

Advanced Introduction to

INTERNATIONAL INTELLECTUAL PROPERTY

Susy Frankel
Daniel J. Gervais



Elgar Advanced Introductions are stimulating and thoughtful introductions to major fields in the social sciences and law, expertly written by the world's leading scholars.

This authoritative introduction provides a detailed overview of the complexities of the international intellectual property regime and the ways in which it operates. The authors cover the key international institutions and agreements that regulate and inform intellectual property at an international level such as the TRIPS Agreement, WIPO, WTO, the Paris Convention and the Berne Convention. The book serves as a platform to understand and contextualize policy discussions on topics such as public health, internet regulation, as well as regional and bilateral trade treaties.

Key features include:

- Accessible and carefully summarized overview of the field
- Comprehensive and up-to-date review of all major international intellectual property institutions and instruments
- Introduces current issues within international IP negotiations
- Provides tools to analyze the history and possible future development of international IP norms.

Students, researchers, policy makers and practitioners of intellectual property will find this book to be an invaluable resource in gaining an understanding of the international rules and context in which both domestic and international IP policy issues should be understood.

Advanced Introduction to

International Intellectual Property

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1. Introduction to the course

Elgar Advanced Introductions are stimulating and thoughtful introductions to major fields in the social sciences and law, expertly written by the world's leading scholars. Designed to be accessible yet rigorous, they offer concise and lucid surveys of the substantive and policy issues associated with discrete subject areas.

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Introduction

This book is designed for students, researchers and practitioners of intellectual property (IP) interested in gaining an understanding of the international rules and the context in which domestic intellectual property policy issues must be understood. Law students and practitioners in almost any field will encounter intellectual property issues, and more often than not international rules are relevant for at least two reasons. First, they may explain the origin of a rule in domestic law, that is, meant to implement an international obligation. Second, but relatedly, international rules and their drafting history can be used to understand and interpret domestic rules. Policy makers implementing changes to their domestic intellectual property regime, often consider whether those changes are compatible with their international intellectual property obligations and draft their rules accordingly. Finally, in some countries international treaty rules will have direct application in domestic law. Hence, few businesses whether they are small or large, can operate without knowing how rules may differ in other territories to which they wish to export and with which they wish to enter into outsourcing or partnership agreements.

A structural and fundamental element of most international intellectual property instruments is the principle of national treatment, the essence of which is that courts, intellectual property offices and administrative agencies must treat foreigners no less favourably than their own nationals. To demonstrate national treatment's prevalence, the concept is provided for in three of the most important substantive instruments, namely the Paris Convention for the Protection of Industrial Property (Article 3(a)),¹ the Berne Convention for the Protection of Literary and Artistic Works

¹ WIPO, Paris Convention for the Protection of Industrial Property, 20 March 1883, 828 U.N.T.S. 305, as last revised at the Stockholm Revision Conference 14 July 1967, www.wipo.int/treaties/en/text.jsp?file_id=287556; accessed 23 March 2015 (hereinafter Paris Convention).

(Article 5),² and the Agreement on Trade-Related Aspects of Intellectual Property Rights, better known as the TRIPS Agreement (Article 3).³ We devote a section to national treatment later on.

Researchers of intellectual property in several areas frequently consider comparative differences in how IP issues are framed and solutions proposed or adopted in various countries and regions. This research often points to how the international system itself might be improved. It can also point to how national approaches to intellectual property law are often deeply embedded and framed within a national legal system and consequently such traditions are difficult to change (and it may even be undesirable to do so).

This book provides an advanced introduction to the international regime of intellectual property, which includes interpretation of international rules at the national level and examples of national laws that illustrate ways in which the international regime can be implemented. This book is written for those readers who already have some knowledge of intellectual property rules and concepts at the national and regional level, though it may also be suitable for those without such knowledge.

Our aim is to provide a thorough overview in a short book. For those wanting more detail on a particular subject, this book can be used in tandem with other books which are more detailed on specific subjects. Books dealing with only one of the many topics we cover, such as the history of the World Intellectual Property Organization (WIPO) or one of the many multilateral treaties, agreements and conventions, are often hundreds of pages long. This book provides an overview of the fundamentals of international intellectual property and the most important points in its current evolution. Where we felt it was appropriate without overwhelming the text or footnotes, we also point to sources containing more detailed information.

2 WIPO, Berne Convention for the Protection of Literary and Artistic Works, 9 September 1886, 828 U.N.T.S. 221, as last revised 24 July 1971, www.wipo.int/treaties/en/text.jsp?file_id=283698, accessed 23 March 2015 (hereinafter Berne Convention).

3 WTO, Agreement Establishing the World Trade Organization, Annex 1C: Agreement on Trade-Related Aspects of Intellectual Property Rights, 15 April 1994, 1869 U.N.T.S. 299, at www.wto.org/english/docs_e/legal_e/27-trips_01_e.htm, accessed 23 March 2015 (hereinafter TRIPS Agreement). As will become apparent below, this Agreement is more significant because of its scope and its enforceability.

This Advanced Introduction examines the principal intellectual property instruments, their history and context, as well as the main institutions that administer them.⁴

The functions of international intellectual property agreements vary from agreement to agreement; however, each one seeks to promote norms that can be grouped into three categories:

- (1) Setting minimum standards of protection that must be adhered to in each member state. We refer to those as substantive instruments.
- (2) Setting up a framework to enable the creation of an intellectual property right in one member state to result in, or assist in, creation of an intellectual property right in another member state – in other words, harmonizing the descriptions of goods and services for purposes of registration. We refer to those as classification instruments.
- (3) Easing the process by which a right holder may apply to register his or her intellectual property right (where registration is required) by creating multilateral registration mechanisms and authorities. We refer to those as procedural instruments.

Before moving on, we should clarify a small but important terminological matter. Countries party to the Berne and Paris Conventions are members of the Berne and Paris Unions, respectively. Those Unions have their own procedural rules, and each one has its own Assembly. By contrast, no country can ratify or adhere to the TRIPS Agreement.⁵ Any *member* of the World Trade Organization (WTO) is bound by TRIPS as Annex 1C of the Agreement Establishing the World Trade Organization.⁶ No reservations are permitted. Not all WTO members are countries. Some are trade territories (such as Macao); others are intergovernmental organizations (such as the European Union).

4 We use the term “instrument” in this book in a generic sense that encompasses international treaties and conventions, international and regional agreements and intellectual property chapters or parts of broader international treaties and arrangements.

5 Ratification follows the signature of an international instrument; adhesion happens when a country that has not signed an instrument accepts to be bound by it. Signature without ratification is not devoid of legal effect in public international law but that discussion is beyond the scope of this book.

6 The WTO Agreement and its various annexes were part of the Uruguay Round package, which ended the Uruguay Round of Multilateral Trade Negotiations. See Section [2.2.1].

This book is divided into five chapters. We first describe the role of the two major multilateral institutions of intellectual property (Chapter 1). Chapter 2 outlines the major instruments of international intellectual property. In Chapter 3 we explain some key and fundamental concepts and features of international intellectual property. In Chapter 4 we provide a sector by sector (copyright, patents, trademarks, etc.) analysis of current norms. Finally, in Chapter 5 we provide analysis of a number of evolving issues in international intellectual property, which can also be used, in a teaching context, as discussion and review topics.

1 The institutions and actors of international intellectual property

The two main multilateral intergovernmental institutions in the field of intellectual property at the multilateral level are WIPO and the WTO. A number of other intergovernmental institutions are also active in the field, including the United Nations Educational, Scientific and Cultural Organization (UNESCO) on matters such as cultural heritage and education; the World Health Organization (WHO) on matters concerning pharmaceutical and medical research and access to medicines; the International Labour Office (ILO) on matters concerning the rights of performing artists; and the secretariat of the Convention on Biological Diversity (CBD) and its Nagoya Protocol on matters relating to uses of biological and genetic resources and the protection of related traditional knowledge.

A number of non-governmental organizations (NGOs) are also extremely active at the international level.⁷ They include organizations representing “right holders” such as pharmaceutical companies, entertainment conglomerates, and luxury brand owners, but also small inventors, songwriters, film makers, actors and performing artists. Some represent indigenous communities that have an interest in protecting their indigenous cultural and medicinal heritage. Even within an industry, not everyone may have similar interests. For example, the software industry includes companies seeking high levels of protection of intellectual property, while others have business models that rely on “open source” software or the possibility of using material created by others. Within the pharmaceutical industry, the companies that spend some part of their profits on research and drug development

⁷ A list of international NGOs accredited at WIPO is at WIPO, “Accredited Observers, International Non-Governmental Organizations”, www.wipo.int/members/en/organizations.jsp?type=NGO_INT, accessed 22 April 2015. As of March 2015, there were 252 such organizations (in addition, 74 national NGOs are also WIPO-accredited). Many of these are authors’ or intellectual property owner organizations. Unlike WIPO, the WTO has been reluctant to admit NGOs to participate in its meetings.

do not always see “eye-to-eye” with those that produce generic drugs (drugs that are not or no longer protected by a patent). Other NGOs represent users of intellectual property mostly or entirely generated by others. They may be consumer groups, Internet-based enterprises, such as search engines or cloud services, and organizations defending access to culture, science and medicines.

1.1 The World Intellectual Property Organization (WIPO)

To address the concern that different countries did not provide similar (and in some cases any effective) levels of intellectual property protection (in particular of foreign intellectual property) and consequently that inventions, copyright works and other forms of intellectual property could be replicated in other countries without payment or attribution, the organization that would become WIPO was established in the late nineteenth century.⁸ Known as the United International Bureau for the Protection of Intellectual Property (or, under the French acronym, BIRPI),⁹ it would serve as the administrative structure on which WIPO was founded in 1968. BIRPI “united” the International Bureau established by the Paris Convention in 1883 and the Bureau established by the Berne Convention three years later. BIRPI, unlike WIPO, was not part of the United Nations. In fact, it was operating under the supervision of the Swiss government.

Why was BIRPI created in the 1880s? At the time, international trade was still in its infancy and limited mostly to raw and primary goods and materials. Increasingly, however, it was starting to involve machinery, books and various trademarked goods. Many creators and owners of intellectual property felt that greater international exposure meant a greater likelihood that people in other countries would

⁸ See WIPO, *WIPO – A Brief History*, at www.wipo.int/about-wipo/en/history.html, accessed 23 March 2015.

⁹ WIPO describes its predecessor, the United International Bureau for the Protection of Intellectual Property (best known by its French acronym BIRPI) usefully on its website, www.wipo.int/treaties/en/general/, accessed 5 October 2015, as thus: “Based in Berne, Switzerland, with a staff of seven, this small organization was the predecessor of the World Intellectual Property Organization of today – a dynamic entity with 188 member States, a staff that now numbers some 938, from 95 countries around the world, and with a mission and a mandate that are constantly growing.” The BIRPI acronym above (the predecessor organization of WIPO) includes the word “united” because it administered both industrial property and authors’ rights.

use their intellectual property without their consent.¹⁰ The need for international protection of intellectual property became evident in particular when foreign exhibitors refused to attend the International Exhibition of Inventions in Vienna in 1873 because they feared their ideas and inventions would be stolen and commercially exploited elsewhere.

It would be accurate – if perhaps overly simplistic – to say that the Paris Convention's birth in 1883 can be attributed to these large international fairs to which countries brought their most advanced machines and inventions, including the famous Paris Fair of 1900, which had previously led to the construction of the Eiffel Tower. In fact, as we will see below, the Paris Convention still contains a number of provisions that seem much more relevant in a world of international trade in physical goods, including goods travelling by sea. The Paris Convention deals with what was then referred to as *industrial property*, namely trademarks, patents, industrial designs and confidential information.

At around the same time, a philosophical movement born in the wake of the Enlightenment led (in countries such as France and Germany) to the recognition of a special role for authors of “works of the mind”. What we might today call the creative class rose to prominence. The special nature of their contribution and the special place of books, music, painting (and later film etc.) led to adoption of laws protecting authors' rights. In 1886, after a major campaign led by a well-known French author Victor Hugo – whose works still find audiences (*Les Misérables* comes to mind) – a second major international convention emerged in the capital of Switzerland, Berne. It was what we now call the Berne Convention.

BIRPI organized a number of revision conferences to update the two main instruments it administered, namely the Paris and Berne Conventions, as well as a number of procedural and classification instruments. At the last such conference, held in Stockholm (Sweden) in 1967, the Agreement Establishing WIPO was signed. That Agreement went into effect in 1970 and the new organization, WIPO, took over from BIRPI. Still today, the WIPO secretariat is referred

¹⁰ The drafting history of the TRIPS Agreement (see Section [2.2.1]) shows that the Agreement was reached because of the concerns, primarily of developed countries, that trade increased the likelihood of counterfeiting of intellectual property products.

to in a number of official documents as the “International Bureau”, reflecting its BIRPI heritage. WIPO, as the organization administering the Berne and Paris Conventions, organizes the meetings of the Berne and Paris Union Assemblies, as well as its own General Assembly, usually all held together in September of each year as the WIPO Governing Bodies meetings. In 1974, WIPO became one of 16 specialized agencies of the United Nations.¹¹

In the late 1970s and all during the 1980s, 1990s and 2000s, WIPO was active on several fronts. A significant increase in membership arose through countries becoming members of WIPO (by adhering to the Convention establishing WIPO) and often of the Paris and/or Berne Conventions as well. As of November 2015, WIPO had 188 member countries, while 168 and 176 countries had adhered to the Berne and Paris Conventions, respectively. This great increase in membership led to a major increase in technical assistance to developing and other countries wishing to develop their intellectual property laws and administration. WIPO was also active on other fronts, helping to negotiate major treaties to facilitate international applications for trademarks, patents and other rights, including the 1970 Patent Cooperation Treaty and the Madrid system, renewed in 1989 and allowing trademark applicants to protect their rights through registration in several countries and territories. We discuss these in greater detail later on.

Since 1994 WIPO has adjusted to an environment where the trade aspects of intellectual property have been negotiated under the auspices of another international organization. In April 1994, after seven years of official negotiations, the Agreement Establishing the WTO was concluded in Marrakesh, Morocco. The TRIPS Agreement was Annex 1C of the WTO Agreement. The TRIPS Agreement incorporates most of the substantive norms of the Paris and Berne Conventions, adds or modifies some of those norms and subjects the package (that is, pre-existing Paris and Berne Convention norms and new TRIPS norms) to the WTO Dispute Settlement System.

Since 1994, there has been relatively little effective norm development work in the field of intellectual property at the WTO. An amendment

11 Agreement between WIPO and the United Nations, signed on 21 January 1975, entered into force on 17 December 1974. Other specialized agencies at the time included the above-mentioned ILO and WHO, but also, for example, the Food and Agriculture Organization (FAO) and the International Telecommunications Union (ITU).

to the TRIPS Agreement was adopted in 2006 to permit export of pharmaceutical products to least developed countries under a compulsory licensing regime. Work on a possible register for geographical indications (GIs) was also undertaken, as were studies on possible changes to the patent system to reflect the origin or ownership of genetic material used in certain inventions. We return to these matters later on.

Since the formation of the WTO, by contrast, WIPO has hosted ongoing discussions about harmonization of patent and trademark law. It has finalized treaties in relation to digital copyright and performers' rights (1996), the protection of audio-visual performers (2012) and exceptions to copyright for the visually impaired (2013). WIPO has also established an ongoing programme of international negotiations on the protection of traditional knowledge, genetic resources and traditional cultural expressions, and a "development agenda" focusing mostly on how best to adapt the international intellectual property regime to the needs of developing nations.

WIPO has an agreement with the WTO to "mutually support" each other on intellectual property matters.¹² This support is evident in dispute settlement where the WTO formally consults WIPO regarding intellectual property norms.¹³ It is also significant that parts of WIPO's treaties are incorporated into the intellectual property agreement that the WTO administers: the TRIPS Agreement¹⁴ discussed below.

1.2 The World Trade Organization (WTO)

1.2.1 Establishment of the WTO

The Uruguay Round of Multilateral Trade Negotiations started in a convention centre overlooking the beaches of Punta del Este, Uruguay in 1986. The discussions were held under the auspices of the General Agreement on Tariffs and Trade (GATT), which is effectively the predecessor of the WTO.¹⁵ As a result of the Uruguay Round, the

¹² WTO-WIPO Co-operation Agreement, World Trade Organization, Geneva 22 December 1995; see "Approval of Agreements with Intergovernmental Organizations", World Intellectual Property Organization (WIPO); www.wipo.int/edocs/mdocs/govbody/en/wo_cc_48/wo_cc_48_2.doc, accessed 30 March 2015.

¹³ We discuss this further in Section [3.2] Principles of Treaty Interpretation.

¹⁴ TRIPS Agreement, Articles 2 and 9 (i).

¹⁵ General Agreement on Tariffs and Trade (1947) 55 U.N.T.S. 194 (hereinafter GATT). The GATT was a legal instrument, not an intergovernmental organization as such. It was, however,