



FÉDÉRATION INTERNATIONALE DES CONSEILS  
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF  
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION  
VON PATENTANWÄLTEN

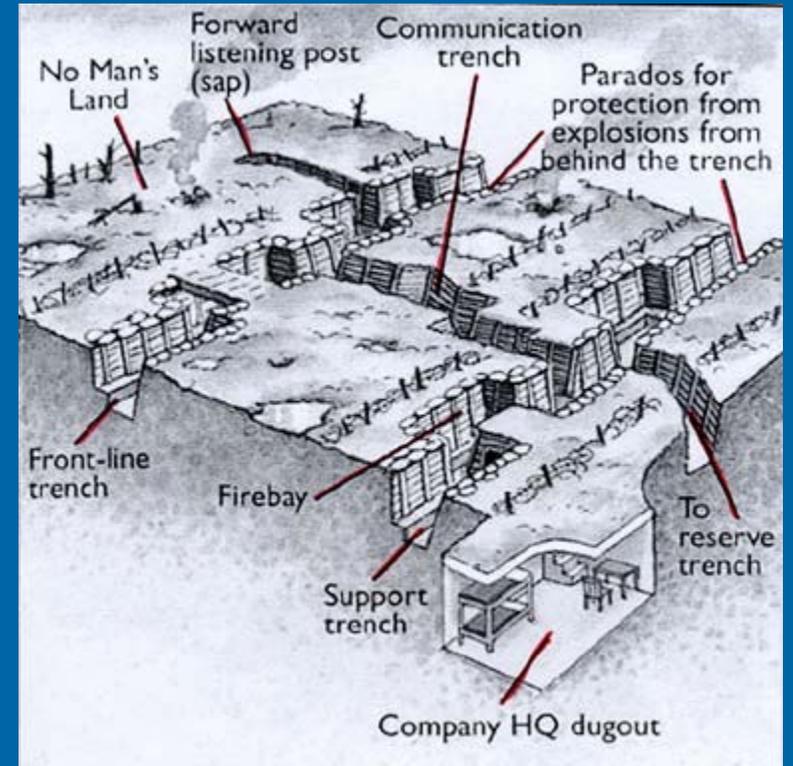
# IP TREATIES AND HARMONISATION



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# IP TREATIES AND HARMONISATION

The IP system is intended to stimulate business – and therefore the economy – in areas where free competition has been found to be inadequate. But do harmonising IP treaties and norm-setting help or hinder this process? Is absolute novelty always desirable for instance? Is a 20-year term appropriate in all fields of technology? How high should the bar be for an inventive step? Will a “unitary patent” boost or stifle European enterprise? This session will explore the advantages and disadvantages of IP treaties and harmonisation from an economic point of view, looking empirically at the way the IP system has evolved flexibly in different countries to meet the needs of business in the face of the long-term rigidities imposed by treaties. The session will explore the pros and cons of IP treaties, and whether it would be possible to conceive of an IP system that is better fitted for its purpose.



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# SPEAKERS

- Jim Pooley
- Matthias Lamping
- Murali Neelakantan
- Markus Hossle



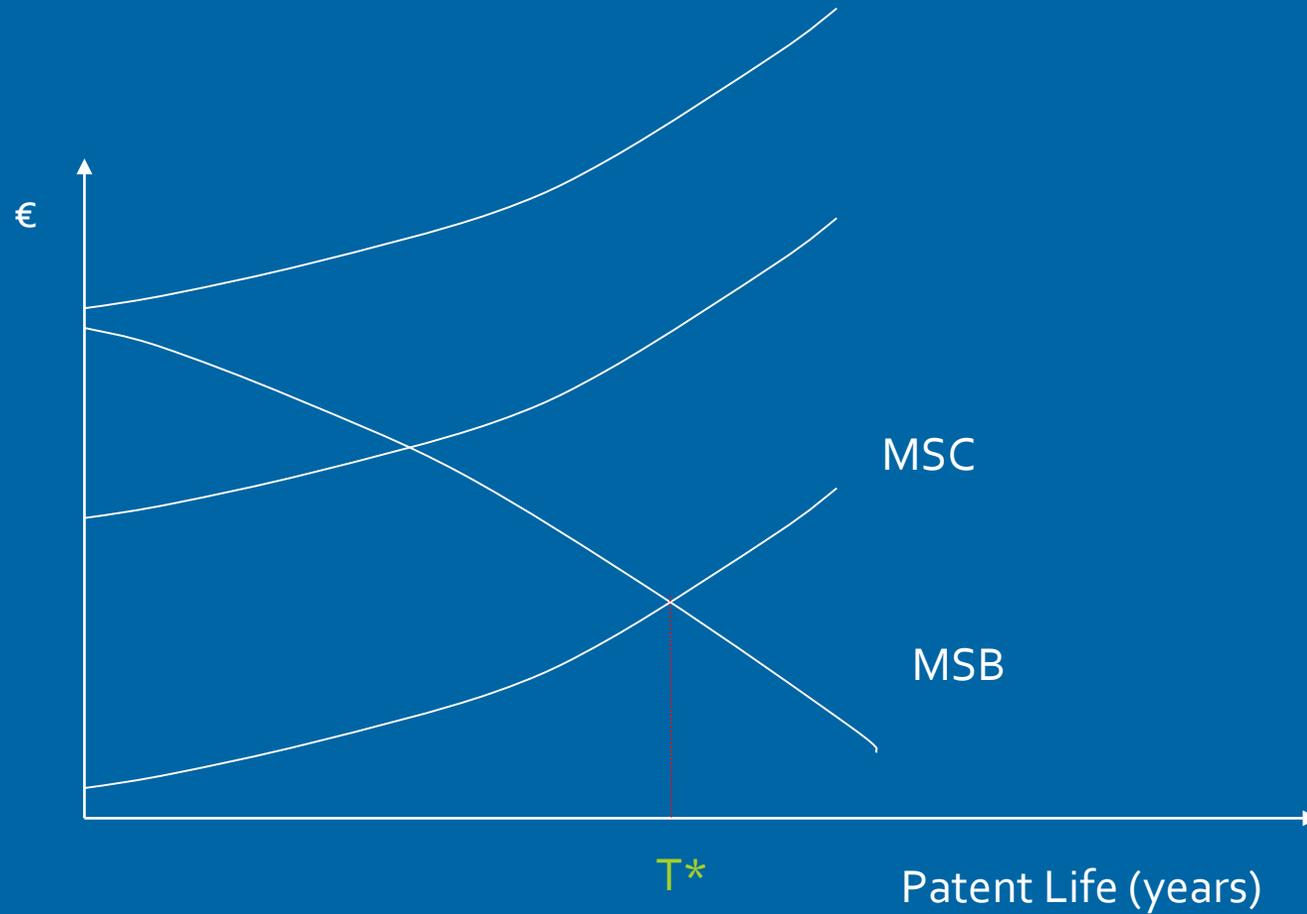


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# COSTS AND BENEFITS OF PATENT LIFE





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## STRATEGIC PLAN (2009)

*"To take a leading role in advancing and stimulating improvements in both the profession at large and the members' professional impact on society."*

# FICPI STATUTES



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## ART. 2.4

2.4 To study all administrative or legislative reforms and all improvements to international treaties and conventions, with the object of facilitating the exercise by inventors and industrialists of their rights, of increasing their security, and of simplifying procedure or formalities.



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## ART. 2.5 AND 2.6

2.5 To intervene in international proceedings for the purpose of pursuing the achievement of the abovementioned reforms and improvements.

2.6 To establish and maintain trusting and cordial relations with official or private international organisations existing in the field of Intellectual Property or called upon to deal with questions of Intellectual Property.

## PART

## 1

## THE TRIPS AGREEMENT IN RETROSPECTIVE

### A National Matter, an International Concern

- **The Uruguay Round**
- **The Aftermath**
  - implementing the Agreement
  - living the Agreement
  - squaring it with public policies
- **Twenty Years Later**
  - Market access (textile, apparel, agriculture)
  - Technology transfer (trade, FDI, licensing)



### Principles for IP Provisions in Bilateral and Regional Agreements

- The use IP provisions as a bargaining chip in trade negotiations;
  - the increasing comprehensiveness and complexity of IP rules in bilateral and regional agreements;
  - the lack of transparency and inclusiveness in the negotiating process;
- imbalanced IP provisions in FTAs.

Available at [http://www.ip.mpg.de/en/pub/news/fta\\_statement.cfm](http://www.ip.mpg.de/en/pub/news/fta_statement.cfm)



### Declaration on Patent Protection: Regulatory Sovereignty under TRIPS

- Patentability, patent eligibility, disclosure
- Scope of protection and limitations thereof (exhaustion, exceptions, compulsory licenses, government use)
- Protection of undisclosed information
- Enforcement
- Transit
- Criminal measures

Available at <http://www.ip.mpg.de/en/pub/news/patentdeclaration.cfm>



### Beyond Trade Rules

- **Dissolving the Marriage of Convenience**
  - global intellectual property ratchet
  - vicious cycle of internalizing externalities
- **Searching for Common Principles**
  - bottom up instead of top down
  - rules need to be based on principles
- **Reconsidering the Role of Dispute Settlement**



### A Matter of Perspective

- **Imitation is an integral element of innovation** (Schumpeter)
  - Switzerland, Canada, United States ...
- **Today's followers may be tomorrow's leaders... and vice versa**
  - India, China ...
- **Policy-making behind the "veil of ignorance"** (Rawls)



**Hössle**<sup>®</sup>

**Patentanwälte**

## IP Treaties and Harmonisation – Economic Friend or Foe / Session 7

Markus Hössle

Patent Attorney

FICPI World Congress 2015

Cape Town, 16 April 2015

# IP Treaties and Harmonisation

## One Size Fits All vs. Individuality

## IP Treaties and Harmonisation False Promises

Applicants are lulled into a false sense of security when preparing and filing their applications based on treaties

- increased costs
- loss of rights

## IP Treaties and Harmonisation False Promises – Examples

Madrid Agreement filing

Applicant wishes  
to protect labels



➔ German base mark = class 16

# IP Treaties and Harmonisation

## False Promises – Examples

### Suchbegriff: labels

NIZIA-KLASSIFIKATION - TREFFER 4	
Klasse	<ul style="list-style-type: none"> <li>■  Deutscher Begriff</li> <li>■  Französische(r) Begriff(e)</li> <li>■  Englische(r) Begriff(e)</li> </ul>
<a href="#">09</a>	<ul style="list-style-type: none"> <li>■ Temperatureiketten, nicht für medizinische Zwecke</li> <li>■ étiquettes indicatrices de température, autres qu'à usage médical</li> <li>■ temperature indicator labels, not for medical purposes</li> </ul>
<a href="#">10</a>	<ul style="list-style-type: none"> <li>■ Temperatureiketten für medizinische Zwecke</li> <li>■ étiquettes indicatrices de température, à usage médical</li> <li>■ temperature indicator labels for medical purposes</li> </ul>
<a href="#">16</a>	<ul style="list-style-type: none"> <li>■ Etiketten, nicht aus Textilstoffen</li> <li>■ étiquettes non en tissu</li> <li>■ labels, not of textile</li> </ul>
<a href="#">24</a>	<ul style="list-style-type: none"> <li>■ Stoffetiketten</li> <li>■ étiquettes en tissu</li> <li>■ labels of cloth</li> </ul>

# IP Treaties and Harmonisation False Promises – Examples

Madrid Agreement filing

Subsequent Extension Request

→ WIPO: Class 16

# IP Treaties and Harmonisation False Promises – Examples

Madrid Agreement filing

Designation US:  
Clarity

# IP Treaties and Harmonisation

## False Promises – Examples

24	016	Label printing machines
25	016	Mailing labels
26	016	Paper labels
27	016	Printed novelty wine labels
28	016	Printed paper labels
29	016	Printed wine and beer bottle labels incorporating a feature that changes color in response to fluctuation in temperature of the contents of the bottle to which the label is affixed
30	016	Shipping labels
31	016	Tape cartridges and tapes for label printing machines
32	016	Wet erase paper labels
33	017	Adhesive-backed plastic films for use in the manufacture of durable labels and nameplates
34	017	Clear plastic adhesive sheets for removal and lamination of labels on bottles
35	017	Plastic sheets for use in the manufacture of labels
36	017	Polyester sheets for use in the manufacture of labels
37	017	Polymer sheets for use in the manufacture of labels
38	018	Luggage label holders
39	018	Plastic luggage labels
40	020	Blank plastic adhesive labels
41	020	Blank, printed, or partially printed plastic labels attached to elastic bands
42	020	Plastic bar code labels
43	020	Plastic labels
44	020	Printed plastic labels for use in identifying and marking the contents of pipes
45	020	Reusable plastic labels with hook and loop backing for temporary attachment
46	020	Reusable wood labels with hook and loop backing for temporary attachment
47	024	Cloth labels

## IP Treaties and Harmonisation False Promises – Examples

Madrid Agreement filing

Designation US:

Clarity → paper labels / plastic labels

→ additional class 20 → loss of protection !

# IP Treaties and Harmonisation False Promises – Examples

Patent Cooperation Treaty

Consideration of national peculiarities !

# IP Treaties and Harmonisation

## False Promises – Examples

5. A door assembly as claimed in claim 1, wherein the carrier is made from a polymeric material and the intrusion member is made from a metallic material.
  
6. A door assembly as claimed in claim 1, wherein the carrier is overmolded on the intrusion member.
  
7. A door assembly as claimed in claim 1, wherein the carrier and the intrusion member together define a carrier/intrusion member cavity.

# IP Treaties and Harmonisation False Promises – Examples

Patent Prosecution Highway

Ever seen two identical search results ?

# IP Treaties and Harmonisation

## Technically Bad Legislation

### EU Directive the Patentability of CII

"The processing, handling, and presentation of information do *not belong to a technical field*, even where technical devices are employed for such purposes."

# IP Treaties and Harmonisation Levelling Down

Germany abandoning its patent grace period for  
the EPC in the 1970's

# IP Treaties and Harmonisation

## Backup: German Utility Model

- By its nature, the utility model is a fast obtainable protective right without examination
  - Maximum duration of 10 years
  - No method claims allowed
  - Registration within 2 to 3 months
  - Enforceable
  - Grace period (6 months)

## German Utility Model „Abzweigung“

- Further, a utility model can be „**branched-off**“ from a patent application pending with effect for Germany (§ 5 Utility Model Act)
  - Any German, European, PCT application
  - At any time (during the maximum duration)
  - Filing date and possible priority claim of patent application are kept
  - German translation required (foreign language filing possible though)

## German Utility Model

- 14,748 applications in 2014  
(vs. 65,958 patent applications)

By the way:

- Increase of 4.4 %
- Increase of foreign originating by 11.3 %
- US: + 8.2 %    JP: + 20.2 %

Thank you for your attention !

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# IP TREATIES AND HARMONISATION – ECONOMIC FRIEND OR FOE