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EDITORIAL



Three years after the successful Melbourne Congress, the Members of our Association met in the capital of Intellectual Property, Geneva, where the WTO and the WIPO have their headquarters, to celebrate its 39th Congress. The Swiss Organising Committee under the leadership of Bertrand Micheli and our professional congress organiser MCI have done a fantastic job and are to be congratulated for the smoothly run and well organised event. We were happy to see many young people in Geneva which indicates the interest of the next generation for AIPPI. The attendance of 1'600 participants and 600 accompanying persons indicates the high interest of the Membership in the activities of the Association.

This Newsletter is mainly devoted to the review of the different parts of the Congress and will give those of you, who were not able to attend an overview. We hope that by reading the Reports you will be stimulated to take into consideration your participation in one of the next events, which will be the EXCO/Forum in Berlin, Germany, in autumn 2005 and the Congress in Gothenburg, Sweden, in autumn 2006.

You will also find some news about our activities. Unfortunately, and despite the efforts of AIPPI and many other NGOs, the 10th SPLT session lead to no result. The different interests of developed and developing countries blocked the harmonisation process. This will most probably lead to a situation where the industrialised countries will go their own way in the harmonisation of substantiv patent law. The Trilaterals (USPTO, JPO and EPO) will follow up with the negotiations outside the framework of WIPO and will invite all interested countries to join. This development is critical and will weaken the position of WIPO. AIPPI will spend all its efforts to bring the harmonisation process back to WIPO in order not to generate a two class society. Alain Gallochat, the Chairman of our SPLT Committee, and the Members of his Committee are to be congratulated for all the efforts performed in the last year and we wish them every success to bring this important question back on track.

In the past three and a half years we have constantly tried to reduce the costs for the Newsletter. Thanks to the efforts of the professional staff in the General Secretariat we have with this edition reached the point where everything but the printing is produced in-house. I take this opportunity to thank Yvonne Fluri, Maria Bratsos, Cinzia Petruzzello and Ruth Vogt for their continuing support and their willingness to constantly improve the running of the Association.

I wish you some interesting moments with this Newsletter. As always, your comments are highly appreciated.

Vincenzo M. Pedrazzini
Secretary General

Ian Karet

Review of the Congress Geneva 2004 – Working Committees



Ian Karet
Deputy Reporter General

There were four Working Questions for the Geneva Congress, reflecting the new format for our meetings. The Working Committees met on Sunday, June 20, 2004 and the Plenary Sessions took place on Monday, June 21, 2004 and Tuesday, June 22, 2004. Both the Working Committees and Plenary Sessions were well attended with Delegates from many countries keen to participate in the debate. The Resolutions are all available in four languages at the AIPPI Website www.aippi.org (under News).

Q180 considered **Content and relevance of industrial applicability and/or utility as requirements for patentability**. The purpose of this question is to evaluate the situation regarding requirements for patentability beyond novelty and inventive step/non-obviousness. It appears that, in practice, Patent Offices rarely refuse applications on this ground. The basis lies in Art. 27 TRIPS, which provides that, subject to certain exceptions, patents shall be available for inventions which are new and inventive and which are "capable of industrial application" or "useful". The draft SPLT under discussion at WIPO contains a provision which deals with this concept as a third requirement of patentability.

The Working Committee concluded that there was a need for a harmonised criterion of "utility" or "industrial applicability". However, the Committee did not find it easy to find a harmonised solution save to say that the term "practical applicability" might be appropriate as a title for the concept. The Delegates accepted the need for a harmonised criterion which would distinguish between patentable and non-patentable subject matter. The criterion should relate to the applicability of the invention so as to exclude, for example, abstract ideas. The Plenary Session also resolved that the

criterion should not be construed to introduce new patentability requirements which do not currently exist under the concepts of industrial applicability or utility. Further, "practical applicability" is not the same as the concept of a "technical content". Finally, the criterion is not intended to embrace exclusions based on morality and the like.

This work on harmonisation is at a relatively early stage and there was not yet agreement on what the exact requirements of this harmonised criterion should be. Accordingly the Resolution provides for AIPPI to conduct further studies in an attempt to define the content of the criterion.

Q181 **Conditions for registration and scope of protection of non-conventional trade marks** considered newer types of trade mark protection including, in particular, colours, shapes, sounds and smells. The Working Committee was largely in agreement with the draft Resolution and the debate was similarly based on a general agreement that such marks should be capable of registration and, in principle, treated in a similar manner to word and sign marks. There may, however, be difficulties in defining non-conventional marks and representing, publishing and searching them. Accordingly, it was resolved that the representation of such marks should be "clear, precise, easily accessible and intelligible". The public must be able to understand the nature of the mark as it is undesirable to grant trade mark rights that cannot be understood.

It was resolved that a colour *per se* can be capable of registration as a trade mark, accepting that in many cases a colour *per se* will only be registrable on the basis of distinctiveness acquired through use. There may be circumstances where a colour *per se*

may be registered on the basis of inherent distinctiveness in relation to certain goods or services.

Sounds should be registrable and not subject to a requirement of graphic representation – so long as the right can be understood from the form in which it is filed, e.g. if a sound is filed as a digital recording in a computer file, there is no particular benefit in graphic representation.

Similarly, smells should not be subject to a requirement of graphic representation, but should be represented by means unequivocally describing or reproducing the smell.

These developments will require Patent Offices to promote effective methods of representing non-conventional trade marks, and the registrations call for this.

Q182 considered **Database protection at national and international level**. This question was selected to examine national and international legislation in case law concerning database protection and to encourage proposals for adoption of uniform rules alleviating potential deficiencies in the current scheme of protection. The Resolution recommends that all countries provide for the protection of databases which require substantial investment by means of a *sui generis* right or other proprietary right.

The European Database Directive definition of a database – "a collection of independent works, data or other materials which are arranged in a systematic or methodical way, and are individually accessible by electronic or other means" – appears comprehensive and may be followed by other legislators. Protection should only be granted when a substantial investment has been made in the obtaining, verification or

presentation of the contents of the database. The protection should be available for electronic and non-electronic databases. The right holder should be able to prohibit the reproduction or transfer to another medium (extraction) and making available (re-utilisation) of the whole or a substantial part (whether qualitative or quantitative) of the contents of the database. The term of duration should be at least 10 years from the making of the database.

AIPPI further supports WIPO's efforts in drafting a basic proposal for the substantive provisions of a treaty for databases (1996) and any further efforts to be made to pursue a harmonised proposal.

Q183 Employers' rights to Intellectual Property raised again a topic which previously had proved challenging for AIPPI. In 1969 the Venice Congress studied Q40A: the Employees' inventions, but was not able to reach a satisfactory Resolution. There is no doubt that this topic raises passions – one speaker at the Plenary Session even suggested that employers' rights were little short of slavery. There was also a suggestion that an employer who owns copyright might seek to enforce this against criticism of the employer written by an employee. The majority thought this unlikely, not least because it would not have been created in the course of the employment. National systems currently provide very different rights for employees based on different understandings of whether a salary is meant to cover inventions by employees or whether additional compensation is appropriate.

Following a vigorous debate, AIPPI succeeded in adopting a Resolution that employers should be granted ownership in the creations made by employees from the framework of their employment relation-

ship. Courts and authorities having jurisdiction in the field of Intellectual Property rights should also be competent to decide on disputes between employers and employees with respect to those rights. While conciliation may be desirable it should not be mandatory in every case. It is desirable that employees should make claims to ownership within a reasonable short term of limitation to avoid uncertainty over ownership and its financial consequences. Any compensation scheme should be clearly determinable and established in a simple way. The harmonisation of rules of ownership of Intellectual Property rights should therefore be encouraged, particularly at a regional level and also through governmental agreements.

It may also be desirable to harmonise ownership rules through legal presumptions and by encouraging the adoption of model standard contracts. The Plenary Session considered it important that employers' rights should not restrict an employee's entitlement to recognition of creative achievement in an appropriate form.

Mr Gaultier (President of Honour, France) congratulated the Plenary Session on reaching a conclusion on this topic which had over so many years eluded meetings of AIPPI. It is a pleasure to report that the new working system has such positive results! ●



Delegates during the Plenary Session

Jochen Bühling

Review of the Congress Geneva 2004 – Special Committees



Jochen Bühling
Deputy Reporter General

Only a few months have passed since the ExCo in Lucerne from October 2003 until the Geneva Congress in June 2004, but nevertheless we have seen numerous developments of the Special Committees (SCs) which are active at this time. Reports which have been prepared by the SCs were handed out to the participants at the Geneva Congress. Please find all Reports and Resolutions of Special Committees on the AIPPI Website:

www.aippi.org

Among the hottest topics at the moment are the SPLT and the development of the patent protection in Europe. Both are covered by Special Committees. **Q170** concerns the **SPLT**. After the very successful Seminar which was held in January by AIPPI together with WIPO in Geneva (see Newsletter No. 13) the Committee prepared a Questionnaire which was sent to the National and Regional Groups and which dealt with two main issues which are critical for the future development of the SPLT. The first issue concerned the relevance of "secret prior art" (Art. 8 SPLT) and the other one dealt with the grace period (Art. 9 SPLT). The Groups responded to a quite large extent despite the time constraints, and these answers formed a well-founded basis for a Resolution which was adopted at the Geneva Congress setting out what should be the contents of those two articles of the SPLT.

Q165 Optional Protocol to the EPC with regard to Litigation concerning European Patents has close links to **Q162 Community Patent**. Only less than a month before the Geneva Congress the European Council once more failed to come to an agreement on a proposal for the Community Patent Regulation which led to the statement of the Commission that all options including a complete withdrawal of the proposal are at stake right now. Once again no compromise could be reached on the question of the legal effect of translations of the claims. Evidently, there will be no solution in the short run. No decision has been made yet. This emphasizes the importance of the Optional Protocol with regard to Litigation concerning European Patents on the other side. **Q165** took the opportunity to prepare a Resolution which was also adopted at the Geneva Congress encouraging the Member States of the EPC to aim at a concentration of patent litigation in one or several national courts and at a high degree of specialization of the judges

dealing with patent cases. This Resolution also follows up on the Resolutions previously taken in Lucerne and Melbourne.

A number of SCs gave an oral presentation in Geneva in addition to the written Reports mentioned above.

Q94 GATT/ WTO under the new Chairmanship of Mr. Ivan Hjertman (Sweden) can take advantage of the specific expertise of AIPPI. Internally, the geographical diversity of the Committee has been widened with Members from China, India, Nigeria and the US. The Committee will review the work program in view of the agenda of the TRIPS Council and coordinate the work with other Committees in consultation with the Bureau. On an external level, it will be important to build on contacts between AIPPI and the TRIPS Council. Also, the issue of Art. 6 of the DOHA Declaration and cross-border licenses play an important role. A Questionnaire has been prepared and was sent to the Groups in September by the Committee so that AIPPI can express a view on these issues to the relevant bodies of WTO.

Q177 Substantive Trademark Law Harmonization has attended the meetings of the Standing Committee of Trademark Law (SCT) at WIPO regularly. The WIPO Committee will most likely come to the end of the work on harmonization so that a conference for a revision of the TLT may be held in 2006. The Committee **Q177** will continue to review the work of the SCT and give specific recommendations to the Bureau. A proposal will be drafted in consultation with the Groups at the appropriate time, probably later this year.

Q114 Biotechnology including plant varieties could report that shortly before the Congress also Austria had joined the UPOV 1991 which now comprises 27 countries. The



The Bureau of AIPPI during the ExCo, from left to right: Ian Karet, Deputy Reporter General, Jochen Bühling, Deputy Reporter General, Luís-Alfonso Durán, Reporter General, Vincenzo M. Pedrazzini, Secretary General, Gerd F. Kunze, former President, Örjan Grunden, President, Annika Ryberg, former Deputy Secretary General

main task of this Committee will still be the monitoring of the implementation of the EU Biotech Directive. This issue is still highly debated in many of the "old" EU Member States, among which are Germany, France and the Netherlands. With the enlargement of the EU effective as of May 1st, 2004 the 10 new members had to ensure that their national laws correspond to the EU rules and that they will also implement EU Directives, including the Biotech Directive 98/44. The Committee will also follow the development in these countries very closely.

Q132 Computer software, information networks, artificial intelligence and integrated circuits had prepared a Resolution which was adopted at the ExCo in Lucerne in October 2003. This Resolution recommended that the European Council and Commission should not accept the amendments which had been suggested by the European Parliament to the EU Directive on the Patentability of Computer-Implemented Inventions. Accordingly, these amendments were rejected. A changed wording of the EU Directive

was adopted by the EU Council right before the Geneva Congress. It comprises the rule that a computer programme as such cannot constitute a patentable invention and that it must make a "technical contribution" which has to be new and not obvious over the prior art. Since this proposal of a Directive will again be put before the European Parliament in due time, it is to be expected that the anti-patent lobby will mobilize all efforts against this Directive again. The Committee Q132 therefore planned to prepare another Resolution for the Geneva Congress. However, it was felt premature to comment on a wording which was only a few days old and that more time was needed to be able to come to a substantial Resolution. The Committee will continue its work and monitor closely the next developments and prepare the necessary steps in due course.

The three youngest SCs are Q179, Q184 and Q185. **Q179 Effectiveness of Regional Systems granting IP Rights** has prepared an overview over the existing regional systems. It will continue to evaluate those systems and

to conclude from there what the advantages and disadvantages of the various systems are. A Questionnaire for the Groups will probably be prepared and distributed later.

Q184 IP issues of the FTAA has closely monitored the developments at the FTAA discussions concerning IP matters. The original plan to conclude the negotiations successfully by the end of 2004/beginning of 2005 is not very promising, since there are significant differences between Brazil (Mercosur) and the US. Whereas the US want to include IP matters as a separate chapter in the FTAA in line with bilateral agreements, Brazil feels that IP matters should be kept under the roof of the WTO (TRIPS). In this context, several parts of TRIPS Plus are not acceptable for Brazil. The legal aspects where there is still disagreement concern the term for patent protection (extension for protection for pharmaceuticals), the copyright area and issues of counterfeited goods. The Committee will continue to monitor the negotiations and will give aid in preparing an AIPPI statement if appropriate.

Q185 Enforcement of IP Rights monitors and advises on developments regarding the enforcement of IP rights with a special focus on the EU Directive of 2004 on IP Enforcement. This comprises questions of substantive law, procedural law, criminal law, customs regulations and education. The proposed EU Directive on Enforcement should be implemented to create a minimum standard for remedies. The main criticism is that it is too far-reaching and not balanced enough. The computer industry has triggered this in their role of the most harmed victim. The Committee has recommended focusing on aspects of collecting evidence and discovery. These are important aspects on an international and on the EU level. A Questionnaire will be sent out to the Groups in the next months. ●

Luís-Alfonso Durán

Review of the Congress Geneva 2004 – Workshops



Luís-Alfonso Durán
Reporter General

The Programme of the last AIPPI Congress included five Workshops (WS). The WSs were very well conducted by the Chairmen and the speakers made excellent and informative presentations that were followed by numerous participants.

WS I – Practical consequences of case law granting protection as registered trademarks of descriptive marks and determination of their scope of protection. The Chairman was the Vice-President of OHIM Alexander von Mühlendahl, and the speakers were Felipe Claro (CL), Fabio Angelini (IT) and Robert Sacoff (USA). The speakers presented the views from the perspective of the US, the European Union (EU) and several Latin American countries. It was pointed out that generally speaking, all jurisdictions exclude from registration marks that lack distinctive character, although views differ on whether a particular mark has a sufficient degree of distinctiveness to be registered. The problem arises when such marks are registered and used as a basis for an opposition or cancellation action when enforcement is attempted.

Among the questions addressed by the speakers, the priority problem that present descriptive marks in the US has been mentioned, since they are protected from the point of time when distinctiveness has been acquired while ordinary marks are protected from the date of first use. In Latin America not all jurisdictions recognise the doctrine of secondary meaning. Also questioned was the too severe approach on the evaluation of enough distinctiveness of marks in the EU before accepting them for registration. The conclusion was that this issue is one of the difficult areas of trademark law and practice, and that it would be desirable to clarify the rules to determine conflicts under which relative weakness or strength of the allegedly infringed earlier mark would be one of the elements that should be taken into account.

WS II – Strategies for optimising patent protection after the enlargement of the EU. The European and national patent systems versus the Community Patent. Chairman was the Vice President of EPO, Manuel Desantes and the speakers were Rolf W. Einsele (DE), Tobias Bremi (CH) and S. Peter Ludwig (USA). After an overview by the Chairman of the current and prospective legal landscape of the European patent system, including the 2000 revision of the EPC to be implemented, the proposals of the European Commission on the Community Patent, and of the new legal scenario that may bring the approval of the proposed European Constitution as far as qualified majority to approve patent and language matters, the discussion was focused almost exclusively on the Community Patent and the conditions it should have. The conclusion was that a future Community Patent should afford high quality patents, uniformity and predictable enforcement at a reasonable cost.

WS III – Filing strategies for the protection of marks making use of the Madrid Protocol, regional systems like the Community Trademark, national systems and combinations thereof. It was chaired by the Assistant Director General of WIPO, Ernesto Rubio, and the speakers were Christophe Lelier (CH) and Fabrizio de Benedetti (IT). They made an explanation of the characteristics of the Community Trademark and of the Madrid Protocol each of them providing the possibility of protecting a mark in 25 and 66 countries respectively. The new advantages of both systems due to its link as from October 1, 2004 were also emphasised. Speakers referred to the drawbacks of the system like the increased vulnerability of the Community Trademark due to its single character and the 5 year dependency on the basic application/registration of the Madrid System. A comparison was made with respect to national systems and the differences of prosecution, examination and length of proceedings up to registration. The conclusion was that the choice of the most appropriate mechanism to protect marks depends on the circumstances of the case and a good knowledge of all systems available is required to make the most appropriate choice in each case.

WS IV – 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. Chairman was Thierry Sueur (F) and speakers were Luc Peeperkorn from the European Commission, William Evan Kovacic General Council of the US Federal Trade Commission (FTC), Robert D. Anderson, Councillor of the IP Division of the World Trade Organisation (WTO), Peter Plompen (NL) and Ronald E. Myrick (USA). They presented the situation in the US, the EU and under TRIPS. In the US

IP is considered essentially comparable to other forms of property rights and that "anti-trust" agencies do not presume that IP creates market power in the anti-trust context. It is also recognised that IP licensing is generally pro-competitive. However, "questionable patents" harm competition. In the US it is considered that competition policy is an important contextual factor in relation to the exercise of IP rights and will become more important in the future given the central role of IP in the knowledge based economy.

As far as the EU is concerned, the European Commission also considers that licensing IP rights is often pro-competitive. Regulations on Block Exemption were recently adopted, concerning inter alia licensing of patents, know-how, designs, software and copyrights, and came into force as of May 1, 2004, corresponding to a new approach focusing more on economy. One of its new features is that the Regulation makes a distinction on the solution depending on the fact that the license or and the licenses are or not competitors. The speakers also explained that the TRIPS Agreement provides scope for the enforcement of competition law vis-à-vis anti-competitive licensing practises and hence, article 40 recognises that licensing practises that restrain competition may have adverse effects on trade or may impede technology transfer (article 40.1). Article 40.2 permits WTO members to specify anti-competitive practises constituting abuses of IP rights such as exclusive grant backs, clauses preventing challenge to the validity of an IP right and coercive package licensing, and to adapt measures to prevent or control such practises. It was felt that the EU and the US approach are in line, but the EU is stricter as to certain "intra-brand" restrictions. It was stated that there is a need for harmonisation of anti-trust policy in a global economy and that

structure and scope licenses/IP pools often have a world-wide positive effect, that national departure laws have a world-wide impact, that licensing is essential for an efficient distribution of innovation results, that innovation is a key driver of economic wealth and that it should not be anti-trust intervention on IP licenses in the absence of a naked hard core violation.

WS V – Proposals for harmonisation of rules on enforcement of IP rights. Alternative ways of enforcement to court actions and punitive damages. Chairman was Paul A. Harris (UK) and speakers were Jacques A. Léger (CA), Regina Quek (SG), Carlos T. Mersan (PY) and Luis Torrents (ES). The Chairman stated that the purpose of this WS was to consider particular issues where harmonisation might be possible in the laws of all countries of the world. The presentation started with an explanation of the advantages of arbitration and mediation as an alternative to court actions being considered as faster and more cost effective. Some situations are more appropriate for Alternative Dispute Resolution (ADR) systems than others. Examples where ADR is appropriate are agreements on franchise, distribution, research and development, while it is less appropriate in enforcement or in validity disputes on IP rights. Among the particular advantages of ADR were the confidentiality and the less burdensome of the proceedings, interactivity and experience of the adjudicator, previous agreement on rules of evidence and easier enforcement.

The next topic was the criminal enforcement of IP rights based upon the experience in Singapore, where enforcement takes place under criminal law. The proceedings followed in that country were explained as well as the successful results in seizing infringed goods and the lengthy

prison sentences with the support of statistics. Afterwards the most relevant items of the EU Directive were explained to approximate member state laws, on enforcement of IP rights. It was emphasised the importance of some of the harmonised rules like the ordering of the communication of banking, financial and commercial information, the preservation of relevant evidence, the obligation to provide information relating to the origin and distribution of the infringing goods and provisional measures concerning search, seizure and delivery-up of infringing goods. However, the Directive substantially reduces the means to fight against counterfeiting through criminal actions and does not provide harmonisation. Last but not least, the problems of counterfeiting in MERCOSUR countries (Brazil, Paraguay, Uruguay, Argentina, Chile and Bolivia) was explained due to widespread corruption in administrative and judicial systems and to the insufficient political will to fight seriously and effectively piracy and corruption. In connection with punitive damages it was said that in Paraguay fines are often low and hardly prevent continued infringement.

In conclusion it was said that counterfeiting and piracy practices are growing in MERCOSUR, that state policies are required to tackle them, that small underdeveloped countries are too weak to fight by themselves against counterfeiting and that they need international support. It was also concluded that crime prevention systems need to be put in place and punishment measures should be reinforced, although it was considered unlikely that punitive damages were to be enacted in MECOSUR.

I wish to take this occasion to warmly thank again all the Chairmen, speakers and participants in the WSs for their great contribution to the success of the Congress. ●

Vincenzo M. Pedrazzini

Review of the Congress Geneva 2004 – Administrative Sessions



Vincenzo M. Pedrazzini
Secretary General

During the Congress in Geneva the **General Assembly** of the Association took place. One of the powers of the General Assembly is to adopt changes to the Statutes. As indicated in the last Newsletter, the Bureau proposed some minor changes to the Statutes namely the addition of three Assistants to the Secretary General. Around 800 Members participated in the General Assembly and the Bureau is thankful for the large support its proposal has received. The changes were adopted unanimously with two abstentions.

The Executive Committee is the decision making body of the Association. It convened during the Congress in Geneva on several occasions and decided on the future officers and activities of the Association. As for the **Elections** I can inform you as follows: The Statutes foresee that the President of the Association be appointed by the National Group holding the next Congress. Gothenburg being the venue for the Congress 2006, the Swedish Group appointed the Vice-President, Mr. Orjan Grunden to be the President for the period of 2004 to 2006, replacing the outgoing President, Mr. Gerd F. Kunze (Switzerland). The US Group of AIPPI, being responsible for the Congress 2008, has appointed Mr. Ron Myrick to become the Vice-President of AIPPI. Both appointments were confirmed by acclamation. Other open positions in the Bureau of AIPPI to be manned with new officers were the one of the Treasurer General and the Deputy Secretary General. Mr. William Keefauver (United States) and Mrs. Annika Ryberg (Sweden) decided to retire from their respective positions. They were both thanked for their devotion to the work of the Association. The Executive Committee elected Mr. Jacques Léger (Canada) as Treasurer General and Mr. Michael Brunner (United Kingdom) as Deputy Secretary General.

All remaining officers were re-elected: Mr. Luís-Alfonso Durán (Spain) as Reporter General, Mr. Jochen Bühling (Germany) and Mr. Ian Karet (United Kingdom) as Deputy Reporters General and myself as Secretary General.

The **Reporter General Team** consisting of so far two Assistants was enlarged by a third Assistant. After the re-election of the two longstanding Assistants Mr. Dariusz Szleper (France) and Mr. Thierry Calame (Switzerland), the Executive Committee elected Mr. Nicolai Lindgren (Denmark) to complement the team.

After the adoption of the new Statutes, the **Secretary General Team** now consists of the following Assistants to the Secretary General: Mr. Robert Miller (Australia), Mr. Guillermo Carey (Chile) and Mr. Bertrand Micheli (Switzerland). While Robert Miller and Guillermo Carey will take over the function of liaison officers for their respective regions (Asia, Americas), Bertrand Micheli will be responsible for the Meetings of the Association.

The **Programme Committee** had to replace several Members. Mrs. Karen Dyekjaer-Hansen (Denmark) who has fulfilled her second term and could not be re-elected as well as Mr. Ron Myrick (United States) appointed as Vice-President and Mr. Robert Miller (Australia) elected as Assistant to the Secretary General. Mr. Joseph Straus (Germany) was re-elected as Chairman of the Programme Committee. The re-elected Members are: Mr. Keiji Kondo (Japan), Mr. Gustavo Leonardos (Brazil), Mrs. Esmé Du Plessis (South Africa) and Mr. Alberto Bercovitz (Spain). The Executive Committee elected newly Mr. Thierry Sueur (France), Mr. Are Stenvik (Norway) and Mr. Bertram Huber (Germany) as Members of the Programme



Vincenzo M. Pedrazzini, Secretary General, congratulates Annika Ryberg, former Deputy Secretary General, to her appointment as Award of Merit Holder

Committee. With these elections the professional and geographical diversity within this important Committee is guaranteed.

The **Finance Advisory Committee** had to replace its outgoing Chairman and now Treasurer General Jacques Léger. He will be replaced by Mr. Eiji Katayama (Japan). Mr. Yves Bizollon (France) and Mr. Ricardo Richelet (Argentina) were re-elected as Members of the FAC. Newly elected as Members of the FAC were Mr. Kwanho Shin (South Korea) and Mr. Gunnar Baumgärtel (Germany).

The **Nominating Committee** underwent a major turnaround in order to guarantee a smooth transition during the next elections, where most of the Members are to retire because of the limitation of the term. Mr. George J. Primak (Canada), Mr. Jorge Otamendi (Argentina) and Mr. Masao Okabe (Japan) have decided to retire from their position as Members of the Nominating Committee. Mrs. Hoda Serageldine (Egypt) was re-elected as Chairwoman of the Nominating Committee. Mr. Hans Peter Kunz-Hallstein (Germany), Mr. Jan Helgerud (Norway), Mr. Alain Gallochat (France) and Mr. Yoon-Bae Kim (Korea) were re-elected as Members of the Nominating Committee. Newly elected were Mr. Yoshio Kumakura (Japan), Mr. Lulin Gao (China), Mr. Martin Michaus (Mexico) and Mr. Robert Sacoff (United States) as Members of the Nominating Committee.

On behalf of the Bureau I would like to thank all outgoing officers of the Association. They have all devoted a lot of their time to strengthen the position of the Association. Without committed volunteers the Association would have no impact on the future of Intellectual Property. A welcome goes to the newly appointed officers. We sincerely hope that they enjoy the work

in the Association. Last but not least we thank the officers who confirmed their willingness to further serve the Association. While it is an honour to act as officers for the Association we appreciate the high dedication these people give for the benefit of our Association.

The Executive Committee furthermore approved the **Finances** for the year 2003 as well as the budget 2004 and 2005. The Treasurer General was able to report on the good financial standing of the Association. The financial year 2003 ended with a surplus of around CHF 90'000 bringing the Association's assets to a total of nearly CHF 1.3 Million. Thanks to these reserves the Executive Committee approved the proposal of the Bureau to hire a fifth full time professional for the General Secretariat. The tasks of this new person will mainly be in support of the Reporter General and the Secretary General. The Bureau will now decide on the job description and start the hiring process.

Regarding the **Venues for future AIPPI Meetings**, the Executive Committee had to decide on the venue for the 2012 Congress. The Delegates decided that after the Congresses of Gothenburg (Sweden) in 2006, Boston (United States) in 2008 and Paris (France) in 2010 it would be more than appropriate to return to Asia, where the last Congress took place in 1992 in Tokyo, Japan. It therefore elected Seoul (South Korea) to be the venue for the 2012 Congress.

Last but not least the Council of Presidents had the pleasure to thank three outstanding Members by awarding them with the **Membership of Honour or the Award of Merit** respectively. For his longstanding, reliable and dedicated services, Mr. Robert Mitchell (Canada) was appointed



Vincenzo M. Pedrazzini, Secretary General, congratulates Robert Mitchell to his appointment as Member of Honour

Member of Honour of the Association. Bob served on many different Committees and was the Chairman of the Organising Committee for the Montreal Congress. His dedication to the world of Intellectual Property is known beyond the frame of our Association and we are happy that he devoted so much time and efforts for our Association. Furthermore the Council of Presidents approved the appointment of Annika Ryberg (Sweden) and Bertrand Micheli (Switzerland) for an Award of Merit. Annika served in different Committees before becoming the Deputy Secretary General of AIPPI in 2001. Bertrand was thanked for his efforts in the Meetings Advisory Committee and for his Chairmanship of the Organising Committee for the Geneva Congress.

Let me end this Review by thanking all Presidents and Delegates for their support and trust they have shown during the Geneva deliberations. The Bureau very much appreciates the positive signs received during our Meetings. This serves as motivation to further improve the life of our Association. ●

Bertrand F. Micheli

**Review of the Congress
Geneva 2004 – Social Events**



Bertrand F. Micheli
Assistant Secretary General

Already a beautiful memory, the Geneva Congress accommodated 2'150 participants with an increasing percentage of Delegates and accompanying persons. Apart from the official scientific Programme, the Delegates with their accompanying persons were offered a rich social Programme offering many opportunities to meet each other and to establish new contacts while providing a local touch. The participation at the different Excursions was very high with a total of 1'460 participants attending one of the various proposed venues in and around Geneva. The Congress started with a traditional Opening Ceremony at the concert hall Arena. The participants were welcomed in a typical Swiss atmosphere with alphorn players, yodlers and folkloric groups.



Several speakers such as Mr. Francis Gurry, Deputy Director General of WIPO, Mr. Roland E. Grossenbacher, Director of the Swiss Federal Institute of Intellectual Property, Mr. Kamen Troller, President of the Swiss National Group of AIPPI and Member of the Organising Committee and last but not least the former President of AIPPI, Mr. Gerd F. Kunze, addressed the audience during the Opening Ceremony of the Congress. Between the speeches typical Swiss folkloric animation was presented.

At the end of the official part of the Opening Ceremony, an aquatic show was performed with water jets in synchronization with music and light. The Opening Ceremony was followed by a Welcome Reception at the Car's Museum where everyone could drink and eat while contemplating some of the dream cars in the museum.



On Monday evening, three different events were offered to the participants. A Cruise on the lake on three Belle Époque-boats was enjoyed by more than 900 persons. Participants were welcomed by a Jazz Band which then enlivened the evening on the boats. All the participants were brought together on the higher decks to admire the departure of the three boats in the Geneva's rade. A dinner was served on board later.



Another opportunity was to attend a Concert at Saint-Pierre's Cathedral where the Diakoff Choir together with the brass Ensemble Ad Libitum enchanted the participants. A cocktail was then offered outside the Cathedral in the heart of the old town of Geneva.



The third option was to attend a ballet especially created for AIPPI by the Rudra Béjart Ballet school. The ballet was hosted in an old industrial building where a cocktail was offered before the performance. Everyone greatly appreciated the freshness and the enthusiasm of the young dancers coming from all over the world. The day after, people with stars in their eyes, still spoke about this wonderful evening.



Last but not least a closing Gala Dinner that had required much preparation and innovation was held within the Congress Center. The participants were invited to join one of the exhibition halls, but when entering, they found an astonishing black structure, decorated with lasers and beautiful decorated tables. The dinner was appreciated just as the fantastic spectacle performed by the modern circus Exos. At the end of the spectacle, the scene built in the medium of the room was lifted up, discovering a dance track. At half past one in the morning the room was still crowded which is usually a synonym for a successful evening.



The local Organising Committee together with MCI take this opportunity to thank all participants and we sincerely hope to meet you again in great numbers at the next Congress of AIPPI in Gothenburg in 2006.

Alain Gallochat

WIPO SPLT – Summary of the 10th Session, Geneva, May 10–14, 2004



Alain Gallochat
Chairman Q170

In the AIPPI Newsletter issue No. 13 of March 2004, our Reporter General, Luís-Alfonso Durán presented a Review of the AIPPI Seminar on the SPLT held in Geneva at WIPO headquarters from January 29 to 30, 2004.

During this Seminar, the Resolution adopted at the October 2003 Lucerne ExCo was discussed and it appeared then that several issues needed an in depth study, namely the concept of novelty in relation with the effect of earlier patent applications not published when the later applications are filed, and the conditions for a harmonized grace period system.

For more information see:
www.aippi.org > Publications & Services
> online Publications > Reports of Representatives at WIPO

The Special Committee Q170 prepared a Questionnaire on these issues which was sent to the National and Regional Groups, in order to get an opinion serving as a basis for preparing a draft Resolution to be debated at the Geneva Congress. In the meantime, as it was initially scheduled, the 10th Session of the Standing Committee on the Law of Patents (SCP) was held in Geneva, at WIPO headquarters from May 10 to 14, 2004.

Before the meeting of the 10th Session of the SCP, and in order to have a common position during said Session, a preliminary meeting of NGOs was held in Geneva (WIPO) on May 9, 2004. This preliminary meeting was a follow-up of the Seminar organized by AIPPI at the end of January 2004.

This preliminary meeting was limited to NGOs and gathered around 20 of them under a co-organisation of AIPPI, AIPLA and FICPI; all the NGOs agreed that a limited number of issues should be discussed at the SCP Session in order to get out of the deadlock situation. As a matter of fact, since the 9th Session of SCP, in May 2003, several NGOs had internal discussions leading to Resolutions: AIPPI in October 2003 (Lucerne ExCo), NGO's Round Table in London (November 2003), FICPI in February 2004 (Singapore ExCo) and the Industry Trilateral comprising representatives of industry from Europe, Japan and the United States. Taking into consideration the position as expressed through said Resolutions, it was agreed that the following articles of the SPLT should be debated in a first reduced package:

- Article 1 (Abbreviated expressions)
- Article 3 (Applications of the Treaty/Patent applications)
- Article 4 (Right to a patent, including its

- § 3 dealing with the 1st to file system)
- Article 8 (Prior art)
- Article 9 (Grace period)
- Article 12 (limited to § 2 and 3/ novelty-inventive step)

This common position was very similar to that expressed by the European Patent Office, the Japanese Patent Office and the United States Patent and Trademark Office during their trilateral discussions.

The 10th Session of the SCP as such was held in Geneva (WIPO) from May 10 to 14, 2004; it was opened by Francis Gurry (Deputy Director General) and chaired by Alan Troicuk (Canada), Philippe Baechtold acting as Secretary.

During the whole day of May 10, the general concept of a limited package was debated; this latter was presented by the American and Japanese delegations together with the EPO, and was strongly supported by various delegations and NGOs (among which AIPPI, the Reporter General of which had the opportunity of presenting its position). However several delegations (under the leadership of Brazil, India, Dominican Republic, Argentina and Egypt) strongly opposed to such a limited discussion; according to such delegations, all the articles of the SPLT were of importance and should be discussed without any priority given to any article. As a conclusion, it was decided that all the articles should be debated in numerical order, starting with Article 8 (Prior art), leaving the WIPO General Assembly of September 2004 to decide upon the future programme of the SCP.

Finally, only Article 8 (Prior art), 9 (Grace period), 10 (Enabling disclosure), 11 (Claims), with their related Rules, and Article 12 (§ 1 and 5) were discussed during the following days.

During those three days (May 11–13), the debate was very similar to the previous ones on these issues and the delegations mainly repeated their positions; the situation can be summarized as follows:

- Article 8 and Rules 8 and 9: Article 8.1 continues to be provisionally accepted (while Article 13.3 continues to be kept with square brackets), for a majority of delegations, the effect of earlier applications (Article 8.2.a) should be limited to the novelty while others (mainly the USA) are of the opinion that the effect should be for both the novelty and inventive step. Interestingly, the concept of "enlarged novelty" has been discussed and the International Bureau will study this issue. There was still no consensus on Article 8.2.b, and both alternatives A and B are maintained.
- Article 9: All the delegations but one (the Islamic Republic of Iran reserved its position) are in favour of a grace period system; there is no consensus for its duration (6 or 12 months), for the declaration to be filed, for the third parties rights.
- Article 10 and Rule 10: Wording to be reviewed by the International Bureau; some delegations would like to state that the "person skilled in the part" should be that of the country in ...
- Article 11 – Article 11.1 and 11.3: Shall be reworded, while the Article 11.2 is provisionally accepted; no consensus on Article 11.4.
- Article 12.1 and 12.5: The "technical character" is still to be debated later, and discussions on the relationship between this Article and Article 27 of the TRIPS Agreement (mainly its paragraphs 2 and 3) did not allow reaching a consensus.

Finally, on May 14, the discussion was focused on the future programme of the SCP and the preparation of the summary by the Chair; the debate was particularly confused since some delegations disagreed on the way they failed to reach a consensus, while others denied any authority to the General Assembly of September to discuss on the future programme of the SCP. Nevertheless, "a room has been tentatively booked during the second half of November 2004" for holding the 11th Session of the SCP.

Under such circumstances the SC Q170 prepared a draft Resolution considering the answers which were received from the National and Regional Groups (around 35 answers), relating to Articles 8 and 9 of the draft SPLT; the Resolution which was adopted at the Geneva Congress states that:

- a) concerning Article 8
 - 1) the whole contents (i.e. claims, description and drawings) of the earlier application shall be taken into consideration;
 - 2) earlier applications in a country shall be considered only when assessing the novelty of the later application in that country wherein the concept of novelty shall not be limited to photographic novelty but shall also include what the person skilled in the art reads as disclosed in the application;
 - 3) when the earlier application is considered as an earlier application only as a result of claiming a priority, it will be considered as prior art only when the relevant information is contained both in the earlier application and in the priority document;
 - 4) only PCT applications which have entered into the national or regional phase shall be considered as elements of the prior art;
 - 5) there may be an exception for earlier

applications which have been made by, at least partly, the same applicant as the later application or for disclosures contained in earlier applications based on misuse of information derived from the later application.

- b) concerning Article 9
 - 1) the term for the grace period shall be 12 months before the filing date or, if a priority is claimed, the priority date, i.e. the patent application shall be filed no later than 12 months after the public disclosure coming directly or indirectly from the inventor;
 - 2) a declaration by the applicant confirming that he is entitled to benefit from such grace period may be required.

It is to be noted that, related to the grace period conditions, the prior users rights have been also considered, it being reminded that, in this respect, the provisions of the Resolution on Q89 D adopted at the Amsterdam ExCo in 1989 shall apply.

The AIPPI position expressed in the Geneva Resolution is very useful for the AIPPI representative at future discussions, if any; some delegations during the 10th SCP meeting contested the possibility of modifying the working programme for the SCP discussions; however, it is up to the Director General to fix the agenda of such September General Assembly and the programme for future SCP meetings on SPLT. In case there is no consensus on such a programme, an alternative is to continue the discussions for the interested countries: such an approach should present a substantial interest for the users of the patent system, which in no case have to be limited to the applicants; however, such an approach could be no longer monitored by WIPO and therefore might present political consequences. ●

Alexander Harguth

WIPO Advisory Comm. on Enforcement – 2nd Session, Geneva, June 28–30, 2004



Alexander Harguth
Chairman Q185

The 2nd session of the WIPO Advisory Committee on Enforcement (ACE) was held in Geneva from June 28–30, 2004.

Issues around enforcement of Intellectual Property rights are a field to which the WIPO has begun to allocate an increasing amount of resources. It is within this context that the ACE must be seen, with its responsibility for global enforcement issues. It represents a forum for discussions and enables the exchange of national experiences. The ACE is mandated to provide technical assistance, coordination and co-operation, whereas norm-setting issues are excluded from its mandate.

The 2nd session of the ACE was opened by Mr. Wolfgang Starein, Director of the Enforcement and Special Projects Division and was chaired by Mr. Henry Olson, Special Government Advisor, Swedish Ministry of Justice. The meeting was attended by 143 representatives from 62 Member States, 3 Inter-Governmental Organizations and 13 Non-Governmental Organizations including AIPPI.

The topics which were considered by the committee during this 3-day event concerned civil and criminal proceedings, the role of the judiciary and administrative authorities and more specifically issues such as the impact of the costs of proceedings and the question of the need for specialized courts. The committee heard presentations by seven high-ranking senior judges and government officials from around the world revealing inter alia parallels between common law and continental law systems, but also showing different ways of addressing this difficult matter. This was also the starting point for discussions in the plenum.

The plenary generally agreed that common efforts in view of better enforcement schemes are crucial and that the ACE should continue in the future to play the role of a discussion platform. It was explicitly emphasized during the session that counterfeiting was still on the increase and that this phenomenon significantly endangered national economies. This is also the reason why there is an increasing interest in this problem within the Member States.

During the session a wide range of important issues were addressed. One of the points emphasized concerned the question of specialized courts. Due to the complicated nature of Intellectual Property disputes, some delegations particularly emphasized the need for specialized courts, whereas others

pointed to the difficulties surrounding the establishment of such courts. In the same context, the committee identified the long term solution as being education and agreed on the importance of continued training for judges. The committee also addressed the question of determining damages in the different legal systems and noted that there are differences from Member State to Member State.

A further important issue focused on the costs of Intellectual Property litigation, which have been viewed as a handicap for effective enforcement systems. Different concepts of how such costs could be reduced were presented and discussed. Some delegates indicated that the implementation of administrative or alternative dispute resolution procedures could help to make the enforcement of Intellectual Property rights more affordable for the right holders.

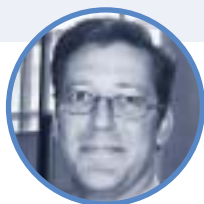
It was also suggested that the right holders should be more actively involved in enforcement measures such as proceedings related to the obtaining of evidence and the identification of infringing goods. Some delegates expressed the wish that the right holder should play a more important role in criminal proceedings.

As regards further work of the committee, it was proposed by the members that the third session in 2005 should deal with education and awareness building. Several delegates expressed an interest in discussions on specific issues such as border enforcement and the comparison of enforcement activities in developing, transition and industrialized countries.

Documents related to the ACE session containing extensive information may be found on the WIPO Website on enforcement www.wipo.int/enforcement/en/. ●

Gustavo Leonardos

Review of the XXIV Seminar of the Brazilian National Group, Brasília, August 16-18, 2004



Gustavo Leonardos
President of the Brazilian National Group

The Brazilian Group of AIPPI held its XXIV Seminar on Intellectual Property in the Brazilian capital, Brasília, from August 16 to 18, 2004, with a total attendance of 568 participants, 122 of which from abroad. The Seminar had a political tone due to the recent Bills on IP rights introduced before Congress, the promulgation in July of a Presidential Decree restructuring the Brazilian Patent and Trademark Office and the Report of the Parliamentary Committee on Piracy which had been delivered to the President the previous week. Adding to this picture, the US Government is threatening to withdraw Brazil from the Generalized System of Preferences, which accounts for 2.5 billions of dollars of Brazilian exports, if until September 30, 2004 there is no progress in the combat against Piracy by the Brazilian Government.

The Seminar, therefore, discussed IP rights issues which resulted from the New Innovation Bill, to the administration of the Brazilian Patent and Trademark Office and to the combat against Piracy, the latter divided in three different sections, namely, the Social Economical Impact of Piracy, Border Measures and the Conflicts between Incentives to IP and the Fair Use Doctrine. Besides, panels on current patent, trademark, competition and biodiversity law issues were held.

Several Government authorities participated as speakers, including the President of the Brazilian Superior Court of Justice Minister Edson Vidigal, the Vice-President for the Parliamentary Committee on Piracy Congressman Mr. Julio Lopes, the President of the International Revenue Agents Mr. Reynaldo Velasco Puggi, the Under Secretary for Legal Matters at the Executive Office of the President Mr. José Antonio Dias Toffoli, the acting President of the Patent Office Mr. Luiz Beaklini, the

Secretary for Industrial Technology Mr. Roberto Jaguaribe, the Director of the Economic Regulation Department Mrs. Barbara Rosenberg and Senator Paulo Otávio, who received the participants of the Seminar for a reception in the Brazilian Federal Senate followed by the exhibition of a film promoted by the Motion Picture Association.

From abroad, we received Mr. John Newton who works for the Interpol IP Crime Action Group, Ms. Victoria Espinel, Deputy Assistant USTR for IP Office of the United States Trade Representative, Professor Dr. Joseph Straus, Head of AIPPI's Programme Committee, Mr. Nuno Pires de Carvalho, Deputy Director of the IP Law Department of the World Intellectual Property Organization, Mr. Adrian Otten, Director of the IP Division of the World Trade Organization and Mr. Luzius Wasescha, Director General for World Trade of the Swiss State Secretariat for Economic Affairs. The last two participated in the closing section "IP and International Trade" together with the Brazilian Ambassador in Geneva Luiz Felipe de Seixas Corrêa and Brazilian Ambassador Regis Arslanian, Director of the Department of International Negotiations of the Foreign Affairs Ministry, discussing the complex trade policies behind a possible TRIPS Plus Agreement.

The Seminar deepened the relation between the Brazilian National Group of AIPPI and the Brazilian Government, allowing the Brazilian Group to comment on several pending pieces of legislation, being invited to participate on the creation of IP Antitrust Directives by the Ministry of Justice and to participate in the proposal of a cooperation agreement for the combat of piracy between Interpol and the Ministry of Justice. ●



The speech of the Senator Paulo Otávio during the Opening Ceremony

Ruth Vogt

AIPPI – Future Events



Ruth Vogt
Assistant in charge of AIPPI Meetings

INTERNATIONAL MEETINGS			
2005	EXCO & Forum	Berlin, Germany	September 23–28
2006	40 th World Congress	Gothenburg, Sweden	October 8–12
2007	EXCO & Forum	Singapore	October
2008	41 st World Congress	Boston, MA, USA	September 6–11
*2009	EXCO & Forum		
2010	42 nd World Congress	Paris, France	October 1–6
*2011	EXCO & Forum		
2012	43 rd Congress	Seoul, Korea	

*These dates are still open. For the EXCO/Forum to be held in 2009 we shall later this year send out a Questionnaire to the AIPPI Groups inviting them to extend their invitations. For more detailed information on the AIPPI Meetings and the respective Questionnaire you are cordially invited to contact the AIPPI General Secretariat in Zurich at any time.

**FORUM and EXCO in Berlin
September 23–29, 2005**

It will be for the first time in the history of the Association that an EXCO Meeting will be combined with a Forum. All responsible bodies will make every effort to offer an attractive and interesting programme for both, the Forum and the Executive Committee Meeting. For the scientific programme of the EXCO Meeting three new Working Questions have been adopted in Geneva and for the Forum four topics of interest will be considered.

Invitations and preliminary programmes with registration forms will be sent out early in 2005. The Forum will be open to all AIPPI Members and also non-Members, the Executive Committee Meeting, however, will be limited to the Delegates of our National and Regional Groups. Please benefit from the news and information published on our Website: www.aippi.org.

The Bureau of AIPPI and the German National Group have already started with the preparations for these two events some time ago. They are very much looking forward to welcoming many of you in Berlin.

NATIONAL AND REGIONAL SYMPOSIA AND CONFERENCES

We have so far been informed of the following events:

2004	Seoul International Conference on Intellectual Property & Licensing	Seoul, Korea	October 30–November 1
2005	Intellectual Property and Export Markets: Lessons from Here and Abroad	Trembland, Canada	February 3–4
2005	Helsinki Symposium The Enforcement of Intellectual Property Rights	Helsinki, Finland	March 6–8

For more information please contact the respective National Group directly.

All National and Regional Groups are cordially invited to send us information on any National or Regional Symposia or Seminars which they will organise. We are happy to announce these events in our Newsletter as well as on our Website with the possibility of a link to the event Website.