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SPECIAL
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Building respect for intellectual property – stimulating innovation and creativity

By **Francis Gurry**,
Director General, WIPO



Photo: WIPO

“The International Conference on Building Respect for Intellectual Property – Stimulating Innovation and Creativity is an opportunity... to explore ways to build greater respect for IP and to leverage opportunities for innovation and creativity to drive economic growth,” says WIPO Director General Francis Gurry (above).

The International Conference on Building Respect for Intellectual Property – Stimulating Innovation and Creativity, co-organized by the Shanghai Municipal People’s Government (SMPG) and WIPO with the support of the State Intellectual Property Office of China (SIPO), will take place from November 17 to 18, 2016, in Shanghai, People’s Republic of China. It offers an exciting opportunity to exchange information and experiences on enhancing public awareness about the importance of respecting intellectual property (IP), and on emerging issues in IP adjudication and jurisprudence.

In the global knowledge economy, innovation, creativity and IP hold far-reaching promise for spurring economic growth, trade and employment in countries at all stages of development. And amid indications that global economic growth is slowing, it is now more important than ever to find new ways to stimulate the world economy by leveraging the opportunities that are presented by global innovation and creativity.

Today, the intellectual component of production is far greater than it has ever been. IP has become an indispensable mechanism for translating know-how into tradeable commercial assets and capturing the competitive advantage that they represent. The vast technological transformation that is currently underway in China is testimony to this ongoing transition toward a global knowledge economy. In 2016, China for the first time joined the ranks of the world’s 25 most innovative economies in the Global Innovation Index, co-published by Cornell University, INSEAD and WIPO. China has become a world-leader in technological innovation, particularly in the area of emerging technologies such as digital communication, computing technology, 3D printing, nanotechnology and robotics, positioning it as a global technology innovation center. For these reasons, this conference in Shanghai is very timely.

THE ROLE OF IP AND ITS PROMISE

IP plays a pivotal role at the center of the innovation–growth nexus. It promotes innovation by incentivizing investment in knowledge-based assets and encouraging the diffusion of knowledge across the economy. IP rights establish a secure legal framework for investment in and commercialization of innovation and creativity. These rights enable firms, including innovative start-ups, to navigate the perilous process of transforming an idea into a commercially viable product, and to compete with success in the global marketplace, while safeguarding the public interest. IP facilitates the diffusion of knowledge by encouraging the disclosure of information and technology transfer. It also provides a framework for innovators to control how and under what conditions their innovations and creations may be used by others. As such, IP is a key factor in creating an environment in which innovation and creativity can flourish and generate future growth and prosperity.

Realizing the promise of IP, innovation and growth is not without its challenges. Much remains to be learned about the complex interactions that occur between these three elements across the diverse range of technologies that exist and are emerging today. But the benefits of achieving sustained growth are well-known; they include job creation, higher living standards and the alleviation of poverty.

To fully grasp these benefits, each nation must find the right mix of policies that balance IP protection with the public interest to realize the innovative and creative potential of its economy. Policymakers must also take into account the economic, social and cultural impacts that flow from their innovation policy decisions. This is an increasingly difficult task, in part because of the rapid rate at which technological breakthroughs are transforming innovation and creative landscapes. Globalization – and with it the digital transformation – present enormous opportunities and challenges. Policymakers must adopt flexible approaches that maximize the opportunities that technological breakthroughs offer while overcoming the challenges that they pose.

BUILDING RESPECT FOR IP

Fostering an environment that encourages respect for IP is a basic principle shared by all WIPO member states. Yet its full realization remains elusive. IP-infringing activities – most notably counterfeiting and piracy – are prevalent in many parts of the world. Devising appropriate responses requires a solid understanding of what motivates producers and consumers of IP-infringing goods and the impact that these IP infringements are having on the welfare of societies. Only then will it be possible for countries to craft and implement a broad range of curative and preventive measures in line with their national strategic needs. Ideally, such measures will target improvements in legislation and enforcement and will boost cultural change and awareness of the value of IP, the development of business and technology solutions that foster legal alternatives, and institutional collaboration.

EXPLORING OPPORTUNITIES AND CHALLENGES

The Shanghai Conference will explore the enormous benefits and opportunities that technological breakthroughs offer as well as the challenges that still need to be overcome. The Conference program offers an exciting and diverse range of speakers and topics. Discussions will focus on two main themes:

- realizing the promise of IP in stimulating innovation and driving development and growth; and
- IP protection and adjudication in an evolving landscape.

Six subtopics will also be discussed:

- developing and implementing comprehensive, coherent and well-coordinated national IP strategies;
- innovation, technology transfer and the commercialization of IP;
- international cooperation on building respect for IP;
- IP enforcement mechanisms;
- how to resolve IP disputes in an effective and balanced way; and
- emerging issues in IP adjudication and jurisprudence.

The International Conference on Building Respect for Intellectual Property – Stimulating Innovation and Creativity is an opportunity for policy- and thought-leaders in government and business as well as legal practitioners to explore ways to build greater respect for IP and to leverage opportunities for innovation and creativity to drive economic growth.

China – on course to become an IP powerhouse

By Dr. **SHEN Changyu**, Commissioner, State Intellectual Property Office of the People's Republic of China (SIPO)



Photo: Courtesy of SIPO

Pointing to national IP statistics, Dr. SHEN Changyu, Commissioner of SIPO (above), notes that China is “a vital force in innovation and remains one of the major drivers of the rapid growth in global IP applications.”

To protect intellectual property (IP) is to protect innovation, and the effective use of IP will stimulate innovation. Since the Reform and Opening-up, the Chinese Government has attached great importance to IP. Through concerted effort by many parties, work on IP in China has developed steadily and rapidly, not only making China an IP powerhouse, but also greatly supporting the country's economic and social development and the progress of the global IP system.

Work on IP in China maintained a promising momentum last year. In the first half of 2016, China received 553,000 patent applications, 19,000 Patent Cooperation Treaty (PCT) international patent applications and 1,740,000 trademark registrations – up 30.5 percent, 43.3 percent and 32 percent respectively on the same period last year. In 2015, China's copyright registrations rose to 1,641,000, representing a 35.5 percent year-on-year increase. In other areas of IP such as new plant varieties and layout designs of integrated circuits, applications also reached record highs. These statistics demonstrate that China is a vital force in innovation and remains one of the major drivers of the rapid growth in global IP applications.

INNOVATION: A KEY DRIVER OF DEVELOPMENT

Today, the economic development of China has reached a new normal with innovation a leading driver of its development. With a focus on the country's current and future potential, China is implementing an innovation-driven development strategy to promote public entrepreneurship and innovation. As the fundamental safeguard and stimulus of innovation, IP is playing an ever more important role in this process. Toward the end of last year, the Chinese Government issued and implemented *Several Opinions on Accelerating the Construction of an Intellectual Property Powerhouse in the New Circumstances*, which identified 106 specific tasks. This document explicitly prescribes a deepening of reforms in key areas of IP, enhanced protection and utilization of IP, strict implementation of IP protection and the creation of a better environment for innovation, entrepreneurship and fair competition, to facilitate innovative and open development in the economy.

At the beginning of this year, the expression “accelerating the construction of an IP powerhouse” appeared in several important governmental documents, including the *Outline of the 13th Five-Year Plan for National Economic and Social Development* and *The National Strategies for Innovation-driven Development*. The *13th Five-Year Plan for Intellectual Property* was also listed as one of the country’s key plans. It sets out a new top-level design of the IP system in China and opens new strategic opportunities for its development.

With the world economy facing a weak recovery, countries including China are pushing forward with supply-side structural reforms, aiming to spur momentum and economic development. IP is a prerequisite for innovation-driven development, playing a crucial role in encouraging institutional development and technology supply. At the same time, IP is also the subject of increasing attention worldwide, as globalization deepens and international trade grows. The Chinese Government believes that, subject to general principles and basic standards of IP, the international community should be pragmatic about global developmental imbalances and should make more reciprocal, inclusive and balanced institutional arrangements to promote shared development and welfare for all. The Chinese Government is willing to contribute to such efforts as part of the international community.

PROMOTING IP EDUCATION IN CHINA

China fully recognizes that in order to construct an IP powerhouse, one has to create a culture of respecting knowledge, admiring innovation and abiding by the law as well as enhancing public awareness of IP. In recent years, China has organized many IP-related activities, such as IP Publicity Week and pilot model projects for IP education in primary and secondary schools during important events like World Intellectual Property Day. These activities have achieved remarkable results. Recently, the State Intellectual Property Office of China published *The 7th Five-Year Plan on the Publicity and Education of IP Laws and Orders Nationwide (2016-2020)*, which identified a series of tasks to further enhance public IP awareness, strengthen publicity and education about IP compliance among young people and create a better IP culture. China is ready to strengthen communication and cooperation with WIPO and its member states to jointly promote innovation and prosperity for humanity as a whole.

Looking to the future, we are confident that the development of IP in China will remain rapid and sustainable and that China’s IP will make an even greater contribution to the development of the country and the global IP system.

Building respect for IP in Shanghai

By Ms. **ZHAO Wen**,
Vice Mayor of Shanghai,
People's Republic of China

Photo: Courtesy of the Shanghai Intellectual Property Administration (SIPA)



“Innovation and creativity are at the core of Shanghai’s competitiveness and are essential pillars of the city’s sustainable development,” says Shanghai’s Vice-Mayor, Ms. ZHAO Wen (above).

Intellectual property (IP) rights are critical in stimulating innovation and creativity, and policymakers across the globe are working to raise awareness about their importance. Thanks to these efforts, the public is becoming increasingly aware of the need to respect IP rights. In fact, building respect for IP has become something of a social trend.

Modern cities – especially mega-cities like Shanghai, with its galaxy of academic institutions, research and development (R&D) centers and industries – are magnets for innovation and creativity, and powerful drivers of economic and social development. As such, they have a leading role to play in enhancing respect for IP and fostering a positive IP culture.

Innovation and creativity are at the core of Shanghai’s competitiveness and are essential pillars of the city’s sustainable development. Shanghai is committed to becoming a “City of Innovation,” a science and technology innovation center of global significance. Our aim is for Shanghai to become a major IP hub within the Asia-Pacific Region, with a fully integrated innovation system that includes a comprehensive IPR protection framework, integrated IP service systems and substantial high-level IP talent.

Shanghai’s IP culture is underpinned by a commitment to “respecting knowledge, advocating innovation, and honest and law-abiding business practices”. We encourage the incorporation of IP into school curricula as well as public science and legal education programs to broaden understanding and awareness of IP and to promote respect for IP rights among the general public, and young people in particular. In April each year, we organize IP Publicity Week with a series of activities around the city, including an IP briefing for foreign consulates, foreign chambers of commerce and the media. This event marks the release of the annual *White Book on IP Development in Shanghai*.

MAKING IP A PRIORITY

In recent years, Shanghai has made protection of IP rights a priority, putting in place strict judicial and administrative measures. The Shanghai IP Court, established at the end of 2014, is one of three specialized IP courts in China. Law enforcement units in the city, under the coordination of the Shanghai IP Joint Committee, regularly carry out targeted actions to clamp down on IPR infringements. A rapid-response mechanism to investigate IPR infringements has also been developed and is now operational.



Photo: Courtesy of the Shanghai Intellectual Property Administration (SIPA)

Mega-cities like Shanghai are centers of innovation and creativity and powerful drivers of economic development. They have an important role to play in building a positive IP culture.

The city's commitment to building respect for IP has led to the rapid development and uptake of IP in Shanghai. This is evident from a significant increase in levels of IP creation and the number of applications filed in recent years. In 2015, for example, the city accounted for around 100,000 patent filings. Forty-seven percent of these related to inventions, 42 percent to utility models and 11 percent to industrial designs. As at the end of 2015, businesses in Shanghai owned 548,000 valid registered trademarks, including a significant number of well-known marks. In the same year, copyright registrations in Shanghai neared 200,000.

In recent years, Shanghai and WIPO have established and developed close relations, organizing many joint training programs and IP-related seminars in the city. The Shanghai Municipal People's Government and WIPO also co-organized the landmark Shanghai International Intellectual Property Forum (SIIPF), which explores a range of topical international IP issues.

This November, we are honored to be hosting the International Conference on Building Respect for Intellectual Property – Stimulating Innovation and Creativity in Shanghai during the SIIP Forum. The event will provide an effective knowledge-sharing and networking platform for government agencies, research institutions, legal bodies and industry. We trust that that the exchange of views and ideas that will take place will give rise to a growing number of best practices with respect to building respect for IP and stimulating innovation and creativity. And we hope that the consensus that emerges from the event will benefit delegates from around the world.

The challenge of protecting intellectual property

By **Baroness Neville-Rolfe**, Minister for Intellectual Property, Department for Business, Energy and Industrial Strategy, United Kingdom



Photo: Courtesy of UK IPO

In May 2016 Baroness Neville-Rolfe, the UK's Minister for Intellectual Property (above), launched the UK Government's new strategy, "Protecting creativity, supporting innovation: IP enforcement 2020". The strategy outlines measures to ensure that IP enforcement works effectively in the UK.

Intellectual property (IP) has been very important to the UK for a long time. The first trademark legislation was passed by the English Parliament in 1266. The UK was at the forefront of developing patent rights and the first to codify copyright law with the Statute of Anne in 1710. It has made good use of these IP rights ever since they were brought into being.

The UK has also led the world in publishing: only seven works of fiction have ever sold more than 100 million copies, and five of those were from British authors. In music, so far only seven artists have sold over 250 million records – four of them were from the UK. And the UK has been, and continues to be, at the forefront of technological innovation protected by patents. From steam engines to televisions to graphene, the UK punches well above its weight.

THE CHALLENGE OF PROTECTING IP

The problem we all face is working out how to ensure that these valuable IP rights are usable, and how to ensure that their value is preserved in the face of relentless infringement on an enormous scale. Professor Hargreaves stated it quite plainly in his 2010 report: "IP rights cannot succeed in their core economic function of incentivizing innovation if rights are disregarded or are too expensive to enforce. Ineffective rights regimes are worse than no rights at all..."

This is where government comes in. In the UK we often say that IP rights are private rights. In some cases the appropriate redress is through the civil courts, and rights holders can be left to get on with it. The problem is that when infringement is so widespread and so damaging that legitimate businesses are in danger of collapse, it is no longer a private matter. As a government we stand right behind businesses, creators and innovators of all types. We cannot sit by while rights that have been developed to nurture innovation and encourage investment are rendered impotent. This is true whether it is caused by the deliberate behavior of serious infringers or by the unthinking actions of people who don't appreciate the harm that is caused by watching free streaming sites or buying "bargain" counterfeit goods.

Photos: Courtesy of UK IPO



In 2013/14, in partnership with industry groups, the UK IPO developed a national campaign comprising various targeted projects to build respect for IP. One of these projects was Music Inc., a downloadable game aimed at 14- to 18-year-olds. It educates gamers about copyright and gives them an insight into the various stages of music production highlighting real issues that arise from piracy.

THE UK'S ENFORCEMENT STRATEGY

In May 2016 I launched the UK Government's new strategy, "Protecting creativity, supporting innovation: IP enforcement 2020". This sets out what we see as the most pressing priorities and some of the work we see as most necessary to make sure that IP enforcement works effectively. In some ways we start from a favorable position. The UK has done well in recent years, being ranked highly for its IP system, and for its enforcement environment in particular. But we know that we must work tirelessly to keep ahead of the challenges.

A key priority for us is to "know the enemy"; good evidence, and clear intelligence about the harm caused by infringement and the business models that facilitate and profit from it, are central to an effective response. This is why the strategy contains a commitment to develop a robust methodology for measuring the harm caused by IP infringement. The UK Intellectual Property Office will develop a comprehensive scoreboard, to be published annually, combining data on the prevalence of civil and criminal IP infringement with the outcomes of enforcement activity and the best available estimates of their impact. This will mean better reporting in the criminal justice system, better reporting of court cases and a deeper understanding of consumer behaviors and emerging trends. The UK IPO has been supporting industry and enforcement agencies with its IP Crime Intelligence Hub, and has built in links with the police and trading standards to share that intelligence.

TACKLING INFRINGING MATERIAL ON- AND OFF-LINE

We also recognize the need to tackle the issue of infringing material online. Our aim is to make it easier for consumers to recognize legitimate content, and to understand the harm caused by piracy. We also want to find a new model for notice and takedown, one which does not require rights holders to send a multitude of notices only to see the same content reposted after it has been taken down. We have had some success here already, with the Infringing Website List now beginning to starve piracy websites of the advertising money they need to survive, but we are now looking to push this out further, to other intermediaries and other territories.

Nancy and the Meerkats was developed with FunKids Radio and targets under 12-year-olds. The first series had 344,000 listeners and 963 downloads of podcasts. See: www.funkidslive.com/features/nancy-and-the-meerkats.



Despite the focus on new technologies and the online world, we cannot afford to take our eyes off the physical world. Counterfeiting remains a huge problem, causing harm for brand owners in lost sales and harming consumers with substandard and sometimes dangerous goods. The strategy sets out our continued leadership in the UK in this area and provides a dedicated intelligence resource to help enforcement agencies tackle counterfeiting. We will also continue our efforts to educate about the deep-rooted and well-proven links between IP crime (piracy and counterfeiting) and other criminal behavior. We will champion the use of Proceeds of Crime seizures in IP investigations. We don't just want to follow the money – we want to take it back from the criminals who have stolen it.

TACKLING NEW MODES OF INFRINGEMENT

In our strategy we have committed to looking at the entirety of the legal framework, to ensure that whatever the type of infringement, and whatever the IP rights, creators and innovators are able to access recourse that is effective and proportionate. We have announced our intention to toughen penalties for online copyright infringement, but we are also looking at new areas where we might need to create new legal tools to tackle new modes of infringement. We will look, for example, at whether or not new legislation is needed to respond to the role of fulfilment houses (companies that specialize in warehousing and packaging for others) and drop-shippers in the distribution of counterfeit goods. We will look at the legislation around set-top boxes and illegal streaming, and whether we have effective remedies to tackle their misuse. And we will look across the legal framework, to ensure that there are effective sanctions when there is infringement to be tackled.

EDUCATING CONSUMERS

Education and building respect for IP are key elements of the strategy. As an example, set-top boxes capable of accessing infringing broadcasts were initially an issue in business premises, especially pubs, which took the opportunity to screen football matches without a valid subscription. More recently these set-top boxes have entered the mainstream consumer market. There is an obvious appeal. If the only factor guiding a purchase decision is price then a set-top box which allows you to watch countless premium channels for a modest one-off payment is an attractive option. This helps give an insight into the solution. We have to work to educate consumers as to what



Photos: Courtesy of UK IPO

Produced in partnership with Aardman Animations, Shaun's Cracking Ideas competition, aimed at the 4-16 age range, introduces young innovators to the concept of IP and the value of protecting innovation and creativity. Over 3,000 entries were received for the 2014/15 competition.

exactly their bargain entails. If they knew that by buying these boxes and watching infringing streams they were directly damaging the future of their favorite programs, they might think twice.

We know that this is not an easy message to get across. Consumers understand that deliberate infringement has consequences, but many don't think that they themselves bear any responsibility. Working with businesses to promote diverse sources of legal content will help to ensure that "it's easier to infringe" or "I can't get it elsewhere" are no longer valid excuses for infringement. Educating consumers directly about the effects their choices have, in the mold of the "Get It Right From A Genuine Site" campaign (www.getitrightfromagenuinesite.org), will help us build momentum for behavior change.

ENFORCEMENT IS A GLOBAL ENDEAVOR

IP is by its nature international. A 2014 study by UK Trade & Investment (the UK Government's international trade and inward investment agency) found that one in four UK businesses were deterred from entering an overseas market due to the risk of IP theft. While some of this can be written off to unfamiliarity, language barriers, different legal systems and so on, there is clearly a real challenge for government as well. That is why our strategy also lays out our plans to build on the existing UK IP *attaché* network, to build influence in key UK markets, to provide

training and practical support to emerging markets, and to strengthen our links with established trading partners to help ensure that consumers receive genuine goods wherever in the world they live.

Bilateral engagement is also important, and earlier this year I visited China to discuss IP issues with ministers, Chinese companies and British brands operating in the region. I was particularly pleased to be able to visit a number of major Chinese companies, including Tencent, Huawei, Alibaba and Lenovo. These high-tech companies are changing the global IP and business landscape. China shares our view that strong IP rights are crucial to support innovation, creativity and business and that this helps deliver growth and a strong economy. In this increasingly global economy, international partnerships are critical to progress against shared challenges. We will also continue to support the excellent work of multilateral organizations such as WIPO, through sharing best practices at meetings of the Advisory Committee on Enforcement and collaboration under WIPO's "Building respect for IP" strategic goal.

Achieving our ambitions won't be easy, and there is not a single device or clever trick to solve these problems. As our strategy lays out, we need to work closely with domestic and international partners, and develop and maintain an entire toolbox of interventions and remedies to deliver an effective enforcement regime.

IP offices of the 21st century

By **Maximiliano Santa Cruz S.**,
National Institute of Industrial Property
(INAPI), Chile



Photo: Courtesy of INAPI

Established in 2009, the Chilean National Institute of Industrial Property (INAPI) has become an integral part of Chile's national innovation system. INAPI's focus is on delivering efficient, effective and high-quality service and demonstrating the pivotal importance of IP to the country's economic, social and cultural development.

Intellectual property (IP) offices need to move with the times.

In the past, patent and trademark offices played a rather passive role, acting as registries for users seeking exclusive rights to protect their IP assets. But in today's dynamic, high-tech and highly competitive globalized world, IP offices must be prepared to actively promote learning, innovation and technology transfer in support of national economic, social and cultural development goals.

At the Chilean National Institute of Industrial Property (INAPI), the aspiration to be more than an office to register IP rights has become part of our DNA. Recognition that our responsibilities go far beyond the protection of distinctive signs and inventions is driving us to constantly redesign and upgrade existing services and procedures. It is also sharpening our focus on facilitating access to knowledge and technology, proposing solutions to specific challenges facing society and employing the best tools to foster economic and social development. This, too, is a fundamental part of our work.

Change at INAPI has been both dizzying and far-reaching. The Institute was only established in 2009, but in just seven years it has become an integral part of Chile's national innovation system and as one of 21 International Searching and Preliminary Examining Authorities (see box) under WIPO's Patent Cooperation Treaty (PCT) since 2014, INAPI is now also recognized as one of the world's major patent offices.

BUILDING A MODERN-DAY IP OFFICE

It was not an easy beginning. Chile went from running a small IP department in the Ministry of the Economy to establishing INAPI as a fully-fledged IP office with new premises and a staff of 180 employees and 105 external patent examiners – staff numbers almost doubled under the new structure.

One of the first tasks was to replace the obsolete IT platforms of the 1980s with IPAS (IP Office Administration System), a modern system developed by WIPO specifically for the management of IP rights. This enabled us to launch an online service platform in 2012. The platform now receives about 85 percent of all trademark and patent applications and allows for 100 percent online processing.



Photo: iStock.com/Ribofranz

INAPI has developed a range of tools to reinforce its work on knowledge dissemination and technology transfer.

Our ability to offer online services is essential for our users, not least because INAPI has just one office in the nation’s capital, Santiago, whereas the country spans some 4,000 kilometers. In future, people won’t even know where INAPI is located.

While establishing its structure, the Institute also had to plan how to perform its new duties. How was it going to inform public policy, take on international responsibilities and promote technology transfer? After careful reflection we set two key goals: to improve the Institute’s registration services, and to maintain an appropriate balance between the interests of rights owners and those of citizens in all our activities.

POSITIONING

Armed with these convictions, INAPI has become a well-respected public institution that is widely recognized for its outstanding performance. In 2016 INAPI was a winner of the Annual Institutional Excellence Award, signaling the Chilean government’s recognition that it is one of the three best public services (out of 181 candidates) in the country. Our reputation as a quality service provider has enabled us to become a PCT International Searching and Preliminary Examining Authority.

INAPI is also well respected for its work in the field of trademarks. In 2016 the International Trademark Association (INTA) selected INAPI along with the IP offices of the UK and Singapore to host a pioneering one-day event to explore what “The IP Office of the 21st Century” looks like.



While enhancing our registration and protection functions (the most private aspect of IP) has been a priority, we have also been focusing on disseminating knowledge and technology transfer. This public-interest dimension of the social contract that underpins the IP system often falls from view. To reinforce this aspect of our work, we have created a series of tools and training programs to promote use of the IP system and enable more people to enjoy the benefits of the system. These include:

- INAPI Proyecta (www.inapiproyecta.cl): a public platform for the dissemination of IP information and knowledge transfer featuring tools geared to learning about, using and transferring IP. Services include on-line courses, access to enhanced and fully searchable databases and diagnostic tools. The platform has a community of over 2,000 registered users.
- INAPI Conecta (www.inapiconecta.cl): a free public forum where creators and national institutions can pitch their IP-protected innovations to entities that are interested in using or exploiting them commercially.
- INAPI Analiza (www.inapi.cl): offers access to dynamic and fully downloadable national statistics covering the past 25 years on patents, utility models, trademarks and industrial designs.
- Buscador de Patentes de Dominio Público (www.dominiopublico.cl): a platform listing patents that have expired or lapsed, meaning that there are no IP restrictions on the exploitation of the technologies to which they relate.

But there is still more work to be done.

BREAKING NEW GROUND

Today, IP offices no longer deal only with traditional actors: patent or trademark agents, companies and inventors. In today's high-tech world, they must forge ties with new players. Instead of serving the few, they must reach out to civil society, universities, small and medium-sized enterprises, patients, farmers and artisans. The role of the IP office of the 21st century is not simply to administer IP laws and regulations and to periodically provide guidelines, but to take full advantage of the IP system's built-in flexibilities and adapt them to the specific needs of the national economy. A modern IP office must also be equipped to operate in an interconnected and complex international framework, and open to cooperate with its counterparts in other countries.

INAPI has gradually and systematically increased the quality of its services, and by simplifying and streamlining procedures has significantly reduced the time it takes to process the applications it receives. Given the importance of IP as a driver of national economic,

The Patent Cooperation Treaty and the role of International Searching Authorities

WIPO's Patent Cooperation Treaty (PCT) makes it possible to seek patent protection for an invention simultaneously in more than 150 countries by filing a single "international" patent application.

Virtually all PCT applications are subjected to a high-quality international search of relevant patent documents and other technical literature that might have an impact on the potential patentability of the invention. Searches are undertaken by one of more than 20 national and regional patent offices that act as PCT International Searching Authorities (ISAs). The results of the search are set out in a report which enables applicants to evaluate their chances of obtaining patents in the PCT contracting states, and assists the patent offices of those states in making their national and regional patenting decisions.

PCT applicants may also request one or more additional supplementary international searches to enlarge the linguistic and/or technical scope of the initial search. Supplementary searches can reduce the risk of new documents being discovered during the national or regional patent granting procedure ("the national phase").

In addition to the international search and optional supplementary searches, PCT applicants may also request an international preliminary examination by an International Preliminary Examining Authority (IPEA) – all the offices which act as ISAs also act as IPEAs. This procedure enables the applicants to amend their PCT applications (for example, in response to the international search and supplementary searches) and obtain a second patentability analysis on the as-amended application. The resulting report provides applicants with a stronger basis on which to evaluate their chances of obtaining patents before national and regional patent offices, and is likewise of assistance to national and regional patent offices in the national phase.

The list of PCT ISAs and IPEAs is available at: www.wipo.int/pct/en/access/isa_ipea_agreements.html.

social and cultural development, INAPI has also been leading an inclusive process to develop Chile's national intellectual property strategy, inviting inputs from a broad range of stakeholders including the public. This extensive process resulted in 60 recommendations covering all aspects of INAPI's operations, from institutional reforms to IP enforcement to public health and access to medicines.

DEVELOPING A CULTURE OF IP IN CHILE

Although Chile has a good system of IP enforcement in place, like many other national IP offices, INAPI does not have an explicit mandate to deal with IP enforcement. However, recognizing the benefits of improving coordination among national law enforcement authorities, and INAPI's responsibilities in developing a culture of IP in Chile, it was decided that IP enforcement should have a special mention in the strategy. In this context, INAPI, in collaboration with WIPO and other international partners will provide training on IP issues to all national enforcement authorities, including civil and criminal courts, the prosecutor's office, the customs agency, tax authorities, the competition agency and the police. INAPI will also set up and coordinate a public task force with industry participation to support national efforts to reinforce respect for IP rights. National enforcement authorities are also being encouraged to develop a unified information system that is available to the public. This will support policy development and greater transparency. INAPI is also exploring the feasibility of incorporating arbitration and mediation into its portfolio of services.

The national IP strategy has put IP at the center of Chile's national innovation policy, and will serve as an invaluable roadmap for the country to develop a genuine and deep-rooted culture of IP.

INAPI is also continuing to lobby the National Congress for the adoption of a new IP law that is better suited to the present-day realities of the information and knowledge society.

DRIVING CHANGE

Once IP offices improve their operating efficiency and service provision, their next big challenge is to develop the capacity to promote innovation, the dissemination of knowledge and technology transfer. This latter aspect relates primarily to promoting access to IP-related databases, managing IP information, ensuring that IP policy balances the often competing interests of creators and the general public, and promoting broader use of the public domain. This can be achieved by making use of the flexibilities that exist within national and international IP law and by creating linkages with legislation on competition, public health, the environment and education. Today, IP offices must be open, transparent, local, flexible, proactive and creative. They can no longer be satisfied with providing adequate service, but must focus on offering outstanding service that is efficient, effective and high quality.

At INAPI, we aspire to be more than just an office that adapts to the knowledge society, meets user needs and provides quality service. Our aim is drive change, and to demonstrate the pivotal importance of IP to the country's economic, social and cultural development, always putting the needs of citizens at the heart of our efforts. This is the role of an IP office in the 21st century.

Building IP awareness in Jordan – challenges and opportunities

By **Catherine Jewell**,
Communications Division,
WIPO



Photo: IPPD

“We need to join forces to tackle counterfeiting and piracy because this illegal trade causes far-reaching economic damage. It undermines legitimate businesses and the long-term interests of young people,” says Zain Al Awamleh, Director of the Industrial Property Protection Directorate of Jordan (above).

Over the past decade, Jordan has undergone major reforms in support of a more open and market-oriented economy. In the process it has overhauled its intellectual property (IP) laws and has made IP awareness a priority. **Zain Al Awamleh**, Director of the Industrial Property Protection Directorate of the Ministry of Trade and Supply of Jordan, shares her views on the challenges and opportunities associated with raising IP awareness in Jordan and the Arab region.

Why is building respect for IP a priority for Jordan?

In Jordan we say “changing laws takes time but changing a culture takes generations.” We want to embed the concept of IP in the country’s cultural development so that a generation of young people emerges that is full of enthusiasm about the huge potential that IP has to drive technological progress and economic development.

To what extent do you have problems with piracy and counterfeiting?

Thankfully, counterfeiting and piracy activities in Jordan are relatively well contained. Most IP infringement is in the area of copyright in the form of pirated CDs and DVDs. This is largely due to weaknesses in the national copyright infrastructure, enforcement of the laws and general lack of public awareness about IP and the consequences of IP theft. Many are unaware of the impact of their actions on creators. That said, the rate of software piracy is expected to drop in 2016 due to the intensified efforts of the National Library Department.

In many countries in the region, counterfeiting and piracy are taboo subjects, but we have broken that silence, which I believe is part of the solution.

What is the Directorate’s role?

The Industrial Property Protection Directorate oversees all matters relating to the registration and protection of IP rights in Jordan in line with existing legislation. IP rights – patents, trademarks, industrial designs and integrated circuits – protect creativity and human invention and ensure a favorable environment for investment in industry and other commercial activities. These rights play a critical role in supporting national economic development and wealth creation. The Directorate plays a major role in setting IP policy and

promoting innovation and creativity in Jordan. It also supervises the publication of patent information and provides access to IP databases. While IP enforcement is not part of the Directorate's remit, it is responsible for developing an IP culture and increasing IP awareness across the country.

In recent years the Directorate's operations have expanded and its reputation as a provider of quality services has grown. We are now starting to expand our service offering, placing greater emphasis on IP education and awareness activities in collaboration with private sector partners. The Directorate has enhanced the quality and range of information available on its website and is also supporting the establishment of Technology and Innovation Service Centers (TISCs) (see p. 34) in the region. It also runs a range of training programs, including for judges and other law enforcement agents, to boost understanding of IP within Jordan's business community and the judiciary. The opportunity to exchange ideas, experience and practice through these initiatives is helping to strengthen the IP system in Jordan and the region. The overriding aim in developing these activities is to showcase the Directorate as a provider of high-quality IP services and to reassure investors that Jordan is committed to a robust IP system.

We have made steady progress in creating the conditions for future generations to be able to harness their huge innovative and creative potential. There is still much to do but these really are very exciting times.

Can you tell us about some specific ways you have boosted IP awareness in Jordan?

Recognizing the importance of promoting IP awareness across the region, in 2013 the League of Arab States, with WIPO, produced a short animated cartoon called "Intellectual Property – Protection for You and for Me." This light-hearted animation highlights the importance of respecting IP rights and some of the negative consequences of not doing so.

When we viewed the cartoon – it was first screened at WIPO's Advisory Committee for Enforcement – we saw an opportunity to bring a new focus to our outreach activities by actually measuring the cartoon's impact in terms of changing perceptions about IP. In the past, such outreach was ad hoc and lacked any meaningful impact assessment. The methodology we used to assess the cartoon's impact had a strong focus on key performance indicators (KPIs) and enabled us to challenge the status quo and to start changing the mindset of policymakers. This was one of the key successes of the project.

We prepared a questionnaire targeting businesses, the public, young people and judges. This created an opportunity to introduce IP as well as WIPO and its work to the Jordanian public, and for people to talk freely about their concerns and needs. The feedback we received was invaluable and is helping to improve the quality of our promotional IP tools and activities. A staggering 90 percent of replies underlined the need for more IP awareness activities. In light of this, we are already planning various new IP outreach initiatives. For example, we are exploring ways to introduce IP into school and university curricula so that young people understand the huge potential that IP has to promote economic, social and cultural development. We believe the shortest way to solve a problem is to face it. And that is what we are doing.

The response has been very positive. The cartoon is now featured on Ministry's website and we are working with the Chamber of Commerce to develop a Jordanian version – using local actors and Jordanian slang – which we plan to release in 2017.

In addition to this, we are actively working, with WIPO's support, to encourage more active use of IP rights by Jordan's business community. The Directorate has also widely distributed to businesses, public authorities and schools, an Arabic version of a range of WIPO publications and guides on the practical use of IP rights.

The Directorate also actively participates in science fairs in schools to promote IP among school children.

What next?

Going forward, the focus is on generating tangible results and taking full advantage of the resources that are being made available to us. So we really need to be innovative and to think out of the box. That is the only way we are going to make a difference. To achieve that, we need to develop a concrete framework of activities with related KPIs. These enable us to remain faithful to our goals and to identify and tackle any unforeseen problems. This is a concept we want to encourage across all government agencies, and that is why we are working with WIPO to develop a national IP strategy. We will be one of the first countries in the region to have such a strategy, and building respect for IP will be an important part of it. This will help us to further strengthen Jordan's IP landscape.

There are many creative ways to improve the IP system and build respect for IP within the Arab region. The more opportunities we have to exchange ideas and experience with others, the greater the chances of bringing about positive and lasting change. Generally speaking, we need

In 2013, the League of Arab States and WIPO developed a cartoon to raise consumer awareness about the negative impact of commercial fraud and counterfeiting. The cartoon demonstrates the negative impact that counterfeiting and piracy can have on individuals and the economy.



Photos: WIPO / LAS



more relevant and compelling awareness materials – an Arab version of WIPO's *Case Book on the Enforcement of Intellectual Property Rights*, for example, would help to strengthen judicial decisions in the region – and information targeting specific audiences, especially policymakers. We absolutely need to bring policymakers on board with IP because they are the people who can lead the changes that we need to see.

What is your relationship with the League of Arab States and why is it important?

We have a good a relationship with the League of Arab States (LAS) and we support it in any way we can. LAS has a key role to play in encouraging greater cooperation among countries in the region. Building respect for IP is a shared responsibility. No one country can achieve it alone, but if we share information and combine efforts, we can make a difference. While everyone generally agrees on the importance of IP, there are many opinions about how to build respect for it. That is why events such as the regional workshop on building respect for IP organized by LAS in Cairo in 2015, which for the first time brought together the heads of national IP and copyright offices, right holders and law enforcement officials in Arab countries, are so important. I was privileged to be a keynote speaker at that event and to present Jordan's experience in building respect for IP, our work in evaluating the impact of the LAS cartoon and other IP awareness materials in Jordan.

Close cooperation among countries will enable us to strengthen our respective national IP systems. Another example of this is the work of the Agadir group – comprising Jordan, Egypt, Tunisia and Morocco – which has successfully established the ArabPat platform (www.arabpat.com) to facilitate the production, publication and exchange of patent documents by patent offices in the region. We are delighted that Saudi Arabia has recently joined the platform. Our aim is to bring more Arab countries on board. These types of practical approaches will make a huge difference to the IP landscape in the Arab region, and LAS has a leading role to play in bringing about such changes.

What challenges and opportunities are you facing?

Making politicians and policymakers aware of the importance of IP is one of our biggest challenges. We are also seeking greater financial independence so that the Directorate becomes a self-sustaining, independent IP

office. This would enable us to be more flexible, responsive and efficient in our operations. Recruiting and retaining highly qualified IP talent with practical experience is also a challenge, given the attractive salaries offered by the private sector.

IP is a vast and fast-moving arena and it can be a challenge to keep up with the latest developments in the field. Language is another challenge. IP information is often not available in Arabic. If we are to succeed in encouraging greater collaboration across the region and a better understanding of IP, we need more IP-related materials available in a language that is understood by the general public. Many IP officials in the region struggle with English (in which most IP materials are available), and even if they understand what is being said, they are often unable to communicate effectively in that language. These are the kinds of challenges we face, but when it comes to opportunities – the sky is the limit.

What is your key message with respect to building respect for IP?

We need to join forces to tackle counterfeiting and piracy because this illegal trade causes far-reaching economic damage. It undermines legitimate businesses and the long-term interests of young people. Those who trade in fake goods are abusing the IP rights of inventors and creators and working against the public good. But if IP rights are respected then we all stand to benefit.

I encourage businesses in Jordan to recognize the value of their IP assets and protect them more actively. By working together with the business community, we will be more effective in increasing understanding among local companies about how IP can create value and support business development.

It is also important that we make the public aware of the negative consequences and dangers of buying fake products. These products can maim and even kill. All too often consumers are lured by a good deal and disregard the quality of the product they are buying. We need to encourage consumers to focus on the quality of the goods they buy, not just the price, and to help them understand that buying counterfeit or pirated products can have far-reaching consequences – it is not a victimless crime.

While we have made some progress, there is still a great need for more IP awareness, capacity-building and legislative advice in the region.

Thinking out of the box to change consumer behavior

By **Amanda Lotheringen**, Senior Manager,
Copyright and IP Enforcement, Companies and
Intellectual Property Commission (CIPC),
South Africa

The importance of intellectual property (IP) rights for any country's social, economic and cultural development cannot be overstated. IP protection is critical to foster innovation and stimulate economic growth and development. Without it, businesses and individuals cannot reap the full benefits of their inventions and have little incentive to invest in further research and development. Similarly, without IP protection artists are not fairly compensated for their works and so are unable to invest in new creations, harming cultural vitality.

IN SEARCH OF BALANCE

The challenges facing national policymakers today are daunting. How can their country be more competitive in the global economy? How can they improve national innovation performance? Another particularly tricky area is how to tackle the illegal trade in counterfeit goods and piracy and enforce IP rights effectively. While counterfeiting and piracy are global phenomena that require global action, developing countries like South Africa have to take the challenges and risks associated with this illegal trade seriously. And we have to safeguard the IP rights of artists and inventors because innovation and creativity are the lifeblood of a vibrant and sustainable society.

A recent assessment of the effectiveness of South Africa's performance in tackling counterfeiting and piracy revealed that established IP enforcement, education and awareness campaigns were not delivering the results that the Companies and Intellectual Property Commission (CIPC) – a statutory body responsible for, among other things, IP education and awareness in South Africa – was looking for. These findings underlined the need for a change in game plan if the country's IP law enforcement activities are to have any impact in today's high-tech world.

At the CIPC, we realized we needed to think out of the box and come up with alternative approaches to complement conventional IP enforcement activities. To bring about lasting behavioral change, we needed an approach that balanced awareness about the benefits that can flow from IP rights and a strong regulation and protection regime (and the harm caused by buying and consuming counterfeit and pirated goods) with targeted enforcement measures, backed up with criminal sanctions against unscrupulous traders in counterfeit goods.

Satisfying these two needs is a delicate balancing act. But through strong collaboration, regular exchanges of information and best practices between all those engaged in the IP enforcement, and a multi-pronged strategy, we are making progress.

“A tree that reaches past your embrace grows from one small seed.”

(Tao Te Ching 64)

COLLABORATION IS THE KEY TO SUCCESS

Fostering effective collaboration between stakeholders is the key to developing and implementing effective IP enforcement policies. But it is a time-consuming and continuing exercise. Relationships that are built must also be maintained.

Since 2006, cooperation between government departments in South Africa has been ensured through the Intergovernmental Enforcement Committee (IGEC) which meets every quarter. The Committee also serves as a platform for right owners to voice their enforcement concerns. But while these arrangements guaranteed a certain level of collaboration, it needed to be further strengthened. This involved identifying joint objectives and outcomes and implementing joint initiatives to raise awareness about IP rights and responsibilities, within a structure with a single dedicated budget. This, we believed, was the only way to achieve the required level of coherence and impact. Developing and systematically communicating a single strong message can be very effective in changing behavior. This new approach involved a shift away from traditional anti-piracy campaigns toward a new concept which we called “Be Your Own Buy Your Own” (BYO²).

FROM WILDLIFE CONSERVATION TO THE “CONSERVATION OF IDEAS”

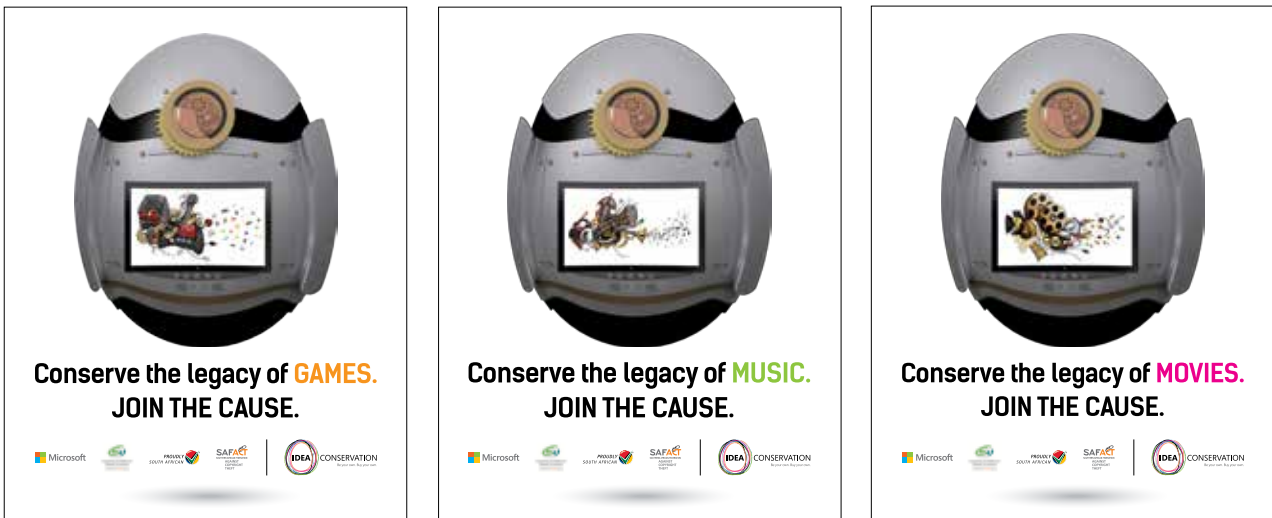
Trade in counterfeit goods and piracy is rife and a growing global problem, but efforts to combat it are often constrained by limited financial and human resources. This is especially true in South Africa. That is why the BYO² campaign linked in to the positive spin surrounding “the Conservation of Ideas” campaign (a springboard for various targeted IP awareness campaigns), which itself drew inspiration from the highly successful and well-known Big 5 (lion, rhino, leopard, buffalo and elephant) animal conservation campaign.

Just like the Big 5 animal conservation campaign, the Conservation of Ideas and BYO² campaigns identified the five major areas of IP – music, film, software, gaming and publishing – facing high levels of piracy. These sectors rely very heavily on copyright and trademark protection to create value, and yet levels of public awareness about the negative impact of piracy on these activities are very low. By introducing parallels between the need to protect the natural environment and the need to safeguard the IP rights of inventors and creators, we began speaking a language that our target audience, the general public, could easily understand.

A PUBLIC-PRIVATE PARTNERSHIP IS BORN

The BYO² campaign was effectively a public-private partnership involving CIPC plus Proudly South Africa, the South African Federation Against Copyright Theft (SAFACT) and Microsoft, which is experiencing major problems with piracy of its software and electronic games. Each “partner” has significant scope to promote and protect copyright-protected creations in the creative industries that are hardest hit by piracy.

CIPC also linked up with two of South Africa’s leading universities, Stellenbosch University in the Western Cape and the University of Pretoria in Gauteng. Universities are excellent partners when it comes to promoting respect for IP. Their students are key targets of IP awareness campaigns that seek to build respect for IP in a community with easy access to a free high-speed Internet connection.



Photos: Courtesy of CIPIC

Following an assessment of South Africa's performance in tackling counterfeiting and piracy, the CIPIC realized it needed to come up with an alternative approach to bring about lasting behavioral change. It drew inspiration from the successful Big 5 animal conservation campaign to develop its "Conservation of Ideas" initiative, which served as a springboard for various other targeted IP awareness campaigns.

The joint effort of all the partners has been invaluable in adding momentum to a balanced IP enforcement approach that drives IP awareness and respect for IP rights through targeted enforcement actions.

INSPIRING CHANGE

The BYO² campaign conveys a positive message about creativity, a universal resource that can be fostered by people from all walks of life for personal growth and commercial benefit. We believed this was the best approach for a developing country like South Africa with its wealth of creative resources. The campaign introduces a new innovative and "off-beat" approach to building greater respect for IP in South Africa, and it is working.

The campaign is enabling us to create the space for people to get excited about IP and to celebrate their own creativity through competitions and exhibitions of local creative talent. It is built around positive IP messages that reward good behavior and help to change consumers' views about fake products by appealing to their aspirations and encouraging them to do the right thing.

Messages, such as "Do your own thing," "Be an original," "Have an identity," "Be the best you can," "Be honest" and "Respect your own identity" are directly relevant to stimulating innovation, creating new things, supporting originality and building respect for IP. Reminding people that ideas are the cornerstones of creativity and can generate significant social – and economic – benefits goes a long way in encouraging positive behavior and discouraging piracy.

In keeping with CIPIC's commitment to a balanced approach to building respect for IP, progress is also being made in tracking and tackling IP infringement on the ground. Combined enforcement operations are actively focusing on both physical and online sales. The recent establishment of a Cyber Crime Action Group that works very closely with Internet service providers to serve takedown notices on pirate sites is already making an impact. Work to further strengthen collaboration among those engaged in the enforcement of IP legislation is underway, and other initiatives to identify strategic priorities to produce the desired outcomes are in the pipeline.

Photo: Courtesy of CIPC



In a bid to strengthen South Africa's performance in tackling counterfeiting and piracy, national authorities are implementing a multi-pronged strategy that complements conventional IP enforcement activities with compelling IP awareness campaigns that focus on creativity as a universal resource.

THE FUTURE

Any attempt to reduce the size of the market for counterfeit and pirated goods must balance effective enforcement with awareness campaigns that encourage changes in consumer behavior to dampen demand for such goods.

As CIPC moves forward with its IP enforcement activities, data gathering to assess the scale and socio-economic impact of counterfeiting and piracy in South Africa is a priority. Work has already started within the CIPC's Policy Analyst Department in Creative Industries to develop methodologies for that purpose.

Success in achieving an all-important balance in initiatives to build respect for IP lies in the partnerships that are established, the teams that are formed and the cooperation that flows from them. At the end of the day, these efforts are all focused on supporting local innovation and creativity, creating opportunities for South Africans and expanding the nation's economy.

Tackling the illegal trade in sporting goods

By Dr. **Jochen M. Schaefer**,
Legal Counsel, World Federation of the
Sporting Goods Industry (WFSGI)

This year's top-tier sporting events, from the European football championships to the 2016 Rio Summer Olympic Games, have once again put the world's leading sporting goods brands in the spotlight. This is great news for sporting goods manufacturers because such high visibility will translate into significant increases in turnover and sales both in stores and online.

But while online platforms are very effective vehicles for legitimate businesses to boost sales and reach new customers, they also make it easier for counterfeiters to peddle an expanding range of fake goods. That is the shadier side of the story.

The illegal trading of fake goods is on the rise. A 2016 study by the OECD and the European Union Intellectual Property Office (EUIPO) entitled *Trade in Counterfeit and Pirated Goods – Mapping the Economic Impact* highlights the “significant economic and social losses” incurred by “right holders, governments and the formal economy” as a result of counterfeiting.

The study estimates that the international trade in counterfeit products represented up to 2.5 percent of world trade, or USD 461 billion, in 2013, while counterfeit and pirated products accounted for up to 5 percent of imports in to the EU – that's EUR 85 billion (USD 116 billion) worth. A significant proportion of this trade relates to the sale of fake sporting goods and lifestyle products. While it is extremely difficult to quantify the exact scale of the trade in counterfeit goods, its sheer volume in both the online and offline worlds suggest that it is the work of highly sophisticated and organized criminals. Lured by high profits and minimal penalties if caught, at least in many parts of the world, counterfeiters and pirates do not care about the impact of their activities on consumers or legitimate businesses.

Within the sporting goods sector, as in other areas of industry, the relentless flow of counterfeit products onto the market is undermining legitimate businesses, damaging brand values and infringing intellectual property (IP) rights. Iconic brands like Adidas, Nike and Under Armour, as well as smaller, more specialized manufacturers like the producers of bicycles and bicycle components, are equally affected.

In an endeavor to tackle this problem head-on, in 2013 the World Federation of the Sporting Goods Industry (WFSGI) joined ranks with Convey, an Italian Internet brand protection company, to develop a mechanism to curb brand abuse and the sale of counterfeit sporting goods products online.

Within the sporting goods sector, as in other areas of industry, the relentless flow of counterfeit products onto the market is undermining legitimate businesses, damaging brand values and infringing intellectual property (IP) rights.



Photo: iStock.com/wundervisuals

About WFSGI

The World Federation of the Sporting Goods Industry (WFSGI) is the world authoritative body for the sports industry. It is officially recognized by the International Olympic Committee (IOC) as the industry representative within the Olympic Family.

The WFSGI is an independent non-profit association formed by leading sports and sports-inspired leisure brands (including bicycle and bicycle component producers and sellers), manufacturers, suppliers, retailers, national/regional sporting goods industry federations and sporting goods industry related businesses.





Photo: iStock.com/Razvan

Counterfeit sporting goods pose serious threats to consumer health and safety. In the cycling sector, for example, the use of substandard, fake components can seriously injure or kill cyclists.

The main aim of the project is to **efficiently and collectively** combat illegal activities on multiple online platforms. This is done by:

- identifying and analyzing existing online threats for brands covering domain name abuses and the marketing and sale of counterfeit products on third-party-operated online platforms;
- removing counterfeit offerings from major e-commerce platforms and online marketplaces and permanently banishing the offending operators and sellers;
- shutting down illicit websites and regaining control of abusive domain names used and registered by third-party operators; and
- safeguarding the trademarks and domain names of WFSGI member companies, including new generic top-level domains.

Under the initiative, four types of services are available under preferential terms to WFSGI members. These include:

- preliminary screening of the actual online situation facing the WFSGI member concerned;
- measures to remove counterfeit offerings from the most prominent and dangerous online marketplaces;
- steps to shut down abusive websites and to regain control of hijacked or otherwise illegally used domain names;
- steps to safeguard new domain names through the registration of trademarks owned by WFSGI members in the Trademark Clearinghouse of the Internet Corporation for Assigned Names and Numbers (ICANN).

The project is attracting wide interest among WFSGI's membership, which includes over 180 sporting goods manufacturers, in particular those operating in the bicycle sector. There are a number of reasons for this, as follows.

Health and safety. Counterfeit sporting goods pose serious threats to consumer health and safety. In the cycling sector, for example, the use of substandard, fake components can seriously injure or kill cyclists. All too often, unsuspecting customers looking for a “good deal” end up buying inferior, fake parts – bicycle frames, handlebars, wheels, saddles – that readily show material fatigue when subjected to standard quality control protocols. If you buy a fake bicycle component that fails, the consequences can be catastrophic.

Similarly, consumers tempted into buying fake sports-wear online often find they have acquired a low-quality product that is either tainted with toxic chemicals or made with highly flammable materials, exposing them to serious health risks.

Brands share a common enemy. When it comes to tackling counterfeit sporting goods, brands are not competing with each other. As a general rule, illegal operators – sophisticated, professionally run organizations – target multiple brands. These large-scale criminal operations have reverse engineering capabilities and use computer-aided design (CAD) software, automated manufacturing processes and complex logistics to produce and ship their fake products. And they use standard web pages and dedicated apps to lure unsuspecting consumers into buying their “irresistible products”, which are extremely difficult to distinguish from the genuine article. In tackling

this problem, all brands face a common enemy, and by working together and with the WFSGI, the global industry can speak with one powerful voice.

Online counterfeiting is indiscriminate and widespread. And it affects both large sporting goods manufacturers and small and medium-sized businesses in all geographic regions of the world. Counterfeiting undermines the operations of legitimate businesses and damages their hard-won brand value, reputation and goodwill as well as their IP rights.

Sporting goods manufacturers need modern tools to tackle a modern-day challenge. The only hope of curbing this illegal trade is to use technological tools that are fit for the task. Traditional methods, including the use of “cease and desist” letters, continue to have a place in the anti-counterfeiting armory, but proactive engagement with Internet Service Providers (ISPs) promises to yield better dividends. The online world is dynamic, and counterfeiters are adept at finding ways to hide or outsmart the system when they come under attack. That is why it is important to engage with ISPs and to use highly sophisticated big data-mining technology with image-detecting capabilities to systematically trawl the web to detect and curb these activities. While ISPs *per se* are not legally responsible for content posted on their platforms, in certain jurisdictions – including China (Tort Law of the People’s Republic of China (Article 36)), the European Union (Directive 2000/31/EC, Article 46) and the United States (17 US Code § 512) – once an ISP has been notified of an infringement it is required to take down the offending content.

RESULTS

The tools that WFSGI and Convey are making available to sporting goods manufacturers are already yielding concrete results. Upon notification of an infringement – in relation to any type of IP right – Convey acts to take down the infringing websites within days.

Since the project’s launch in 2013, more than 40 prominent brand owners, including premier European football clubs and many bicycle manufacturers, have started using these services. In the bicycle sector alone, more than 160,000 counterfeit listings with a commercial value of more than EUR 8.6 million had been directly deleted as at March 15, 2016.

The success of the initiative is generating a lot of interest, and it promises to serve as an effective model for other industrial sectors to adopt in their anti-counterfeiting efforts.

While complete eradication of the illegal trade in counterfeit goods is unrealistic, the WFSGI and its members have demonstrated that modern data-mining technologies can be an effective weapon in tackling it. The next step is to develop a sophisticated industry-wide authentication system. Our hope is that this will provide legitimate businesses with a higher degree of brand protection and of course make life even more difficult for counterfeiters.

Counterfeiting is a complex and sophisticated global operation that requires a multi-pronged strategy underpinned by the use of modern technologies. This is our best hope of limiting the damage caused by this illegal trade.

A closer look at specialized intellectual property courts*

by Mr. Jacques de Werra, Vice-Rector and
Professor of Intellectual Property and
Contract Law, University of Geneva

Amid a global trend to specialize or centralize the handling of certain types of IP disputes, there is no clear answer as to whether it is advantageous or necessary to establish specialized IP courts. Any plan to create specialized IP courts requires careful analyses of the prevailing situation in the country concerned.

*This article is derived from *Specialised Intellectual Property Court – Issues and Challenges* by J. de Werra et al., Second Issue, Global Perspectives for the Intellectual Property System, CEIPI ICTSD, Issue Number 2, 2016, available at: www.ictsd.org/themes/innovation-and-ip/research/specialised-intellectual-property-courts-issues-and-challenges. To reuse or adapt this article, please contact the author directly at Jacques.DeWerra@unige.ch

While there is no international obligation to do so, there is a global trend to specialize or centralize the handling of certain types of intellectual property (IP) disputes. The question whether it is advantageous or necessary to establish specialized IP courts, however, is a difficult one to answer as there are both advantages and disadvantages associated with them and they are certainly not recommended in all circumstances. Any plan to create specialized IP courts requires careful analysis of the prevailing situation in the country concerned.

WHAT SPECIALIZED IP COURTS CAN DO

A specialized IP court is an independent public judicial body that can operate at national or regional levels to adjudicate certain types of disputes relating to IP rights, but may also adjudicate other types of disputes. Although IP disputes are often associated with the enforcement of IP rights against piracy and counterfeiting activities (especially in the areas of copyright and trademarks), the reality of IP disputes is far more complex. This results from, for example, differences in the types of IP rights and the legal regimes on which they are based, the diversity of legal issues that can arise as well as the different types of legal proceedings available to resolve them, namely, civil, criminal and administrative proceedings.

Although there is a marked global trend toward specialization, the types of specialized courts that are emerging are by no means uniform. Some only have jurisdiction over certain types of IP disputes, such as patent disputes, while others are restricted to particular types of legal issues, such as the validity of IP rights, or may only consider civil disputes. Some act as trial courts while others act as appellate bodies with the power to review cases on appeal and to reverse the decisions of lower courts.

ADVANTAGES OF SPECIALIZED IP COURTS

Specialized IP courts are generally believed to improve the quality of justice available to IP right holders. The court's expertise means that disputes can be handled coherently on the basis of past experience. This is particularly important for IP disputes because courts are often requested to render decisions very quickly on applications for provisional measures in order to prevent or stop an infringement of IP rights.

Specialized IP courts are better equipped to keep pace with and adapt to dynamic developments in IP law. They allow for timely and cost-effective handling of proceedings and can improve the consistency of case law. They can also help to eliminate or reduce any risk of forum shopping – whereby IP owners, given the choice of court, choose the one that will favor their interests – by centralizing IP disputes before the specialized IP courts, and can further foster the development of special procedural rules that are tailored to IP disputes.

DISADVANTAGES OF SPECIALIZED IP COURTS

The cost of establishing and operating specialized IP courts can be their major disadvantage, especially for countries with limited resources and a low IP caseload. Attracting the expertise needed for the court to be effective can be expensive and may require increasing judicial wages to draw potential candidates from the private sector.

Specialized IP courts may also have a negative impact from the perspective of access to justice as litigants may be forced to bear the costs of pleading before a court which may not be easy for them to get to.

These courts are also often considered to be less independent than general courts and more vulnerable to political or economic influences. This may arise either when appointing judges or as a consequence of more informal interactions between parties and their counsel and judges.

Tunnel vision is yet another risk. Some believe that specialized IP courts may neglect the broader legal and policy framework that often surrounds IP disputes. Centralization may also inhibit the exchange of legal ideas and lead to perpetuation of errors. Problems with defining boundaries between the jurisdictional power of a specialized IP court and that of a general court also pose a potential risk.

POLICY CHOICES

The diversity of legal systems and regimes around the world means there is no single method for establishing an efficient IP court system that promotes innovation and social welfare. There is also no clear evidence that specialized IP courts are more effective than non-specialized courts in promoting innovation in all circumstances. But what is clear is that a sufficient level of experience and expertise among courts and judges can significantly improve the quality of justice surrounding IP disputes. This is particularly important because many IP disputes start with an application for preliminary injunctive relief (made by IP owners) on which the court is expected to decide in quick time. The court's expertise in handling IP disputes can also result in more efficient case management because judges are better placed to direct and guide attorneys. Experienced judges may also issue non-binding preliminary opinions which may promote settlement between the parties.

IS A SPECIALIZED IP COURT REALLY NECESSARY?

Before working out how to establish a specialized IP court, policymakers need to carefully weigh up the merits of doing so. If they decide that establishing such a court is the best option, then they need to carefully assess the scope of the court's jurisdiction. Will it be limited to specific types of IP disputes – such courts may be more justifiable in some areas of IP law, such as patent law – or will it extend to all types of disputes? Will the IP court have the jurisdiction to hear civil IP disputes only or will it also hear criminal disputes? It may be enough to simply centralize all IP disputes to ensure coherent development of IP law without establishing a specialized court. In any case, the process of establishing a specialized IP court must be distinct from the creation of specific rules applying to IP disputes, because the adoption and application of those rules do not necessarily require the creation of a specialized IP court.

BEST PRACTICES

The experiences of countries that have established specialized IP courts has given rise to a number of best practices which can ensure that these courts operate effectively. These include:

- Appointing judges with a representative level of expertise in the relevant areas.
- Providing judges with continuing education and training opportunities to allow them to keep abreast of the rapid evolution of IP, IP litigation and other important legal concepts and developments beyond IP law. Such training can also help control the risk of specialized IP courts developing tunnel vision.
- Establishing a system where the judgments of specialized IP courts are appealable to non-specialized courts to ensure the decisions of specialized IP courts are in line with general legal principles.

TO BE OR NOT TO BE?

Evaluating the desirability of establishing a specialized IP court in any given jurisdiction requires a transparent and objective assessment of many factors that go well beyond IP including the prevailing economic, legal and social circumstances of the country in question.

Contrary to common belief, there is no clear evidence that the existence of specialized IP courts generates benefits for IP owners, nor that they automatically increase levels of IP protection or generate increased foreign direct investment.

The goal of creating specialized IP courts must be to ensure the availability of an efficient and equitable dispute resolution mechanism that is conducted by expert judges for the benefit of all stakeholders – IP owners, users of goods and services, and society as a whole. The decision to establish a specialized IP court cannot be based solely on the need to fight IP piracy and counterfeiting activities. In general, disputes arising from these illegal activities do not require the services or expertise of a specialized IP court.

An alternative and more appropriate option, especially for developing countries, may be to focus on developing the IP expertise of non-specialized courts, by creating specialist IP benches within regular courts. Regular courts may also call on a third party institution with IP expertise, such as a national IP office, to express its view on a particular issue (the validity of a patent, for example) in a dispute. Developing expertise in IP dispute settlement therefore does not necessarily require the establishment of a specialized IP courts.

IP expertise and knowledge may also be boosted by fostering opportunities to improve the transparency of judicial processes and by allowing the participation of third parties. This can be achieved, for example, by allowing “friends of the court (*amicus curiae*)” briefs in IP litigation cases, and by publishing the decisions rendered in IP cases in online databases. There is also much to be gained from encouraging international exchanges between judges and courts dealing with IP cases. Building and sharing expertise in this way creates opportunities for mutually enriching and stimulating exchanges. While IP issues remain largely governed by local rules, the global nature of many of them means that fostering such a dialogue is essential.

ADDITIONAL OPPORTUNITIES TO IMPROVE IP DISPUTE RESOLUTION

A careful analysis of the role and responsibilities of all actors within the national IP ecosystem can help identify additional opportunities to improve IP dispute resolution. Such an exercise necessarily involves identifying the processes by which IP rights are granted in the jurisdiction in question, bearing in mind that the need for a specialized IP court may be greater if IP rights are granted without a complete examination of their validity when they are registered. An assessment of the entire IP ecosystem is critical because the efficiency of IP dispute resolution mechanisms in any jurisdiction depends not only on the judiciary, but also on other players, especially the lawyers who plead before the courts.

An efficient IP dispute resolution ecosystem should also seek to eliminate vexatious IP infringement actions against innocent third parties. Procedural tools can be developed to help ensure that courts are not unnecessarily burdened with meritless claims and remain available to litigants entangled in non-frivolous IP disputes.

In sum, the balance of competing interests, which is at the core of the substantive IP system, should also be reflected in the mechanisms by which IP disputes are resolved. This will ensure that all interests are considered in an equitable manner. It follows that any decision to establish a specialized IP court should only be taken after careful analysis of the prevailing situation in a given jurisdiction.

WIPO alternative dispute resolution – saving time and money in IP disputes

By Heike Wollgast,
WIPO Arbitration and Mediation Center

The use of alternative dispute resolution (ADR) procedures – mediation, arbitration and expert determination – to settle disputes between private parties outside the courts has a long tradition in legal systems around the world. While traditionally ADR options have not been widely used to settle intellectual property (IP) and related disputes, such procedures are becoming increasingly popular.

IP and related disputes have distinctive characteristics. With the globalization of trade and the increasingly international creation and exploitation of IP, these disputes often span multiple jurisdictions and involve highly technical matters, complex laws and sensitive information. In these circumstances, parties often look for flexible dispute resolution processes that can be customized to their needs and that enable them to control the time and cost of proceedings. The 2013 *WIPO International Survey on Dispute Resolution in Technology Transactions* revealed that the ability to limit the time and cost of proceedings were top priorities when selecting dispute resolution options (see Figure 1).

MAIN FEATURES OF ADR

Which dispute resolution option (see box) parties select will depend on the circumstances of the case as well as their needs and expectations. While there is no general response as to whether ADR processes are preferable to conventional court-based IP litigation, each type of ADR has features that, if well managed, can translate into substantial time and cost savings, making them a more affordable and accessible avenue for resolving IP-related commercial disputes (see Figure 2).

These features include:

- *Single procedure.* Parties can use ADR to settle disputes involving several jurisdictions in a single forum, thereby avoiding the expense and complexity of multi-jurisdictional litigation and the risk of inconsistent results.
- *Expertise.* The parties can appoint arbitrators, mediators or experts (known as neutrals) with specific knowledge of and experience in the relevant legal, technical or business area. This helps achieve high-quality outcomes while limiting the time and cost of the proceedings as compared to court proceedings.
- *Party autonomy.* Unlike court litigation, the private nature of ADR means that parties can exercise greater control over the way their dispute is resolved. The parties themselves can select the most suitable neutral to facilitate the settlement of their dispute. Parties may also choose

ADR options

The most commonly available ADR processes include:

Mediation. An informal consensual process in which a neutral intermediary, the mediator, assists the parties in reaching a settlement based on the parties' interests. While the mediator cannot impose a settlement, any settlement agreement has force of contract. Mediation does not preclude any subsequent court or arbitration options.

Arbitration. A consensual procedure in which the parties submit their dispute to one or more arbitrators of their choice for a binding and final decision (an "award") based on the respective rights and obligations of the parties and enforceable under arbitral law. Arbitration normally forecloses any subsequent court options.

Expedited Arbitration. A procedure that normally involves a sole arbitrator and which is carried out in a shorter time frame and at reduced cost. Expedited arbitration is especially suited to less complex cases involving lower disputed amounts and where speedy resolution is needed.

Expert determination. A consensual procedure in which the parties submit a specific matter, such as a technical question, to one or more experts who make a determination on the matter. The parties can agree for the determination to be legally binding.

the place and language of the proceedings and the applicable law.

- **Neutrality.** ADR can be neutral to the law and language of the parties, preventing any home court advantage that one of the parties may enjoy in court-based litigation.
- **Cost and time efficiency.** Cost-effective and speedy dispute resolution is essential in IP and related commercial disputes. Compared to multi-jurisdictional proceedings, ADR methods generate significant cost savings and entail short timelines which the parties can further adapt. Specific fast-track methods, such as expedited arbitration, are also available.
- **Confidentiality.** ADR proceedings and outcomes are confidential, allowing the parties to sidestep concerns about the dispute's public impact. This is particularly relevant where commercial reputations and trade secrets are involved.
- **Preserving long-term relationships.** By using ADR mechanisms, in particular mediation, business interests can be taken into account and viable long-term solutions can be developed in a less confrontational forum, allowing parties to preserve business relationships.
- **Finality and international enforceability of arbitral awards.** When parties refer their disputes to arbitration, they benefit from the finality of arbitration awards. Unlike court decisions, arbitral awards are normally final and binding. They are not subject to appeal. The 1958 United Nations Convention on the Recognition and Enforcement of Foreign Arbitral Awards, which governs such settlements, generally puts arbitral awards on a par with domestic court judgments. This makes the cross-border enforcement of awards much easier.

AD-HOC OR INSTITUTIONAL PROCEDURE?

While parties themselves can handle ADR proceedings directly with the neutral, such *ad hoc* procedures require considerable ADR experience and effective cooperation between all parties to avoid delays and unnecessary costs. In an institutional ADR proceeding, the selected institution provides a tested framework for initiating and conducting the procedure, case management services, and access to qualified arbitrators and mediators. Administrative fees do vary and may be a factor in selecting an institution.

THE WIPO ARBITRATION AND MEDIATION CENTER

With offices in Geneva, Switzerland, and in Singapore, the WIPO Arbitration and Mediation Center (WIPO Center) is a neutral, international and non-profit dispute resolution provider specializing in IP and related commercial disputes. Developed by leading experts in cross-border dispute settlement, the procedures it offers are

recognized as particularly appropriate for technology and other disputes involving IP. The WIPO Center maintains a database of over 1,500 independent and neutral WIPO mediators, arbitrators and experts skilled in IP and ADR from more than 70 countries.

The WIPO Center places emphasis on containing the time and cost of proceedings conducted under WIPO Rules. It assists parties in selecting and appointing a suitable neutral; offers active case management, including guidance on the application of relevant procedural rules; provides access to its Electronic Case Facility (WIPO ECAF); and, where proceedings take place at WIPO in Geneva, provides meeting and hearing facilities free of charge. The WIPO Center also offers a 25 percent fee reduction to parties that use WIPO's global services (the PCT (patents), Hague (designs) or Madrid (trademarks) Systems). A typical WIPO Mediation takes 4.5 months, but may be completed more rapidly at the request of the parties, for instance to ensure compliance with timelines in court referrals.

WIPO ADR procedures seek to create positive opportunities for party settlement. To date, 70 percent of the mediation procedures administered by the WIPO Center have been settled. And even for arbitration, which can be more complex, around 37 percent of WIPO cases settle before any tribunal award is issued.

The cases handled by the WIPO Center cover a wide range of IP-related subject matter, including:

- patents (such cases make up more than 30 percent of the WIPO Center's caseload)
- know-how and software licenses
- franchising and distribution agreements
- trademark coexistence agreements
- distribution contracts
- joint venture agreements
- research and development contracts
- technology transfer agreements
- technology-sensitive employment contracts
- mergers and acquisitions involving IP assets
- sports marketing agreements
- publishing and music and film contracts.

Over 70 percent of WIPO cases (and over 90 percent of patent-related WIPO cases) are international in scope, with amounts in dispute ranging from USD 15,000 to USD 1 billion (see Figure 3).

The WIPO Center's services are available to anyone; there are no restrictions on who may use them. They have been used by multinational corporations, small and medium-sized enterprises, R&D centers, Technology and Innovation Support Centers (TISCs) (see box) and universities from more than 60 jurisdictions around the world.

SUBMISSION TO WIPO ADR PROCEDURES

Referral to WIPO dispute resolution procedures is consensual. To facilitate party agreement and avoid any ambiguity that might later complicate or delay the dispute resolution process, the WIPO Center provides recommended contract clauses and submission agreements for use by parties when establishing business contracts. It also offers access to an online Clause Generator that proposes additional contractual elements based on WIPO case experience.

The WIPO Center is regularly contacted in relation to disputes where one party wishes to submit a dispute to mediation, but no mediation agreement exists between the parties, for example in infringement disputes or in cases pending before the courts. To facilitate submission of such disputes to WIPO Mediation, a party may submit a unilateral Request for Mediation to the WIPO Center under new WIPO Mediation Rules effective since January 1, 2016. The WIPO Center may then assist the parties or, upon request, may appoint an external neutral to provide the required assistance. This process has been used successfully by parties in a number of cases.

TAILORED WIPO ADR PROCESSES FOR EXTRA TIME- AND COST-EFFICIENCY

The WIPO Center's experience shows that specific aspects of IP transactions can benefit from targeted adaptation of the standard ADR framework, for example in relation to rules, neutrals, fees and clauses. The WIPO Center has therefore developed a number of tailored ADR schemes, including in the areas of information and communication technology, R&D, procedures before national IP offices, film and media, and art and cultural heritage.

At the request of certain IP offices the WIPO Center provides dispute resolution advice and case administration services to a growing number of parties to resolve disputes in relation to pending applications or granted rights. Such collaboration is ongoing with the national IP offices of Brazil, Colombia, Indonesia, Mexico, the Philippines, the Republic of Korea and Singapore. Since January 2016, the WIPO Center has also been listed as an ADR service provider for proceedings before the Trademark Trial and Appeal Board (TTAB) and the Patent Trial and Appeal Board (PTAB) of the United States Patent and Trademark Office. The WIPO Center's *Guide on Alternative Dispute Resolution Options for Intellectual Property Offices and Courts* (www.wipo.int/export/sites/www/amc/en/docs/adrguidejuly2015.pdf) provides a detailed overview of this experience.

The WIPO Center also makes available model submission agreements that may be tailored by parties to address standards-related disputes involving telecom patents in multiple jurisdictions. Developed in consultation with patent law, standardization and arbitration experts from a number of jurisdictions, the WIPO model submission agreements are designed to enable cost- and time-effective determination of fair, reasonable and non-discriminatory (FRAND) licensing terms (see box). In this regard, the WIPO Center collaborates with standardization bodies such as the European Telecommunication Standards Institute (ETSI) and the Institute of Electrical and Electronics Engineers (IEEE).

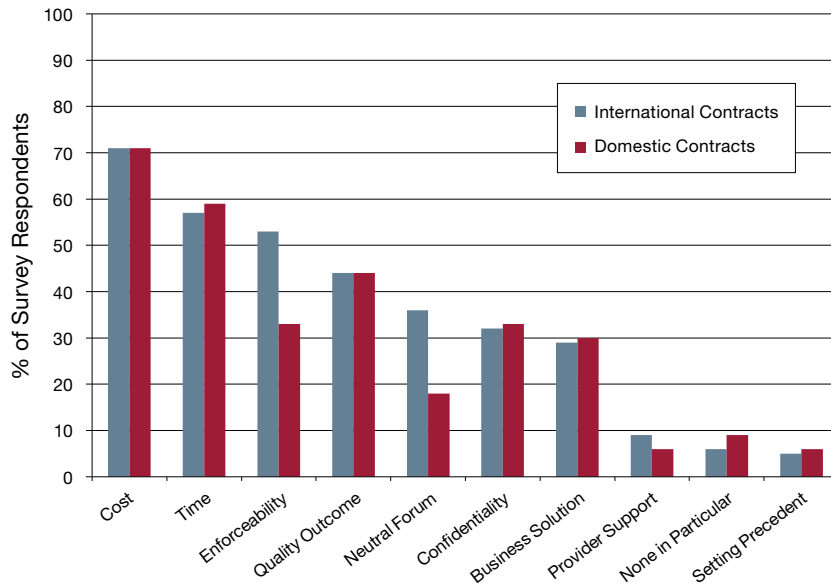
About FRAND

Standard-setting organizations typically require their members to license standard-essential patents (SEPs) on terms that are fair, reasonable and non-discriminatory (FRAND). FRAND terms are not predetermined but are the subject of often complex negotiations between the SEP owner and the standard-setting organization. If negotiations fail, arbitration and other ADR mechanisms can facilitate a time- and cost-efficient solution. The WIPO Center makes available tailored submission agreements which facilitate party submission of FRAND disputes to WIPO mediation or arbitration and offer guidance on procedural options that may foster the time- and cost-efficiency of proceedings.

About TISCs

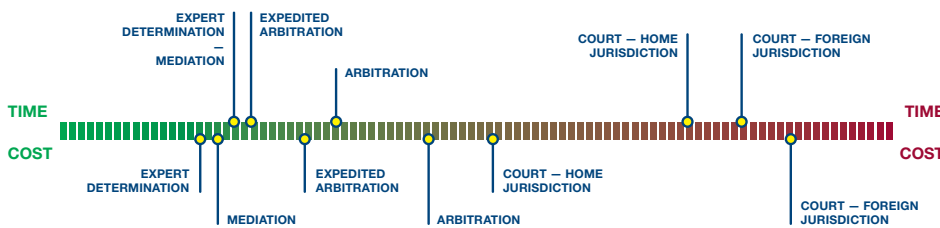
The WIPO Technology and Innovation Support Center (TISC) program provides innovators in developing countries with access to locally-based, high-quality technology information and related services, helping them to exploit their innovative potential and to create, protect and manage their IP rights. TISCs benefit from a 50 percent reduction in registration and administration fees for ADR services provided by the WIPO Center. More information about the WIPO TISC program is available at www.wipo.int/tisc.

Figure 1



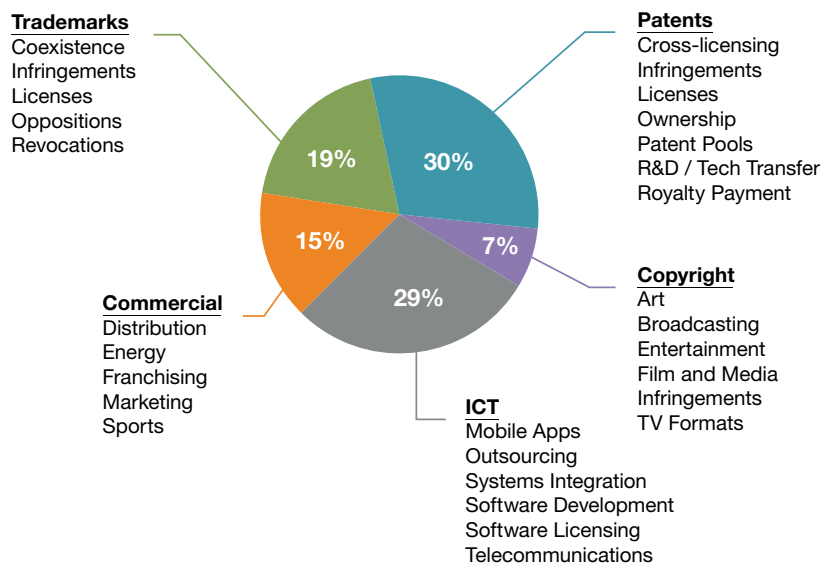
Main considerations when negotiating dispute resolution clauses (Source: WIPO International Survey on Dispute Resolution in Technology Transactions)

Figure 2



Relative time and cost of resolving disputes through court litigation, mediation, arbitration, expedited arbitration and expert determination (Source: WIPO International Survey on Dispute Resolution in Technology Transactions)

Figure 3



Subject matter of WIPO ADR cases (as of July 2016)

Examples of cases handled by the WIPO Center

A telecom patent license dispute

A European telecom company licensed US, European and Asian telecommunication technology-related patents to a US company involved in wireless product development. The license agreement contained a clause stating that any dispute arising from the agreement should be submitted to WIPO mediation, which in the absence of settlement would be followed by WIPO arbitration.

Four years after concluding their agreement, the licensor alleged that the licensee had violated its patents by using the licensed technologies beyond the scope of the license.

The European telecom company initiated a WIPO mediation. The Center suggested potential mediators with specific expertise in patents and telecommunication technology, and with the mediator's assistance the parties were able to settle their dispute within five months.

A trademark coexistence dispute

A European company had registered a trademark for luxury goods in multiple countries. An Asian manufacturer started to sell fashion products under a similar registered trademark and filed a court case and administrative cancellation proceedings in two European countries, alleging non-use by the European company of its trademark. After the court case went to appeal, the parties settled their dispute by concluding a trademark coexistence agreement which included a WIPO expedited arbitration clause. When the European company used its trademark at a trade fair, the Asian company initiated WIPO expedited arbitration proceedings, claiming infringement of the coexistence agreement.

Following consultations between the parties and the Center, a European trademark specialist was appointed as sole arbitrator. After two rounds of pleadings, the arbitrator held a one-day hearing in Munich (Germany) and issued an award six months after the proceedings began. Finding partial infringement of the coexistence agreement, the arbitrator granted the primary remedy claimed and ordered the European company to refrain from such infringing behavior.

An IT dispute

A Lebanese and a US-based start-up company entered into a license agreement on the use of mobile phone applications which contained a dispute resolution clause referring to WIPO mediation followed, in the absence of a settlement, by WIPO arbitration. The place of mediation was Paris, and the language to be used English.

A dispute arose between the parties regarding the use of the application under the license. Following the commencement of the mediation, the Center proposed several candidates and appointed a mediator in accordance with the parties' choice. The mediator was a French lawyer experienced in technology cases, fluent in English and French.

The parties agreed that the mediator should lead the oral proceedings in French, and that written communications should be in English. Given the parties' confirmed willingness to cooperate in the mediation and the distances and costs involved in arranging a physical meeting, the parties agreed to hold mediation sessions entirely via telephone. Within two months of the mediator's appointment, a settlement agreement was concluded and formed the basis of the parties' further collaboration.



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