



# 2024 AIPPI World Congress

Hangzhou

19-22 October 2024

# AIPPI Resolutions



## About AIPPI

The International Association for the Protection of Intellectual Property, known as AIPPI (Association Internationale pour la Protection de la Propriété Intellectuelle), is the world's leading non-profit association dedicated to the development and improvement of laws for the protection of intellectual property. It is a politically neutral, non-profit organisation, based in Switzerland with over 8000 members worldwide from 110 countries.



2024 AIPPI World Congress – Hangzhou  
Adopted Resolutions  
19–22 October 2024

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## Study Question – Patents

### Harmonisation of disclosure requirements and consequences of non-compliance

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#### **Background:**

- 1) This Resolution concerns the harmonisation of disclosure requirements and consequences of non-compliance.
- 2) The laws of some jurisdictions require patent applicants to disclose Prior Art to the Patent Office, such as prior art that might be viewed as relevant to the assessment of the novelty and/or inventive step of a patent's claims. On the one hand, such an obligation increases the work involved in and therefore also, the costs of filing patent applications. On the other hand, such an obligation can serve the efficiency of the system because it provides for a more effective patent application examination if the Patent Office has the opportunity to consider and evaluate more information relevant or potentially relevant to patentability.
- 3) This Resolution determines if, and to what extent, a Disclosure Requirement should be mandated during the prosecution of a patent application and after the patent is granted, and what sanctions should apply for non-compliance with such obligations.
- 4) 40 Reports were received from AIPPI's National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General Team of AIPPI and distilled into a Summary Report (which can be found at [www.aippi.org](http://www.aippi.org)).
- 5) At the AIPPI World Congress in Hangzhou in 2024, the subject matter of this Resolution was further discussed within a dedicated Study Committee, and again in a full Plenary Session, following which the present Resolution was adopted by the Executive Committee of AIPPI.
- 6) This Resolution does not address any special disclosure issues related to genetic resources/traditional knowledge (GRTK), which are outside the scope of the Resolution.

#### **AIPPI resolves that:**

- 1) Harmonisation of Disclosure Requirements is desirable.
- 2) The term "Disclosure Requirement" as used herein means, "a requirement to disclose Prior Art to the Patent Office". The term "Prior Art" as used herein means, "all information which has been made available to the public anywhere in the world in any form before the filing date or, where applicable, the priority date".

- 3) There should be no requirement for the applicant, or any other person involved with the preparation or prosecution of the patent application, to disclose any Prior Art to the Patent Office.
- 4) There shall be no requirement for the applicant to search for Prior Art.
- 5) Notwithstanding paragraph 3 above, if the National Law provides for a Disclosure Requirement, the Disclosure Requirement should be limited to Prior Art cited by Patent Offices for the same invention and applied only upon request by the Patent Office.
- 6) AIPPI recommends that all Patent Offices share information on Prior Art by way of a common, publicly accessible database or common portal to such database (e.g., Global Dossier or Common Citation Document - CCD).
- 7) Notwithstanding paragraph 3 above, if the National Law provides for a Disclosure Requirement, the submission of the Prior Art documents alone should satisfy the Disclosure Requirement, without the need for any analysis or reference to specific parts thereof. In proceedings before a Patent Office, submission of such Prior Art document that can easily be retrieved by that Patent Office should not be required.
- 8) Any Prior Art information communicated to a Patent Office in writing should be made available to the public once the patent application is made available to the public.
- 9) Submitting Prior Art under the Disclosure Requirement should not be taken as any kind of an admission regarding the relevance of that Prior Art to any of the claims of the patent or patent application in any proceeding.
- 10) Further to paragraph 5 above, and notwithstanding paragraph 3 above, if a jurisdiction has a Disclosure Requirement in their National Law and it is discovered at any time after patent grant that there has been an intentional failure to comply with the Disclosure Requirement, the relevant administrative or judicial body should have the authority to partially revoke the patent on that ground, but only to the extent that the undisclosed Prior Art is detrimental to the validity of the subject matter of one or more claims of the patent.
- 11) AIPPI recommends further study of special disclosure requirements relating to GRTK in view of the Disclosure Requirement.

## Study Question – Trade Marks

### Conflicts between composite trade marks including non-distinctive elements

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#### **Background:**

- 1) This Resolution concerns what factors should be considered by courts, tribunals or IP offices in assessing similarity and likelihood of confusion between trade marks when one or both are composite trade marks including non-distinctive elements, and what role should these non-distinctive elements play in the assessment.
- 2) The subject of non-distinctive elements as constituent parts of trade marks and their impact in assessing trade mark similarity and likelihood of confusion, or asserting exclusive rights over a trade mark, was partially addressed in previous AIPPI Resolutions, such as Q127 “Evaluation of Confusion in Trademark Law” (1995) and “Limitations of Trademark Rights” (2007). At the AIPPI World Congress in 2022, a panel session entitled “How different is different?” dealt with the issue of composite trade marks and evaluation of their similarity and risk of confusion.
- 3) Determining similarities and likelihood of confusion between allegedly conflicting trade marks is a key issue in trade mark prosecution and enforcement. Since assessment of similarity is more difficult when one or both of the marks in conflict are composite, and even more challenging if non-distinctive elements are involved, and insofar as the previous work of AIPPI has not covered the principles, factors or circumstances which may be relevant to this issue, more extensive study and this Resolution are justified.
- 4) 41 Reports were received from AIPPI’s National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General Team of AIPPI and distilled into a Summary Report (which can be found at [www.aippi.org](http://www.aippi.org)).
- 5) At the AIPPI World Congress in Hangzhou in 2024, the subject matter of this Resolution was further discussed within a dedicated Study Committee, and again in a full Plenary Session, following which the present Resolution was adopted by the Executive Committee of AIPPI.

#### **AIPPI resolves that:**

- 1) Assessment of similarity and likelihood of confusion between trade marks, when at least one of them is a composite trade mark that includes at least one non-distinctive element, should be made on a case by case basis.

- 2) In assessing similarity and likelihood of confusion between such trade marks, the overall impression of the composite trade mark (the “Anti-Dissection” Rule) should be considered taking into account the dominant element of either trade mark (the “Dominant Element” Rule), along with the distinctiveness of the element(s) and any other factors or circumstances relevant to the specific case.
- 3) A non-distinctive element of a composite trade mark should not, as a general rule, be disregarded completely when assessing similarity and likelihood of confusion, though said non-distinctive element would typically be given less weight in the assessment.
- 4) Those factors or circumstances referred to in paragraph 2) of this Resolution include, but are not limited to:
  - a. the structure of the composite trade mark(s), in particular:
    - i. whether the distinctive and the non-distinctive elements would be regarded by the relevant public as severable;
    - ii. the relative comparative size of those elements;
    - iii. the distance and/or ratio between them;
  - b. the perception of the relevant public;
  - c. the history and use status of the earlier trade mark;
  - d. the degree of sophistication of the relevant public;
  - e. the practices and conventions relating to the use of trade marks in the relevant field;
  - f. the nature of the non-distinctive elements within the composite trade mark(s);
  - g. the nature and characteristics of the relevant goods or services;
  - h. the industry/field of the concerned trade marks.
- 5) The approach referred to in paragraphs 1) to 4) of this Resolution should apply to both trade mark registration and infringement procedures when assessing similarity and likelihood of confusion between the allegedly conflicting trade marks.

## **Study Question – Copyright**

### Defence of parody in copyright

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#### **Background:**

- 1) This Resolution concerns whether third parties may without permission from the author or rights holder of an underlying work, use such copyrighted work to create a “parody”, without being liable for infringement and under which conditions.
- 2) This Resolution strives to find harmonised principles for the defence of parody, but intentionally does not define parody and may apply to related genres and defences, such as satire, caricature and pastiche.
- 3) This Resolution is limited to civil (private) law issues of copyrights. This Resolution does not address international private law issues.
- 4) 43 Reports were received from AIPPI’s National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General Team of AIPPI and distilled into a Summary Report (which can be found at [www.aippi.org](http://www.aippi.org)).
- 5) At the AIPPI World Congress in Hangzhou in 2024, the subject matter of this Resolution was further discussed within a dedicated Study Committee, and again in a full Plenary Session, following which the present Resolution was adopted by the Executive Committee of AIPPI.

#### **AIPPI resolves that:**

- 1) Under the conditions set out in this Resolution, in claims for copyright infringement, parody should be recognised as an exception, defence, or limitation.
- 2) Parody is a form of freedom of expression.
- 3) In claims for copyright infringement, parody, as an exception, defence, or limitation should be available in relation to all types of works.
- 4) Parody, as an exception, defence, or limitation to copyright:
  - i. must be recognisably different from the underlying work used in the parody.
  - ii. must include an element of humour or mockery or critique of the underlying work, on its author or on something else.
  - iii. must satisfy the three-step test reflected in Article 9(2) of the Berne Convention which is also embedded in TRIPS Agreement (Article 13) and which has also been incorporated to Article 10 of the WIPO Copyright Treaty (WCT).



- iv. need not satisfy the minimum level of originality requirements for copyright protection.
  - v. need not acknowledge the copyright holder or author of the work used in the parody (no attribution requirement).
  - vi. does not require either permission from or remuneration to the rightsholder of the underlying work used in the parody.
  - vii. must not mislead the public as to its nature or its author
- 5) Commercial exploitation of a parody should not be precluded per se.
  - 6) The existence of a moral right of the author of the underlying work used in the parody shall not in itself be sufficient to prevent the application of the parody exception, defence or limitation.
  - 7) Notwithstanding point 6, parody cannot justify the distortion, mutilation, or other permanent modification of an original work if it exists only in one physical embodiment.
  - 8) A parody must be assessed objectively and the intent of the creator shall not be decisive in determining whether a parody should be recognised as a parody for the purposes of providing an exception, defence or limitation in the context of a claim for copyright infringement.

## Study Question – General

# Unjustified Allegations of Infringement of Intellectual Property (“IP”) Rights

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### Background:

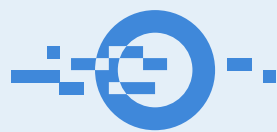
- 1) This Resolution concerns unjustified allegations of IP infringement, in particular (a) the kind of activities that constitute unjustified allegations of IP infringement, and (b) the consequences of making such unjustified allegations of IP infringement.
- 2) In this resolution “unjustified allegations of IP infringement” refer to infringement allegations that exceed the boundaries for the legitimate exercise of an IP holder’s right.
- 3) Given the cross-border nature of IP infringement and the cross-border reach of allegations of IP infringement, a harmonised framework on the issues of unjustified allegations of IP infringement is desirable. Such a framework would benefit both IP right holders and parties who are subject to allegations of IP infringement by providing consistency, certainty, and predictability in assessing the legitimacy of such allegations.
- 4) This Resolution does not address the interaction of competition or anti-trust law with allegations of IP infringement and whether the exercise of an IP right could be barred due to its exercise being anti-competitive. This Resolution also does not address issues relating to general good business practices, marketing law, compulsory licensing, and abuse of the IP registration system itself (such as potentially abusive utility models and trade mark registrations, and repetitive divisional patent applications).
- 5) 37 Reports were received from AIPPI’s National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General Team of AIPPI and distilled into a Summary Report (which can be found at [www.aippi.org](http://www.aippi.org)).
- 6) At the AIPPI World Congress in Hangzhou in 2024, the subject matter of this Resolution was further discussed within a dedicated Study Committee and again in a full Plenary Session, following which the present Resolution was adopted by the Executive Committee of AIPPI.

### AIPPI resolves that:

- 1) The laws on unjustified allegations of IP infringement should be harmonised to provide a clear and consistent framework across jurisdictions for the relevant parties.
- 2) The determination of whether an allegation of IP infringement is unjustified should be a fact-sensitive approach that assesses a combination of objective and subjective criteria. The factors which should be taken into account include, without limitation:

- a. whether the allegation was made with a reasonable basis (i.e., that a reasonable person in the position of the party making the allegation would have formed the belief that there was infringement);
  - b. the motivation of the party who made the allegation, in particular whether the allegation was made with malicious intent or bad faith; and
  - c. the knowledge of the party who made the allegation, in particular whether said party had knowledge of (i) validity destroying circumstances or (ii) circumstances leading to non-infringement.
- 3) The mere fact that an allegation of IP infringement is later proved incorrect, either because of invalidity or non-infringement, does not in itself conclusively warrant a finding that said allegation was unjustified. However, at least the following should be considered as unjustified allegations of IP infringement:
- a. Making an allegation of IP infringement while having actual knowledge of validity destroying circumstances;
  - b. Making an allegation of IP infringement while having actual knowledge of circumstances leading to non-infringement;
  - c. Making an allegation of IP infringement when the IP right does not in fact exist; and
  - d. Making an allegation of IP infringement aiming to obtain an injunction against an alleged further infringement when the invoked IP right has expired.
- 4) The mere fact that an allegation of IP infringement is later proved to be founded (e.g., by a decision on the merits), does not in itself conclusively warrant a finding that the allegation of IP infringement was justified.
- 5) The following should not categorically result in a finding that an allegation of IP infringement is unjustified:
- a. Making an allegation of IP infringement when the party making the allegation knew or should have known that the infringement claim had a low likelihood of succeeding;
  - b. Making an allegation of IP infringement before the IP right has been granted provided that such communications does not assert the IP right as granted; and
  - c. Making an allegation of IP infringement when settlement negotiations or other dispute resolution processes are ongoing.
- 6) Any communication that can reasonably be understood by the person against whom the allegation of IP infringement is made as a threat of infringement proceedings, whether it is an express or implied threat, can constitute an unjustified allegation of IP infringement, subject to Paragraphs 3), 4) and 5). However, a mere notification of the existence of an IP right should not be deemed to constitute a threat of infringement proceedings.

- 7) National or regional laws should strive to provide greater clarity on what does or does not amount to a threat of infringement proceedings to enable parties to communicate without apprehension of incurring potential liability for unjustified allegations of IP infringement.
- 8) Any party, whether such party is the actual IP right holder or any other party (such as a non-exclusive licensee, exclusive licensee, group company, and/or other third party), who makes an allegation of IP infringement shall be liable if the allegation is found to be unjustified. Advocates, solicitors, and other IP or legal professionals acting in their professional capacity, and in accordance with applicable professional rules of conduct, on behalf of their clients shall not be personally liable for making unjustified allegations of IP infringement.
- 9) Proceedings for relief in respect of an unjustified allegation of IP infringement may be brought by the party to whom the allegation of IP infringement was made and/or by any other party whose interests have been, or might be, affected by the allegation.
- 10) When an allegation of infringement of an IP right has been determined to be unjustified, one or more of the following remedies, if applicable, should be available against the party who made the unjustified allegation:
  - a. Declaratory judgment that the allegation of IP infringement is unjustified;
  - b. Injunction;
  - c. Damages;
  - d. Fines;
  - e. Punitive damages;
  - f. Publication of the judgment;
  - g. Publication of correction;
  - h. Removal of the allegation; and/or
  - i. Reimbursement of court and legal costs.
- 11) The burden of proof in cases of unjustified allegations of IP infringement lies with the party who claims that an allegation is unjustified.



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