



Comments on the UPC Rules of Procedure

- 15th Draft of Rules of Procedure
- Public consultation 25 June – 1 October 2013
- Some 400 rules
- Some 50 Rules commented by AIPPI
- Varied from edit/typos to substantive comments on controversial issues
- Most debate on “Protective letters” Rule 207



- Q238 – Second medical use and other second indication claims (Sarah Matheson)
- Q239 – The basic mark requirement under the Madrid System (Sara Ulfsdotter & Anne Marie Verschuur)
- Q240 - Exhaustion issues in copyright law (Kazuhiko Yoshida)
- Q241 – IP Licensing and Insolvency (John Osha)

Working process

- Topics proposed by National Groups and Special Committees
- Programme Committee (in co-operation with Reporter General Team) selects and refines
- Working Questions are adopted by ExCo
- Introductory Session at annual meeting
- Preparation of Working Guidelines
- Preparation of Group Reports

Working process

- Preparation of Summary Report
- Selection of Working Committee leadership
- Preparation of draft Resolution
- Debate in Working Committee
- Debate in Plenary Session
- Adoption of Resolution in ExCo II
- Resolutions are communicated and used for preparing positions etc.

Q238 – Second medical use and other second indication claims



- Patent protection per se?
 - Not allowed – India, Egypt, Andean Community of Nations
- If allowable - Scope of claims
 - Claims to the method of treatment?
 - ‘Swiss-type’ claims?
 - Claims to the formulation for a particular purpose?
 - Claims to new dosage regimes/forms of administration?
- Variation in enforcement
- Variation in term

Questions to explore



- Are patents covering any aspect of new uses of known pharmaceutical compounds permitted?
- If yes, against whom are such claims enforceable
- How do courts determine infringement?

Q239 – The basic mark requirement [...]



- An international registration (IR) is generally an efficient way to obtain trademark protection in many countries
 - First basic registration in country of origin of trademark owner (the basic mark requirement)
 - Then other countries can be designated as part of an IR
- In the first five years, an IR can be nullified by nullifying the basic registration (central attack)



Relevance

- In favour of abolishing the basic mark requirement:
 - Central attack too far-reaching
 - Simplification/cost benefits
- Against abolishment basic mark requirement:
 - Balanced, well working system
 - Central attack is an efficient tool

Questions to explore

- Do the national groups support a change of the basic mark requirement?
- What form should any changes take?
 - E.g. shortening of central attack period from five to three years, no requirement that basic registration in country of origin TM owner
- What are the pros and cons of such changes?

Q240 - Exhaustion issues in copyright law



- In a tangible world, exhaustion of copyright is a widely accepted principle.

After the first sale of a copyrighted work in the form of a tangible good with the consent of the right owner,

⇒ the distribution right derived from copyright is said to be “exhausted”.

Exhaustion in the digital world



- In the digital world, less and less data carriers are used for the distribution of copyrighted works.
- Software, music, films, games or e-books may be downloaded from online-shops for permanent or temporary use.

Questions to explore

- Are downloaded copies fully comparable with copies bought on tangible data carriers?
- How do you guarantee adequate remuneration for the right holders?
- Should "re-sellers" of digital copies be allowed to further re-sell that digital?
- Should software and other works (e.g., music files, e-books and videos) be treated equally?
- Multi-user-licenses; would it be allowed to split them up and sell them separately?

Q241 – IP Licensing and Insolvency

- Do current national laws or jurisprudence provide rights / obligations for licensee / licensor in the event of insolvency?
- In the event of insolvency of a party to a license, what would provide an appropriate balance between protecting the rights of the other party and allowing the bankrupt estate to maximize value to creditors?

Questions to explore



- What rights / obligations should a licensor have vis-à-vis a third party purchaser of an insolvent licensee?
- In the case of co-owners of licensed IP rights, what should be the effect of insolvency of one of these co-owners?
- If a license includes providing know-how to licensee, how should the right to use this know-how affected by insolvency of the licensor?
- Is the use of a registration system desirable?

Sara Ulfsdotter, Assistant to the Reporter General

sara.ulfsdotter@lindahl.se

s.ulfsdotter@aippi.org