

MULTILATERAL TRADE
NEGOTIATIONS
THE URUGUAY ROUND

RESTRICTED

MTN.GNG/NG11/W/58
12 December 1989
Special Distribution

Group of Negotiations on Goods (GATT)

Original: English

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

ENFORCEMENT OF TRADE-RELATED INTELLECTUAL PROPERTY RIGHTS

Submission from the Nordic Countries

The following communication has been received from the delegation of Norway on behalf of the Nordic countries (Finland, Iceland, Norway and Sweden) with the request that it be circulated to the Negotiating Group.

INTRODUCTION

1. The TRIPS agreement should contain an obligation for Signatories to maintain procedures for effective enforcement.
2. Effective enforcement would entail adherence to the following basic principles:
 - MFN/non-discrimination. Signatories would be obliged to extend to all nationals, goods and services of other Signatories any benefits accorded to nationals, goods and services of any other country as regards the specific commitments made in the agreement. Certain exceptions will be needed for bilateral or other international arrangements on legal cooperation. Arbitrary or unjustifiable discrimination between nationals, goods and services of other Signatories would not be allowed.
 - National treatment. Protection and enforcement of IPRs covered by the agreement should be equivalent in effect irrespective of whether the right holder is a national or from another Signatory and irrespective of whether the goods or services concerned are domestically produced or imported. Certain exceptions will be needed relating to e.g. jurisdiction and appointment of an agent.
 - Transparency. Provisions on publication, notification, exchange of information and consultation would be needed in the agreement.
3. The TRIPS agreement should oblige Signatories to ensure that enforcement procedures do not give rise to obstacles to legitimate trade or disguised restrictions on international trade.

4. The provisions on enforcement should cover those IPRs which are included in the agreement.

5. Procedures for internal enforcement should constitute the main instrument for securing effective protection. Measures at the border should, however, be an important complement for those IPRs which can be subjected to such procedures.

6. The provisions should be formulated as general rules acceptable to different national legal systems. Formulations reflecting country-specific features must therefore be avoided. Signatories must, however, be prepared to amend national law, leaving their legal systems basically unchanged.

7. The provisions should be sufficiently detailed and specific to guarantee enforcement of the agreed level and scope of protection of IPRs and to make multilateral dispute settlement possible.

8. A reference to acquisition of intellectual property rights could lay down rules to the effect that registration, if required, should be granted within a reasonable period of time and that there should be a right of review of decisions on acquisition of IPRs.

INTERNAL MEASURES

9. The TRIPs agreement should contain provisions on civil judicial procedures. Parties should be entitled to substantiate their claims and present evidence as well as to exercise their right of defence with regard to all relevant acts such as imports, internal production and use. Decisions should be reasoned and made without undue delay in a fair and open manner. There should also be a right to judicial review.

10. The judicial authorities should be provided with the authority to issue an order for the discontinuation of an act involving infringement of an IPR, and for forfeiture and destruction of infringing goods when deemed necessary. In cases of infringement the right holder should be entitled to remuneration for the exploitation. In cases of wilful or negligent infringement adequate compensation should be given to the right holder.

PROVISIONAL MEASURES

11. The agreement should also provide for procedures for provisional judicial or administrative measures. The objective of these measures should be to deter infringement and to provide the right holder with an opportunity to bring ongoing infringement to an immediate halt.

12. To prevent abuse, the plaintiff should be required to furnish both evidence with regard to the infringement and adequate security for compensation to the defendant in case the provisional measure turns out to be unjustified.

13. If a provisional measure is taken by an authority other than a judicial authority, the defendant should be given the possibility to have

the provisional measure submitted to judicial review. If a provisional measure has been taken inaudita altera parte, the defendant should be given the right to full review.

14. A decision allowing for a provisional measure should specify the period of duration of the measure. The measures should lapse if within the expiry of such a period the plaintiff has not obtained a prolongation or has not initiated or fulfilled legal proceedings.

BORDER MEASURES

15. Border measures should be seen as a specific form of provisional measures. Accordingly, the Nordic position on provisional measures as outlined above also applies to border measures.

16. Signatories should be obliged to provide for and maintain procedures whereby a right holder can apply to a competent authority to have the customs authorities suspend customs clearance of imported counterfeit or pirated goods.

17. In addition to the safeguards against abuse contained in the general provisions on provisional measures, a border measure should lapse if the right holder has neither initiated legal proceedings with a judicial authority competent to take decisions on the merits of the case, nor has obtained a prolongation of the border measure or another provisional measure from a judicial authority, within two weeks after he has been informed that the customs clearance of particular goods has been suspended.

CRIMINAL PROCEDURES

18. In cases of wilful infringement of intellectual property rights criminal procedures and sanctions should apply.