

Resolutions adopted in Buenos Aires

At its annual meeting of the Executive Committee in Buenos Aires in October 2009 AIPPI adopted four Resolutions on various IP topics covering the fields of patent law, trademark law and more general IP matters. Although certain issues were more controversial than others, AIPPI was again able to formulate Resolutions which are based on a broad consensus of its membership and were adopted with a great majority. The Resolutions truly reflect the views of all interested circles and aim at contributing to a worldwide harmonization of laws and practices in IP in order to further promote balanced IP systems which consider and the interests of all parties involved, including the public.

The full texts of our Resolutions as well as the underlying materials (Working Guidelines, National and Regional Reports and Summary Reports) are available on our website (www.aippi.org) for further reference.

I.

Q194 dealt with the “**Impact of Co-ownership of Intellectual Property Rights on their Exploitation**”. This topic was first debated at the annual meeting in Singapore 2007. At that time the ExCo adopted a first Resolution which contained various statements with regard to the principles. First and foremost it was stated that the co-owners should be free to organize their co-ownership by way of a mutual agreement and that statutory law should only be used as a secondary source in case of absence of such an agreement. At the same time the differences between the various IP rights, such as patents or trade marks were well recognized.

Regarding a patent each co-owner should be free to exploit the patented invention, unless otherwise agreed between the co-owners without compensation for the other co-owners. On the other hand, a license granted by one co-owner should require the consent of the other co-owners.

As regards trademarks and copyright works AIPPI resolved that no co-owner should be entitled to use or exploit the IP right without the consent of the other co-owners.

The Executive Committee of AIPPI also felt that certain issues needed further investigation, such as the impact of the co-ownership on the exploitation of IPRs and on the criterion for determining the applicable law and the jurisdiction in case of absence of an agreement. These issues were the focus of the continuing work which had been prepared for the Buenos Aires ExCo and which is now the core of the second Resolution.

Following up on the Singapore Resolution it is stated that, in exploiting a co-owned patented invention, each co-owner may also outsource or subcontract the work without the need to seek authorization from the other co-owners provided that the outsourcing or subcontracting co-owner remains in control of the manufacturing process. Such control may be achieved by a close supervision of the outsourcing co-owner or by an obligation of the subcontractor to only supply the goods manufactured by him to the co-owner.

Also an assignment of the ownership by a co-owner should not require the consent of the co-owners. However, national law should safeguard the interests of the other co-owners and provide for certain means such as the right of first refusal or the like.

With regard to the regime which governs the relationship between the co-owners AIPPI confirms the clear position that the co-owners should be allowed to decide on the choice of law and jurisdiction. Where such an agreement between the co-owners does not exist a single law with the closest connection should be applicable. The decisive factors for determining the closest connection should be the domicile of the co-owners or the place where the IP right was first created, used or filed.

AIPPI also recommends addressing the issue of the applicable law in the context of international regulations and/or treaties. The reason is the complexity and importance of this issue which cannot be resolved solely in the context of this working question.

II.

In the past, various aspects of customs intervention in the field of IP have been the subject of debates in several AIPPI Resolutions. This time **Q208 (“Border Measures and other Means of Customs Intervention against Infringers”)** looked at specific issues of border measures taking into consideration the latest international developments of the law and the practical impact of such measures.

While the Executive Committee confirmed earlier Resolutions of London 1986 (Q86) and Lisbon 1993 (Q122) it was also stated that border measures should be available in respect of all IP rights and for all forms of infringement of such rights. This means that border measures should not only be used for pirate goods, such as counterfeit trade mark goods or pirated copyright goods. Also the infringement of patents or design rights should be a sufficient basis for border measures. As regards the various acts of infringement the Resolution recommends to apply those measures also for acts of parallel importing or other acts which are not limited to direct infringement.

One of the crucial issues in the context of border measures is the evidence which needs to be put forward to show infringement. In accommodating both the interest of the IP right owner to enforce the right on the one hand and the interest of the importer or consignee of allegedly infringing goods to freely import the goods on the other hand a balanced system needs to be created also for border measures. This becomes even more important where infringement cannot be proven after all. Customs authorities should be entitled to temporarily hold the goods to allow for a preliminary assessment of infringement by competent courts or the competent administrative bodies. The IP owner should be required to provide a security or an undertaking of indemnification in case infringement cannot be found or no assessment is sought by the IP owner. In that case an appropriate compensation for the wrongful detention of the goods should be awarded to the importer or consignee. One of the points of discussion concerned whether the right of the customs authorities to temporarily hold the goods should be subject to the availability of a preliminary assessment of infringement. The Executive Committee felt, however, that such a proviso would be seen as a disclaimer and would not accurately reflect the idea of the Resolution which urges national legislations to provide for such an assessment.

The Resolution finally recommends that a centralized system for managing multiple applications for customs measures through a single contact point should be encouraged on an international basis. This would facilitate the work to be performed by the authorities and would in particular avoid a duplication of work where e.g. the same applicant files several applications in a number of jurisdictions. The recommendation may also be seen as an incentive for the international bodies to cooperate more closely where this is appropriate.

III.

Q209 (“Selection Inventions – the Inventive Step Requirement, other Patentability Criteria and Scope of Protection”) considered selection inventions with a focus on the aspects of the inventive step requirement, other patentability criteria and the scope of protection. The work was done on the basis that while the general concept of selection inventions is well established and broadly recognised in most jurisdictions there is still a need for harmonisation of the rules and the application of law when it comes to details of selection inventions.

The Resolution adopted in Buenos Aires states that selection inventions, i.e. inventions which are a selection from a previous disclosure should be patentable in all technical fields and that the usual patentability criteria should apply. In other words no special regime is desirable with regard to the patentability in principle provided that in particular with regard to the assessment of novelty and inventive step/non-obviousness the specific circumstances of selection inventions are sufficiently taken into account.

In the context of novelty and the inventive step criterion it was discussed whether any special different unpredictable properties should be required. The Resolution states that, for being novel, such properties should not be necessary. On the contrary, in order to be inventive, a selection invention should display unexpected or surprising properties not apparent from the previous disclosure whereby substantially the whole of the claimed selection must display such properties. At the same time, these properties must be derivable from the application as filed.

Regarding infringement AIPPI held that any unclaimed unexpected or surprising properties does not have to be utilised by the alleged infringer. This is also in line with the general principles that the claims of a patent are the decisive basis for assessing the scope of protection. The intent of the alleged infringer to use a selection invention is irrelevant.

Selection inventions may more than other inventions give rise to the question of the submission of data to support the unexpected or surprising properties and to the timing of such submissions. This issue has to be seen in a broader context and plays a significant role in various situations during prosecution of a patent application beyond selection inventions. In order to investigate all aspects of this issue the Resolution recommends that AIPPI further study this broader question.

IV.

The last Working Question dealt with the **“Protection of Major Sports Events and Associated Commercial Activities through Trade Marks and other IPR” (Q210).**

Major sports events are unthinkable without the support of official sponsors. There is a close link between the value of a sponsorship and the nature and extent of the exclusivity which can be awarded to sponsors with regard to a specific event. At the same time it can be observed that although the existing trade mark and unfair competition laws already provide a good protection certain jurisdictions have felt the need to create *sui generis* rights which supplement trade mark and unfair competition laws.

In its Resolution AIPPI expresses a great hesitation in accepting and suggesting such *sui generis* protection. As a matter of principle, trade mark and unfair competition laws should not be amended just for major sports events and *sui generis* rights should be avoided.

Since such rights are already in existence and are also promoted by various jurisdictions, certain limitations should be observed with regard to the time during which such protection is in force and the acts which might be considered infringing those rights. The Resolution expressly mentions a balancing of interest of the *sui generis* rights with the right of the alleged infringer to freedom of expression. Moreover, pre-existing IP rights have to be recognised.

V.

All Resolutions which were adopted in Buenos Aires are again the result of a very thorough work conducted by the Working Committees and the Executive Committee. The basis is formed by the reports of our National and Regional Groups which give an excellent overview of the current situation and provide a very comprehensive comparative law study. The substantive Resolutions adopted in Buenos Aires can be seen as another great accomplishment of our Association in promoting and improving balanced IP systems worldwide.