

International agreements on IP

There are two main types of multilateral agreements concerning IP: (a) general conventions offering minimum standards and rules for protecting IP rights and (b) conventions on specific subject matter that include substantive provisions (rules that determine the rights and obligations of the parties) and/or procedural rules (which govern the process for obtaining and enforcing those rights and duties) for particular types of IP rights (e.g. patents, trademarks, utility models, etc.). These include the TRIPS, the Paris Convention and the Patent Cooperation Treaty, among others.

Which are the main international IP agreements and their main characteristics?

Table 1 gives an overview of some of the main international IP agreements.

| Type | Agreement | Description |
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| No subject-matter specific international IP agreements | Paris Convention 1883 | - Administered by WIPO - Industrial property - 175 Contracting Parties as of July 2013 |
| | TRIPS Agreement 1994 | - Administered by WTO - Intellectual property (utility excluded) - 159 Member Countries as of March 2013 |
| International IP agreements on specific subject-matter | Patent Cooperation Treaty 1970 | - Administered by WIPO - Single international patent application - 148 Contracting Parties as of July 2013 |
| | Patent Law Treaty 2000 | - Administered by WIPO - Harmonisation of formal procedures of national and regional patent offices - 34 Contracting Parties as of July 2013 |
| | Madrid system 1891 | - Administered by WIPO - Functions under the Madrid Agreement of 1891 and the Madrid Protocol of 1989 - As of July 2013, the Madrid Protocol has 66 members, 56 of which are also members of the Madrid Agreement |
| | Trademark Law Treaty 1994 | - Administered by WIPO - Simplify and harmonise the administrative procedures of national and regional application for the protection of marks - 53 Contracting Parties as of July 2013 |
| | Berne Convention 1886 | - Administered by WIPO - Provisions on the protection of the rights of authors in their literary and artistic works - 166 Contracting Parties as of July 2013 |

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|---|---|---|
| | Hague Agreement 1925 | <ul style="list-style-type: none"> - Administered by WIPO - Single registration procedure for the protection of industrial designs - 60 Contracting Parties as of July 2013 |
| Regional IP agreements on specific subject-matter | European Patent Convention 1973 | <ul style="list-style-type: none"> - Administered by the European Patent Office (EPO) - Provides an autonomous legal system for the granting of European patents via a single, harmonised procedure before the EPO - 38 Contracting States as of July 2013 |
| | Community Designs Regulation 2001 | <ul style="list-style-type: none"> - Administered by OHIM - Provisions for the granting of Registered Community Designs (RCD), which is registered with OHIM - 28 Member States of the European Union |
| | Community Trademark Regulation 2009 | <ul style="list-style-type: none"> - Administered by the Office for Harmonization in the Internal Market (OHIM) - Provisions for the granting of the Community Trademark (CTM), which is registered with OHIM - 28 Member States of the European Union |

Paris Convention 1883

The first international treaty on the protection of industrial property is the Paris Convention for the Protection of Industrial Property, which was adopted on March 20, 1883. Initially signed by 8 countries, the Paris Convention has been revised and amended several times. It entered into force in 1884 with 14 member States and it has a total of 175 Contracting Parties as of July 2013. It is administered by the World Intellectual Property Organization (WIPO) and applies to all types of industrial property, including patents, trademarks, industrial designs, geographical indications, trade secrets and utility models. It also includes provisions against unfair competitive practices.

The provisions of the Paris Convention can be grouped into four main sections:

- There is a first set of rules that guarantees the “right to national treatment” in each of the member countries. The rights of national treatment means that all nationals of member states enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals.
- A second category of rules establishes the “right of priority” for applications concerning patents, trademarks, industrial designs and utility models. For these types of industrial property rights, any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union, or under bilateral or multilateral treaties concluded between countries of the Union, shall be recognized as giving rise to the right of priority. This means that a subsequent

application (filed within 6 or 12 months after the first application) concerning the same subject as a previous first application will have effects as if they had been filed on the same date as the first application, the filing date of which is the starting point of the period of priority.

- A third set of provisions contains substantive rules concerning each type of industrial property that is covered by the Convention. In this regard, the Convention includes rules requiring or allowing member countries to protect certain types of industrial property, and rules establishing rights and obligations of rights' owners.
- Finally, there are some provisions dealing with the administration and implementation of the Convention and certain final clauses.

Agreement on Trade-Related Aspects of Intellectual Property Rights 1994

The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) is to date the most comprehensive multilateral agreement on intellectual property. This agreement is administered by the World Trade Organization (WTO) and sets out minimum standards for most forms of intellectual property regulation within all member countries of the WTO. It was negotiated at the end of the Uruguay Round of the General Agreement on Tariffs and Trade (GATT) in 1994. The Agreement was signed on April 15, 1994 and entered into force on January 1, 1995 for all WTO member countries (159 countries as of 2 March 2013), except the least developed ones. It incorporates and builds upon the latest versions of the primary international intellectual property agreements administered by WIPO, the Paris Convention and the Berne Convention. It applies basic international trade principles to member states regarding intellectual property, including national treatment and most favoured nation treatment.

Since it is a minimum standards agreement, members can provide more extensive protection of intellectual property if they wish. The areas of intellectual property that it covers include: a) patents, b) copyright, c) trademarks, including service marks, d) geographical indications (GI), and e) industrial designs. The TRIPS agreement does not cover utility models, which are therefore fully open to national IP legislation. The agreement also allows for limited exceptions to IP rights, such as fair use, compulsory licensing and government use without authorization of the right holder, but requires certain obligations to be fulfilled.

Patent Cooperation Treaty 1970

The Patent Cooperation Treaty (PCT) was signed on June 19, 1970 by 35 countries and entered into force on January 24, 1978 with 18 Contracting States. It is managed by the WIPO and has 148 Contracting States as of July 2013. The PCT does not grant patents. Instead, PCT procedures provide the possibility of seeking patent rights in a large number of countries through the filing of a single international application (PCT application) with a single patent office (receiving office), and then entering the national stage in desired countries at a later date. All applications (international or regional) will ultimately acquire a national status (they need to be validated/granted in the national patent offices where patent protection is desired) (OECD, 2009).

The PCT application starts with the filing of an international application, either at the national (or regional) patent office or with WIPO. This has to be done in the 12-month period following the priority

filing, but it can be done immediately as a priority filing. The applicant must be a national or resident of one of the PCT signatory states (OECD, 2009).

Patent Law Treaty 2000

The Patent Law Treaty (PLT) was adopted on June 1, 2000 and entered into force on 28 April 2005. The PLT was open for signature until June 1, 2001. It was signed by 53 States and one intergovernmental organization. As July 2013, the PLT (administered by WIPO) has 34 Contracting Parties. The purpose of the PLT is to harmonise and streamline formal procedures with respect to national and regional patent applications and patents. The PLT provides maximum sets of requirements that the Office of a Contracting Party may use for a patent application. Thus, IP offices may not seek additional formal requirements with respect to matters that the PLT deals with (WIPO, IP Handbook, 2004).

Madrid system 1891

The Madrid system for the international registration of marks (the Madrid system) was established in 1891 and functions under the Madrid Agreement of 1891 and the Madrid Protocol of 1989. It is administered by the International Bureau of WIPO. The original Agreement had 56 members, 55 of which (with the exception of Algeria) were also party to the Protocol. As of July 2013, the Madrid Protocol has 91 members, 56 of which are also members of the Madrid Agreement.

Similar to the Patent Cooperation Treaty, the Madrid system offers trademark owners the possibility of obtaining trademark protection in several countries by filing one application (single registration procedure) directly with their national or regional trademark office. An international mark that is successfully registered under this system is equivalent to an application or a registration of the same mark filed directly in each of the countries designated by the applicant. The Madrid system also simplifies the subsequent management of the trademark, by making it possible to record subsequent changes or to renew the registration through a single procedure (WIPO, Madrid System for the International Registration of Marks).

Trademark Law Treaty 1994

The Trademark Law Treaty (TLT) was adopted on October 27, 1994, signed by 51 Parties and entered into force on August 1, 1996. As of July 2013, the TLT has a total of 53 Contracting Parties. Its principal objective is to simplify and harmonise the administrative procedures of national and regional applications, and the protection of marks. The TLT does not deal with substantive trademark law covering the registration of marks. Individual countries and intergovernmental organizations, which have regional offices for the registration of trademarks (e.g. Office for Harmonization in the Internal Market [OHIM] in the EU), may become party to the Treaty. The provisions of the Treaty are supplemented by the Regulations and Model International Forms (WIPO, IP Handbook, 2004).

Berne Convention 1886

The Berne Convention for the Protection of Literary and Artistic Works is the oldest international treaty in the field of copyright. It was adopted on September 9, 1886 and entered into force on November 19, 1886. It has been revised several times in order to improve the international system of protection provided by the Convention and also to cope with the challenges of accelerating development of technologies in the field of utilization of authors' works (WIPO, IP Handbook, 2004). Originally signed by 8 countries, the Berne Convention (administered by WIPO) has 166 Contracting Parties as of July 2013.

The aim of the Berne Convention is "to protect, in as effective and uniform a manner as possible, the

rights of authors in their literary and artistic works.” The signatory countries of the Convention constitute a Union for the protection of the rights of authors in their literary and artistic works, which relies on three main principles: national treatment, automatic protection and independence of protection.

WIPO Copyright Treaty and WIPO Performances and Phonograms Treaty 1996

After the adoption of the TRIPS Agreement in 1994, the WIPO committees intensified the preparatory work of new rules on copyright and related rights in order to deal with problems not addressed by the TRIPS Agreement. As a result, in 1996 the WIPO Diplomatic Conference on Certain Copyright and Related Rights Questions adopted two treaties, the WIPO Copyright Treaty (WCT) and the WIPO Performances and Phonograms Treaty (WPPT) on 20 December 1996.

Hague Agreement 1925

The Hague Agreement Concerning the International Deposit of Industrial Designs was adopted on November 6, 1925 within the framework of the Paris Convention. Initially signed by six countries, the Hague Agreement entered into force in June 1928, and has been revised and supplemented several times at London in 1934 and at The Hague in 1960. An Additional Act signed at Monaco in 1961 and a Complementary Act signed at Stockholm in 1967, which was amended in 1979, completed it. A further Act was adopted at Geneva in 1999. As of July 2013, the Hague Agreement has 60 Contracting Parties and it is constituted by three international treaties:

- the Geneva Act of July 2, 1999 (the “1999 Act”)
- the Hague Act of November 28, 1960 (the “1960 Act”)
- and the London Act of June 2, 1934 (the “1934 Act”).

The Hague agreement provides a mechanism for registering a design in countries and/or intergovernmental organizations. It offers proprietors of industrial designs a means of obtaining protection in several countries through a single registration procedure, consisting of a single application with the International Bureau of WIPO, in one language (English, French or Spanish), and with one set of fees in one currency (Swiss Francs) (WIPO, 2012).

A design that has been registered through the procedure established by the Hague Agreement, and that has not been refused by the national offices of the designated countries, will receive the same protection in each of those countries as if the design had been registered directly with each national office (WIPO, 2012). The Hague System also simplifies the subsequent management of an industrial design registration, since it is possible to record subsequent changes or to renew the registration through a single procedural step with the International Bureau of WIPO.

European Patent Convention 1973

The Convention on the Grant of European Patents, widely known as the European Patent Convention (EPC), was signed on 5 October 1973 and entered into force on October 7, 1977. It provides an autonomous legal system for the granting of European patents via a single, harmonised procedure

before the European Patent Office (EPO) (EPO, Legal texts).

The new European unitary patent or “European patent with unitary effect” is also granted by the EPO under the rules and procedures of the EPC. Patent applicants will be able to obtain, upon request to the EPO, unitary effect for their patents for the territory of the 25 Member States participating in the unitary patent scheme (EPO, Unitary Patent). The unitary patent will co-exist with national patents and with classical European patents, thus establishing a third layer of available patent protection in Europe.

Community Designs Regulation 2001

The Community Designs Regulation (CDR) provides a single legal system for the granting of Community designs, providing strong and uniform protection throughout the EU. Unregistered Community design protection has existed since 6 March 2002 and registered Community design (RCD) protection has existed since 1 April 2003.

The RCD system consists of a simple registration procedure with a single application, language of filing, administrative centre, file to be managed and payment. During the examination, the applications are checked mainly for formalities (e.g. no search for novelty).

An RCD is valid in the EU as a whole. It is not possible to limit the geographic scope of protection to certain Member States. An RCD initially has a life of 5 years from the date of filing and can be renewed in periods of 5 years up to a maximum of 25 years. The RCD confers on its holder the exclusive right to prevent any third party from using the RCD without the consent of the holder. After any future enlargement of the EU, any RCD registered or applied for will automatically be extended to the new enlarged territory without any need to make an application or pay fees (OHIM, What is a Community Design?).

Community Trademark Regulation 2009

The Community Trademark Regulation (CTMR) contains the provisions for the granting of the Community Trademark (CTM), which is registered with OHIM. Once granted, Community Trademarks are valid across the territory of the European Union as a whole (and after any future enlargement of the European Union, any CTM registered or applied for will be automatically extended to the new member states without formality or fee). It is not possible to limit the geographic scope of protection to certain Member States. The CTM system is a single registration procedure, consisting of a single application, language of procedure, administrative centre and file to be managed.

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[1] <http://www.epo.org/law-practice/legal-texts.html>

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[3] <http://ssrn.com/abstract=2160229>

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