Preface

The purpose of this book is twofold. First, it aims to provide researchers and practitioners of international intellectual property law with the necessary tools to understand the latest debates in this incredibly dynamic and complex field. Second, the book can be used by students of international intellectual property to obtain useful knowledge of major institutions and instruments, and to gain an understanding of ongoing discussions. The book thus contains both doctrinal analyses and ground-breaking theoretical research by many of the most recognized leading experts in the field.

The book is divided into four main parts. The first part begins with an analysis of the origins, structure and content of the two instruments that can undoubtedly be considered historically as the most important intellectual property treaties, namely the Berne Convention on the Protection of Literary and Artistic Works and the Paris Convention on the Protection of Industrial Property.

The first chapter, on the Berne Convention, was co-authored by the two most prominent commentators on the Convention, namely Professors Jane Ginsburg and Sam Ricketson. They anchor the origins of the Convention solidly in human rights waters, explain the major features of the Convention, and turn to events since its last revision in 1971 and in particular since 1986, the year at which they situate the high-water mark for authors' rights' protection, adding that in "the years since 1986, there has been increasing awareness of other human rights that are competing for attention along with those of authors." In spite of a very rapid increase in its geographical coverage (the Convention had 168 Member States as of November 2014), however, the authors suggest that:

when its broader context is considered, the real story of the Berne Convention in recent years is rather different, and its successes have been more formal than substantive, with countervailing currents and pressures that have led to its reduced relevance since 1986. At the symbolic level, the institutional importance of the Berne Union now also appears diminished.

The following chapter, on the Paris Convention and other major patent-related instruments, was co-authored by three experts from the Patent Law Division at the World Intellectual Property Organization (WIPO)

including its director, Dr Philippe Baechtold, with Tomoko Miyamoto and Thomas Henninger. The chapter explores the emergence of the Paris Convention (176 Member States as of November 2014), but also the role of other instruments such as the Patent Cooperation Treaty (PCT) (on which there is a separate chapter by Dr Cees Mulder – see below), the Patent Law Treaty, and the interface with the TRIPS Agreement. The chapter also discusses the role of major regional organizations (including the European Patent Office) and others in achieving a greater degree of patent law harmonization (that is, beyond existing instruments). Future harmonization, to the extent that it does happen, is likely to emerge not (just) as a set of new multilateral norms, but also as administrative practice, especially of major examining entities, which new technological tools make much easier and cost-effective.

In Chapter 3, Professor Peter Yu considers the different fora in which international intellectual property norms have been or are being negotiated. The chapter then focuses in particular on the recent move away from the multilateral institutions such as WIPO, and towards a regional or a “like-minded” fora, such as the Trans-Pacific Partnership discussions. The chapter offers several important insights on the back-and-forth between smaller (regional or like-minded) groups and multilateral institutions, concluding that if:

the many diverse, and at times conflicting, normsetting activities that take place in the non-multilateral era would eventually lead to norm consolidation through the multilateral process, such as the development of TRIPS II, non-multilateral activities will benefit the international intellectual property regime. By contrast, if those activities further fragment the existing international intellectual property regime or polarize the global community, those activities will greatly undermine the regime.

In the final chapter of Part I, Professors Graeme Dinwoodie and Rochelle Dreyfuss discuss a key emerging issue namely the existence of an *acquis* in international intellectual property. They define this *acquis* as “a set of basic principles that form the background norms animating the intellectual property system.” They note that there indeed exist:

principles that constitute the backdrop to all international and national intellectual property lawmaking. The international intellectual property system has been 150 years in the making; comprehensively fleshing out its underlying principles will also take time and will require the efforts of numerous scholars and policy makers. However, the benefits are potentially vast. As the *acquis* grows, so too will its significance. Retrospectively, it can be used interpretively, to bring coherence to the international system, and to

fill gaps. Prospectively, it would create a template for crafting new intellectual property instruments.

Part II is devoted to copyright and related rights. Copyright is of course mentioned in most of the chapters of Part I. Here, the book presents two major substantive issues that have caused a significant degree of difficulty and disagreement among scholars and policy makers alike and illustrate ongoing difficulties in defining an optimal set of copyright rules. The first chapter of this part, co-authored by Professors Christophe Geiger and Martin Senftleben and the Editor, explains the origins of the three-step test in Article 9(2) of the Berne Convention and recent debates concerning the interpretation of the test. As the chapter explains, the test has become the key norm guiding lawmakers and negotiators crafting domestic exceptions and limitations to copyright rights but also to other rights, including industrial designs and patents in Articles 26.2 and 30 of the TRIPS Agreement. Beyond Berne and TRIPS, the test is also used in the WIPO Copyright Treaty, the WIPO Performances and Phonograms Treaty, the Beijing Treaty on Audiovisual Performances and the Marrakesh Treaty to Facilitate Access to Published Works for Persons who are Blind, Visually Impaired or Otherwise Print Disabled. Interestingly, “a significant concern follows from the fact that the language of the test changes, sometimes quite significantly, each time it appears somewhere new.”

In the next chapter, Professor Katharina de la Durantaye, explores options to ameliorate the fate of “orphan works,” that is, works that are still protected by copyright but are “without an owner to negotiate with.” There is no uniform international solution or policy response. Current proposals can be grouped in three main categories: licensing; expansion or recognition of a greater role for exceptions and limitations; and limitations on remedies (e.g. statutory or predetermined damages). The chapter explains that another approach would be to work to reduce the size of the problem.

The most elegant way of dealing with the orphan works problem, at least prospectively, would be to prevent orphanage and the market failure associated with it. The orphan works problem is mainly an information problem. It comes in three forms: a work may have never contained any ownership information, ownership information may have gotten lost, or the information may be outdated, either because the author has died or because ownership has changed for other reasons.

While copyright remains extremely important, as debates in national courts, WIPO, and legal literature illustrate, much of the research and

policy focus in recent years have been on patents due mostly to two issues: the interface between patents and pharmaceutical research (and access thereto), and generally the desire in many countries around the world to develop a better innovation policy. In parallel, efforts are afoot to implement easier mechanisms to obtain a patent in multiple jurisdictions. These are the themes explored in Part III.

The part begins with a chapter by Professor Susy Frankel on “Traditional Knowledge and Innovation as a Global Concern.” Using a number of Māori examples from Aotearoa/New Zealand, the chapter demonstrates the importance of the protection of certain knowledge assets for indigenous peoples and also several developing countries, explaining that the “tension over what sort of intellectual property is protected and what is not is also a concern for indigenous populations of both developing and developed countries, and particularly minority populations in developed countries with high levels of intellectual property protection.” After a discussion of the (considerable) definitional difficulties in this area, the chapter shows the overlap and disjuncture of traditional knowledge and intellectual property rules, including those contained in the TRIPS Agreement. It concludes that “some agreed minimum standards are necessary.”

The next chapter examines the limits of patents. The co-authors, Professor Elizabeth Judge and the Editor, explain that, at times perhaps too much is expected of the patent system. It does not always deliver. At times, it may indeed be counterproductive – either systemically or because of the specific way in which some people use it – if measured in terms of impact on net innovation outcomes. Among the issues mentioned in the chapter are: the one-size-fits-all way in which patentable inventions are typically defined domestically and internationally; relatedly, the possible need to factor in industry-specific impacts of patents; low quality of patents issues in certain jurisdictions at least; the fact that patents are rights to exclude; and finally the fact that patents are seldom compared to other forms of incentives (such as prizes). The chapter then examines the applicable provisions of the TRIPS Agreement. It also considers the latest research on whether patents help or hinder, in which circumstances and why, and how patents interface with human rights. The last part provides a detailed account of research on the role that patents play, with other policy levers, in developing a coherent innovation policy.

Asking whether patents – in aggregate or at least by type of invention or industry – help or hinder research and innovation presupposes that there are convincing ways to measure such impact. This is the subject of the next chapter by Professor Geoffrey Scott, which provides a detailed

account of how information is generated, including in the “open source” context, and disseminated, based on various and often cultural factors, which are reflected, *inter alia*, in the existence of different legal systems. The chapter offers a broad historical and geographic *tour d’horizon*, concluding that “[m]isunderstanding, whether through failure of inquiry, failure to truly appreciate the presumptions and perspectives of others in the dialogue, or nondisclosure of assumptions or expectations, seems to often punctuate discussion and has led to considerable tension and unsatisfactory outcomes in the global IP community.”

The last chapter of Part III presents the PCT: the poster child for internationally integrated application systems for intellectual property that can or must be registered with or granted by governmental authorities, given that intellectual property rights are largely territorial in nature. One of the world’s foremost experts on the PCT, Dr Cees Mulder presents the PCT: its history, structure, and its principal features (process and procedures). While formal harmonization of substantive patent law has been an elusive target, much progress has been made on the administrative side as the PCT and instruments adopted since (including the PLT) amply demonstrate. The chapter presents a complete picture of the PCT application, examination, and publication process, one of the very few publications to do so comprehensively.

The last part of the book (Part IV) deals with the protection of two types of trade symbols, namely trademarks and geographical indications. Trademarks are a major influence in the daily lives of billions of people. They guide the hand of the buyer. People wear them proudly (sometimes) on everything from t-shirts to designer handbags. They function as symbols from the grocery store to fancy soirees and even among various countercultural movements. Their interface with free expression is, therefore, an essential area of study. It is also the topic of the first chapter of this part, authored by Professor Lisa Ramsey. The chapter explains how trademark can be speech-restrictive, describes the major applicable rules including those contained in the TRIPS Agreement, and discusses the role of model laws. Important “external” limits on trademark rights to further expressive interests can be found in a number of constitutional laws and human rights treaties. Countries can also internalize free speech principles within their trademark laws, however. The chapter thus includes a call to “develop a global soft law instrument that contains specific, speech-protective model trademark laws that comply with international obligations to protect trademarks in TRIPS and the Paris Convention.”

The following chapter, by Professor Sam F. Halabi, offers a path to reconcile trademarks with a somewhat different normative concern,

namely international rights and obligations to protect health. After setting the stage by offering useful examples of the interface between trademarks and public health (such as the ban or limitations on the use of trademarks on cigarette packaging), the chapter proceeds to explain the expansion of trademark rights in international intellectual property. After a brief discussion of speech-related issues, the chapter then turns to its central thesis, namely that seeing trademarks as a “form of property with narrow rights to exclude and alienate” would allow “regulators to tailor their protective scope to their commercial function.” It suggests in this context that “[n]ational authorities and international arbitrators enjoy sufficient flexibility to craft an expropriation proceeding that balances the state’s duty to protect individual and public health with the trademark holder’s legitimate interest in the distinguishing characteristics of its mark.”

The penultimate chapter, by Professor Haochen Sun, focuses on a particular form of expansion of trademark right – domestically but increasingly internationally as well – namely anti-dilution protection, in particular when applied to luxury brands. The chapter draws a clear picture, illustrated by several examples, of the arguments surrounding the emergence of anti-dilution protection for global brands, the (limited) role of dilution in the TRIPS Agreement, and divergences among major players, especially the European Union and the United States on the best way to define and implement anti-dilution rules. The chapter then considers the regime of protection of well-known marks in China. It suggests a path forward: amend the TRIPS Agreement to include an explicit requirement about anti-dilution protection; rely on an expansive application of the national standard to link the fragmented domestic anti-dilution laws together; consider the limitations that should be carved out in anti-dilution protection to avoid overzealous trademark protection; and continue research to ascertain the appropriate level of anti-dilution law in protecting brands.

Last but not least, Professor Irene Calboli’s chapter “Of Markets, Culture, and *Terroir*”, discusses the unique economic and culture-related benefits of geographical indications (GIs). GIs are mentioned in the TRIPS Agreement, where a distinction is made between GIs on wines and spirits (high level of protection); other GIs (lower, trademark-like level in that it requiring a likelihood of confusion); and an obligation to negotiate a possible system of notification and registration for GIs on wines (and spirits as was added by the Doha Declaration in 2001). There is also renewed interest as of this writing (early 2014) in a renovated Lisbon system. The chapter presents the economic and cultural advantages of GIs, but also relevant critiques and counterarguments. Among the key economic arguments is that GIs can incentivize “the creation and

conservation of niche-markets,” but also “provide consumers with a unique set of information about the products that are identified by the GIs, namely with respect to the physical location and the methods of production of the GI-denominated products.” The chapter ends with a suggestion that the GI issue is ripe for consideration multilaterally, which would allow the development of better and clearer rules and exceptions.

Daniel J. Gervais