

Geneva, March/April 2004

LEVERAGING IP

Creating a Climate for Success



GETTING THE MOST OUT OF YOUR TRADEMARK



COORDINATING EFFORTS ON ENFORCEMENT





WIPO Publishes New Guides for Enterprise

Entrepreneurs, designers and small and medium-sized enterprises (SMEs) can now consult two WIPO publications that explain, using concrete examples, how trademarks and industrial designs can be used to further strategic business goals. The guides, entitled "Making a Mark" and "Looking Good", seek to promote a better understanding of how trademarks and industrial designs can help companies differentiate and customize products for specific market segments, create a new niche market and strengthen their brand image. A copy of "Making a Mark" was inserted in the January/February WIPO Magazine and "Looking Good" has been inserted in this issue. These are the first in a series of new WIPO guides on the theme of "Intellectual Property for Business".

To further enhance the usefulness of these guides, WIPO will be partnering with national institutions to adapt them to the specific law, practice, and business environments of individual countries.

Both guides can be downloaded as PDF documents from WIPO's SME website or may be obtained in hard copy by writing to publications.mail@wipo.int.



WIPO/ITC Guide on the Role of Intellectual Property in Marketing Crafts and Visual Arts

Artisans, craftsmen and visual artists involved in business can now make use of a practical guide, jointly published by WIPO and ITC (International Trade Centre), on how to successfully manage and market their intellectual property (IP) assets. "Marketing Crafts and Visual Arts: The Role of Intellectual Property. A practical guide" provides advice and draws on success stories to demonstrate the relevance of IP and marketing to the commercial activities of artisans and visual artists. The Guide has been published as part of a WIPO-ITC joint initiative to improve awareness of the links between the IP system and successful marketing.

Understanding the market, particularly the behavior of consumers and competitors, is the key to business success. A planned and systematic marketing strategy which integrates the use of tools of the IP system is important in enabling artisans and visual artists to get a fair return on their creativity. The guide attempts to explain principles of IP and marketing by underlining the practical relevance of both and their interdependence in enabling artisans, craft entrepreneurs and visual artists to create and retain a competitive edge in the marketplace and to profit from their creativity, expertise, skills and enterprise through fair means.

"Marketing Crafts and Visual Arts: The Role of Intellectual Property. A practical guide" may be ordered online from WIPO's website at www.wipo.int/ebookshop/ or from ITC's website at www.intracen.org/eshop.

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Geneva,
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INTELLECTUAL PROPERTY AS A LEVER FOR ECONOMIC GROWTH

The Latin American and Caribbean Experience (Part II)

The mind is not a vessel to be filled but a fire to be kindled. – Plutarch

This is the fourth in a series of articles highlighting examples of how intellectual property (IP) is created and leveraged to obtain financial return. Each article concentrates on one of the main regions of the world – this and the previous one on Latin America and the Caribbean and the first two on Africa.

The impetus for the series springs from the fact that most countries are now in possession of a modern intellectual property system; it is impor-

tant that this tool, with such great potential for rewarding national creativity and inventiveness, is recognized as such and used to maximum advantage by individuals and companies – both large and small. This is greatly facilitated if governments also recognize this potential and work towards establishing an “IP culture” – that is, a national environment that respects, values, and encourages creativity and innovation and heightens awareness of the rewards and recognition to be obtained through the IP system.

Creating a climate of success in Mexico

Many countries in Latin America are strengthening their national IP cultures. Of the many elements needed, the allocation of resources dedicated to actively identifying, protecting and marketing IP is one of the most important. For example, the National Autonomous University of Mexico (UNAM) has been IP-aware for many years and its various institutes and faculties have built up a portfolio of more than 130 patents. Already in the 1990s, UNAM established an incubator system for technology and science-based companies with the goal of nurturing the embryonic companies within the system until they are robust enough to operate outside it, helping to commercialize intellectual property generated by UNAM.

A successful outcome of this system is the creation of IBTech, a company established in 1995 within the incubator system. IBTech, which started to operate independently in 1997, specializes in biotechnology and engineering in the field of environmental pollution control. Its activities include the management and re-use of agricultural and municipal waste water as well as waste water from various types of industries – including factories manufacturing such diverse products as confectionery, petrochemicals, potato chips and beer.

IBTech commercially exploits inventions protected by patents held by UNAM for which it is granted non-exclusive licenses. One of these patented technologies is an anaerobic method of treating industrial and municipal waste water, which has been very successful in part because of the low investment costs needed as well as the compactness of the facilities and the simplicity of their operations. IBTech also continues to receive the support of the UNAM's Institute of Engineering, one of the most important research centers in this particular field in Latin America.

IBTech is now involved in research and development (R&D) as well as project management for its clients. Its technological expertise and skilled human resources have allowed it to carve out a share of the market in





Mexico and other countries in the region, including Argentina and Chile.

Through its use of the IP system UNAM has been able to extract benefit from its creativity and contribute to economic growth. By licensing its patented technology, UNAM is able to help finance its own activities as an academic and research body as well as contribute to private sector growth by providing key intellectual resources to companies such as IBTech.

Awareness of the potential of its intellectual resources has led UNAM's Engineering Institute to set up an Intellectual Property Group that has facilitated the protection of IP and the transfer of technology from the University to micro, small and medium-sized enterprises.

Development and commercialization are areas that are often not sufficiently – and sometimes not at all – in focus

when research is viewed through the lens of academia. Many universities and research centers in the region are carrying out cutting edge research in a number of sectors. However, often the technology does not find its way to the market. Increased awareness of the economic benefits to be obtained through the use of the IP system particularly in patenting to leverage the results of this research would help to facilitate its development and commercialization.

The UNAM experience shows the return that can be made by creating the means to transform ideas into viable products via the IP system. It is a good example of technology transfer in which both sides benefit.

Biotech benefits in Cuba

An example of the considerable benefits to be reaped from a national policy of encouraging the growth of creativity (and harvesting its fruits) can

be found in Cuba. For many years the Cuban government has made substantial investments in biotechnology and medical research. This has included the creation of a stable of biotech research centers, almost 40 of which are clustered in a "science park" outside the capital, Havana. These centers are involved not only in actual R&D but also in protecting and commercializing its results¹.

One of the best-known products of Cuban biotech research is the vaccine against meningitis B and C – considered one of the most advanced currently available on the market – developed by the country's Carlos J. Finlay Institute of Serums and Vaccines. Spurred by the need to counter a national public health problem, the development of this vaccine has resulted in a patented product that is earning the country millions of dollars through foreign sales (patents for the vaccine are held in over 15 countries²).

Many other products are proving themselves to be successful income-generators. These include a hepatitis B vaccine patented by the Center for Genetic Engineering and Biotechnology (CIGB) and a new vaccine (the world's first with a synthetic antigen³) against the *Haemophilus influenzae* Type b (Hib) bacteria⁴ patented jointly by the University of Havana and the

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¹ See www.pugwash.org/reports/ees/ees8c.htm

² The Institute has also filed an application under the PCT with respect to the vaccine – PCT publication number WO 2003/105890.

³ The smallest substance antibodies need to recognize so that they can trigger the immune system to take action.

⁴ Hib bacteria can cause infections such as pneumonia and meningitis in very young children; in trials the vaccine gave a 99.7 percent success rate among such children in developing the required antibodies to give protection.

University of Ottawa that went into production in Cuba at the end of last year. The list also includes PPG – a sugar-cane by-product that reduces cholesterol levels – drugs that prevent the rejection of transplanted organs; and an epidermic growth factor used to treat burns, radiation and skin ulcers. On-going research includes vaccines against AIDS and cholera as well as cancer therapy drugs.

The range and quality of the intellectual property of Cuba's biotech sector also attracts attention from foreign researchers and investors. For example, a monoclonal antibody for the treatment of advanced brain and neck cancer (in combination with radiotherapy) that has obtained remission in more than 60 percent of patients in trials was originally a joint venture with a Canadian company. The therapy has now attracted the interest of another foreign company, which is attempting to acquire rights to it.

With some 150 biotech patents in the country and almost 70 in force abroad, and with exports of its products and technologies going to some 50 countries, Cuba has linked scientific skill with IP awareness in order to promote economic growth and further fuel its innovation cycle.

Cuba's considerable success in the biotech field has been achieved by focusing on specific goals and investing in a variety of projects, both short and long term as well as high and low risk. Considerable government in-



vestment both in resources and in providing an environment that encourages and values innovation and creativity have been critical in determining this success.

In addition, an integrated system equips the biotech research bodies to handle everything from research through development and IP protection to marketing and the development of spin-off companies – for example Heber Biotec SA, was set up to commercialize the sector's products, both nationally and internationally⁵.

Protecting its IP rights has also given Cuban biotech enterprises the possi-

bility of forming joint ventures with foreign partners – opening up new markets and increasing economic return. For example, Heber Bioven Sdn Bhd, a Malaysian-Cuban joint venture was set up in October 2002 to manufacture Cuban biotech products in Malaysia for the Asian market. Similarly, the Bangalore-based Biocon India and the marketing subsidiary of the Cuban Center of Molecular Immunology have set up a joint venture – Biocon Biopharmaceuticals Pvt, Ltd – to produce and market Cuban anticancer drugs in India.

⁵ Heber Biotec exports to more than 35 countries and last year the company announced a 42.1 percent increase in its exports for 2001 compared with 2000.

Venturing out with venture capital in Brazil

Biotechnology is also a key area for R&D in Brazil. According to a recent study⁶ 97 biotech patents were filed in the country in the 16 years between 1979 and 1995 but more than 186 were filed from 1996 to 1998.

One contributor to this growing area is FK Biotecnologia S.A., which in 1999 became the first Brazilian biotechnology firm to receive venture capital (both domestic and foreign) for the development of its innovative technologies. Since then, the company has grown at a steady pace and is considered a "pioneering example" of a successful biotech start-up in Brazil.

FK Biotec develops and markets immunodiagnostic kits and currently has over 70 products on its books. This is an area that, until recently, relied on imported products or licensed foreign technology and is fertile ground for domestically developed products. The company is also working in the field of cancer therapy and is developing a cancer vaccine in cooperation with national university research bodies and medical institutions for which an application has been filed under the Patent Cooperation Treaty (PCT)⁷.

Intellectual property protection is an important part of the company's business strategy and an international patent application has been filed un-

der the PCT with respect to the still-experimental cancer treatment. The company has also recognized the value of trademarks in strengthening its marketing strategy by registering trademarks for a range of its products.

The care the company takes in tending to its IP pays off in many ways from brand recognition to attracting investors, including government funding and venture capital. Its awareness of the value of IP extends to patent information data, an often unrecognized resource that the company has used to identify new technologies, niche markets and potential licensors.

Partnerships – key to success

There is increasing recognition within Latin America of the need to use the IP system to protect the results of innovation and inventive activity; however, there is often less recognition of how to exploit ownership of this IP once it is acquired. This is particularly true with respect to public research bodies and universities, in which the research takes center stage and less emphasis is placed on realizing the economic potential of the IP it generates – that is, developing an idea, commercializing it, and bringing actual products onto the market.

The above cases from Latin America show the successful commercialization of technology through IP awareness, the creation of specific implementation mechanisms and collaboration with other organizations. This

includes the setting up of commercial companies and outlets to which IP assets can be licensed as well as the use of those assets as the basis for joint ventures with foreign companies or to attract financing in the form of government funding or venture capital.

Creativity and innovation are key not only in producing IP assets but also in ensuring that their potential for contributing to economic growth is fully realized.



⁶ Ermudez, 2002.

⁷ PCT publication number WO 0177301.

TRADEMARK USAGE: GETTING THE BASICS RIGHT

Imagine a frequent traveler looking for his favorite fast-food chain in a foreign country and finding the restaurant sign, that is always unmistakably bright yellow, looking more like a dark orange. Or a writer buying a new ink cartridge for her printer and noticing something wrong with the label on the package – the writing is somewhat different from what she is used to. These people may wonder: Am I in the right place? Did I buy the right product? Is this my tried and tested brand? At times, companies don't use their trademarks properly and risk confusing or, worse, losing their customers. They may also be jeopardizing the validity of the mark itself and the enforcement of their rights against infringers.

Protecting a trademark begins in-house. Knowing how instrumental a trademark is to developing brand identity and consumer loyalty, businesses should make proper use of their trademark and protect it from being misused by others. Here are some of the do's and don'ts to preserve and even enhance the distinctiveness and value of a trademark over time.



Do set the trademark apart from surrounding text – When referring to a trademark in printed material, always distinguish the mark from the rest of the text by using capital letters, bold, color, italics, underline or quotation marks. This will reduce the chance of the mark being seen as a generic term.

Correct use: After you install the *Windows*[®] operating system...

Incorrect use: After installing Windows programs you can...

Do specify the font (style or typeface), size, proportion and placement of your trademark – If a specific font is used for the lettering, then it should be consistently reproduced especially if the font is an integral part of the registered trademark. Take for example the IBM logo which consists of three grooved capital letters. The font is stylized and when reproduced must match the logo exactly. The letters may either be in white on a blue background or blue on a white background. It also helps to provide guidelines (or develop style manuals) regarding the size, positioning and spatial ratio when reproducing the trademark. This helps maintain a uniform and consistent look and avoids confusing consumers.

Do specify the colors of the trademark – If color is a feature of the trademark, it must always appear in the correct corporate colors and the color version should be used whenever possible. If a third party is given permission to use the trademark, provide

them with color specifications down to the exact 'Pantone' mix that gives the trademark its distinctiveness. If it is not possible to use color – in a newspaper reproduction or because of budget restrictions – specify if and when the monochrome version of the logo can be used.

Do use the trademark as an adjective, not as a noun or verb – It is best to use a trademark as an adjective and avoid using it as a noun. The function of a mark is to distinguish - not to describe - the goods or services produced or provided by one enterprise from those provided by other enterprises. If care is not taken about how a trademark is used, it may eventually become generic. The words "aspirin", "yo-yo", "thermos" and "escalator" were once trademarks that eventually lost their protection because of common use. It is best to say, "make a XEROX copy", not "make a XEROX". The latter phrase would turn the trademark "XEROX" into a replacement term for photocopier. This is risky and also damaging because the company produces other products such as fax machines, scanners, etc.

The same risk is involved if the trademark is used as a verb. For example people often incorrectly say "XEROX this for me" instead of saying "photocopy this for me on the XEROX copier".

To protect a mark, use it as an adjective in association with a generic, descriptive noun. Never use a plural

form of the trademark. Rather than putting the trademark in plural form, it is best to make the nouns that are described by the trademark plural.

Correct: Buy Macintosh computers from authorized dealers

Incorrect: Buy Macintoshes from authorized dealers

Immediate steps to take to avoid erosion of a trademark into a descriptive term and loss of trademark rights:

- ▶ Correct any inadvertent misuse or mistaken reference to the mark appearing in the press or in advertising;
- ▶ Register the trademark as a domain name as soon as possible in all countries of interest to the business;
- ▶ Include a trademark ownership attribution notice in the credit notice section of the product, product documentation, or other product communication, such as advertisements and brochures. The preferred notice is an asterisk (*) and footnote reference of ownership placed after the first mention of the trademark in a running text, it need not be used thereafter.

Do not use a trademark in a possessive form unless the trademark itself is possessive

– In the case of “McDonald’s” the trademark itself is possessive. However, it would be wrong to say, “the BMW’s great comfort”. The correct form would be “the great comfort of a BMW car”. The issue is slightly different in the case of trade names. These are proper nouns that can be used in the possessive form without a generic modifier. Many companies use their trade names as trademarks for example “IBM” is both a trademark of International Business Machines Corporation and an abbreviation of its company name. It is therefore permissible to use the possessive form of IBM when referring to the company.

Do not use the mark as an abbreviation

– The spelling of a trademark should not be modified. Hyphens should not be inserted or deleted, nor words merged. Changes in the form of the mark will confuse the consumer. It would be incorrect to use S/F for STYROFOAM. Abbreviated terms can only be allowed if they constitute registered trademarks of their own – as for **Coca-Cola** and **Coke** – both registered trademarks of the **Coca-Cola** Company.



Coca-Cola

The **Coca-Cola** soft drink was officially registered in the US Patent and Trademark Office in 1893. Early advertising tried to stop people from calling the product **Coke** because the company was afraid that the new nickname would break down the distinctiveness of the mark and contribute to making it generic. But people kept asking for **Coke**. In 1941, the Company started advertising as **Coke** and **Coca-Cola**. Finally, in 1945 **Coke** was registered as a trademark.

Do use a trademark notice in advertising and labeling

– Use of the ® symbol is not compulsory since it does not provide any legal protection. It is used to alert the public that the mark is registered and therefore may discourage others from illegally using the mark. If the trademark registration notice is used, it should appear with the first and most prominent use of the mark in an advertisement or on a label. It is not necessary to repeat the notice each time the mark is mentioned. Generally, the registration symbol is in subscript or superscript. What is most important is that the symbol appears with the name or logo of the mark. It is highly recommended to include trademark notices in advertising or on websites where trademarks receive wide exposure.



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When a trademark has not been registered, the symbol TM (trademark) or SM for an unregistered service mark is placed next to the logo. **Do not use** the registration symbol ® in countries where the mark has not been registered. Trademark rights vary from country to country. There may be severe penalties for the unlawful use of the registration sign.

Do monitor the authorized users of the mark – Monitor licensees, franchisees, authorized resellers, brand owners, developers, designers, advertising agencies, retailers, subsidiaries, customers and other parties allowed to use the mark in promotional, instructional or reference material, or on websites, products, labels or packaging. Control the quality of the goods and services offered under the licensed mark in order to maintain the quality and standard that the trademark stands for. Quality control is particularly important in relation to labels, signs or displays. Be sure that licensees or franchisees do not utilize the mark in a manner that goes beyond the terms of the license agreement; they may create a different consumer opinion of the mark that can have a devastating effect on the overall reputation of the trademark.

Do review your portfolio of trademarks – Every business should conduct an annual review of its portfolio of trademarks to check whether timely action has been taken to (1) register all trademarks in use or proposed to be used; (2) record licensing of a trademark if required under the trademark law; and (3) renew trademark registrations.

What to do if your trademark evolves?

Many trademarks, including some of the most famous, have evolved over the years to modernize the image of the company or to adapt to new advertising media. Take for example the Shell trademark below.

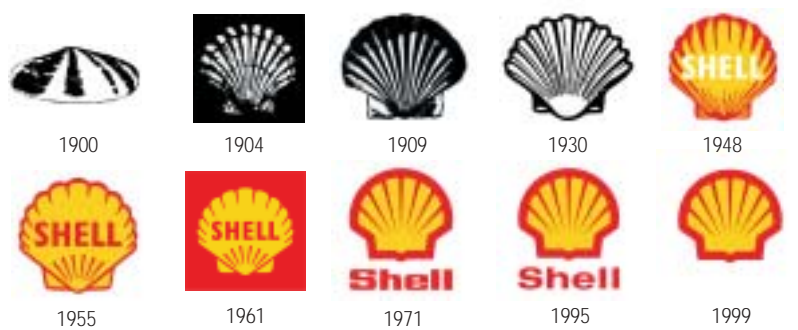
There is no restriction on modifying or adapting marks, but a company would have to consult with the trademark office(s) concerned or a competent trademark agent in order to determine the cost and procedure involved in registering the change. The modification of a trademark should suit the nature of the product and not simply be done for the purpose of modernization as there is always a risk of confusing loyal consumers.

Trademark user manual

It is common practice in many companies to issue trademark usage manuals. Apart from instructions concerning proper use, these manuals usually require a systematic review of information, promotional material and company publications, including annual reports and press releases, to make sure trademarks are presented properly and consistently to the public.

For more information on various practical aspects of the IP system of interest to business and industry, please visit the website of the SMEs Division at www.wipo.int/sme/.

The next article in the IP and Business series will discuss merchandizing.



Further Recommendations to Protect a Trademark

- ▶ Do not allow third party use or registration, in whole or in part, of the trademark or any alteration of it as part of a company name, trade name, product name or service name of another company.
- ▶ Do not allow use of the trademark on or in connection with websites, products, packaging, manuals, promotional/advertising materials, or for any other purpose except pursuant to an express written trademark license.
- ▶ Do not allow use of variations, take-offs, phonetic equivalents, foreign language equivalents or abbreviations of the trademark.
- ▶ Do not allow the manufacture, sale or free distribution of merchandise items, such as T-shirts, mugs, souvenirs, etc. bearing the trademark, except pursuant to an express written trademark license.
- ▶ Do not allow the registration or maintenance of a domain name identical to, or virtually identical, or incorporating a part or the whole of the trademark as a second-level domain name.
- ▶ Do not combine the trademark with trademarks owned by others.
- ▶ Do not allow the logo to be redesigned, compromised or misused in any way. Do not allow any change in the relationship, size, perspective, shape or configuration. Examples of misused logos include reworked proportions, repositioning of logo elements, combining logo with additional elements, stretching logo colors, adding a separate color background to any of the elements, or stretching the logo horizontally or vertically. Do provide an appropriate electronic file or hard copy, reproduction quality art of the logo to partners.
- ▶ Do not use a mark to modify or describe any words other than the appropriate generic, descriptive or chemical name:
Incorrect: STYRON Plant
Correct: The plant that manufacturers STYRON polystyrene.
- ▶ Do not combine or use a whole mark with other design elements, logos or devices, unless the combined mark has received approval for use from the appropriate authority in the company.
- ▶ Do not use a trademark with a developmental/experimental product designation because if that product fails, there is a risk the mark will be tarnished by association. Trademarks are so difficult to clear for use that they should not be placed at risk until the product for which the trademark is intended is moved to full commercial status.

A registered trademark needs to be properly and actively used in commerce to keep the registration valid. Essentially, the right to keep and use a trademark has to be earned through its proper and regular use. Use in commerce means the mark is applied on the goods, containers, packaging tags, labels or displays associated with the goods. The notice of the mark must be given to the consumer/user at the time the product bearing the mark is sold to the consumer. If a company's name is the same as its trademark, use of the company name is not use as a trademark.



COUNTRY FOCUS: MODERNIZING INFRASTRUCTURE IN SAINT LUCIA

Saint Lucia was one of nine Caribbean countries to sign a landmark multilateral agreement with WIPO last November to promote the use of intellectual property (IP) as a tool for economic growth and social benefit. Saint Lucia's Registry of Companies and Intellectual Property (ROCIP), which was formally opened on September 27, 2000, will act as the focal point for all activities to be undertaken as a result of the Agreement.

Prior to the establishment of ROCIP, IP matters in Saint Lucia fell under the direct supervision of the Registry of the Supreme Court and were handled by a single staff member. Today, with nine staff members, the ROCIP is still a small office and must prioritize its efforts. Over the past three years the country has modernized and improved its IP system; however the human constraint meant that ROCIP could only concentrate on one area at a time. They chose to work first on trademark legislation, then on regulations for industrial design, geographical indications and layout-designs, and are today addressing patent regulations.

While updating legislation took precedence, the Registry could also see the importance of upgrading and adjusting to the new business environment. The user community was acquiring increasing knowledge of the options for protecting their works and the Registry had to be able to satisfy their demands if it was to encourage investment and stimulate economic growth. The ROCIP Registrar, Mrs. Kimberly Cenac-Phulgence, outlined the twofold objective of the Registry: "To maintain a customer-oriented department by providing efficient administration and timely registration of companies, business names, partnerships and intellectual property, and to create an awareness of matters relating to those areas throughout Saint Lucia." This has meant significant technical improvement, staff development and extra effort to reach out to the public.

Customer orientation

ROCIP's early focus on customer service is yielding results. The Registry has decreased processing time for applications and has created a conducive environment to assist those seeking information. With the assistance of WIPO, trademark processing at the Registry has been completely automated. The system installed allows for better administration, processing and tracking of trademark applications. Trademarks, which sometimes took over a year to process, are now completed within five or six months (when there are no oppositions). The public also has access to a new search room where they can carry out their searches in comfort.

Such changes required the setting up of new procedures and processes and were admittedly a challenge for the new Registry. Many stakeholders were resistant to the changes and it took significant efforts – communicating, explaining, and demonstrating – to get them to appreciate the need for change. New staff members also had to be trained and given assistance with the automated system. Two benefited from a study visit to the Barbados Corporate Affairs and Intellectual Property Office and four others completed the WIPO Worldwide Academy Distance Learning course, DL-101.

Customers at the Registry have noticed the difference. Mrs. Nathalie Glitzenhirn-Augustin, an attorney with Glitzenhirn, Augustin & Co, com-



Courtesy of ROCIP

PCT seminar participants at ROCIP

The ROCIP has already faced quite a challenge in modernizing the country's antiquated intellectual property (IP) infrastructure in just over three years, and was instrumental in Saint Lucia's successful completion of the review process under the Agreement on Trade-Related Aspects of Intellectual Property Rights before the World Trade Organization in 2001.

ments, "With the implementation of regulatory procedures under the Trade Marks Act 2001, practitioners in Saint Lucia are now able to expand their practices and provide a more professional service to IP service seekers in particular. The staff is in tune with the purpose of the service they provide to users of the Registry, allowing for efficient and friendly service."

Mr. Tyrone Chong, an attorney at Chong & Co, adds, "One can immediately appreciate the timely manner in which documents are now being processed and the ease with which documents can now be located."

The recently-installed patent module of the system, although not yet in full use, is a welcome addition to the office tools. However, the Registry and its users still see areas in which efficiency gains can be made. "The Registry still needs to standardize certain procedural matters so that users have a fair idea of what will be acceptable," notes Mr. Chong. The Registry continues to have in-house training sessions to deal with new areas, legislation and for problem-solving. ROCIP is also looking forward to further cooperation with WIPO in view of achieving full computerization of processes as well as online filing.

Creating awareness

The second part of ROCIP's two-fold objective is to create a vigorous and strong IP culture in Saint Lucia to stimulate creativity and thus economic growth. The Registry does this on various levels, creating awareness through seminars, exhibitions and presentations, the use of WIPO publications and a public outreach program for secondary schools. ROCIP also makes good use of the local media, publishing newspaper articles and participating regularly in discussion programs on radio and television. The steady increase in IP inquiries at the office is a definite sign of growing awareness.

A key element of building an IP culture is teaching respect for IP rights. ROCIP has addressed this through its public education program on piracy. A month after it opened, the Registry hosted a "Copyright Awareness Week" during which radio and panel discussions were held, a newspaper supplement was published on copyright, a seminar held on software piracy and another on copyright enforcement, together with an exhibition. The local collective management society, Howanorra Musical Society (HMS), also cracked down on record shops engaged in piracy. The Registry's initiative showed clear results as vehicles known to sell pirated CDs suddenly disappeared from the streets. ROCIP persists in its outreach efforts in this area, as the level of piracy in Saint Lucia is still a cause for concern.



Courtesy of ROCIP

Mrs. Marva Hazell, Assistant Registrar, showing the in-house display set-up for World IP Day 2003

In April 2003, ROCIP, stimulated by the encouragement and material received from WIPO for World Intellectual Property Day, extended its outreach to new areas. That month the Registry started a pilot outreach program at a secondary school in Saint Lucia. The WIPO multimedia CD "At Home with Invention" was used to make IP come alive to the teachers. Based on the response of the pilot program, ROCIP hopes to continue with other schools in 2004. IP reading material was also made available to the Ministry of Education, Human Resource Development, Youth and Sports for dissemination to the primary schools on the island.

The Registry followed this up by organizing numerous activities during the week of April 26 for World Intellectual Property Day. The office held an exhibition, published newspaper ar-

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Customs and police officers attend a seminar on enforcement at ROCIP



Courtesy of ROCIP

ticles, presented a series of radio shows featuring all aspects of IP, broadcast WIPO videos on television, and collaborated with UNESCO in observing World Book and Copyright Day on April 23. The Registry, HMS and UNESCO participated in a discussion on national television on "The detrimental impact of piracy on national creativity" and held a panel discussion in the central library on "Nurturing and fostering national creativity for economic development."

The Registry faces a challenge in its outreach activities as it lacks certain technical resources, particularly when it comes to making external presentations. As a solution, the Registry uses promotional material supplied by WIPO and borrows equipment when needed. Installation of the WIPONET KIT has helped. To further its outreach, ROCIP is planning to establish an Internet presence and will work toward that goal this year.

Results

The Registry reports healthy revenue figures – revenue from trademarks, especially from publication fees, has increased significantly since the coming into force of the Trademark Act. No assessment has been made as to whether the current revenues suffice for the Registry to be self-sufficient; however, they will be in the near future when the Patent Act enters into force and outstanding patent fees are collected.

The coming into effect of the Technical Cooperation Agreement between many Caricom Governments and WIPO will provide a defined framework within which cooperation for development can be managed. It will facilitate the inclusion of all parties in

the definition of what is to be achieved. The ROCIP expects that this movement away from *ad hoc* and short-term activities towards long term development planning will permit a more holistic and integrated development of the IP sector. Additionally, through the process of regular evaluations, both WIPO and States party to the agreement will be able to effect positive adjustments designed to respond to changing circumstances.



Trademark Registration Statistics

Year	Registrations
2000	436
2001	518
2002	470
2003	446*

*Actual filings decreased in 2003 due to the fact that multi-class filing was permitted as of that year.

PCT RECEIVING OFFICE MARKS ITS TENTH YEAR

WIPO's Patent Cooperation Treaty (PCT) Receiving Office (RO/IB) recently celebrated its tenth anniversary. The RO/IB mainly carries out similar procedural functions to other receiving offices, such as according a valid filing date to the international application, collecting the relevant fees from the applicant, transmitting a copy of the international application to other authorities, etc. However, the RO/IB has an extended mandate, which allows applicants from all PCT contracting States to file international patent applications with it.

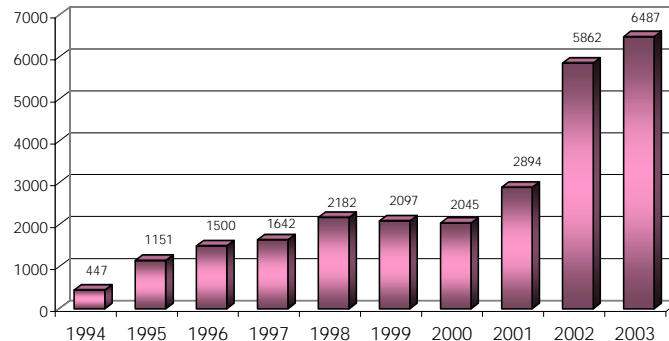
This peculiar and unique feature of the RO/IB seems to be the overriding factor for consideration by applicants that file international applications with the RO/IB. The fact that these applicants can file international patent applications directly with the RO/IB irrespective of their status as determined by place of residence or nationality is just one of the more salient features of the RO/IB.

Advantages of the RO/IB for PCT users

An applicant who files using the RO/IB can also benefit in the following areas:

- ▶ **language versatility** - international applications may be filed in *any* language, however the "request" part of the application must be in a PCT-approved language of publication;
- ▶ **access to more international authorities** - a broader choice of potential international searching and preliminary examination authorities is made available to applicants from different PCT contracting

No. of applications received by RO/IB



States who file an international application at the RO/IB;

- ▶ **agent representation** - the applicant may have a wider choice of professional agents to represent him if he uses the RO/IB: all persons with the right to practice before the national offices of the relevant PCT contracting States (as determined by applicant's nationality/residence), may also qualify to do so before the RO/IB.

Growth and evolution of the RO/IB

The RO/IB launched operations ten years ago with just two staff members and one supervisor. In its first year, it processed approximately 500 PCT applications. At present, approximately 6,500 applications are received annually by the RO/IB, handled by 13 staff member and one – the same – head of section. The graph above illustrates the increase in filings since the inception of the RO/IB.

The flexibility offered by the RO/IB has attracted a worldwide clientele as well as local Geneva-based enterprises such as Moltech Invent and Firmenich, a prominent multinational company and world leader in flavor-

ing and perfumery innovation. Some other companies that use the RO/IB include Pfizer, the first American client of the RO/IB, and the Dutch-based company Philips, currently the most frequent PCT user.

Quality assurance

The success of the RO/IB also lies in its commitment to customer service. It provides a crucial entry-point into WIPO as the essential first link in a dynamic operational sequence. Achieving exacting standards demands a high level of dedication and hard work from the RO/IB staff. The RO/IB examiners set the pace and determine efficiency for further work down the line. They provide the first point of contact that the customer has with the RO/IB and a ready source of direct, person-to-person advice and assistance.

The RO/IB has achieved a high degree of excellence in the ten years of its existence. This is attributed largely to the flexibility of its mandate and the consistently high standard of staff output, which make it an attractive option for use by innovators globally.

NEW ONLINE DATABASE ON PROTECTED EMBLEMS



Coat of arms of the Austrian Federal Province of Tirol



Armorial ensign of Malta, Vertute et Constantia



Emblem of the Pacific Community



The Singapore Lion

WIPO recently launched a new online database of emblems and signs that enjoy protection under Article 6ter of the Paris Convention for the Protection of Industrial Property. The new database, named "Article 6ter Express", is part of the WIPO Industrial Property Digital Library (IPDL), and can be accessed free-of-charge.

Since 1883, Article 6ter of the Paris Convention enables countries to have their armorial bearings, flags and other State emblems as well as official signs and hallmarks indicating control and warranty adopted by them, protected against unauthorized registration or use as trademarks. Moreover, following the revision of the Paris Convention in 1958, this protection is also available for the names, abbreviations, emblems and flags of international intergovernmental organizations.

It is important to note that protection under Article 6ter is not a substitute for trademark registration, but prevents certain signs from being used by private parties as trademarks. The protection is not available for private organizations such as non-governmental organizations (NGOs).

Communication Procedure under Article 6ter

Protection of a given sign under Article 6ter is subject to a communication procedure administered by WIPO. Requests for protection are forwarded by WIPO to all States party to the Paris Convention as well as to all members of the World Trade Or-

ganization (WTO). Regarding WTO members, the communication is made by WIPO under an Agreement between the two Organizations, which is of particular importance for those WTO members that, without being actually party to the Paris Convention, have to comply with the provisions of that Convention by virtue of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS).

Once a State has received a communication under Article 6ter, it must make it available to the public. The competent authorities of the States bound to comply with Article 6ter often include Article 6ter notifications in their trademark search files. Where an application for registration of a trademark conflicts with a sign protected under Article 6ter, that application may be rejected or, if the mark was registered despite the conflict, the registration may be cancelled later on. Here, the new database presents a much-welcome complement to the current system of notification and publication. Although – strictly speaking – the publication of a communication by the competent authorities of a State continues to be necessary, the database provides a quick and complete overview of all signs so far communicated under Article 6ter whose use or registration as trademarks is prohibited.

The database currently contains 1,204 signs corresponding to 116 notifications made by States party to the Paris Convention, and 117 notifications made by international intergovern-

mental organizations. A notification consists of a reproduction of the sign or signs for which protection was requested as well as a reproduction of the circular note sent by WIPO to Member States of the Paris Convention and members of the WTO not party to the said Convention, and setting out details concerning the requesting state or organization and the sign or signs for which protection is sought.

Nature of Protection

The degree of protection of a certain sign under Article 6ter varies according to its nature. Whereas protection for State emblems, flags and armorial bearings of States pertains to unauthorized use or registration of trademarks for any goods, protection of other signs envisaged by Article 6ter such as official hallmarks adopted by States, or names, abbreviations, emblems and flags of intergovernmental organizations is only available where unauthorized use of those signs would be misleading.

The Article 6ter Express database may be accessed at www.wipo.int/ipdl/en/index.jsp. General information on Article 6ter is published under www.wipo.int/article6ter/en/index.html.

ENFORCEMENT – COORDINATING EFFORTS

Many countries have passed legislation for the enforcement of intellectual property rights (IPRs) in the last ten years. However, legislation on its own does not suffice; a formal strategy to implement the enforcement of IPRs is an absolute necessity. The effective enforcement of IPRs also requires cooperation at both the international and national levels. Thus many countries face quite a challenge to define a strategy to implement their IPR enforcement legislation, and to overcome the major stumbling block caused by the lack of cooperation at both the international and national levels. WIPO Member States, holding the view, that enforcement activities should be coordinated for improved results, created the WIPO Advisory Committee on Enforcement (ACE) in October 2002 to provide support in this area.

ACE is responsible for global IPR enforcement issues with as principal objectives:

- ▶ coordination with certain organizations and the private sector to combat counterfeiting and piracy; and
- ▶ public education and assistance, to coordinate national and regional training and to exchange information.



Lesotho meeting participants worked through the break period, studying material and discussing areas for further cooperation

Coordination – international level

In its efforts to coordinate enforcement activities at the international level, WIPO has joined forces and cooperated with Interpol's Intellectual Property Crime Action Group and the World Customs Organization (WCO) IPR Strategic Group.

Currently, for example, WIPO is collaborating with Interpol, WCO and the private sector, to arrange the Global Congress on Counterfeiting, which is scheduled for May 25 and 26 in Brussels. The Organization is also cooperating with other intergovernmental organizations as well as a number of non-governmental organizations, including the European Commission,

the Global Anti-Counterfeiting Group (GACG) and the International Anti-Counterfeiting Coalition (IACC), in order to share expertise and experiences in the field of the enforcement of IPRs.

Efforts at the national level

Most of the cooperation carried out by WIPO at the national level emphasizes public/private partnerships in order to make enforcement activities more effective and meaningful. WIPO views the commitment and cooperation of all stakeholders – government, both at the policy and operational level, industry, legal profession, academic institutions, etc. – as essential to the successful implement-

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tation of an IPRs enforcement strategy. As many countries are experiencing similar problems in the implementation of IPRs enforcement, WIPO undertook a pilot project on enforcement in South Africa in November 2003. The project shows the direction WIPO is taking as per ACE's objectives.

The South Africa Counterfeit Goods Act of 1997 vests power in three government entities:

- ▶ the Department of Trade and Industry (*the dti*), which has an enforcement unit as part of consumer protection activities and is responsible for the administration of the Act;
- ▶ the South African Revenue Services (SARS), which is responsible for border enforcement (customs); and
- ▶ the South African Police Services (SAPS).

These three parties as well as other government departments such as Health and Justice, private sector representatives, WIPO, and the GACG participated in the "Consultation Meeting on Enforcement" held in Pretoria. The meeting objectives were to review the existing legislative framework, to formalize a coordinated strategic approach on IPRs enforcement for both the public and private sectors; to assess needs in the area of training and awareness raising as cornerstones in the fight against counterfeiting and piracy; and to determine other priority areas in this fight.



Mrs. Amanda Lotheringen and Ms Lana van Zyl, both from the National Inspectorate, Consumer Affairs Committee, the dti, Mrs. Louise Van Greunen, WIPO, Commissioner Jackie Selebi, South African Police, and Commissioner Hans Meiring, Commercial Crime Unit

Discussions underlined some core problems participants experienced with the legislation. For example, the Johannesburg Metro Police mentioned that they sometimes have problems identifying the appropriate legislative framework under which to prosecute, and the Public Prosecution Authority mentioned that they sometimes have problems with implementation. On the positive side, the meeting revealed that private/public partnerships have already taken place although no formal framework has been set up. Representatives of the Department of Health and the pharmaceutical industry mentioned that they have established an effective Pharmaceutical IP Crime Action Group. They, along with the customs service, are also in the process of developing written training guidelines for enforcement agencies.

Under the heading "Private Sector Enforcement Initiatives", the Southern African Federation Against Copy-

right Theft explained their activities pertaining to customs seizures, flea markets and street vendors. The Federation noted that, despite huge seizures, the market is still flooded with counterfeit goods, which emphasizes the need for more cooperation with other copyright industries, SAPS, SARS and *the dti*.

The meeting underscored the importance of a legislative framework with procedures that could readily be implemented; the need for organizational measures such as the establishment of dedicated units, focal points and formal cooperation structures to include all the role players in order to obtain meaningful results in the area of enforcement; the benefits to be derived from public/private partnerships; the necessity of improved inter-agency intelligence sharing; the continued need for training and capacity building of customs, police and judicial officials involved in enforce-

ment; the importance of addressing “emerging” issues including increased infringement activities over the Internet; and the key role of public awareness and education activities in building support for effective enforcement, while “presenting the facts” to the public for them to understand the seriousness of IP crimes and their significant socio-economic effects.

Due to the political will of the South African Government, cooperation of the private sector, and the assistance of WIPO and the GACG, the meeting succeeded in sensitizing stakeholders to the realities behind the struggle against counterfeiting and piracy. It convinced those present of the importance of effective and rigorous enforcement for socio-economic development and consumer protection. The work will continue in three committees:

- ▶ the **Legislation Committee** to review the complete applicable legislative framework under which to act, including to make proposals on amending the Counterfeit Goods Act;
- ▶ the **Strategic Approach Committee** to make recommendations on formalizing cooperation structures between the stakeholders; and
- ▶ the **Training and Awareness Raising Committee** to make suggestions on future training and awareness raising campaigns for the short, medium and long terms, indicating target groups at various levels, beginning at the school level right through to the public and private sectors.

The level of commitment to the enforcement of IPRs was demonstrated by the response of the Commissioner of Police when informed of the outcome of the meeting and the future cooperation that would be necessary with the police department: The Commissioner agreed with the request that the training curricula for the ranks of sergeants and above be expanded with training materials on counterfeiting and piracy. He called for further development of curricula so that every policeman in the South African Police Force would be trained to participate in the fight against counterfeiting and piracy. The customs services also committed not only to cooperate on an inter-department and national level, but also in training and awareness activities in the framework of regional cooperation. This was reinforced one week later in a sub-regional seminar on the enforcement of IPRs in Lesotho when a link to handle enforcement issues in the English-speaking African countries was created.

The pilot project in South Africa has created a ripple effect on enforcement issues throughout Sub-Saharan Africa. As one country takes up the fight, it stimulates the bordering country to join in its efforts. The Lesotho meeting, carried out in cooperation with the WIPO Economic Development Bureau for Africa, in December defined areas for future cooperation and work and should lead to further projects in other countries and regions.



EFFORTS TO STAMP OUT CYBERSQUATTING CONTINUE

Efforts by WIPO to combat the abusive registration of trademarks as domain names or cybersquatting made significant headway in 2003, although the problem persists, most notably for high-value brands around the world. Since December 1999 when the Uniform Domain Name Dispute Resolution Policy (UDRP) went into effect through to the end of 2003, WIPO's Arbitration and Mediation Center handled some 6,000 disputes, covering 10,000 domain names.

The number of cases filed daily with WIPO is now less than in the early days of the UDRP, however, as emphasized by WIPO Deputy Director General Francis Gurry, continued effort is needed to ensure that the rights of legitimate trademark owners are not diluted. "Reducing the practice of cybersquatting is an important element in enabling the Internet to develop as a secure and reliable environment which inspires confidence on the part of the ever-growing number of Internet users," he observed. "The fact that over 80 percent of the WIPO expert decisions went in favor of the trademark holder, be it a large multinational corporation or a small or medium-sized business, underlines the bad faith inherent in this practice," Mr. Gurry further noted.

In 2003, the Center received 1,100 UDRP cases, averaging three cases per calendar day, similar to the daily filing rate during the previous year. While this is clearly an improvement compared to the five daily filings the Center received in the early days of the UDRP, it remains significant.

Cybersquatters broaden their target

In addition to famous brands (recent WIPO cases include the domain names *pepsi-smash.com*, *calvinklein-watches.com*, *rolexgroup.com*), celebrities continue to be targeted by cybersquatters. Often their winning cases were based on common law rights in their names rather than on a registered trademark. In 2003, the Center received cases relating to movies, authors and books (*jrrtolkien.com*, *thecatinthecat.com*), pop stars (*nsyncfilm.com*, *utadahikaru.com*), television shows (*oscartv.com*, *operaciontriunfo.tv*), and movie stars (*piercebrosnan.com*, *victoriarowell.com*). Sports personalities (*terrellowens.com*) and sporting events (*torino2006.net*, *madrid2012.org*) were also the target of cybersquatters.

Companies involved in recent or prospective mergers also fell prey to cybersquatters. The Center has recently dealt with cases involving domain names such as *yellowroadway.com*, *japanairgases.com*, *konicaminolta.net*, *astrazenica.com*, which were all newly created following recent or predicted mergers.

Using the UDRP

The UDRP is designed specifically to discourage and resolve the abusive registration of trademarks as domain names. Under the UDRP, a complainant must demonstrate that the disputed domain is identical or confusingly similar to its trademark, that the respondent does not have a right or

legitimate interest in the domain name and that the respondent registered and used the domain name in bad faith.

Fact Sheet on the WIPO Arbitration and Mediation Center

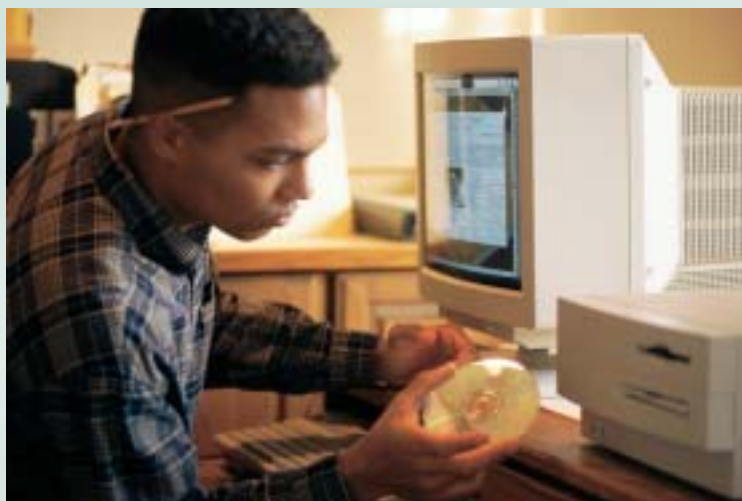
- ▶ In 2003, the Center dealt with 56 cases involving country code top-level domains (ccTLDs), a 40 percent increase over the previous year. Cases dealt with by the Center have included the domain names *bodyshop.as*, *nutella.bz*, *amazon.com.cy* and *yahoo.ph*. The Center now provides services for disputes in 36 ccTLDs. As of March 1, the Center also started to provide services under a new dispute resolution procedure which applies to the Swiss *.ch* domain.
- ▶ The Center's experts are frequently called upon to decide cases that involve high-value brands. They have resolved cases involving 66 of the 100 largest brands by value, including seven of the top 10 such brands (Interbrand Brand survey 2003).
- ▶ The Center's services are multinational and multilingual. So far, parties to WIPO UDRP disputes have come from 116 different countries. In 2003, the Center added three languages (Dutch, Italian and Russian) to the nine case languages it has used to date, namely, Chinese, English, French, German, Japanese, Korean, Norwegian, Portuguese and Spanish. Domain



MEMBER STATES TAKE STOCK OF AUTOMATION PROJECTS

names themselves may also be presented in different scripts, such as Chinese, Cyrillic or Korean. The Center has handled 36 such “multilingual name” disputes so far.

- ▶ All domain name decisions handled by the Center are fully indexed and published on the Center's website (arbitr.wipo.int/domains/search/index.html).
- ▶ In addition to its domain name activities, the WIPO Center is increasingly called upon to provide arbitration and mediation services for all types of intellectual property disputes, such as disputes involving patent, trademark or copyright licensing. For this purpose, the WIPO Arbitration and Mediation Center makes available model arbitration and mediation clauses which can be downloaded from its website at arbitr.wipo.int/arbitration/contract-clauses/index.html.



The WIPO Standing Committee on Information Technologies (SCIT), meeting in Geneva from February 23 to 27, endorsed the Organization's commitment to using information technologies to promote greater efficiency in delivery of intellectual property (IP) services worldwide. The SCIT's participants underlined the importance of WIPO's efforts to automate the IP offices of developing countries and countries in transition in enabling effective delivery of IP services.

During the meeting WIPO presented a progress report on various automation initiatives which aim to facilitate administrative and business procedures, electronic publication of IP information and the handling of statistical data within all intellectual property offices (IPOs). The Organization further encouraged its Member States to take full advantage of the services that were being made available.

The Committee reviewed the status of ongoing IT projects including:

WIPO_{NET} – This initiative has reached its final stages of deployment. Some 103 offices have benefited from the computer equipment and training made available under this project. It is anticipated that the 14 remaining offices requiring WIPO_{NET} deployment will be fully operational by late spring. Statistics reflect consistent growth in the use of WIPO_{NET} as deployment progresses and this is expected to continue. Day-to-day operational responsibility of the WIPO_{NET} components deployed in IPOs will gradually be transferred from WIPO to those offices in the interests of the network's long-term sustainability. A number of countries reported on the benefits of WIPO_{NET} in terms of enhancing their administrative and business procedures and called upon WIPO to continue to actively enrich and develop the services available through the WIPO_{NET} platform, particularly in relation to database sharing.

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Interconnection of IP Networks – (WIPO_{NET}, TriNET and Patnet): The SCIT expressed broad support for the interconnection of these networks which will further enable global access to, and exchange of, IP data. This in turn should facilitate patent searches and generate cost-savings. WIPO, the United States Patent and Trademark Office (USPTO), the Japan Patent Office and the European Patent Office (EPO) host these three networks.



Automation of IPOs – The Committee was informed of the new focus given to this area and the new strategic approach that has resulted in concrete deliverables. In the 2002-2003 biennium, a total of 155 automation assistance activities were carried out in 72 Member States ranging from advice and guidance to comprehensive automation solutions including completion of automation projects in 24 IPOs. A technical support structure and training program form an integral part of the new approach.

Patent Cooperation Treaty (PCT) Information Systems – PCT-SAFE: The full deployment of the PCT-SAFE (“Secure Applications Filed Electroni-

cally”) system in February 2004, means that applicants from all of the PCT’s 123 Member States may file their international applications electronically with WIPO at a reduced fee of up to 300 Swiss francs.

PCT CLAIMS is a set of computerized administrative tools supporting the reform and revision of the International Patent Classification (IPC). CLAIMS is expected to be fully deployed by the end of June 2004 and covers a range of activities including the setting-up of a master classification database in cooperation with the EPO and the development of advanced tools for the sharing and searching of highly reliable patent classification information. Work on the further automation of the processing of international patent applications under the PCT continues to make steady progress. WIPO is seeking, as a matter of priority, to put into place systems that will enable paperless processing of PCT applications through the establishment of electronic dossier facilities.

The next session of the SCIT will take place from February 21 to 25, 2005.

SCIT Working Group Takes Steps to Ease Use of IP Information

In a meeting held a month earlier, from January 26 to 30, the SCIT’s Standards and Documentation Working Group (SDWG) took the decision to revise certain standards associated with the recording, storage, exchange and retrieval of patent, trademark and industrial design information. These standards facilitate access to and use

of the rich pool of publicly available industrial property information associated with the grant of patents, trademarks and industrial designs. This will make it easier for users of the intellectual property system to access prior-art information, which is critical in determining the patentability of an invention.

The SDWG adopted a revision of WIPO Standard (ST.10/C) regarding the bibliographic data components of patent documents, in particular the presentation of priority application numbers. Priority application numbers are attributed to applicants by industrial property offices. This number establishes priority over any rival applications from that date and also marks the beginning of the period of validity of the patent itself. The priority application number appears in the notification of the first filing, and in the certificates of priority under the Paris Convention for the Protection of Industrial Property.

Applicants cite priority application numbers when filing a subsequent application for the same or related subject matter with another industrial property office in accordance with the Paris Convention. The priority application number can then be used by industrial property offices to link all related patent document “families” together in databases and computerized search systems. The ability to create patent families is of tremendous value to users of the industrial property system as they enable patent examiners to review previously published patent documents in a given language, if available. Patent families facilitate the patent classifica-

The Automation of Intellectual Property Offices (IPOs)

WIPO provides demand-driven automation assistance to developing countries, least developed countries and countries in transition in the general framework of cooperation for development policies. The components of a full automation project include:

- the provision of the IP automation kit (network, server, up to four workstations, printers, scanner, Anti-Virus and standard desktop software, etc.);
- customization of the WIPO software;
- establishment of a national IP database;
- on-site training of the IPO staff;
- problem reporting and technical support;
- post-deployment monitoring and impact assessment; and
- free upgrades of the new releases of the software.

The full implementation of an automation project could take between three to six months, with about three weeks dedicated to the onsite deployment of the WIPO software and training of IPO staff. At the end of deployment, the IPO is able to start receiving new IP applications online and performing all the steps that are required for processing them using the new system. Once successfully deployed, ownership of the system passes to the IPO for the day-to-day operation and administration of the system.

tion process by allowing industrial property offices to use the classifications of one patent family member for all members of the patent family. These and other uses of patent families make the accurate recording of the priority application number by applicants a critical concern of all industrial property offices.

The Working Group also agreed to revise standard (ST.80) relating to bibliographic data components of indus-

trial designs. This revision was necessary for the implementation of the 1999 Act of the Hague Agreement Concerning the International Registration of Industrial Designs; and, in particular, will enable unambiguous publication of the announcements appearing in the International Designs Bulletin. The 1999 Act, which seeks to enhance the existing system of international protection for industrial designs, entered into force on December 23, 2003, and will become operational on April 1, 2004.

The SDWG also reviewed progress in the preparation of proposals to revise WIPO Standards relating to trademarks and agreed to give priority to the establishment of two new standards. The first relates to a standard for the electronic management of the figurative elements of trademarks. The second, concerns an Extensible Markup Language (XML) standard for the electronic external process and exchange of trademark data which is to be developed in close cooperation with the Expert Group of the Office for the Harmonization in the Internal Market (European Union) which is discussing a similar standard.

A Task Force to renew the WIPO *Handbook on Industrial Property Information and Documentation*, the authoritative guide to WIPO Standards was also established. The Handbook, which provides information on various matters concerning patents, trademarks and industrial designs, is a reference for the industrial property information and documentation community.

The SDWG agreed that a proposal for a new XML standard in the field of patents would be presented for consideration at the next session of the Working Group from November 8 to 12.



FOUNDATION LAID FOR PROTECTION OF TRADITIONAL KNOWLEDGE

The WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC), meeting in Geneva from March 15 to 19, took concrete steps to accelerate international work on the protection of traditional knowledge (TK) and folklore (or traditional cultural expressions (TCEs)). The Committee members agreed on the development of the building blocks for the protection of TK and expressions of folklore.



This was the first IGC meeting since its mandate was renewed by the WIPO General Assembly in October 2003, with instructions to accelerate its work and focus on the international dimension of intellectual property (IP) and genetic resources, TK and folk-

lore. The new mandate excludes no outcome for the IGC's work, and raises the possibility for the development of an international instrument or instruments in this field.

During its meeting, the IGC commissioned the development of two complementary sets of core materials for TK and for folklore/TCEs. In each case, the IGC approved the development of an overview of policy objectives and core principles for protection, and an outline of the policy options and legal mechanisms,

backed up by precise analysis of the implications of each option. This would form the essence of substantial outcomes of the Committee as an international framework for protection of TK and TCEs. The African group of countries submitted a text on objectives, principles and elements of an international instrument, or instruments. This proposal received widespread support in the Committee as a framework for its work.

The need to enhance the participation of indigenous and local communities in the work of the Committee continued to be a central concern – this was the first issue taken up by the IGC at this session. The IGC accredited ten additional non-governmental organizations (NGOs), nine of which directly represent indigenous interests or communities, bringing the total to over 90 NGOs specially accredited to the IGC. The Committee also considered a range of practical steps to enhance the participation of representatives of TK holders, and launched a new website to disseminate position papers of IGC observers that would enhance awareness of the perspectives and concerns of TK holders.

The need for practical support, in the form of funding of participation, was identified as a major impediment to effective participation. The IGC agreed to look at possible structures for a distinct voluntary fund to overcome this hurdle. In the meantime it appealed to voluntary donors immediately to support the participation of representatives of accredited NGOs representing indigenous and local

communities, so they can take part both in the IGC and in a consultative forum for indigenous and local representatives to be held in advance of IGC meetings.

Among the practical issues the IGC addressed were strengthening the defensive protection of TK and genetic resources against illegitimate patenting. It initiated work on improving understanding of the legal and practical basis of defensive protection, to strengthen its understanding of how different traditional knowledge systems, including orally-based knowledge systems, can be recognized and applied in the patent examination process. The IGC also considered a draft guide to assist custodians of genetic resources in negotiating effectively to safeguard their interests in relation to the intellectual property system, and called for comments and input for an enhanced draft.

The secretariat of the Convention on Biological Diversity (CBD) reported to the IGC on the recent meeting of the Conference of Parties of the CBD (COP), including the positive reception given to a technical study on patent disclosure requirements relating to genetic resources and TK which WIPO had prepared as an information resource for the COP. The COP recently invited WIPO to undertake further work in this area. Because the proposed work cut across the mandate of several WIPO bodies, the IGC suggested that the invitation be referred to the WIPO General Assembly for coordinated action.



CASES STUDIES on the use of Intellectual Property by Indigenous Communities



On the first day of the IGC, WIPO released a collection of practical case studies on the use of the intellectual property system by indigenous communities in Australia. The publication, entitled, "Minding Culture: Case Studies on Intellectual Property and Traditional Cultural Expressions", was written for WIPO by Ms. Terri Janke, an Australian lawyer and a descendant of the Meriam people of the Torres Strait Islands, Australia.

The publication will guide the work of WIPO on how the intellectual property system can respond to the needs and expectations of the custodians of traditional cultures and knowledge. It therefore contributes to a process of exploration, dialogue and policy development aimed at enhancing the protection, promotion and preservation of traditional creativity and expressions of traditional cultures (or 'expressions of folklore'). The case studies provide traditional communities, as well as policymakers, legislators and other stakeholders, with realistic, empirically-based options and new ideas for future policy development.

During the WIPO fact-finding missions in 1998, many indigenous communities called for more practical information, based on actual cases, on the usefulness and the limitations of intellectual property in relation to traditional knowledge and cultural expressions/expressions of folklore, particularly information reflecting the perspectives and experiences of indigenous peoples. This publication responds directly to that request.

'Minding Culture' gives actual examples of how industrial designs, copyright and trademarks have been used by indigenous Australian communities to protect and promote their artworks, cultures and identities, as well as their economic interests. The case studies point out where traditional communities found existing systems useful and where they were found inadequate. The studies convey the suggestions of these communities for policy and practical measures that could improve the protection of traditional cultural expressions by intellectual property.

The case studies show that current intellectual property laws can operate to meet the needs of indigenous communities and individuals, and shows how legal concepts have been adapted and extended to respond to these needs. For instance, trademark and unfair competition laws have been used by indigenous communities to safeguard the authenticity of arts and crafts; copyright protection is available for contemporary tradition-based art; indigenous designers have received industrial design protection; and the courts have accommodated claims for the recognition of communal rights and cultural interests, the application of customary laws and the development of culturally-sensitive remedies. The studies point out that non-intellectual property measures (such as customary laws, contracts and protocols, cultural heritage preservation programs and marketing and trade practices laws) also play a role in securing comprehensive and effective protection, so that the intellectual property system need not operate in isolation.

The publication feeds directly into the ongoing deliberations of the IGC. Along with the experience of many other countries and communities, the practical examples, options and suggestions it contains have already begun to be integrated into the working documents on legal and policy options for the protection of traditional cultural expressions/expressions of folklore prepared for the IGC's consideration. The case studies provide a solid, empirical platform for the IGC's further policy development.



WIPO AND MPA DISCUSS VALUE OF COPYRIGHT INDUSTRIES

The economic and cultural value of copyright industries and the need to stem digital piracy around the world were the focus of discussions between WIPO Director General Kamil Idris, and the Motion Picture Association (MPA) Chairman and Chief Executive Officer Jack Valenti at WIPO headquarters on February 10. Dr. Idris and Mr. Valenti, a key figure in the fight against intellectual property theft, also stressed the importance of effective enforcement measures to ensure the growth of cultural industries.

Dr. Idris and Mr. Valenti agreed on the economic importance of the copyright sector and the need to raise public awareness about copyright issues. "Copyright industries have enormous potential in promoting the economic development of a nation, in enriching our daily lives and in safeguarding national cultural traditions," Dr. Idris said. "WIPO is committed to strengthening the international copyright system and to promoting more effective protection, development, use and management of literary and artistic works to ensure that all countries are in a position to capitalize on their creative assets and cultural industries."

Mr. Valenti thanked Dr. Idris for WIPO's work in promoting effective copyright standards and increasing awareness about the value of intellectual property. "The World Intellectual Property Organization is playing a key role in the digital revolution that will bring access to creative expression and cultural diversity within the grasp of every citizen around the



Photo: Mercedes Martínez Dozal

Dr. Idris presents Citation for Distinguished Service to Mr. Valenti

world," he said. "Each and every one of us has an enormous stake in maintaining and even strengthening the incentives to create intellectual property, and we appreciate Dr. Idris' leadership role in that endeavor."

Mr. Valenti highlighted the importance of WIPO's activities in assisting its Member States to strengthen systems for enforcement of intellectual property rights. He noted that all sectors that rely on intellectual property protection face huge losses from increased digital piracy, and urged governments to join forces with industry in the fight against this trend. While visiting WIPO, Mr. Valenti met with ambassadors from several countries in Europe, Asia and the Americas whose film industries contribute significantly to economic health and job creation.

In recognition of Mr. Valenti's efforts in promoting and developing the motion picture industry worldwide, Dr. Idris presented Mr. Valenti with a WIPO Medal and a Citation for Distinguished Service. Mr. Valenti has been President and Chief Executive Officer of the Motion Picture Association of America (of which the MPA is the international arm) since 1966. He is a member of WIPO's Industry Advisory Commission (IAC), which is composed of senior representatives of industry and advises the Director General on intellectual property issues from the perspective of the industry and market sectors.



NEWS
ROUNDUP

A New Working Language for Trademark Registration

As of April 1 users of the international trademark system can file applications in Spanish, in addition to English and French, thereby removing language as a barrier to more Spanish-speaking countries joining the Madrid Protocol for the International Registration of Trademarks.

WIPO Assistant Director General Ernesto Rubio remarked, "The introduction of Spanish as a working language of the Madrid Protocol heralds a new era in international trademark protection." He added, "It gives an added incentive to hispanophone countries to join Spain and Cuba, the only two Spanish-speaking countries currently in the system, and paves the way for its wider use, making it a truly global registration system." Mr. Rubio said, "In today's global marketplace, trademarks play a key role, particularly in the field of export promotion and WIPO's international trademark registration services offer a quick, easy and cost-effective way to obtain trademark protection in multiple countries".

In the first quarter of 2004, the Madrid system saw a 12.5 percent growth in use as compared with the same period (January-March) in 2003. Prospects for further growth of the Madrid Protocol are promising owing to recent developments, such as its entry

into force in the United States of America (U.S.A.) in November 2003, the country with the largest international trademark activity. In its five months as a Member of the Madrid Protocol, the U.S.A. joined the top ten users of the Madrid Protocol. The European Community has also declared its intention to join the system this year.

The Madrid Agreement and Protocol also entered into force in the Islamic Republic of Iran on December 2003. To raise awareness of the Madrid system among Iranian trademark owners and agents as well as to train experts and staff of the Industrial Property Office, WIPO held two training sessions in that country in January. Such efforts to promote the system in new Member Countries will lead to further growth in coming years.



Madrid seminar
in Iran

WIPO received 23,872 trademark applications under the Madrid system in 2003. This represented a three percent increase over 2002. By the end of 2003, some 412,000 international trademark registrations, belonging to over 134,000 different trademark holders, were in force in the International Register. Those international registrations represented the equivalent of some 4.9 million national registrations, taking into account that, as an average, each international registration extends its effects to some 12 designated countries.

WIPO/Francophonie Cooperation

WIPO and the *Organisation internationale de la Francophonie* (OIF) representatives, meeting at the end of 2003 to review the scope of cooperation activities during the past year and to study ways to extend these in 2004, identified two areas for further collaboration. The first concerns universities, for which both organizations have developed initiatives, which would benefit from the building of synergies. The second is in the area of traditional knowledge (TK) and expressions of folklore, where the OIF is interested in keeping abreast of the work done by WIPO, and to consider activities of common interest relating to the valuation of economic assets of cultural industries.

Discussions also led to the decision to further triangulate cooperation activities, as much as possible, with the *Organisation africaine de la propriété intellectuelle* (OAPI), whose member states are mostly French-speaking.

International Patent Filings Exceed 110,000 for Third Year Running

The number of international patent applications filed in 2003 using the Patent Cooperation Treaty (PCT) exceeded 110,000 for the third consecutive year, with users from the United States of America (U.S.A.) topping the list. Applicants from Japan clinched the second place over Germany for the first time in over a decade. The PCT is the cornerstone of the international patent system and offers a rapid, flexible and cost-effective route to obtaining patent protection in the 123 countries that have signed up to the system.

International patent applications received from developing countries in 2003 saw an 11 percent increase. The Republic of Korea topped the list with 2,947 applications, followed by China (1,205), India (611), South Africa (376), Singapore (313), Brazil (221) and Mexico (123). Both India and the Republic of Korea saw a double-digit increase in their use of the PCT, experiencing 27.3 percent and 15.5 percent increases, respectively.

The top ten users of the PCT from developing countries include: LG Electronics (Republic of Korea), Samsung Electronics Co. Ltd. (Republic of Korea), Council of Scientific and Industrial Research (CSIR) (India), Huawei Technologies Co. Ltd. (China), Ranbaxy Laboratories Ltd. (India), LG Chem Ltd. (Republic of Korea), Hetero Drugs Ltd. (India), CJ Corporation (Republic of Korea), Electronics and Telecommunications Research Institute (Republic of Korea), Young Suk Son (Republic of Korea) and ZTE Corporation (China).

Malawi Awards US\$10,000 Royalty Check

At the end of 2003, the Copyright Society of Malawi (COSOMA) awarded a check of 1 million Malawi Kwacha (equivalent to US\$10,000) to a Malawian best-selling musician from mechanical rights fee collections from one single album for the period between July and November. This event was considered a breakthrough, illustrating the economic importance of copyright and collective management, and how the IP system can be used for wealth creation in all countries.

WIPO Awards Inventors from Iran and Mali at Geneva Fair



Mrs. Maryam Sabooni Asre Hazer

WIPO presented two awards to inventors at the Geneva International Exhibition of Inventions as part of the Organization's commitment to promoting innovation and recognition of inventors worldwide. The distinctions were presented for the best invention by a woman and the best invention by a national from a developing country. This is the twenty-fifth consecutive year in which WIPO has presented awards at the Geneva fair.

Mrs. Maryam Sabooni Asre Hazer, an Iranian national, received an award for the invention of a natural, 100 percent cotton-based, fire-resistant insulating material called SATEX which replaces asbestos and is safer for both humans and the environment. The second award went to a Malian inventor, Mr. Gaoussou Traore, for the invention of a construction process using blocks of agglomerated concrete that serve as "H" or "HH" shaped moulds for earth to make shuttering for adobe (earth).

CALENDAR of meetings

MARCH 1 TO 5

GENEVA

Committee of Experts of the IPC Union

The Committee will consider amendments to the seventh edition of the IPC proposed by the IPC Revision Working Group and will discuss remaining tasks of the IPC reform in preparation for the publication of the next edition of the IPC.

Invitations: As members, the States members of the IPC Union; as observers, States members of the Paris Union, which are not members of the IPC Union, and certain organizations.

MARCH 4 AND 5

GENEVA

Seminar on the Madrid System of International Registration of Marks

This Seminar, in English, aims to increase awareness and practical knowledge of the Madrid system amongst trademark agents who use or will use the system, whether in industry or in private practice. These Seminars are held regularly every year, both in English and in French.

Invitations: Registration is open to all interested persons, subject to the payment of a registration fee.

MARCH 15 TO 19

GENEVA

Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (Sixth session)

The Committee will continue its work based on the results of its fifth session and on the renewed mandate established by the General Assembly, and

will prepare the interim report requested by the General Assembly for its consideration at its next session.

Invitations: As members, the States members of WIPO and/or the Paris Union, and the European Community; as observers, certain organizations.

APRIL 26 TO 30

GENEVA

Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) (Twelfth session)

The Committee will continue its work on the revision of the Trademark Law Treaty (TLT), and on other issues based on the results of the eleventh session.

Invitations: As members, the States members of WIPO and/or the Paris Union; as observers, other States and certain organizations.

MAY 3 TO 7

GENEVA

Working Group on Reform of the PCT (Sixth session)

The meeting will consider proposals for the reform of the PCT system.

Invitations: As members, the States members of the PCT Union and the International Searching and Preliminary Examining Authorities under the PCT; as observers, all States members of the Paris Union which are not members of the PCT Union and certain organizations.

MAY 10 TO 14

GENEVA

Standing Committee on the Law of Patents (SCP) (Tenth session)

The Committee will continue its discussion on a draft treaty on harmoni-

zation of certain provisions of patent law and practice. **Invitations:** As members, the States members of WIPO and/or of the Paris Union; as observers, other States and certain organizations.

JUNE 7 TO 11

GENEVA

Standing Committee on Copyright and Related Rights (Eleventh session)

The Committee will continue its discussions on the protection of broadcasting. It will also discuss topical copyright issues.

Invitations: As members, the States members of WIPO and/or the Berne Union, and the European Community; as observers, certain intergovernmental and non-governmental organizations.

NEW PRODUCTS

Hague Agreement Concerning the International Registration of Industrial Designs - Common Regulations and Administrative Instructions (as in force on April 1, 2004)

English No.269(E), French No.269(F)
15 Swiss francs (plus shipping and handling)

Patent Cooperation Treaty (PCT) and Regulations Under the PCT (as in force from January 1, 2004)

English No.274(E)
20 Swiss francs (plus shipping and handling)

Madrid Agreement Concerning the International Registration of Marks and its Protocol - Regulations and Administrative Instructions (as in force on April 1, 2004)

English No.204(E), French No.204(F), Spanish No.204(S)
20 Swiss francs (plus shipping and handling)

Looking Good - An Introduction to Industrial Designs for Small and Medium-sized Enterprises

English No.498(E)
Free of charge

Créer une marque - Initiation aux marques pour les petites et moyennes entreprises

French No.900(F), Spanish No.900(S)
Free of charge

Guide to the Copyright and Related Rights Treaties Administered by WIPO and Glossary of Copyright and Related Rights Terms

English No.891(E)
55 Swiss francs (plus shipping and handling)

Minding Culture - Case Studies on Intellectual Property and Traditional Cultural Expressions - Study 1

English No.781(E)
30 Swiss francs (plus shipping and handling)

National Experiences with the Protection of Expressions of Folklore/ Traditional Cultural Expressions - Study 2

English No.912(E)
15 Swiss francs (plus shipping and handling)



Marketing Crafts and Visual Arts : The Role of Intellectual Property - A Practical Guide (WIPO/ITC)

English No. ITC/P159

40 Swiss francs (plus shipping and handling)

Guide of the International Registration of Marks under the Madrid Agreement and the Madrid Protocol

English No. 455(E), French No. 455(F)

60 Swiss francs (plus shipping and handling)

Guide of the International Registration of Industrial Designs under the Hague Agreement

English No. 857(E)

35 Swiss francs (plus shipping and handling)



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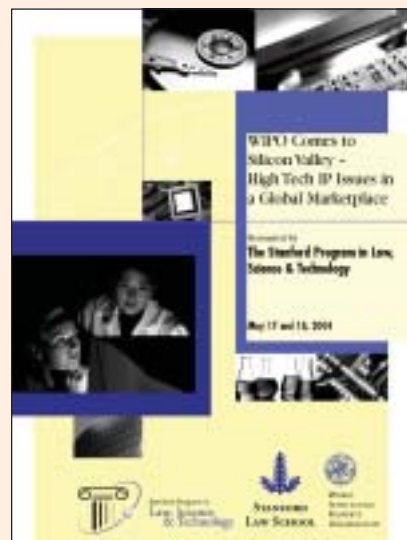
WIPO Comes to Silicon Valley – High-Tech IP Issues in a Global Marketplace

Stanford Law School, May 17 and 18, 2004

The World Intellectual Property Organization (WIPO) and Stanford University are joining forces to bring to the fore issues relating to intellectual property and its growing importance in technology and today's knowledge driven economies. The conference will address current issues relating to intellectual property. These include the international patent and trademark systems administered by WIPO, alternative dispute resolution services of WIPO, and its work relating to patent law harmonization. Domain names, software and biotechnology patents, protection of genetic resources, and the link between public health and intellectual property are among the session topics.

The event will bring together participants from Silicon Valley's high technology industries and venture capital community, patent and trademark practitioners, academics, and members of the public.

For further information, please consult WIPO's website at: www.wipo.int/meetings/2004/stanford/.



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If you are interested in receiving copies, contact:

**Marketing and Distribution Section
WIPO
34, chemin des Colombettes
P.O. Box 18
CH-1211 Geneva 20,
Switzerland
Fax: 41 22 740 18 12
e-mail: publications.mail@wipo.int**

For comments or questions, contact:
The Editor
WIPO Magazine (at the above address)

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For more information contact WIPO at:

Address:
*34, chemin des Colombettes
P.O. Box 18
CH-1211 GENEVA 20
Switzerland*

Telephone:
41 22 338 91 11
FAX:
41 22 740 18 12

e-mail:
wipo.mail@wipo.int

or its New York Coordination Office at:

Address:
*2, United Nations Plaza
Suite 2525
New York, N.Y. 10017
United States of America*

Telephone:
1 212 963 6813
Fax:
1 212 963 4801
e-mail:
wipo@un.org

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