

Hot Topics in International IP Law

**ABA-IPL Section
April 7, 2011**

**International Association for the
Protection of Intellectual Property,
U.S. Group, AIPPI-US**

**AIPPI Paris Congress Resolutions
and Hyderabad Forum & ExCo**

**Philip C. Swain
Boston, MA
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AIPPI-US President**

What is AIPPI?

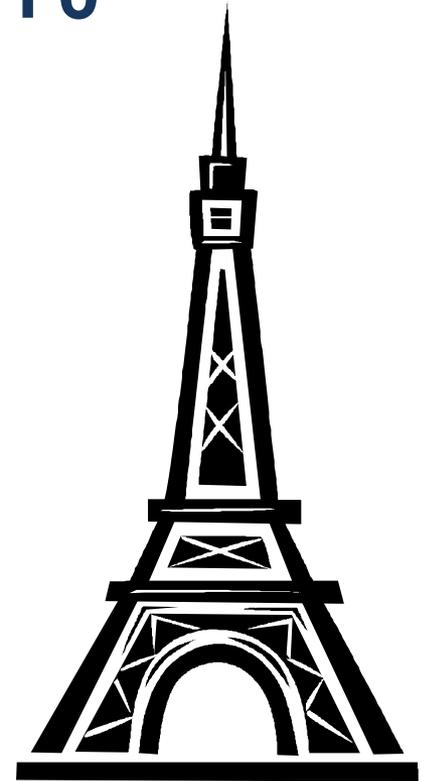
- **The International Association for the Protection of Intellectual Property, generally known under the abbreviated name AIPPI, is the world's leading International Organization dedicated to the development and improvement of intellectual property.**
- **It is a politically neutral, non-profit organization, domiciled in Switzerland which currently has almost 9000 Members representing more than 100 countries. It operates mainly through National Groups, such as AIPPI-US, the U.S. Group.**
- **The international organization meets at periodic world Congresses to be held on a biennial basis.**
- **In intervening years, a meeting of the AIPPI Executive Committee and an educational forum are held**

Objective of AIPPI

- **The objective of AIPPI is to improve and promote the protection of intellectual property on both an international and national basis.**
- **It pursues this objective by working for the development, expansion and improvement of international and regional treaties and agreements and also of national laws relating to intellectual property.**
- **It operates by conducting studies of existing national laws and proposes measures to achieve harmonisation of these laws on an international basis.**
- **In this context AIPPI has become increasingly concerned with issues concerning the enforcement of intellectual property rights.**

42nd AIPPI World IP Congress

- **Paris, France, October 3-6, 2010**
- **Resolutions on five “Working Questions”**
 - **Plus 18 Workshops**
 - **Cultural events and receptions**



Q 204 P - Liability for contributory infringement of intellectual property rights

- **Q204 had been adopted in the Boston Congress in 2008**
- **Recommended harmonization of basic principles for contributory infringement of intellectual property rights**
 - **clarified that “contributory infringement” does not include “inducement of infringement of infringement”**
 - **further clarified that the means offered or supplied must be for committing an act of “direct infringement”**
 - **Urged that injunctive relief should be available against acts of contributory infringement**

U.S. Q204P Comm. Leaders: Damian Wasserbauer, Ken Adamo



Q 213- The skilled person in context of the inventive step requirement in patent law- 1

- **AIPPI has studied “inventive step” many times**
- **This resolution concluded the person of skill in the art has certain characteristics**
 - **possesses common general knowledge as well as knowledge in the field**
 - **possesses skills that are expected from the average person in the field**
 - **is able to perform routine experimentation and research, and can be expected to obtain predictable solutions as compared to the prior art**
 - **the assessment of the person skilled in the art should be made as of the priority date or other relevant date under applicable law for the purposes of assessing patentability**

U.S. Q213 Comm. Leaders: Marc Richards, Drew Meunier

Q 213- The skilled person in context of the inventive step requirement in patent law- 2

- **Characteristics of the person of skill in the art – cont'd**
 - **person skilled in the art is generally an “individual person”**
 - **but depending on the technical field and the complexity of the invention, may correspond to a team of people from different disciplines (provided that would have been a common practice in the technical field of the invention at the relevant time)**
- **Question of whether or not person of skilled in the art can have any creativity over and above characteristics described above is directly linked to question of obviousness of an invention, which AIPPI will discuss at Hyderabad**

- **Dilution of trademarks has also been studied by AIPPI many times before**
- **Certain trademarks should be eligible for protection against dilution irrespective of the identity, similarity or dissimilarity of goods and services**
 - **those marks having recognition or fame among a significant part of the relevant public (i.e., “famous marks”)**
 - **“distinctiveness” is also a requirement**
 - **dilution by blurring or tarnishment should also be recognized**

U.S. Q214 Comm. Leaders: David Hill, Robert Sacoff

Q 215- protection of trade secrets through intellectual property rights and unfair competition law

- **AIPPI has not frequently addressed the subject of trade secrets**
- **This resolution generally urged members countries to adopt trade secret protections**
 - **To provide injunctive remedies for provide injunctive remedies for the threatened or actual violation of trade secrets**
 - **To adopt provisions to provide effective means of protecting confidentiality of trade secrets during and after litigation**
- **It also suggested that trade secrets can be the subject of license agreements**

U.S. Q215 Comm. Leaders: Mark Halligan, Margaret Dobrowitsky



Q 216A - Exceptions to copyright protection and permitted uses of copyright works in hi-tech and digital sectors

- **This resolution urged efficient copyright enforcement in the digital environment**
 - **Copyright holders should be entitled to address all parties that enable, facilitate or contribute to acts of copyright infringement, including requiring Internet Services Providers to provide information necessary to allow them to enforce their rights**
 - **Although the resolution allows that there generally should be no obligation on ISPs to monitor for infringing activity**
- **Urges harmonization of national laws to allow international enforcement**
- **Q216B will be addressed in Hyderabad (concerning user generated content services, transient or temporary copies, private copying and copyright levies and hypertext links)**

U.S. Q216A Comm. Leader: John Carson



Q 199- Protection of Clients' Intellectual Property Professional Advice (“PCIPPA”)

- AIPPI has urged WIPO and its national groups to urge their countries to recognize privilege protection for advices by non lawyer patent attorneys**
- Discussions within WIPO may lead to amendments to treaties, etc.**

U.S. Q199 Comm. Leaders: David Hill, Robert Wells

AIPPI's upcoming meetings

- **2011 – Hyderabad, India (Oct. 13-19) ExCo and Forum**
- **2012 – Incheon, Korea (Oct. 20-24) 43rd World Congress**
- **2013 – Helsinki, Finland ExCo and Forum**
- **2014 – Toronto, Canada 44th World Congress**
- **2016 – Milan, Italy 45th World Congress**
- **2018 – Cancun, Mexico 46th World Congress**

A new site voted every year

AIPPI Forum & ExCo 2011



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

Q 217 – The patentability criteria for inventive step/ non-obviousness

- **Inventive step is approached differently in different jurisdictions**
 - **US: KSR emphasized the “common sense” and predictability of results**
 - **UK: inventive step is determined by the “Windsurfing/ Pozzoli” test, which asks whether the differences would have been obvious to the person skilled in the art**
 - **Germany: “if, having regard to the state of the art, it is not obvious to a person skilled in the art”**
 - **EPO is the same as that of Germany**
 - **Japan: inventive step is determined by reasoning whether a person skilled in the art would have been able to easily make the invention based on one or more cited inventions**
- **National groups asked to focus on inventive step in each jurisdiction, whether it has evolved in last 20 years, and whether the patent-granting authority publishes examination guidelines on inventive step**

U.S. Q217 Comm. Leaders: Marc Richards, Alan Kasper, Drew Meunier, Josh Goldberg

Q 218 – The requirement of genuine use of trademarks for maintaining protection

- **The requirement of use to maintain protection is formulated differently in different jurisdictions**
 - **Japan: requires “use as a mark”**
 - **Australia: requires “use in good faith”**
 - **European Union: requires “genuine use”**
- **The national groups will address what constitutes use of a trade mark to meet the legal requirements in their jurisdictions**

U.S. Q218 Comm. Leaders: Maria Scungio, Red Horowitz,
Jim Slattery, and Uli Widmaier

Q 219 – The availability of injunctions in cases of infringement of intellectual property rights

- **Recognizes that injunctions have always been the primary remedy for infringement**
- **Desirable that there be a level of consistency in the approach to injunctions at an international level**
 - **2006 decision of US Supreme Court in eBay demonstrated there is no general rule in the United States that an injunction will be granted as matter of course, as is the case in many common law jurisdictions**
- **National groups are asked to focus upon describing any circumstances in which a permanent injunction either must be granted, or will not be available following a finding of infringement**

U.S. Q219 Comm. Leaders: Andrew Simpson, Barry Cohen, Ethan Horwitz, Kevin Tottis, and Ken Adamo

Q 216B – Exceptions to copyright protection and the permitted uses of copyright works in the hi-tech and digital sectors

- **This broad topic has been dealt with in two parts – Q216A was considered in Paris in 2010 and Q216B will be considered in Hyderabad in 2011 – with the aim of obtaining a comprehensive study at the end of the two-year cycle.**
- **Q216B raises a number of key questions in relation to user generated content services, transient/ temporary copies, private copying and copyright levies and hypertext links.**
- **Q216B is to explore exceptions to copyright protection in the specific areas resulting not from issues of eligibility/ qualification for protection at the time of inception but from various exceptions, permitted uses or defences which are relevant at the moment of use of the work in the digital environment. National and Regional Groups are asked to consider relevant exclusions from or defences to copyright protection.**

U.S. Q216B Comm. Leaders: Steve Bauer, Damian Wasserbauer,
Mark Halligan and Bob Sacoff

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AIPPI-US

Thank You!

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