

Working Questions Helsinki 2013

Explanatory Note

Q233 Grace period for patents

The recent adoption of the Leahy-Smith America Invents Act in the U.S. has provided an opportunity to restart long-stalled discussions on substantive patent law harmonization. The heads of the world's five largest intellectual property offices, who refer to themselves as the IP5, have noted the importance of maintaining the momentum toward harmonization of patent laws and agreed to establish an expert panel to continue discussions. The so-called "Tegernsee Group", which was formed in July 2011 and is comprised of the heads of the European, Danish, French, German, UK, Japanese and United States patent offices, is undertaking a comparative analysis of substantive patent laws, with a view to identifying and studying areas of patent law that can be substantively aligned. The grace period has been highlighted as one of four issues for near term focused effort. Equally, the Japanese Group of AIPPI recently surveyed the National Groups of AIPPI in order to identify those patent law harmonization issues that are considered to be most urgent. The grace period has been identified as one of these issues.

Therefore, adoption of a grace period can be considered a key requirement in realizing international harmonization of substantive patent law. It is against this background that we propose to study the grace period for patents in the framework of a working question for Helsinki in 2013. AIPPI has acknowledged the necessity of adopting a grace period in principle in previous Resolutions (for instance in Q75 in 1980/ 1982 and in Q170 regarding the Substantive Patent Law Treaty [SPLT] in 2004). However, the specific conditions have not been studied in detail in the framework of a working question. The traditional AIPPI working method is well suited to conduct an in-depth comparative analysis of specific conditions of a modern grace period involving multiple countries. What should the ideal scope of the grace period be? How long should the grace period be? Should a declaration by the applicant confirming that he is entitled to benefit from such grace period be required? By studying these questions, among others, AIPPI hopes to make an important contribution to the current substantive patent harmonization discussions.

Q234 Relevant public for determining the degree of recognition of famous marks, well-known marks and marks with a reputation

The question of the relevant public for determining the degree of recognition of a mark was discussed in Paris in 2010 when AIPPI adopted Resolution Q214 dealing with the protection against dilution of a trademark. The working guidelines Q214 discussed whether the general public at large or a relevant sector of public would be the relevant public in determining the knowledge, recognition or fame of a mark. This prompted mixed answers by the Groups. A number of Groups noted that the relevant population for determining the knowledge or reputation of a well known mark or a mark with a reputation is the public that is concerned by the products or services covered by the protected mark in question. In these jurisdictions, recognition or a reputation in a niche market is sufficient. In other jurisdictions, however, the relevant population in determining the degree of recognition of a famous or even a well known mark or a mark with a reputation is the entire consuming public of the country; i.e. recognition in a niche market is not sufficient.

The Resolution Q214 eventually adopted in Paris states that the relevant public in determining the recognition or fame of a mark depends on the public concerned by the products or services covered by the trademark and can be a limited product market. However, in the working committee Q214 in Paris it became clear that the issue of the relevant public requires further study and should be made the subject of a separate question. Specifically, not only the qualitative aspect of the relevant public (what is the relevant public?) should be studied in more detail, but also the quantitative aspect of the relevant public (what part of that relevant public is required, e.g. the entire public or a significant part of that public?). It is against this background that we propose to take up the question of the relevant public again and study it in more detail in the framework of a working question for Helsinki in 2013.

Q235 Term of copyright protection

Alternatively, we propose to study the term of copyright protection. The political discussion about copyright protection is ongoing. One of the issues brought up by interested parties who would like to limit copyright protection is a limitation of the term of protection. Different models are discussed, for example a term of protection only for the lifetime of the author or a term of protection depending on the type of work. The revised Bern Convention sets a minimum term of protection of 50 years after the death of the author, but allows exceptions for certain types of works, for example photography or applied art (which may not be less than 25 years after creation). In the European Union, there is even a fixed term of protection of 70 years after the death of the author. Due to these international rules, a national legislator would not be free to decide on a term of protection. Accordingly, it makes sense to discuss the topic of limitation of copyright term on an international level.

Q236 Relief in IP proceedings other than injunctions or damages

The availability of relief for infringement is fundamental to the protection of intellectual property rights (IPRs). In Hyderabad last year, AIPPI adopted Resolution Q219 regarding injunctive relief in the case of infringements of IPRs. In Boston in 2008, AIPPI adopted Resolution Q203 dealing with damages in the context of trademark infringement, and notably counterfeiting and piracy of trademarks. Besides injunctive relief and damages, there are other remedies permitting 'effective action against any act of infringement' (Article 41 (1) TRIPS) which AIPPI has not studied so far. We propose to explore the availability of relief in IP proceedings other than injunctions or damages.

These other forms of relief include, for example, seizure of infringing goods, delivery up and destruction of infringing goods, rectification, publication of the court's judgment and declaratory relief. In addition, there may be other forms of monetary relief than damages, e.g. account of profits where the infringer is asked to surrender the profits earned as a result of the IPR infringement. While the Working Guidelines Q203 briefly addressed account of profits, the Working Committee and, hence, the Resolution Q203 did not further consider account of profits as a separate form of monetary relief. Alternatively, the plaintiff may obtain an award of monetary reparation for moral tort or an award of reasonable royalty based on unjust enrichment law. Finally, in addition to these more general forms of relief, there are also other forms of relief which are heavily fact specific, e.g. alteration of infringing goods such as change/removal of packaging, and modifications to technology by way of a workaround.

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