

## Negotiating for the United States

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### Introduction

The TRIPS Agreement introduced a new foundation for IP agreements. Through the TRIPS Agreement, WTO members established minimum standards for the protection of the broadest range of IP ever addressed in a single agreement and broke new ground with the acceptance of norms for domestic enforcement of IPRs. The Agreement forged new and stronger connections between trade policy and other domestic policies, including enforcement and competition policy, and, for the first time, IP issues were subject to an effective international dispute settlement mechanism.

The negotiations on the TRIPS Agreement presented significant challenges for the trade and IP communities. Negotiators tackled a wide array of new and difficult issues, for example, defining and recognizing rights in “undisclosed information” and establishing norms on domestic enforcement of IPRs. Trade negotiators and IP experts had to learn each other’s policy perspectives and language, and officials from some United States (US) agencies became participants in a trade negotiation for the first time. Congress and private sector groups were key drivers in the US negotiating process.

During the negotiations, developed countries, including Canada, Japan and the United States, as well as the European Communities (EC), pursued objectives between themselves, including major issues related to copyright, such as rental rights, moral rights and contractual rights, patentability of agricultural chemicals and pharmaceuticals, and trademarks and geographical indications (GIs). Often, the most difficult issues to resolve in the negotiations were those arising between these major trading partners. For their part, developing countries sought recognition of the need to achieve transfer of technology and prevent abuse of IPRs, and some developing countries, such as India, pursued affirmative objectives in the negotiations on issues such as copyright and GIs.

As discussed below, the TRIPS Agreement reflects pragmatic compromises with regard to achieving various objectives and the timing for implementation of results. While negotiators were able to produce an agreement that achieved key objectives for many participants, some issues remained to be resolved. Time and technology have diminished the significance of some of the issues that were left outstanding from the TRIPS negotiations, others have been addressed in other negotiations, but some still remain and many new issues involving the interface of IP with other issues have arisen.

This chapter sets out a personal perspective on the negotiations – the initiation of negotiations in the context of the GATT, US objectives for certain issues, the negotiating process and the results of that process. The TRIPS Agreement has now been in effect for 20 years. WTO members face new issues, such as the connection between IPRs and standards-setting and licensing practices and whether too much protection can prevent innovation, prompting policy makers to consider maximum as well as minimum levels of protection. The chapter concludes with a few brief observations on the IP issues that are currently demanding the attention of policy makers.

## **Accepting IP as an issue for negotiation in the GATT**

### ***A patchwork of multilateral obligations and increases in trade in counterfeit goods***

Prior to the TRIPS Agreement, multilateral disciplines on the protection and enforcement of IPRs were the subject of international treaties, most of which were negotiated and administered under the aegis of WIPO. Texts of the two principal treaties, the Paris Convention for the Protection of Industrial Property (Paris Convention) and the Berne Convention for the Protection of Literary and Artistic Works (Berne Convention), dated back to the nineteenth century. As of 1986, some GATT contracting parties did not participate in these and other IP treaties or adhered to an early version of the relevant treaty. The United States, for example, did not become a party to the Berne Convention until March 1989. Chile, Colombia and India – and several other contracting parties – were not parties to the Paris Convention, and Canada applied the 1938 version of Articles 1–12 of that Convention.<sup>2</sup> These and other international IP treaties were based in part on national treatment and, in some cases, permitted parties to require reciprocity as a condition for a particular right. The scope and terms of protection for new technology, such as computer programs and biotechnology, had not been established. While the GATT (1947) included a few references to IP, for example,

Articles, IX, XVIII and XX, these provisions did little to address core IP issues, such as lack of consistency in the level of protection, weak standards and uncertainty over the protection of new technologies.

During the 1970s and 1980s, governments saw a surge in both the development of new technologies – such as computer software and biotechnology – and international trade, including trade in counterfeit and pirated goods (counterfeit goods). IP owners faced significant difficulties in enforcing IP rights, in particular in obtaining remedies that deterred infringement.

During the Tokyo Round (1974–9), the United States and some other GATT contracting parties began negotiations on an Agreement on Measures to Discourage the Importation of Counterfeit Goods (Anti-Counterfeiting Code). Participants failed to conclude negotiations on the Anti-Counterfeiting Code during the Tokyo Round, but intensified efforts before the 1982 GATT ministers' meeting. Faced with resistance from some developing countries regarding whether the GATT was the appropriate forum for negotiating and concluding an Anti-Counterfeiting Agreement, ministers instructed the GATT Council to:

[E]xamine the question of counterfeit goods with a view to determining the appropriateness of joint action in the GATT framework on the trade aspects of commercial counterfeiting and, if such joint action is found to be appropriate, the modalities for such action, having full regard to the competence of other international organizations.<sup>3</sup>

The draft Anti-Counterfeiting Code included requirements for parties to provide owners of trademarks the means to initiate procedures to protect rights against imported counterfeit goods, and some of the principles and language of the draft Anti-Counterfeiting Code can be found in the border enforcement section of the TRIPS Agreement. While the United States considered the draft Anti-Counterfeiting Code ready to conclude in 1985, action on the Code and addressing IP more generally in the Uruguay Round of multilateral trade negotiations continued to face resistance from some delegations as ministers met at Punta del Este to decide on initiating the Round.

### *Developments in the United States*

In the 1980s, a wide spectrum of US industries that rely on IP protection were working to strengthen the link between access to the US market and whether a country provided adequate and effective protection and enforcement of IPRs.

The first tangible result of their efforts was seen in the Trade and Tariff Act of 1984 (1984 Act). That legislation included protection and enforcement of IP as a criterion for evaluating whether a country should receive preferential market access under the US Generalized System of Preferences (GSP). The 1984 Act also spelled out that denial of adequate and effective IP protection and enforcement was an unreasonable act, policy or practice within the meaning of Section 301 of the Trade Act of 1974. That provision authorizes the President (and subsequently the US Trade Representative) to take action to address unreasonable acts, policies or practices that burdened or restricted US commerce.

In 1985, President Reagan delivered remarks endorsing the initiation of a new round of negotiations, including on IPR. Subsequently, the Reagan Administration issued a White Paper on IP and initiated investigations under Section 301 in regard to the Republic of Korea's IP regime and Brazil's treatment of computers and computer software (Informatics). The United States was sending a strong message that maintaining access to its market was linked to having adequate IP protection.

Achieving a strong agreement on IPR in the Uruguay Round negotiations was a top offensive objective for the United States. The United States saw IP as the future for US high-tech industries and economic growth, and industry was able to identify significant economic harm resulting from lack of protection and enforcement of IPRs. In addition, US policy makers believed that including IP in the Uruguay Round negotiating package and achieving an outcome that set the stage for increased trade in IP-based goods would build support for the results of the Round as a whole, and help overcome domestic objections to a result that addressed sensitive issues for the United States, such as textiles, safeguards and anti-dumping.

In 1988, after a three-year effort, Congress enacted the Omnibus Trade and Competitiveness Act of 1988 (1988 Act), which provided guidance to US negotiators on objectives for the Uruguay Round negotiations, including on IP and dispute settlement.<sup>4</sup> The 1988 Act also included a provision known as Special 301. Based on a statutory requirement to identify countries that denied adequate and effective protection and enforcement of IPRs or market access for goods embodying IPRs, the Office of the US Trade Representative and other agencies developed a process for reviewing IP regimes of other countries and used it as a mechanism to organize and prioritize bilateral engagement on IP issues.

Starting in 1989, the United States began an intensive process of review and engagement with its trading partners on trade-related IP issues. US objectives in the TRIPS negotiations were one of the benchmarks used in evaluating partners' IP standards and enforcement. Before and during the Uruguay Round negotiations, the United States successfully engaged with its trading partners as part of its GSP process and under Special 301 to obtain improvements in IP protection in other countries. For example, Singapore enacted improvements to its copyright law and Korea strengthened its protection of copyrights, patents and trademarks. In the TRIPS negotiations, Special 301 was the target of repeated objections and claims of unilateral action intended to improve the negotiating position of the United States. Special 301, and actions the United States took under it, provided motivation for those delegations seeking to prevent unilateral trade actions as reflected in proposals in the TRIPS and dispute settlement negotiations.

## **Status of TRIPS in the Uruguay Round negotiations**

### *The early years, 1987–8*

The mandate for the TRIPS negotiations was one of the last elements of the Punta del Este Ministerial Declaration to be resolved. The TRIPS negotiating mandate consisted of three paragraphs, including the instruction that the “negotiations shall aim to clarify GATT provisions and elaborate, as appropriate, new rules and disciplines”. Negotiations were to aim to develop a multilateral framework of principles, rules and disciplines dealing with trade in counterfeit goods, taking into account work already undertaken in the GATT. Finally, the negotiations were not to prejudice other “complementary initiatives” in WIPO.<sup>5</sup>

Under the TRIPS work plan that the GATT Council adopted in February 1987,<sup>6</sup> the Negotiating Group spent innumerable hours debating the scope of the Group's mandate. At the same time, however, many delegations engaged in an internal process of determining objectives and educating trade experts on IP issues. In the early stage of the negotiations, the United States, the EC, Switzerland, Thailand, the Nordic countries, Brazil and other delegations submitted general papers setting out views on the scope and nature of negotiating objectives and how they should be achieved. The GATT and WIPO Secretariats produced documents on the status of protection of various IPRs and enforcement.<sup>7</sup> Reflecting its view that the Anti-Counterfeiting Code was ready to sign in 1987, the United States proposed that GATT contracting parties sign the Code and reap an “early harvest” for the negotiations. Delegations did not take up that proposal,

and the debate continued until April 1989 over whether it was appropriate to include anything more than provisions related to importation of counterfeit goods in the GATT and, if so, what types of provisions should be subject to negotiation.

In October 1988, the United States submitted to the TRIPS Negotiating Group a detailed proposal on standards for IP protection and enforcement to be included in a TRIPS agreement.<sup>8</sup> The proposal included legal text on standards for the protection of patents, trademarks, copyrights, trade secrets and integrated circuits, as well as on civil and criminal enforcement of those rights. Descriptive language addressed the issues of dispute settlement, national and most-favoured nation (MFN) treatment as well as international cooperation. Other delegations also submitted general proposals. This proposal and those from other delegations, including from the EC, Japan, and Switzerland,<sup>9</sup> which followed in 1989, provided the necessary building blocks for the substantive negotiations.

### *After the mid-term review, 1989–93*

In April 1989, as part of the Montreal mid-term review, ministers resolved that negotiations could include substantive provisions on IP protection and enforcement. Ministers agreed, *inter alia*, that negotiations would continue and encompass:

- the applicability of the basic principles of the GATT and of relevant international IP agreements or conventions;
- the provision of adequate standards and principles concerning the availability, scope and use of trade-related IPRs;
- the provision of effective and appropriate means for the enforcement of trade-related IPRs, taking into account differences in national legal regimes;
- the provision of effective and expeditious procedures for the multilateral prevention and settlement of disputes between governments, including the applicability of GATT procedures;
- transitional arrangements aiming at the fullest participation in the result of the negotiations.

Ministers also agreed that the negotiations would include consideration of the “underlying public policy objectives” of national systems for the protection of IP, “including developmental and technological objectives”.

In addition, negotiations were to include the development of a multilateral framework of principles, rules and disciplines dealing with international trade in counterfeit goods.

Another key element of the Ministerial Declaration was agreement that the negotiations were without prejudice to views concerning the institutional aspects of the international implementation of the results and that this would be decided at the end of the negotiations. The TRIPS Negotiating Group maintained work on international trade in counterfeit goods as a separate agenda item until the end of the negotiations, which resulted in duplicative and often overlapping drafts on this issue.

### *Work done in parallel with the TRIPS negotiations*

The delay in reaching a consensus to engage in detailed, text-based negotiations had both immediate and longer term benefits for the negotiating process. Trade and IP experts had the opportunity to become familiar with their respective IP regimes and policies, assess other participants' objectives for the TRIPS negotiations and identify their own objectives and sensitivities. The EC, for example, needed the time to obtain a mandate on negotiating IP standards and thus focused its initial efforts on enforcement, where it had competency.

During this period, the WTO Secretariat produced a number of factual papers that informed the negotiations and helped identify gaps in IP protection and enforcement under existing international IP agreements. The Chair of the Negotiating Group, Ambassador Lars Anell of Sweden, began a process of meeting with individual delegations and groups of delegations to encourage candid exchanges of views, and then providing reports on those meetings to the broader group to provide transparency in the negotiations.

Delegations began meeting in various groups to exchange views and build support for proposals. At the early stages of the negotiations, a group of like-minded contracting parties (the Friends of Intellectual Property group) started meeting and discussing core issues. Switzerland and the United States hosted seminars on existing IP standards and domestic enforcement regimes, which improved the negotiators' level of knowledge on IP and related trade issues. All of these initiatives built confidence in the process and strengthened relationships between negotiators as well as with the Chair and Secretariat. As the negotiations progressed and delegations tackled the many "hard" issues between them, groups often formed and reformed based on the particular issue under negotiation. During

the later stages of the negotiation, work among the “Quad” countries (Canada, the EC, Japan and the United States) was often the most contentious. On some issues, one or more of the Quad countries would share the views of some developing country delegations and form the core of support for, or opposition to, a particular proposal. For example, the United States and India shared views on aspects of copyright protection, while Canada and India opposed some of the US proposals on patents.

During 1987–8, industry groups engaged intensively with their counterparts in other countries to reach a consensus on the substance of a comprehensive agreement on IP in the GATT. Independent groups, such as the Intellectual Property Committee and the IP Task Force of the US Chamber of Commerce, produced specific recommendations for negotiators. In particular, the Intellectual Property Committee, the Keidanren of Japan, and the Union of Industrial and Employers' Confederations of Europe (UNICE) issued a common statement of views in their *Basic Framework of GATT Provisions on Intellectual Property: Statement of Views of the European, Japanese and United States Business Communities*, in June 1988. While this statement assumed that an IP agreement in the GATT would be a code, many of the principles and ideas expressed in this document provided useful guidance on the business communities' perspective and what disciplines they could support, thus providing a better foundation for the intensive negotiations that commenced in earnest in the spring of 1989.

### **Summary**

As of April 1989, negotiations on IP standards and enforcement requirements began in earnest after more than 10 years of debate over whether even more limited disciplines could be appropriate to include in the GATT. A multitude of reasons, ranging from progress on other trade issues to domestic politics, likely contribute to the explanation of why delegations agreed to negotiate a broad, substantive IP agreement. Among those reasons, I would highlight the growing concern of governments and industry regarding IP issues and the determination of some, in particular the US Government, to take trade action to address those concerns. Further delay or refusal to negotiate on issues such as IP meant risking market access. The emphasis that some delegations placed on dispute settlement—generally, and in regards to the TRIPS Agreement—also supports the view that some participants in the TRIPS negotiation now recognized that enforceable disciplines could provide a shield against unilateral action. Changes in IP or more general economic policies have been mentioned as reasons for the change in position on IP negotiations. That said, while GATT contracting parties agreed that

negotiations on substantive standards and enforcement requirements could move forward, delegations reserved the right to assess the entire package and what, if any, IP disciplines would be implemented in the GATT.

## **Objectives, negotiations and results**

### *General observations*

With over half of the announced negotiating period for the Uruguay Round having expired, TRIPS negotiators engaged in intensive work in the run-up to the ministerial meeting in Brussels in December 1990. In May 1989, delegations asked the Secretariat to produce a synoptic table of submissions from delegations regarding substantive standards for the protection of IPRs. This approach was replicated with enforcement issues, as well as for proposals focused on addressing trade in counterfeit goods. At the participants' direction, the Secretariat left nothing out of the synoptic table and its revisions. This provided a good format for delegations to see the degree of divergence on each issue and encouraged drafting that narrowed that divergence.

In the spring of 1990, the EC, the United States, a group of 14 developing countries, Switzerland, Japan and Australia each submitted detailed proposals including specific standards for the protection and enforcement of IPRs.<sup>10</sup> The US submission was the product of months of internal work, including input from a wide range of agencies that had a direct or indirect stake in protection or enforcement of IPRs. While the United States had consulted intensively with the EC and other delegations, significant divergences existed on several subjects, including copyright and neighbouring rights, GIs and some aspects of patent protection.

In June 1990, the first consolidated text was produced for discussion. Six successive bracketed texts were produced between June and November 1990, along with countless "room documents" that delegations circulated as part of the discussions. Negotiators made progress on areas where delegations agreed in principle on substance and wording was the main issue. With essential guidance from the Chair, the process of reaching agreement on language that delegations could "live with" ensued. Based on these intensive negotiations, in November 1990, the Chair of the TRIPS Negotiating Group provided a text that was incorporated into the comprehensive text for the Brussels ministerial meeting. The IP text was incomplete as several critical issues remained unresolved, including patent and copyright issues and dispute settlement. While the Brussels ministerial meeting concluded with an impasse on several issues, in particular on those

related to agriculture, the Uruguay Round negotiations resumed in 1991. On TRIPS, delegations met almost non-stop to address the remaining issues, many of which were the most difficult and contentious. At the end of the year, the Chair circulated a proposed text that delegations were asked to evaluate and accept as part of the final Uruguay Round package. As with the other draft texts developed in the TRIPS negotiations, the Chair circulated it on his own responsibility. In some cases, the Chair proposed solutions, such as the language in Article 27.1 on non-discrimination in enjoyment of patent rights and the transition periods, and asked delegations to decide whether they could live with the proposal. The text that the Chair circulated at the end of 1991 became the TRIPS Agreement with only two changes. In 1992, negotiations on the overall Uruguay Round package were suspended until delegations were able to address key obstacles in the agriculture negotiations. In 1993, when the TRIPS and other Uruguay Round negotiations resumed, the United States presented five proposals to address concerns expressed in the United States about the text, which were not accepted. The Negotiating Group did adopt two US proposals to limit the grounds for issuing a compulsory licence on a patent for semiconductor products and to adopt a moratorium on non-violation disputes on IP issues.

### *Comments on the negotiating process*

The negotiations concerning the TRIPS Agreement and the text that evolved from those negotiations reflect certain axioms that, in my view, apply generally. The fact that the TRIPS Agreement and its negotiating process are consistent with these axioms may help explain why the TRIPS Agreement changed the IP landscape and became an important part of the WTO Agreement.

The first axiom is that all participants in the negotiations need to benefit from something in the package. In this case, that package could be within the TRIPS Agreement itself or the larger Uruguay Round package. In the Uruguay Round package, these benefits varied, but most were linked to market access, such as increased market access for textiles and agriculture, improved protection and enforcement of IP, which would promote exports of IP-based goods and licensing of IP, or market access for services. The package also included a mechanism to enforce rights and obligations, which helped induce implementation and provided some safeguards against unilateral action.

Second, each participant needs to prioritize its objectives and be willing to make changes in its own regime – even somewhat difficult ones. That was certainly the case for the United States in the context of the TRIPS negotiations. Some of the

changes that the United States made to implement the TRIPS Agreement were controversial. For example, in the copyright area, changes to US law related to Article 18 of the Berne Convention were the subject of domestic litigation that was not resolved until 2014, when the US Supreme Court decided that the relevant change in US law did not violate the US Constitution.<sup>11</sup> The legislation implementing Article 33 (Term of Patent Protection) as applied to pre-existing patents also provoked controversy and litigation in the United States. The United States also amended Section 337 of the Tariff Act of 1930, which involves enforcement of IPRs at the border, in the legislation implementing the results of the Uruguay Round negotiations. These changes had been subject to intensive debate for nearly five years.

At an appropriate point in the negotiations, delegations need to engage in a realistic assessment of potential outcomes. With regard to “must achieve” objectives, the successful pursuit of such an objective likely depends on its nature. Does the objective require a change to a country’s domestic law or practice that is consistent with the overall direction of a country’s system and its longer term goals, or would the objective require a change to a core principle of that country’s IP or other regime? As seen in the TRIPS negotiations, the former may be achieved, while the latter may be unattainable or not implemented as envisioned.

Finally, flexibility is essential and with it negotiations can make progress in achieving even difficult objectives. Progress can occur through a text that encourages certain action, through the development of norms in other fora, for example, regional agreements, which can provide ideas and approaches that may be adopted later on a multilateral basis, and through continued domestic debate and further experience with particular issues.

In 1989, some delegations raised major systemic issues for negotiation that had eluded resolution in other fora, for example, requiring parties to adopt a first-to-file patent system and enhanced protection of GIs, as well as particular trade irritants, for example, procedures for enforcement of IPRs at the border through Section 337. Other delegations sought to “safeguard” the ability to protect against abuse of IPRs (patent licensing), promote transfer of technology and maintain space for pursuing other policy objectives. During the negotiating process for the TRIPS Agreement, each delegation had to prioritize its objectives and decide how to address “deal-breaker” issues (both offensive and defensive) for it and other delegations. The resulting text had to be acceptable at each level, that is, particular article, IP topic, agreement and as part of the overall Uruguay Round results. This

was achieved through hard work, flexibility and pragmatism, and good will on the part of all participants.

### *Observations on how the negotiations played out on specific topics*

#### **1. The patent complex (patents, undisclosed information and transitional provisions, including exclusive marketing rights)**

##### *General observations*

The negotiations on the patent complex involved two major elements: (i) general aspects of patent protection, such as term and scope of protection and conditions for compulsory licensing, and (ii) issues related to the unavailability of product patents for pharmaceuticals and agricultural chemicals in some countries and protecting otherwise undisclosed data that must be submitted to obtain government approval for marketing pharmaceuticals and agricultural chemicals. Often these issues, along with proposals on use of a patent without the authorization of the right holder, were considered as a package with “trade-offs” proposed among the various provisions. Proponents of addressing the data protection issues, including the United States, focused on the diminished “effective” term of patents for pharmaceuticals and agricultural chemical products, and providing a means for applicants for product patents for pharmaceuticals and agricultural chemicals to secure some benefit under the TRIPS Agreement in the near term. The United States and other proponents noted that, unlike other IPRs, obtaining a patent for a pharmaceutical took several years and marketing approval additional years and required large expenditures of time and resources.

The negotiations on rights and obligations related to patents presented some of the most complex and contentious issues in the negotiations. Among developed countries, the general standards for patent protection, such as the term of protection, varied widely. While many countries provided a term of 20 years from the date a patent application was filed, some countries provided a shorter term, for example, 16 years. When the TRIPS negotiations started, Canada and the United States calculated the term of protection from the date of grant of the patent. In 1989, Canada moved to a term of 20 years from the date the application is filed. Additionally, product patents for pharmaceuticals and agricultural chemicals were not available in all developed countries. Spain, Portugal and Greece had agreed to provide product patents for pharmaceuticals after a transition period that ended in 1992, and Canada did not provide product patents for pharmaceuticals until 1993.

### *Objectives and results for patent standards*

As of 1989, the main negotiating objectives for the patent section related to patentable subject matter, rights conferred, term of protection, limitations and exceptions, patent-related procedures including first-to-file and reversal of burden of proof in cases involving process patents, and provisions on “Other Use without the Authorization of the Right Holder” (compulsory or non-voluntary licensing). At least one objective – requiring a party to adopt a first-to-file patent system – would have required a basic change in the US patent system. This objective was not achieved.

The key objective for the United States and several other delegations was to ensure that product patents would be available for pharmaceuticals and agricultural chemicals. This objective was achieved, but with flexibilities provided in other provisions in the patent complex.

Most delegations had to deal with various exceptions in their respective domestic laws. Common exceptions were included in proposals on the matter made by the EC, Switzerland, Japan and a group of developing countries.<sup>12</sup> For some delegations, exceptions such as the one relating to patenting humans were based on moral as well as legal grounds. The exception for plants or animals other than micro-organisms and essentially biological processes for the production of plants or animals (other than non-biological and microbiological processes) reflected the state of domestic law for many participants in the negotiations.

Contrary to the US proposal,<sup>13</sup> the TRIPS Agreement explicitly enumerates exceptions from patentable subject matter. Given the overwhelming support for exceptions, the United States worked to craft text that could prevent their abuse. The exception for exclusions from patentable subject matter necessary to protect *ordre public* or morality, for example, is conditioned on the requirement that the party prohibit the commercial exploitation of the invention.

The EC's initial proposal also included a provision on “Exceptions to Rights Conferred”.<sup>14</sup> That proposal included examples of certain acts that could be excepted from a patent holder's rights provided that the exception took into account the legitimate interests of the patent holder and third parties. Many delegations welcomed this proposal and initially engaged in a debate on the list of actions mentioned in the text. Not surprisingly, that list grew to include the exceptions from each participant's domestic law. After extensive debate, negotiators adopted general language drawn from the Berne Convention that included the elements relating to normal commercial exploitation of the patent,

the interests of the patent holder and those of third parties. This approach preserved flexibility and addressed concerns that an excepted act would be omitted from the list.

Another element of flexibility in the patent text related to “other use without the authorization of the patent owner” (compulsory licences). The discussion of this matter was intertwined with the debate on elimination or maintenance of a requirement in domestic law to “work” (manufacture domestically) the patent within a certain period from its grant or face a compulsory licence, if requested. Elimination of the so-called “working requirement”, that is, a requirement for use of a process or manufacture of a product in the country granting the patent within a certain time period, was a major objective of the United States and the EC. Industry support for approval and implementation of any IP agreement required a good outcome on this issue.

While governments seldom granted compulsory licences for non-working, governments used these provisions more often as a threat to induce a “voluntary” licence or investment in domestic production. During the negotiations, some developing countries sought an explicit obligation for a patent holder to work the invention in the country granting the patent within the time period specified in national legislation. While the Paris Convention recognizes the possibility for a party to grant a compulsory licence for failure to work the patent in that party, the Convention does not require parties to include such requirements in domestic law.<sup>15</sup>

Building on the trade concept of non-discrimination, the Chair of the Negotiating Group proposed compromise language that, subject to the transitional provisions in the agreement, “patents shall be available and patent rights enjoyable without discrimination as to the place of invention, the field of technology and whether products are imported or locally produced”. Delegations were asked if they could live with this compromise, taking into account the provisions on limitations and exceptions and compulsory licences. This language now appears in the TRIPS Agreement.

The TRIPS Agreement also needed to deal with those cases in which a party’s domestic law provided for a compulsory or non-voluntary licence. These provisions could be found in laws on a variety of subject matter, including government or sovereign use provisions and competition law. The United States recognized that its domestic law had provisions under which the government or others on behalf of the government could use a patent upon payment of full compensation. In

addition, a compulsory licence, in theory, could be part of a settlement or remedy in a competition matter.

The United States, the EC, Japan and Switzerland, among others, shared the objective of a transparent process of decision-making on the grant of a compulsory licence, with recourse to judicial review of that decision available to the right holder, and payment of appropriate remuneration. Limitations on the use, for example, scope and duration, of compulsory licences also had strong support. After considerable discussion, negotiators were able to propose conditions that applied to compulsory licences generally and which relied on concepts of “public non-commercial use”, “national emergency” and other “circumstances of extreme urgency” to provide flexibility and serve as the basis for a waiver of the requirement for prior negotiations on a voluntary licence. The United States and others also proposed language to deal with the special case of a compulsory licence to address anti-competitive behaviour. This language permitted competition authorities to pursue remedies resulting from actions to address anti-competitive practices such as abuse of IPR licensing, subject to other provisions of the Agreement, including Article 40.

With regard to other patent issues, such as rights conferred and term of protection, negotiations focused on the development of a consensus on the details rather than agreement on basic principles. Reversal of the burden of proof in civil actions for infringement of a process patent was a widely held objective, since proof of infringement required information uniquely in the hands of the alleged infringer. Although reaching a consensus on how to achieve this objective required detailed discussions of the various legal mechanisms that were available and flexibility on the part of all, negotiators reached a consensus on the conditions that would give rise to a presumption of infringement, thus providing an incentive for the alleged infringer to provide the necessary information on the process it used.

***Objectives and results on protection of undisclosed test and other data submitted to obtain marketing approval***

In addition to achieving recognition of undisclosed information as a form of IP and reaching agreement on a basic standard for its protection, the EC, Switzerland and the United States sought disciplines on the use of undisclosed test and other data submitted to governments to obtain marketing approval for pharmaceuticals and agricultural chemicals. Difficult discussions ensued, reflecting the differing policy perspectives among delegations. At the later stages of the negotiation, the EC, Canada and India presented the Negotiating Group with a package proposal

to resolve the patent complex, which covered compulsory licences, protection of undisclosed information to obtain marketing approval of pharmaceuticals and agricultural chemicals, and transitional provisions linked to the availability of product patents for pharmaceuticals and agricultural chemicals.

The United States had significant difficulties with this package proposal, in particular with regard to protection of undisclosed data submitted to obtain marketing approval and the transitional provisions. Although the final text of Article 39.3 includes some elements of the initial proposals from the United States, several limitations were included and specific references to the duration of the protection were deleted. Article 39.3 refers to “new chemical entities”, and requires considerable effort in the development of the relevant data and the protection of that data against “unfair commercial use” (which is not defined) for an unspecified period of time. While parties are required to protect the data against disclosure, except where necessary to protect the public, or unless steps are taken to ensure that the data are protected against “unfair commercial use”, again, this second obligation is for an unspecified period of time. The absence of a definition of “unfair commercial use” and the open-ended nature of the obligations have led to a continuing debate over the meaning of the obligation.

***Certain transitional provisions (Article 70.8 and 70.9): Objectives and results***

While inventors of pharmaceutical or agricultural chemical products could apply for product patents when a party implemented the relevant provisions of the TRIPS Agreement, it would be many years before that patent holder could realize benefits from the patented product due to the time taken for patent examination and obtaining marketing approval for these types of products. In its early submission, the United States had proposed a form of transitional protection for products which were not previously patentable subject matter. Under this proposal, India, for example, would have provided protection for certain foodstuffs as well as pharmaceuticals, agricultural chemicals and any other categories of products excluded from patent protection, unless one of the exceptions set out in the chapter, such as that for diagnostic, therapeutic and surgical methods for the treatment of humans or animals, applied. In such cases, if the product was the subject of a patent in another party prior to entry into force of the TRIPS Agreement and the product had not been marketed in the relevant country, the party providing transitional protection would limit the right to make, use or sell the relevant product to the owner of that patent for the remaining term of the relevant product patent. The party seeking exclusive rights under this proposal would need

to submit a patent on the product granted in another party. The term of protection would be limited to the remaining term of the product patent submitted to the party providing transitional protection. This proposal for what was known as “pipeline protection” was the most ambitious of the proposals on transitional provisions and became part of the patent complex discussions.

During the course of negotiations, the Swiss delegation presented a proposal that was limited to pharmaceuticals and agricultural chemicals and set up a mechanism for accepting applications as of the date the TRIPS Agreement became applicable in that country, and examining those applications based on the date of receipt of the application. This would address the issue of whether an invention was “new” or “novel” at the time of examination. The proposal also required the party to provide exclusive marketing rights in that party for a period of five years after obtaining marketing approval or until the product patent is granted or rejected. This proposal focused on the most important technologies that some parties had excluded from patentability and provided the possibility for patent applicants to reap some economic benefit during the transition period. At the time the Swiss made this proposal, the actual transition periods for implementing the obligation to make product patents available was not known.

### *Assessment*

The proponents of a broad scope of patentable subject matter achieved their main objective. Members must make product patents available for pharmaceuticals and agricultural chemicals. The results of negotiations on the patent complex were a very mixed bag for the United States. The combination of long transition periods and the limitations on the form of transitional protection that were included gave parties that needed to implement product patent protection for pharmaceuticals and agricultural chemicals a long period for adjustment. These provisions provoked significant complaints from the US pharmaceutical industry about the potential ten-year delay in actually realizing the benefit of patent protection for its products. WTO members continue to debate the details of the obligations set out in Article 39.3. Some WTO members, including the EU and the United States, have used negotiations on the accession of countries to the WTO as an opportunity to add specific details on the substance of this obligation. The matter has also been addressed in various free trade agreements (FTAs).

With regard to other patent issues, such as term of protection, rights provided to patent holders and shifting the burden of proof that had created uncertainty about the level of patent protection that would be provided, the TRIPS Agreement sets

out clear disciplines. On compulsory licensing, a member must meet specified conditions, including transparency, review of decisions and payment of remuneration if it grants a compulsory licence. Such actions can no longer be by fiat and for entire categories of technologies, for example, all pharmaceuticals. A member also has obligations to maintain the confidentiality of undisclosed information submitted to it to obtain marketing approval of pharmaceuticals and agricultural chemicals and to prevent unfair commercial use of such information. While the patent provisions set out significant improvements in the level of protection for inventions, those provisions also have proven to include the flexibility necessary to address specific concerns that have arisen.

## 2. Trademarks and geographical indications

### *Trademarks: Objectives and results*

The major objectives for the United States regarding the protection of trademarks related to defining the scope of protectable subject matter in as broad a manner as possible, for example, to potentially include marks consisting of a colour, sound or scent; maintaining the ability of parties to require use of a mark as a condition for obtaining and maintaining protection; clarification of the requirements for establishing that a mark is “well known” and thus subject to special treatment; extending Paris Convention provisions on trademarks to service marks; setting the parameters for exceptions to the rights provided; and establishing a minimum term of protection.

The negotiations on standards for trademarks were somewhat less contentious than those for patents and GIs. Implementing the TRIPS Agreement section on trademarks does not require a party to make major changes to foundation principles of its trademark system. Thus, parties whose systems included use requirements to obtain or maintain a registration or the possibility for a sign to obtain trademark status through use rather than registration were able to maintain those elements of their respective systems. Conditions and limitations were, however, placed on any requirements for use.

With regard to the standard for determining whether a mark was well known, negotiators were able to agree on some clarifications: that the standard continues to be subjective and authorities apply various criteria. Among those criteria, parties were required to recognize efforts to promote the mark, such as through advertising, rather than use of the mark in the relevant territory. In addition, language was included to address some participants' particular requirements on how a trademark is presented or used. Overall, however, participants applied basic

trademark principles, such as distinctiveness and likelihood of confusion, in drafting the text, and showed flexibility on issues such as term (seven years was adopted rather than ten, as many developed parties proposed) and scope of protection. Enforcement of trademarks was more of a critical issue for delegations, and the provisions on civil and criminal remedies and enforcement at the border reflect the desire for strong disciplines to address an issue that had adverse effects on consumers and businesses in many countries.

### ***Geographical indications: Objectives and results***

If the negotiations on trademark standards were comparatively uncontentious, the opposite was the case for GIs. The EC's submission on standards for GIs included a broad definition of protected indications (that included appellations of origin as a subcategory and covered all types of products); restricted use, *inter alia*, based on "susceptibility to mislead"; and, "where appropriate", required protection for appellations of origin, "in particular for products of the vine, to the extent that it is accorded in the country of origin."<sup>16</sup> The proposal required parties, *inter alia*, to provide a means for "interested parties" to prevent a GI from becoming generic and declared that "products of the vine shall not be susceptible to develop into generic designations." Finally, the EC proposed the establishment of an international register to facilitate the protection of GIs, including appellations of origin.<sup>17</sup>

While some delegations, such as Thailand and India, welcomed the fact that the EC's proposal covered products other than wine and distilled spirits, since they had an interest in GIs for certain beverages and food products, many questioned the need for a special regime for GIs. To the United States and several other delegations, it seemed that the main issue was that those using GIs did not want to go through the time and expense of litigating rights provided through trademarks. Instead, the EC's proposal would have required many developed and developing countries to establish a form of *sui generis* protection for GIs, modify core provisions of their respective trademark regimes, including provisions related to generic terms, and invalidate existing trademarks. Despite strong opposition to its proposal, the EC indicated that including obligations in respect of GIs, in particular on wines and distilled spirits, was a "must have" element of any TRIPS Agreement.

Australia submitted a counterproposal on GIs, and delegations worked intensively on a package that reinforced requirements to protect against trademark infringement and unfair competition, including acts which mislead the public as to

the true origin of a good. These protections would apply to all GIs. Since many parties had special regimes in place relating to GIs for wines and spirits, the text includes additional provisions related to protections for GIs for wines and spirits. Article 23.4 refers to negotiations for a multilateral system for notification and registration of wines. The further elaboration on those negotiations set out in Article 24 reflects a hard-fought balance between proponents of GIs and those seeking to defend and preserve trademark principles and the continued use of trademarks with geographical elements. The negotiations on a possible GI register have consumed the time of the TRIPS Council and special sessions for years and appear to remain stalled.

Since the TRIPS Agreement entered into force, the EU and the United States have concluded FTAs with provisions on GIs that take divergent approaches to protection of GIs. EU agreements tend to include lists of products that are to be protected if used in accordance with the relevant laws of the EU and products of the other party that are used in accordance with that party's relevant laws.<sup>18</sup> The US approach requires a party to provide certain procedural safeguards, such as cancellation or opposition proceedings, to address concerns, *inter alia*, regarding protection of generic terms and trademarks.<sup>19</sup> Although some countries have agreements with both the EU and the United States, it remains to be seen whether the divergent approaches can be reconciled.

### 3. General provisions on national treatment, most-favoured nation treatment and exceptions

#### *National treatment and most-favoured nation treatment*

Until the later stages of the negotiations, the United States, the EC and others worked on the basis that the TRIPS Agreement would be a plurilateral Tokyo-Round-style code, such as the Anti-dumping Code, with no requirement that all GATT contracting parties become party to the Agreement. The proposals on national treatment and MFN and the final text of the Agreement were an amalgam of IP and trade principles, with the IP community unwilling to give up existing exceptions to national treatment and the trade community seeking to avoid "free-riders."

As noted, certain IP agreements, including the Berne Convention, Paris Convention and International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (Rome Convention of 1961) require a party to provide national treatment in respect of certain rights. Thus, if a party decides to limit the rights it accords to its nationals, that party is

not required to provide those rights to foreign owners of IP. This principle is maintained to some extent in Article 3 of the TRIPS Agreement, which maintains the exceptions to national treatment included in the three previously mentioned Conventions and in the Treaty on Intellectual Property in Respect of Integrated Circuits. Furthermore, the national treatment obligation in respect of performers, producers of phonograms and broadcasting organizations applies only in respect of the rights covered under the TRIPS Agreement. The exceptions to national treatment related to enforcement of IPRs, however, are subject to a classic trade limitation, that is, that they not be applied in a manner that would constitute a disguised restriction on trade. The overall effect of maintaining these exceptions, however, is diminished in the TRIPS Agreement, because under the TRIPS Agreement members must provide their nationals the rights specified in the Agreement.

US right holders were particularly disappointed that WTO members could maintain the exceptions from national treatment provided in the Rome Convention. Under these exceptions, US performers, producers of sound recordings and broadcast organizations received less favourable treatment than those of Rome Convention parties, and this could continue.

MFN treatment in the context of IP requires a party to provide the same treatment to owners of IP from all other parties and addresses those infrequent cases where a party provides better treatment to foreign right owners than to its nationals. The EC was the principal proponent of including MFN provisions in the TRIPS Agreement. While recognizing that exceptions to MFN would be necessary, the EC wanted to ensure that higher levels of protection granted under bilateral agreements would be accorded generally. This objective was due to provisions in a bilateral agreement between the United States and the Republic of Korea concerning "pipeline protection" of certain pharmaceutical products covered under US patents. Products covered under a patent granted by a member state or the European Patent Office did not qualify for such protection.

Commentators have raised an interesting question about the application of the MFN principle in the context of regional or bilateral FTAs and customs unions. The TRIPS Agreement does not include an exception from MFN for advantages or benefits relating to protection of IP under such agreements, that is, it does not contain a counterpart to Article XXIV of the GATT 1994. Since most IP laws are drafted and administered on an MFN basis, the issue has arisen principally in the context of agreements related to the protection of GIs. To date, members have chosen not to challenge such provisions as denial of MFN treatment.

### *Exceptions: General exceptions*

Article 73 of the TRIPS Agreement sets out the security exception to the provisions of the Agreement with language taken from Article XXI of the GATT, thus avoiding any question as to whether measures permitted under Article XXI of the GATT (1994) could be contrary to the TRIPS Agreement. Article XX (d) of the GATT 1994 provides an exception from the obligation of the Agreement for measures “necessary to secure compliance with laws or regulations which are not inconsistent with the provisions of this Agreement, including those relating to ... the protection of patents, trade marks [sic], and copyrights, and the prevention of deceptive practices;”<sup>20</sup> The TRIPS Agreement does not include a “general exceptions” article corresponding to Article XX of the GATT 1994. The need for a counterpart to Article XX was considered and rejected.

The TRIPS Agreement takes a different approach in providing for exceptions. It includes specific, limited exceptions to national and MFN treatment and, within Part II, the Agreement sets forth specific provisions on exceptions or limitations to rights for each form of IPR in the Agreement.<sup>21</sup> This approach permitted exceptions tailored to each right. With regard to enforcement, which is the focus of the GATT Article XX(d) exception, the TRIPS Agreement sets out the specific disciplines. Indeed, Article 1 of the TRIPS Agreement recognized that members could provide more extensive protection than provided in the Agreement provided that it did not contravene the Agreement. A general exception from the enforcement obligations would be inconsistent with the principle that the Agreement expresses the minimum standards for enforcement.

## **4. Dispute settlement**

### *Application of GATT/WTO rules*

Achieving the application of GATT/WTO dispute settlement procedures to rights and obligations on IP was a top-level objective for the United States before and throughout the negotiations, and was coupled with ambitious objectives for modifying the dispute settlement procedures in place at the time the Uruguay Round negotiations began.<sup>22</sup> Negotiators often remarked that strong standards for IP protection meant little if disciplines requiring effective enforcement of IPRs were not included. The same could be said of government-to-government enforcement. The lack of an effective government-to-government enforcement mechanism in existing IP treaties was a significant factor in deciding to initiate negotiations in the GATT. Initial proposals from both the United States and the EC were in the form of an additional GATT article with detailed provisions included in

an Annex to GATT (1947). As such, GATT dispute settlement procedures, as negotiated in the Uruguay Round, would have applied.

While the United States favoured application of GATT dispute settlement rules, including any modifications agreed during the Uruguay Round, India and some other delegations proposed procedures that focused on consultations without retaliation. New Zealand led a group of countries putting forward a middle-ground proposal that would authorize the TRIPS Committee to endorse sanctions only after a period of non-compliance.

Those delegations, such as the United States, that sought application of new dispute settlement rules to IPR had to address a number of questions, including whether to include some special rules, for example, on recourse to experts, and what trade actions could be authorized after a finding of violation of IP obligations and subsequent non-compliance. The Draft Final Act issued in December 1990, for example, included three texts as options for consideration once the institutional issues were decided.<sup>23</sup>

During the hiatus in negotiations during 1992 and part of 1993, thinking evolved on the formation of what was proposed to be the Multilateral Trade Organization (MTO). An organization, which eventually was named the World Trade Organization, would be established and the results of the Uruguay Round negotiations would be agreed as part of a “single undertaking”. This would assure that a participant could not “opt out” of a sensitive part of the Uruguay Round package and that those accepting the single undertaking would know the entirety of the deal and decide whether it was sufficient and acceptable.

Ultimately, ministers decided to include the TRIPS Agreement as Annex IC to the Marrakesh Agreement Establishing the WTO (WTO Agreement) and subject it to the rules and procedures set out in the Understanding Governing the Rules and Procedures on the Settlement of Disputes. The only special rule that applies to matters under the TRIPS Agreement is the moratorium on complaints of the type provided for under paragraphs 1(b) and 1(c) of Article XXIII of the GATT (1994), that is, non-violation and other matters.

### *Cross-retaliation*

One key reason for industry and government support for the application of GATT/WTO dispute settlement to the TRIPS Agreement was the potential for authorized trade action against imported goods. The IP community in the United States was comfortable with the link between market access for goods and IP, as seen in the

criteria for its GSP and Special 301. Taking action against IP owned by nationals of a member found in violation of an IP obligation was considered neither practicable nor fair. Numerous questions were presented. Would the action need to be against the same form of IP? How would the affected member and ultimately the WTO value the violation and the resulting trade action? The results of the Uruguay Round negotiations included cross-retaliation and, to date, three members have received authorization to take action with regard to IPRs for violations in agreements related to trade in goods and services.<sup>24</sup>

### *Non-violation complaints*

As mentioned above, negotiators agreed to two changes to the draft TRIPS text that was proposed in December 1991 as part of the Draft Final Act. The delay in finalizing the negotiations had provided contracting parties time to examine and socialize the text. Most contracting parties found it acceptable without change as part of the overall Uruguay Round package. The United States, however, proposed a handful of changes to the patent, copyright, transitional and dispute settlement provisions of the draft TRIPS text. Since most delegations considered that the current text was acceptable, any changes had to be by consensus.

In addition to these changes, the United States proposed to establish a five-year moratorium on so-called “non-violation” complaints as part of a package that included limiting the grounds for issuing compulsory licences on semiconductor technology. During the five-year moratorium, the TRIPS Council was to study the scope and modalities for bringing such complaints and make its recommendations to address these issues or to extend the moratorium to the ministerial meeting. Several, but not all, delegations supported elimination of “non-violation” complaints due to uncertainty over the scope of the provision and how it would apply in the context of IPRs.

GATT contracting parties and WTO members have brought only a handful of disputes that include a non-violation complaint. The elements of such a dispute differ from a violation complaint, *inter alia*, because nullification or impairment of rights is not presumed and must be established and, even if the complaint is successful, the respondent member is not required to modify the relevant measure. Thus, to a large extent, non-violation complaints have been used to bring the respondent member to the table to address an issue.

As noted, the United States was motivated to propose the moratorium on non-violation complaints to obtain a consensus in support of another of its proposals, which would limit the application of compulsory licences to patents on

semiconductor technology to cases of public non-commercial use or to remedy anti-competitive practices. Since it was difficult to predict what type of measure might be actionable under a non-violation complaint and the remedy was limited, policy makers thought that the value of the provision was also limited. Moreover, the moratorium was intended to end in five years. Members, however, have repeatedly decided to extend the moratorium. The United States, with little support, has urged an end to the moratorium. The option of bringing a non-violation complaint would provide a useful tool to address new issues that have arisen since the TRIPS Agreement entered into force.

### **Observations on evolving issues related to IP**

The TRIPS Agreement broke new ground with regard to multilateral disciplines on the protection and enforcement of IPRs. That said, it has been more than 22 years since the text was negotiated. Since then, new multilateral IP agreements, such as the WIPO Internet Treaties and the Patent Law Treaty, have entered into force. New technologies and products have been developed and the Internet provides unprecedented access to information. Indeed, information has become a good that is gathered and traded.

Governments must address a wide range of issues with implications for IP protection. One such issue is how to provide access to patented technology used in interoperability standards for various products, such as smartphones, that must interface with complex and growing networks. Standards-setting organizations in the telecommunications area that require participants in the standards-setting process to license standards and essential patents on fair, reasonable and non-discriminatory (FRAND) terms present a potential model that could be strengthened and emulated in other situations. A key element in that process is that the right owner makes the initial decision on whether to participate in the process and accepts both its positive economic consequences (many licences) and other consequences (limits on the level of royalties and possibly on other terms of the licence).

Practices of those who purchase patent rights for the sole purpose of licensing them (so-called patent trolls) have raised concerns that patent rights are not serving the purpose of promoting innovation. Addressing the objectionable practices, rather than weakening patent protection generally, would seem to be the better approach. Members of the US Congress, for example, have proposed measures to address some of the more egregious practices of patent trolls.

Concerns about potential abuse of patents or copyrights have led some to urge use of competition law as a means to investigate and prevent such abuse. This is a longstanding concern with regard to patents. In the United States, the intensity of application of antitrust law to those asserting patent rights has varied over decades. The TRIPS Agreement recognizes a member's right to apply appropriate measures to address abuses of IP by a right owner, including licensing practices that may adversely affect trade or impede the transfer of technology, but any measures taken must be consistent with the TRIPS Agreement. From an IP perspective, the lack of a common approach or international standards for application of antitrust or competition law leaves a right holder vulnerable. Currently, application of competition law lacks transparency and predictability.

Whether any of these or other IP-related issues is appropriate for international negotiations is an open question. Maintaining the integrity of systems for the protection of IP, which have their foundation in the TRIPS Agreement, should be a major consideration in deciding next steps. The solution worked out on access to medicines is an example of the flexibility of the TRIPS Agreement and the IPRs provided under that Agreement. Members adopted a solution without making major changes to the Agreement or to IPRs generally. In my view, a similar approach needs to be taken to address the "new" IPR issues that are arising.

## Endnotes

- 1 The US delegation had various “chief negotiators” during the period 1986–93, and officials from the US Patent and Trademark Office, and Copyright Office, among others, had significant responsibilities in the negotiations. For the United States, this was a quintessential team effort. I thank the US Uruguay Round negotiating team, the TRIPS team, my colleagues from other delegations and the GATT Secretariat who participated in the TRIPS negotiations for a proud highlight of my career and many fond memories of them.
- 2 See [www.wipo.org](http://www.wipo.org) and GATT document MTN.GNG/NG11/W/13/Rev.1, Negotiating Group on Trade-Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods – International Conventions Regarding Intellectual Property and Their Membership – Note by the Secretariat – Revision, 19 June 1989.
- 3 GATT document L/5424, CONTRACTING PARTIES – Thirty-Eighth Session – Ministerial Declaration adopted on 29 November 1982, 29 November 1982. The contracting parties requested the Director-General (DG) to consult with the DG of WIPO to clarify the legal and institutional aspects involved. Those consultations occurred and work continued through 1985. NB: “Joint Action” pursuant to Article XXV of the GATT refers to the mechanism by which the contracting parties took decisions.
- 4 Section 1102(b)(10) of the Omnibus Trade and Competitiveness Act of 1988.
- 5 GATT document MIN.DEC, Multilateral Trade Negotiations – The Uruguay Round – Ministerial Declaration on the Uruguay Round, 20 September 1986.
- 6 GATT document MTN.GNG/5, Uruguay Round – Group of Negotiations on Goods (GATT) – Fifth Meeting of the Group of Negotiations on Goods – Record of Decisions Taken, 9 February 1987.
- 7 See, for example, GATT documents MTN.GNG/NG11/W/24/Rev.1, Negotiating Group on Trade-Related Aspects of Intellectual Property Rights, including Trade in Counterfeit Goods – Existence, Scope and Form of Generally Internationally Accepted and Applied Standards/ Norms for the Protection of Intellectual Property – Note Prepared by the International Bureau of WIPO – Addendum, 15 June 1988, and MTN.GNG/NG11/W/31, Negotiating Group on Trade-Related Aspects of Intellectual Property Rights, including Trade in Counterfeit Goods – Proposal by the European Community for the Negotiations on the Enforcement of Trade-Related Intellectual Property Rights, 30 May 1989.
- 8 GATT document MTN.GNG/NG11/W/14/Rev.1, Negotiating Group on Trade-Related Aspects of Intellectual Property Rights, including Trade in Counterfeit Goods – Suggestion by the United States for Achieving the Negotiating Objective – Revision, 17 October 1988.
- 9 See, for example, GATT documents MTN.GNG/NG11/17, Negotiating Group on Trade-Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods – Meeting of 11, 12 and 14 December 1989 – Note by the Secretariat, 23 January 1990 (Japan); MTN.GNG/NG11/25, Negotiating Group on Trade-Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods – Meeting of Negotiating Group of 10–21 September 1990 – Note by the Secretariat, 8 October 1990 (Switzerland); and MTN.GNG/NG11/26, Negotiating Group on Trade-Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods – Meeting of Negotiating Group of 8 and 18 October 1990 – Note by the Secretariat, 31 October 1990 (the EC).

- 10 GATT documents MTN.GNG/NG11/W/68, Negotiating Group on Trade-Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods - Draft Agreement on Trade-Related Aspects of Intellectual Property Rights, 29 March 1990; MTN.GNG/NG11/W/70, Negotiating Group on Trade-Related Aspects of Intellectual Property Rights, including Trade in Counterfeit Goods – Draft Agreement on the Trade-Related Aspects of Intellectual Property Rights – Communication from the United States, 11 May 1990; MTN.GNG/NG11/W/71, Negotiating Group on Trade-Related Aspects of Intellectual Property Rights, including Trade in Counterfeit Goods – Communication from Argentina, Brazil, Chile, China, Colombia, Cuba, Egypt, India, Nigeria, Peru, Tanzania and Uruguay, 14 May 1990; MTN.GNG/NG11/W/73, Negotiating Group on Trade-Related Aspects of Intellectual Property Rights, including Trade in Counterfeit Goods – Draft Amendment to the General Agreement on Tariffs and Trade on the Protection of Trade-Related Intellectual Property Rights – Communication from Switzerland, 14 May 1990; MTN.GNG/NG11/W/74, Negotiating Group on Trade-Related Aspects of Intellectual Property Rights, including Trade in Counterfeit Goods – Main Elements of a Legal Text for Trips – Communication from Japan, 15 May 1990; and MTN.GNG/NG11/W/75, Negotiating Group on Trade-Related Aspects of Intellectual Property Rights, including Trade in Counterfeit Goods – Draft Text on Geographical Indications – Communication from Australia, 13 June 1990, respectively.
- 11 US Supreme Court case *Golan v. Holder*, 565 U.S. (2012).
- 12 The group of developing countries comprised Argentina, Brazil, Chile, Colombia, Cuba, Egypt, India, Nigeria, Peru, Tanzania, Uruguay, Pakistan and Zimbabwe. Twelve of them (Pakistan and Zimbabwe joined the group later) submitted MTN.GNG/NG11/W/71 with specific proposals on IP standards, consultations, and trade in counterfeit goods. (China also signed on to the submission, but was in the process of accession during the Uruguay Round negotiations).
- 13 GATT document MTN.GNG/NG11/W/70.
- 14 GATT document MTN.GNG/NG11/W/68.
- 15 See Article 5 of the Paris Convention.
- 16 GATT document MTN.GNG/NG11/W/68.
- 17 *Ibid.*
- 18 See, for example, the EU–Korea Free Trade Agreement Article 10.19.
- 19 See, for example, the United States–Korea Free Trade Agreement Article 18.2 paragraphs 8, 14, and 15.
- 20 In addition to meeting the requirements set out in subparagraph (d), a member asserting an Article XX exception must establish compliance with the conditions set out in the chapeau to that Article.
- 21 For undisclosed information, the limitations are in the form of conditions on what information qualifies for protection, that is, language in Article 39.2 subparagraphs (a) through (c) and 39.3.

- 22 See, for example, GATT documents MTN.GNG/NG11/W/14, Negotiating Group on Trade-Related Aspects of Intellectual Property Rights, including Trade in Counterfeit Goods – Suggestion by the United States for Achieving the Negotiating Objective, 20 October 1987, and MTN.GNG/NG11/W/70.
- 23 GATT document MTN/TNC/W/35/Rev.1, Uruguay Round - Trade Negotiations Committee – Draft Final Act Embodying the Results of the Uruguay Round of Multilateral Trade Negotiations – Revision, 3 December 1990.
- 24 Action against IPRs has been authorized in three disputes to permit the following: Ecuador to take action against the EC in connection with the bananas dispute; Antigua and Barbuda to take action against the United States in connection with the General Agreement on Trade in Services (GATS) dispute involving online gambling; and Brazil to take action against the United States in connection with the dispute regarding subsidies for upland cotton.