



Working Questions for the Paris Congress 2010 (explanatory note)

At the Executive Committee Meeting in Buenos Aires the working programme for our Paris Congress in October 2010 was adopted. The ExCo chose five questions one of which (Q204P) continues the work which was done earlier at the Boston Congress in 2008 and resulted in a first Resolution. The other four topics concern new issues not previously dealt with by AIPPI.

This explanatory note is meant to give some additional background information while the Working Guidelines are self-explanatory and form the usual basis for the studies of the National and Regional Groups.

Q204P: Liability for contributory infringement of IPRs – certain aspects of patent infringement

Q204P continues the studies which led to the Boston Resolution in 2008. The Group Reports which were prepared in the first round as well as the debates in the Working Committee and the plenary sessions showed the difficulties arising from the very broad question. The task of this Committee for Paris is now limited to some important aspects which have not been treated sufficiently by the Boston Resolution. The first limitation regards the type of IPR involved. In particular from a practical standpoint patents seem to be the most relevant IPR in connection with contributory infringement. The discussions have shown that other IPRs are less relevant for this topic.

Furthermore, the studies mainly deal with three aspects of contributory infringement as recommended by the Boston Resolution. Firstly, we shall discuss which acts can be established as contributory infringement under which conditions. The second and third aspects are linked closely together and concern situations in which the acts contributing to the infringement happen in different countries. With regard to a specific act it should be determined if and under what circumstances such act constitutes an act of infringement either in that country or in another country where further acts are committed. One issue is the applicable law in those cases, although that is mainly determined by the specific IPR due to its territoriality. Immediately connected thereto is the question of whether the act of contributory infringement and the intended infringing use should take place in the same jurisdiction.

With this limited scope Q204 should finalize its studies on issues of contributory infringement. Other issues which were debated seem to be too controversial to come to a common position for a resolution although it would certainly be worthwhile from an academic standpoint to explore those questions as well.

Q213: The role of the skilled person in the context of the inventive step requirement regarding validity and infringement in patent law

The patentability criterion of inventive step has become the focus of attention on many levels. The growing criticism about patents and the allegedly sometimes too low hurdle for granting patents have put in particular the criterion of the inventive step into the limelight. "Raising the bar" as it has been expressed by the European Patent Office is only one example of recent voices which seem to suggest that the inventive step criterion needs to be revisited.

AIPPI has picked up this topic and started to investigate the latest developments. Any discussion of the inventive step criterion will have to start with the skilled person (also known as the man skilled in the art) and his knowledge and expertise as the basis for the assessment.

The focus will be on the role in the process of granting or invalidating a patent. Other situations in which the skilled person plays a role concern infringement of granted rights. In particular, in claim construction and in applying the doctrine of equivalence, the person skilled in the art is again the decisive factor. At that point, infringement and validity are necessarily connected to each other. The Working Guidelines make reference to these issues as well.

Q214: Protection against the dilution of a trademark

This question looks at the protection given to trademark owners against the dilution of their marks. Trademark dilution is commonly defined as the lessening of the capacity of a (in most cases famous) mark to identify and distinguish goods and services, regardless of the presence or absence of likelihood of confusion. Dilution will in the end result in a total loss of distinctiveness of a trademark. The aim of anti-dilution provisions is to protect the mark's inherent „selling power“ against those consequences. This selling power of a well-known trademark goes beyond the mark's ability to guarantee the trade origin of particular goods or services and is a distinct characteristic based on various factors in a specific case.

Q214 will firstly look at the conditions for protection against dilution in the various jurisdictions of our NRGs. This will include the eligibility criteria for such protection. In particular, it will be investigated whether and to what extent a trademark must have reached a certain degree of recognition amongst the relevant public or whether it even has to be famous or has to have any acquired reputation. In addition, further conditions such as distinctiveness will be examined.

The question also treats the available relief in cases of dilution and some procedural aspects such as the burden of proof and preliminary injunctive relief.

Q215: Protection of Trade Secrets through IPR and Unfair Competition Law

As investments and people move freely across national borders, trade secret protection is becoming an international issue. In order to encourage international technology transfer and investments, international standards for trade secret protection have to be established. The Paris Convention only requires effective protection against unfair competition in general (Art. 10bis) and does not mention trade secrets explicitly. Even the TRIPS Agreement, while Article 39 has a definition of "undisclosed information," merely mandates its members to provide the "possibility of preventing" unwanted disclosure, acquisition and use of such information.

Q215 will review the current situation in the Groups' jurisdictions concerning the protection of trade secrets and make an attempt to establish international standards or guidelines toward their effective protection. For this purpose, AIPPI would like to study trade secrets in terms of their definition, source of law, remedies, and litigation tools, such as protective court orders, for effective protection. In this context also non-compete or non-disclosure agreements and their enforcement and effectiveness in each jurisdiction will be investigated.

Q216: Exceptions to copyright protection and the permitted uses of copyright works in the hi-tech and digital sectors

This question will examine certain exceptions to copyright protection and the permitted uses of copyright works with a particular focus on the hi-tech and digital sectors, including the Internet, databases, search engines, on-line social networking sites, file-sharing and the digital music industry. During the preparatory work and the introductory session in Buenos Aires it became evident that the topic is too broad to be covered in one year. In accordance with the Programme Committee we have therefore decided to split up the work and to limit the studies for Paris to a first set of issues. We shall then propose to the ExCo to continue the studies with the second set of issues in Hyderabad in 2011 so that the entire topic can be dealt with in a two-year cycle.

In the first round Q216 is intended to explore the situation of Internet Service Providers (ISPs), issues of digitisation and format shifting, orphan works and issues of fair dealing and fair use.

The core of the question will be certain exceptions to copyright protection resulting not from issues of eligibility for protection but from various defences which are available in cases where a copyrighted work is used. National and Regional Groups will be asked to consider relevant exclusions from or defences to copyright protection based on concepts of permitted uses, private uses, fair use and fair dealing. The work within this question will analyse also exceptions provided by national and international legislation such as the European Digital Copyright Directive. In particular, the Groups will have to look at how and to what extent such exceptions are applicable to modern forms of communication.

The scope of the question also allows for debate on important issues such as exceptions for "digitisation" to allow for copying and format shifting of sound

recordings, films, broadcasts or other works. It will deal with search engines, platforms like YouTube, the Google Book Search and other phenomena of the Digital Age. The scope of fair dealing rights for the benefit of libraries and archives and the dissemination of works for teaching and research purposes will equally be treated. This will include technical considerations as well as legal issues.

December 2009 JB