

WORLD TRADE ORGANIZATION

RESTRICTED

IP/C/W/8

28 July 1995

(95-2202)

Council for Trade-Related Aspects of Intellectual Property Rights

DRAFT FORMAT FOR LISTING OF "OTHER LAWS AND REGULATIONS" TO BE NOTIFIED UNDER ARTICLE 63.2

Note by the Secretariat

1. Paragraph 10 of the Working Hypothesis on Procedures for Notification of, and Possible Establishment of a Common Register of, National Laws and Regulations under Article 63.2 (IP/C/W/6) provides that each Member shall provide in a WTO language a listing of its "other laws and regulations" together with a brief description of the relevance of each law and regulation to provisions of the TRIPS Agreement. At the meeting of the Council for TRIPS on 24 May 1995, the Chairman said that a fairly simple two-column type of presentation, with the type of law or regulation in question in one column and a brief description of the subject of the law or regulation and of its relevance to the TRIPS Agreement in the other column, might be envisaged (IP/C/M/2, paragraph 14). The Council agreed to his suggestion that the Secretariat be requested to prepare a draft format (IP/C/M/2, paragraphs 34 and 35). The purpose of this note is to respond to this request.

2. It will be recalled that, in the light of the volume of legislation to be notified pursuant to Article 63.2 of the TRIPS Agreement, the Working Hypothesis departs from customary GATT/WTO practice of requiring that notifications of national legislation be in a GATT/WTO language and be circulated to all Members in the three working languages of the GATT/WTO. A distinction is made between the "main dedicated intellectual property laws and regulations" and "other laws and regulations". Legislation falling in the first category would have to be notified in a WTO language and would be distributed in that language to all Members as TRIPS Council documents. Translations into other WTO languages would only be made by the WTO Secretariat on the request of a Member in the TRIPS Council and within the limits of the WTO Secretariat's resources. Notifications of the "other laws and regulations" could be made in a national language, even where that was different from a WTO language, and would not be circulated automatically to the Members, but would be available for consultation by Members in the Secretariat. Copies would be distributed to Members as Council documents only if a request were made in the TRIPS Council.

3. Given, therefore, that these "other laws and regulations" would not normally be distributed to Members in a WTO language, the Working Hypothesis provides that each Member shall provide in a WTO language a listing of these "other laws and regulations", together with a brief description of the relevance of each law and regulation to the provisions of the TRIPS Agreement.

4. A draft format for such listings, along the lines suggested by the Chairman at the TRIPS Council's meeting of 24 May 1995, can be found at Annex 1. Annex 2 contains some hypothetical examples of the information that might be provided in such a listing, in order to give Members a more concrete appreciation of what might be involved. The remaining

paragraphs of this note consider a number of issues relevant to the information that should appear in a Member's listing.

What are the "other laws and regulations" that would figure on the listing?

5. Article 63.2 of the TRIPS Agreement requires the notification of laws and regulations made effective by a Member pertaining to the subject matter of the TRIPS Agreement (the availability, scope, acquisition, enforcement and prevention of the abuse of intellectual property rights). It is clear from Article 63, paragraphs 1 and 2, that the notification obligation does not extend to final judicial decisions and administrative rulings of general application. The "other laws and regulations" that would figure on the listing are those laws and regulations to be notified under Article 63.2 minus the "main dedicated laws and regulations". Therefore, in order to establish what are these "other laws and regulations", it is necessary to define what are the "main dedicated intellectual property laws and regulations".

6. In the Working Hypothesis, it is stated that these main dedicated intellectual property laws and regulations would include the main laws and regulations on the availability, scope and acquisition of each of the categories of intellectual property together with such other main laws and regulations as are dedicated to intellectual property, such as those on border enforcement. Thus, the basic law applicable to each area of intellectual property would no doubt fall within this category. On the whole, secondary legislation, laying out more detailed provisions for the implementation of the basic law, especially those of an essentially procedural nature, could be supposed generally not to fall within this category but to figure on the listing of "other laws and regulations". However, there may be some regulations which are so closely related to the obligations of the TRIPS Agreement that they should be treated as "main dedicated intellectual property laws and regulations"; examples might include regulations specifying the protection of foreign nationals and detailed provisions on compulsory licensing giving effect to TRIPS provisions. In regard to enforcement, some provisions, especially those relating to remedies, often fall in laws and regulations dedicated to the intellectual property right in question. These would thus normally be notified as part of the "main dedicated laws and regulations". There may also be, in some countries, laws or regulations of a more horizontal nature, but which nonetheless deal specifically with intellectual property enforcement and are sufficiently important to the TRIPS Agreement to be considered as a main law or regulation; examples might include provisions establishing a court to deal specifically with intellectual property matters or provisions on the customs enforcement of intellectual property rights. The situation in respect of legislation on prevention of the abuse of intellectual property rights is likely to be similar to that for enforcement.

7. The "other laws and regulations" would include all laws, however important in relation to the provisions of the TRIPS Agreement, which are not dedicated (i.e. specific) to intellectual property but of more general application. Much legislation in regard to procedures for domestic enforcement, e.g. the codes of civil and criminal procedures, and much legislation with regard to the prevention of abusive practices, e.g. competition or anti-trust laws, are likely to fall in this category. As indicated in the third sentence of the previous paragraph, this category of "other laws and regulations" would also include those laws and regulations which, although dedicated to intellectual property, are not main laws and regulations.

8. Of course, it will inevitably be somewhat arbitrary what, at the margin, is put in one category or the other. This is a judgment that will have to be made in the first instance by each Member when deciding how to notify. If, however, another Member considers that a text subjected to the simplified procedure of the listing should have been treated as a "main dedicated law or regulation", the Working Hypothesis contains mechanisms for dealing with

the situation. That other Member can request the notification of the law or regulation, or relevant parts of it, in a WTO language and its circulation to Members of the TRIPS Council. It should also be recalled that, in the area of enforcement where laws are less likely to be "dedicated" and therefore more likely to figure on the listing, the Working Hypothesis provides for a checklist of issues.

Treatment of consolidated texts

9. The question might arise as to whether consolidated texts of laws and regulations should be notified, even where they do not have legal standing in the country in question. It is suggested that, in the initial notification of laws and regulations, to be made as of the time that the corresponding substantive obligations under the TRIPS Agreement become applicable, Members should be encouraged to submit any consolidated texts that exist, both of the main dedicated laws and regulations and of the others, wherever the Member is satisfied that they accurately represent the state of its legislation. This does not mean that delegations would be invited to prepare consolidations specifically for the purposes of their TRIPS notifications, although of course they would be free to do so if they so wished; rather it is suggested that they should use any existing consolidated texts and notify them together with any amendments subsequent to their preparation.

10. In regard to notifications of legislation subsequent to the initial notification, other Members may well find the notification of amendments useful, since they would enable Members to see easily the change that has been made. The Council may therefore wish to suggest that, in regard to such subsequent changes to national legislation, the amendments be notified, Members might also be invited to provide copies of consolidated texts, whether of an official or unofficial nature, when and if they prepare them.

Structure of listing

11. The listings might be structured along the lines of the categorization in the TRIPS Agreement itself, i.e.

- Copyright and related rights
- Trademarks
- Geographical indications
- Industrial designs
- Patents (including plant variety protection)
- Layout-designs (topographies) of integrated circuits
- Protection of undisclosed information

- Prevention of the abuse of intellectual property rights

- Civil judicial procedures and remedies
- Provisional judicial measures
- Special requirements related to border measures
- Criminal procedures
- Any administrative procedures and remedies not covered above

Where a law or regulation is relevant to more than one heading, it would need to be mentioned under each of the relevant headings.

ANNEX 2

HYPOTHETICAL ILLUSTRATIVE EXAMPLES OF INFORMATION
TO BE PROVIDED UNDER FORMAT

<p style="text-align: center;">TITLE DATE OF ADOPTION AND ENTRY INTO FORCE</p>	<p style="text-align: center;">BRIEF DESCRIPTION</p>
<p><u>Copyright and related rights</u></p>	
<p>Copyright Regulation No. ... of 19.., adopted ..., entry into force ...</p>	<p>The Regulation contains provisions on detailed application of the provisions of the Copyright Act No. ... of 19... relating to the calculation of <i>droit de suite</i> remuneration, ephemeral recordings for broadcasting purposes and the procedures of the Copyright Tribunal as well as certain miscellaneous provisions</p>
<p>Regulation No. ... of 19.., adopted ..., entry into force ...</p>	<p>The Regulation amends the provisions of the Copyright Regulation No. ... of 19... relating to the calculation of <i>droit de suite</i> remuneration</p>
<p><u>Patents</u></p>	
<p>Patent Regulation No. ... of 19.., adopted ..., entry into force ...</p>	<p>The Regulation contains provisions on detailed application of the provisions of the Patent Act No. ... of 19... relating to patent applications</p>
<p>Regulation No. ... of 19.., adopted ..., entry into force ...</p>	<p>The Regulation amends Patent Regulation No. ... of 19.. by adding necessary provisions giving effect to the procedural requirements flowing from the adherence to the Patent Cooperation Treaty</p>
<p>Regulation on the Patent Office No. ... of 19.., adopted, entry into force ...</p>	<p>The Regulation contains detailed provisions on the organization of the Patent Office</p>
<p>Regulation on Patent Fees No. ... of 19.., adopted ..., entry into force ...</p>	<p>The Regulation establishes the patent fees</p>
<p><u>Prevention of the abuse of intellectual property rights</u></p>	
<p>Restrictive Trade Practices Act No. ... of</p>	<p>The Act makes actionable, in certain</p>

<p style="text-align: center;">TITLE DATE OF ADOPTION AND ENTRY INTO FORCE</p>	<p style="text-align: center;">BRIEF DESCRIPTION</p>
<p>19., adopted ..., entry into force ...</p> <p><u>Civil judicial procedures and remedies</u></p> <p>Act on Civil Procedures No. ... 19., adopted ..., entry into force ...</p> <p>Act on Liability No. ... of 19., adopted .., entry into force ...</p> <p><u>Provisional judicial measures</u></p> <p>Act on Provisional Measures No. ... of 19., adopted ..., entry into force ...</p> <p><u>Criminal procedures</u></p> <p>Act on Criminal Procedures No. ... of 19., adopted ..., entry into force ...</p>	<p>situations, certain licensing practices and conditions which restrain competition. The relevant provisions may in particular cases be applied to an abuse of intellectual property rights</p> <p>The Act, together with the subsequent amendments, establishes the basic procedures for civil judicial proceedings</p> <p>The Act contains provisions on the calculation of damages</p> <p>The Act contains provisions on certain provisional measures applicable to civil and/or criminal procedures</p> <p>The Act together with the subsequent amendments establishes the basic procedures for criminal proceedings</p>