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INTERNATIONAL IP TREATIES AND CONVENTIONS: PATENT LAW

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INTRODUCTION

Intellectual property has a dual nature, i.e. it has both a national and international dimension.

For instance, patents are governed by national laws and rules of a given country, while international conventions on patents ensure minimum rights and provide certain measures for enforcement of rights by the contracting states

Today, the Paris Convention, The TRIPS Agreement and the treaties WIPO administers, together with national and regional laws, make up the international legal framework for patents.

Standing Committee on the Law of Patents (SCP) - WIPO works with its member states and observer organizations to develop balanced international frameworks for patent law and policy.

Committee members discuss, debate and decide on diverse issues related to the development of patent law to meet society's evolving needs.

Standing Committee on the Law of Patents: Thirty-First Session - December 2 to December 5, 2019 (Geneva, Switzerland)

The Paris Convention for the Protection of Industrial Property

signed in Paris on 20 March 1883, last revised on 14 July 1967.

The Paris Convention applies to industrial property in the widest sense, including:

- patents,
- trademarks,
- industrial designs,
- utility models (a kind of "small-scale patent" provided for by the laws of some countries),
- service marks,
- trade names (designations under which an industrial or commercial activity is carried out),
- geographical indications (indications of source and appellations of origin) and
- the repression of unfair competition.

This international agreement was the first major step taken to help creators ensure that their intellectual works were protected in other countries.

The substantive provisions of the Convention fall into three main categories:
national treatment, right of priority, common rules.

National Treatment [arts. 2, 3]

- each Contracting State must grant the same protection to nationals of other Contracting States that it grants to its own nationals.
- Nationals of non-Contracting States, domiciled or having a real and effective industrial or commercial establishment in a Contracting State – also get NT

Right of Priority (Art. 4, 4A)

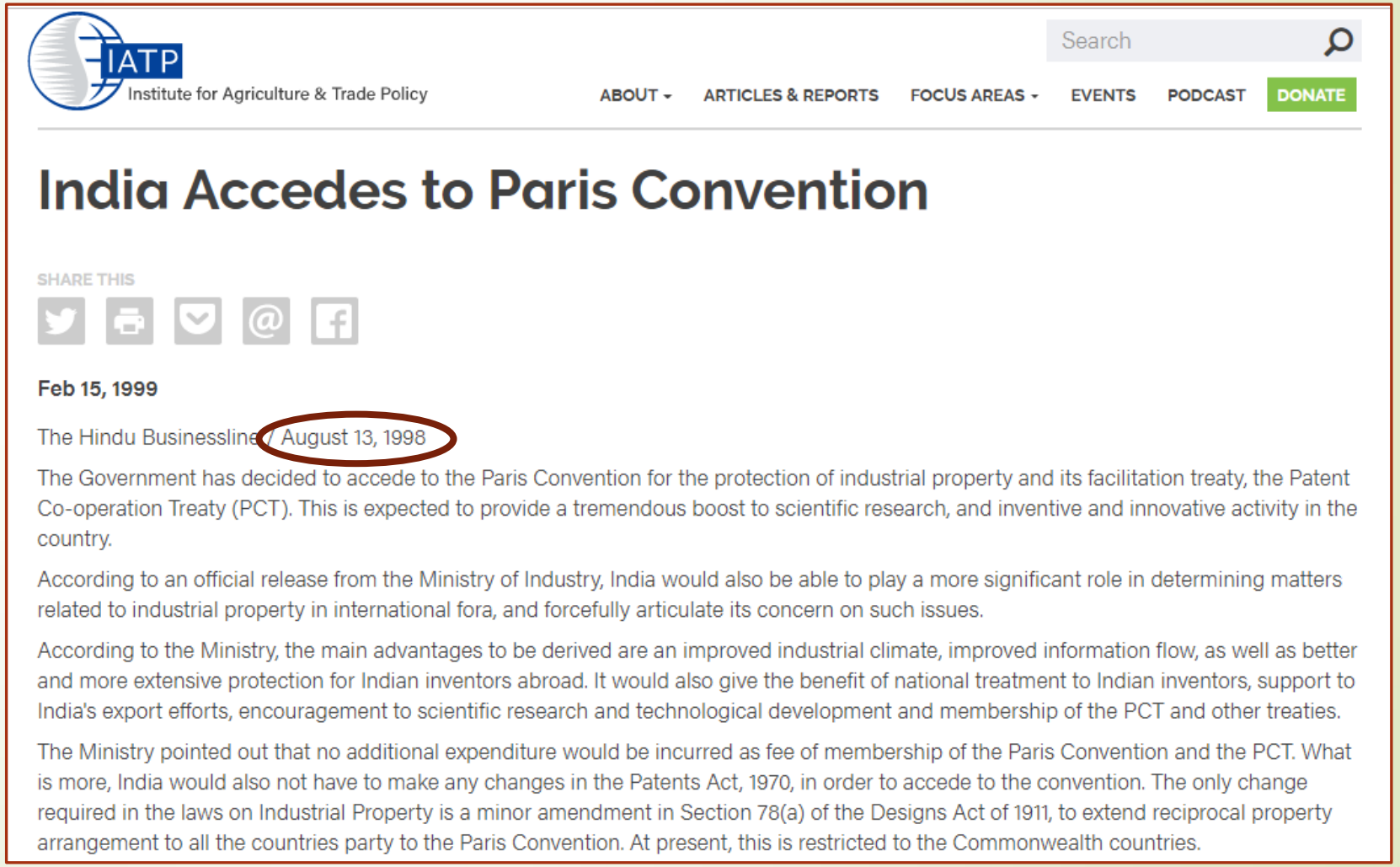
- on the basis of a regular first application filed in one of the Contracting States, the applicant may, within a certain period of time (12 months for patents and utility models; 6 months for industrial designs and marks), apply for protection in any of the other Contracting States.
- These subsequent applications will be regarded as if they had been filed on the same day as the first application - enjoy a priority status with respect to all applications relating to the same invention filed after the date of the first application.
- the right of priority may also be invoked by the successor in title of the first applicant

Common Rules on Patents

- Independence of Patents- Article 4bis.
- The Right of the Inventor to be Mentioned - Article 4ter
- Importation of articles covered by patents, failure to work the patented invention and compulsory licenses - Article 5A of the Convention
- Grace Period for the Payment of Maintenance Fees - Article 5bis – for patents, the maintenance fees must generally be paid annually - called annuities.
- Patents in International Traffic - Article 5ter - Temporary or accidental entry of the patented device into a Member country in some cases constitutes no infringement of the patent for invention – conditions to be fulfilled.
- Inventions Shown at International Exhibitions - Article 11

India and Paris Convention (+ PCT)

- On Monday, September 7, 1998, India deposited its instrument of accession to two international treaties with the Director General of WIPO in Geneva.
- The two treaties were the Paris Convention for the Protection of Industrial Property and the Patent Cooperation Treaty (PCT).



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India Accedes to Paris Convention

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Feb 15, 1999

The Hindu Businessline / August 13, 1998

The Government has decided to accede to the Paris Convention for the protection of industrial property and its facilitation treaty, the Patent Co-operation Treaty (PCT). This is expected to provide a tremendous boost to scientific research, and inventive and innovative activity in the country.

According to an official release from the Ministry of Industry, India would also be able to play a more significant role in determining matters related to industrial property in international fora, and forcefully articulate its concern on such issues.

According to the Ministry, the main advantages to be derived are an improved industrial climate, improved information flow, as well as better and more extensive protection for Indian inventors abroad. It would also give the benefit of national treatment to Indian inventors, support to India's export efforts, encouragement to scientific research and technological development and membership of the PCT and other treaties.

The Ministry pointed out that no additional expenditure would be incurred as fee of membership of the Paris Convention and the PCT. What is more, India would also not have to make any changes in the Patents Act, 1970, in order to accede to the convention. The only change required in the laws on Industrial Property is a minor amendment in Section 78(a) of the Designs Act of 1911, to extend reciprocal property arrangement to all the countries party to the Paris Convention. At present, this is restricted to the Commonwealth countries.

Patent Cooperation Treaty

entered into force on January 24, 1978, and became operational on June 1, 1978, with an initial 18 Contracting States.

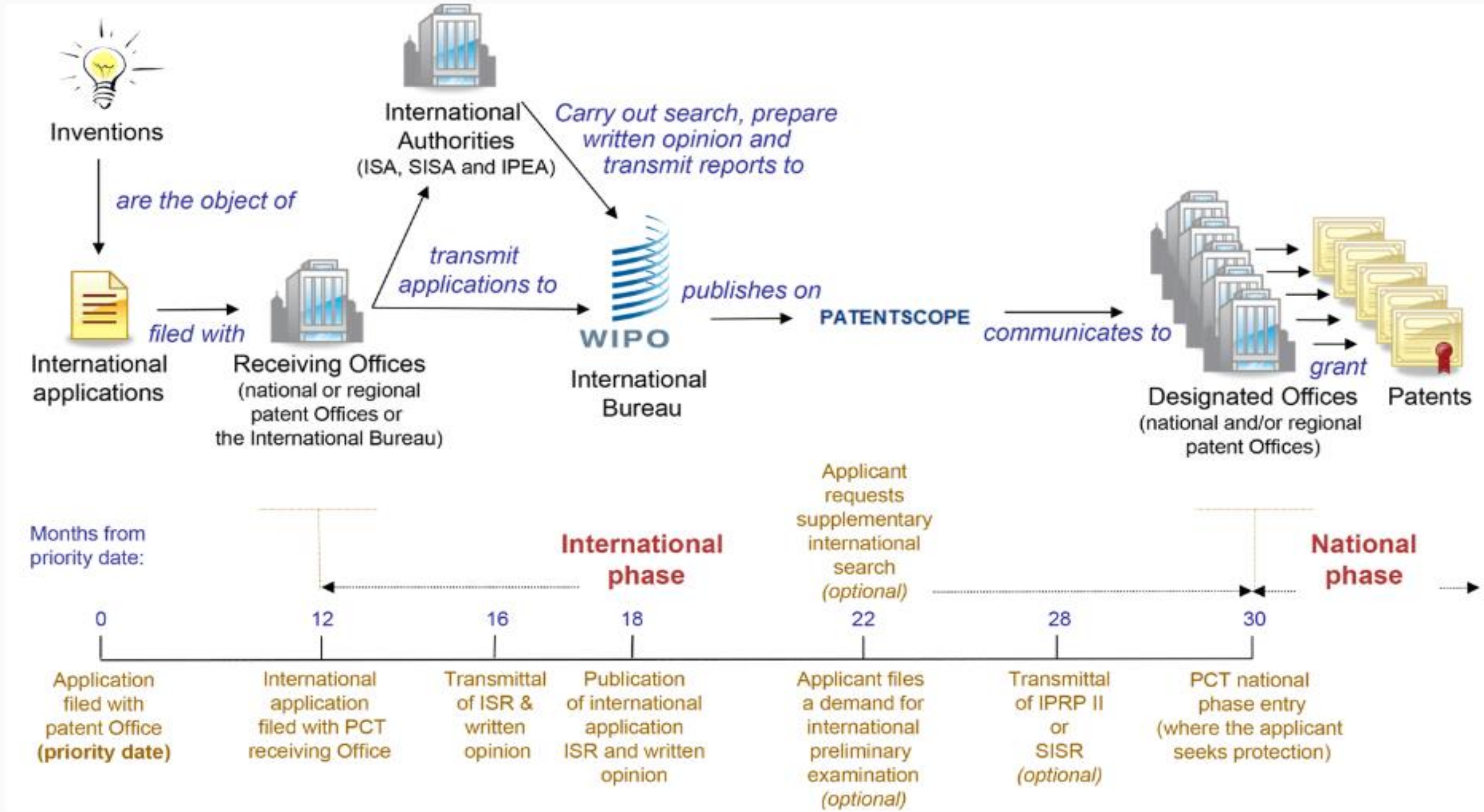
The Patent Cooperation Treaty (PCT) makes it possible to seek patent protection for an invention simultaneously in each of a large number of countries by filing an "international" patent application

Such an application may be filed by anyone who is a national or resident of a PCT Contracting State. It may generally be filed with the national patent office of the Contracting State of which the applicant is a national or resident or, at the applicant's option, with the International Bureau of WIPO in Geneva.

The Treaty regulates in detail the formal requirements with which international applications must comply. - Filing a PCT application has the effect of automatically designating all Contracting States bound by the PCT on the international filing date. The effect of the international application is the same in each designated State as if a national patent application had been filed with the national patent office of that State.

Read more: https://www.wipo.int/pct/en/faqs/faqs.html

Overview of the PCT System



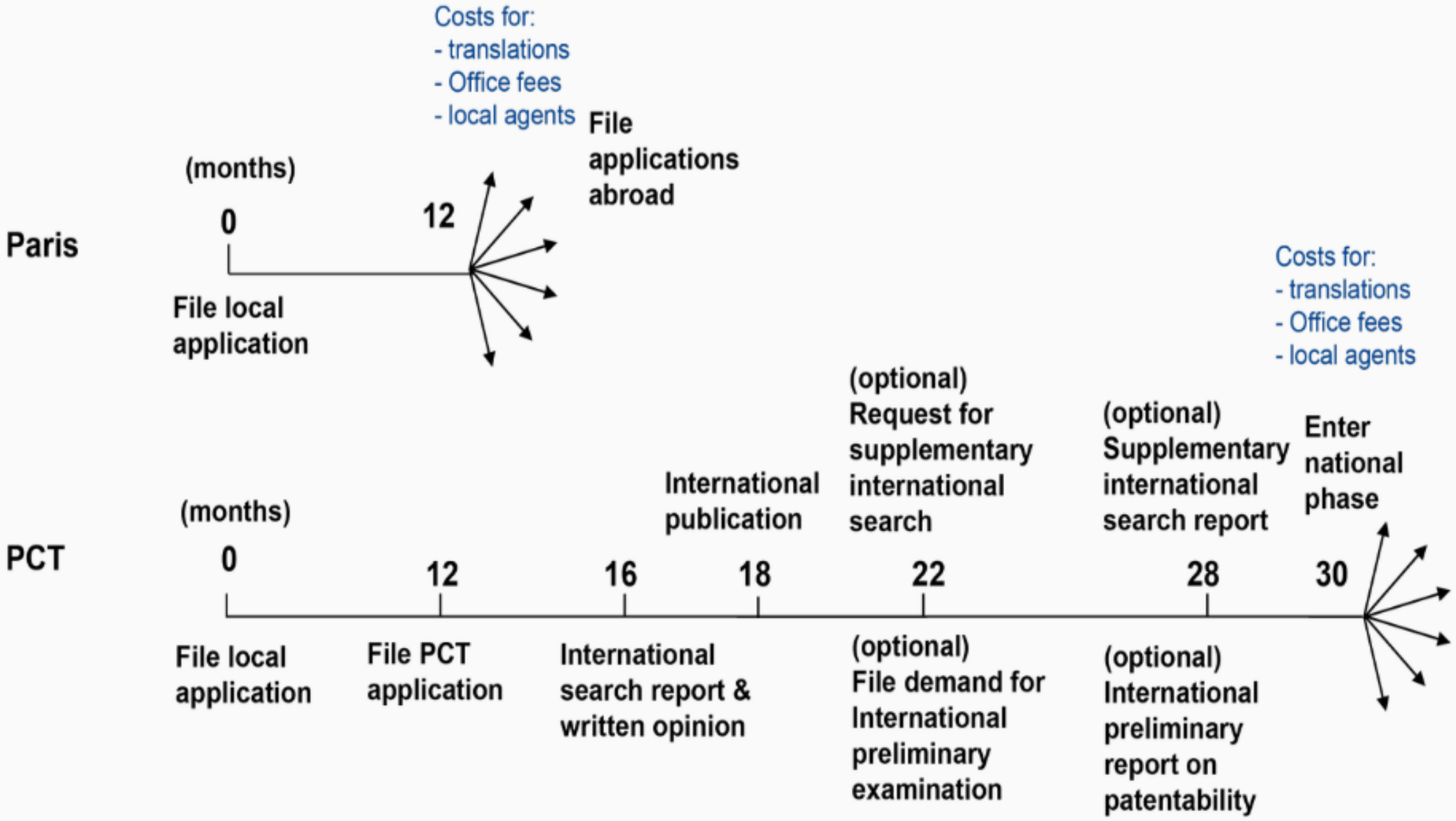
FAQ : **How do I protect my invention in several countries?**

Patents are territorially limited. In order to protect your invention in multiple countries you have a few options:

(a) Direct or Paris route: you can directly file separate patent applications at the same time in all of the countries in which you would like to protect your invention (for some countries, regional patents may be available) or, having filed in a Paris Convention country (one of the Member States of the Paris Convention for the Protection of Industrial Property), then file separate patent applications in other Paris Convention countries within 12 months from the filing date of that first patent application, giving you the benefit in all those countries of claiming the filing date of the first application

(b) PCT route: you can file an application under the PCT, directly or within the 12-month period provided for by the Paris Convention from the filing date of a first application, which is valid in all Contracting States of the PCT and, therefore, simpler, easier and more cost-effective than both, direct or Paris route filings.

Comparison of Paris and PCT Route



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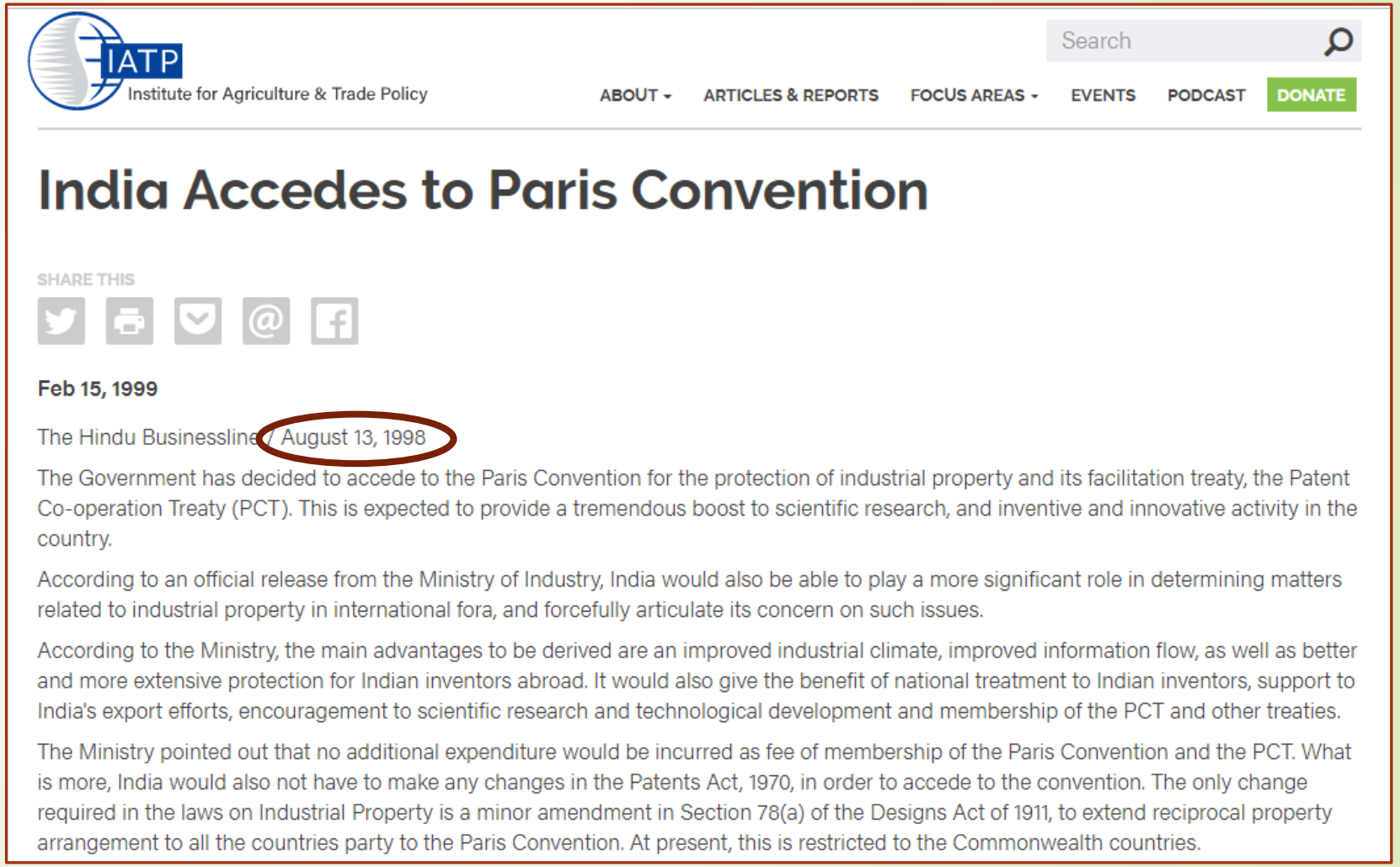

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The Patent Law Treaty (PLT)

The PLT was concluded in 2000, and entered into force in 2005. - The PLT is open to States members of WIPO and/or States party to the Paris Convention for the Protection of Industrial Property (1883). It is also open to certain intergovernmental organizations. Instruments of ratification or accession must be deposited with the Director General of WIPO.

The purpose of the PLT is to harmonize and streamline formal procedures in respect of national and regional patent applications and patents.

With a significant exception for the filing date requirements, the PLT provides maximum sets of requirements which the Office of a Contracting Party may apply: the Office may not lay down any additional formal requirements in respect of matters dealt with by this Treaty

According to Article 3, the Treaty applies to national and regional applications that are applications for patents for invention, applications for patents of addition and divisional applications for patents for invention or for patents of addition.

The PLT also applies to international applications for patents for invention and for patents of addition filed under the PCT once the international applications have entered into the "national phase."

Advantages of the PLT

- From the viewpoint of inventors, applicants and patent attorneys, standardization and simplification of the formality requirements
- a reduced risk of formality errors,
- less frequent loss of rights
- cost reductions.
- Elimination of unnecessarily complex procedures
- streamlining - Offices may operate more efficiently, and therefore reduce their costs.

Strasbourg Agreement Concerning the International Patent Classification

Many years of international cooperation, which started in 1956 under the auspices of the Council of Europe and the World Intellectual Property Organization (WIPO), resulted in 1971 in the Strasbourg Agreement Concerning the International Patent Classification, and provided a worldwide forum for the International Patent Classification (IPC). It entered into force on October 7, 1975, amended in 1979

The Strasbourg Agreement establishes the International Patent Classification (IPC) which divides technology into eight sections with approximately 70,000 subdivisions. Each subdivision is denoted by a symbol consisting of Arabic numerals and letters of the Latin alphabet.

The appropriate IPC symbols are indicated on patent documents (published patent applications and granted patents), of which over 2 million are issued each year. The appropriate symbols are allotted by the national or regional industrial property office that publishes the patent document. For PCT applications, IPC symbols are allotted by the International Searching Authority.

Classification is indispensable for the retrieval of patent documents in the search for "prior art". Such retrieval is needed by patent-issuing authorities, potential inventors, research and development units and others concerned with the application or development of technology.

Although only 62 States are party to the Agreement, the IPC is used by the patent offices of more than 100 States, four regional offices and the Secretariat of WIPO in administering the Patent Cooperation Treaty (PCT) (1970).

In order to keep the IPC up to date, it is continuously revised and a new edition is published each year on January 1.

The revision of the IPC is carried out by the IPC Committee of Experts set up under the Agreement. All States party to the Agreement are members of the Committee of Experts.

Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure

Adopted in 1977, the Budapest Treaty concerns a specific topic in the international patent process: microorganisms.

All states party to the Treaty are obliged to recognize microorganisms deposited as a part of the patent procedure, irrespective of where the depository authority is located.

In practice this means that the requirement to submit microorganisms to each and every national authority in which patent protection is sought no longer exists.

The main feature of the Treaty is that a contracting State which allows or requires the deposit of microorganisms for the purposes of patent procedure must recognize, for such purposes, the deposit of a microorganism with any "international depositary authority", irrespective of whether such authority is on or outside the territory of the said State.

What the Treaty calls an "international depositary authority" is a scientific institution - typically a "culture collection" - which is capable of storing microorganisms. Such an institution acquires the status of "international depositary authority" through the furnishing by the contracting State in the territory of which it is located of assurances to the Director General of WIPO to the effect that the said institution complies and will continue to comply with certain requirements of the Treaty.

On October 1, 2018 there were 47 such authorities: seven in the United Kingdom, four in the Republic of Korea, three in China, Italy and the United States of America, two each in Australia, India, Japan, Poland, the Russian Federation and in Spain, and one each in Belgium, Bulgaria, Canada, Chile, the Czech Republic, Finland, France, Germany, Hungary, Latvia, Mexico, Morocco, the Netherlands, Slovakia and Switzerland.

India and Budapest Treaty

In India, there is one International Depository Authority at Chandigarh which is known as Institute of Microbial Technology (IMTECH) and other is at Microbial Culture Collection (MCC), Pune.

The Controller General of Patents, Designs and Trademarks has issued a notification regarding the aforesaid, on July 2nd, 2014 which states as follows:

- *"According to the provisions of the Act, the deposition of such material in an International Depository Authority (IDA) under the Budapest Treaty shall not be later than the date of filing of patent application in India. However, the reference of deposition of biological material in the patent application shall be made within three months from the date of filing of such application as per Rule 13(8) of the Patents Rules, 2003.*

According to Section 10(4)(d)(ii), "*if the applicant mentions a biological material in the specification which may not be described in such a way as to satisfy clauses (a) and (b), and if such material is not available to the public, the application shall be completed by depositing the material to an international depository authority under the Budapest Treaty and by fulfilling the following conditions, namely:-*

- the deposit of the material shall be made not later than the date of filing the patent application in India and a reference thereof shall be made in the specification within the prescribed period;]
- all the available characteristics of the material required for it to be correctly identified or indicated are included in the specification including the name, address of the depository institution and the date and number of the deposit of the material at the institution;
- access to the material is available in the depository institution only after the date of the application of patent in India or if a priority is claimed after the date of the priority;
- disclose the source and geographical origin of the biological material in the specification, when used in an invention."

Section 3(j) of Patent Act 1970, prescribes: 3. What are not inventions.- The following are not invention within the meaning of this Act,- (j) "*Plants and animals in whole or any part thereof other than micro-organisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals are not inventions.*"

Earlier to the 2002 amendment of the Patents Act, 1970, [*with effect from 20-May-2003*] the inventions on microorganisms were not patentable. TRIPS under the Article 27.3(b) stipulated that '*parties may exclude from patentability plants and animals other than microorganisms and essentially biological processes for the production of plants or animals other than non-biological and microbiological processes' [emphasis laid]*. Thus, India to be a TRIPS compliant member country had to amend the provision to allow patentability over microorganisms.

Agreement on Trade-Related Aspects of Intellectual Property Rights [WTO TRIPS Agreement]

The TRIPS Agreement, which came into effect on 1 January 1995, is to date the most comprehensive multilateral agreement on intellectual property.

sets out the minimum standards of protection to be provided by each Member – on the subject-matter to be protected, the rights to be conferred and permissible exceptions to those rights, and the minimum duration of protection.

the substantive obligations of the main conventions of the WIPO, the Paris Convention and the Berne Convention in their most recent versions, must be complied with..

the TRIPS Agreement adds a substantial number of additional obligations on matters where the pre-existing conventions are silent or were seen as being inadequate. The TRIPS Agreement is thus sometimes referred to as a Berne and Paris-plus agreement.

The second main set of provisions deals with domestic procedures and remedies for the enforcement of intellectual property rights. The Agreement lays down certain general principles applicable to all IPR enforcement procedures.

In addition, it contains provisions on civil and administrative procedures and remedies, provisional measures, special requirements related to border measures and criminal procedures, which specify, in a certain amount of detail, the procedures and remedies that must be available so that right holders can effectively enforce their rights.

The Agreement makes disputes between WTO Members about the respect of the TRIPS obligations subject to the WTO's dispute settlement procedures.

In addition the Agreement provides for certain basic principles, such as national and most-favoured-nation treatment, and some general rules to ensure that procedural difficulties in acquiring or maintaining IPRs do not nullify the substantive benefits that should flow from the Agreement.

The obligations under the Agreement will apply equally to all Member countries, but developing countries will have a longer period to phase them in.

Special transition arrangements operate in the situation where a developing country does not presently provide product patent protection in the area of pharmaceuticals.

The TRIPS Agreement is a minimum standards agreement, which allows Members to provide more extensive protection of intellectual property if they so wish. Members are left free to determine the appropriate method of implementing the provisions of the Agreement within their own legal system and practice

The general goals of the TRIPS Agreement are contained in the Preamble of the Agreement, which reproduces the basic Uruguay Round negotiating objectives established in the TRIPS area by the 1986 Punta del Este Declaration and the 1988/89 Mid-Term Review.

These objectives include the reduction of distortions and impediments to international trade, promotion of effective and adequate protection of intellectual property rights, and ensuring that measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade.

These objectives should be read in conjunction with Article 7, entitled “Objectives”, according to which the protection and enforcement of intellectual property rights should contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations.

Article 8, entitled “Principles”, recognizes the rights of Members to adopt measures for public health and other public interest reasons and to prevent the abuse of intellectual property rights, provided that such measures are consistent with the provisions of the TRIPS Agreement.

The TRIPS Agreement requires Member countries to make patents available for any inventions, whether products or processes, in all fields of technology without discrimination, subject to the normal tests of novelty, inventiveness and industrial applicability.

It is also required that patents be available and patent rights enjoyable without discrimination as to the place of invention and whether products are imported or locally produced (Article 27.1).

There are three permissible exceptions to the basic rule on patentability.

- One is for inventions contrary to ordre public or morality; this explicitly includes inventions dangerous to human, animal or plant life or health or seriously prejudicial to the environment. The use of this exception is subject to the condition that the commercial exploitation of the invention must also be prevented and this prevention must be necessary for the protection of ordre public or morality (Article 27.2).
- The second exception is that Members may exclude from patentability diagnostic, therapeutic and surgical methods for the treatment of humans or animals (Article 27.3(a)).
- The third is that Members may exclude plants and animals other than micro-organisms and essentially biological processes for the production of plants or animals other than non-biological and microbiological processes. However, any country excluding plant varieties from patent protection must provide an effective sui generis system of protection. Moreover, the whole provision is subject to review four years after entry into force of the Agreement (Article 27.3(b)).

The exclusive rights that must be conferred by a product patent are the ones of making, using, offering for sale, selling, and importing for these purposes.

Process patent protection must give rights not only over use of the process but also over products obtained directly by the process.

Patent owners shall also have the right to assign, or transfer by succession, the patent and to conclude licensing contracts (Article 28).

Members may provide limited exceptions to the exclusive rights conferred by a patent, provided that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties (Article 30).

The term of protection available shall not end before the expiration of a period of 20 years counted from the filing date (Article 33).

Members shall require that an applicant for a patent shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art and may require the applicant to indicate the best mode for carrying out the invention known to the inventor at the filing date or, where priority is claimed, at the priority date of the application (Article 29.1).

If the subject-matter of a patent is a process for obtaining a product, the judicial authorities shall have the authority to order the defendant to prove that the process to obtain an identical product is different from the patented process, where certain conditions indicating a likelihood that the protected process was used are met (Article 34).

Compulsory licensing and government use without the authorization of the right holder are allowed, but are made subject to conditions aimed at protecting the legitimate interests of the right holder.

The conditions are mainly contained in Article 31. These include the obligation, as a general rule, to grant such licences only if an unsuccessful attempt has been made to acquire a voluntary licence on reasonable terms and conditions within a reasonable period of time; the requirement to pay adequate remuneration in the circumstances of each case, taking into account the economic value of the licence; and a requirement that decisions be subject to judicial or other independent review by a distinct higher authority.

Certain of these conditions are relaxed where compulsory licences are employed to remedy practices that have been established as anticompetitive by a legal process.

These conditions should be read together with the related provisions of Article 27.1, which require that patent rights shall be enjoyable without discrimination as to the field of technology, and whether products are imported or locally produced.

TRIPS and public health

The WTO Doha Declaration on the TRIPS Agreement and Public Health, agreed by WTO members in 2001, helped to frame the health policy context of the intellectual property system.

It stressed the need for the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) to be part of the wider national and international action to address public health problems afflicting developing countries and least-developed countries.

The Declaration identified specific options open for governments to address public health needs, also termed 'flexibilities', and the importance of such flexibilities was highlighted more recently by their inclusion in the Sustainable Development Goals.

The flexibilities identified in the Doha Declaration include "the right to grant compulsory licences". - The Doha Declaration recognized that this restriction on compulsory licensing could hamper its effective use by countries with insufficient or no manufacturing capacities in the pharmaceutical sector. The amendment of the TRIPS Agreement aims at removing this difficulty by creating an additional form of compulsory licence that had not existed before: a compulsory licence especially tailored for the export of medicines to countries in need – in effect, a 'trade related' compulsory licence. This mechanism was sometimes termed the 'paragraph 6 system', from its origins in the Doha Declaration.

The new Article 31bis of the TRIPS Agreement gives full legal effect to this system and allows low cost generic medicines to be produced and exported under a compulsory licence exclusively for the purpose of serving the needs of countries that cannot manufacture those products themselves. For the minority of WTO members yet to accept the amendment, an interim waiver will continue to apply.

DOHA DECLARATION – IMPORTANT PARAS

4. We agree that the TRIPS Agreement does not and should not prevent members from taking measures to protect public health. Accordingly, while reiterating our commitment to the TRIPS Agreement, we affirm that the Agreement can and should be interpreted and implemented in a manner supportive of WTO members' right to protect public health and, in particular, to promote access to medicines for all.

In this connection, we reaffirm the right of WTO members to use, to the full, the provisions in the TRIPS Agreement, which provide flexibility for this purpose.

5. Accordingly and in the light of paragraph 4 above, while maintaining our commitments in the TRIPS Agreement, we recognize that these flexibilities include:

a. In applying the customary rules of interpretation of public international law, each provision of the TRIPS Agreement shall be read in the light of the object and purpose of the Agreement as expressed, in particular, in its objectives and principles.
b. Each member has the right to grant compulsory licences and the freedom to determine the grounds upon which such licences are granted.
c. Each member has the right to determine what constitutes a national emergency or other circumstances of extreme urgency, it being understood that public health crises, including those relating to HIV/AIDS, tuberculosis, malaria and other epidemics, can represent a national emergency or other circumstances of extreme urgency.
d. The effect of the provisions in the TRIPS Agreement that are relevant to the exhaustion of intellectual property rights is to leave each member free to establish its own regime for such exhaustion without challenge, subject to the MFN and national treatment provisions of Articles 3 and 4.

INDIA AND TRIPS

In 1995, India joined the WTO and the TRIPS Agreement.

Pursuant to TRIPS obligation, India amended its Patent Act in 1999 and inserted section 11A to provide that applications claiming pharmaceutical inventions would be accepted and put away in mailbox which would be examined in 2005.

In 2005, in order to comply with the requirements of TRIPS, the Indian government introduced product patents on pharmaceuticals.

Section 92A 'Compulsory licence for export of patented pharmaceutical products in certain exceptional circumstances' has been introduced.

Though most of the provisions in the Indian Patent Act seem to be TRIPS compliant, Section 84(1)(c)[5]creates difficulty. TRIPS clearly stipulate that patents will not be differentiated on the ground that they are imported.[6] Thus on a plain reading of Article 27.1, it CAN BE ARGUED that the ground of compulsory licensing under section 84(1)(c) is SEEEMINGLY in conflict with TRIPS

NOVARTIS AG v UNION OF INDIA - The main argument of the writ petitioner was that section 3(d) of the Indian Patent Act was unconstitutional as it violated not only Article 14 of the Constitution of India but also on the ground that it was not in compliance to "TRIPS" – Madras HC (in n 2007) held that the Court had no jurisdiction to decide the validity of the amended section, being in violation of Article 27 of "TRIPS", it also refused to delve into the question whether any individual was conferred with an enforceable right under "TRIPS" or not.


ANY
QUESTIONS