

**MULTILATERAL TRADE  
NEGOTIATIONS  
THE URUGUAY ROUND**

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Group of Negotiations on Goods (GATT)

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Negotiating Group on Trade-Related  
Aspects of Intellectual Property Rights,  
including Trade in Counterfeit Goods

STANDARDS AND PRINCIPLES FOR NEGOTIATIONS ON TRADE-RELATED  
ASPECTS OF INTELLECTUAL PROPERTY RIGHTS

Communication from New Zealand

The following communication has been received from the delegation of New Zealand with the request that it be circulated to members of the Negotiating Group.

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This submission will focus on the trade-related aspects of standards for the protection of intellectual property rights, as New Zealand considers such standards can be a practical means of addressing trade distortions.

The agreement that results from these negotiations would appropriately fall within the GATT framework, since it is the trade aspects at issue. This is not to suggest however that the GATT should be a standard-setting organisation or that New Zealand is seeking in this forum a comprehensive framework of intellectual property right standards. That is more appropriately a task for other bodies.

The agreement could contain a statement to the effect that Parties should accord intellectual property rights protection at least as adequate and effective as the standards contained in the principal international intellectual property conventions, in particular the Paris Convention for the Protection of Industrial Property and the Berne Convention for the Protection of Literary and Artistic Works<sup>1</sup>.

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<sup>1</sup>This would allow parties to subscribe to a certain level of intellectual property standards without being tied to a particular expression of them. This would, inter alia, allow for any future revision of the conventions without requiring renegotiation of a TRIPS agreement.

Where appropriate, minimum standards and norms in relation to the protection of intellectual property could be those of existing instruments relevant to this agreement, that is the International Conventions or Agreements. The Negotiating Group will need to consider the means by which parties could give effect to these minimum standards.

Any statement regarding minimum standards in the agreement should be no more detailed or complex than is necessary to address the major causes of trade distortion.

Provisions relating to trade in counterfeit goods could be incorporated into the structure of the TRIPS agreement, and the dispute settlement mechanism would apply equally.

New Zealand considers that the overall TRIPS agreement, in whatever form which may eventuate, could consist of:

- (a) general obligations on Governments which would incorporate common GATT principles and disciplines, such as transparency, national treatment and mfn;
- (b) a minimum set of standards and norms addressing specifically the intellectual property area. These would be concerned with:
  - (i) intellectual property rights and their protection (i.e. standards);
  - (ii) a further set of obligations relating to how those rights can be made effective (i.e. enforcement);
- (c) mechanisms for the multilateral resolution of any disputes that may arise between parties. These would be modelled closely on existing GATT procedures and should include specific provision for the use of technical experts (for example analogous to those given in Article 14.9 of the Agreement on Technical Barriers to Trade).

The agreement could also incorporate provisions for transitional arrangements aiming at the fullest participation in the results of these negotiations. Such provisions could include the concept of a transition period to assist countries to adjust to the set of standards and norms for the protection of intellectual property.

The following standards and norms are presented by New Zealand as a basis for adequate minimum standards in the area of intellectual property rights which could be adopted in national legislation. These standards and norms are without prejudice to the outcome of intensive reviews now underway on New Zealand's statutes relating to copyright and to patents, trademarks and designs, which are intended to update these statutes.

### Copyright

Literary and artistic works should be protected in accordance with the rights conferred under the relevant International Conventions, including the Berne Convention for the Protection of Literary and Artistic Works.

It is considered that the standards and norms in these Conventions are sufficient for the purposes of the agreement.

### Neighbouring Rights

Neighbouring rights should be protected in accordance with the provisions of the Geneva Convention for the Protection of Producers of Phonograms against Unauthorised Duplication of Their Phonograms.

### Patents

#### 1. Patentable subject matter

A patent shall be granted for an invention. However, some subject matter may be regarded as unpatentable; for example:

- (a) the mere presentation of information;
- (b) mere discoveries;
- (c) schemes, rules or methods of performing a mental act, playing a game or doing business; and
- (d) inventions the use of which would be contrary to public order or morality.

#### 2. Conditions for patentability

Conditions for the granting of a valid patent are that the invention must possess:

- novelty
- non-obviousness
- utility

#### 3. Term of protection

The term of patent shall be a minimum of sixteen years. Extensions of term for prescribed reasons may be available.

#### 4. Rights conferred

A patent grant shall give the patentee an "exclusive right", to stop others from using the invention during the patent term.

The patentee is entitled to make, sell, use or exercise the invention protected by the patent.

5. Compulsory licensing

A compulsory licence may be given to address a declared national emergency or to remedy an adjudicated anti-competitive practice or in cases where Government exploitation of that patent is essential. In the case of a national emergency or government exploitation for national interest reasons, the compulsory licence should be granted only for the duration of that emergency and payment of adequate compensation should be granted to the patentee.

A compulsory licence shall be non-exclusive and should be subject to review by a court of law.

Trademarks

1. Definition

The term "trademark" shall include service and goods marks and certification marks.

A mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, three dimensional shape or any combination thereof.

A mark is any of the above when used or proposed to be used for the purpose of indicating a connection in the course of trade between the goods or service and the owner.

The following trademarks are not capable of being registered:

- (a) Marks which lack "distinctive" character;
- (b) Marks which contain scandalous matter or which would be contrary to law or morality;
- (c) Marks which would be likely to deceive or cause confusion;
- (d) Marks which are in conflict with earlier rights.

2. Derivation of rights

Actual use should not be a pre-requisite for registration.

3. Rights conferred

Trademark registration should give the registered proprietor the exclusive right to the use of the trademark in respect of the goods and services for which it is registered, and to prevent others from using the same or similar goods or services where such use would result in a likelihood of confusion.

4. Protection of well-known marks

Protection shall be provided for well-known marks. There should be protection for marks which are so well-known that the use of another identical or similar mark would cause confusion or public deception.

5. National registration system

Trademarks may be protected through a system of registration.

6. Term of protection

A system of registration should provide for a defined term.

7. Use requirements for maintenance of protection

Non-use of a registered trademark over an uninterrupted period of at least five years may be grounds for revocation.

8. Compulsory licensing

There should be no provisions for compulsory licensing of a trademark. Voluntary licensing is permitted.

Industrial Design Rights

1. Definition

The provisions of the Paris Convention are considered sufficient for the purposes of protecting industrial designs.

2. Criteria

An industrial design may be granted a right if the design is new or original.

3. Rights conferred

An industrial design right should give the owner "the exclusive right" to make or import for sale or for use for the purposes of any trade or business, or to sell, hire or offer for sale or hire, any article in respect of which the design is registered.

4. Term of protection and renewal

Initial protection should be for a minimum of five years with provisions for limited renewals.

Geographical Indications

In order to avoid consumers being confused or deceived as to the place of origin of goods there should be a provision to prohibit false or misleading use of geographical indications.