E

WIPO/IPLT/DDK/02/III-6
ORIGINAL: English
DATE: March 2002

INTERNATIONAL INTELLECTUAL PROPERTY TRAINING INSTITUTE
KOREAN INTELLECTUAL PROPERTY OFFICE

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

JAPAN PATENT OFFICE

WIPO ASIAN REGIONAL TRAINING COURSE FOR INTELLECTUAL PROPERTY TRAINERS AND INSTRUCTORS

organized by
the World Intellectual Property Organization (WIPO)

in cooperation with
the International Intellectual Property Training Institute (IIPTI)

and
the Korean Intellectual Property Office (KIPO)

and with the assistance of
the Japan Patent Office (JPO)

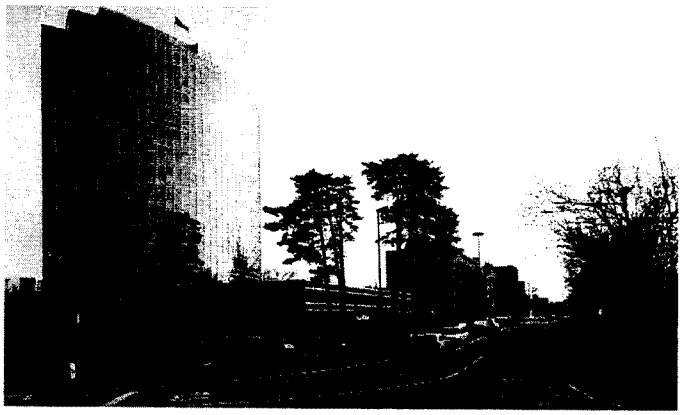
Daeduk, Daejeon, Republic of Korea, March 18 to 22, 2002

INTELLECTUAL PROPERTY (IP) TODAY; RECENT DEVELOPMENTS, CURRENT AND EMERGING ISSUES

THE ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS (IPRs); CURRENT SITUATION AND FUTURE PERSPECTIVES - POINT OF VIEW OF INTERNATIONAL ORGANIZATIONS

Document prepared by the International Bureau of WIPO

WORLD INTELLECTUAL PROPERTY ORGANIZATION



WIPO ASIAN REGIONAL TRAINING COURSE FOR INTELLECTUAL PROPERTY TRAINERS AND INSTRUCTORS

DAEDUK, MARCH 18 TO 22, 2002

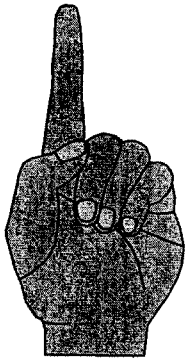
TOPIC 6
The Enforcement of Intellectual Property Rights (IPRs): Current Situation and Future Perspectives – Point of View of International Organizations



PRESENTATION OUTLINE

- A. WIPO 's Mandate and Policy Framework
- B. Enforcement-Related Activities of WIPO in Relation to the TRIPS Agreement
- C. WIPO 's Renewed Focus on Enforcement

A. WIPO 's Mandate and Policy Framework



WIPO,
UNITED NATIONS
SPECIALIZED AGENCY

PROMOTE INTELLECTUAL PROPERTY PROTECTION WORLDWIDE

PROMOTE CREATIVE AND INTELLECTUAL ACTIVITY

THROUGH COOPERATION WITH MEMBER STATES, INTERGOVERNMENTAL AND NON-GOVERNMENTAL ORGANIZATIONS



WIPO 'S MANDATE FOR ENFORCEMENT

- Pursuant to the mandate of the WIPO General Assembly in 1994 and 1995 and the WIPO-WTO Agreement, WIPO has carried out extensive activities related to the TRIPS Agreement
- *Enforcement* of intellectual property rights, as an integral part of the TRIPS Agreement, was incorporated into the WIPO programs since January 1996.

ENFORCEMENT PROCEDURES

- Article 41 of TRIPS Agreement (1996)
- A number the WIPO-administered treaties contain provisions which indirectly require appropriate enforcement measures:
  - Article 25 of Paris Convention (1883)
  - Article 36 of Bern Convention (1886)
  - Article 26 of Rome Convention (1961)

Article 25 of Paris Convention

- [Implementation of the Convention on the Domestic Level]
- (1) Any country party to this Convention undertakes to adopt, in accordance with its constitution, the measures necessary to ensure the application of this Convention.
- (2) It is understood that, at the time a country deposits its instrument of ratification or accession, it will be in a position under its domestic law to give effect to the provisions of this Convention.

Article 36 of Bern Convention

- **[Application of the Convention: 1. Obligation to adopt the necessary measures; 2. Time from which obligation exists]**
- **(1) Any country party to this Convention undertakes to adopt, in accordance with its constitution, the measures necessary to ensure the application of this Convention.**
- **(2) It is understood that, at the time a country becomes bound by this Convention, it will be in a position under its domestic law to give effect to the provisions of this Convention.**

Article 26 of Rome Convention

- [Implementation of the Convention by the Provision of Domestic Law]
- 1. Each Contracting State undertakes to adopt, in accordance with its Constitution, the measures
- necessary to ensure the application of this Convention.
- 2. At the time of deposit of its instrument of ratification, acceptance or accession, each State must be in a position under its domestic law to give effect to the terms of this Convention.

ENFORCEMENT PROVISIONS OF WIPO TREATIES

- Copyright and Related Rights
  Bern Convention:
  - Article 15: Rights to institute infringement proceedings to enforce protected rights
  - Articles 13(3) and 16: Seizure of infringing copies
  WCT: Article 14
  WPPT: Article 23

Article 15 of Bern Convention

- **[Right to Enforce Protected Rights: 1. Where author's name is indicated or where pseudonym leaves no doubt as to author's identity; 2. In the case of cinematographic works; 3. In the case of anonymous and pseudonymous works; 4. In the case of certain unpublished works of unknown authorship]**

- **(1) In order that the author of a literary or artistic work protected by this Convention shall, in the absence of proof to the contrary, be regarded as such, and consequently be entitled to institute infringement proceedings in the countries of the Union, it shall be sufficient for his name to appear on the work in the usual manner. This paragraph shall be applicable even if this name is a pseudonym, where the pseudonym adopted by the author leaves no doubt as to his identity.**

- (2) The person or body corporate whose name appears on a cinematographic work in the usual manner shall, in the absence of proof to the contrary, be presumed to be the maker of the said work.
- (3) In the case of anonymous and pseudonymous works, other than those referred to in paragraph (1) above, the publisher whose name appears on the work shall, in the absence of proof to the contrary, be deemed to represent the author, and in this capacity he shall be entitled to protect and enforce the author's rights. The provisions of this paragraph shall cease to apply when the author reveals his identity and establishes his claim to authorship of the work.

(4) (a) In the case of unpublished works where the identity of the author is unknown, but where there is every ground to presume that he is a national of a country of the Union, it shall be a matter for legislation in that country to designate the competent authority which shall represent the author and shall be entitled to protect and enforce his rights in the countries of the Union.

- (b) Countries of the Union which make such designation under the terms of this provision shall notify the Director General by means of a written declaration giving full information concerning the authority thus designated. The Director General shall at once communicate this declaration to all other countries of the Union.

Article 13 (3) 0f Bern Convention

- **[Possible Limitation of the Right of Recording of Musical Works and Any Words Pertaining Thereto: 1. Compulsory licenses; 2. Transitory measures; 3. Seizure on importation of copies made without the author's permission]**
- **(3) Recordings made in accordance with paragraphs (1) and (2) of this Article and imported without permission from the parties concerned into a country where they are treated as infringing recordings shall be liable to seizure.**

13.03.02 LJ ASPAC BUREAU 17

Article 16 of Bern Convention

- **[Infringing Copies: 1. Seizure; 2. Seizure on importation; 3. Applicable law]**
- **(1) Infringing copies of a work shall be liable to seizure in any country of the Union where the work enjoys legal protection.**
- **(2) The provisions of the preceding paragraph shall also apply to reproductions coming from a country**
- **where the work is not protected, or has ceased to be protected.**
- **(3) The seizure shall take place in accordance with the legislation of each country.**

13.03.02 LJ ASPAC BUREAU 18

Article 14 of WCT

Provisions on Enforcement of Rights

(1) Contracting Parties undertake to adopt, in accordance with their legal systems, the measures necessary to ensure the application of this Treaty.

(2) Contracting Parties shall ensure that enforcement procedures are available under their law so as to permit effective action against any act of infringement of rights covered by this Treaty, including expeditious remedies to prevent infringements and remedies which constitute a deterrent to further infringements.

Article 23 of WPPT

Provisions on Enforcement of Rights

(1) Contracting Parties undertake to adopt, in accordance with their legal systems, the measures necessary to ensure the application of this Treaty.

(2) Contracting Parties shall ensure that enforcement procedures are available under their law so as to permit effective action against any act of infringement of rights covered by this Treaty, including expeditious remedies to prevent infringements and remedies which constitute a deterrent to further infringements.

ENFORCEMENT PROVISIONS OF WIPO TREATIES

- Trademarks, Trade Names, etc.

  Paris Convention - Article 10*ter*(1): Assurance of appropriate legal remedies to repress prohibited acts
  Articles 9 and 10(1): Seizure upon importation of goods bearing unlawful affixation

Paris Convention - Article 10*ter*(1)

- [*Marks, Trade Names, False Indications, Unfair Competition:* Remedies, Right to Sue]
- (1) The countries of the Union undertake to assure to nationals of the other countries of the Union appropriate legal remedies effectively to repress all the acts referred to in Articles 9, 10, and 10bis.

Paris Convention - Article 9

- **[Marks, Trade Names: Seizure, on Importation, etc., of Goods Unlawfully Bearing a Mark or Trade Name]**
- **(1) All goods unlawfully bearing a trademark or trade name shall be seized on importation into those countries of the Union where such mark or trade name is entitled to legal protection.**
- **(2) Seizure shall likewise be effected in the country where the unlawful affixation occurred or in the country into which the goods were imported.**
- **(3) Seizure shall take place at the request of the public prosecutor, or any other competent authority, or any interested party, whether a natural person or a legal entity, in conformity with the domestic legislation of each country.**

Paris Convention - Article 10 (1)

- [*False Indications:* Seizure, on Importation, etc.,of Goods Bearing False Indications as to their Source or the Identity of the Producer]

- (1) The provisions of the preceding Article shall apply in cases of direct or indirect use of a false indication of the source of the goods or the identity of the producer, manufacturer, or merchant.

ENFORCEMENT PROVISIONS OF WIPO TREATIES

- Geographical Indications

  Madrid (Indication of Source) Agreement-
  Article 1(1) and (2): Seizure of goods in respect of false indication of source
  Lisbon Agreement-
  Article 8: Legal action for ensuring the protection of appellations of origin

Madrid (Indication of Source) Agreement- Article 1(1) and (2)

- **(1) All goods bearing a false or deceptive indication by which one of the countries to which this Agreement applies, or a place situated therein, is directly or indirectly indicated as being the country or place of origin shall be seized on importation into any of the said countries.**

- **(2) Seizure shall also be effected in the country where the false or deceptive indication of source has been applied, or into which the goods bearing the false or deceptive indication have been imported.**

Lisbon Agreement- Article 8

- [Legal Proceedings]
- Legal action required for ensuring the protection of appellations of origin may be taken in each of the countries of the Special Union under the provisions of the national legislation:

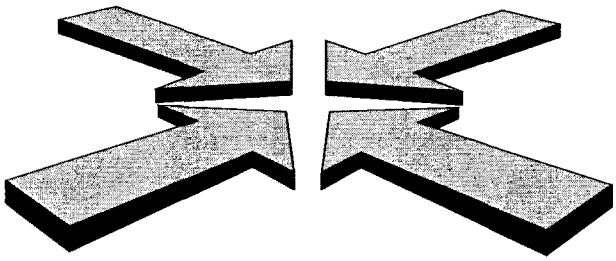
- 1.at the instance of the competent Office or at the request of the public prosecutor;
- 2.by any interested party, whether a natural person or a legal entity, whether public or private.

ENFORCEMENT PROVISIONS OF WIPO TREATIES

- Unfair Competition

Paris Convention- 10*ter*(1): Assurance of appropriate legal remedies to repress prohibited acts (for text see slide 22)

B. Enforcement-Related Activities of WIPO in Relation to the TRIPS Agreement



ENFORCEMENT PROVISIONS UNDER THE TRIPS AGREEMENT

Part III Enforcement of Intellectual Property Rights

Altogether, there are 21 articles (Article 41 to 61) in five sections which deals with enforcement.

- Section 1, General Obligations, consists of one Article (41), which contains principles of enforcement procedures.

- Section 2, Civil and Administrative Procedures and Remedies, consists of 8 Articles (42-49), which have no corresponding provisions in the WIPO treaties.

- Section 3, Provisional Measures, consists of one Article (50), which require certain procedures and provide guidelines for such procedures.

- Section 4, Border Measures, which consist of 10 Articles (51-60).

- Section 5, Criminal Procedure, consists of one Article, which contains principles relating to criminal procedures.

WIPO - WTO AGREEMENT 1996

- **Assistance to developing countries**
- **Notification collection of IP Legislation (CLEA-online)**
- **Notification of Emblems**

OBLIGATIONS IN PART III OF THE TRIPS AGREEMENT ON ENFORCEMENT

- to ensure effective action for enforcement and expeditious remedies for deterring infringement
- no requirement for any special judicial system distinct from general judicial system or allocation of resources
- to ensure that enforcement procedures are applied in a manner that avoid the creation of barriers to legitimate trade and avoid abuse

WIPO'S LEGAL-TECHNICAL ASSISTANCE FOR TRIPS ENFORCEMENT PROVISIONS

- Legal and legislative assistance
- Awareness building and human resource development
- Institution building and modernization
- Fostering international, regional and sub-regional cooperation
- Cooperation with IGO's and NGO's and right holders associations

ASSISTANCE ON LEGISLATION

(Worldwide)

Year	Draft laws submitted	Comments submitted	Legislative advice provided
1996	20 (laws) for 10 (countries)	30 (comments)/ 20 (countries)	27 (advices) / 32 (countries)
1997	54	40	23
	29	27	18
1998	42	47	37
	23	31	29
1999	61	66	52
	33	31	37
2000	21	25	17
	16	12	13

ASSISTANCE ON LEGISLATION

(Asia and Pacific)

YEAR	DRAFT LAWS SUBMITTED	COMMENTS SUBMITTED	LEGISLATIVE ADVICE
1996	Bhutan, India, Lao PDR	Bhutan, Brunei, Malaysia, Pakistan, Phils., Sri Lanka, Tonga	India, Iran, Lao PDR, Singapore
1997	Cambodia, Malaysia, Nepal	Brunei, Cambodia, Fiji, Mongolia, Pakistan	China, India, Malaysia, Viet Nam
1998	Indonesia, Mongolia, Nepal, PNG, Sri Lanka, Vanuatu	Brunei, Cambodia, Indonesia, Korea, Mongolia, Pakistan, Singapore, Thailand	Bhutan, China, Fiji, India, Mongolia, Nepal, PNG, Samoa, Singapore, Thailand, Vanuatu
1999	Cambodia, Iran Malaysia, PNG, Pakistan, Maldives, Nepal, Samoa	Bangladesh, Brunei, Cambodia, Indonesia, Malaysia, Pakistan	Bhutan, Brunei, Cambodia, China, Fiji, Indonesia, Malaysia, PNG, Singapore
2000	Bangladesh, Tonga	Bangldesh, Vanuatu	Bangladesh, Iran, Malaysia
Total cntries	17	17	19

HRD AND TRAINING

- Training courses/special meetings on enforcement under TRIPS
- Special WIPO Academy for enforcement officials
- Orientation and study programs for senior customs officials - WIPO, WTO, WCO, advanced countries
- Colloquia for judges, prosecutors



SUMMARY OF TRAINING/HRD ACTIVITIES UNDER TRIPS, (1996 - 2000)

- Regional policy and high level meetings- 120, 11,000 participants
- Sub-regional and national meetings - 240, 21,000 participants
- Interregional introductory and specialized training courses - 110; 1,300 participants
- Study attachments - 250
- Use of national and regional institutions

13.03.02 LJ ASPAC BUREAU 39

SUMMARY OF ENF. HRD & TRAINING ACTIVITIES, Asia and Pacific 1996-2000

- Regional meetings/symposia - 3
- Sub-regional meetings - 4
- Orientation/Study Program for Customs and Law Enforcement Officials - 4
- National Seminars - 9
- Training Courses - 1
- Colloquium for Judges and Prosecutors - 6

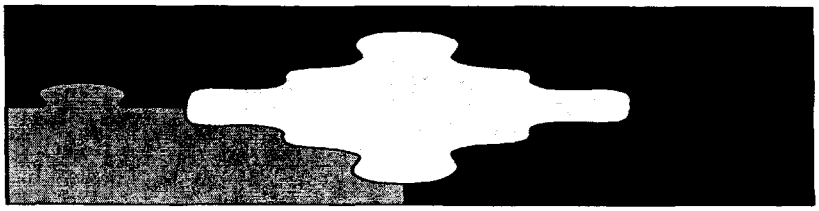
*approx. 1,000 participants from the A/P region

13.03.02 LJ ASPAC BUREAU 40

OTHER ENFORCEMENT-RELATED ASSISTANCE

- Survey of enforcement mechanisms, ASEAN
- Questionnaire to assess conformity of existing enforcement mechanisms vis-a-vis TRIPS
- Expert missions
- Promoting contacts among national focal points for enforcement
- Facilitating interaction among associations of right holders, industry representatives and enforcement officials
- Providing documentation, equipment and training materials

C. WIPO 's Renewed Focus on Enforcement of IPRs



RE-ENFORCING IPR ENFORCEMENT SUPPORT

- Development Cooperation Program
- Development of Industrial Property Law - Protection of Industrial Property Rights
- Development of CR & Related Rights
- E-commerce and IP



13.03.02 LJ ASPAC BUREAU 43

MEETINGS OF ADVISORY COMMITTEES

- Two sessions on industrial property October 2000 and December 2001
- Three sessions on copyright December 1998, December 1999 and December 2001

13.03.02 LJ ASPAC BUREAU 44

ADVISORY COMMITTEE ON ENFORCEMENT OF INDUSTRIAL PROPERTY RIGHTS (ACE/IP)

Objective of the ACE/IP:

- Monitor all activities in international IP law
- Prepare studies and proposals for improvement
- Consider the most appropriate approach to their adoption and implementation

First Session: Geneva, October 19 and 20, 2000

Second Session: December 18 to 20, 2001

ADVISORY COMMITTEE ON MANAGEMENT AND ENFORCEMENT OF COPYRIGHT AND RELATED RIGHTS IN GLOBAL INFORMATION NETWORKS (ACMEC)

- Renamed from Advisory Committee on Management of Copyright and Related Rights in Global Information Networks (ACMC), which had to two sessions (1998, 1999)
- Third session of ACMEC jointly convened with ACE/IP in 2001

ACMEC Activity indicated in 2000-2001 Program and Budget

- to discuss the issues of the exercise, management and enforcement of rights in the digital environment, particularly in global networks, including the practical application of technological measures of protection, rights management information systems and new methods for management of rights

JOINT MEETING OF ACE/IP AND ACMEC

- Held from December 18 to 20, 2001
- Unanimously agreed
  - enforcement of intellectual property rights was of great importance to all countries
  - WIPO was in a particularly appropriate position: to gather information on enforcement of IPRs to coordinate activities undertaken by the Committees jointly with various IGOs and NGOs aiming at establishing adequate and effective enforcement systems

Further Actions Required at the Joint Committees

- to establish an Electronic Forum to facilitate the exchange of information relating to enforcement issues
- identify the existing needs for training and for development of enforcement strategies
  continue and intensify WIPO activities in favor of developing countries and countries in transition, in particular the activities of the WIPO Worldwide Academy and of the regional bureaus, with regard to training, technical assistance and awareness building in the field of enforcement
- preparation of model enforcement provisions and practices, including Internet enforcement issues, for Sept. 2002

13.03.02 LJ ASPAC BUREAU 49

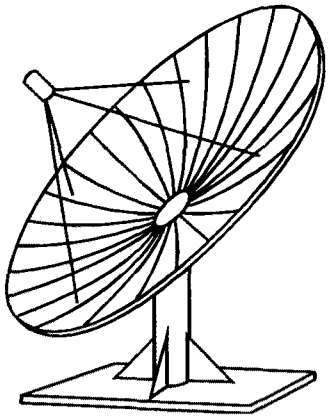
WORK OF WIPO REGIONAL BUREAUS ON ENFORCEMENT

- One of the documents discussed at the ACE/IP First Session is "WIPO's Legal and Technical Assistance to Developing Countries for the Implementation of the TRIPS Agreement from January 1, 1996 to June 30, 2000" (document WIPO/TRIPS/2000/1), which described the work in the area of enforcement undertaken by the WIPO Regional Bureaus and the Intellectual Property Law Department of the Sector of Cooperation for Development. WIPO has, since 1996, incorporated into its ongoing cooperation for development programs various activities regarding the enforcement of intellectual property rights.

13.03.02 LJ ASPAC BUREAU 50

WIPO 's Response to the Impact of Digital Technology

- WCT and WPPT
- WIPO Digital Agenda
- WIPO Internet Domain Name Process
- WIPO Online Dispute Resolution Mechanism
- WIPO Arbitration and Mediation Center



WIPO ARBITRATION AND MEDIATION CENTER

- Established in 1994 to provide arbitration and mediation services for the resolution of commercial disputes between private parties involving IP, as alternative to court litigation
- Center is international, independent and neutral and assisted in its operation by advisory bodies composed of external experts in international dispute resolution and IP

ACTIVITIES OF CENTER

- Mediation
- Arbitration
- Mediation followed by arbitration
- Expedited arbitration
- On-line dispute resolution
- Domain names dispute resolution

PROGRAM AND BUDGET FOR THE 2002-2003 BIENNIUM

MAIN PROGRAM 10
GLOBAL INTELLECTUAL PROPERTY ISSUES

SUB-PROGRAM 10.4
Intellectual Property Enforcement Issues and Strategies



OBJECTIVES

- To assist Member States in identifying needs and possible solutions concerning the enforcement of all intellectual property rights
- To contribute toward increased communication and networking between Member States and between intellectual property agencies and enforcement agencies in each Member State

13.03.02 LJ ASPAC BUREAU 55



EXPECTED RESULTS

- Greater recognition and awareness among Member States and other concerned parties of the importance of appropriate measures to protect and enforce intellectual property rights, and of identifying less burdensome, cost-effective procedures for enforcement
- Improved communication and cooperation among Member States, and among intellectual property and enforcement agencies within Member States

13.03.02 LJ ASPAC BUREAU 56

ACTIVITIES

- Executing the directives of the former Advisory Committee on Enforcement of Industrial Property Rights in the broader context of all intellectual property rights
- Preparation of additional studies and surveys
- Cooperation and share expertise with others
- Promoting understanding of the international principles
- Contribution to preparing a Guide

13.03.02 LJ ASPAC BUREAU 57

Executing the directives of the former Advisory Committee on Enforcement of Industrial Property Rights in the broader context of all intellectual property rights, *including, inter alia, assisting the Member States in*:

-· identifying the challenges in enforcement of intellectual property in all Member States;

-· identifying best practices for enforcement of intellectual property in Member States, including practices that are effective, while being at the same time less costly and time-consuming;

- identifying existing requirements and needs for training and development of enforcement strategies for intellectual property in Member States;

- identifying external resources for training and cooperation in enforcement of intellectual property, such as private sector resources and other multilateral and regional organizations; and

- identifying additional issues and/or initiating additional activities as the need arises and available resources allow.

13.03.02 LJ ASPAC BUREAU 58

- Preparation of additional studies and surveys on important issues relating to the enforcement of intellectual property rights, where appropriate with the help of consultants.
- Cooperation and coordination with multilateral and regional organizations in order to share expertise and experiences, as appropriate.
- Promotion of the understanding of the international principles relating to the enforcement of intellectual property rights, including correspondence, attendance at seminars, advising national governments, preparation and provision of advice concerning WIPO documents and publications, and following the activities of the WTO.
- Contribution to the preparation of a Guide on International Treaty Provisions concerning Industrial Property Protection and a Guide to International Treaty Provisions on Copyright and Related Rights as far as the enforcement of intellectual property rights is concerned.

"SEEING THE UNPRECEDENTED WEALTH OF NEW TECHNOLOGY ENTERING THE MARKETPLACE TODAY, WE HAVE EVERY REASON TO BELIEVE THAT INTELLECTUAL PROPERTY RIGHTS AND THE ASSURANCE OF THEIR ENFORCEABILITY HAVE NEVER BEEN MORE IMPORTANT."

THANK YOU FOR YOUR ATTENTION !



13.03.02 LJ ASPAC BUREAU 61

[End of document]