INTERNATIONAL TREATIES on INDUSTRIAL PROPERTY RIGHTS

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What is a TREATY?

- More modern and deliberate method of creating International law.

- Article 2(1) of the Vienna Convention on the Law of Treaties 1969 defines a ‘treaty’ as ‘an international agreement concluded between States in written form and governed by International law, whether embodied in a single instrument or in two or more related instruments and whatever its particular designation.’

- Known by different names such as Conventions, International Agreements, Pacts, General Acts, etc.

- Refers to the creation of written agreements whereby the states participating bind them legally to act in a particular way or to set up particular relations between themselves.

- Bilateral or Multilateral
Basis of Obligation in International Treaties.

CONSENT is the basis of obligation in International Treaties.

- Consent may be Active or Passive.
- .

Unlike Municipal local system there is no permanent institution specifically empowered to make laws, implement them and adjudicate them irrespective of the consent of the person concerned.
## Indian membership to International Treaties

India became a founder member of WTO and agreed to the TRIPS obligations during 1995. Indian membership of IP treaties and date of ratification is appended below.

<table>
<thead>
<tr>
<th>Convention</th>
<th>Date of Ratification</th>
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<tbody>
<tr>
<td>Berne Convention</td>
<td>April 1 1928</td>
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<tr>
<td>WIPO Convention</td>
<td>January 5 1975</td>
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<tr>
<td>UCC</td>
<td>January 7 1988</td>
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<tr>
<td>WTO (TRIPS)</td>
<td>January 1 1995</td>
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<td>Paris Convention</td>
<td>December 7 1998</td>
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<td>PCT</td>
<td>December 7 1998</td>
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<tr>
<td>Budapest Convention</td>
<td>December 17 2001</td>
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The *raison d’être* for the Paris Convention for the protection of Industrial Property, 1883, was the Science Exhibition that was proposed to be held at Vienna in 1873.

Since then, it has been revised at:
- Brussels (1900),
- Washington (1911),
- Hague (1925),
- London (1934),
- Lisbon (1958), and
- Stockholm (1967).
Types of IPR protected under the Convention

The purpose of the Paris Convention is

- to protect various forms of Intellectual Property, such as Patents, Utility Models, Industrial Designs, Trademarks, Service Marks, Trade names, indications of source or appellations of origin,

- repression of unfair competition, and

- to protect agricultural & extractive industries like wine, tobacco, cattle, minerals, flowers and flour.
National treatment

Articles 2&3 of the Paris Convention lay down the principle of “National Treatment”.

As per this provision, a state shall not discriminate between its own nationals and the nationals of all the contracting parties in terms of the content of the IPR and the fee charged therefore.
Article 14 of the Indian Constitution that speaks about equality as a fundamental right, makes it clear that the right of equality would be available to all persons, irrespective of nationality or their being real or artificial persons.

Even the Indian Patent Act, throughout, uses expressions like Applicant or Patentee and does not contain any discriminatory provisions against foreign nationals.
Right to priority

Article 4 of the Paris Convention speaks about the right to priority in matters of Industrial Property registration.

As per this principle, the date of Application in one member country would be deemed to be the date of Application in other member countries, if the priority is claimed within the prescribed time of the earlier Application from which the priority is claimed.
Different priority dates for different IPR

- 6 months for industrial designs and trademarks
- 12 months for patents and utility models

The Paris Convention also provides for multiple priorities wherein the earlier Application may even claim an earlier date by virtue of a previous Application made in another Member Country. For the Purpose of computing the 12 month period, the day of filing will not be included in the period.
Independence of patents

Article 4(a) provides for detailed provisions for the applicable rules relating to claiming of priority.

Article 4 bis of the Convention talks about the “independence of Patents”.

Patents are strictly territorial and the developments to the Patent in other countries is not itself a ground for changing the Patent grant in third countries.
Moral rights of inventor & Legality of invention

Article 4 *ter* establishes the moral right of the inventor to be mentioned as the inventor of the Patent.

Article 4 *quater* says that Patent for a product should not be refused merely on the ground that the sale of the patented process or product is subject to restrictions and limitations arising from the domestic law.
Prevention of Abuse of IPR

Article 5 of the Convention talks about the State Powers in regulating the possible abuse of Patents by IPR holder.

This Article makes it clear that the importation of the Patented Product is not prima facie illegal, if the Patented process or product is available to the members of the public at reasonable cost.
The same Article further provides that while the State shall be free to grant compulsory licenses for encouraging local working of Patent.

Such licenses cannot be granted before the expiration of a grace period, 4 years from the date of Application or 3 years from the date of grant of the Patent, whichever period expires last.
Compulsory Licensing (Contd..)

However, the Paris Convention says that the compulsory license shall be non-exclusive and non-transferable.

Under Indian law, compulsory license can even be exclusive and freely transferable at the instance of the license holder.
Compulsory Licenses (Contd.)

Indian Patent Act contemplates different types of Compulsory Licenses (CLs).

Under Section 84 any person can apply for a CL after the expiration of 3 years from the date of a grant of a patent if any of the following requirements are satisfied:

- Reasonable requirements of the Indian market is not met.
- The patented invention is not available to the public at reasonable cost.
- The patent is not worked in the territory of India.
- Unlike the past, now there can be compulsory license for export as well
**India as a Member**

- India was not a member of the Paris Convention till the end of the second Millennium.

- Prior to that, India had bilateral arrangements with England, Canada, Australia and Sri Lanka.

- Contrary to popular perception, India demonstrated its willingness to modernize its Patent Laws.

- IDMA (Indian Drug Manufacturers' Association) lobbied hard to ensure that India did not become a member of the Paris Convention.

- Despite their lobbying, India not only adhered to the Paris Union, but also became a member of the Patent Co-operation Treaty.
The Berne Convention for the Protection of Literary and Artistic Works of 1886 was developed at the instigation of Victor Hugo of the Association Littéraire et Artistique Internationale. It was influenced by the French "right of the author" (droit d'auteur).

The Berne Convention was revised in Paris in 1896 and in Berlin in 1908, completed in Berne in 1914, revised in Rome in 1928, in Brussels in 1948, in Stockholm in 1967 and in Paris in 1971, and was amended in 1979.
BASIC PRINCIPLE given by the Convention

- All foreign authors to receive same Copyrights and protections for their copyrighted work, in a member country of the Convention, as given to its domestic authors.

- The concept of ‘Inherent protection’ guarantees the author copyright and protection based upon the creation and publication of a work (not subject to conditional or required registration or notification to acquire copyrights and protection).

- The Berne Convention legislation is to apply regardless of a particular nation's own copyright laws and regulations.
Membership

- As of September 2008, there are 164 countries that are parties to the Berne Convention.

- India ratified the Berne Convention on 1st April 1928
The Universal Copyright Convention, 1952

- Developed by United Nations Educational, Scientific and Cultural Organization, for those states which disagreed with aspects of the Berne Convention, but still wished to participate in some form of multilateral copyright protection.

- These states included developing countries and the Soviet Union, which thought that the strong copyright protections granted by the Berne Convention overly benefited Western developed copyright-exporting nations.

- India became a member State on 7th January 1988.
The Universal Copyright Convention, 1952

- Unlike Berne Convention, UCC permitted the member states who had a system of copyright protection for a fixed term at the time of signature to retain them.

- The UCC provides that any member country that requires, as a condition of copyright protection, compliance with formalities (such as registration, deposit or notice) must treat such formalities as satisfied if all published copies of a work bear the copyright notice.
Madrid Agreement (1891)

- It provides for International Trademark Registration, unlike the treaties concerning patents where nothing known as an International Patent exists.

- The Madrid Agreement concerning the International Registration of Marks (1891) is a special treaty designed to ease the acquisition of trademark rights in various countries.
Madrid Agreement

- The Madrid system for the international registration of marks (the Madrid system)

- It is administered by the International Bureau of WIPO located in Geneva, Switzerland.

- The system enables the registration of trademarks in multiple jurisdictions worldwide that are part of Madrid Union’s 85 member countries by filing a single application.
Requirements under Madrid Agreement

- Prior registration in country of origin.

- Single International application to be filed.
  (Designating the Member countries in which the applicant wants its Trademark to be registered.)

- Examination of application for compliance with requirements of the Madrid Agreement (concerning Indication of goods & services, their classification, required fee payment, etc.).
PROCEDURE (Contd..)

- On successful examination the International Bureau then Records the mark in the International Register, publishes the mark in the Gazette

- I.B. then notifies each contracting party or member country that are the designated countries listed in the application

- Examination by Regional Office of each contacting party according to their domestic laws.

- Individual grant of Protection or Refusal by each Contracting Party.
Dependence on Basic Mark

- For a period of five years from the date of an international registration.

- After the expiry of the period of five years from the date of international registration, the registration becomes independent of the basic registration or basic application.
Duration of Registration

- An international registration is effective for 10 years.

- It may be renewed for further periods of 10 years on payment of the prescribed fees.

- The international registration may be renewed in respect of all the designated Contracting Parties or in respect of only some of them.
BUDAPEST TREATY, 1980

- Disclosure and the Requirement for Deposit.
- Need for a Uniform International Deposit System.
I. International Depositary Authorities and Recognition of Single Deposit

Certain culture collections are recognized as “international depositary authorities” (IDAs). Any Contracting State which allows or requires the deposit of microorganisms for the purposes of patent procedure must recognize, for those purposes, a deposit made in any IDA, wherever that IDA may be. Any culture collection can become an IDA provided that it has been formally nominated by the Contracting State on whose territory it is located and that that Contracting State has furnished solemn assurances that the collection complies and will continue to comply with the requirements of the Treaty and the Regulations.
II. Deposit and Furnishing of Samples

The duration of storage of deposited microorganisms is at least 30 years or five years after the most recent request for a sample, whichever is later.

Provision is made for samples to be furnished at any time to the depositor, to anyone having the depositor’s written authorization, and to any “interested” industrial property office (i.e., one dealing with a patent application concerning the deposited microorganism and which provides the IDA with a declaration to that effect).
III. Safeguard of Deposits

The IDA must have the expertise and facilities necessary to keep the microorganism viable and uncontaminated throughout the storage period required by the Treaty.

If for any reason an IDA is no longer able to furnish samples of a microorganism, a new deposit of the same organism can be made and can benefit from the date of deposit of the original.
IV. Meaning of the Term “Microorganism”

‘Microorganism’ is not defined in the Treaty.

Whether an entity technically is or is not a microorganism matters less in practice than whether deposit of that entity is necessary for the purposes of disclosure and whether an IDA will accept it.

The range of materials able to be deposited under the Budapest Treaty includes:

- cells, for example, bacteria, fungi, eucaryotic cell lines, plant spores;
- genetic vectors (such as plasmids or bacteriophage vectors or viruses) containing a gene or DNA fragments;
- organisms used for expression of a gene (making the protein from the DNA).
“Microorganisms” (Contd…) 

There are many types of expression systems: bacterial; yeast; viral; plant or animal cell cultures;

- yeast, algae, protozoa, eucaryotic cells, cell lines, hybridomas, viruses, plant tissue cells, spores, and hosts containing materials such as vectors, cell organelles, plasmids, DNA, RNA, genes and chromosomes;

- purified nucleic acids; or

- deposits of materials not readily classifiable as microorganisms, such as “naked” DNA, RNA, or plasmids.
MEMBERSHIP

- 75 countries are party to the Budapest Treaty
- The Treaty is open to States party to the Paris Convention for the Protection of Industrial Property (1883). Instruments of ratification or accession must be deposited with the Director General of WIPO.
- India became a member on 17th December 2001.
International Depositary Authority (IDA)

- There are 40 such authorities all over the world.

- In India:

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<tr>
<th>Microbial Culture Collection (MCC)</th>
<th>Telephone: (+91 20) 25708000</th>
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<tbody>
<tr>
<td>National Centre for Cell Science (NCCS)</td>
<td>Facsimile: (+91 20) 25692259</td>
</tr>
<tr>
<td>University of Pune Campus, Ganeshkhind</td>
<td>E-mail: <a href="mailto:yogesh@nccs.res.in">yogesh@nccs.res.in</a></td>
</tr>
<tr>
<td>Pune-411007, Maharashtra</td>
<td>Internet: <a href="http://www.nccs.res.in">http://www.nccs.res.in</a></td>
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<tr>
<td>India</td>
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<tr>
<th>Microbial Type Culture Collection and Gene Bank (MTCC)</th>
<th>Telephone: (91-172) 263 66 80 to 94</th>
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<tbody>
<tr>
<td>Institute of Microbial Technology (IMTECH)</td>
<td>Facsimile: (91-172) 269 05 85, 269 06 32</td>
</tr>
<tr>
<td>Council of Scientific and Industrial Research (CSIR) Sector 39-A</td>
<td>E-mail: <a href="mailto:idamtcc@imtech.res.in">idamtcc@imtech.res.in</a>, <a href="mailto:curator@imtech.res.in">curator@imtech.res.in</a></td>
</tr>
<tr>
<td>Chandigarh - 160 036 (Union Territory)</td>
<td>Internet: <a href="http://mtcc.imtech.res.in">http://mtcc.imtech.res.in</a></td>
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