EDITORIAL

From the last Newsletter edition you know that we had to decide to move the EXCO Meeting 2003 from Seoul, Korea, to Lucerne, Switzerland. At that time we were still confident to be able to hold the 3rd AIPPI Forum as planned in Seoul. Unfortunately we had to realise that this is not possible. On June 6, 2003, the President of the Korean National Group of AIPPI, Mr. Yoon Bae Kim, informed us as follows:

"After consultation with friends and colleagues in neighboring countries, as well as those in Europe and North America it would appear that a combination of the SARS virus, the North Korea nuclear issue and the continued threat of terrorist acts are making people reluctant to travel to this region and especially to Korea. Taking this into consideration, the Forum organizing committee, along with representatives of the Korean Group of AIPPI, made the unanimous decision that the Forum cannot be held in Korea at this time. In the light of this, it was felt there was no choice but to make the difficult decision not to go ahead with the Forum in Korea at this time. Please be assured that this is a huge disappointment to us and that this decision was not made lightly, but after much heartfelt discussion and consideration of the best interests of the AIPPI and its Members."

The Bureau was in full agreement and congratulates the Korean National Group on their wise decision. The risk of an unsuccessful Forum and possible negative financial impacts was simply too high. On behalf of the Bureau of AIPPI I wish to extend our sincere gratitude for the good co-operation and the enormous amount of work the Koreans have spent in order to make the EXCO and Forum a success.

While we are still working towards the EXCO Meeting in Lucerne, October 2003, the preparations for the Geneva Congress 2004 are reaching their final steps. The Swiss National Group and the Organising Committee have made a fantastic job to offer an attractive but also affordable Congress. The shorter format of the Congress and other saving methods will enable all Members to attend the Meeting. The invitations for the Congress will be sent by October/November this year and I encourage all of you to consider participation. In order to give you an overview of the programme, you will find an article by the Chairman of the Programme Committee, presenting the themes which will be discussed in Geneva.

As always, you will find different Reports on representations and visits to National Groups in this Newsletter. I hope you enjoy the Summaries on the different topics and if you want to know more about a specific topic, please check our Website: www.aippi.org.

Vincenzo M. Pedrazzini
Secretary General
The Executive Committee of AIPPI is the governing body of the Association. It is a Council of Delegates and the principal decision-making body of AIPPI. According to the Statutes, the Executive Committee shall in particular determine and study questions coming within the objects of the Association, adopt Resolutions and Recommendations and decide upon the actions to be taken by the Association. Furthermore, it elects the Bureau, the Programme Committee and the Finance Advisory Committee. The Executive Committee convenes once a year, during a Congress or as a stand-alone Meeting. After having met in Lisbon, Portugal, from June 16 to 22, 2002, it now meets in Lucerne, Switzerland, from October 25 to 28, 2003, before getting together again on the occasion of our next Congress in Geneva, Switzerland, from June 19 to 24, 2004.

The Executive Committee is composed of the Delegates representing the Members of the respective National and Regional Groups. The Delegates are appointed by their respective National or Regional Group and the more Members a Group includes the more Delegates they can name to represent the Group. The Executive Committee is further composed of the Presidents and Members of Honour, the Members of the Bureau, the Presidents of the National and Regional Groups and the Chairmen of the Programme and Finance Advisory Committee. We expect to welcome in Lucerne around 300 Participants from all over the world. This number includes Presidents, Delegates and Members of Bureau Advisory and Special Committees as well as Members of the National Group hosting the EXCO.

The Lucerne EXCO starts with a Council of Presidents Meeting on October 25, 2003. The main issue to be discussed in depth at this Meeting is the functioning of National and Regional Groups. After having reached a minimal consensus at the Lisbon EXCO last year, it is time to proceed further with some more concrete results. Active Groups are the key for the functioning of our Association. We are confident that the exchange of views in the Council of Presidents will help the Groups to further improve their work.

The Reporters of the different Working Committees will devote their time on the same day to the work of the Working Questions. The three Committees (Q173, Q174 and Q175) will meet in parallel and prepare draft Resolutions to be put forward for discussion to the Executive Committee. The official Opening of the EXCO follows this working day. The Delegates will convene in the IMAX cinema for some welcome speeches followed by a Welcome Reception at the Swiss Museum of Transport and Communication.

Sunday, October 26, starts with a short Administrative Session. It is followed by the three Working Sessions. At lunchtime the Bureau invites the representatives of GO’s and NGO’s for a lunch and an exchange of views and information. The day ends with a Reception hosted by the Swiss National Group of AIPPI and the Government of Lucerne. Thanks to the initiative of the President of the Swiss Group, Kamen Trolller, the participants will enjoy some typical local food, drinks and entertainment.

The whole of Monday is devoted to decision making on administrative and scientific matters (Resolutions). The grand finale of this Executive Committee Meeting will be the traditional Dinner and dance event in a historical building.

For more detailed information on the Executive Committee Meeting in Lucerne please visit our Website at www.aippi.org > Meetings.●
The French National Group had great pleasure in welcoming the Reporter General, Luis-Alfonso Durán, during its ordinary working meeting held in Paris on July 3, 2003. This meeting was attended by more than 70 people and was devoted to three main topics.

The first period focused on various issues regarding the day to day running of the French Group. Especially, the President, Jean-Jacques Martin, put forward the organization of the four Working Committees to deal with AIPPI’s questions Q180, Q181, Q182 and Q183, in view of the Geneva Congress in June 2004.

Then, the meeting was pursued by the presentation made by Luis-Alfonso Durán. In fact, the Board had launched an invitation to the Reporter General thinking that its Members – especially the youngest – would be very interested in hearing some information and some news on the life of the International Organization.

Luis-Alfonso Durán explained various things about:
- the history of AIPPI, pointing out the important role performed by great French personalities,
- the recent development of our organization,
- questions currently under review and scheduled for the EXCO 2003 and the Congress 2004 and
- the working methods of AIPPI.

Everybody enjoyed this very interesting and friendly presentation a lot.

We also noticed that two former Reporter Generals – Geoffroy Gaultier and Bruno Phélip – a former Deputy Reporter General – Thierry Mollet-Viéville – and the current Assistant to the Reporter General – Dariusz Szleper – were attending this presentation.

The last part of the meeting was devoted to Professor Goutal’s very lively presentation of a report carried out by the British Commission on Intellectual Property Rights.

This report had been forwarded to the French Group by the British Group and, as it looked very interesting, the French Group appointed one of its Members, Professor Goutal, to make a presentation of this huge work about the theme “Integrating Intellectual Property Rights and Development Policy”. Professor Goutal summed up the main ideas highlighted in this report and pinpointed the difficulties raised by integration of Intellectual Property Rights in developing countries. Further, he gave an overview of these difficulties based on the various aspects treated by the report such as, for instance, Agriculture, Genetic Resources, Traditional Knowledge and more especially Patent and Health. The report of the IPR Commission is available on the website www.iprcommission.org.

The friendly meeting ended with a light cocktail.

On this occasion, the French National Group once again wishes to thank Luis-Alfonso Durán for his kind visit. ●
AIPPI Representations – Visits to National and Regional Groups

Visit to the Luxembourg Group of AIPPI, Luxembourg, May 8, 2003
After an introductory discussion with the President of the Group, Mr. Paul Emering, I had the pleasure to attend a lunch Meeting with all Members of the Board and some Members of the Group. The main topic to be dealt with was the possibility of a small Group to actively participate in the work of AIPPI despite the limited human and financial resources. It seems obvious that it is not possible for such a Group to answer all Questionnaires. Nevertheless it is desirable that at least some topics which are of specific relevance to this country are studied and cumulated in a Group Report. Also the Group should take into consideration to organise Seminars, if possible with the cooperation of a neighbouring AIPPI Group.

AGM of the German Group of AIPPI and GRUR Meeting, Hamburg, May 28 to 30, 2003
It has become a tradition that I pay a visit to our second largest Group (953 Members) during their Board Meeting and the Annual General Meeting. I was pleased to see that the Group is very active and an important source for information and manpower for AIPPI. Many Members participate as Chairmen or Members of Working and Special Committees and we are always very pleased with the high standard of their work. One decision taken at the AGM deserves special attention. In order to make sure that the Group Reports of the German National Group can be taken into account by more international Members it was decided, that these Reports shall be translated into English at the Groups expenses. This means that in future many of you will be able to read the very valuable German Group Reports in English. Of course they will still establish the Reports in German too. The Bureau of AIPPI very much supports this attitude. We were always of the opinion that it is of utmost importance to make one's own work known as broadly as possible.

Another point of discussion at the Meetings was the preparation of the AIPPI EXCO and Forum, which will take place in Berlin in 2005. The preparations are well under way and I would like to extend my thanks to the President of the German National Group, Mr. Peter Mes, for the excellent work of his Group.

The German AIPPI Meeting takes place in conjunction with the GRUR Meeting. GRUR is the most important IP association in Germany with more than 4000 Members. It is a pleasure to see that the former President of the German National Group, Hans-Peter Kunz-Hallstein, also a Member of Honour of AIPPI, is the current President of GRUR.

FICPI EXCO and Congress, Berlin, June 1 to 7, 2003
FICPI, the International Federation of Intellectual Property Attorneys, is our most important sister organisation. Over the years we have established a close professional cooperation and the Board Members of both Associations meet regularly at each others Meetings in order to exchange views and discuss common positions to be lobbied at Meetings of WIPO. As always, AIPPI was asked to give an overview to the delegates on AIPPI's current and future scientific work. Luis-Alfonso Durán, our Reporter General, who attended this Meeting as well, gave a short summary of our work which was well received. We furthermore had a separate Meeting with the Bureau of FICPI in which we discussed further improvements of our co-operation.

After having presided over FICPI for the last three years, Malcolm Royal retired as President. I take this opportunity to thank

September 2003
Malcolm Royal, Past President FICPI and Vincenzo M. Pedrazzini, Secretary General of AIPPI

Malcolm for the excellent co-operation during the past three years. The successor of Malcolm is Francis Ahner from France and I look forward to working with him in the next few years.

Visit to the Czech National Group of AIPPI, Prague, June 11, 2003

On the occasion of a joint Czech AIPPI/LES Seminar held in Prague I was able to introduce the work of AIPPI to a larger audience. Specifically in view of the Czech accession to the EU there were interesting topics to be discussed. It is good to see that after my visit in October last year, the Board of the Czech Group picked up the idea of organising a Seminar and I hope that the activities of this Group will further develop.

ECTA AGM and Congress, Salzburg, June 13, 2003

Like every year I have attended the Meeting of our sister organisation, the European Communities Trademark Association. Our main field of co-operation is at the OHIM User Group Meetings in Alicante, where ECTA plays an important role. One of the main topics for this Association as well as for ours in relation to Trademarks is the accession of the Eastern European Countries to the EU.

LES International Conference, Oslo, June 15 to 18, 2003

Another important sister organisation is the Licensing Executives Society International. With over 10,000 Members it is a powerful and well established organisation with whom we have the pleasure of co-operating closely. At a Meeting with the Board of LES I was able to discuss a possible co-operation in relation to educational Seminars. As many National Groups of AIPPI and LES jointly organise Meetings already it seems desirable to work together also on an international level.

Visit to the Icelandic Group of AIPPI, Reykjavik, June 19 to 21, 2003

Last but not least I had the pleasure to visit the Icelandic National Group of AIPPI. Like the Luxembourg Group they have the difficulty of limited resources. Nevertheless I was very impressed by their active approach. The visit started with a discussion with the President, Arni Vilhjalmsson, and the Secretary, Gunnar Örn Hardarson. The discussions were followed by visits to the two largest Icelandic corporations which have a special interest in IP matters. At a lunch Meeting I had the pleasure of introducing AIPPI to an audience of 35 practitioners and Members from the Patent Office. The high turnout was surprising taking into account that the Group so far counts only 11 Members. It is to be hoped that my visit helped to increase the Membership in this Group. My visit ended with a Meeting with the President of the Patent Office where the possible accession of Iceland to the European Patent Convention in 2004 was discussed.

My visits to the above mentioned Groups have shown once again, that the contact between Bureau Members and Representatives and Members of National Groups are of high importance. It is a perfect way to reactivate Members and to gain new Members.

Visit to the Slovak National Group of AIPPI, Bratislava, June 12, 2003

I had the possibility to give an overview on AIPPI’s aims and work during the AGM of this Group. Also the Slovak Republic will join the European Union in 2004 so that there is a lot to do for a National Group regarding education and legislative work. It was a pleasure to realise, that the Group is very active within the country and highly recognised by the Government. It is of course desirable that the Group will become more active on an international level too.
Scientific Programme for Geneva, Congress 2004

Joseph Straus
Chairman Programme Committee

As generally accepted, but also expected, the scientific programme of AIPPI should cover all areas of activities of its Membership evenly, i.e., patents, marks, competition and related matter. Moreover, the questions should be of high relevance, fairly general and dealing with most recent developments, preferably even be a front runner in order to be able to adopt resolutions so timely as to successfully influence international and national developments. Thus, ongoing or expected harmonisation projects of the World Intellectual Property Organisation (WIPO) are of outstanding interest to the Association’s work.

The selection, eventually made well reflects these underlying thoughts: Two questions, one related to patents, one to trademarks, are closely linked to present WIPO activities. One question is dealing with a highly debated legislation adopted in one part of the world, but not in others, however, being of high economic relevance; and the other addresses an issue of fundamental importance, which the Association tried to address decades ago in Venice.

Since the Working Guidelines for the questions, most thoughtfully drafted by the Reporter’s General team, were already mailed out to the Presidents of the National Groups and to Independent Members and are available on the Association’s Website, here only a brief note on the selected topics should suffice.

The work on the Substantive Patent Law Treaty (SPLT) of the Standing Committee on Patent Law at WIPO (SCP) inspired Q180 dealing with the “Content and Relevance of Industrial Applicability and/or Utility as Requirements for Patentability”. During the past deliberations in the Standing Committee on Patents of WIPO, in respect of this issue various positions have been taken, basically reflecting either the European approach of “industrial applicability” or the US “utility” approach. Although “industrial applicability” and “utility” are equated under Article 27 of the TRIPS Agreement as the third requirement of patentability, in addition to novelty and inventive step or non-obviousness, the differences between the two as regards the statutory provisions and case law are substantial. Whereas in more distant past, at least in Europe, this patentability requirement was of relatively low importance, this has changed with the advent of biotechnology. Even the EU-Directive on the Legal Protection of Biotechnological Inventions (98/44/EC) addresses this issue specifically. Comprehensive rules are contained also in the last versions of the US PTO Utility Examination Guidelines. Interestingly, the rules laid down in the US PTO Examination Guidelines, which require the invention to demonstrate a “substantial, specific and credible utility” have recently been applied also by the Opposition Division of the EPO, although no “utility” requirement exists under the EPC. It is expected that the Working Committee in Geneva will be able, based on the replies from the National Groups, to propose a resolution in which not only the debated question, whether or not utility or industrial applicability should be maintained as the third patentability requirement, which under the Article 27 TRIPS is mandatory, will be properly addressed, but which will also contain a competent assessment of the value of the respective patentability requirement in practice. The results of these deliberations should be immediately transmitted to the Standing Committee on Patent Law of WIPO, as well as to competent national authorities.

Q181 “Conditions for Registration and Scope of Protection of non-conventional Trademarks”, although closely linked to
the current work of the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, has a different background. AIPPI has already discussed different aspects of this question since 1963 and touched upon those aspects in a number of Resolutions. In Geneva a consensus on the treatment of registrability of colours per se and combinations of colours per se, three-dimensional marks, smells, sounds, as well as of moving images and holograms will have to be reached. Moreover, the question of the scope of protection of such marks will be a focal point for discussions. As impressively demonstrated by the Working Guidelines on this question, the case law in different countries differs considerably on the registrability of the indicated types of non-conventional marks, thus efforts to reach further harmonization seem essential.

The Programme Committee has the hope that Resolutions on these two questions to be adopted in Geneva will be timely enough so as to be taken into account by the competent WIPO bodies. However, as our Association has learned from the experience preceding the Lisbon Revision Conference of 1958, direct influence on the harmonization work of WIPO will also require intensive promotion of the adopted Resolutions by National Groups at national level. In other words, it is a formidable task of National Groups to persuade their national delegates in WIPO bodies of the correctness and usefulness of solutions elaborated by AIPPI. If the majority of National Groups, eventually, succeeds, delegates of those states will in WIPO advocate the views along the lines of AIPPI Resolutions. This might sound ambitious, but could very well work. It worked in the more distant past!

One of the most controversially debated issues of IP constitutes the “Database Protection at National and International Level”, the topic of Q182. Database protection, for which an EU-Directive (96/9/EC) was adopted in 1996 and which provides for copyright as well as for a sui generis protection, is disputed on various aspects. Among others fears have been expressed that, especially the sui generis type of protection could monopolize knowledge stored in databanks. Annoying in that respect seems to be especially the fact that those who actually produced that knowledge, would not have free access to it or at least could not use it the way they would like. Internationally, the US is intensively discussing the problem, but has not yet taken a final position, and did not accept the European approach. The expected Resolution of Geneva will hopefully clarify not only the state of the law in the countries of National Groups, but also reach a consensus on a solution which would take into account the justified interest of database producers as well as of database users. The fact alone that the US is still undecided, although the largest databanks are located in the USA, clearly demonstrates the complexity of the issues to be addressed.

A second attempt, after 1969 Venice Congress, will be made in Geneva, to find common grounds for an approach toward “Employers’ Rights to Intellectual Property” under Q183. As revealed from the Guidelines, the respective Committee will have to deal with employers’ rights in all forms of Intellectual Property. With the progress of globalization not only of markets but also of production and research, the question has become of high importance, to whom, depending on the place of production, or research site, and depending also on whose contribution in a team composed of researchers from different countries, the rights in research results belong and how he or she can handle them. The need for international harmonisation in that area has become apparent. It goes without saying that reaching a consensus in this area will probably also be difficult in the year 2004. However, in view of the fact that even within the European Union as yet no consensus could have been reached and no activities are under way, a convincing and detailed Resolution of AIPPI could very well provide a push and incentive for the future developments.

We were very pleased by the positive acceptance of our proposals by the Bureau and by their approval by vote of correspondence.

The Programme Committee, although this is actually beyond its competence, traditionally also suggests topics for Congress Workshops. After consultation with the Bureau, the following topics for Workshops have been decided upon:

- Practical consequences of case law granting protection as registered trademarks of descriptive marks and determination of their scope of protection
- Strategies for optimising patent protection after the enlargement of the European Union. The European and national patent systems versus the Community Patent
- Filing strategies for the protection of marks making use of the Madrid Protocol, regional systems like the Community Trademark, national systems and combinations thereof
- Interface between license agreements on technology transfer including IP rights and know-how and the rules on free competition and antitrust in the light of TRIPS. New block exemption rules in the EU
- Proposals for harmonization of rules on enforcement of Intellectual Property rights. Alternative ways of enforcement to court actions and punitive damages.

You will find more information on the Workshops in the next Newsletter edition.
AIPPI intends to be in the front line of Intellectual Property and, therefore, addresses its studies to follow up any initiatives for the protection of Intellectual Property at international level directed to improve and harmonize IP law. In the last few months the Bureau of AIPPI has decided to set up five new Special Committees on new key IP areas.

The Bureau has been aware of the initiatives of WIPO to harmonize substantive aspects of Trademark Law following the harmonization on procedural aspects undertaken by the Trademark Law Treaty (TLT). These studies will be done under the umbrella of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT).

The SCT is a forum to discuss, facilitate coordination and provide guidance concerning the progressive international development of the trademark and design laws as well as of geographical indications, including the harmonization of national laws and procedures. The SCT was responsible for the preparation of the Joint Recommendations concerning the provisions on the protection of well-known marks, on protection of Industrial Property Rights in relation to the Use of Signs on the Internet and concerning Trademark Licenses, that probably will be incorporated in the new proposed treaty on substantive harmonization.

The harmonization on substantive aspects will deal with essential topics like the definition of mark including non-traditional marks (smell marks, sound marks, holograms and three-dimensional marks). This issue is being studied by AIPPI under Q181, a question that will be discussed in the next Geneva Congress in June 2004. Other issues to be studied for trademark harmonization will be absolute and relative grounds for refusal, the appropriate use of symbols indicating that a mark is protected ie: TM and ® etc.

The SCT has been also studying the international protection of geographical indications such as appellations of origin and the system of protection under collective and certification marks, links between the place of production of the products and the geographical indication and its reputation and conflicts between trademarks and geographical indications. This topic is also being discussed in the context of TRIPS.

The tenth session of the SCT took place in Geneva from April 28 to May 2, 2003, as you have probably seen in Newsletter No. 9, and the next one is envisaged to take place from November 10 to 14, 2003. To follow up the proposals of harmonization of trademark law, the Bureau of the AIPPI has decided to set up a new Special Committee Q177 “Substantive Trademark Law Harmonization”. The composition of this Special Committee is the following:

Chairman:
Marino Porzio (Chile)

Co-Chairman:
Roland Mallinson (United Kingdom)

Secretary:
Matthew Swinn (Australia)

Members:
Kozo Takeuchi (Japan)
Gerard du Plessis (South Africa)
Richard Metzger (France)
Brett A. August (United States of America)
Joaquin Latas (Spain)
Wu Qun (China)
Christian Rohnke (Germany)
Zeljko Topic (Croatia)

Another area where there is international activity is the enforcement of Intellectual
Property rights. On the one hand, the European Commission has presented on January 30, 2003 a draft of Directive on enforcement of Intellectual Property rights that pretends to harmonize certain aspects of enforcement in the European Union. This initiative is a follow up of the Green Paper presented by the European Commission on the fight against counterfeiting dated October 15, 1998 as a result of which, the European Commission reached the conclusion that there were great discrepancies among European Union member states about the national systems of penalties to refrain counterfeiting and this was harmful for the proper functioning of the Internal Market. In parallel, on June 11-13, 2003 the first meeting of an Advisory Committee of WIPO member states has taken place in Geneva to explore issues relating to the enforcement of Intellectual Property rights. To study these matters and to prepare the AIPPI opinion, the Bureau of AIPPI has decided to set up a new Special Committee Q185 “Enforcement of IP Rights”, for which the composition is not yet defined.

According to the proposal of the Programme Committee, the Bureau of AIPPI has decided to set up a new Special Committee Q179 “Effectiveness of Regional Systems for protecting Intellectual Property”. The objective of this Committee is to analyse how the many regional systems that exist nowadays for protecting Intellectual Property like the European, ARIPO, EURASIAN and OAPI Patents, the Community Trademark etc. operate and how effective they are. Further to try to extract some conclusions either with the idea to make proposals for improvement and/or to take them as models for other eventual regional treaties that may be created in the future.

The composition of this Special Committee is the following:

Chairman:
Kerry Tomlinson (United Kingdom)

Co-Chairman:
Luigi Carlo Ubertazzi (Italy)

Secretary:
Rodrigo Cooper C. (Chile)

Members:
François Ohresser (France)
Eric De Gryse (Belgium)
P.K. Luke (Singapore)
Janusz F. Luterek (South Africa)
Magda Haroun (Egypt)
Vladimir Kuryshiev (Russia)

AIPPI has been always watching and presenting submissions relating the creation of IP rules in free trade areas like the European Union. Under way there is the proposal to create a treaty for the Free Trade Area of the Americas (FTAA) who envisages to create a free trade area on the American continent.

This is obviously a very ambitious project and will have a major impact in the world economy. Obviously there are Intellectual Property aspects that will have to be considered and discussed in the negotiations that the countries of the American continent are having in connection with the creation of the FTAA. To study these matters and to be ready to give the AIPPI opinion on this area, the Bureau of the AIPPI, following a proposal of the Paraguayan Group, has decided to set up a Special Committee Q184 “IP issues of the Treaty for the Free Trade Area of the Americas (FTAA)” that will be responsible to study these issues and to prepare information and proposals for the Bureau and for the Executive Committee. The composition of this Special Committee is not yet defined.

Last but not least, AIPPI has launched a very ambitious project Q178 “Scope of Patent Protection” about which the AIPPI Deputy Reporter General, Jochen Bühling, reported to you in the Special Edition of the Newsletter No. 7/1-03. I can report to you that a Questionnaire on this subject has already been distributed to all National and Regional Groups of AIPPI and it has been sent as well to about 200 companies in the biotech and computer related fields as well as to GO’s and NGO’s with the idea to analyse the reasons of those in favour or against the enlargement of patent protection to new areas of technology as well as to analyse the scope of protection already existing to protect these inventions. We expect to receive the responses from the Groups as well as from the other addressees in the course of the summer and to be able to prepare a Summary of the replies received in order to analyse the follow-up of this Question and thereafter, it will be decided on the composition of this Committee.

As you can see, AIPPI continues to be active in the different fields of IP in order to exercise its leadership in the improvement of the protection of Intellectual Property internationally, and to give the possibility to its Members to be updated about the new events taking place in the international scene on Intellectual Property. I invite all Groups of AIPPI to follow up the studies being conducted by AIPPI on these fields and to establish internal Committees at national level to study these Questions. This will enable the Groups to have a good knowledge of these matters and to be prepared to answer any Questionnaires that the Special Committees would send out for replies.

The Members of the Special Committees as well as myself and any other Members of the Bureau will be very happy to reply to any questions you might have in connection with the work of these Committees.
The OAMI User Group is the successor of the OAMI Trade Mark Group, and one of the most important discussion forums between the Office for Harmonization in the Internal Market and the non-governmental organisations. As a consequence of the entering into force of the Community Design Regulation, the Group has not only changed its name but also been enlarged by organisations representing designers.

Irrespective the open question on whether searches will be abolished or not, the Commission stated that the fees of Office will not be increased to maintain the search system. In September 2003, Spanish is expected to become the third official language in the Madrid Protocol, following which the Commission hopes that the EC will be able to access the Madrid Protocol and thus establish “the link” between the CTM System and the Madrid Protocol. The blocking point is (again) the language problem, but only one country seems to be against.

By the end of August 2003 the Office expects to have worked down its old backlog of unexamined seniority claims. The Office does not intend to publish amendments to CTM’s as a consequence of the examination, and the status of a CTM will thus only be available from the file and not from the publication.

By Communication of the President of 10 February 2003, the Office has informed how it will process authorisations in the future. Obviously the communication does not change the law, and it is therefore still required to submit authorisations, see Art. 89.1 CTMR and Rule 76 CTMIR – at least until the CTMR is amended as proposed by the Commission. The Office has prepared a very comprehensive set of substantive opposition guidelines (in practice the internal opposition guidelines of the Office), which will be published on the website of the Office as amended to take into consideration the comments of the users, and subject approval by the Administration Board. It is the Office’s intention to revise the guidelines at two years intervals, and between the revisions to communicate important changes in practice by a Communication of the President or through this Group.

The Community Design

On the basis of the applications received so far, the Office forecasts to receive between 27 - 39,000 Registered Community Design (RCD) applications in 2003, which is more than according to its original expectations. Draft examination guidelines are in the process of being amended to take into consideration the comments of the users, and invalidity guidelines are in the process of being drafted.

Before the end of 2003 the Commission will prepare a proposal on whether the EC shall access the international registration system for designs or not, and the US position will be an important factor in this respect.

Administration of the Office

The Office is presently considering the possibility of establishing certain e-business solutions, such as looking on the entire file on-line and e-mailing the examiner, and will inform the users of future e-business projects on its website.

New simplified forms were presented, but a formal communication will follow when the forms are available for use.
François Curchod

WIPO Worldwide Symposium on Geographical Indications, San Francisco, July 9 to 11, 2003

Following eight earlier such meetings in other parts of the world, the Worldwide Symposium on Geographical Indications, organized by the World Intellectual Property Organization (WIPO) and the United States Patent and Trademark Office (USPTO), took place in San Francisco, California, from July 9 to 11, 2003.

All the presentations (but not the discussions) can be found on the website of WIPO (www.wipo.int).

It came just two months before the Cancun Ministerial Conference of the World Trade Organization (WTO) which is expected to take decisions concerning the very controversial issue of the international protection of Geographical Indications (GIs), in particular as regards the establishment of a multilateral system of notification and registration of GIs for wines and spirits under Article 23.4 of the TRIPS Agreement and the possible extension of the protection afforded to GIs for wines and spirits under Article 23 of that Agreement to GIs for other goods. The ongoing WTO negotiations were in the minds and often in the mouths of most if not all participants.

There were some 140 participants from more than 40 countries, with no less than 27 speakers taking the floor within the framework of seven themes. After the opening of the Symposium, during which representatives of WIPO and the USPTO took the floor, an introduction to GIs and information on recent developments in WIPO and WTO were given by representatives of those two organizations. Speakers from the USPTO, the European Commission, Argentina and Hungary then expressed the views of governments on the protection of GIs. This was followed by views of producers on the protection of GIs, a topic that was addressed by representatives of the Mexican Tequila industry, the Indian tea industry, the Grocery Manufacturers of America and the Italian wine industry.

The next theme was GIs and trademarks. The undersigned spoke on behalf of AIPPI, describing the Resolution on that matter that was adopted in Copenhagen in 1994. He was followed by representatives of the International Trademark Association and the International Wine Law Association. The industry perspectives of GIs and international trade were discussed by a producer of wines and spirits from Switzerland, a representative of a US winery, the Director of the Moroccan Industrial and Commercial Property Office and a representative of the Australian dairy industry. GIs around the world was the next topic. It was addressed by representatives of the European cheese industry in the USA, the Australian wine industry, the Champagne industry and the coffee industry of Guatemala (the latter speaker being also the President of the newly created Organization for an International Geographical Indications Network (ORIGIN)). A way forward for GIs was the last theme. Speakers from the US beer industry, the European spirits industry and the Spanish Turron industry as well as the Australian Ambassador to the WTO made presentations on that topic.

Finally, the undersigned “moderated” an open-floor discussion in which many participants expressed their views. All discussions were extremely animated, sometimes heated. They reflected the sharp division of positions, already noticeable during most of the presentations, between the proponents (mainly European) of a strengthening of the international protection of GIs and those (mainly from the “new world”) who think that the level of protection granted under the TRIPS Agreement as it stands is more than sufficient. Not surprisingly, the divergent views expressed during the Symposium reflected the divisions in the positions defended by the negotiators in the WTO.

Nevertheless, all the participants seemed to be satisfied with opportunity that the Symposium gave in a rather informal manner to express and hear the various arguments of the two sides. In the opinion of the undersigned, it was particularly useful for the producers of goods bearing GIs to be able to be directly heard by the government representatives.

Full Report see: www.aippi.org > Publications & Services > online Publications > Reports of Representatives at WIPO
Summary of the WIPO Meeting of the Advisory Committee on Enforcement, Geneva, June 11 to 13, 2003

The meeting was chaired by Mr. Henry Olsson from Sweden and representatives of about 72 countries and some 20 IGOs and NGOs participated. The meeting welcomed the setting up of the Committee and generally encouraged its work as a forum for discussing the very important issues of enforcement of IPRs. In particular the recent activities carried out by WIPO such as expert missions, training and study visits, seminars and workshops were mentioned as positive developments in the area. The setting up of the Electronic Forum on Intellectual Property Enforcement Issues and Strategies (IPEIS) was regarded as an excellent tool for exchange of information. The Committee decided that from now on there should be no restrictions for the participation in the IPEIS Forum and no requirement for registration to access the Forum. The Forum is found at www.wipo.int/ipeis/

The Committee encouraged Member States to invite officials, in particular from enforcement agencies and Intellectual Property offices to submit information to be published on the Forum. It should be noted that organizations like AIPPI are also welcomed to publish information on the Forum. In future the Secretariat of WIPO will structure the information available on the Forum to make it easier to access and search. It should also be noted that an Enforcement and Special Projects Division has been set up within the Secretariat.

The two and a half days of meeting included lively discussions about what the Committee’s tasks should be in future and the mandate and role of the Committee. General statements were made by the GRULAC Group (Grupo de Paises de America Latina y el Caribe) and the B Group and the former Group noted that in its view norm-setting was excluded in the mandate of the Committee and that e.g. the Committee should cover implementation of already existing obligations in the field of enforcement but refrain from measures of prescriptive nature.

The Secretariat had suggested in document ACE/1/2 that the Committee should identify themes of special interest for further examination and discussion. Some themes were identified in said document, but many more were suggested during the discussions. The five themes suggested by the Secretariat were the role of the judicial authorities, the development of national strategies to make enforcement of IPRs more effective, assistance by the private sector to enforcement agencies in the identification of counterfeit and pirate goods (including training and education activities), the socio-economic impact of counterfeiting and piracy and the implementation of procedures and mechanisms for effective and appropriate border measures. The Committee agreed with this principle of a “thematic approach” for the future work, but the conclusion of the meeting after an intense discussion with numerous interventions by many countries and observers was that all the suggested themes as well as their priority should be subject of a further and more comprehensive discussion and decision at the next meeting of the Committee.

At the end of the meeting the Secretariat suggested that the next meeting of the Committee to be held in 2004 should include presentations of the role of the judiciary and quasi-judiciary authorities in the enforcement activities, including related issues such as litigation costs.
There was no discussion on Articles 2 (General Principles and Exceptions), 11 (Claims), 12 (Conditions of Patentability), 13 (Grounds for refusal of a claimed invention), 14 (Grounds for invalidation or revocation of a claim or a patent), 15 (Review) and 16 (Evidence). At the end of the 8th session, there was no consensus on Articles 2, 12, 13, 14 and Articles 15 and 16 were accepted. “Hot” issues (“1st to file” / “1st to invent” or “technical” character of an invention) were not treated.

Some definitions needed further discussion: Article 1(ii) “application”, 1(vi) “claimed invention”, 1(ix) “priority date of a claimed invention” and 1(x); a reworded version will be prepared. Should the wording be clarified, there is no major problem to adopt Article 3 (Applications and patents to which the Treaty applies); a similar situation prevails for Article 4 (Right to a patent), with a consensus to delete Article 4.3, and Article 4.4 being reserved. Very hot debate on Article 5 (Application): some countries (including Brazil, India, Argentina…) requested to delete Article 5.2 and to introduce in Article 5.1 references to genetic resources, traditional knowledge; other delegations (including the USA, European countries, Japan) strongly opposed to such deletion and introduction, arguing that the SCP was not the appropriate forum to discuss this issue. On that occasion the Brazilian delegation reminded that during the PLT discussions, a similar reference was requested but, at that time, was refused, based on the proviso that such reference should be more appropriately discussed at the SPLIT meeting… No consensus either concerning Article 5.3 (Abstract).

Article 6 (Unity of invention): no detailed discussion, the USA studying possible modifications in the concept of unity of invention. Article 7 (Observations, Amendments or Corrections of application): the International Bureau shall propose a re-worded text, with a clear distinction between corrections and modifications; no consensus on the role of the abstract with possible modifications. No consensus on Article 7bis (Amendments or corrections of patents): is it useful? It was pointed out that this article deals with provisions applicable after the grant of the patent. Article 8 (Prior art): no decision as to whether the accessibility to the public should be qualified as legal or reasonable. Once more some delegations (USA, NewZealand, Australia) put forward the issue of loss of rights in case of prior secret use, the majority of delegations being opposed to; similarly the American delegation maintained that the effect of earlier applications should apply to both the novelty and the non-obviousness. Another issue was raised concerning the definition itself of the term “novelty”.

Article 9 (Grace period): preliminary statement from the Greek delegation (on behalf of European Union members) in favour of a limited grace period (six months before the priority; any disclosure; claimed by the applicant); USA, Canada, Brazil, Australia in favour of a 12 month period from the priority, with no obligation for the applicant to claim it. The issue of third party rights was also discussed but without any consensus. The International Bureau will prepare a new text with alternatives. Article 10 (Enabling disclosure): no final decision except that, in order to comply with the enabling disclosure requirement, an applicant could not rely on something which was not present in the disclosure on the filing date.

At the end of the session some issues clearly appeared as blocking points; the 10th SCP session, initially envisaged for November 2003, has been tentatively scheduled to be held in the first half of 2004.
ICANN held a meeting from 22 to 26 June, 2003 in Montréal, Canada. The meeting focused on issues surrounding WHOIS data. WHOIS is the publicly accessible record of registrants of generic top domain names, such as .com and .net. Most country code registries also publish details of registrants of their domains, although the ICANN meeting was mainly focused on the issues concerning gTLDs. The meeting brought together users of WHOIS, the domain name registries and registrars who maintain the databases and advocates who argue for more restrictive access to the data.

One type of user of WHOIS data and the type which has led to most problems was, however, absent. Spam has become a major problem for the internet and few email users are lucky enough to escape it altogether. WHOIS databases are mined by spammers who obtain the email addresses listed to add to their large files of email addresses who are sent advertisements for all types of unsolicited goods and services. No one speaking at the ICANN meeting favoured spam, but many explained the legitimate uses of WHOIS data and emphasised the importance of unrestricted access. Speakers from the US Department of Justice, the Federal Trade Commission and the UK Office of Fair Trading all emphasised the importance of WHOIS in assisting law enforcement in tracking down those responsible for spam, consumer frauds, child pornography and other illegal activities taking place in cyberspace.

The author spoke on the uses of the WHOIS by Intellectual Property owners and their lawyers in identifying the owners of websites where pirated or counterfeit products are offered for sale, or to identify the registrant of a scam site which is designed to confuse the customer into believing they are dealing with the brand owner. Although many cybersquatters or pirates give false address details, a surprising number of infringers give correct details, or sufficiently correct details to enable further research to identify the culprit. Where patently false contact information is given, the registrar of the domain name can be contacted and requested to verify the correct data or remove the domain name. In addition to being an extremely useful tool in the fight against online infringers, the author also addressed the importance of WHOIS in managing domain name portfolios and carrying out due diligence in corporate acquisitions. Other commentators explained how WHOIS is used by technical staff to assist in dealing with security issues.

On the other side of the debate privacy advocates claimed that individuals registering domain names should not be forced to disclose their personal address and telephone number to the world and a representative from the European Commission raised concerns as to the compatibility of the current WHOIS system in the top level domains with European data protection laws. A speaker from the registry for .nl explained how they had achieved a balance between access and privacy.

Work to reach a compromise acceptable to all parties is now underway at ICANN. The Intellectual Property Constituency will continue to advocate open access to WHOIS data, due to its importance to IP owners and registrants, in the belief that privacy concerns can be adequately addressed by top level domains aimed at individuals (such as .name) and proxy services.
Enn Urgas

Preview of the Baltic IP Conference, Tallinn, November 5 to 7, 2003

This year the host of the Conference will be Estonia. The Conference will be organized under the banner of AIPPI in collaboration with the Association of Estonian Patent Attorneys and will take place in Tallinn, the capital of Estonia from 5 to 7 November 2003.

The topics and issues of the Conference are predestinated by the major currents in political and economic development in Europe wherein also the Baltic States are involved – they have received respective invitations to accede to the European Union whereas at the same time joining negotiations with NATO are being held.

The tradition of organizing Baltic IP Conferences was born in Lithuania in 1962. Since that year the biannual conferences have been held alternately in Lithuania, Latvia and Estonia.

For small countries and prospective Community members economic globalisation, rapid technological development and the development of an information society have presented a serious challenge to enterprise innovation. An important bottleneck appears under the circumstances where enterprises rarely participate in national or international developmental activities. In the development of Estonian economy to improve the quality of life and increase social well-being, the strategic objectives of Estonia are primarily:
1) updating the knowledge pool; and
2) increasing the level of enterprise competitiveness.

While the general title of the Conference is “The Baltic States in uniting Europe”, in reality, broader problems and issues will be discussed, for instance: IP in the European Union. What is reasonable to centralize and what shall remain in the domain of the member states; the already enforced as well as further planned developments in the European Patent Convention and in the PCT; the supranational and national interests in conferring legal protection for IP; the practical experience of countries, including small ones, already operating in the EPC and EU trademark protection system.

The Organizing Committee of the Conference expects presentations from the representatives of AIPPI, EPO, experts from European countries, as well as specialists and scientists from the future member-states of EU.

The venue of the Conference will be the newest and most modern four-star hotel Radisson SAS having duly equipped conference rooms and situated in the very heart of Tallinn. The Conference participants will be accommodated at the same hotel and at the hotel Viru located within a five minutes walking distance from the Conference venue and having accommodation level similar to Radisson SAS.

The Conference participants will also have the opportunity to explore our capital Tallinn, a city of contrasts where the contemporary skyscrapers and the turmoil of a modern city friendly coexist with the medieval part of the city separated from each other by the city-wall. Also events introducing our history and national culture as well as cultural heritage will be available. One will see how voluminous construction activities are in Tallinn nowadays and nevertheless, as it is said in our folklore, Tallinn will never be completed. The Old Town of Tallinn has been on UNESCO’s World Heritage list since 1997; Tallinn’s Town Hall was first mentioned as early as 1322.

The Estonian National Group of AIPPI and other organizing authorities sincerely hope that the Conference will be an event offering the IP experts as well as the specialists in the IP management field a good opportunity to discuss the relevant matters of IP, to enhance the contacts between the experts in different countries, thus providing a certain contribution to the development of the legal protection of IP and enforcement of the respective rights. We shall be looking forward to meeting you at the Conference in Tallinn.
On August 18th and 19th 2003 ABPI, the Brazilian National Group of AIPPI, held its 23rd Seminar on Intellectual Property in São Paulo.

The Seminar was attended by 533 people, 102 of which from abroad, from a total of 20 countries. Simultaneous translation was available to and from English and Spanish.

The programme focused on the redesign of Intellectual Property rights in the framework of international commerce and addressed issues of both international and local interest, such as the role of Intellectual Property in the context of environment, protection of traditional knowledge, patent protection for computer programmes, treatment of non-traditional marks (fragrance, sound and other types of marks), proposals of measures to foster the protection of creations inside enterprises and universities, the Madrid Protocol, arbitration of IP disputes, treatment of appellations of origin and other relevant issues.

The opening speech was delivered by the Rector of UNICAMP, one of Brazil’s top universities and high tech research centers, Prof. Carlos Henrique Brito Cruz, who made a comprehensive analysis of the role of Intellectual Property in the current world, departing from a historical background, and discussed the ongoing negotiations of major international treaties. The Seminar’s closing session addressed specifically the structural problems of the Brazilian Patent and Trademark Office and had the participation of the Secretary of Industrial Policy of the Ministry of Industry and Commerce who is in charge of this area, besides the President of the Brazilian Patent and Trademark Agents’ Association.

The Seminar took place at Transamérica Hotel, a prestigious complex located off São Paulo’s central areas and included social functions, in particular a dinner to celebrate the 40th anniversary of ABPI, during which we rendered homage to the remaining founders of the Association.