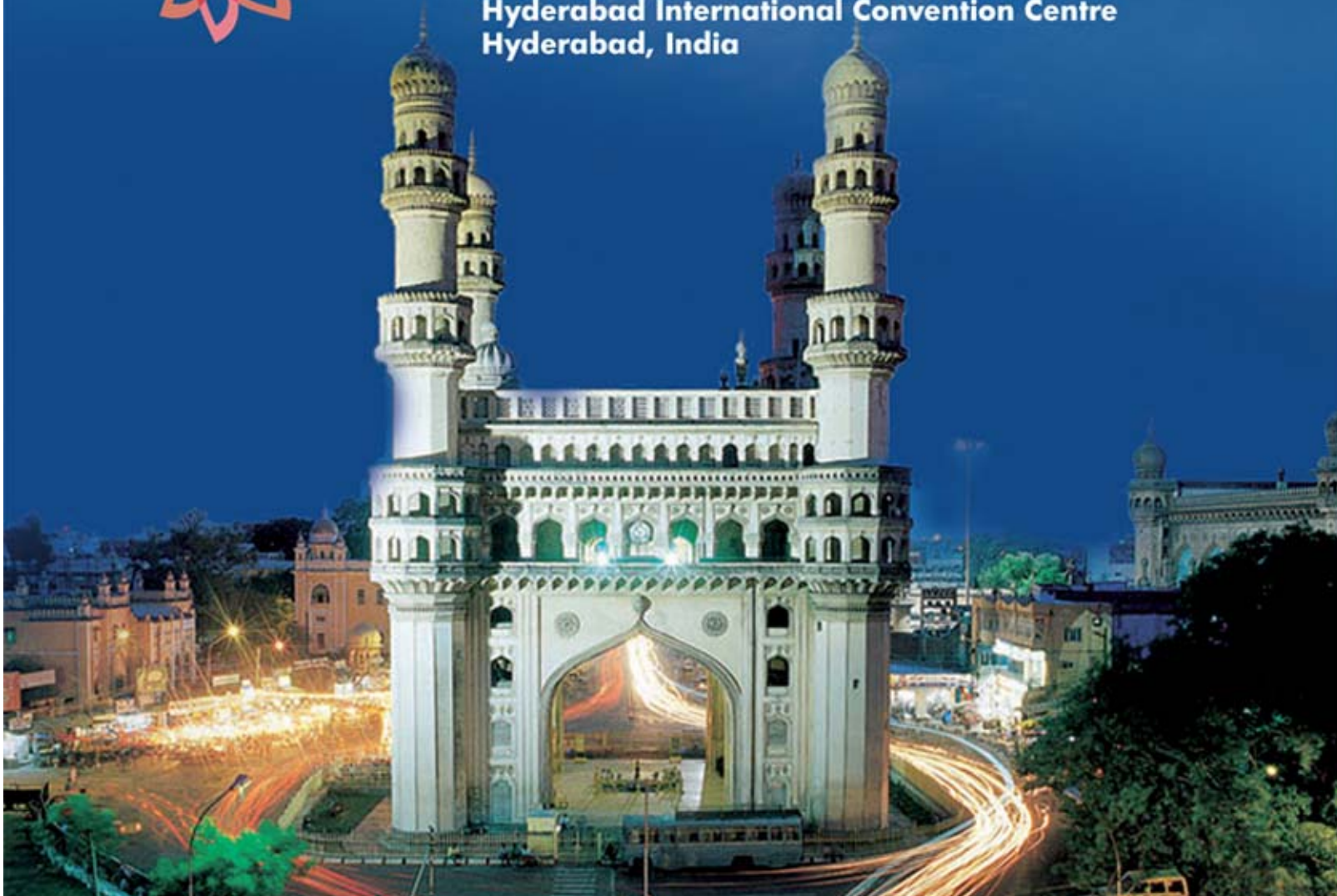




AIPPI Forum & ExCo 2011
13 – 18 October 2011
Hyderabad International Convention Centre
Hyderabad, India





Report on Hyderabad Forum & ExCo 2011





Forum

- Workshops
 1. India and the Madrid Protocol
 2. Geographical indications and developing countries
 3. Interim relief in IP infringement cases
 4. Reconciling indigenous rights & IP protection
 5. Inventorship for multinational inventions involving IP issues resulting from outsourcing
 6. Software protection strategies
 7. Social networks – implications on trademark and domain name protection
 8. Border measures and goods in transit



Forum

- Pharma Sessions
 1. Protection of new medical uses and exceptions for medical treatment in patent law
 2. Experimental Data – the standard to be met to support patentability of a potential biological pharmaceutical
 3. Securing patent protection for therapeutic antibodies
 4. Regulatory approval – patent linkage

Forum Observations (unofficial)

- Pharma sessions very popular
- General impression that overall quality of workshops was higher than prior years
 - More understandable speakers
 - Choice of strong, experienced moderators very helpful to program quality
- High level of U.S. involvement
 - All 4 pharma sessions
 - 5 of 8 workshop sessions



Scientific Work



- Workflow
 - Working questions proposed by Programme Committee and Bureau
 - Working questions approved by ExCo
 - Working guidelines prepared by RGT and distributed to national and regional groups
 - Groups research and prepare group reports
 - RGT prepares summary report
 - Working committee leadership prepares a draft resolution and circulates to committee members
 - Working committee meets to debate resolution
 - Resolution is discussed/amended in plenary working session
 - ExCo votes on resolution (with any additional changes)



Hyderabad Resolutions



- Q216: Exceptions to copyright protection and the permitted uses of copyright works in the hi-tech and digital sectors
 - Q216 was split in two parts; Q216A was already the subject of a resolution at the Paris Congress in 2010
 - Q216A dealt with activities of ISPs, format shifting, and orphan works
 - Q216B deals with user-generated content, transient/temporary copies, private copying, copyright levies and hypertext links



Q216B Resolution



- National laws should be harmonized with respect to exceptions to copyright protection, relying on the Three-Step-Test
- In general no obligation for UGC service providers to monitor for infringing works
 - Take-down and stay-down duty where rights holder has provided prima facie evidence of specific infringement
- Providing user-actuated hyperlinks to a copyright work, in and of itself, is not a reproduction of the work
 - Providing a link to a copyright work already available to the public on the internet with authorization of the rights owner is not a further act of making available to the public
 - Search engines, helping users to access such works, should be able to rely on exceptions to copyright protection



Q216B Resolution

- May search engines rely on an implied license when rights holders make copyright works available on the internet without blocking search engine access?
 - No, only if so provided by national jurisdictions
- Transient copies:
 - For a computer program, transient copies exempted from copyright protection where copies necessary to perform or secure a lawful use of the program
 - For other works, transient copies exempted where the copies are supportive of a lawful use, technical means employed are content neutral, and copies have no economic significance
- Copyright exceptions should allow for private copying of electronic works, but only for non-commercial use
 - May be further restricted by national law
 - No resolution was reached regarding copyright levies



Hyderabad Resolutions



- Q217: The patentability criterion of inventive step non-obviousness
 - Three-part study
 - Q209 (Buenos Aires) considered inventive step in the limited context of selection inventions
 - Q213 (Paris) considered definition of the person of ordinary skill in the art in the context of the inventive step requirement
 - Q217 (Hyderabad) considers the broader general question of the standard for inventive step / non-obviousness

Q217 Resolution

- WC chaired by Marc Richards (USA)
 - Considerable differences evident in group reports and during WC meeting between problem-solution jurisdictions and others
 - Introductory presentation by EPO director Bertrand Gellie was very helpful in moving the working session toward consensus





Q217 Resolution



- There should be a common definition of inventive step / non-obviousness accepted across all jurisdictions worldwide and that this definition should be applied in a consistent and uniform manner in all administrative and judicial proceedings within a relevant jurisdiction
- A claimed invention shall be considered to involve an inventive step, if, having regard to the differences between the claimed invention and the prior art, the claimed invention as a whole would not have been obvious to a person skilled in the art at the filing date or, where priority is claimed, the priority date, of the application claiming the invention



Q217 Resolution

- Practical application of definition
 - for evaluating inventive step / non-obviousness, the following framework is useful:
 - a) Identify the relevant prior art bearing in mind the nature of the invention;
 - b) Identify the difference(s) that distinguish the claimed invention from the relevant prior art;
 - c) Consider whether or not it would have been obvious for a person skilled in the art to have modified the relevant prior art to obtain the invention as a whole based on factors such as, but not limited to, common general knowledge, disclosures in the prior art, the technical problem to be solved and/or technical effects.

Q217 Resolution

- Lack of inventive step of a claimed invention may be shown over a single prior art reference missing one or more elements of the claimed invention, if such one or more elements were within the common general knowledge of a person skilled in the art
- Two or more prior art references may be combined to prove lack of inventive step, but a reason to combine the references is required. The reason to combine the references does not need to be explicit or implicit in the references. It may come, for instance, from the common general knowledge of the person skilled in the art, from consideration of the problem to be solved by the invention, or from the closeness of the art

Q217 Resolution

- Hindsight should not be used in evaluating whether it would have been obvious for a person skilled in the art to have modified the relevant prior art to obtain the invention
- The closeness of the technical field of the invention and the technical field of the prior art is relevant to the inventive step inquiry
- Technical effects, advantageous results and evidence of secondary considerations may be considered to support the inventive step of an invention. Secondary considerations may include unexpected / surprising or advantageous technical effects or results, evidence of commercial success, satisfaction of a long-felt need or unsolved problem, failure of others, copying by competitors, wide-spread licensing and overcoming technical scepticism
- National and regional patent offices should establish publicly available examination guidelines for determining inventive step / non-obviousness



Hyderabad Resolutions



- Q218: The requirement of genuine use of trademarks for maintaining protection
 - AIPPI confirmed the principle that the rights to a trademark should only be maintained if the mark is put to genuine use, subject to a reasonable grace period
 - In order for the use to be recognized, the use must be made as a mark distinguishing goods or services as to their origin



Q218 Resolution

- When a sign is used as a mark depends on the perception of the public to which the mark is addressed
 - To assess whether a sign is used as a mark, it should not matter whether or not this sign is also used as another distinctive sign, such as a trade name
- The use of a mark which differs from the registered mark must be recognized as sufficient use of the registered mark if the differences between the used and the registered mark do not alter the distinctive character of the mark
- The mark must be used by the proprietor or by third parties with his consent, such as by licensees or related companies
 - use by a licensee should be attributed to the proprietor regardless of whether or not the license is registered

Q218 Resolution

- The mark must be used for the goods or services for which it is registered
 - Where the mark is used only for some of the registered goods or services, the mark should not be maintained for the goods or services for which it has not been used
 - However, where there has been use for a specific product or service in a broader category of goods or services, a properly restricted broader category should be recognized



Q218 Resolution



- The mark must be used in the territory for which it is protected
 - The territory includes customs-free zones
 - The extent of territorial use was debated, but it was eventually accepted that no minimum territorial extent should be required
 - Export of goods or rendering of services from the territory should be recognized as use in the territory



Q218 Resolution

- The use must be made in the course of trade
 - Excludes private use and purely internal use
 - However, making available goods or services for free or not for profit should not exclude the use from being recognized as use in the course of trade
 - Only use which is genuine is sufficient to maintain trademark rights
 - Where it is established, in view of all the facts, that the use is made to establish or maintain a presence on the market, it should be held to be genuine
 - In this respect, no minimum threshold should be established
 - However, if the use is made merely to protect or obtain a registration (“token” or “sham” use) it should be disregarded
 - Use in advertising should be recognized if a sufficient relation with the goods or services is established



Q218 Resolution



- Burden of proof
 - When proof of use is required, the trademark proprietor should bear the burden of proof
- Grace period
 - A reasonable grace period should be provided before a mark becomes liable to sanctions on grounds of non-use
 - The grace period should be at least three years and should not be longer than five years
 - Beginning or resuming use after the expiry of the grace period and before validity of the mark is properly challenged should “cure” the defect arising from the absence of use
 - The re-filing of application for registration of unused marks, during or after the expiry of a grace period, should be allowed, provided that it is not in bad faith

Q218 Resolution

- A trademark proprietor must be allowed to justify the absence of genuine use
 - In judging whether the grounds invoked by the proprietor constitute “valid reasons” for the absence of use, all relevant circumstances should be taken into account, for example the need to obtain authorizations for the marketing, to the extent that the circumstances are beyond the control or sphere of the trademark proprietor
- Any person, subject to the requirements of the respective legal system, must be entitled to seek cancellation of a mark that has not been genuinely used
 - Where a jurisdiction provides for an administrative opposition or invalidation procedure on the basis of earlier trademarks, the applicant or proprietor of the contested mark should be entitled to invoke the absence of genuine use of the earlier mark, which should lead to the proprietor of the earlier mark being required to prove genuine use



Hyderabad Resolutions



- Q219: Injunctions in cases of infringement of IPRs
 - Not previously considered by AIPPI as a dedicated question
 - Encompasses both preliminary and permanent injunctions, but not ex parte injunctions / orders



Q219 Resolution

- The criteria to be considered for grant of preliminary injunction should include the following:
 - a claim of infringement with a reasonable prospect of success on the merits;
 - evidence that the claimed infringing conduct is imminent, ongoing or has already occurred;
 - a reasonable prospect of establishing or defending the validity of the IPR in suit on the merits;
 - whether the balance of convenience and/or the concept of proportionality, which can include the risk of irreparable harm, favours the granting of the injunction; and
 - due diligence on the part of the claimant in pursuing preliminary injunction

Q219 Resolution

- The courts should be empowered to impose, as a condition of granting a preliminary injunction, that the claimant provide a bond, security or undertaking to compensate a defendant who has suffered loss by a grant of preliminary injunction which is not upheld on the merits
- As a general rule, an IPR holder should be entitled to a permanent injunction in cases where infringement of a valid IPR is found on the merits. However, in making its decision on whether to grant the injunction, the court may consider **exceptional** circumstances which would make the granting of the injunction inappropriate, such as issues of public health or safety or issues arising under the doctrine of abuse of rights or in cases of conflict with other laws
- Injunctions should only be granted against persons or parties identified, whether by name or otherwise, in an infringement proceeding. The scope of an injunction should be clear, defined and effective to prevent infringement



Social Program



Falaknuma Palace



Social Program



Social Program



Falaknuma Palace



Handicraft Market

Social Program



Chowmahalla Palace

Social Program



Bollywood Show



See you in Seoul!

