

## **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 and fifth sessions of the Committee on Development and Intellectual Property (CDIP), held from April 27 to May 1, 2009, and from April 26 to 30, 2010, respectively, 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 during those sessions of the Committee.
2. The Annex to this document provides the updated approved text.

[Annex follows]

**DEVELOPMENT AGENDA RECOMMENDATIONS NOS. 16 AND 20**

**PROJECT DOCUMENT**

<b>1. SUMMARY</b>	
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 intellectual property (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.360,000</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</p>

	<p>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 three components that will address the issue from the perspective of (1) copyright; (2) trademarks; and (3) patents on the understanding that the text of trademarks has to be discussed at the Fifth Session of the CDIP. 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 to promote norm-setting activities related to IP that support a robust public domain in WIPO's Member States.</p>
<p><b>2. PROJECT DESCRIPTION</b></p>	
<p><b>2.1. Introduction to the Issue/Concern</b></p>	
<p>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.</p> <p><b>Component (1) Copyright and Related Rights:</b></p> <p>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</p>	

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 of any Member State, 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.

### **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.

#### **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: They should also form a basis to promote norm-setting activities related to IP that support a robust public domain in WIPO’s Member States.

**(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, particularly in the digital environment, which affect 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. The study should also take into account the ongoing work in the Standing Committee on Copyright and Related Rights on limitations and exceptions to copyright.

**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 least developed countries (LDCs) and developing countries would be financed under the project.

**(2) Trademarks**

**Study on Misappropriation of Signs:** The proposed study would undertake a fact-based comparative analysis of the trademark laws of a representative number of Member States to examine how they make their determinations to define and apply misappropriation of signs owned by specific collectivities.

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 past cases 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.

**The study would be considered final once Member States have an opportunity to review and to provide amendments to the study to be incorporated in the overall draft.**

**(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 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.

<b>3. REVIEW AND EVALUATION</b>	
<b>3.1. Project Review Schedule</b>	
A mid-term review will be undertaken after one year, which will be the basis for reporting on progress to the CDIP.	
<b>3.2. Project Self-Evaluation</b> <i>In addition to the project self-evaluation, an independent evaluation may also be undertaken for the project</i>	
<b>Project Outputs</b>	<b>Indicators of Successful Completion (Output Indicators)</b>
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	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.
1.4. A Conference on Copyright Documentation and Infrastructure	Feedback from Member States on the paper and on the outcome of the conference.
2. Study on misappropriation of distinctive signs and possibilities to prevent such practices	Completion of the study within the established timeframe and the quality required by the TOR for presentation to the CDIP; and  Feedback from Member States on the study when presented to the CDIP.
3.1 Study on patents and the public domain	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 study when presented to the CDIP.



<p>3.2. Feasibility study on creation of a national patent register database and linkage to PATENTSCOPE®</p>	<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>
<p><b>Project Objective(s)</b></p>	<p><b>Indicator(s) of Success in Achieving Project Objective</b> (Outcome Indicators)</p>
<p>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>	<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>
<p>Identification of new tools or guidelines to be developed on the basis of findings of studies</p>	<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 <sup>st</sup>	2nd	3rd	4th	1st	2nd	3rd	4 <sup>th</sup>
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				
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) [excluding budget for trademark component]**

	TOTAL (Swiss Francs)
<i>Travel and Fellowships</i>	
Staff Missions	15,000
Third-party Travel	75,000
Fellowships	
<i>Contractual Services</i>	
Conferences	30,000
Experts' Honoraria	240,000
Publishing	
Others	
<i>Equipment and Supplies</i>	
Equipment	
Supplies and Materials	
<b>TOTAL</b>	<b>360,000</b>

## 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 Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (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.

[End of Annex and of document]