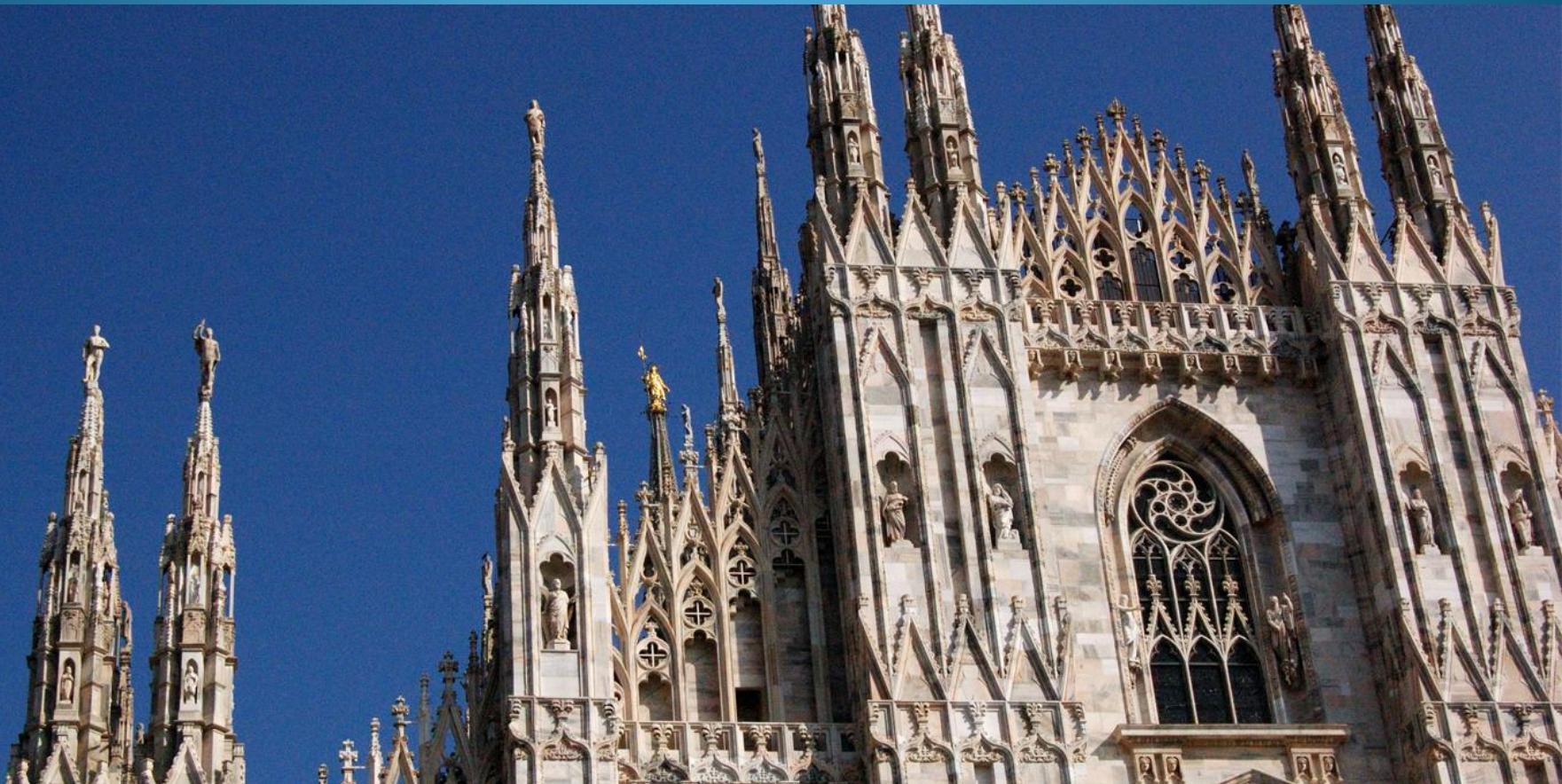


The Trans-Pacific Partnership (TPP) and the Transatlantic Trade and Investment Partnership (T-TIP) Agreements



Our Panelists

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The Trans-Pacific Partnership: The 12 Parties

- Australia
- Brunei
- Canada
- Chile
- Japan
- Malaysia
- Mexico
- New Zealand
- Peru
- Singapore
- United States
- Vietnam

Status of the TPP

- Official version released in November 2015
- Signed by representatives of participating countries
 - President Obama signed on February 4, 2016
- Signatory countries have 2 years for domestic ratification of agreement
- A priority of Obama Administration, but this is a presidential election year in the U.S.
- Unlikely anything will happen before November elections
- TPP seeks to promote trade and strengthen relationships between signatory countries, including by fostering competition and creating greater business opportunities
- IP Chapter (Chapter 18) is very important component

Status of the T-TIP

- Trade and Investment Agreement Being Negotiated Between the U.S. and the EU
- Negotiations started over three years ago
- Regular communications between U.S. Trade Representative Michael Froman and EU Trade Commissioner Cecilia Malmström
- A priority of Obama Administration, but this is a presidential election year in the U.S.

Highlights of TPP IP Chapter 18

- Article 18.7 – Affirms International Agreements
 - Patent Cooperation Treaty
 - Paris Convention
 - Berne Convention
- Ratification/Accession of Agreements:
 - Madrid Protocol
 - Budapest Treaty (on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure)
 - Singapore Treaty (on the law of trademarks)
 - UPOV 1991 (International Convention for the Protection of New Varieties of Plants)
 - WCT (WIPO Copyright Treaty)
 - WPPT (WIPO Performances and Phonograms Treaty)

Highlights of TPP IP Chapter 18

- Trademarks
 - Registration of sounds and scents (18.18)
 - Well-Known trademarks (18.22)
 - No requirement for registration or prior recognition
 - Provide for appropriate measures to refuse application or cancel registration and prohibit use of a trademark that is identical or similar to a well-known trademark for identical or similar goods or services, if the use of that trademark is likely to cause confusion with the prior well-known trademark

Highlights of TPP IP Chapter 18

- Trademarks
 - Examination, Opposition and Cancellation Procedures (18.23)
 - Provide for system for examination and registration
 - Electronic communications
 - Opportunity to respond/judicially appeal
 - Opportunity to oppose registration and seek cancellation
 - Reasoned, written administrative decisions
 - Electronic Trademark System (18.24)
 - System for electronic application and maintenance, online database of registered marks

Highlights of TPP IP Chapter 18

- Trademarks
 - Classification of Goods or Services (18.25)
 - Adopt or maintain system consistent with Nice Agreement
 - Term of Protection (18.26)
 - Provide initial registration and each renewal for a term of “no less than 10 years”
 - Domain Names (18.28)
 - Procedure for settlement of disputes along same lines as UDRP for ccTLD domain names and online access to database of registrants
 - Appropriate remedies for bad faith intent to profit from registrations identical or confusingly similar to a trademark

Highlights of TPP IP Chapter 18

- Geographical Indications (GIs)
 - Recognition of GIs (18.30)
 - May be protected through a trademark or *sui generis* system or other legal means
 - In other words, subsumes GI protection into trademark law
 - GIs are used on goods that possess qualities, reputation or characteristics attributable to its place of origin
 - Administrative Procedures for Protection or Recognition of GIs (18.31)
 - International Agreements (18.36)

Highlights of TPP IP Chapter 18

- Patents
 - Patentable Subject Matter (18.37)
 - Make patents available for any invention in all fields of technology, provided the invention is new, involves an inventive step and is capable of industrial application
 - May exclude from patentability inventions necessary to protect human, animal or plant life or health or to avoid harm to the environment; and may also exclude diagnostics, therapeutic and surgical methods for treatment of humans or animals
 - Grace Period (18.38)
 - Grace disclosures made by applicant or obtained from applicant that occurred within 12 months prior to the date of filing

Highlights of TPP IP Chapter 18

- Patents
 - Publication of Patent Applications (18.44)
 - Each Party “shall endeavour to publish” unpublished pending patent applications promptly after the expiration of 18 months from filing date or earliest priority date
 - Information Relating to Published Patent Applications and Granted Patents (18.45)
 - Make available search and examination results, non-confidential communications with applicants, patent and NPL citations

Highlights of TPP IP Chapter 18

- Patents
 - Patent Term Adjustment for Patent Office Delays (18.46)
 - Make best efforts to process applications in efficient and timely manner
 - Provide means to adjust term for unreasonable delays
 - Delay of more than five years from date of filing or three years from request for examination (whichever later) is unreasonable
 - Patent Term Adjustment for Unreasonable Curtailment (18.48)
 - For pharmaceutical products, make available an adjustment of patent term to compensate for unreasonable curtailment as a result of marketing approval process

Highlights of TPP IP Chapter 18

- Patents
 - Protection of Undisclosed Test or Other Data (18.50)
 - If a Party requires, *as a condition for granting marketing approval for a new pharmaceutical product*, the submission of undisclosed test or other data concerning the safety and efficacy of the product, that Party shall not permit third persons, without the consent of the person that previously submitted such information, to market the same or a similar product on the basis of that information or the marketing approval granted to the person that submitted such information *for at least five years* from the date of marketing approval of the new pharmaceutical product in the territory of the Party.

Highlights of TPP IP Chapter 18

- Patents
 - Biologics (18.52)
 - With regard to new biologics, a Party shall with respect to the first marketing approval in a Party of a new pharmaceutical product that is or contains a biologic, either (a) provide effective market protection through the implementation of Article 18.50.1 and Article 18.50.3 – for a period of at least 8 years from the date of first marketing approval of that product in that Party; or (b) provide effective market protection through the implementation of Article 18.50.1 and Article 18.50.3 – for a period of at least 5 years from the date of first marketing approval of that product in that Party, through other measures, and recognizing that market circumstances also contribute to effective market protection to deliver a comparable outcome in the market.

Highlights of TPP IP Chapter 18

- Patents
 - But per footnote 53, a Party may limit the protection under paragraph 1 of Article 18.50 to five (5) years, and the period of protection under Article 18.52.1(a) (Biologics) to eight (8) years
 - Note that in the U.S., 12 years of data exclusivity is provided under the Biologic Price Competition and Innovation Act

Highlights of TPP IP Chapter 18

- Industrial Designs
 - Protection (18.55)
 - Each Party shall ensure adequate and effective protection of industrial designs
 - Improving Industrial Designs (18.56)
 - Give due consideration to ratifying the Hague Agreement

Highlights of TPP IP Chapter 18

- Copyrights and Related Rights
 - Right of Reproduction (18.58)
 - Provide to authors, performers and producers of phonograms the exclusive right to authorize or prohibit all reproduction of their works, performances or phonograms in any manner or form, including in electronic form
 - Right of Communication to the Public (18.59)
 - Right of Distribution (18.60)
 - Term of Protection (18.63)
 - life of the author plus 70 years

Highlights of TPP IP Chapter 18

- Copyrights and Related Rights
 - Technological Protection Measures (TPMs) (18.68)
 - Provide for liability and remedies relating to circumvention of technological measures for restricting unauthorized acts with respect to works, performances and phonograms of authors, performers and producers
 - Provide for criminal procedures and penalties
 - May provide for certain exceptions in order to enable non-infringing uses
 - In other words, requires Parties to increase protections for Digital Rights Management, such as laws banning circumvention of digital locks

Highlights of TPP IP Chapter 18

- Enforcement
 - General Obligations (18.71)
 - Expeditious remedies to permit effective action against act any of infringement of IP rights
 - Confirm remedies available with respect to acts of trademark and copyright infringement in the digital environment

Highlights of TPP IP Chapter 18

- Enforcement
 - Civil and Administrative Procedures and Remedies (18.74)
 - Make available to rights holders civil judicial procedures concerning enforcement
 - Provide judicial authorities with authority to order injunctive relief conforming to Article 44 of TRIPS Agreement
 - Provide judicial authorities with authority to order infringer to pay right holder damages adequate to compensate for the injury
 - Provides judicial authorities with authority to order infringing pirated copyright goods and counterfeit trademark goods be destroyed
 - Provide destruction of devices used to infringe copyright or circumvent technical protections

Highlights of TPP IP Chapter 18

- Enforcement
 - Criminal Procedures and Remedies (18.77)
 - Provided for cases of willful trademark counterfeiting or copyright or related rights piracy on a commercial scale
 - Willful importation or exportation of counterfeit trademark goods or pirated copyright goods on a commercial scale subject to criminal penalties
 - Ensure criminal liability for aiding and abetting is available under law

Highlights of TPP IP Chapter 18

- Trade Secrets (18.78)
 - Ensure legal means for trade secret protection
 - Provide for criminal procedures and penalties for unauthorized and willful access to trade secret “held in a computer system”, unauthorized and willful misappropriation of a trade secret, including by means of a “computer system”, or the fraudulent disclosure of a trade secret, including by means of a “computer system”

Highlights of TPP IP Chapter 18

- Internet Service Providers
 - Legal Remedies and Safe Harbors (18.82)
 - Provide enforcement procedures to permit effective action by rights holders against copyright infringement in the online environment
 - Ensure legal remedies are available and maintain appropriate safe harbors for ISPs
 - Notice and takedown provisions (differ somewhat from the Digital Millennium Copyright Act in the U.S.)

Discussion

- TPP – Hot Issues
- T-TIP – Hot Issues
- Impact of Free Trade Agreements from an IP Perspective
- Thoughts for the Future

THANK YOU!