

AIPPI Congress - Cancun

1. Overview

As usual, the Congress covered many cutting-edge IP topics. The programme included the following high notes:

- Six resolutions :
 - Four of these were on the basis of AIPPI’s 2018 Study Questions:
 - Conflicting patent applications ;
 - Registrability of 3D trademarks ;
 - Partial designs ;
 - Joint liability for IP infringement.
 - Two further Resolutions were prepared by Standing Committees of AIPPI:
 - Post filing data (Standing Committee on Pharma & Biotechnology) ;
 - HCCH - Judgments Project (Standing Committee on Enforcement).

The adopted resolution can be downloaded on the following websites:
https://aippi.org/library/?publication_title=&publication_categories%5B%5D=10&start_date_range=2018&end_date_range=2018.

- Thirteen panel sessions, including the following topics: “*Artificial intelligence—the real IP issues*”; “*Standard essential patents*”; “*Personality rights*”; “*Linking into the digital era*”; “*Alternatives for enforcement: criminal and administrative proceedings*”; “*A balancing act—copyright versus other rights*”; “*Use it or lose it—genuine use of trademarks*”; and “*Surveying the field—a gold standard for survey evidence*”;
- Four pharma sessions (“*The endgame: patent term extensions and SPCs*”, “*Access to medicines - what’s fair?*”, “*Big Data and Big Pharma*”, “*Biosimilar litigation - dissimilar considerations?*”); and
- Three lunch sessions: (1) a session on the scope of IP5 cooperation with representatives from the US Patent and Trademark Office, the European Patent Office, the Japan Patent Office, the Korean Intellectual Property Office, and the Chinese National Intellectual Property Administration to provide; (2) a session about Trademarks, morality and “*The Band Who Must Not Be Named*” (with the pop band « The Slants »); and (3) a session on blockchain and cryptocurrencies.

Hereafter, we will shortly discuss the resolutions and provide the list of issues that will be discussed during the Congress in London (September 14-18, 2019).

2. No agreement on the resolution regarding remuneration

Last year's Congress in Cancun began with an unusual development, countries' representatives in a plenary session of the Standing Committee on Patents voted to postpone the resolution on the subject of inventor remuneration.

Some countries have passed inventor remuneration laws, others have not, and it was obvious that no agreement could be reached on this issues at this stage.

It seems that a number of national groups stated that they do not seek harmonisation in this area and that the national groups had not been given sufficient time to discuss.

3. Conflicting patents applications resolution

This resolution aimed to discuss patent applications that conflict with earlier-filed (but later published) patent applications (by the same or a different applicant).

The AIPPI was of the opinion that *"it would be beneficial to harmonize the treatment of conflicting patent applications"* and the representatives agreed on various guidelines.

For examples, the resolution indicates that *"secret prior art should be available against the claims of a later-filed application, after the secret prior art is published, for examining novelty only"* but that *"secret prior art should not be available against the claims of the later-filed application for examining inventive step/obviousness"*.

4. 3D Trademarks resolution

According to the resolution, it should be possible for 3D Shapes to be registered as trademarks on the basis of inherent or acquired distinctiveness.

The AIPPI's position is that 3D Shapes should be refused registration as trademarks, and 3D Trademarks should be declared invalid, 1) if they consist exclusively of shapes that result from the nature of the goods stated in the application or registration or 2) if they consist exclusively of shapes that are necessary to obtain a technical result.

This refusal or finding of invalidity should not be overcome on the basis of acquired distinctiveness.

On the other end, according to the Resolution, 3D Shapes should not be refused registration as trademarks, and 3D Trademarks should not be declared invalid, on the ground that they consist exclusively of shapes that give substantial value to the goods.

If some national law provides that 3D Shapes should be refused registration or that 3D Trademarks should be declared invalid on the ground that they consist exclusively of shapes that give substantial



value to the goods, the Resolution considers that it should be possible to overcome such refusal or finding of invalidity on the basis of acquired distinctiveness.

5. Partial design resolution

Partial designs (a part or parts of a whole product) were excluded from the Milan resolution on Designs ("*Requirements for protection of designs*", AIPPI Congress 2016).

According to the resolution, it should be possible to register partial designs. Such registered designs would protect only the overall visual appearance (including ornamentation) of the claimed part.

The resolution recommends that the claimed part (i.e. the object of the registration) and unclaimed part of partial designs should be explicitly indicated (in other words, easy to identify).

The resolution also indicates the following:

"In determining the nature and use, the Design Corpus, and the relevant observer of the Product to which the Partial Design is directed, consideration should be given to the Claimed Part and the Unclaimed Part. The validity and scope of protection of the Partial Design is assessed through the eyes of that relevant observer of that Product, considering exclusively the Claimed Part".

Finally, it is also noted that, in the assessment of the overall impression created by a prior design (validity) and an accused product (infringement), the part (or parts) of the prior design or accused product that do not correspond to the claimed part "*need not be excluded*".

6. Joint liability resolution

During the Congress, the AIPPI decided to discuss the issue of Joint liability (i.e. when infringement is found by combining the actions of more than one party).

A few related issues were discussed and a resolution was adopted. In particular, we have to mention that the resolution proposes the following general rule:

"A party who assists in or otherwise facilitates an IPR infringement taking place in a particular jurisdiction, should be held liable for Joint Infringement arising in that jurisdiction in case where:

- *the party has actively participated in or in a substantial manner facilitated the IPR infringement and*
- *the party knows of, or should have known of, said IPR infringement; including when the said party did not take reasonable steps to avoid participating in or in a substantial manner facilitating the IPR infringement after being notified of the infringing activity".*



7. Pharma and biotech resolution

The resolution passed in only 30 minutes, with no amendments, and with 99% support.

The resolution recommends a harmonised practice to allow “*consideration of post-filing data in the assessment of inventive step, particularly if such data elaborates on effects already apparent from the application or patent*”.

8. Judgments resolution

The Standing Committee on Enforcement was successful in passing a resolution on judgements. The Hague Conference on Private International Law is indeed working to develop a “*convention on the recognition and enforcement of foreign judgments*” and AIPPI was invited to give an opinion regarding the inclusion of IPRs as well as related issues.

The draft Resolution under discussion had three parts. The first part stated that “*Intellectual property should be excluded from the scope of the Convention*”. The second part recommended modifying Article 2(m) of the Draft Convention as well as removing the wording “analogous matter” from the section. The third part of the resolution discussed issues arising if IP was included within the scope of the Convention.

Since then, a new Hague Convention was signed on July 2, 2019. In line with AIPPI’s position, IP was excluded from the scope of the convention (see <https://aippi.org/no-show/aippi-at-the-hcch-diplomatic-conference/>).

9. London Congress

Finally, the AIPPI Committees presented the questions for the Congress that will take place in London next month:

- Patents: Plausibility ;
- Trademarks: Consumer survey evidence ;
- Copyright: Copyright in artificially generated works ;
- General: IP damages for acts other than sales.