WIPO

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WORLD
INTELLECTUAL PROPERTY
ORGANIZATION


Linking the World
26 APRIL
WORLD INTELLECTUAL PROPERTY DAY
10th Anniversary
www.wipo.int

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THE WIPO CONVENTION – LIFE BEGINS AT 40!

It was an *abracadabra* moment… that took place 40 years ago, on April 26, 1970. Two small, French-speaking, Swiss-led "bureaux," rooted in a couple of 19th century treaties, were transformed into a single, multilingual, member-state-driven international organization. That organization would soon become a UN specialized agency and would adopt a new treaty – the Patent Cooperation Treaty (PCT) – that would not only bring it world renown and financial stability, but revolutionize the international patent system.

It was on that day, four decades ago, that BIRPI became WIPO – or, to put it less succinctly, the *Bureaux internationaux réunis pour la protection de la propriété intellectuelle* became the World Intellectual Property Organization.

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The Convention Establishing the World Intellectul Property Organization was hammered out in the halls of the Swedish Parliament in Stockholm.

The "magic wand" responsible for this metamorphosis – the Convention Establishing the World Intellectual Property Organization – had been crafted during a five-week-long conference of BIRPI member states in the halls of the Swedish Parliament in Stockholm in 1967. The agreement reached at that time, and distilled into the text of the Convention, not only established WIPO but also revised the Organization's two key treaties – the 1883 Paris Convention for the Protection of Industrial Property (then with 77 members, now 173); and the 1886 Berne Convention for the Protection of Literary and Artistic Works (then with 58 members, now 164). It also modified five special agreements established under the Paris Convention, mainly dealing with the registration and classification of marks, registration of industrial designs, and the protection of appellations of origin. The Convention was signed in English, French, Russian and Spanish, ushering in a new era of multilingualism within the Organization.

On a structural level, three governing bodies were set up within WIPO: the Conference, the General Assembly and the Coordination Committee. These were to meet regularly, in contrast to the previous arrangement under BIRPI whereby Member States of the Paris and Berne Conventions (which BIRPI had been set up to service) had made decisions on an *ad hoc* basis for some 87 years – mainly in diplomatic conferences of revision held, on average, every 20 years. Control of BIRPI's activities and finances had been essentially exercised by Switzerland, the Bureaux's host country, which also appointed the staff, including the Director. With the entry into force of the WIPO Convention, this control passed to Member States and, to a certain extent, the WIPO Director General elected by those States.

Just a beginning

In the last 40 years, the 6 original treaties managed by BIRPI have grown in number, in tandem with a changing technological landscape, and now count 24, including the WIPO Convention. The Organization's Member States currently stand at 184 and its working methods have changed beyond imagining with the arrival of wireless technology and the web. Intellectual property (IP) and the innovation at its heart have taken on a new global significance, increasingly recognized as a means of wealth creation, of improved living stan-

"The technological, economic and social changes since 1970 have transformed the international IP landscape. In those 40 years, WIPO has also changed, growing into a dynamic, forward-looking and truly global entity, focused on the use of IP to promote innovation and creativity for economic, social and cultural development."

WIPO Director General Francis Gurry

dards and, perhaps most important, of developing solutions to the daunting challenges related to climate change, spiraling energy needs, food security and public health, that are facing us all.

At age 40, WIPO has taken on these new challenges, implementing programs to encourage the use of the IP system as leverage for economic development and focusing on cooperation with other UN organizations to find solutions to global problems. The road ahead for the Organization and the international IP system promises to be rocky in parts but also fascinating, as the IP landscape morphs and changes under the influence of accelerating advances in technology, rapid globalization and an increasingly sophisticated and all-encompassing digital environment. WIPO will continue to spearhead international discussions on these and other such IP-relevant issues.

In this anniversary year, WIPO will launch a new corporate logo (see page 4) and expand its headquarters with a new building that will allow all staff to be brought onto one site. This year also marks the 10th anniversary of World Intellectual Property Day – the date of which was set to coincide with that of the entry into force of the WIPO Convention. The WIPO Magazine traces the story of IP Day over the last decade and highlights the chord it has struck with Member States. It records the innovative ways the IP community has used this annual opportunity to showcase the enormous contribution inventors and artists make to enriching our daily lives. It will also highlight the theme for this year's celebrations: Innovation – Linking the World.

WIPO 2.0: New YouTube™ Channel Launched

Watching videos has become one of the most popular online activities. The video-sharing site YouTube™ – just another Internet startup a few years ago – is now one of the most visited websites wiwell over a billion views a day. Going where the audience is, WIPO has set up a YouTube presence: the WIPO channel. Aimed at the general public, the channel features documentaries and interviews with artists, creators and inventors showing how creativity and innovation affect their own and our lives, giving IP a human face. A selection of informational and promotional videos, as well as videos in French and Spanish, round off the offer.

Interactivity is an important feature of the WIPO channel. Users are not only encouraged to rate, comment on and subscribe to the videos, but also to share their own content by becoming "IP Reporters," local correspondents of the WIPO channel in their own neighborhood. IP Reporters from around the world are invited to submit videos telling their own story, or that of their favorite authors, inventors or entrepreneurs, and how IP protects their works and allows them to profit from their talents. WIPO also welcomes submissions of video content covering events and activities organized to celebrate World IP Day.

To find out how Dr. Ramón Barba's invention benefits mango growers in the Philippines, what Jamaican musician Shaggy thinks about copyright, and how counterfeit medicines have affected Tolomeo's life, visit WIPO's YouTube channel, which already has as many as 70 videos available. Stay tuned, as more content from both WIPO and its IP Reporters will be added throughout the year.

THE NEW WIPO LOGO

WIPO is revamping its corporate image and, at the heart of it, creating a new logo, which will be unveiled on April 26, 2010.

The new WIPO logo is a powerful symbol of WIPO's revitalization and strategic repositioning in line with rapid changes in the field of intellectual property (IP). The design is contemporary, memorable, and distinctive. It projects dynamism and innovation.

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The new logo is based on a graphic representation of the WIPO headquarters building, an iconic structure familiar to WIPO Member States and stakeholders. The color blue links the Organization with the United Nations. The seven curved lines represent the seven elements of IP, as set out in the WIPO Convention:

- literary, artistic and scientific works,
- performances of performing artists, phonograms, and broadcasts,
- inventions in all fields of human endeavor,
- scientific discoveries,
- industrial designs,
- trademarks, service marks, and commercial names and designations,
- protection against unfair competition, and all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields.

The spaces between the blue lines signify transparency and openness. The gathering sweep of the curves is inclusive and embracing – WIPO is an open forum, welcoming all stakeholders and points of view. The dynamic, upward pitch of the curves represents ideas, movement, and the progress which comes from using innovation and creativity as a means of improving the world. All of this rests on a strong foundation, the name and acronym of the Organization.

WIPO is undergoing a major strategic repositioning, moving into new areas in order to keep pace with the rapid technological, cultural and social changes affecting the world. It is an organization that looks to the future, and its new brand reflects that direction. The new logo is progressive and forward-looking, while linked to WIPO's history and tradition at the center of international IP policy. Its clean, modern lines reflect the Organization's central corporate values, notably trust, reliability, efficiency.

April 26, 2010, marks the 10th World Intellectual Property Day, as well as the 40th anniversary of the entry into force of the WIPO Convention that established the Organization – an ideal date to launch the new logo.

History of the WIPO Logo

The origin of the WIPO logo dates to 1962 when a design representing WIPO's predecessor organization, the *Unions Internationales Propriété Intellectuelle* (UIPI), appeared on some of its publications. That image, similar to the WIPO logo, contained the acronym UIPI at the center. In 1963, that acronym was replaced by the acronym of the *Bureaux internationaux réunis pour la protection de la propriété intellectuelle* (BIRPI). Then, in 1964, the Director of BIRPI officially communicated the BIRPI logo, name and abbreviation to the Member States of the Paris Union, for protection under Article 6*ter* of the Paris Convention for the Protection of Industrial Property.

In July 1970, the year the Convention Establishing the World Intellectual Property Organization entered into force, the WIPO logo was communicated to the Member States of the Paris Union for protection under Article 6*ter* of the Paris Convention. Since then, it has appeared on the Organization's documents, publications, buildings and other related materials.

INNOVATION LINKING THE WORLD

WORLD INTELLECTUAL PROPERTY DAY – 2010

Message from Director General Francis Gurry

Dhillon Photographics

Relatively few decades ago, the world remained vast and largely unknown for most people. Travel was costly and long. Knowledge was paper-based and hard to share. Telephone service was, in many places, non-existent. Outside of large cities, access to foreign culture and the arts was limited.

Rapid innovation and its global adoption has transformed our outlook. We are now linked – physically, intellectually, socially and culturally – in ways that were impossible to imagine. We can cross continents in a few hours. From almost anywhere on the planet, we can access information, see and speak to each other, select music, and take and send photographs, using a device small enough to fit in the palm of a hand.

This universal connectivity, sustained by the Web and wireless technology, has huge implications for the future. With the "death of distance," we are no longer limited by physical location – and the benefits are legion.

Web-based learning frees intellectual potential in previously isolated communities, helping to reduce the knowledge gap between nations. Sophisticated video-conferencing techniques reduce business travel, diminishing our carbon footprint. Mobile telephony, already used by over half the world's population, transforms lives and communities: Solar powered mobiles are helping track disease, run small businesses, and coordinate disaster relief in areas previously out of reach.

Rapid data management and exchange speed the innovation cycle, facilitating collective innovation and promoting mutually beneficial collaboration between companies, research institutions and individuals. At the same time, digital technologies are enabling like-minded people to create virtual platforms from which to work on common projects and goals – such as WIPO's web-based stakeholders' platform, aimed at facilitating access to copyrighted content for the estimated 314 million persons with visual and print disabilities world wide.

Innovative technologies are creating a truly global society. The intellectual property system is part of this linking process. It facilitates the sharing of information – such as the wealth of technological know-how contained in WIPO's free data banks. It provides a framework for trading and disseminating technologies. It offers incentives to innovate and compete. It helps structure the collaboration needed to meet the daunting global challenges, such as climate change and spiraling energy needs, confronting us all.

WIPO is dedicated to ensuring that the intellectual property system continues to serve its most fundamental purpose of encouraging innovation and creativity; and that the benefits of the system are accessible to all – helping to bring the world closer.

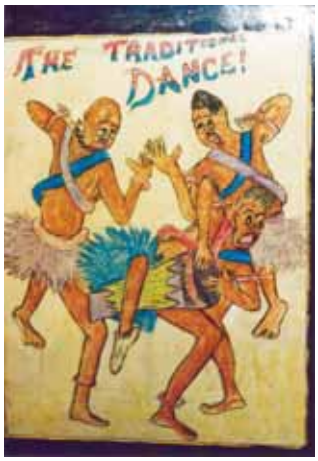
A DECADE OF CELEBRATING CREATIVITY

It seems like yesterday that Algeria and China tabled a proposal at the WIPO Assemblies to establish April 26 as World Intellectual Property Day. It was September 2000 and the theme of the first celebration, to take place on April 26, 2001, was "Creating the future today."

Despite the short notice for that first celebration, Member States were enthusiastic in their response. Over 50 reported having held events – from simple open-door days at national intellectual property (IP) offices to full weeks of activities with concerts and gala celebrations to award outstanding inventors and creators.

The exhibition Creativity by Children – A Chinese Experience featured a collection of drawings made by Chinese children for the celebration of the first World IP Day in 2001.

The following year's theme – "Encouraging creativity" – would be a recurring one, repeated in different ways in 2004 and 2007. Requests from Member States and observers for ideas on how to make the most of World IP Day inspired WIPO to propose potential IP outreach activities that could help to generate public and media interest in IP issues. Some 70 Member States took up the challenge. IP was in newspapers from Bhutan to Uruguay, on radios from Cuba to Kazakhstan, on television sets from Antigua and Barbuda to Mauritius, on the Internet, in the streets of Kenya and Zimbabwe…



Kenya organized a week of activities in 2002, including an IP Day march by Boy Scouts, a traditional dance evening with music and poetry and a symposium on the Encouraging Creativity theme.

Counterfeit CDs were destroyed publicly on April 26, 2003, in Peru as part of an anti-piracy campaign.

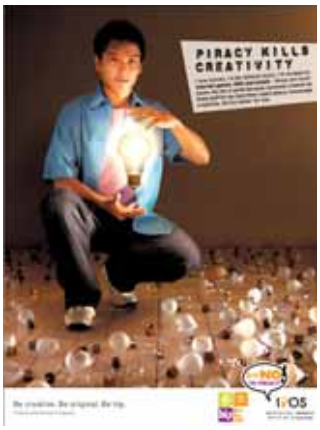
"Make IP your business," the theme for 2003, was an appeal to entrepreneurs to fully capitalize on their intellectual assets and to use the tools of the IP system to further their business goals. It was also a wider call for civil society to recognize that respect for IP rights benefits not only creators but society as a whole. WIPO dispatched some 800 World IP Day kits containing the publication *IP – A Power Tool for Economic Growth (Overview)*. Many events that year focused on anti-piracy campaigns, including the actual destruction of counterfeit goods.

The opening of a seminar and exhibition to mark IP Day in Ghana in 2004.

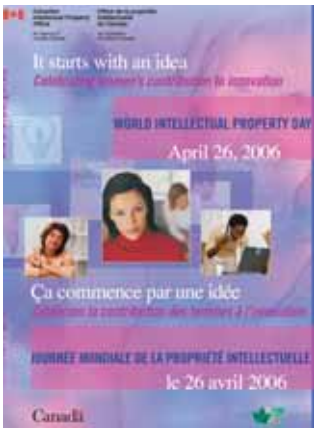
It is never too soon to start learning about the importance of creativity and innovation in building a better world, and young people were the focus of many celebrations in 2004, including outreach activities by IP offices in local schools. WIPO distributed 78 copies of the "Creative Planet" video series for broadcast in 44 countries, and also released three television spots on the theme "Encouraging Creativity," which were aired by CNN. It was also the occasion to launch two new guides in the "IP for Business" series for small and medium-sized enterprises (SMEs).

Intellectual property stamps issued by Hong Kong for World IP Day 2004.

"Think, imagine, create," the theme of the fifth World IP Day, encouraged young people everywhere to recognize the creator, the problem-solver, the artist within themselves. WIPO's "Striving for Excellence" exhibition, inaugurated on World IP Day, aimed to stimulate the young to think about the presence of IP in their everyday lives – and to create their own – by looking at the world of sports. Many offices geared their IP message and activities towards children, organizing special competitions and other events to give them a first glimpse at how their own creativity can make a difference in the world.



An anti-piracy poster produced by Singapore for World IP Day in 2005.



The Canadian Intellectual Property Office focused its activities on women in innovation in 2006.

The extensive worldwide press coverage of the 2006 World IP Day – "IP: It all starts with an idea" – confirmed growing recognition of the annual event and its role in conveying the importance of IP. Events to mark the day ranged from large-scale gala evenings with live concerts and awards ceremonies, to local folkloric music and dance festivities, to exhibitions at IP offices. Many IP offices held activities for specific IP right holders, and themes of respect for IP were at the forefront. Some countries celebrated the event for the first time, while others built on technology and innovation promotion programs dating from before the first World IP Day celebration.

Korean Ministry of Culture & Tourism)

In 2006, Jisoo Kim won first prize in the Korean IP Day essay competition based on the Korean comic, *Copy and paste: What's wrong?*

Distribution of WIPO comics in a Bahrain shopping mall in 2007.

For many people, the connection between IP and creativity is far from obvious. The word "creativity" conjures up a world of artists and musicians, of poets and problem solvers; whereas, IP summons images of lawyers and courtrooms. But it is the IP system that sustains those creators and the "Encouraging Creativity" theme in 2007, underscored this. WIPO hosted a discussion on "Making IP Work for Development" that generated input for the Development Agenda. World IP Day also brought together those who question the IP system: various blogs debated the validity of the patent system, and others tackled issues of copyright and the public domain.

With the growing popularity of World IP Day, public and private-sector organizations turned their creative talents to finding new ways to attract attention to the slogan in 2008: "Innovation – Respect it!" National IP offices increasingly produced their own messages and posters, targeting their specific needs for increasing IP awareness. Many focused on the importance of fostering in-

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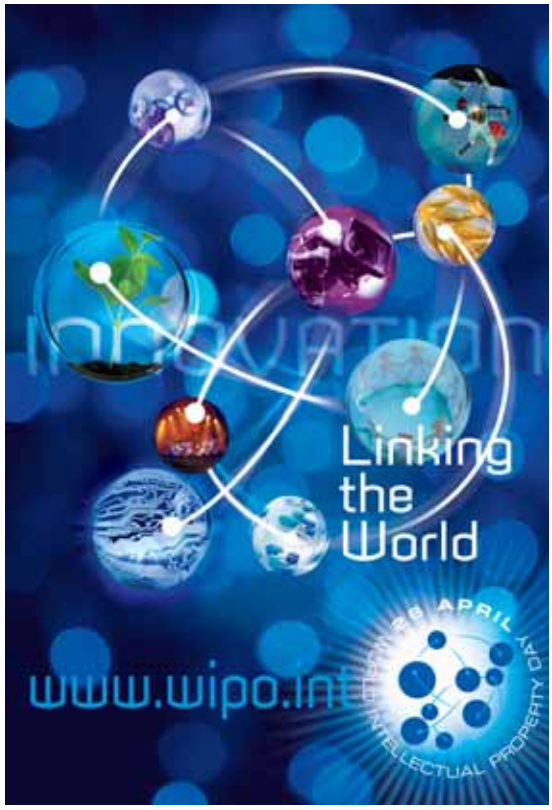
Mexico promotes World IP Day 2008.

2008 poster of the Polish Patent Office.

novation in solving global problems and improving well-being, and of respecting the fruits of that innovation by promoting respect for the related IP rights.

"Green innovation," the theme in 2009, hit a mark with IP stakeholders and engaged a broader public. The message from WIPO Director General Francis Gurry, "human ingenuity is our best hope," struck a positive note in audiences preoccupied by dismal economic forecasts and looming environmental problems. Never had there been such an outpouring of creative IP posters from around the world, not to mention the many and varied activities to promote interest in the theme. WIPO published a Green Innovation Special Issue of the WIPO Magazine, reinforcing the IP Day message with articles that highlighted the links between innovation and the IP system. In keeping with the spirit of the theme, WIPO made its IP Day materials available for download, and also launched an organization-wide Carbon Neutrality Project.

To mark the 10th anniversary of World IP Day, WIPO will host an exhibition showing the event's evolution over the years. Tapping into the heart of creativity, this year's IP Day theme focuses on "Innovation – Linking the World." Advances in, for example, information and communication technologies, have progressed by leaps and bounds in recent years, bringing information and services to more and more people worldwide. Rapid technological changes coupled with pressing global challenges (such as climate change, food security, access to health care) mean that innovation, and the infrastructure that enables it, are increasingly important. New approaches such as open innovation take advantage of the benefits of the IP system and ensure that vital know-how and ingenuity can be shared with other solution seekers. All of this means that an understanding and awareness of IP and the need for its protection is increasingly critical.



Looking back over the last 10 years is also a time for looking forward, to the next 10 – and to what the future of IP might bring.

2009 posters from MAWHIBA, Saudi Arabia; U.K. Intellectual Property Office; Asociación Argentina de Intérpretes; Universidad de Guadalajara, Mexico; Universidad Ricardo Palma, Peru; State Patent Office, Uzbekistan.

INNOVATION, THE ENVIRONMENT AND THE FUTURE

Innovative companies and individual bright sparks are creating new technologies that will help reduce global carbon emissions. Jo Bowman reports on how IP links the world in its search for a response to the global challenge of climate change.

The greenhouse effect and the issue of carbon-neutrality are now part of a global dialogue – never has awareness of the urgency of taking action been greater. The task is nothing less than radically changing the way we live and work. The Royal Institute of International Affairs in London says that to keep the rise in average global temperatures below a critical 2 degrees Celsius, global greenhouse gas emissions must peak before 2020, and be reduced to between 50 and 85 percent below 2000 levels by the year 2050.

The low-lying islands of the Maldives – extremely vulnerable to rises in sea level – are among the first countries to commit to becoming entirely carbon neutral. The government there is switching to renewable energy sources such as wind and solar power with the aim of hitting its zero-carbon target within a decade. The South Pacific Island state of Tuvalu has said it wants all its energy to come from renewable sources by 2020. Norway's government has pledged to be carbon neutral by 2030; Costa Rica is hoping to get there by 2021. And, in New Zealand, the prime minister has said that, by 2025, 90 percent of the country's energy must come from renewable sources, and transport emissions must be cut in half by 2040. Elsewhere, individual cities and states have declared their carbon-neutral intentions.

But if any of these ambitious targets are to be met, it will take much more than good intentions and community spirit. "Ensuring access to climate-friendly technologies at affordable prices is a critical issue for international public policy – and one that cuts across economic, legal, security and geopolitical concerns," says Ilian Iliev, co-founder and Chief Executive Officer (CEO) of intellectual property (IP) consultancy CambridgeIP. "It requires a critical mass of low-carbon investment, innovation and deployment that meets mid and long-term goals. The implications for corporate strategies and business models are profound."

Who owns the low-carbon future?

The role that IP rights play in the quest for a lower-carbon future is a contentious one. British think-tank Chatham House, in its report "Who owns our low-carbon future?" notes that, on the one hand are proponents of stronger IP rights regimes that encourage innovation in climate technologies; on the other is the argument that the IP system should be made more flexible, broadening access to technologies, particularly in developing countries.

The Chatham House authors, among them Mr. Iliev, are essentially in favor of strengthening IP protection. They argue that a patent portfolio can be used to attract venture capital, bring about strategic alliances, provide protection against litigation and create opportunities for mergers and acquisitions.

Appetite for low-carbon technologies has resulted in a flurry of applications worldwide to register patents on everything from stand-by lights for appliances that turn themselves off, through to new-fuel cars and carbon capture. Analysis of the Derwent patent database shows that, from 2003 to 2008, inventions for reducing power consumption numbered 1,200, compared to just 481 in the previous five years – the number granted in 2008 alone was 340. "It does suggest a major trend," says Steve Van Dulken, information expert with the British Library Research Service. A search for patents related to reducing the power consumption of appliances in stand-by mode reveals even more marked growth – from a total of only four between 1984 and 1988, to 62 between 2002 and 2008.

"What we see happening is typical of any kind of technology – the deployment of different types of technology very much grows in line with patent filing," says Alan MacDougall, a partner with IP attorneys Mathys & Squire. Patents relating to photovoltaic cells and wind power have risen, for example, he says, from between 300 and 400 a year, to closer to 1,600 filings per year. "There's a very,

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very clear correlation between the number of patent filings and products on the market."

The increase in patenting clearly shows that the IP system provides incentive for investing in research into environmentally-friendly technologies, thereby resulting in even more such products coming to market.

Limiting emissions leads to more patents

Businesses in some of the highest energy-consuming and biggest carbon-emitting industries are behind many of these innovations. In the auto industry, Rolls-Royce, for instance, filed 425 patent applications in 2008, a record number for the company, which invested £885 million in research and development that year, "a significant proportion" of which was aimed at reducing the environmental impact of its products. The global aviation industry, meanwhile, has agreed to cut its net carbon emissions to half of 2005 levels by 2050. The airline industry, if left unchecked, is forecast to account for up to 20 percent of all CO_2 emissions by 2050.

One of the major aircraft producers, Airbus, is developing new technologies to help bring this about, and protects its IP through patents. More than 380 patents have been filed in relation to technology developed for its double-decker A380 jet. "Significant breakthrough innovations have been achieved in aerodynamics, cabin design, engine integration, flight controls, aircraft systems, manufacturing techniques and the extensive use of advanced lightweight composite materials," the company says. "These intellectual property rights secure Airbus' innovations and form a solid basis for maintaining Airbus' lead in new technological developments." One of the patents relates to a new joining process for making a carbon fiber composite wing-box for commercial aircraft. About a quarter of the A380 is made from composites, leading to a weight saving over traditional construction of 15 metric tons that significantly reduces fuel consumption.

It is a little ironic that high-carbon companies control some of the IP that appears essential for the low-carbon economy. "Technological development does not evolve within the boundaries of economic sectors. This means that innovation can come from a range of sectors – high or low carbon ones," says Bernice Lee, Research Director, Energy, Environment and Resource Governance, The Royal Institute of International Affairs. "The good news is that this gives high-carbon industries potentially serious stakes in the future of a global low-carbon economy. The problem is that companies in these industries need to balance their short-term gains from high-carbon activities with investment in their long-term future."

Smaller companies are also using patents to secure their future in a lower-carbon business environment. Solarcentury, founded 11 years ago to design and supply solar energy solutions for residential and commercial buildings, uses patents to make sure it is not squeezed out of an increasingly popular industry. The company's chief innovation officer, Alan South, says solar power has averaged 40 percent compound growth over a decade. "The way we use patents' capability is a means of ensuring we have freedom to trade," he says." This guarantees that the company – which employs about 120 people – can operate without infringing anyone else's patents."

According to Mr. MacDougall, the biggest problem with green technology is deployment – getting technology to the marketplace. Many companies are developing new technologies, and they will develop their own proprietary systems, but it is likely to take years before significant progress is made in confronting the challenge of climate change. And time is of the essence if warnings about the rapidity of global warming are to be believed.

Borrowed time

Research at Chatham House shows inventions in the energy sector generally take two to three decades to reach the mass market. This time lag reflects the time it takes for any patented technology to become widely used in subsequent inventions. Data on 180 patents from six technology sectors relevant to carbon reduction show an average lag time of about 24 years. "The diffusion time for clean technologies globally will need to be halved by 2025 to have a realistic chance of meeting climate goals," says Mr. Iliev.

Moving quickly is especially important in emerging markets, where large infrastructure programs are being rolled out. Where low-carbon technology is available, it can be implemented on a grand scale; otherwise, investment will be made in higher-carbon technology, and the switch will not occur for some years.

Fast-tracking green technology

Several countries have implemented fast-track systems to enable patents relating to green technologies to "jump the queue;" among them, Australia, the Republic of Korea, the U.K. and U.S. Brazil, China and Japan have expressed an interest in following suit.

Tony Howard, divisional director responsible for patent examination and legal policy at the U.K. Intellectual Property Office, says the fast-track scheme announced in May 2009 means applicants can ask for part or all of the patent application process to be accelerated. This can reduce the time from application to granting of a patent from the usual three to five years, to as little as eight or nine months. "It's part of a wider range of policies directed at supporting the battle against climate change," Mr. Howard says. "It highlights the importance of patents and IP in general in combating climate change, as well as the critical role played by innovation."

By October 2009, there had been 65 applications for fast-tracking under the U.K. program. "That doesn't sound like very many … but that's quite an encouraging figure," says Mr. Howard. Those applications related to a diverse range of technologies, from new methods of energy generation, to products to make processes more efficient or to conserve energy. Some applicants were large companies, some small, and others individual inventors. The ability to move faster is of particular benefit to smaller businesses, Mr. Howard notes, as it allows them to get their technology to market more quickly and helps with licensing.

Initiatives to pool and share

Universal concern for the environment is leading to new approaches in IP ownership. The Eco-Patent Commons – founded by IBM, Nokia, Sony and Pitney Bowes – allows patents with environmental benefits to be shared and used by other contributors free of charge, encouraging new technology to be adopted more broadly, more quickly.

In the Netherlands, the CATO-2 program – a joint government and private-sector carbon capture and storage initiative – encourages participants to use different levels of IP ownership. Patent applications are soon expected to emerge from within the project. Ownership of the patents will reside with the inventing party (or parties), with ownership sometimes being shared between a knowledge institute and a private company.

This multi-tiered arrangement sounds complicated, but Jan Hopman, deputy CEO of CATO-2, says the complexity is a necessary evil. "The alternative is that everything's public, shared with everybody. If everything's shared, then the big breakthroughs will come from outside the program. We want to give an incentive to keep them inside."

International cooperation needed

The enthusiasm with which governments are embracing carbon-reduction targets is a huge vote of confidence in technologies that promise to reduce emissions, and gives the companies and individuals behind them confidence that their investment in green technologies could have a significant pay-off.

It is now time for governments to be more specific about the ways in which they work to reduce emissions, notes Mr. Iliev, to help focus research and guide investment into the areas most likely to be favored. "Government signaling intent is very important, but if they don't follow through it can lead to disillusion," he says. "We are now at a critical moment."

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The IP System as Part of the Climate Change Solution

Green innovation requires significant private-sector investment, which is incentivized through an effective patent system. The IP system makes an invention a tradable commodity that can be licensed or assigned, thereby facilitating technology partnerships.

Effective international patent protection can spur technology transfer from the private sector across countries. Moreover, since all patents are published, the patent system provides the most comprehensive public repository of information on the latest technologies. It gives access to existing technological knowledge, thus contributing to the development of new technologies, and helping to identify technologies that are not protected and thus freely available.

The authors of the Chatham House report caution that apparently well-intentioned government efforts to support national champions may actually hinder global innovation in energy systems. They say that existing industrial structures, regulatory regimes, research capabilities of private and public institutions, as well as other supporting infrastructures, are already determining the types of investments or technologies most likely to take off in decades to come.

What is needed, they say, is cooperation across international boundaries – particularly between developed and developing economies – and across diverse business sectors. "Many breakthrough innovations occur when different fields interact," they say. Innovation in solar photovoltaic technology has benefited from developments in consumer and industrial electronics, and advances in concentrated solar power come from aerospace and satellite technology. "Given the importance of innovation from outside the energy sector to the development of energy technologies, proactive innovation and climate change policy-makers face a complex challenge in monitoring technological and commercial developments," their report says.

Setting standards for the future

As companies, entrepreneurs and governments seek new approaches to business as usual, so too might the world of IP, and there might well be a lesson to be learned from mobile telephony, an industry whose rate of growth in the past decade and a half could serve the green technology industry handsomely.

"There needs to be a major refocus in how IP is used, and we're not saying the patent system needs to be changed … just that there's such a rich experience in other sectors where IP has been critical," says Mr. Iliev. Mobile telephony's worldwide success – there are now more mobile phones than toasters, he says – happened as quickly as it did because of standardized technology based on patents.

Mr. MacDougall also points to mobile telephones as inspiration for green-technology diffusion. "All the mobile phone companies could have continued making phones with their own different systems, but there would have been a limited market for them." By standardizing the technology on which they were based, they widened the market for everyone. "Everyone benefited, and it led to a profusion of mobile technology."

If it became clear that standards were the way forward, the incentive for holding a patent on which the standard was based would be even greater. In all likelihood, the pace of innovation would accelerate, and diffusion of technology would also happen much faster once a standard was agreed on.

The Green Touch Consortium

In January, the information and communication technologies (ICT) community announced the launch of Green Touch™, a global consortium aimed at creating new technologies to make communications networks 1,000 times more energy efficient than at present. Such a reduction would make it possible to power communication networks worldwide for three years on the energy currently used in a single year.

Green Touch, organized by Bell Labs, will bring leaders in industry, academia and government together to research and invent more energy-efficient networks. Its membership includes AT&T, China Mobile, Freescale Semiconductor, Huawei, Samsung Advanced Institute of Technology, Swisscom, University of Melbourne's Institute for a Broadband-Enabled Society (IBES) and many others. An open invitation was issued at the launch for all members of the ICT community to join the consortium.

"Truly global challenges have always been best addressed by bringing together the brightest minds in an unconstrained and creative environment. (…) Green Touch is an example of such a response – bringing together scientists and technologists from around the world and from different disciplines in an environment of open innovation to attack the problem from many different directions," said Dr. Steven Chu, U.S. Secretary of Energy.

ARTIST, ILLUSTRATOR, CREATOR – BOB MACNEIL

Biodata

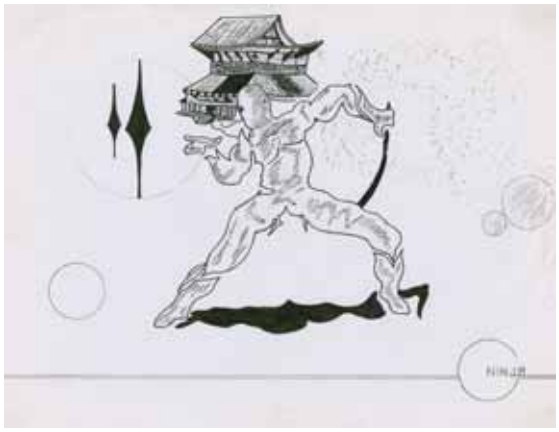
Born: 1971, New Jersey, U.S.
Media: Professional work: digital (Adobe Photoshop and Illustrator); leisure work: watercolor and acrylics
Education: Graduate of Newark School of Fine and Industrial Art; self-taught in digital media
Awards: (alone and jointly as part of teams) American Corporate Identity 20 for Skippy Brand Redesign; Creativity 33 for Skippy Peanut Butter Brand Redesign; American Graphic Design Awards for Dofino Cheese Brand Design; American Graphic Design Awards for Mott's Fruit Blasters; Art Director's Club of New Jersey for Mott's Fruit Blasters Brand Design; America Corporate Identity for The Roll; America Corporate Identity for Popsicle Redesign; and America Corporate Identity for Skippy Squeeze Stix Package Design
Hobbies: Black belt in Taekwondo
Website: *www.taminglight.com*

The award-winning brand and product designer Bob MacNeil drew an illustration of a "Patent Troll" (see WIPO Magazine 1/2010, page 4) for a well-known magazine that proved so popular he found it illegally copied and used by the very defenders of intellectual property (IP) rights themselves. A bit ironic, but they did immediately remedy the situation when he contacted them. In this interview for the WIPO Magazine, he talks about his first childhood experience as an artist; how the Internet has become an indispensable tool, linking him to the wider world and broadening the market for his work; and gives stern recommendations to young people seeking to follow in his footsteps.

When did you start drawing? When did you start making a living from it?

My earliest drawings are from when I was about six years' old. A year or so later, I took a test through a mail order art instruction course I saw on TV – funnily enough, the advertisement still runs today. After I completed the test, I anxiously awaited praise. But the greats who sat atop that artistic throne unfortunately informed me my work wasn't good enough; I did not have what it took to be an artist. I guess at age seven my dreams were bigger than my ability, but the results inspired me to prove them wrong.

My family is made up of artists – professionals and hobbyists alike – so I was fortunate enough to be surrounded by people who were supportive of my creativity. It was evident to them that I would one day pursue a creative career. My first official job as an illustrator was to produce a series of pen and ink images for a relative who owned a print shop. The experience was invaluable. I was able to work directly with a client while still in art school. Eventually, I built up my portfolio to a reasonable level and landed my first job without the aid of family or friends – designing kiosks for store installations and shopping malls.



***Pencil and marker*, circa 1977-78. The drawing Mr. MacNeil pinned all his hopes on at age seven.**

How do you make a living as an artist?

I work full time in a studio that designs and develops land-based slot machines and freelance in animation and video games. Simply put, I don't sleep. But I'm not complaining, it is work I truly enjoy. Over the last 19 years, it has allowed me to take part in almost every type of creative outlet

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imaginable, though I'm mostly centered on the entertainment industry.

I'm now focusing my attention on the children's market. Hopefully, one day I will be a published illustrator/author. Until then, I'll continue to get no sleep.

Where do you find inspiration?

My daughter is a huge source of inspiration and motivation. She allows me to act like a child and, as a result, I'm finding my ideas are being refreshed and revived.

Other artists have always been a source of inspiration. Having said that, I firmly believe if you are too "inspired" by another artist, your work can unintentionally take on qualities of that artist's work. I try not to pigeonhole myself that way, so to mention anyone specifically is kind of hard to do. I do have a penchant for animation art and lately have been following a lot of the up and coming artists in France.

Is copyright important to you? Why?

*Works whose authors or right holders are unknown and impossible to identify or locate.

Of course. I think it's important, because it recognizes and protects artists. The Copyright Act of 1976 gave artists some semblance of security in their work. However, the reintroduction of the bill defining orphan works* has made copyright important – a necessity – in protecting my creations. Artists work hard at trying to make a living from their craft. I couldn't walk into a furniture store and walk out with a couch because no one claimed it as theirs. Why should someone be able to do that with my artwork?

***Digital*. Since his site went live in 2006, Mr. MacNeil has received over 100,000 visitors.**

How do you view new media such as the Internet?

I absolutely love the Internet as a tool. I am located in the eastern U.S., in New Jersey. It's not much of a hotbed for the video game and animation industries, so the Internet has been invaluable in developing my portfolio – even beyond what I thought possible. It has also opened up my demographic and target audience, because I am able to see what people respond to in my online presence. The traditional method of taking out expensive ads in circulated directories has been replaced by the ease of the Internet. It seems to be the preferred vehicle for getting your voice out there. If you know how to design an appealing web presentation, and post it to an online store or YouTube, you can reach millions of people. And if you are consistent and professional in your presence, opportunity will find you.

Whether the Internet is also a threat dangerous enough to affect my bottom line remains to be seen. It does demand vigilance to sustain one's online assets, presence and professional relationships.

***Digital*. Mr. MacNeil works in a variety of styles, which he blends seamlessly together.**

Has any of your artwork ever been used without your authorization?

Ironically enough, my illustration of a Patent Troll has been used without my permission. I contacted the respective "rule breakers" and asked that they take the work down or appropriately acquire usage rights. All those I contacted have cooperated and removed the image, or compensated me for its use. Yes, "all" – there have been more than one.

To see my work used this way made me feel ambivalent, both good and bad at the same time. It's

flattering that my work is seen as being better than some of the other examples available online. However, it also bothers me that I put time and effort into an image and someone feels they can just use it for their own needs with no permission granted whatsoever.

Where would you set the border between inspiration and plain, simple copying?

A boundary should exist to stop one artist from taking work away from another more established one, because he/she can produce similar work at a much cheaper rate. These lines are often broken, because those who commission copyrighted works promote and support this sort of practice. The only thing that can be done to stop or control these situations is to educate or inform those that perpetuate this use.

Do you have any recommendations for budding illustrators?

Prepare yourself for what could be a long and arduous road of hard work. For a small number of people intent on becoming illustrators, things may come quite easily; unfortunately that is not the norm.

The typical development of an illustrator is slow and steady as you learn to master your technique and to handle the business side of things, which can be the worst part of it. Creative people want to create. They do not want to worry about whether they're being taken advantage of financially, how to manage taxes, budget their work and personal time or even their lives and the money they make – money that unfortunately does not arrive in your bank account on a regular basis.

These pitfalls tend to be determining factors in whether or not you succeed. Once you get a good grasp of business issues – and you will – you will have to learn to deal with insensitive critiques of the work you poured your heart and soul into, and the never ending lineup of "Nos" you'll receive that can break the strongest character. It sounds like a lot, and it is, but anyone who can say I don't care about all the red tape and difficulties because I love to paint, draw and create… that individual is well primed to become an illustrator.

I recommend that anyone crazy enough to take this journey begin with baby steps. There is no need to jump into anything massive at first; start out small and find your own artistic voice. Illustration is not only a profession that demands you be a skilled artisan, but also an exercise in humility. An illustrator is often looked at as a cog in a much bigger machine, especially when starting out. Respect and recognition come with experience; do not expect it early on!

Another important aspect is that, with the emergence of digital media, there is an inclination to forgo learning the foundations of art and jump directly to the computer – don't! First learn how to paint and draw. Those basic principles will set you apart from the masses and, in the long run, your work will be much more rewarding. I work digitally for the speed that it provides; however, I began my career without ever having touched a computer. I did so because I made it a point to learn the basics. You can't build a house without a proper foundation.

***Digital*. Mr. MacNeil's work is primarily digital, but knowledge of basic principles – how to draw and paint in traditional media – is what makes his work stand out.**

How do you feel about your work?

I love what I do. I love it because it's who I am. There aren't many jobs that allow you to constantly grow and improve your skills. And there aren't many jobs that allow you to work in your pajamas! In fact, illustration and creating art in general are, in my opinion, the best way to make a living.

It's a serious business, so treat it as such, but it can also be a lot of fun. It's very rewarding to see your art after it's been printed and circulated. I often walk into stores and feel like my portfolio has followed me. I'm paid to create; it's what I enjoy doing. What could be better!

SLOGANS AS TRADEMARKS – European and French Practice

Businesses, constantly searching for unique ways to identify their goods and services from that of the competition, are registering ever more creative trademarks – from a specific color, shape, sound, moving image, taste or smell to slogan marks. This article, by returning contributors Franck Soutoul and Jean-Philippe Bresson, of INLEX IP Expertise, and reporters for IP TALK, France, highlights some of the difficulties of registering slogan trademarks in Europe and France.

"Parce que vous le valez bien"™ (Because you're worth it), "Just do it"™, "*Le contrat de confiance*"™ (the contract of trust)… These slogans grab attention and are sometimes better known than the branded products themselves. Slogans are a marketing and communication tool *par excellence* and directly impact consumers by encouraging them to choose certain goods or services over others.

But legally speaking, slogans are at the intersection of several converging intellectual property (IP) rights and the source of many headaches. What is the best way to protect a slogan? How can a slogan be registered as a trademark? If registered as a trademark, how is similarity with another slogan determined? How is a slogan combined with a verbal mark perceived in terms of comparing signs? What precautions need to be taken for slogans created by advertising agencies?

As slogans are tools for gaining market share, involving creative, financial and commercial investment, choosing the most appropriate method of protection is key. Trademark and copyright protection can make a slogan an IP asset, and legislation against unfair competition may be used as a defensive approach. However, each of these means of protection involves a certain risk.

Protection as a trademark

A slogan is a separate category of sign, and is different from the standard trademark. Slogans can, in principle, be protected under trademark law, although they are not explicitly listed among the signs likely to constitute a trademark. However, Article L. 711-1 of the French Intellectual Property Code provides for "combinations of words," and Article 4 of Regulation No. 207/2009 on the Community trademark refers to "words" in a broader sense. Slogans must conform to the same requirements as any other trademark and, in particular, should not be generic in nature or describe the goods or services themselves, and must have their own distinctive character.

The European Union's Office for Harmonization in the Internal Market (OHIM) has been much stricter in assessing the distinctiveness of slogans than the French trademark office and courts. Community case law indicates that a more stringent procedure is used to determine slogan distinctiveness than that used for conventional ver-

L'Oréal, parce que je le vaux bien

The famous l'Oréal slogan "Because you're worth it," registered at the USPTO in 1976, has evolved with the company's customers over the years. *"Parce que je le vaux bien"* and its English translation "Because I'm worth it" became popular in the late 1990s. In 2004, l'Oréal advertising started targeting the ever-growing cosmetics market for men with "Because you're worth it too." Then in 2009, their advertising started using "Because we're worth it" and for kids "Because we're worth it too." The shift to "we" followed a psychology-based study of l'Oréal's consumer base. "We" apparently creates stronger consumer involvement in l'Oréal's philosophy and lifestyle and provides more perceived consumer satisfaction with l'Oréal products.

As l'Oréal celebrated its 100th anniversary in 2009, it continued to re-create itself, making ever stronger trademarks. A simple Madrid system database search yields 1,892 international trademark registrations for l'Oréal. The company also seeks to remain at the cutting edge of the cosmetics and beauty industry through research and development. It is reportedly the top nanotechnology patent-holder in the U.S.

Protection of slogans – the Madrid System

The WIPO-administered Madrid system for the international registration of marks is an international procedural mechanism that offers trademark owners the possibility to obtain protection for their marks in several countries, by simply filing one application through their national office. The granting of protection in each country that is designated in an international registration, including those of marks incorporating slogans, is determined by the corresponding national trademark office, in the light of the applicable legislation.

The Madrid system allows for the international registration of various types of marks, among them, those resulting from the combination of letters or words, which – of course – include the possibility of registering slogans. Slogans registered using the Madrid system include, for example,

- "Have it your way," registered by the Burger King Corporation to distinguish hamburgers, steak and fish sandwiches and other related products;
- *"Chesterfield: Être absolument femme,"* (Chesterfield: Be completely woman) registered by DIM to distinguish, among others, ladies' lingerie;
- "We're talkin' serious," registered by Ford's Foods, Inc. to distinguish sauces and salsa used in cooking or with chips;
- "Style on skin," registered by Lacoste to distinguish, clothes, footwear and headwear;
- *"Longines l'élégance du temps depuis 1832,"* (Longines, time elegance since 1832) registered by the Longines Watch Company to distinguish watches and chronometric instruments; and,
- "Passionate about creativity," registered by LVMH Moet Hennessy Louis Vuitton to distinguish various clothing and accessory products.

"We're talkin' serious" is a registered international trademark.

bal marks. Among the slogans refused registration in 2008 and 2009 were:

- "Passion for wood" for building materials;
- "Leave an impression" for bar, entertainment and advertising services;
- "Everywhere on earth" for transport services,
- *"Religieuse de Rêve"* (A dream pastry) for pastries;
- "Play for your country" for services for arranging golf tournaments; and
- "Night of champions" in particular for entertainment services.

Invariably, OHIM's reasoning on refusals was that the public would be likely to understand those expressions as advertising messages, underlining the positive aspects of the goods and services, rather than as signs identifying the goods and services themselves (the function of a trademark). One of the few exceptions, the "Play with nature"™ slogan was accepted by OHIM to designate food and clothing supplements. The European Court of Justice also issued a decision in January that the Audi slogan *"Vorsprung durch Technik"* (Advancement through technology) could mature into registration as it was not necessary for a trademark slogan to display "imaginativeness" or "conceptual tension creating surprise and thus making a striking impression."

On the other hand, the French Office is more flexible regarding slogan registration. The following examples have been recognized as distinctive, and accepted as trademarks:

- *"Le monde sans fil est à vous"*™ (The wireless world is yours) for telephony services;
- *"Quoi de plus naturel?"* ™ (What could be more natural?) for milk products and
- *"Vous avez le droit"* ™ (You have the right) for magazines and printed matter.

Protection facilitated by copyright

Even if slogans are not on the list of creations likely to constitute intellectual works (Article L112-2 of the French Intellectual Property Code provides a non-restrictive list of works), they are copyrightable in France provided they are original. For

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instance, the slogan *"C'est trop d'la bulle"* (It's too much fun), could not be registered as a trademark by chewing gum company Wm. Wrigley Jr., as an earlier copyright claim was recognized by the court because it: "introduced a play on words into this expression, an expression well-known to young teenagers and particularly relevant to that audience, gives this slogan novelty and originality, reflecting the personality of its author."

But contrary to trademarks where the right stems from an easily identifiable registration, copyright systematically belongs to the creator of a work, and that may be a problem if the slogan's creation was outsourced to an advertising agency. In France, to obtain copyright from an agency, a business must follow a formal path by which rights are assigned and an appropriate remuneration determined. This is a required step to ensure sustainable use of the slogan, as well as the possibility to act against third parties and to file the slogan as a trademark. For instance, the company BuyCentral was only recognized as the right holder of *"Comparez les doigts dans le net"* ™ (Compare fingers in the net) thanks to the assignment of the slogan rights in the contract binding them to Saatchi & Saatchi.

Unfair competition claims

It is also possible in France to defend slogan rights by filing an unfair competition claim, in which civil liability rules are applied to commercial disputes. A business can use such a claim to assert, for example, that an imitation advertising slogan aimed to benefit a competitor's investments.

Air France KLM successfully used such an approach against RyanAir. The French Court of Appeal held that RyanAir's slogan *"Faire du ciel l'endroit le moins cher de la terre"* (Making the sky the cheapest place on earth) – a slight modification of the Air France slogan *"Faire du ciel le plus bel endroit de la terre"* ™ (Making the sky the best place on earth) – constituted unfair practice because it repeated and distorted the well-known Air France phrase, and that RyanAir thereby benefited from Air France's substantial advertising campaigns.

The three possible means of protecting slogans can be sought concurrently and may all be referred to in litigation. Owning a trademark should not prevent the holder from also seeking copyright protection of the slogan, which may prove useful, for example, if a trademark is canceled during a dispute.

Assessment of risk

The assessing of similarity between two slogans is not carried out using quite the same procedure as that for "conventional" verbal marks. In the case of slogans, it is rare, even exceptional, for signs to be devoid of rational meaning; that aspect therefore carries more weight than it does for other signs.

Assessing the similarity of two trademarks comprising slogans depends largely on the estimated distinctiveness of the slogans. The more distinctive the earlier filed slogan is considered, the greater its scope of protection. So, even where differences between slogans are significant, the risk of confusion can be qualitatively determined. Naturally, the level of distinctiveness (and therefore the possible similarity between two slogans filed as trademarks) depends on which court is hearing the case as demonstrated in the following:

- The French trademark office considered *"Bien dans ma vie"* ™ (Happy in my life) and *"Bien dans ma maison"* (Happy in my home) to be similar, in that the structure of the phrase and the image evoked were comparable. The first slogan *"Bien dans ma vie"* was said to be distinctive.
- The slogans *"Manger bien pour vivre mieux"* ™ (Eat well to live better) and *"Bien se nourrir pour mieux vivre"* ™ (Eat well to live better) for foodstuffs were considered different, the first sign having been evaluated as weak in terms of distinctiveness and appearing to be a promotional slogan to encourage consumers to adopt a healthy lifestyle.

But as is the case with all trademarks, the better known the slogan, the greater its level of distinctiveness.

When it comes to comparing translated slogans, assessment typically depends on the territories and consumer groups targeted. The French Court of Appeal held that French consumers were likely to make the connection between the expressions *"Skin breakfast"* ™ and *"Petit déjeuner de la peau"*

Examination of Traditional and Non-Traditional Trademarks

Three-dimensional (3D) designs, such as the shape of goods or their packaging, colors *per se*, moving images, or specific sounds or smells, are being increasingly used in marketing to individualize goods or services. WIPO has been responsive to these developments; the Singapore Treaty on the Law of Trademarks, which entered into force on March 16, 2009, sets out a multilateral framework for the definition of criteria concerning the reproduction of hologram, motion, color and position marks and of marks consisting of non-visible signs on trademark applications and in trademark registers.

WIPO has followed up on the entry into force of the Singapore Treaty and a working group, established under that Treaty, will meet for a first session in April with the goal to further determine the details of the representation of such non-traditional marks. WIPO is also organizing seminars and workshops to assist trademark examiners who are examining applications for such marks. For example, senior trademark examiners from 17 countries in the Asia and Pacific region received advanced training on the examination of traditional and non-traditional marks at a five-day workshop held in Canberra, Australia, in October 2009. The 34 examiners were also updated on recent developments in the area of international trademark law, and given an opportunity to exchange views and share national experiences in administering trademarks.

The workshop, jointly organized in cooperation with IP Australia, was the first of its kind carried out by WIPO in the Asia and the Pacific region, and responded to the growing need for capacity-building in the area of trademark examination in the region. Non-traditional trademarks are being used more frequently in the marketplace as businesses look for innovative ways to differentiate their products and services from those of their competitors.

Ongoing discussions on issues related to non-traditional trademarks in the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), such as work on agreed areas of convergence concerning the representation of non-traditional marks,[1] make such workshops pertinent and timely for all IP offices.

(Breakfast for the skin) and therefore judged them similar. On the other hand, OHIM considered that French and Belgian consumers would not confuse the two slogan trademarks *"C'est prouvé. Clarins rend la vie plus belle"* ™ (It's a fact. Clarins makes life more beautiful) and "Douglas – makes life beautiful" ™ as only a small percentage of Belgian consumers would understand the meaning of the French expression.

But businesses should be aware that while the French trademark office will register trademarks comprising slogans more readily than OHIM, the scope of legal protection remains limited when comparing two trademarks where only one of them includes a slogan. For example, the French trademark office considered the following to be confusingly similar:

- *"Oui"* ™ *(Yes) and "Oh oui, oser d'autres plaisirs" (Oh yes, dare to try other pleasures) and*
- Synergie ™ and "SynergyGroup, le groupement de compétences" *(SynergyGroup, the association of skills)*, as the expression added on "is of secondary importance and will be perceived more as a slogan."

Slogans – at crossroads

Slogans do not directly designate a good or service but support it in commercial terms by enabling the public to link a slogan to a specific company. They are also the first line of communication with the consumer. Moreover, they represent significant investment and effort by companies to draw consumers to their products. They therefore form a specific category of signs, as is the case for three-dimensional marks.

Their specific nature makes it important to ask the right questions regarding the substance of a slogan before seeking to protect or defend it. While there is no ideal, one-size-fits-all approach, existing tools and their use by the French courts and trademark office and OHIM, reveal emerging trends and call for a case-by-case analysis in adopting the most appropriate strategy.

1 www.wipo.int/export/sies/www/sct/en/meetings/pdf/wipo_strad_inf_3.pdf

BETTER DRAWINGS MAKE A BETTER PATENT

This article is by Bernadette Marshall, President, NB Graphics & Associates, Inc. (*www.nbgraphics.com*). Ms. Marshall heads a creative team, specializing in the preparation of design and utility patent drawings and trademark illustrations. She and her team have over 20 years of experience working nationally and internationally.

"A picture speaks a thousand words." That ancient adage certainly holds true in the case of patent drawings. An invention can often be more easily explained through drawings than in reams of description. Accurate, clear drawings strengthen and enhance patent applications, helping overloaded patent examiners to understand inventions faster.

Simple, clear and precise images also help to instruct judges in cases of patent infringement, often clarifying the patent owners' claims and clinching the decision in their favor. Drawings can also work in favor of patent holders in negotiating damages or a settlement. Even more important, meticulously prepared drawings that make the patent understandable and unambiguous may mean potential infringers will think twice about copying. The earlier infringement is deterred the better it is for patent owners.

Patent filers should not underestimate the importance of drawings in their applications. Patent offices apply specific criteria concerning the technical details of drawings they accept, but attention must be paid to more than just meeting those requirements. A patent applicant's safest option is to use the services of a professional draftsperson specialized in technical patent drawings and knowledgeable of the various demands of patent offices.

Technical specifications

Many patent offices now accept drawings submitted on anything from paper to digital media, but specifications on shape, size and form often vary. For example, for filings on paper, some patent offices require that flexible sheets be used while others specify rigid cardboard. Beyond the media itself, there can also be significant differences in the drawing specifications when it comes to, for example, surface shading, broken lines and line thickness.

Drawings must meet the requirements of (a) the country where the patent is filed, (b) the U.S. Patent and Trademark Office (USPTO), for filings in the U.S. and (c) the Patent Cooperation Treaty (PCT) for international applications. The PCT specifies how patent drawings are to be created and submitted in its 142 contracting states.

Some requirements are universal to all patent offices: drawings must be clear, in black and white and have solid black lines. The main difference between drawings for the USPTO and PCT filings, for example, is the size of the paper on which drawings can be submitted. The USPTO allows letter size paper or A4, while the PCT only accepts size A4. Margins remain the same whether filings are done on A4 or letter size pages.

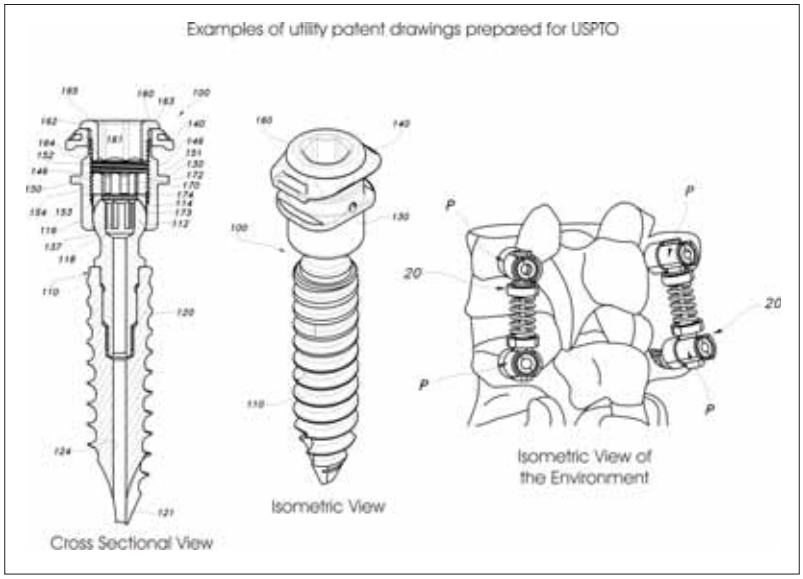
PCT drawings

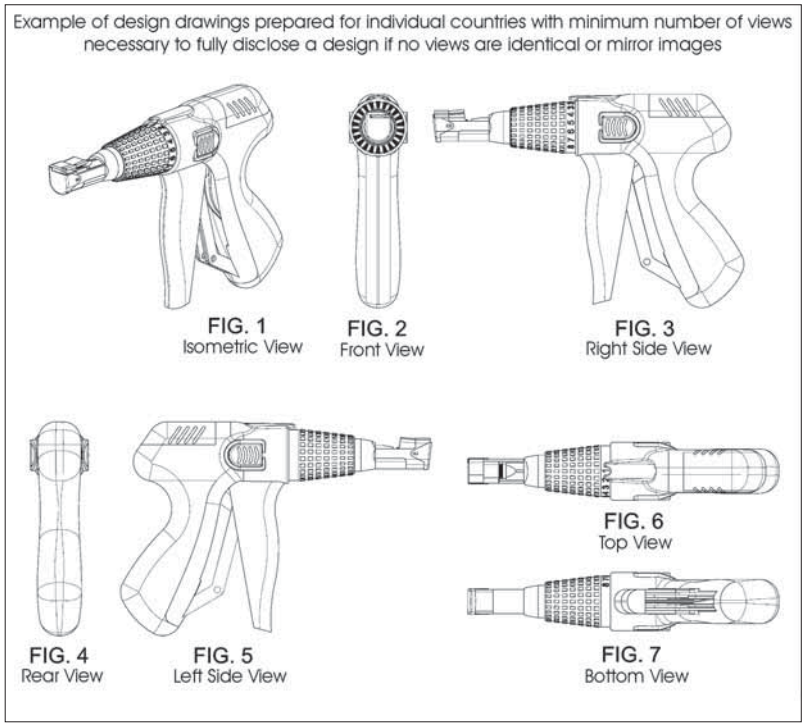
The PCT only requires drawings where they are necessary for the understanding of the invention. This will be the case for a mechanical or electrical invention. It will not be the case when an invention cannot be drawn, as is the case for a chemical product. In each of the drawing figures, reference signs or numerals for the various elements in the drawings are to be provided, and corresponding explanations of their function and operation included in the description.

Utility patents

There are strict requirements for drawings of utility patents. They should be prepared in the correct scale ensuring that lines, numbers and letters are "sufficiently dense and dark and uniformly thick and well defined" – enough to give them "satisfactory reproduction characteristics." Depending on the invention, tables, chemical or mathematical formulae, waveforms of electrical signals and symbols can also be used.

Courtesy NB Graphics & Associates





Drawings or diagrams are usually crafted to correspond to the individual claims of the patent. Specific views may be used to illustrate a problem the invention solves, a particular advantage it offers or a need it fulfills, thereby describing a new function or how the invention implements that function. Prior art can be used to show contrast or to differentiate a new invention from an older one or, for a new invention consisting of an improvement to an existing one, the drawings can show the improved portion with enough of the old invention to demonstrate the connection.

Placing an invention in its intended environment can make it more easily understandable, and the drawings themselves can be arranged in such a way that it helps readers to better understand the invention. Plan or elevated views, perspective views, isometric projections, sectional views and exploded views can be used as well.

The more complex and hard to define the invention, the more valuable the draftsperson's suggestions for improving the drawings and presenting the invention clearly will be. If drawings are created before the patent application is completed, the applicant can save time by basing the detailed description on the sequence of drawings.

Design patents

Unlike utility patents, applications for design patents rely fully on the drawings. According to USPTO guidelines, "the drawing disclosure is the most important element of the application," and the drawings in design patent applications "constitute the entire visual disclosure of the claim." In well-executed drawings "nothing regarding the design sought to be patented is left to conjecture."

Most countries include similar rules in their guidelines. One notable difference, however, is that the USPTO requires all surfaces of drawings to be appropriately and adequately shaded: "Shading which shows clearly the character and contour of all surfaces of any three-dimensional aspect of the design." This requirement makes USPTO design drawings appear more artistic than those of most other countries that more closely resemble engineering or technical drawings (but without the dimensions) as they do not include shading or broken lines. Design drawings with surface shading and broken lines are acceptable under the PCT.

Most countries require a number of views, executed as black-and-white line art, sufficient to fully disclose the invention. If the design cannot be shown by line art, photographs may usually be submitted instead. In cases where photographs are not allowed and an applicant is requested to supply regulation black-and-white drawings, the applicant will not be allowed to correct any inconsistencies in the drawings once they have been submitted, unless that can be done without

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adding new matter. Nothing can be removed or added when replacing figures. The USPTO specifies, "An incomplete or poorly prepared drawing may result in a fatally defective disclosure which cannot become a patent."

Generating photographs or drawings for design patents that depict exact views can be challenging. For instance, only one side of the invention may be shown per photograph or drawing. For a simple cube, for example, each photograph or drawing should show only one side – not the side and a portion of the top or of another side. When using photographs as a reference for drawings, any distortion in them must be corrected.

Informal vs. formal drawings

In the case of filings containing informal drawings, the images are converted – through copying – into poor quality images. This process causes them to lose integrity, quality and detail. When the patent office requests that the applicant submit formal drawings, often the only existing reference material is a low quality copy of the informal drawing. When such material is all a draftsperson has to go on, it takes longer to execute the formal drawings and results in more revisions, increasing costs for the applicant.

Design patents can only be corrected if no new matter is introduced. So applicants who submit informal drawings with inconsistencies may find themselves caught in a proverbial "Catch 22" situation: either the drawings will be rejected for being inconsistent or because new matter has been added.

Finding a good draftsperson

Generating good drawings requires technical skill and creativity. There is no special license or university degree for patent drafting. A draftsperson's experience, body of work, professional references and use of technology are good indicators of competence and skill.

Most are skilled in computer-aided design and drafting (CADD) and have gained experience under the supervision of senior professionals. Firms often employ several draftspersons, providing a broad skill set as well as a variety of perspectives and approaches. Expertise must be acquired through years of practice, for which there is no easy substitute.

Computer vs. hand-drawn figures

It is not the quality of the equipment but the skill of the draftsperson that is important, and there is nothing wrong with traditional hand-drawn figures. However, the most cost-effective process is to make drawings from CADD files, which avoids the draftsperson having to recreate the drawings from scratch. For items that have already been manufactured or for existing prototypes, chances are there are CADD files available as they are used in all modern manufacturing processes.

Where that is not the case, creating drawings in CADD has its advantages. Electronic data can be archived to simplify the subsequent amendment of drawings; drawings can be modified to create new drawings; and duplicate elements in a drawing can be copied and reused instead of having to redraw each one manually.

Choose the best

The patent drawings in an application may be accepted in one country and rejected in another. But regardless of where an applicant files, good drawings make for good applications – and for a good defense when necessary. Once good, accurate and clear drawings are executed, the patent applicant has only one difficult choice to make: selecting the best one for the front page of the application.

TRADITIONAL CULTURES,
Indigenous Peoples and Cultural Institutions

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Museums, libraries, archives and other cultural institutions play an invaluable role in preserving and providing access to their collections, an endeavor that can raise a number of intellectual property (IP) issues, especially in a digital environment. Handling collections of elements of cultural heritage, or "traditional cultural expressions" (TCEs) often brings about specific and even more complex IP issues.

Indigenous peoples and traditional communities have expressed concerns that the very process of preserving TCEs, like documenting and displaying, for example, a traditional song or tribal symbol can open the door to misuse or misappropriation.

Using a fictional example, this article illustrates the IP issues involved in safeguarding cultural heritage. It is inspired in part by a case study featured in Dr. Jane Anderson's "Access and Control of Indigenous Knowledge in Libraries and Archives: Ownership and Future Use."

A Visit to Community X

In the 1960s, a researcher, Ms. Y, interested in studying traditional cultures and their symbolism, went to community X. During her field visit, she made film and sound recordings of an important ceremony. The recordings featured the respected elder and leader of community X. As Ms. Y made the recordings, she owns the rights to those works and to objects of related rights.

Ceremony X may be qualified as a TCE. According to the Draft Provisions for the Protection of Traditional Cultural Expressions/Expressions of Folklore, TCEs are any form, whether tangible or intangible, in which traditional culture and knowledge are expressed, appear or are manifested. TCEs are products of creative intellectual activity, including individual and communal creations. They are characteristic of a community's cultural and social identity and cultural heritage and are maintained, used or developed by that community, or by individuals having the right or responsibility to do so in accordance with the customary laws and practices of that community.

The collections of TCEs held in cultural institutions are priceless records of ancient traditions and community histories integral to indigenous peoples' identity and social continuity. They reflect a community's history, traditions, values and beliefs. In many cases, these TCEs have been documented by researchers from outside the community. The rights to that documentation – and the documentation itself – are often not owned by the community, but by those who made the films, recordings, photographs, etc. As a result, communities often believe that because they are not the owners, they have lost control over the content.

Some 20 years later, the son of the respected elder and leader of community X composed a song about his community. To accompany the song, he decided to make a video clip showing images of his father. While there were not many images of his father available, he remembered that an anthropologist had come to the community many years before, and he eventually located that anthropologist's recordings at the central national archive. At his request, the archive sent a copy of the recording to the community without enquiring as to its intended use. The son of the leader then incorporated footage of the ceremony in the 1960s film into his own video clip.

Was there copyright infringement? Not obtaining Ms. Y's permission meant that incorporating parts

Handling collections which comprise elements of cultural heritage often means that museums must resolve complex IP issues.

>>>

of the protected recording into the video clip almost certainly infringed copyright. Assuredly, the son of the elder and the archivist who supplied the film excerpts did not realize they were violating the law when the recording was copied and used in the video. Given that the video clip was to accompany a song intended for commercial distribution, it is unlikely that an exception or limitation to copyright could apply, despite the cultural objective behind its making.

The original film of the 1960s ceremony was significant for the community; they even wished to digitize it and post it on their website. The film was meant to be an educational tool for future generations of the community. The copyright owner, Ms. Y, managed her rights in a strict manner and had firm ideas about who the material was made for, and who could access it. She exercised total control over the material.

This made for tense relations between the community and Ms. Y, as well as with the archive that held the original films and recordings. In such circumstances, how should negotiations between the community, Ms. Y and the archive be conducted? How could these seemingly conflicting rights and interests be reconciled?

Indigenous peoples and traditional communities want to have access to existing material from their culture so that it can be reinterpreted and given new meaning. However, the process of creating new meanings can contravene the copyright owners' rights in the material. Who then should be entitled to make decisions concerning such films and recordings? The researcher? The community? The archive?

Copyright owners may use their works as they wish within the law, and may prevent others from using them without authorization. They have the exclusive right to authorize third parties to use the works, subject to the legally recognized rights and interests of others, which are often embedded in exceptions or limitations within copyright law. But use by indigenous peoples and traditional communities can fall outside the exceptions and limitations of copyright law.

Indigenous peoples and traditional communities have a growing interest in being more directly involved in recording, presenting and representing their own cultures to the public. They also wish to own, control and access cultural heritage materials held by cultural institutions. To answer these needs, WIPO, under its Creative Heritage Project is offering hands-on training in documentation, recording and digitization of intangible cultural heritage for indigenous and local communities and museum staff of developing countries.[1] This is carried out in partnership with the American Folklife Center/Library of Congress and the Center for Documentary Studies, in the U.S. This WIPO program provides the training in documentary techniques and archival skills necessary for effective community-based cultural conservation, as well as IP training and a basic kit of audiovisual equipment provided by WIPO. A pilot project concluded with success with the Maasai community in Kenya (see "Capacity-Building – Intellectual Property and Traditional Knowledge," WIPO Magazine 5/2009).

Many years later, a couple of musicians with a passion for "world" music visited the archive in search of traditional music from community X. They listened to many, many recordings, and asked for digital copies of some particularly interesting tracks. In granting their request, the archive was fulfilling its mandate to provide access to the public of the valuable collection of X's music. The recordings in question were free of rights, having fallen into the public domain.

A few months later, an archive employee, and member of community X, went to the town's disco. To his dismay, he heard a traditional X song fused with techno-house dance rhythms. He then recalled the couple having taken samples from the collection. He was appalled: surely large profits had been made from selling the remix record, and no one had sought the community's or the archive's permission. He knew there had been no royalty payments and doubted that community X had even been acknowledged on the remix.

At the border of the IP framework

The valuable processes of preservation and safeguarding (such as the recording, documentation, digitization, dissemination, circulation and publication of TCEs) can sometimes fail to take adequate account of the rights and interests of source communities. This runs the risk of unintentionally making TCEs freely available for use by others, often against the wishes of the source community; for example, culturally sensitive materials may be commercially exploited by others.

International Negotiations for the Protection of TCEs

Negotiations on the protection of TCEs are taking place internationally at WIPO in the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (the IGC).[2] The Creative Heritage Project is a practical complement to these negotiations.

Draft provisions[3] for the *sui generis* protection of traditional knowledge and TCEs are currently under negotiation. The provisions seek, *inter alia*, to respond to the needs of safeguarding and to the specific IP aspects of registering and documenting TCEs. For example, the draft contains a provision to the effect that the measures for the protection of TCEs would not apply to the making of recordings and other reproductions of TCEs for the purpose of their inclusion in an archive or inventory for non-commercial cultural heritage safeguarding purposes.[4]

In September 2009, WIPO Member States renewed the mandate of the IGC, adopting a clearly defined work plan and terms of reference to guide the Committee's work over the next two years. They agreed the IGC would undertake text-based negotiations with the objective of reaching agreement on a text of an international legal instrument (or instruments) that will ensure the effective protection of genetic resources, traditional knowledge and TCEs.

A cultural institution's collection might contain sacred or confidential matter that is subject to restricted use under customary laws. For such sacred, spiritual or otherwise culturally significant TCEs, some uses allowed under IP regimes can be considered inappropriate by the community that created the TCEs.

Under conventional IP law, TCEs are often perceived to be in the public domain (see "Archives and Museums: Balancing Protection and Preservation of Cultural Heritage," WIPO Magazine 5/2005). However, broader interests may still be attached to, for example, a traditional song and require careful handling.

A role for IP

As the above example illustrates, the acquisition, preservation, display, communication and re-use of elements from collections of TCEs raise unique, complex and sensitive questions. Who owns the collections? Who has control over their content? Who owns the IP rights associated with these collections? How should the collections be accessed, managed and used? The list goes on.

The answers may often reside in two simple letters: IP. Any given item in a collection has an "IP status": TCEs may or may not benefit from IP protection. Thus, managing access to and use of collections inevitably implicates IP law, policy and practice.

Cultural institutions lie at the junction between tradition-bearers and the public. In their daily activities lies a unique opportunity to, on the one hand, allow the public to access, use and recreate cultural heritage while, on the other, to protect TCEs and preserve the rights and interests of their bearers.

Many institutions and communities have developed IP-related policies and practices concerning the safeguarding, access, ownership and control of cultural heritage. Such IP strategies often go beyond conventional IP to address "ethical" issues, focusing on changing behaviors, establishing trust and guiding modes of conduct.

WIPO's Creative Heritage Project[1] is developing resources for the strategic management of IP rights and interests by cultural institutions, so as to both preserve and protect cultural heritage. Examples of such resources include surveys on practical experiences with IP in the archival practices of institutions and of indigenous and local communities; a searchable database of codes, policies and practices; and a draft publication on IP management and TCEs for museums, archives and libraries.

1 For more information see *www.wipo.int/tk/en/folklore/culturalheritage/*

2 For more information about the IGC see: *www.wipo.int/tk/en/igc/*

3 The draft provisions may be consulted at *www.wipo.int/tk/en/consultations/draft_provisions/draft_provisions.html*

4 See Draft Provisions Article 5(a)(iii).

CULTURAL HERITAGE IN THE DIGITAL WORLD

The key points discussed at a conference in Madrid, co-organized by WIPO and the Spanish government, are highlighted here for the WIPO Magazine by Jaime de Mendoza Fernández, Head, Copyright Unit, Ministry of Culture, Spain.

Peoples in every country of the world have rich cultural heritages that deserve to be discovered, enjoyed and learned from; in short, to be disseminated for public benefit. But at the same time, that culture needs to be conserved for future generations. The WIPO conference on Intellectual Property and Cultural Heritage in the Digital World, organized jointly with the Ministry of Culture of Spain, focused on striking a balance between intellectual property (IP) rights and the public's right to have access to culture.

Participants in the conference included representatives of various cultural institutions – archives, libraries, museums and the like. Once seen as sacred coffers guarding the treasures of the world's cultural heritage and granting access only to a select few, cultural institutions have now become the movers and shakers of culture and have shifted to an open-door policy. At the conference, these institutions offered their unique perspective as custodians, or repositories, of cultural heritage with the obligation and responsibility to preserve and protect the legacy entrusted to them and make it available to the public.

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Prado National Museum in Madrid

A paradigm shift

Representatives of various cultural bodies highlighted the challenges and opportunities presented by the new policy for disseminating culture in the digital world. Without a doubt, one of the most crucial challenges is to find a way to balance the dissemination of collections with the need to protect IP rights.

Representatives of Spain's largest cultural institutions, such as the Prado National Museum and the National Library, agreed with their European and North and Latin American counterparts that IP rights are increasingly important assets, both from a cultural as well as an economic viewpoint. Generating revenue from the added-value of IP rights has traditionally been seen in continental Europe as incompatible with the principal functions of public cultural institutions; today, however, it is seen in a more positive light. IP offers cultural institutions a means to generate significant revenue, allowing them to move towards becoming self-financing.

Managing IP rights

Cultural institutions are generous in making available the collections in their care. But in order to continue their efforts in the conservation, research and dissemination of cultural heritage, they are calling for a relaxing of current IP restrictions. The main difficulty they face is in managing the IP rights that apply to their collections. Specifically, the absence of a "one-stop shop" for communicating with rights management bodies, the lack of clarity surrounding the public domain and difficulties in managing so-called orphan works (i.e., works whose right holders are unknown or unreachable), were some of the most hotly debated issues during the conference.

The alternatives offered by the existing legal framework in relation to orphan works, for example, do not meet the needs of cultural institutions. They are, therefore, requesting a broadening of the current rules to allow them to use such works in certain instances, such as for the benefit of the disabled or for educational purposes.

To better address those challenges, participants agreed it was essential to create a constructive dialogue among cultural institutions, representatives of content industries, right holders and providers of information technology services. Both WIPO and the Ministry of Culture of Spain can play a fundamental role in fostering a climate of greater legal certainty for all stakeholders by promoting normative harmonization at the international level.

IN THE NEWS

Economic Downturn Hits WIPO Registration and Filing Services

International trademark filings under the Madrid System for the International Registration of Marks dropped by 16 percent in 2009 as a result of the global economic downturn, while Patent Cooperation Treaty (PCT) filings fell by 4.5 percent. WIPO received 35,195 international applications under the 84-member Madrid system compared to 42,075 in 2008. Provisional data for the PCT, which has 142 contracting parties, indicates that 155,900 international patent applications were filed in 2009 compared to the nearly 164,000 applications filed in 2008.

International trademark registrations began showing signs of a slowdown in 2008, so the 2009 figures were not wholly unexpected. Trademark registrations reflect the introduction of new products and services to the market and are sensitive to business cycles. The comparatively smaller decrease (-1.2%) in the renewal of international trademark registrations, compared to 2008, underscores the value of established brands at a time when consumers opt for goods that are tried and trusted. In 2009, 19,234 international trademark renewals were recorded.

"The decline in PCT filings is not as sharp as originally anticipated – last year's results bring us back to just under 2007 levels, when 159,886 international applications were filed," said WIPO Director General Francis Gurry. "Interestingly, the rate of decline in international filings is lower than that experienced in some national contexts. This is an indication of a broad recognition that it makes good business sense, whatever the economic conditions, to continue to protect commercially valuable technologies internationally."

International patent filings in a number of East Asian countries continued to see positive growth in spite of challenging global economic conditions. Japan, the second largest user of the PCT, experienced a 3.6 percent rate of growth with 29,827 applications; the Republic of Korea, ranked fourth largest user of the system, experienced a 2.1 percent growth with 8,066 applications; and China became the fifth largest PCT user with a strong growth rate of 29.7 percent representing some 7,946 international applications.

The Madrid System also observed increases among some major users, notably the European Union (3.1%) and Japan (2.7%), as well as the Republic of Korea (33.9%), Singapore (20.5%), Croatia (17.5%) and Hungary (14.5%). ■

Movie Props are Industrial Designs not Art

In December, the English High Court confirmed the decision of a lower court according to which props designed by Mr. Andrew Ainsworth in 1976 for the original Star Wars movies are designs, benefitting from only 15 years of protection in the U.K., rather than artwork that would be protected under copyright for 70 years.

The initial case was filed in 2005 by Lucasfilm after Mr. Ainsworth set up a website selling replicas made from the original molds he had created for props in the first Star Wars movie. Mr. Ainsworth did not challenge Lucasfilm's claim in the U.S., where he had sold only 19 models. By default judgment, a California court granted Lucasfilm the US$20 million it claimed in damages. But Mr. Ainsworth could not ignore the Lucasfilm case filed in the U.K., his actual place of business.

On December 16, 2009, English High Court Lord Justices Rix, Jacob and Patten upheld the lower court decision that the models were not sculptures and therefore could not benefit from copyright protection – which extends 70 years beyond the death of the creator – but industrial designs. Lucasfilm's appeal was dismissed.

Lucasfilm plans to take the case to U.K.'s Supreme Court. ■

LETTERS AND COMMENTS

WIPO Magazine welcomes letters and comments on issues raised in Magazine articles, or on other developments in the field of intellectual property. Letters should be marked "for publication in the WIPO Magazine" and addressed to The Editor at WipoMagazine@wipo.int or to the postal/fax address on the back cover of the Magazine. Please also include your postal address. We regret that it is not possible to publish all the letters we receive. The editor reserves the right to edit, shorten, or publish extracts from letters. The author will be consulted if substantial editing is required.

First registry of a scent trademark in Argentina

From Juan Martin Aulmann and Daniel R. Zuccherino, Obligado & Cia, Buenos Aires, Argentina

Following publication of the article "Smell, Sound and Taste – Getting a Sense of Non-Traditional Marks" (Issue 1/2009), it may interest WIPO Magazine readers to learn that Argentina has registered its first scent trademarks.

Argentine trademark law does not expressly refer to the registration of so-called scent trademarks – fragrances, smells or scents. However, marketers of certain products provided the containers thereof with a distinctive scent and tried to obtain exclusive rights to the particular scent through trademark protection. Argentina's trademark law allows for a wide interpretation to be applied in registering distinctive signs, and many juridical authors support the registration of scented signs.

The marketers were finally successful in their quest. In January 2009, INPI – the Argentine trademark authority – granted its first scented trademarks (numbers 2.270.653/54/55/56 to 2.270.657) to L'Oréal (under Nice Classification 3). Each one comprises a *"… Fragrance of… (different fruits in each case)… applied to the Containers …"*

It is fundamental to note that if the trademark applications had been for products, rather than containers, INPI's decision would surely have been different. The fragrances of a product itself would, in many cases, be considered a resource in the public domain – if, for example, the product incorporated scents such as strawberry, raspberry, peach, mint, etc.

L'Oréal's applications for scent trademarks dated back many years, but had been opposed by a third party when published by INPI. L'Oréal brought legal action to have the opposition withdrawn. The court's decision in the case emphasized that, in order to determine the registration of a sign, there is no "substantial requirement" in the Argentine trademark legislation that such signs be "visually perceptible" or "graphically represented." After the court notified INPI that the opposition had been withdrawn, INPI evaluated the trademarks for distinctiveness and registered them.

The L'Oréal trademarks are still the only scent marks in Argentina's trademark registry. ■

The New Kids... "block" a Community mark

From Franck Soutoul and Jean-Philippe Bresson, INLEX IP Expertise, Paris, France, *www.inlex.com, www.iptalk.eu*

"What you don't know about trademarks" (issue 6/2009) discussed how to keep your trademark healthy. One easy way is by not letting it lapse, then, worse, be registered by a third party who can free-ride on the trademark's good reputation, as a number of popular music groups have learned. It would have been much easier for the "New Kids On The Block," mentioned in the case below, to maintain their trademark than to file for invalidation.

The names of rock and pop bands are hot topics of conversation in schoolrooms and chat rooms alike – but also in courtrooms. Whether such proceedings are opportunistic or publicity-seeking, a band name remains a unifying instrument able to generate sales, fan mail and cult followings long after a group has disbanded. Ozzy Osbourne's battle over "Black Sabbath" caught headlines in mid-2009; in December, that distinction fell to the "New Kids On The Block."

In 2005, SM Productions Partnership filed a Community trademark for "New Kids On The Block" for video recordings, compact discs, live entertainment services, the organization of a fan

club and the publication of printed matter. The S and M were Richard Scott and Denny Marte.

As to the history behind the scenes, Maurice Starr set up the American boy band "New Kids On The Block" in Boston in 1984. Management of the group's affairs – concerts, spin-off products and protection of the group name and logo by trademarks – was entrusted to Big Step Production, 60 percent owned by Maurice Starr and the rest by Richard Scott. The same Richard Scott as in SM Productions. When the group broke up in 1992, Richard Scott continued to receive royalties on recordings and spin-off products, and Big Step Production transferred all rights in the group's name and logo to its five members.

Back to the present. In 2008, three years after SM Productions filed the Community mark, the original members of the boy band – Daniel Wood, Donald Wahlberg, Jonathan Knight, Jordan Knight and Joseph McIntyre – filed an **administrative application** for the trademark to be invalidated. The grounds put forward were, *inter alia*, the bad faith linked to the filing. The involvement of Richard Scott in the record industry; his participation in the companies Big Step Production and SM Productions Partnership; and the expiry of the boy band's trademarks – in spite of its public recognition and phenomenal economic potential – led OHIM to invalidate the Community mark in December 2009.

The mark could not be transferred to the five former band members as the procedure was one of administrative application for invalidation based on bad faith. Only a court case at the national level would have made it possible to envisage a transfer of the rights based on bad faith.

Calendar of Meetings

APRIL 26 TO 30 ■ GENEVA

■ ***Committee on Development and Intellectual Property (5th session)***

Invitations: As members, the States members of WIPO; as observers, other States and certain organizations.

MAY 3 TO 7 ■ GENEVA

■ ***Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (16th session)***

Invitations: As members, the States members of WIPO and/or of the Paris and Berne Unions, and the European Community; as observers, other States; and as Permanent Observer and *ad hoc* observer organizations, certain organizations.

JUNE 21 TO 25 ■ GENEVA

■ ***Standing Committee on Copyright and Related Rights (20th session)***

Invitations: As members, the States members of WIPO and/or the Berne Union, and the European Community; and as Permanent Observer and *ad hoc* observer organizations, certain organizations.

SEPTEMBER 1 TO 3 ■ GENEVA

■ ***Program and Budget Committee (15th session)***

Invitations: All States members of the WIPO Program and Budget Committee are invited to be represented at this session of the Program and Budget Committee. All other States members of WIPO are invited to be represented at this meeting in an observer capacity.

SEPTEMBER 20 TO 29 ■ GENEVA

■ ***Assemblies of the Member States of WIPO (48th session)***

Invitations: As members or observers (depending on the assembly or body), the States members of WIPO; as observers, other States; and as Permanent Observer and *ad hoc* observer organizations, certain organizations.

OCTOBER 4 TO 8 ■ GENEVA

■ ***Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (24th session)***

Invitations: As members, the States members of WIPO and/or of the Paris Union and the European Community; as observers, other States; and as Permanent Observer and *ad hoc* observer organizations, certain organizations.

OCTOBER 11 TO 15 ■ GENEVA

■ ***Standing Committee on the Law of Patents (15th session)***

Invitations: As members, the States members of WIPO and/or of the Paris Union; as observers, other States; and as Permanent Observer and *ad hoc* observer organizations, certain organizations.

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