



Available IP Tools to Protect TK and TCEs within the Existing IP System

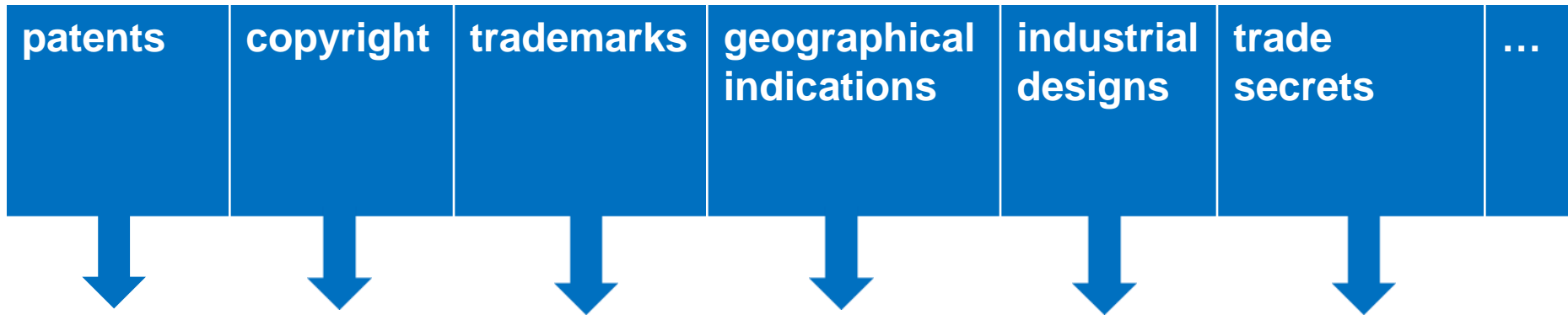
Claudio Chiarolla

Traditional Knowledge Division

**Constantine,
April 5, 2016**

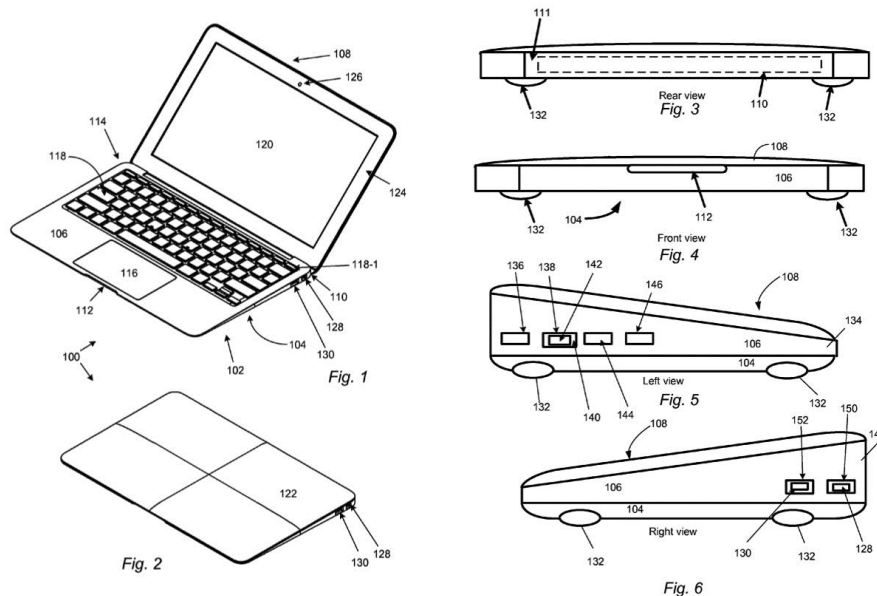
What is the intellectual property system?

- IP is protected by different laws and mechanisms...



Patent

- A new product, method or process that solves a specific technical problem
- A right granted by a state to an inventor, to exclude others from making, using, selling or importing in the territory without the inventor's consent



Patentability Requirements

- Novelty

 - Prior art

- Inventive Step

- Industrial Applicability

- In exchange for a full disclosure of the invention
- Limited period or exclusivity: 20 years in most countries
- Limited territorial scope

Copyright

- Rights over literary and artistic “**works**”
 - Original
 - Recorded in material form

Conditions for protection

- Arises automatically
- No formalities

Exclusive Rights

Moral rights

attribution

integrity

Economic rights

reproduction

distribution

adaptation

translation

public performance/display

public communication

Idea/Expression

form of expression of ideas

Style

- utilitarian aspects, concepts, formulaic or other non-original elements, colors, subject matter and techniques used to create a work

Duration

- Life of the author + min. 50 years

What is a trademark?

- A sign
- Which distinguishes goods or services of one from those of others

What is a sign?

Very few restrictions on
what can be a sign

- Words
- Designs
- Letters
- Numerals
- The shape of goods or their packaging
- Slogans
- Colours
- Sounds
- Smells
- Gestures
- Taste

Capacity to distinguish

- The sign must be capable of distinguishing the goods or services of one undertaking from the goods or services of another
- A failure to comply with this requirement constitutes an absolute ground for refusal of registration

Passing off

- The action for passing off allows a trader A to prevent a competitor B from passing off its goods as if they were A's.
- The claimant must establish that:
 - They have goodwill
 - The defendant made a “misrepresentation” that is likely to deceive the public
 - The misrepresentation damages the goodwill of the claimant.

What are Trade Secret?

- Secret
- Commercial value
- Subject to reasonable steps to keep it secret

Why Trade Secret?

- No procedural formalities
- Unlimited period of time

What is the Risk?

- If discovered or leaked, it can be used by others.

Breach of confidence

- The information is capable of being protected (i.e. it is not trivial, immoral, vague or in the public domain)
- The defendant owes the claimant an obligation to keep the information confidential (arising either contractually, because of the nature of the relationship or from the manner of communication)
- The defendant used the information in a way that breached that duty

Geographical Indications

What's in your mind when you hear:

- Champagne
- Cognac
- Roquefort
- Chianti
- Pilsen
- Porto
- Sheffield
- Havana
- Tequila
- Darjeeling

What are Geographical Indications?

- A sign used on goods that have a specific geographical origin (**the name of the place of origin** of the goods and/or symbols without literally naming its place of origin).
- Possess **qualities, reputation or characteristics** that are essentially attributable to that place of origin.
- In short, to be distinct due to geographical location.

Why Geographical Indications?

- Identify its source
- Indicate the unique qualities
- Promote the product with a distinguishing name
- Prevent infringement and unfair competition

HOW TO USE IP TOOLS TO PROTECT TK AND TCES?

Existing IP System

- Patent
 - TK based inventions
 - Defensive protection
- Copyright
 - TCEs as such
 - Derivative works (recordings, photographs, films)
 - Performances
 - Compilations and databases
- Trademarks and Geographical Indications
 - Products based on TK/TCEs
- Trade Secret
 - Undisclosed TK

What are the main “Gaps”/ “Disadvantages”? (1)

Patent

- TK based inventions
- A recognized inventor or inventors
- TK which does not fulfill the patentability requirements (such as novelty and inventive step)
- Innovation which is cumulative and collective over generations within the community
- Definite protection (20 years)
- Will be placed in the public domain

What are “Gaps”/ “Disadvantages”? (2)

Copyright

- TCEs as such
- Derivative works
(recordings, photographs, films)
- Performances
- Compilations and databases
- copyright requirement of originality (styles are usually not protected)
- limited term of protection
- need to identify the creator of a work can also pose problems
- performers’ rights will only protect an individual’s performance
- exceptions and limitations allow certain uses by third parties

What are “Gaps”/ “Disadvantages”? (3)

Trade Secret

- Undisclosed TK
- Once discovered by a third party or leaked to the public, it can be used by others
- Difficult to protect against misappropriation

What are “Gaps”/ “Disadvantages”? (4)

Trademarks

Geographical Indications

- Products based on TK/TCEs

- Does not protect TK/TCEs itself/themselves

- Does not prohibit use of TK/TCEs