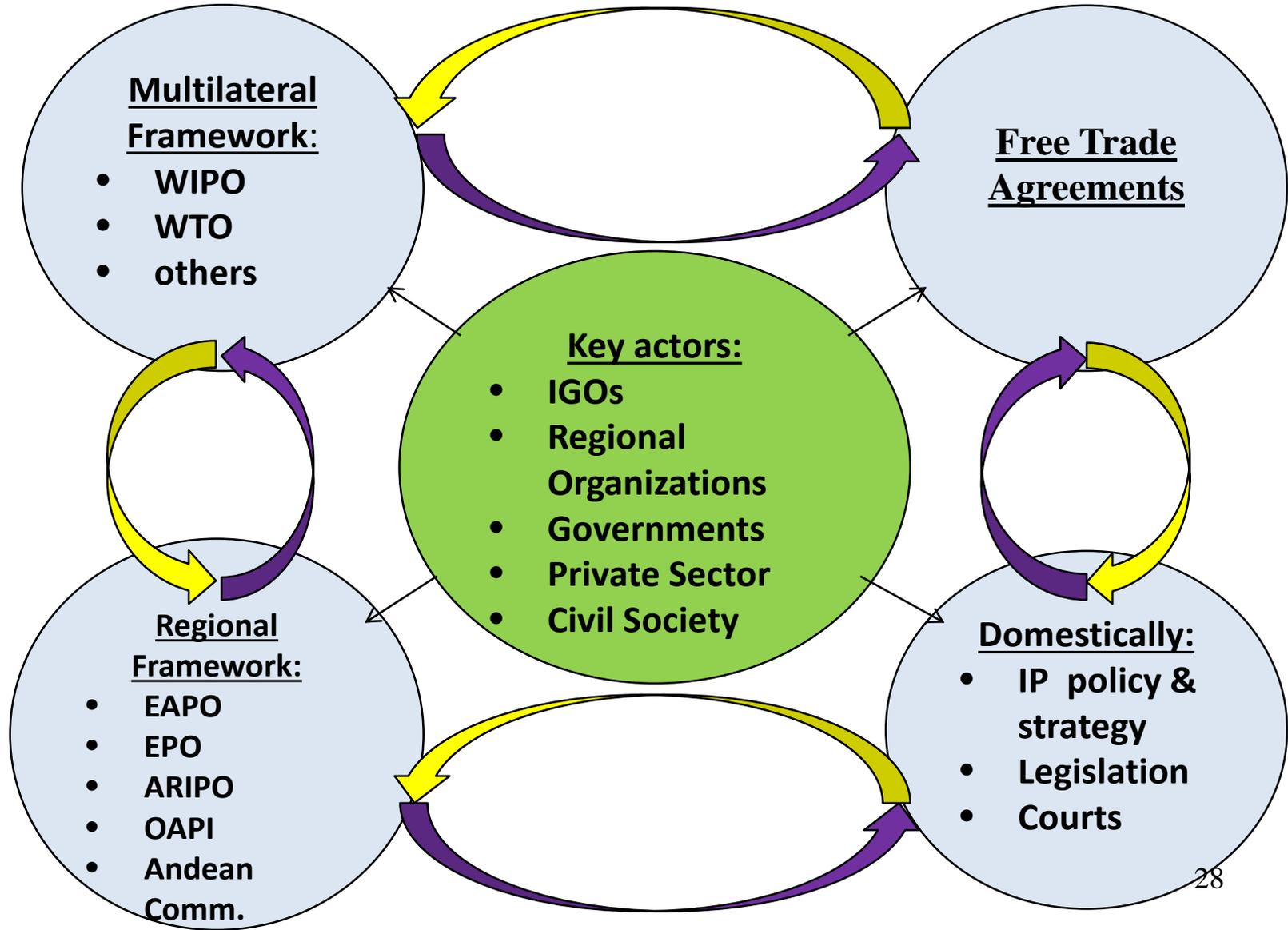
WIPO



WTO



Relevance of Different Levels and Actors



Who else in the U.N. System is involved in IP?

- WHO
- UNCTAD
- UNESCO
- UNHRC
- ITU
- Ad hoc: High Level Panel on Access to Medicines

Intensifying IGO Cooperation

- Trilateral cooperation: WHO, WIPO, WTO
- Focus on capacity building activities
- Series of joint technical symposia
- WHO/WIPO/WTO study on “Promoting Access and Medical Innovation: Intersections Between Public Health, IP and Trade”:
 - Aims at assisting decision-makers by providing information and data
 - Illustrates the need to adopt a holistic approach

Regional Frameworks

- Regional IP Organizations cooperate on a number of IP issues
- Patent Examination is one example. In some regions, countries created a regional patent office for filing, search and examination of regional patents.
 - African Intellectual Property Organization (OAPI)
 - African Regional Intellectual Property Organization (ARIPO)
 - Eurasian Patent Organization (EAPO)
 - European Patent Organisation (EPO)
 - Patent Office of the Cooperation Council for the Arab States of the Gulf (GCC Patent office)

Free Trade Agreements

- Bi-lateral
 - US
 - Australia.
 - Bahrain.
 - Chile.
 - Colombia.
 - Israel.
 - Jordan
 - EU
 - Many countries
 - IP is often a key issue (e.g., stalled negotiations with India)

Regional Trade Agreements

- European Community
- NAFTA
- TPP
- And hundreds more

TRIPS and Free Trade Agreements: TRIPS Plus

- Art.1.1 TRIPS: freedom to implement more extensive protection
- Development of standards through “TRIPS plus” elements
- Non-discrimination rules generally apply:
 - national treatment
 - MFN treatment
 - What does this imply?

TRIPs: Three levels of

- Strongest requirements for “patents, copyrights, trade secrets,” etc.
- Lesser requirements for “related” or “neighboring” rights
- No requirements for “non-IP” rights



Different National Definitions

- TRIPs member nations can define “intellectual property” differently
 - E.g., one TRIPs member might define “performances” as a “copyright right.”
 - Another TRIPs member might define performances as a “neighboring right.”
 - Another might define it as not an “IP” right.*

* Though TRIPs imposes some minimal rights for performances anyway

Public Lending Right

UK – statutory fee for libraries:
aka, “public lending right”



Germany: copyright owners
have right to control lending



Must UK give “public lending” royalties
to German nationals?

Can Germany deny “public lending”
control to British nationals?



TRIPs and MFN

- Suppose US, Germany, and Spain all allow patents on surgical methods
- Suppose US agrees to respect German patents on surgical methods
- Must the US now respect Spanish surgical patents?

Civil Society

- IP Owners
 - IFPMA
 - IFPI
 - MPA
 - IPA
 - Domestic trade organizations:
 - PhRMA
 - RIAA
 - MPAA
 - AAP

Civil Society

- NGOs
 - Oxfam
 - MSF
 - KEI
 - Public Citizen
 - Third World Network
 - ICTSD

Problem 3.1

Assume the new nation of Libertas joins TRIPS. Review each of these measures and determine whether it violates (1) TRIPS generally; (2) MFN; (3) National Treatment; (4) Both MFN and NT; (5) Neither MFN or NT; or (6) It Depends:

- a. Libertas exempts foreign Libertas style (“Tas”) music from Libertasian copyright protection.
- b. Libertas exempts all Tas style music from copyright protection.
- c. Libertas exempts foreign Tas style music from Libertasian copyright protection, EXCEPT for Jamaican Tas.
- d. Libertas grants a subsidy to Tas musicians, but only Libertasian and Jamaican Tas musicians.
- e. Libertas declares a public health emergency and grants the right to a local manufacturer to make Merleteb (which is patented)

Problem 3.2

1. Which organization administers the Berne convention?
2. Which organization administers TRIPS
3. Which other U.N. Agencies play a role in IP? Why?
4. What was the “grand bargain” underlying TRIPS?