



e-News

No.20

September 2011

International Association for the Protection of Intellectual Property
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WIPO Standing Committee on Copyright and Related Rights – 22nd Session *Sanna Wolk and Jan Bernd Nordemann, Special Committee Copyright of AIPPI*

In June 2011, WIPO held the 22nd Session of the Standing Committee on Copyright and Related Rights “SCCR” in Geneva. Sanna Wolk and Jan Bernd Nordemann, both members of AIPPI's Program Committee, represented AIPPI as observers in the session. The SCCR is WIPO's top copyright negotiating body.

The SCCR session agenda included a number of important issues that have been up for discussion within the Committee for some time, such as:

- a. limitations and exceptions in copyright/neighbouring rights,
- b. a possible convention on the protection of radio and television broadcasts and,
- c. a possible convention on the protection of performers in audiovisual performances.

The question on limitations and exceptions was divided into two different categories, namely the issue of blind and visually impaired access to copyrighted material, and also the wider question of limitations and exceptions for the benefit of other “disabled persons”, as well as teaching and research purposes and archives and libraries.

Proposal for protection of audiovisual performers As an important result of the session, it can be reported that after 11 years of negotiations, the SCCR has agreed on provisions to protect performers in the audiovisual industry. WIPO's General Assembly was asked to convene a diplomatic conference. This signals entry into the final phase of treaty negotiations, with the objective of concluding a treaty.

Performers “e.g. actors, singers, musicians, dancers” already enjoy international protection for their performances under the Rome Convention “1961” and under the 1996 WIPO Performances and Phonograms Treaty “WPPT”. These treaties, however, grant protection mainly in relation to sound recordings of performances.

In 2000, a diplomatic conference on the protection of audiovisual performers had already reached a provisional agreement on 19 of the 20 articles under negotiation. In the 22nd SCCR session, the member states were able to reach agreement on the remaining article, which relates in particular to the transfer of rights to producers.

Broadcasting organizations

Furthermore, the SCCR controversially discussed the protection of broadcasting organizations. Some progress was made here with agreement on a work plan aimed at advancing negotiations on an international instrument. The international instrument is meant to update the rights of broadcasters, which are currently dealt with by the Rome Convention (1961).

Exceptions/limitations: persons with print disabilities

In the case of this issue a series of proposals were put forward, namely:

- a draft convention on the subject (by Brazil, Ecuador, Mexico and Paraguay, which connects to an earlier proposal by the World Blind Union)
- a “Consensus paper” (by the US)
- a “Draft Joint Recommendation” (by the European Union).

The differences between the proposals is that the EU wants a non-binding instrument, Brazil and its co-sponsors want a binding convention, and the United States appear to be willing to eventually accept a binding instrument.

There had been extensive informal consultations on the issue of limitations and exceptions for persons with print disabilities preceding the Committee session, with very high expectations when the session began. After some informal discussion in what was called “four-way meetings” (from Brazil, Mexico, the US and the EU and its 27 Member States), a joint text that was submitted in the form of a “non-paper” (i.e. a document without official status) was agreed upon. Such a non-paper is considered a major step in the international negotiation context. South Africa announced, however, on behalf of the African countries that although they had participated in informal discussions their views had been disregarded. Furthermore, the question of the future instrument's legal nature is not yet finally settled, the EU and the US prefer a recommendation while Brazil, India and the African Group wanted a binding convention.

This non-paper was the subject of a fairly extensive discussion with both substantive and procedural objections. The result was that the Chairman Manuel Guerra Zamarro presented a Chair proposal, based on past discussions but also containing views expressed during the session. This paper now forms the basis for

further discussions on an international instrument to address the problem of limitations and exceptions for visually impaired persons.

Regarding the issue of a recommendation or convention, a two-stage approach was mentioned – first a recommendation and then after some time a convention.

In summary, a large and important step towards a resolution of this issue was made, and discussions will continue during the SCCR's 23rd meeting in November 2011.

For more information, see also WIPO's website <http://www.wipo.int/copyright/en/>.

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AIPPI Spotlight
AIPPI Communications Committee

This edition we speak to Mr Pravin Anand, President of the Indian Group.

Q1. What are the vital statistics for your Group?

a. When was your group formed?

The AIPPI Indian Group was formed in 1986.

b. How many members do you have?

In August 2011, the Indian Group had 129 members.

c. Where do the members come from? eg which industry sectors? IP lawyers? Patent and trade marks attorneys?

Members of the Group come from intellectual property law practitioners, patent and trademark agents in private practice and in industry.

Q2. How is the Group run? Is there a committee/council?

The AIPPI Indian Group has an Executive Committee which at present has six members including the President of the Indian Group.

Q3. What is its membership (eg. IP lawyers, patent attorneys, corporate representatives)?

At present, the Committee is made up of six intellectual property law practitioners.

Q4. How often does it meet?

The Executive Committee meets around three to four times a year.

Q5. Does the Group arrange any of its own events for local members? If so, please provide examples

The Group arranges its own events from time to time including a National Seminar on Intellectual Property organized in Hyderabad from 18th to 20th November 2010; and a seminar in Ahmedabad on 5th March 2011 to spread awareness about Intellectual Property and AIPPI.

Q6. Does the Group do anything else for its local members? For example, a publication?

At present the Group does not have its own publication.

Q7. How does your Group deal with replies to the AIPPI Questions each year?

The Indian Group invites its members to participate in discussion of and the preparation of responses to the Questions. Depending on the participation its members, the Group chooses its representatives for the Questions who in turn prepare responses which incorporate the Indian Group's inputs and views.

Q8. What plans and improvements do you have in mind for the coming year?

The AIPPI Indian Group is currently organizing the AIPPI Exco and Forum to be held in Hyderabad from 13th to 19th October 2011.

Q9. Is there anything else of interest about your Group which you would like to add?

Some of the Group's future plans include the following:

- i. Having its own website;
- ii. Starting its own publication;
- iii. Arranging for seminars to spread intellectual property awareness in smaller cities of the nation such as Ahmedabad.

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US patent law reform is passed by the US House of Representatives; expected to be approved by the US Senate in September

Joshua Goldberg, U.S. Group Reporter

Continuing the ongoing developments regarding patent law reform in the US, the US House of Representatives passed their version of the America Invents Act (H.R. 1249) on June 23, 2011 providing several different changes to the US patent laws.

The similarities between the House bill and that previously passed by the Senate include:

- A transition to a first-to-file system (also known as a first inventor to file system).
- Repeal of interferences.
- Transition of inter partes re-examination to inter-partes review, requiring petitioner to show a reasonable likelihood that petitioner would prevail against one or more claims.
- A new "first-window" post-grant patent opposition system with broader jurisdiction (but a shorter timeframe) than reexaminations.
- Elimination of statutory damages in false marking cases.
- Permission to virtually mark patented products with an internet address.
- Creation of micro-entities.
- Affirming that failure to obtain legal counsel may not be used as evidence to prove willful infringement.
- An administrative procedure for challenging business method patents.
- A provision that eliminates certain tax strategy patents.
- USPTO authority to establish satellite offices.
- Elimination of the best mode defense.

In contrast, the differences between the House bill and that previously passed by the Senate include:

- The issue of prior user rights - the House bill allows prior user rights as a defense to infringement, whereas the Senate bill first requires a study.
- Unlike the Senate bill, the House bill contains a section on the various fees that can be charged by the PTO, including a fee for prioritized examination.
- The House bill would not allow any claims directed to or encompassing a human organism.
- The House bill instructs the USPTO to work with and support the establishment of pro bono programs to assist financially under-resourced independent inventors and small businesses.
- The two bills also provide different mechanisms for funding the USPTO.

Since there are differences between the two bills, the House bill will now move to a Senate committee to be reconciled with the Senate bill, after which the Senate will again have to vote to adopt the bill before it is sent to President Obama for signature. It looks promising that this process will be carried out in September, now that certain financial issues have been dealt with.

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US Court of Appeals for the Federal Circuit indicates isolated human DNA molecules are patentable

Joshua Goldberg, U.S. Group Reporter

On July 29, 2011, the US Federal Circuit overturned the Southern District of New York in ASSOCIATION FOR MOLECULAR PATHOLOGY V. MYRIAD GENETICS and held that isolated human DNA molecules are patentable under US law. However, the case was not a complete win for the patent holder, Myriad. In this regard, the Federal Circuit held the following with respect to the various types of patent claims:

- Myriad's claims directed to isolated DNA were valid.
- Myriad's claims directed to comparing or analyzing gene sequences were invalid.
- Myriad's claims directed to scanning potential cancer therapeutics via changes in cell growth rates were valid.

All of the parties in this case agreed that the claimed DNA molecules are "compositions of matter" that nominally fall under 35 U.S.C. § 101. The issue instead came from the Supreme Court's repeated indication that neither products of nature nor natural phenomena qualify for patenting. Accordingly, the key issue was whether the claimed molecules qualify as a "product of nature".

According to the Federal Circuit, to be distinguishable from products of nature, a "human made" invention must be "markedly different" or express "distinctive" characteristics from what is found in nature. This can be seen in the Federal Circuit's holding that the claims are patentable on the basis that:

1. the claimed cDNA is not a molecule found in nature;
2. human intervention is necessary to make the cDNA; and
3. the molecule is changed, it is not merely "purified".

It is important to note that this decision will likely be appealed to the Supreme Court, so the story might not yet be over. Stay tuned!

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Yahoo case

Luigi Manna, LGV Avvocati, Milan, Italy

A much anticipated second instance decision in the matter of Internet search engine services was issued on 11 July 2011 by the IP section of the Rome district court.

An Italian company holding exclusive rights to the movie "About Elly", PFA, had filed motion for summary judgment against several providers of Internet search engine services before the Rome IP court. The applicant had complained that a simple search on the respondents' engines made by using the title of the movie as key word highlighted links to third party websites that offered unauthorized reproductions of excerpts of the movie. According to the applicant, although made aware of these ongoing infringements, the ISPs had failed to adopt any measures to put an end to them. On these grounds, the applicant had sought an injunction under ISP liability and copyright enforcement rules.

The first instance judge had upheld the applicant's motion and granted the injunction against Yahoo, ordering the latter to remove from the search results of its Internet search engine any links to websites offering excerpts of the movie other than the official movie website. The other respondents had been exempted on the grounds that they were only the local branches of the concerned ISP and had no *locus standi*.

The ruling was appealed by both Yahoo and PFA before a panel of judges of the same court and all the ISPs taking part in the first instance proceedings were joined in. One of several arguments put forward by the ISPs was that, in sending its notices of infringement, PFA had never exactly pointed out what links it wanted to be removed, although expressly requested to do so in reply, nor had it given clear evidence of the fact that the related content infringed its rights.

The court upheld Yahoo's appeal and reversed the prior judgment.

The appeal judges found indeed that the rightholder had failed, first in its takedown notices to the concerned ISPs, and then in its submissions to court, to show specific evidence of particular third party websites making available content infringing its asserted rights.

This defective allegation, in the court's view, worked against the rightholder's claim – and the first instance judgment – on several levels.

From a strictly procedural law standpoint, it was inconsistent with the burden of showing detailed evidence of specific infringements, bearing on any parties seeking judicial remedies before a court of law. In addition, it precluded the granting of an injunction directed to specific online infringements, only allowing for an inadmissible generic order - such as the one in fact granted by the prior judge – so wide in scope as to potentially affect third party legitimate activities (the court observed in this respect that the claimant was not the sole and exclusive owner of rights over the movie).

In addressing the issue of the equally unspecific and unsubstantiated notices of infringement sent in advance of the proceedings to the ISP, the Court made reference to the Community law principle that ISPs are not required to pre-emptively monitor the information which they transmit or host, from which it follows that there can be no duty for ISPs to actively cooperate in putting an end to alleged infringements unless detailed and specific notices of infringement are submitted to them by the concerned rightholders.

On these grounds, the appeal court revoked the injunction granted in the first instance proceedings.

Although this ruling has been given in the framework of summary proceedings and it could be overridden by a judgment on the merits pursuant to ordinary proceedings, it does represent a step forward in the process of defining clearer standards in the matter of ISPs' duties and liabilities in the Italian jurisdiction.

After years of uncertainty, the principle that ISPs cannot consider themselves totally unconcerned with any IP infringements going on through their services – which has previously struggled to impose itself – seems now to be substantially accepted by Italian courts. What was missing (and is in part still missing) is the drawing of the boundaries of any duties and liabilities falling on the ISPs, partly due to badly drafted legislation.

The Rome decision, which at its core seems to confirm the recent landmark decision of the Milan IP court in the *IOL* case, sets a major precedent by clarifying that an obligation of the ISP to act, and a corresponding right for the rightholder to seek an injunction if that obligation is breached, may only arise if the rightholder does his part and puts the ISP in condition to comply.