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…

<table>
<thead>
<tr>
<th>patents</th>
<th>copyright</th>
<th>trademarks</th>
<th>geographical indications</th>
<th>industrial designs</th>
<th>trade secrets</th>
<th>…</th>
</tr>
</thead>
</table>

WIPO
WORLD INTELLECTUAL PROPERTY ORGANIZATION
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**

- Products based on TK/TCEs

**Geographical Indications**

- Does not protect TK/TCEs itself/themselves
- Does not prohibit use of TK/TCEs