

Summary of Resolutions adopted by Executive Committee in Helsinki 2013

Q233 Grace period for patents

AIPPI has passed resolutions relating to grace periods for patents in connection with two prior working questions: Q75, Prior disclosure and prior use of the invention by the inventor (Buenos Aires Congress of 1980 and Moscow Executive Committee of 1982); and Q170, Substantive Patent Law Treaty (Lucerne Executive Committee of 2003). However, recent changes to relevant national laws and renewed interest in harmonization in this area have made the topic ripe for reconsideration by AIPPI at this time.

AIPPI's Executive Committee adopted a resolution in support of an internationally harmonized grace period for patents having a duration of twelve months preceding the filing date of the patent application or, if priority is claimed, the earliest relevant priority date. The grace period would exclude from the prior art against the inventor or his successor in title any disclosure to the public by means of a written or oral description, by use, or in any other way, made: a) by the inventor or his successor in title, irrespective of whether such disclosure is intentional or not; or b) by a third party who derived the content of the disclosure from the inventor or his successor in title, irrespective of whether such disclosure results from an abuse in relation to or was made against the will of the inventor or his successor in title. The resolution clarifies that the grace period shall not exclude from the prior art: a) disclosures from a third party which are not derived from the inventor or his successor in title, even if said disclosures occur after a non-prejudicial disclosure; and b) disclosures resulting from the proper publication by an Intellectual Property Office of an application for or the grant of an intellectual property right filed by the applicant or his successor in title. AIPPI resolved that the applicant or his successor in title shall benefit from the grace period without being required to deposit a declaration.

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

Following an interesting discussion AIPPI's Executive Committee adopted by a vast majority of 99% a resolution on the relevant public for determining the degree of recognition of famous marks, well-known marks and marks with reputation.

In short AIPPI resolved that the relevant public must always be determined on a case-by-case basis in light of the goods and services to which the mark applies. In the determination all relevant circumstances should be taken into consideration.

Furthermore, AIPPI resolved that the term "well-known marks" should be used as a legal term of art only for marks as referred to in Article 6*bis* Paris Convention and Article 16 (2) and (3) TRIPS.

AIPPI affirmed WIPO's "Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks" in its general approach to the determination of whether a mark is well-known in a given country (part I) and the scope of protection (part II) to be accorded against conflicting marks (Article 4).

AIPPI further resolved that the relevant public for determining whether a mark is well-known should be the segment of the general public involved with the goods or services to which the mark applies rather than the general public. But AIPPI also acknowledged that in certain cases, if the goods or services to which the mark applies are purchased, recognized, or used by the general public, then the relevant public should be the general public at large.

Q235 Term of copyright protection

AIPPI has not previously studied term of copyright protection as a stand-alone question. The term of protection of copyright is governed by international treaties, which have set minimum standards of protection, such as the Berne Convention amended in 1979, TRIPS 1994 and the WIPO Copyright Treaty 1996. The maximum term, however, has not been set by such treaties. The term has been adjusted in an upward direction in many countries, some of which were brought about by Free Trade Agreements (FTA).

AIPPI resolved that a maximum term of copyright should be introduced in relevant international treaties and that the maximum term of copyright should not exceed 70 years pma of the last deceased author when the term is calculated on the basis of the life of the natural person. AIPPI also resolved that different types of copyrighted work should in principle enjoy the same term of copyright protection and that the term of copyright for industrial products should not differ from the term normally applied to other copyrighted works.

Q236 Relief in proceedings other than injunctions or damages

AIPPI has previously passed resolutions relating to injunctions and damages but has not considered, as a dedicated question, other forms of relief available where intellectual property rights are infringed. Such additional relief may include declaratory relief, delivery up/surrender or destruction of goods, rectification, alteration of infringing goods, corrective advertising, publication of judgement, orders to provide information and monetary relief other than damages.

By a majority of 98%, AIPPI's Executive Committee adopted a resolution concerning additional relief available in *inter partes* proceedings of a court or like administrative body following the findings on the merits of the case. In summary, AIPPI resolved that courts should have the power to award additional relief that is appropriate to the circumstances, reasonable, practical and proportionate. In combination with damages and injunctions, additional relief should be effective to prevent and/or dissuade further infringement. In appropriate circumstances, courts may take into account the interests of, and hear third, parties when determining whether to award additional relief. AIPPI also resolved that, in contested cases, courts should give reasons for rewarding or refusing additional relief and such reasons should in general be publicly available. The manner in which judgements are made available should have a bearing on orders requiring corrective advertising.

AIPPI also resolved the court should have the power to award legal costs.

Q212 Plain Packaging

In several jurisdictions, legislation regarding a requirement for tobacco products to have "plain packaging" (sometimes referred to as "standardised packaging") is being considered, while in Australia such has in fact been adopted. In a previous question, AIPPI has studied issues relating to the influence of advertising restrictions on trademarks. Furthermore, on December 17, 2010, the Bureau of AIPPI submitted its views on the possible revision of the European Union's Tobacco Products Directive 2001/37/EC. However, AIPPI has not previously passed a resolution regarding plain packaging.

AIPPI's Executive Committee now resolved that the use of a trademark by a trademark right holder on products or packaging thereof should in principle not be restricted in the sense contemplated by plain packaging. Exceptionally such use may be restricted for public interest reasons, but only if (i) it is documented that such public interest reason exists and the restriction at issue will likely have the intended effect; and (ii) the restriction is neither disproportionate, nor unreasonable (and there are thus no reasonable alternatives); and (iii) the public interest reason outweighs other interests (such as, without limitation, the interest of consumers to distinguish products, the interest in limiting trade in counterfeit goods, the interest in legal certainty and the interest of trademark right holders to protect their investment in trademarks registered or acquired in good faith and lawfully).

AIPPI further resolved that a restriction in the sense contemplated by plain packaging should not constitute an obstacle to an application to register or registration of a trademark, for those products, nor should it constitute a ground for cancellation. Equally, non-use or limited use of a trademark by reason of plain packaging should not provide a basis for cancellation of a registered trademark under Article 5C Paris Convention.

Q162 Rules of Procedure

In June 2013 the Preparatory Committee published a draft of the Rules of Procedure of the Unified Patent Court (UPC) and invited stakeholders and interested parties to submit written comments until 1 October 2013. In July 2013, the Bureau decided to participate in this important project and to this end set up a task force and invited all National and Regional Groups to submit comments. In August, the task force prepared consolidated comments which were again open to comments by the contributors and other interested parties. In Helsinki, an introductory session was held followed by a drafting session where the consolidated comments were discussed. A number of controversial issues emerged where no consensus could be found. These points were voted upon by AIPPI's Executive Committee. Some of these issues included the following:

According to Article 33(3) of the Agreement on the UPC the local or regional division has the discretion to refer the counterclaim for revocation to the central division and suspend or proceed with the action for infringement ("bifurcation"). AIPPI resolved that where the panel of the local division decides to bifurcate, it should have to give an opinion on the reasons for bifurcating. Moreover, in deciding on the bifurcation, the panel of the local division should consider whether in a particular case scope of protection and validity must be jointly considered. AIPPI further resolved that where the local division decides to stay the action for infringement following bifurcation the local division must give reasons why it sees a high likelihood that the relevant claims of the patent will be held invalid. AIPPI also expressed some concern at the possibility of an "injunction gap" in

bifurcated actions and suggested that the central division be required to accelerate bifurcated revocation claims.

AIPPI noted that a one day oral hearing may not suffice depending on whether both infringement and validity is in issue; the number of patents in suit; the number of parties (especially defendants); and the complexity of the technology. AIPPI also welcomed the intention to bring UPC actions to trial within one year and resolved that stays should always be discretionary and ordered only exceptionally. Finally, AIPPI resolved that the system need not include an elaborate system of protective letters.