

INTERNATIONAL INTELLECTUAL  
PROPERTY – SELECTED TOPICS

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AUTUMN 2014

LOYOLA LAW SCHOOL

Prof. Hughes

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## Take Home Examination

### Introduction

This is a twenty-four (24) hour, take home examination. You have 24 hours from the time you access this examination to submit the answers. You are to access this particular examination and provide your answer by whatever means is designated by the Registrar's Office.

### *Conditions and your professional commitments*

Once you have received this exercise, you may not discuss it with anyone prior to the end of the examination period. Nor may you discuss the exercise at ANY time with any student in the class who has not taken it. You may NOT collaborate on this work.

Professor Hughes permits you to use any and all inanimate resources. The only limitations on outside resources are those established by the law school for take home examinations.

By turning in your answers you certify that you did not gain advance knowledge of the contents of the examination, that the answers are entirely your own work, and that you have complied with all relevant Loyola Law School rules.

The examination consists of two parts. Part I is a set of true/false questions. Part II has three short essay questions, of which you should select two. Each essay should be no more than 1,000 words.

GOOD LUCK

*Happy holidays to all – thanks for an enjoyable semester.*

## PART I. TRUE/FALSE QUESTIONS

(30 points)

This part of the exam is worth 30 points. Each answer is worth 2 points. Note that there are 17 questions, so in the same spirit as the LSAT and other standardized tests, you can get 2 wrong and still get a maximum score on this section.

Please provide your answers to this section as a single column series, numbered 1 to 17, with “T” or “F” beside each number, i.e.,

- 6. True
- 7. False
- 8. False

Make sure these T/F answers are on a separate page from the essay answers.

If you are concerned about a question, you may write a note before your essay answers concerning that question [mark the section “True/False Comments”], but only do so if you believe that there is a fundamental ambiguity in the question.

TRUE OR FALSE

- 01. If Ethiopia belongs to the WTO, but not to the Paris Convention, TRIPS Article A requires Ethiopia to provide to an inventor of any WTO Member the “the right to be mentioned” in a patent covering that person’s invention (Paris Convention Article 4ter)
- 02. In *Harvard College v. Canada (Commissioner of Patents)* (2002), the Canadian Supreme Court followed the U.S. *Chakrabarty* decision in its interpretation of “manufacture” and “composition of matter,” phrases that are found in both countries’ patent laws.
- 03. If Malaysia is a WTO Member, then if trial courts in Malaysia do not issue written opinions in civil cases, including intellectual property enforcement cases, Malaysia will be in clear violation of its TRIPS Article 41(3).

04. The reciprocity requirement in the EU Database Directive (1996) for the *sui generis* right means that Singaporean and Indian database makers do not enjoy “national treatment” in the EU in relation to the *sui generis* right.
05. If primary means of interpretation leave the meaning of a treaty provision ambiguous or obscure, Article 32 of the Vienna Convention allows an international tribunal to use the “travaux préparatoires,” the preparatory drafts, reports, and documents from the treaty’s negotiation.
06. Under Article 4 of the Dispute Settlement Understanding (DSU), if Australia requests consultations with Mexico over a TRIPS concern, Mexico responds within one week, but 25 days pass without the consultations beginning, Australia may immediately request the establishment of a Panel.
07. If Uzbekistan belongs to the Berne Convention but not the WTO, the Solomon Islands belong to the WTO but not the Berne Convention, and South Africa belongs to both WTO and Berne, then South African copyright law must give both Uzbeki and Solomon Islander authors an “exclusive right of authorizing adaptations, arrangements and other alterations of their works” as provided in Berne Article 12.
08. If a country qualifies as “Least Developed” under TRIPS Article 65, it currently has no obligations under the TRIPS Agreement except under the “most favored nation” provisions of Article 4.
09. Article 5 of the Marrakesh Treaty to Facilitate Access to Published Works for Persons who are Blind (2013) would forbid “Bookshare,” an American non-profit serving the blind, from providing special format copies directly to blind people in Nigeria; Bookshare would be required to work with a Nigerian non-profit or NGO serving blind people there.

10. Article 37 of the Berne Convention provides that, in the case of interpretative ambiguities or inconsistencies, the English language text of the Convention controls.
11. If SOVIET CHAMPAGNE [*Sovetskoye Shampanskoye* or Советское Шампанское in Cyrillic] was a product name dating to the 1980s in the USSR/Russia and it has been a bona fide trademark in Russia for at least a decade before Russia joined the WTO (August 2012), then Russia has no duty under TRIPS to stop the use of the trademark even though CHAMPAGNE is a protected geographical indication in the European Union.
12. According to the Vienna Convention, the “Agreed Statements” in the Marrakesh Treaty to Facilitate Access to Published Works for Persons who are Blind (2013) are relevant to the interpretation of the treaty’s provisions because those agreed statements are “subsequent practice in the application of the treaty which establishes the agreement of the parties regarding its interpretation” pursuant to Article 32.
13. In *European Communities – Protection of Trademark and Geographical Indications for Agricultural Products and Foodstuffs* (DS174), the Panel concluded that the EU Origins Regulation violated the national treatment requirements of the TRIPS Agreement.
14. Even if COLOMBIAN COFFEE is a protected geographical indication in the EU and is a registered certification mark in the US, the United States can permit non-confusing uses of phrases like “Colombian-style Coffee” without violation of TRIPS Article 23(1).
15. Professors Hugenholtz and Okediji believe that interpretation of copyright’s “three step test” by dispute settlement panels at the WTO is desirable because such decisions include consideration of human rights and civil society issues.
16. Most panels convened under the Dispute Settlement Understanding consist of three members, but DSU Article

- 8(5) permits five panelists to serve on a panel if the disputing Members so agree with a fixed time frame.
17. Under the interpretation given by the European Patent Office Board of Appeals in *Harvard v. British Union for the Abolition of Vivisection* (2004), if a seemingly benign invention had been invented in a process that involved torturing primates, this would be a *per se* violation of the morality and *ordre public* standards of Article 53 of the European Patent Convention (revised 2000).

## PART II – ESSAY QUESTIONS

(70 points)

This part of the Examination requires two short essays, each in the form of a memorandum. Each essay should be in the range of 750-1000 words with 1,000 words being the upper limit.

Please include a word count (such as “This essay is 687 words”) at the end of EACH essay. Professor Hughes takes on no obligation to read any one essay beyond the 1,000 word limit.

\* \* \*

Mona Jaconde was recently appointed as the new Canadian Deputy Minister of Industry – her portfolio includes intellectual property matters. You are a staff attorney in the Deputy Ministry’s office. As a way of introducing her to the customs and practices of the WTO, Minister Jaconde will be officially leading the Canadian delegation at the next meeting of the TRIPS Council. As part of the TRIPS Council meeting, Jaconde will be expected to have side meetings with a number of countries to discuss intellectual property issues that have arisen. Other members of the staff are preparing the briefing papers for Jaconde’s likely meetings with the American, EU, Chinese, and Brazilian delegations.

Meetings with several other delegations are also planned, principally based on specific issues brought to the Ministry’s

attention – usually by private industry representatives (lobbyists) in Ottawa. Below are three of the issues on which Jaconde expects to meet with her counterpart from the respective WTO Member country. For each of these meetings, she will need a short preparatory memo (1000 word limit) explaining the potential TRIPS or other intellectual problems and what Jaconde might profitably say to her foreign counterpart on behalf of Canadian interests.

Based on your expertise – and the rest of your workload – Jaconde’s chief of staff’s has asked you to pick two of these three and do memos. Remember Mona reads slowly and has a busy ministerial schedule – so no more than 1,000 words for each essay.

#### 1. COPYRIGHT LAW in JAMAICA and BARBADOS

Jamaica and Barbados are both members of the Caribbean Community (CARICOM) which has worked to improve economic, political, and policy integration among Caribbean countries. As part of this effort, CARICOM members have, to some degree, harmonized their intellectual property laws following CARICOM “model” provisions. Until 2014, the copyright law of both Jamaica and Barbados had the following provisions – Sections 42 and 43 – dealing with exceptions and limitations to copyright law:

\* \* \* \* \*

#### **Section 42**

##### **Criticism, review, news reporting, research and private study**

- (1) Fair dealing with a work for the purposes of criticism or review, of that or another work or of a performance of a work, does not infringe copyright in the work if such fair dealing is accompanied by a sufficient acknowledgement.
- (2) Fair dealing with a work for the purpose of reporting current events by means of a sound recording, film, or communication work does not infringe copyright in the work.
- (3) Fair dealing with a work (other than a photograph) for the purposes of reporting current events by any means other than those referred to in subsection (2) does not infringe copyright in

the work if such fair dealing is accompanied by a sufficient acknowledgement.

- (4) Fair dealing with a work for the purposes of research or private study does not infringe copyright in the work

### **Section 43**

#### **Other permitted uses**

In addition, the following uses of a work do not infringe copyright in the work:

- (1) Use, for the benefit of people with a disability, which are directly related to the disability and of a non-commercial nature, to the extent required by the specific disability;
- (2) Use during religious celebrations or official celebrations organised by a public authority;
- (3) Use by making a temporary reproduction of the work or adaptation as part of the technical process of making or receiving a communication.

\* \* \* \* \*

In the past year both Jamaica and Barbados have amended their copyright exceptions and limitation provisions. The Parliament of Jamaica decided to keep all the exceptions in Sections 42 and 43, but added the following Section 43a:

\* \* \* \* \*

#### **Section 43a (Jamaica Copyright Act) Discretionary exceptions and limitations**

In addition to and in keeping with the existing limitations and exceptions in Sections 42 and 43, any court hearing a copyright dispute shall have the power to permit the unauthorized use of a copyrighted work in any certain special case, provided that such use does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author.

\* \* \* \* \*

Meanwhile, the Barbados House of Assembly (Parliament) decided to *abolish* its list of copyright exceptions and limitations in Sections 42 and 43 of their copyright act and replace it with the following:

\* \* \* \* \*

**New Section 42 (Barbadian Copyright Act)  
Exceptions and Limitations**

In order to ensure that copyright law maintains the appropriate balance between incentives for creativity, protection of author's interests, and public access to information, any court hearing a copyright dispute shall have the power to permit the unauthorized use of a copyrighted work in any certain special case, provided that such use does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author.

\* \* \* \* \*

Obviously, both of these laws are modeled on the "three step" test of Berne Article 9(2) and TRIPS Article 13. But Canadian publishing interests have complained to Minister Jaconde that it makes no sense to amend national copyright laws this way and that the new Jamaican and Barbadian laws actually should fail the three-step test. Analyze.

2. **INDONESIAN PATENT (and Copyright and Trademark) LAW**

Meanwhile, the Republic of Indonesia has promulgated a series of amendments to its patent law with some related amendments to its copyright and trademark laws. Cumulatively, the amendments seem to have the most impact on the pharmaceutical and computer software industries. In a statement accompanying the presidential signing of the amendments, the Government of Indonesia said, "Today, we are introducing a modest set of changes in our country's overall intellectual property law, designed to ensure that we do not 'overprotect' some works through duplicative



intellectual property, that consumers are especially protected from the most offensive kinds of counterfeiting, and that intellectual property law does not unduly hinder competition, particularly in the field of health care.”

\* \* \* \* \*

#### New provisions of Indonesian Patent Law

##### **Section 3-39**

[a]      Regardless of any other provisions of the patent law, neither criminal prosecution nor criminal sanctions shall be available against infringement of patents related to pharmaceutical products used in the treatment of human, processes for making said pharmaceutical products, diagnostic or therapeutic methods for the treatment of humans, or diagnostic or therapeutic products used in the treatment of humans.

[b]      In cases concerning the infringement of patents as described in Section 3-39[a], courts shall not issue *inaudita altera parte* orders for the seizure of evidence unless the infringers activities are shown to be related to violations of criminal law not directly related to infringement of intellectual property.

[c]      The Minister of Public Health, in coordination with the Indonesian Patent Office, will promulgate regulations defining said processes and products as described in Section 3-39[a].

##### **Section 3-127**

The grant of a patent covering any software invention renders null and void any copyright over [a] a software program embodying that invention where the patent holder is or was the copyright holder of the software, and [b] any software program enabling that invention for purposes of the patent application on which the patent was granted.

#### New provision of Indonesian Trademark Law

##### **Section 5-40**

(a)      In the case of trademarks for [a] pharmaceutical products used in the treatment of human, or [b] diagnostic or therapeutic products used in the treatment of humans, in a civil action for infringement of said trademark(s) after any district court has reached a final judgment in favor of plaintiffs pursuant to [*existing statutory damage* amounts], the plaintiff may petition the court to treble any damages awarded.

- (b) The district court shall grant said petition unless defendant can show cause why treble damages are not warranted.
- (c) No Court of Appeals may reduce any award granted pursuant to section 5-40(b) more than one-third.

### New provision of Indonesian Copyright Law

#### **Section 17-55**

[1] Copyright protection of any software or computer program(s) is contingent on timely filing of a “certificate of single protection” filed by the copyright holder with the Indonesian Ministry of Justice stating, under penalty of perjury, that the software or computer program(s), including any sub-routines, is neither protected nor was ever protected by any patent issued by the Indonesian Patent Office.

[2] A Certificate of Single Protection as described in [1] must be filed with the clerk of court in any civil action seeking to enforce a copyright over any software or computer program(s).

\* \* \* \* \*

In rough summary, these amendments seem to remove all possibility of criminal prosecution for patent infringement in health care products, but substantially increase trademark infringement damages in many of the same health care products. Meanwhile, other provisions seem to make a software producer “choose” between copyright and patent protection.

A coalition of companies with substantial IP interests have already come to complain to Minister Jaconde during her first week on the job about the new Indonesian laws. Her handwritten notes from the meeting with industry lobbyists says “*could be -- TRIPS Art. 10, 27, 29. Article 41, 50? Burn art 5? Something else traipse --- maybe 13, 30? 61?*”

### 3. THE NEW “REVISED LISBON AGREEMENT”

The World Intellectual Property Organization (WIPO) will convene a “Diplomatic Conference” (dipcon) in 2015 to consider a massive revision of the 1958 Lisbon Agreement for the Protection of

Appellations of Origin and their International Registration. Minister Jaconde remembers that you studied the 1958 Lisbon Agreement, the subsequent provisions on “geographical indications” (GIs) in the TRIPS Agreement, and the abiding disagreement between the EU and the “New World” countries [Australia, Canada, the US, Argentina, Chile, New Zealand, South Africa] over GI protection.

At the next TRIPS Council meeting, New World countries are likely to start discussing strategy for the “dipcon,” so Minister Jaconde needs a general understanding of what the **most important provisions of the proposed “new” Lisbon** do. Does it cut back or strengthen GI protection compared to the current Lisbon? How does it handle the interaction between GIs and trademarks? Is it an attempt to create a default for the “multilateral system of notification and registration of geographical indications” that is supposed to be negotiated by WTO Members under TRIPS Article 23(4)?

The 1958 Lisbon Agreement is in Course Pack #3; the entire new proposed Lisbon Agreement can be found at [http://www.wipo.int/edocs/mdocs/mdocs/en/li\\_wg\\_dev\\_8/li\\_wg\\_dev\\_8\\_2.pdf](http://www.wipo.int/edocs/mdocs/mdocs/en/li_wg_dev_8/li_wg_dev_8_2.pdf), but you need only consider the articles below, focusing on a comparison of Draft Article 2 to existing Lisbon Article 2, a comparison of Draft Articles 8-10 to existing Lisbon Article 3, and analysis of the new Draft Article 13 (which has no counterpart in the current Lisbon Agreement). [Text in colors shows alternatives that the dipcon will consider.]

\* \* \*

**DRAFT REVISED LISBON AGREEMENT ON APPELLATIONS OF ORIGIN  
AND GEOGRAPHICAL INDICATIONS**

**Draft Article 2**  
Subject-Matter

- (1) *[Appellations of Origin and Geographical Indications]* (a) This Act applies in respect of:
- (i) any denomination protected in the Contracting Party of Origin consisting of or containing the name of a geographical area situated in that Contracting Party, or a term known

as referring to such area, which serves to designate a good as originating in that geographical area, where the quality or characteristics of the good are [due] [attributable] exclusively or essentially to the geographical environment, including natural and human factors <sup>1</sup>, and which has given the good its reputation<sup>2</sup>; as well as

(ii) any indication protected in the Contracting Party of Origin which identifies a good as originating in a geographical area situated in that Contracting Party, where the quality, reputation or other characteristic of the good is essentially attributable to its geographical origin<sup>3</sup>.

(b) For the purposes of this Act, denominations as referred to in item (i) of subparagraph (1)(a) are identified by the term “appellation of origin” and indications as referred to in item (ii) of subparagraph (1)(a) are identified by the term “geographical indication”.

(2) *[Possible Geographical Area’s of Origin]* A geographical area of origin as referred to in subparagraph (1)(a) may consist of the entire territory of a Contracting Party or a region or locality in a Contracting Party. [This does not exclude the application of this Act in respect of any appellation of origin or geographical indication that adjacent Contracting Parties may have established jointly in respect of a good originating in a geographical area situated in, or covering, these Contracting Parties, subject to Article 5(4).]

\* \* \*

### **Draft Article 8**

#### **Commitment to Protect**

Each Contracting Party shall protect on its territory, in accordance with the terms of this Act, appellations of origin and geographical indications registered under this Act.

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- 1 The geographical environment of the area of production may be determined predominantly by natural factors or predominantly by human factors.
  - 2 The reputation of the good may serve as evidence of the connection between the quality or characteristics of the good and the geographical environment of the area of production.
  - 3 The reputation of the good may serve as evidence of the connection between the quality, reputation or other characteristic of the good and its geographical origin.

**Draft Article 9**

## Protection Under Laws of Contracting Parties and Other Instruments

- (1) *[Freedom to Provide More Extensive Protection]* Each Contracting Party shall be free to provide more extensive protection than the protection stipulated in this Act.
- (2) *[Form of Legal Protection]* Each Contracting Party is free to choose the type of legislation under which it establishes the protection stipulated in this Act, provided that such legislation meets the substantive requirements of this Act.
- (3) *[Protection Under Other Instruments]* The protection stipulated in this Act shall be without prejudice to any protection a Contracting Party has already granted under national law or under other international instruments, such as the Paris Convention, the Madrid Agreement on Indications of Source, the TRIPS Agreement or a bilateral agreement.

**Draft Article 10**

## Protection Accorded by International Registration

- (1) *[Content of Protection]*
- (a) Subject to the provisions of this Act, each Contracting Party shall, from the date of international registration, extend to the registered appellation of origin, or the registered geographical indication, protection against:
- (i) any use of the appellation of origin or the geographical indication
- in respect of goods of the same kind as those to which the appellation of origin, or the geographical indication, applies not originating in the geographical area of origin or not complying with any other applicable requirements for using the appellation of origin, or the geographical indication, [which would amount to its usurpation or imitation [or evocation]];
  - which would be detrimental to, or exploit unduly, its reputation,

even if the true origin of the goods is indicated or if the appellation of origin, or the geographical indication, is used in translated form or accompanied by terms such as “style”, “kind”, “type”, “make”, “imitation”, “method”, “as produced in”, “like”, “similar”, or the like;

(ii) any other practice liable to mislead the consumer as to the true origin, provenance, nature, quality or characteristics of the goods.

[Option A:

(b) Without prejudice to Article 13(1), Contracting Parties:

(i) shall refuse or invalidate the registration of a trademark which contains or consists of a registered appellation of origin, or a registered geographical indication, with respect to goods not originating in the geographical area of origin;

(ii) may refuse or invalidate the registration of a trademark which contains or consists of a registered appellation of origin, or a registered geographical indication, with respect to goods that, while originating in the geographical area of origin, do not comply with any other applicable requirements for using the appellation of origin or the geographical indication.]

[Option B:

(b) Without prejudice to Article 13(1), Contracting Parties shall refuse or invalidate the registration of a trademark which contains or consists of a registered appellation of origin, or a registered geographical indication, when it corresponds to one of the situations covered by subparagraph (a).]

[(2) *[Presumption in Case of Use by Third Parties]* Each Contracting Party shall provide for a presumption of unlawful use under paragraph (1)(a) in case a registered appellation of origin, or a registered geographical indication, is used in respect of goods of the same kind as those to which the appellation of origin, or the geographical indication, applies.]

[(3) *[Homonymy]* The provisions of this Act do not prevent the international registration of homonymous appellations of origin or

geographical indications. Each Contracting Party shall determine what protection it shall provide in respect of such appellations of origin or geographical indications. Such protection shall be subject to practical conditions taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled<sup>4</sup>.]

\* \* \*

### Article 13

#### Safeguards in Respect of Other Legitimate Rights

(1) *[Prior Trademark Rights]* In case a denomination constituting an appellation of origin, or an indication constituting a geographical indication, registered under this Act, conflicts with a prior right in a trademark applied for or registered, or, where possible, acquired through use, in good faith in a Contracting Party, each such Contracting Party shall respect such prior trademark right. Taking into account the legitimate interests of the owner of the prior trademark as well as those of the beneficiaries of the rights in the appellation of origin or the geographical indication, the Contracting Party, if not notifying a refusal under Article 15 or invalidating the effects of the international registration concerned, as referred to in Article 19, shall, in any event, not prejudice the eligibility for, or the validity of, the registration of the trademark, or the right to use the trademark, on the basis that such a trademark is identical with, or similar to, the denomination or the indication.

(2) *[Prior Rights in Another Appellation of Origin or Geographical Indication]* The provisions of paragraph (1) shall apply *mutatis mutandis* in case a denomination constituting an appellation of origin, or an indication constituting a geographical indication, registered under this Act, conflicts with a prior right in another appellation of origin or geographical indication.

(3) *[Personal Name Used in Business]* The provisions of this Act shall in no way prejudice the right of any person to use, in the course of trade,

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<sup>4</sup> It is understood that a Contracting Party has the right not to accord protection, as stipulated in this Agreement, in respect of an appellation of origin, or a geographical indication, which would, although literally true as to the geographical area in which the goods designated by the appellation of origin, or the geographical indication, originate, falsely represent to the public that the goods originate in another territory.

that person's name or the name of that person's predecessor in business, except where such name is used in such a manner as to mislead the public.

(4) *[Legitimate Rights Based on Other Signs Used in the Course of Trade]* A Contracting Party may apply the provisions of paragraph (3) *mutatis mutandis* with regard to another sign used in the course of trade, in respect of which a legitimate right other than those referred to in paragraphs (1) to (3) has come into effect in that Contracting Party before the date of the international registration of an appellation of origin or a geographical indication under this Act.

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*Thanks for an enjoyable class.*

END OF EXAMINATION MATERIALS/International Intellectual  
Property/Autumn 2014/Professor Justin Hughes