

WIPO



CDIP/4/3

ORIGINAL: English

DATE: September 18, 2009

E

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

COMMITTEE ON DEVELOPMENT AND INTELLECTUAL PROPERTY (CDIP)

Fourth Session
Geneva, November 16 to 20, 2009

PROJECT ON INTELLECTUAL PROPERTY AND THE PUBLIC DOMAIN
(RECOMMENDATIONS 16 AND 20)

Document prepared by the Secretariat

1. At the third session of the Committee on Development and Intellectual Property (CDIP), held from April 27 to May 1, 2009, the Committee discussed Recommendations 16 and 20, in the context of the project on “Intellectual Property and the Public Domain”, and requested the Secretariat to update the information in the project so as to reflect the discussions in the Committee.
2. The Annex to this document provides the updated text as requested.
3. *The CDIP is invited to take note of the contents of this document and its Annex.*

[Annex follows]

DEVELOPMENT AGENDA RECOMMENDATIONS NOS. 16 AND 20

PROJECT DOCUMENT

1. SUMMARY	
Project Code:	DA_16_20_01
Title:	Intellectual Property and the Public Domain
Development Agenda Recommendation(s):	<p>Recommendation 16 (Cluster B): Consider the preservation of the public domain within WIPO's normative processes and deepen the analysis of the implications and benefits of a rich and accessible public domain.</p> <p>Recommendation 20 (Cluster B): To promote norm-setting activities related to IP that support a robust public domain in WIPO's Member States, including the possibility of preparing guidelines which could assist interested Member States in identifying subject matters that have fallen into the public domain within their respective jurisdictions.</p>
Project Budget:	<p>Non-personnel costs: Sfr.505,000</p> <p>Personnel costs: Sfr.380,000</p>
Project Duration:	24 months
Key WIPO Sectors Involved and Links to WIPO Programs:	<p>Patent Division; Copyright and Related Rights Sector; Sector of Trademarks, Industrial Designs and Geographical Indications; Global IP Issues Division; Global IP Infrastructure Department and the Development Agenda Coordination Division, in cooperation with the Technical Assistance and Capacity Building Sector.</p> <p>Links to WIPO Programs 1, 2, 3, 4, 8, 9 and 14.</p>
Brief Description of Project:	<p>Identifying subject matter that has fallen into the public domain, and preventing subject matter that is in the public domain or under a common or communal proprietorship from individual appropriation, is a key challenge for firms, individuals and Member States, worldwide. With a view to addressing the concerns raised under Recommendations 16 and 20, this project will provide a series of surveys and studies to deepen the conceptual understanding of what constitutes the public domain in different jurisdictions, what tools have been already made available to help identify the subject matter that has fallen into the public domain, and, to the extent relevant information is made available, what are the implications and benefits of a rich and accessible public domain. The project is divided into four components that will address the issue from the perspective of (1) copyright, (2) trademarks, (3) patents, and (4) traditional knowledge (TK) and traditional cultural expressions (TCEs). The outcome of the studies and surveys should be a first step towards further work, including the preparation of guidelines and/or development of tools to facilitate the identification of and access to public domain subject matter.</p>

2. PROJECT DESCRIPTION

2.1. Introduction to the Issue/Concern

The support for, and the preservation of, the public domain requires a clear identification of subject matter that has fallen into the public domain, of what should remain in the public domain, and of what is protected by IP rights. The distinction is a key challenge for firms, individuals and Member States, worldwide. At present, for various reasons outlined below, the public does not always have the effective tools which provide easy access to such information for verifying the validity of relevant IP rights. With a view to addressing the concerns raised under Recommendations 16 and 20, both of which have the same root of challenges, and based on discussions at the previous sessions of the CDIP, this project will be divided into four components that will address the issue from the perspective of copyright, trademarks, patents, traditional knowledge and traditional cultural expressions.

Component (1) Copyright and Related Rights:

Uncertainty over copyright ownership and status of works may result in works not being made available to the public, even where no living person or legal entity asserts claims to ownership of copyright, or where the owner has no objection to such use. With respect to works of unknown authorship or in respect of which the owner cannot be identified (“orphan works”), uncertainty can undermine the economic incentive to create, imposing additional costs on subsequent users/creators wishing to incorporate material taken from existing works into new creations. In recent years, commentators have highlighted the importance of registration/deposit of copyright and related rights in the evolving digital environment, beyond the traditional functions of facilitating the exercise of rights, for example, as a means to prove the existence and/or ownership of a work, and to identify works that have fallen into the public domain. In relation to copyright registration systems, the role of Rights Management Information (RMI) has tremendous potential for identifying and locating content. RMI is increasingly used in the networked environment, which helps users to customize their searches, find the content they are seeking, and where appropriate, enter into licensing agreements with right owners. Understanding how different registration and deposit systems function (both those established in the public sector, as well as the emerging private ones) will thus prove useful in order to identify works that have fallen into the public domain. It is important to understand how different jurisdictions define the public domain, directly or indirectly, and to identify the existing initiatives and tools, technical and legal, which can facilitate access to, use, identification and location of public domain material. In addition, there is a need to clarify the relationship between copyright limitations and exceptions and the public domain, including legal, conceptual and functional aspects.

Surveys and studies proposed for the Development Agenda should be able to take advantage of work which has already been undertaken by WIPO for different purposes in the area of registration of copyright works, such as a Survey of National Legislation on Voluntary Registration Systems for Copyright and Related Rights (SCCR 13/2) undertaken at the request of Member States, in November 2005, and the WIPO Seminar on Rights Management Information which took place in 2007.

Component (2) Trademarks:

IP rights in signs, such as trademarks, confer exclusive rights over those signs, provided that particular conditions for protection are met. Typically, those conditions concern the distinctive character of the signs for which an exclusive right is claimed. Generally speaking, the refusal of trademark protection of certain signs for failing to meet those conditions is referred to as “absolute grounds of refusal” (although this terminology is not necessarily being used by all existing trademark laws). Trademark laws and registration procedures aim at avoiding encroachment upon the public domain, which may occur through acts such as the misappropriation of signs belonging to a common patrimony, or abusive

appropriation of signs that should remain usable by the public. The refusal of trademark protection may take the form of pre-grant examination procedures including *ex officio* refusals of trademark applications consisting of non-registrable signs, and post-grant invalidation procedures including cancellation. Third parties may intervene in the process through oppositions or observations. Problems can arise in cases of misappropriation or abusive appropriation of certain signs. This could be the case where, broadly speaking, individual property rights should not be granted over a specific sign, because that sign has to be used by others and, thus, should remain free from individual rights; or where signs should not be the subject of individual property rights, because they are owned collectively. Examples are the registration of trademarks incorporating signs that are functional or descriptive (including geographically descriptive) (the former case); or misappropriation of signs that are part of a common communal heritage or patrimony, such as state emblems, sacred signs, or signs of cultural significance, (the latter case). To preserve the public domain in the area of trademarks, understanding what tools and practices are currently used by Trademark Offices should be useful to the consideration of further projects.

An example for a source of information that could be useful for Trademark Offices to avoid undue registration of generic terms would be a non-exhaustive list of customary names associated with biodiversity prepared by Brazil, which will be published on the WIPO website to facilitate further discussions of the issue, as appropriate.

Component (3) Patents:

One of the essential elements of the patent system is the public disclosure of patent information, which includes both technical and legal information relating to patents. Information dissemination policies, the legal framework and technical infrastructures all play an important role in supporting access to and use of publicly available patent-related information and in facilitating the identification of technology that is in the public domain. In the context of the Standing Committee on Patents (SCP), discussions were held on two studies prepared by the Secretariat; “Exclusions from Patentable Subject Matter and Exceptions and Limitations to the Rights” and “Dissemination of Patent Information” (SCP 13/3 and 13/5).” These studies include useful information about the role of the patent system in the identification, access and use of technology that is in the public domain. As explained in the study on dissemination of patent information, the public domain in relation to patent law consists of knowledge, ideas and innovations, over which no person or organization has any proprietary rights. Subject matter in the public domain with respect to patents, could be identified by confirming the absence of legal restrictions on use (i.e., exclusion from patent protection under applicable laws), the rejection of a patent application, the expiration of patent protection, non-renewal, and revocation or invalidation of a patent. However, in practice, it is often hard for the public to identify the validity of relevant patents due to the lack of effective tools in many jurisdictions such as patent legal status databases accessible to the public.

Component (4) TK and TCEs:

Participants in efforts aimed at the enhanced protection of TK and TCEs recognize that it is critical to consider the role, boundaries and contours of the “public domain”. The “public domain” concept resonates in various and unique ways in relation to TK and TCEs. For instance, TK and TCEs have often been considered by the IP system as “public domain” (*scientia nullius*), and some still argue today that the public domain character of TK and TCEs promotes their continued preservation and vitality. Yet, many representatives of indigenous communities and Member States reject the concept of the “public domain”, and call for *sui generis* forms of protection for TK and TCEs which are not necessarily situated within or based on conventional IP systems. These complex and sensitive issues are the subject of ongoing reflection within WIPO’s TK Program and the WIPO IGC and have been so for some years.

These issues can arise concretely in relation to the documentation of TK and TCEs, especially initiatives to pre-empt patents and other IP rights on TK and TCEs through “defensive protection” measures. While indigenous and local communities assert that TK and TCEs are protected by customary laws and protocols, they may, technically, from the perspective of the current IP system in many jurisdictions, be considered to be part of the “public domain”. Yet patent search and examination authorities are often not aware of this knowledge and these expressions as part of searchable prior art and may therefore not systematically take account of them in assessing the validity of patent and other IP applications. This situation has led to concerns that inappropriate patent and other IP rights may be taken out on elements of such TK and TCEs.

In this context, defensive protection refers to both legal and practical/administrative measures taken to pre-empt or reverse the grant or exercise of patents and other IP rights over TK and TCEs, where these patents and rights inappropriately cover materials that are ineligible for patent protection by virtue of their origin and their public availability. One such measure may be the creation of national databases that include information on TK and TCEs in languages and formats that can be used by Patent Offices. The Traditional Knowledge Digital Library (TKDL) developed by India is a leading example in this respect. However, such databases aim to render TK and TCEs “publicly available” as part of searchable prior art rather than in the “public domain” as such, and calls for a rich and accessible public domain might run counter to the aspirations of certain TK and TCE holders and Member States. Whether or not to establish TK and TCEs databases for defensive purposes is a policy choice for Member States and communities to make. Databases could also serve to provide “positive” protection for TK and TCEs, which may also have implications for the public domain.

2.2. Objectives

The overall project objective is established by Recommendations 16 and 20 of the WIPO Development Agenda. In particular, the project will focus, as a first step, on the second part of Recommendations 16 and 20, namely, analysing the implications of a rich and accessible public domain, exploring the various tools available for identifying and accessing subject matter that has fallen into the public domain, and wherever possible, suggest or work towards the development of new tools or guidelines in this respect, in order to enhance access to the public domain and preserve knowledge that is already in the public domain.

2.3. Delivery Strategy

In order to achieve the objectives indicated above, a series of studies, surveys, pilot and feasibility tests will be undertaken by the Secretariat. This may be the first step in the implementation of the Recommendations, which will enable Member States to get an initial understanding of the subject under consideration. The studies will analyze the various tools that are available for identifying subject matter that is in the public domain, and consider whether further action is required in any field to enhance the capacity of actors to identify material in the public domain. Depending on the findings and conclusions of the studies, Member States may decide on additional activities that might be undertaken to meet the concerns of the Recommendations:

(1) Copyright

1.1. Second Survey on Voluntary Registration and Deposit Systems: The new survey would expand on the 2005 Survey in at least four different respects, namely, (i) enable scrutiny of the operational requirements for voluntary registration/deposit systems in the digital environment and available search tools; (ii) include information on how Member States with voluntary registration systems address the issue of orphan works in those systems; (iii) solicit information on

recorded/registered public domain subject matter; and (iv) attempt to include all Member States. The Survey would include conclusions based on the data received by Member States.

1.2. Survey of Private Copyright Documentation Systems and Practices: This would cover the use of copyright documentation, including in the form of RMI, by entities such as collective management organizations or the Creative Commons System, and would examine how these systems identify, or might contribute to identifying, content that is protected or in the public domain.

1.3. Scoping Study on Copyright and Related Rights and the Public Domain: The scoping study would include an illustrative comparison of national legislation that directly, or indirectly, defines the public domain (as far as copyright is concerned), a survey of initiatives and tools, technical and legal, which facilitate access, use, identification and location of public domain material, and, finally, recommendations for further work to be undertaken by WIPO in regard to the public domain as far as copyright is concerned. The study would also include a preliminary analysis of the possible implications of a rich and accessible public domain.

1.4. A Conference on Copyright Documentation and Infrastructure: will be organized following completion of the two Surveys and Scoping Study under 1.1, 1.2 and 1.3, above. The participation of some representatives of LDCs and developing countries would be financed under the project.

(2) Trademarks

Study on Misappropriation of Signs and Possibilities to Prevent Such Practices: The proposed study would analyze the situation in a representative number of Member States by looking at the applicable legal provisions, primarily in trademark law, and researching reported cases of alleged misappropriation of certain distinctive signs and abusive appropriation of signs, that should remain available for use by the public. The study would cover both trademark applications and registrations involving the appropriation of signs that should remain freely available to the public, and those involving the misappropriation of signs owned by specific collectivities. The study would be prepared by a consultant, with contributions from a number of regional consultants, as well as inputs from Member States. The study would also include examples of misappropriation of distinctive signs and a preliminary analysis of the possible impact of misappropriation on various stakeholders, based on voluntary inputs from interested Member States. The findings of the study could form the basis for further consideration and deliberation, as to whether concrete action needs to be undertaken in that area. This component of the project would be coordinated with the Standing Committee on Trademarks.

(3) Patents

3.1. Study on Patents and the Public Domain: It is proposed to undertake a study that would focus on patents and the role of patent information in the identification, access and use of public domain material. As mentioned above, a preliminary study on the dissemination of patent information (which has, *inter alia*, addressed the public domain issue) and another study on exclusions from patentable subject matter and exceptions and limitations to those rights, were prepared for the SCP, and would be a useful basis for preparing a specific study focusing on patents and the public domain. The specific study would be useful to further explore the analysis of patent information and certain provisions of the patent system as a tool and basis for identifying and claiming subject matter that has fallen into the public domain. The study would focus particularly on legal status information to identify off-patent technology. The study would also analyze the implications and benefits of a rich and accessible public domain.

3.2. Feasibility Study: The Study would analyze the feasibility of WIPO supporting IP Offices that wish to establish a national database containing the legal status of national patents so that the register may enhance public access to the information necessary for identifying inventions in the public domain. The study also includes the possibility of creating a global portal in PATENTSCOPE®, which would link to those patent registers.

(4) Traditional Knowledge (TK) and Traditional Cultural Expressions (TCEs)

4.1. Study on the “Public Domain” and TK and TCEs: The concise study would examine the origins and role of the public domain concept in IP, the various ways in which the concept is referred to and utilized in relation to TK and TCEs, and analyze and evaluate the interaction between calls for a richer and more accessible public domain, to the current proposals for the enhanced protection of TK and TCEs. The study would provide an analytical foundation for, and complement the survey below, which would address the specific case of TK and TCE databases, and their impact upon the public domain.

4.2. Survey of the existing National TK and TCEs Databases: The survey would provide a factual description of a selection of existing TK and TCE databases and their objectives. Based on inputs from owners and stakeholders of the databases, the survey would also analyze the use of such databases, including those used by patent offices in connection with the identification and preservation of TK and TCEs that may be considered to be in the “public domain”, and the possible advantages and disadvantages of establishing them. The survey would refer to and draw upon the study above.

3. REVIEW AND EVALUATION

3.1. Project Review Schedule

A mid-term review will be undertaken after one year, which will be the basis for reporting on progress to the CDIP.

3.2. Project Self-Evaluation

In addition to the project self-evaluation, an independent evaluation may also be undertaken for the project

<u>Project Outputs</u>	<u>Indicators of Successful Completion</u> <u>(Output Indicators)</u>
1.1. Second Survey on Voluntary Registration and Deposit Systems	Reasonable number of replies to the questionnaire from Member States enabling a meaningful analysis by the Secretariat; Completion of the paper within the established timeframe and the quality required by the terms of reference (TORs) for presentation to the CDIP; and Feedback from Member States on the paper when presented to the CDIP.
1.2. Survey of Private Copyright Documentation Systems and Practices	Completion of the paper within the established timeframe and the quality required by the TOR for presentation to the CDIP; and Feedback from Member States on the paper when presented to the CDIP.

1.3. Scoping Study on Copyright and Related Rights and the Public Domain	<p>Completion of the paper within the established timeframe and the quality required by the TOR for presentation to the CDIP; and</p> <p>Feedback from Member States on the paper when presented to the CDIP.</p>
1.4. A Conference on Copyright Documentation and Infrastructure	<p>Feedback from Member States on the paper and on the outcome of the conference.</p>
2. Study on misappropriation of distinctive signs and possibilities to prevent such practices	<p>Completion of the study within the established timeframe and the quality required by the TOR for presentation to the CDIP; and</p> <p>Feedback from Member States on the study when presented to the CDIP.</p>
3.1 Study on patents and the public domain	<p>Completion of the paper within the established timeframe and the quality required by the TOR for presentation to the CDIP; and</p> <p>Feedback from Member States on the study when presented to the CDIP.</p>
3.2. Feasibility study on creation of a national patent register database and linkage to PATENTSCOPE®	<p>Completion of the study within the established timeframe and the quality required by the TOR for presentation to the CDIP; and</p> <p>Decision taken on the basis of conclusions reached by the Study.</p>
4. Survey of the existing national TK and TCEs databases	<p>Study and survey completed; and</p> <p>Any follow-up action taken on the basis of the study and survey, as agreed by the CDIP.</p>
<u>Project Objective(s)</u>	<u>Indicator(s) of Success in Achieving Project Objective</u> (Outcome Indicators)
Enhanced understanding of the definition of the public domain and the availability of tools for identifying subject matter that has fallen into the public domain	<p>Quality of discussion among Member States on the studies/tools/surveys developed; and</p> <p>Feedback by Member States on the extent to which the outputs have met the concerns addressed in the Recommendation.</p>
Identification of new tools or guidelines to be developed on the basis of findings of studies	<p>List of tools and guidelines for possible development by WIPO in the specified areas, to be made available at the end of the project for evaluation by Member States.</p>

4. IMPLEMENTATION TIMELINE

ACTIVITY	QUARTERS									
	2009*		2010				2011			
	3rd	4th	1 st	2nd	3rd	4th	1st	2nd	3rd	4 th
1.1. Second Survey on Voluntary Registration and Deposit Systems	X	X	X	X						
1.2. Survey of Private Copyright Documentation Systems and Practices			X	X	X	X	X	X		
1.3. Scoping Study on Copyright and Related Rights and the Public Domain	X	X	X							
1.4. A Conference on Copyright Documentation and Infrastructure								X	X	X
2. Study on Misappropriation of Distinctive Signs			X	X	X	X	X	X		
3.1 Study on Patents and the Public Domain			X	X	X	X	X			
3.2. Feasibility study on creation of a national patent register database and linkage to PATENTSCOPE®			X	X	X	X				
4.1 Study on the public domain and TK and TCEs			X	X						
4.2. Survey of the existing national TK and TCEs Databases					X	X	X	X		
REVIEW SCHEDULE					X					

* Activities foreseen for 2009 are of a preparatory nature requiring no financial resources.

5. BUDGET

5.1. Project Budget for the 2010/2011 Biennium (non-personnel costs)

	TOTAL (Swiss Francs)
<i>Travel and Fellowships</i>	
Staff Missions	25,000
Third-party Travel	100,000
Fellowships	
<i>Contractual Services</i>	
Conferences	30,000
Experts' Honoraria	290,000
Publishing	
Others	60,000
<i>Equipment and Supplies</i>	
Equipment	
Supplies and Materials	
TOTAL	505,000

SUPPLEMENTARY INFORMATION FOR THEMATIC PROJECTS

1. Linkages to activities contained in document CDIP/1/3 for Recommendation 20

This Project Document is based on the activities suggested by the Secretariat for Recommendation 20 in Document CDIP/1/3. It reflects the modifications requested by Member States during discussions and includes some additional components.

Copyright: the copyright component of this project draws from the discussions that took place at the second session of the CDIP, in which changes were requested to the initial suggestions made by the Secretariat.

Trademarks: the trademark component remains as included in document CDIP/1/3 and additional information on this component is provided in this document.

Patents: the patent component reflects the changes requested during the second session of the CDIP, and includes some additional activities that are proposed to be undertaken by the Secretariat, including a feasibility study on the inclusion of information on legal status in the databases of national patent offices and PATENTSCOPE®.

Traditional Knowledge: in the field of traditional knowledge, document CDIP/1/3 referred to the “*development of practical tools to ensure that public domain traditional knowledge and genetic resources are not the subject of inaccurately granted patents*”, without providing guidance about the nature of the tools . The project document suggests that the main tool would be the development of a methodology or guidelines for the establishment of National Traditional Knowledge Databases (NTKD), and that a pilot project would be undertaken in one country applying the methodology.

2. Linkages to activities contained in document CDIP/1/3 for Recommendation 16

Copyright: in the field of copyright, document CDIP/1/3 referred to the first WIPO Survey on Voluntary Registration Systems and mentioned the possibility of intensifying that work. The Project Document proposes the elaboration of a second survey which will provide additional information on more countries that would be particularly relevant to the issue of the public domain. Similarly, the document referred to the Seminar on Rights Management Information (RMI) that took place in September 2007. The Project takes this line of work a step further, proposing a Survey of Private Copyright Documentation Systems and Practices that would cover the use of copyright documentation in the form of RMI by entities such as collective management organizations.

Trademarks: the document refers to activities undertaken under the SCT but no new activities were proposed. The study proposed in this project document, is closely related to the issues mentioned in CDIP/1/3.

Patents and Traditional Knowledge: the document makes reference to the work under the SCP and the IGC, which will continue its course on the basis of Member State requests in those WIPO bodies, while taking into account the need to “*consider the preservation of the public domain*” in such normative processes.