Index

ACTA see Anti-Counterfeiting Trade Agreement

ADB 33

Agreement on Trade-Related Aspects of Intellectual Property Rights see TRIPS Agreement

Anderman, S. 192

Anderson, R. 198

Anti-Counterfeiting Trade Agreement (ACTA) 14, 201–2

border measures to ensure goods are not released into channels of commerce 124–5

civil society, role of 142

everlapping with SECURE border measure provisions 167–8

overlooking the interests of developing countries 209

targeting the developing world 133

Argentina

RR gene 82

soy-related products 81–2

see also Monsanto

Ariyanuntaka, V. 26

Asian Development Bank (ADB) 33

Australian Government 19

Barton, J. 194

Bently, L. 45

Biadgleng, E. 9, 10, 32, 46, 72, 202

Blakeney, M. 20

Blenko, W. 38

Boiron, P. 53

border measures misconceptions about types of transactions and forms of IPRs to be enforced 31–3

SECURE Working Draft 68

TRIPS Agreement 68, 208

WCO Model Provisions 168

see also Anti-Counterfeiting Trade Agreement; customs administrations; Monsanto

Bosworth, D. 23

Braithwaite, J. 16

Brandelli, O. 164

Branstetter, L. 189

Brazil

SECURE project concerns over TRIPS-plus push 181

replacement of ‘shoulds’ with ‘mays’ 182

undermining of flexibilities 181

Brusick, P. 201

Business Software Alliance (BSA) 21

Centre for Economics and Business Research (CEBR) 24

China

United States’ complaint against China 134–5, 141
denial of protection and enforcement to unauthorized works 140–41
disposal of goods confiscated by customs authorities 138–40

Downloaded from Elgar Online at 03/06/2019 07:27:59AM via free access
example of developed country intervention into law-making and enforcement 141
isolating enforcement provisions from principles and objectives of TRIPS 148
thresholds for criminal procedures and penalties 135–8
China National Intellectual Property Protection Working Group 26
Choer Moraes, H. 164
CIPIH 3
CIPR 3, 45, 46, 55, 200
civil society
role in lobbying against legislative initiatives 142
collection societies 47
commercial users
role and interests in intellectual property enforcement 48–9
Commission for Intellectual Property Rights (CIPR) 3, 45, 46, 55, 200
Commission on Intellectual Property Rights, Innovation and Public Health (CIPIH) 3
competition policy
developed countries
competition / antitrust laws as countermeasures against abuse of IPRs 190–94
efficiencies 194
guidelines regarding IPRs 194
promotion of research and development 193–4
public interests 194
rule of reason 194
developing countries
adoption of national competition legislation against abuse of IPRs 199
balance between IPR protection and other social and public interests 202
capacity building and technical assistance 200, 202
enhancement of enforcement of national competition policy vis-à-vis IPRs 200
international cooperation in dealing with transnational issues 200–201, 202
need for pro-competitive IPR policy 199
international harmonization of IPR competition rules 195–6, 201
international IPR conventions inherent limitations and exceptions on competition aspects 194–5
TRIPS Agreement provisions 196–7
WIPO Development Agenda 198
WTO 198
public interests 212
compulsory licensing regimes concerns over 122, 123
consumers
role and interests in intellectual property enforcement 48
Convention on Biological Diversity compatibility with TRIPS Agreement 177
Cornish, W. 28, 136
Correa, C. 5, 6, 8, 45, 50, 52, 199
costs of enforcement 28–31
cost–benefit approach 29, 30, 31, 74–5, 149
direct costs 29
effect of developed countries’ enforcement agenda 143
indirect costs 29
private parties 74, 75
SECURE 75, 76, 77
TRIPS Agreement 29, 30, 31
counterfeit medicine 10, 210
definition of 19
counterfeiting and piracy
consumer threat 20–21
definitions 19, 71–2
discourse on global threat 9
Global Congress on Combating Counterfeiting and Piracy 10, 14, 15
misconceptions on scope of TRIPS 16–18
misuse of the terms product falsification, counterfeiting and IP-infringed goods 18–19
TRIPS-plus agenda 162, 209, 210
WCO Action Plan to Fight Counterfeiting and Piracy 171–2
see also Anti-Counterfeiting Trade Agreement
criminal procedures 208, 211
misconception that WTO members are required to provide criminal procedures for all IPRs under TRIPS 34–7
non-commercial activities 143
thresholds
United States’ complaint against China 135–8
customs administrations
China
disposal of goods confiscated by customs authorities 138–40
expanded authority of 210
harmful to economy 144
misconception that customs administrations have the authority to determine IP infringement 37–40
power to detain allegedly infringing goods 96
role and interests in intellectual property enforcement 52
see also border measures;
Monsanto; Provisional Standards Employed by Customs for Uniform Rights Enforcement
damages
award of 111
adequacy of awards 111, 112, 113, 114, 125
potential for irreparable harm 111, 112, 113
Delich, V. 82
developed countries
pressure on developing countries to strengthen enforcement 4, 5, 209–10
developing countries
awareness of TRIPS-plus agendas 178
barriers for innovation and development 189–90
coordinated actions on TRIPS-plus agendas 13, 177, 178
hindrance to development from TRIPS-plus standards 13
interests in intellectual property enforcement
defensive interests 54–5
offensive interests 55–6
need to make use of flexibilities in the international intellectual property regimes 3, 55
pressures to increase efforts 4, 5, 209–10
pro-development enforcement agenda 145, 146, 147, 150
data development 147
diversified enforcement system 150
linking enforcement provisions to principles and objectives of TRIPS 147, 148
need for solidarity 147, 150, 151
technology transfer 148
role in multilateral intellectual property rules 209
soft law
development of 147
Devereaux, C. 86
Digital Millenium Copyright Act (DMCA) 145
Digital Rights Management (DRM) 145, 169, 170
DMCA 145
Doctrine of Equivalents 38
Drahos, P. 7, 16
DRM 145, 169, 170
Dutfield, G. 6, 7
EC 28
Economic Partnership Agreement 26, 32, 33
equity jurisprudence 98–9
see also injunctive relief
EU 18, 20, 22
European Community
competition policy for regulating IPRs 192–3
European Parliament 37
European Scrutiny Committee 36, 37
evolution of intellectual property systems
developed countries 4
developing countries 4–5
Finger, M. 189
Fink, C. 201
forum shifting 10, 146, 159, 160, 210, 211
disadvantages for developing countries 146
dynamics of 160–61
mandate for intellectual property discussions 9, 10
multiple forum capture 9, 10, 11
‘second-best’ venue 161
see also World Customs Organization
G8 20
Gantz, J. 25
Geiger, C. 45
Geist, M. 19
general public
role and interests in intellectual property enforcement 49–50
generic medicines 167, 183
genres
patents 83
see also Monsanto
Gervais, D. 45
Global Congress on Combating Counterfeiting and Piracy 10, 14, 15
global governance
changes taking place 9–12
governments
bearing the cost of enforcement 28–31
responsibility for intellectual property enforcement 26–8
Grosse Ruse-Khan, H. 45, 54
Guibault, L. 46
Havana Charter 195–6
Heath, C. 193
Holzmann, R. 38
Howse, R. 45, 55
Hugenholtz, P. 46
industry players
linking intellectual property and trade 6–7
TRIPS-plus agenda 4, 9
injunctive relief 99
deterring challenges to validity 117–20
developing countries’ approach to 54
flexibility of relief 125
TRIPS Agreement 107–10
holdup costs 116, 117
judicial resources 115, 116, 117
public interests 120–21, 122, 123
trade pressures 125
United States
eBay, Inc. v. MercExchange, L.L.C. 103, 104, 105, 106, 120
flexibility of relief 104, 106, 107, 124
four-factor test 105
granting relief 100–103
presumption of irreparable harm 100, 101, 102
public interest 105
right-remedy distinction 104
innovation barriers 189–90
legalization of private enforcement measures 144–5
promotion of 212
competition policy 193–4
intellectual property treaties 5
intermediaries
role and interests in intellectual property enforcement 52–3, 54–5
see also Internet Service Providers
International Medical Products Anti-Counterfeiting Taskforce 10
Internet Service Providers (ISPs)
as private police for copyright enforcement 145
role and interests in intellectual property enforcement 52–3
intervention into law-making 141, 142, 143
civil society role 142
see also China
IP-infringed goods
definition of 19
misuse of the terms product falsification, counterfeiting and IP-infringed goods 18–19
ISPs see Internet Service Providers

Japan
competition policy 193
judicial discretion 98, 99
see also injunctive relief
judiciary
judicial control over market prices 122, 123, 124
misconception that WTO members are required to establish a distinct judicial system for the enforcement of IPRs 33–4
resources for injunctive relief 115, 116, 117
role and interests in intellectual property enforcement 51
Kennedy, K. 196
Kjøelbye, L. 193
legalization of private enforcement measures threatening developing countries’ innovative development 144–5
Li, X. 23, 53, 68, 96
licensees
role and interests in intellectual property enforcement 49
Llewelyn, D. 136
Locklear, F. 25
López, A. 82
magnitude of claimed IP-infringement 21–5
Mantilla, G. 35
Maskus, K. 75
Mathew, J. 46, 49, 52
Matthews, D. 6, 161
May, C. 6
McCalman, P. 199
McCullagh, D. 51
McDermott, E. 56
misconceptions on intellectual property enforcement 15, 40
counterfeiting and piracy includes patent infringement 16–18
counterfeiting and piracy pose a consumer threat 20–21
customs administrations have the authority to determine IP infringement 37–40
governments should bear the cost of enforcement 28–31

governments should take primary responsibility for intellectual property enforcement 26–8

implications for developing countries 40, 41

magnitude of claimed IP-infringement is enormous 21–5

product falsification, counterfeiting and IP-infringed goods are identical 18–19

purposely promoted by developed countries 40

WTO members are obliged to provide border procedures for all types of transactions and all forms of IPRs 31–3

WTO members are required to establish a judicial system for the enforcement of IPRs 33–4

WTO members are required to provide criminal procedures for all IPRs under TRIPS 34–7

Monsanto

action against European importers 85–6, 87

chances of success 88–9

court rulings 90–96

customs action against suspected infringements 89, 90

patent infringement 87

RR gene

compensation request 85

consent to use of in Argentina 84, 85

development of 82

patenting of 82

strategic litigation 96

transnational litigation 81

Muñoz Tellez, V. 9, 10, 32, 46, 72, 202

Musungu, S. 6, 7

Narendranath, K. 49, 52

Netherlands

Monsanto court rulings 94–6

Newberg, J. 190

non-commercial activities

criminal punishments 143

OECD 18, 21, 23

Okediji, R. 45

Ollier, P. 51

ongoing royalty injunctions 105–6, 123

Parliament of Australia 48

Pate, R. 191

patent infringement determination 38

litigation process 39

see also Monsanto

patent system

characteristics of 82–3

genes 83

non-global 83

territorial nature 82, 83

Peeperkorn, L. 193

piracy see counterfeiting and piracy

postal services

role and interests in intellectual property enforcement 53

product falsification consumer threat 20

definition of falsification 19

misuse of the terms product falsification, counterfeiting and IP-infringed goods 18–19

Provisional Standards Employed by Customs for Uniform Rights Enforcement (SECURE) 20, 160, 161, 163

Brazil

commisions over TRIPS-plus push 181
replacement of ‘shoulds’ with ‘mays’ 182
undermining of flexibilities 181
developing countries concerns for 63, 179–80, 181, 182
constraints on policy space 77
coordination against adoption of standards 63, 65, 66, 67, 77, 78, 178, 179–80
lack of agreed terms of reference 182
participation of 179, 180, 181, 183
documents 163
access to 173, 181
standards 164–8
WCO Action Plan to Fight Counterfeiting and Piracy 171–2
WCO model provisions 168–70
economic impact of 74, 75, 76, 77
costs of enforcement 75, 76, 77
trade barriers 75, 76, 77, 166, 167
legal effect of 74
legitimacy
references to G8 priorities 163
negotiations 64–5
observers 181
origins 64
SECURE Working Draft 66, 67
border measures 68
characteristics of 67–8
standards 66, 67, 164–8
best practices 164
customs authorities’ powers 165, 166, 167
format of document 164
generic medicines
consequences for 167, 183
hard law provisions 164
need for more informed discussions 181
‘one size fits all’ legal framework 164, 165
overlapping with ACTA
border measure provisions 167–8
trade barriers 166, 167
transparency 180–81
TRIPS-plus-plus measures 63, 68–73, 77
disruption of legitimate trade 70–71, 72–3
expansion of subjects and scope of enforcement 68, 69, 71–2
favouring rights-holders 69, 70, 72
uncertain rules 181
WCO Action Plan to Fight Counterfeiting and Piracy 171–2
improving legislative provisions 171
WCO model provisions 168–70
‘backdoor legislation’ 170
Digital Rights Management 169, 170
mandatory legislation 168
privacy rights 170
recommendations for the implementation of border measures 168
technological protection measures 169, 170
trade barriers 170
WIPO Development Agenda comparison with 73–4, 77
Working Group 10, 63, 64, 65, 163, 175, 176
composition of 173
terms of reference 173
see also World Customs Organization
public interest
competition policy 194, 202, 212
injunctive relief 105, 120–21, 122, 123
World Customs Organization 184
Reichenmiller, P. 201
Reichman, J. 47
research and development
competition policies to promote
193–4
responsibility for intellectual
property enforcement 26–8
delineation of 27
rights-holders 27, 28
rights-holders
bias towards 43, 56, 69, 70, 72, 211
costs of enforcement 74, 75
developing countries 55–6
exploitors 47
influence in WIPO 6
initial rights-holders 46–7
role and interests in intellectual
property enforcement 27, 28, 46–7
Roffe, P. 196
Russian Federation 35
Sakakibara, M. 189
Schneider, M. 72
Schuler, P. 189
SECURE see Provisional Standards
Employed by Customs for
Uniform Rights Enforcement
Sell, S. 6, 9, 161
Sherman, B. 45
Sindico, F. 86
social and economic development
effect of enforcement agenda
145
IP regimes 212
relationship with intellectual
property 3
TRIPS Agreement 45, 73
WIPO 73
South Centre 29, 30, 66, 74, 228
Innovation, Access to Knowledge
and Intellectual Property
Programme 228
Spain
Monsanto court rulings 93–4
‘Special 301’ Report 26
stakeholders 45
bias towards rights-holders 43, 56
developing countries 53–6
enforcement interests
dependent on role and interests
in intellectual property
system 44
intermediaries 52–3
rights-holders 46–7
state authorities 50–52
users 48–50
wide understanding of
intellectual property
enforcement 44–5
state authorities
customs administrations 52
IP offices 51
judiciary 51
role and interests in intellectual
property enforcement
50–52
strategic litigation 96
see also Monsanto
Sweney, M. 53
technology transfer
pro-development enforcement
agenda 148
restrictive practices imposed by
TNCs 190
TRIPS Agreement 148
territoriality 82, 83, 149, 150
Tom, W. 190
trade barriers
customs administrations 38, 39, 52
SECURE 75, 76, 77, 166, 167, 170
transnational litigation 81
see also Monsanto
Trebilcock, M. 45, 55
TRIPS Agreement 7
border measures 68, 208
challenges for developing
countries 189
competition issues 196–7
Convention on Biological Diversity
compatibility with 177
costs of enforcement 29, 30, 31
criminal procedures and penalties 208
developing countries’ agreement and trade-offs 7
diversified enforcement systems 150
effect on developing countries 7–8
enforcement of obligations 7
flexibilities, limitations and safeguards 40–41, 207, 208
developing countries’ difficulties in implementing 8, 9
left to national discretion 8–9
increased global IPR protection levels 189
industry players’ influence 7
injunctive relief flexibility of relief 107–10
legal systems states’ own systems 207, 208
linking enforcement provisions to principles and objectives 147, 148
minimum standards of enforcement 8
priorities of developed countries 8
remedies against mala fide use to intimidate developing countries 148
social and economic welfare 45, 73
technology transfer 148
territorial differentiations 149, 150
wide understanding of intellectual property enforcement 44–5
see also misconceptions on intellectual property enforcement
TRIPS-plus enforcement standards avenues of 209
bias towards rights-holders 211
border measures Economic Partnership Agreement 32, 33
WCO forum 31–2
cost–benefit assessment 149
counterfeiting 162, 209, 210
criminal punishments 211
non-commercial activities 143
customs authorities expanded authority of 210
power to detain allegedly infringing goods 96
developed countries and industry players’ pursuit of 4, 9
developing countries awareness of TRIPS-plus agendas 178
coordinated actions on TRIPS-plus agendas 13, 177, 178
hindrance to development 13
explanatory factors 10, 11–12
domestic law reforms 12
regional and bilateral trade agreements 12
resistance of developing countries 12
window of opportunity 10, 11
misconceptions of consumer threat 21
United States provisions in bilateral investment treaties and free trade agreements 201
World Customs Organization change in approach 184
characteristics favourable for TRIPS-plus enforcement agenda 161, 176–7
see also Anti-Counterfeiting Trade Agreement; China; forum shifting
TRIPS-plus-plus intervention into law-making 142, 143
see also Provisional Standards
Employed by Customs for Uniform Rights Enforcement
Tulquois, G. 53

UNCTAD 45, 189
UNCTAD-ICTSD 8, 45, 197
uniformity of protection standards and enforcement measures 149, 150

United Kingdom
Monsanto court rulings 90–93

United States
antitrust regulations against abuse of IPRs 191–2
complaint against China 134–5, 141
denial of protection and enforcement to unauthorized works 140–41
disposal of goods confiscated by customs authorities 138–40
denial of protection and enforcement to unauthorized works 140–41
example of developed country intervention into law-making and enforcement 141
isolating enforcement provisions from principles and objectives of TRIPS 148
thresholds for criminal procedures and penalties 135–8
TRIPS-plus provisions in bilateral investment treaties and free trade agreements 201

see also injunctive relief
users
commercial users 48–9
consumers 48
general public 49–50
role and interests in intellectual property enforcement 48–50

USPTO 28
USTR 202
Vrins, O. 72

Wager, H. 198
Watal, J. 201
WCO see World Customs Organization
WHO 19, 22

wide understanding of intellectual property enforcement 44–5
Wilson, B. 191
WIPO see World Intellectual Property Organization
World Bank 45
World Customs Organization (WCO)

border measures
TRIPS-plus standards 31–2
characteristics favourable for TRIPS-plus enforcement agenda 161, 176–7
counterfeiting and piracy used to push TRIPS-plus project 162
difficulties for developing countries 177
informed and balanced discussions, need for 183
institutional aspects of the decision-making process 173–6
legitimacy of 162
limited transparency 162, 172, 175, 176
mandate 62, 64
Policy Commission 65, 173–4, 175
composition of 174–5, 183
developed countries’ influence 175
observers 174
public interests 184
representation 183, 184
‘second-best’ forums 184
Secretariat 172, 182
  influence of 175–6
  recommendation to establish
  new group to deal with
  IPR matters 182–3
TRIPS-plus strategies
  change in approach 184
see also Provisional Standards
  Employed by Customs
  for Uniform Rights
  Enforcement
World Intellectual Property
  Organization (WIPO) 21, 26
  administering of treaties 5
  developing countries’ role in 5, 6
  Development Agenda 73, 177
  comparison with SECURE
  73–4, 77
  competition policy 198
  developing countries’ capacity
  for agenda-setting
  150–51
  pro-development enforcement
  agenda 146–7
  private right-holders’ influence 6
  societal interests 73
  technical assistance scheme
  142–3
World Trade Organization (WTO)
  competition policy 198
  Dispute Settlement Body
  developing countries sued at
  133
see also China
Xue, H. 134, 145