

# WIPO



ACE/IP/1/4

ORIGINAL: English

DATE: October 19, 2000

**WORLD INTELLECTUAL PROPERTY ORGANIZATION**

GENEVA

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## **ADVISORY COMMITTEE ON ENFORCEMENT OF INDUSTRIAL PROPERTY RIGHTS**

**First Session**

**Geneva, October 19 and 20, 2000**

DISCUSSION PAPER  
ON THE ENFORCEMENT OF INDUSTRIAL PROPERTY RIGHTS

*Document submitted by the Delegation of Japan*

### Summary

This paper outlines the topics that may be discussed within the framework of WIPO toward the effective enforcement of industrial property rights. This paper consists of two main parts: general issues and specific issues.

While this discussion paper is presented with a certain degree of specificity, it is primarily intended to focus its attention on a conceptual framework for future work under WIPO.

### Discussion

The main tasks of industrial property administration are to properly grant industrial property rights, to adequately protect the granted industrial property rights, and to encourage active and effective utilization of the industrial property rights. However, goods infringing industrial property rights are distributed worldwide today. Industrial property right holders and consumers are now suffering considerable losses due to the distribution of such goods.

In recent years, there has been scarcely any chance to discuss enforcement-related activities of WIPO. Discussion about enforcement within the framework of WIPO, however, is indispensable for establishing an environment for adequate protection of industrial property rights in the future.

On the other hand, anti-counterfeiting activities conducted by non-governmental organizations in cooperation with government organizations are now achieving results. WIPO should give its utmost support to these activities.

At the first session of the Advisory Committee, we should establish a foundation for future discussion about the direction of WIPO's activities in this area.

### General Issues

At the first session, the direction of the Committee should be discussed in order to establish the foundation for future discussions. The following are proposed general issues to be discussed.

#### 1. Scope of discussion

Infringing activities are mainly carried out in the fields of trademarks and copyright, more specifically, fake brands and pirated compact disks. The issue of intellectual property rights enforcement cannot be fully realized without taking infringements of copyright into consideration. Thus, it is desirable to closely cooperate with the Advisory Committee on Management and Enforcement of Copyrights and Related Rights in order to effectively deal with issues of common concern.

#### 2. Relations with the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)

The TRIPS Agreement has greatly contributed to an effective enforcement of industrial property rights, and consequently the level of enforcement activities has remarkably increased worldwide. Under the WIPO-WTO Agreement, legal-technical cooperation both by WIPO and WTO has been provided to developing country members of WIPO and WTO, in regards to the TRIPS Agreement. WIPO should continue to provide this helpful assistance.

There are still strong demands for enforcement-related activities, for example from the private sector, while the TRIPS Agreement comprehensively contains a number of provisions related to enforcement. Therefore, under WIPO, the scope of discussion should not be necessarily limited to the TRIPS Agreement implementation.

#### 3. Schedule, systems, and budget in the future

As regards the session schedule of the Advisory Committee, the second session should be held in the first quarter of 2001 so that the outcome of the discussions at this Committee can be reported to the next session of the assemblies of the member states of WIPO for approval. The report of the Committee may include: (a) an action plan of the enforcement-related activities of WIPO; and (b) recommendations for an appropriate framework to implement the action plan.

#### 4. Collaboration with enforcement organizations

WIPO is an international organization that specializes in activities relating to intellectual property rights; it is not an enforcement organization. To secure effective enforcement, therefore, WIPO has to make joint efforts with enforcement organizations. Considering the roles of WIPO, it is important that WIPO actively collaborate with enforcement organizations (e.g., in the field of information exchange), giving due consideration to the confidential nature of information treated by enforcement organizations.

#### Specific Issues

Possible contributions by WIPO in the field of enforcement can be: (a) the improvement of enforcement systems in member countries; (b) the making of rules; and (c) the gathering of information on enforcement. From this standpoint, Japan suggests that the future actions by WIPO can include the following.

##### 1. Formulation of guidelines, guiding principles, best practices, or model provisions

The WIPO Committee of Experts on Measures Against Counterfeiting and Piracy once drafted the Model Provisions for National Laws in 1988, which were not adopted at that time.

It is important that the guidelines, guiding principles, effective practices, or model provisions that members refer to for efficient enforcement be adopted within the framework of WIPO so that countries can get better understanding of the enforcement process and learn how to improve their current practices.

##### 2. Construction of information exchange network

If a right that is registered in multiple countries using such international treaties as the Patent Cooperation Treaty (PCT) or the Madrid Protocol is infringed in one country, similar cases of violation are likely to occur in other countries.

Establishment of an information exchange network will be helpful to prevent such spread of infringement. Under this network, national industrial property offices or enforcement agencies in the country in which the first infringement occurred should notify WIPO of such incidence. WIPO then notifies all the other members to the related treaties of this infringement in order to prevent further spread of the violation.

##### 3. Establishment of certification system

WIPO or national organizations should be able to give certification to the distributors, manufacturers, and exhibition sponsors that satisfy certain conditions prescribed by WIPO; e.g., they should employ staff who deal with anti-counterfeiting measures, or they should conduct training courses on industrial property.

One of the advantages of this system is that distributors, manufacturers, and exhibition sponsors can show their credibility to the public. The public, on the other hand, will be able to identify reliable distributors, manufacturers, and exhibition sponsors.

4. Analysis of current status and the publication of white paper on counterfeiting

It is important to ascertain the actual amount of damages in order to improve anti-counterfeiting measures. National governments, private organizations, and international organizations should submit reports to WIPO on damages caused by counterfeiting as well as their anti-counterfeiting measures. WIPO should then consolidate these reports and issue a White Paper on Counterfeiting.

5. Establishment of the contact points

Each member country establishes contact points on enforcement in industrial property offices and reports them to WIPO. Contact points exchange information such as statistical data of industrial property right infringement cases.

6. Effective training of enforcement-related personnel

It is important to train enforcement-related personnel because on-site practices, in addition to the improvement of legal systems, are major factor of enforcement.

Therefore, WIPO should make lists of training programs for enforcement-related personnel prepared by each member country and international organizations in the field of industrial property. Because these lists will reduce redundancy and encourage cooperation among members in the fields of training, training programs can be more efficient as a whole.

7. Public education

One of the problems of counterfeiting is the lack of awareness of consumers who tend to buy counterfeit goods without much respect for industrial property rights. Therefore, it is necessary for the public to be educated by measures below:

(a) educate students on industrial property rights to raise awareness on the importance of industrial property rights protection; and

(b) organize a global anti-counterfeit campaign to raise public awareness on industrial property rights protection.

8. Education of industrial property right holders

To solve counterfeiting problems, it is indispensable for right holders to take positive action.

Therefore, WIPO should hold seminars and publish manuals on how to enforce industrial property rights in each member country in order to educate right holders.

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