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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

COMMITTEE ON DEVELOPMENT AND INTELLECTUAL PROPERTY (CDIP)

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DRAFT

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

Document prepared by the Secretariat

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

[Annex follows]

ANNEX

DEVELOPMENT AGENDA RECOMMENDATIONS NOS. 16 AND 20

PROJECT DOCUMENT

I. SUMMARY

Project Code:	DA 16 20 01
Title:	Intellectual Property and the Public Domain
Development Agenda Recommendation(s):	<p>Recommendation 16 (Cluster B): Consider the preservation of the public domain within WIPO's normative processes and deepen the analysis of the implications and benefits of a rich and accessible public domain.</p> <p>Recommendation 20 (Cluster B): To promote norm-setting activities related to IP that support a robust public domain in WIPO's Member States, including the possibility of preparing guidelines which could assist interested Member States in identifying subject matters that have fallen into the public domain within their respective jurisdictions.</p>
Project Budget:	<p>Non-personnel costs: Sfr.505,000</p> <p>Personnel costs: Sfr.380,000</p>
Project Duration:	24 months
Key WIPO Sectors Involved and Links to WIPO Programs:	<p>Patent Division; Copyright and Related Rights Sector; Sector of Trademarks, Industrial Designs and Geographical Indications; Global IP Issues Division; Global IP Infrastructure Department and the Development Agenda Coordination Division, in cooperation with the Technical Assistance and Capacity Building Sector.</p> <p>Links to WIPO Programs 1, 2, 3, 4, 8, 9 and 14.</p>
Brief Description of Project:	<p>Identifying subject matter that has fallen into the public domain, and preventing subject matter that is in the public domain or under a common or communal proprietorship from individual appropriation, is a key challenge for firms, individuals and Member States, worldwide. With a view to addressing the concerns raised under Recommendations 16 and 20, this project will provide a series of surveys and studies to deepen the conceptual understanding of what constitutes the public domain in different jurisdictions, what tools have been already made available to help identify the subject matter that has fallen into the public domain, and, to the extent relevant information is made available, what are the implications and benefits of a rich and accessible public domain. The project is divided into <u>four-three</u> components that will address the issue from the perspective of (1) copyright, (2) trademarks, (3) patents, and (4) <u>traditional knowledge (TK) and traditional cultural expressions (TCEs) on the understanding that the text of trademarks has to be discussed at the Fifth Session of the CDIP.</u> The outcome of the studies and surveys should be a first step towards further work, including the preparation of guidelines and/or development of tools to facilitate the identification of and access to public domain subject matter to promote norm-setting activities related to IP that support a robust</p>

	public domain in WIPO's Member States.
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2. PROJECT DESCRIPTION

2.1. Introduction to the Issue/Concern

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

Component (1) Copyright and Related Rights:

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

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

Component (2) Trademarks:

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

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

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

Component (3) Patents:

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

Component (4) TK and TCEs:

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

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

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

2.2. Objectives

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

2.3. Delivery Strategy

In order to achieve the objectives indicated above, a series of studies, surveys, will be undertaken by the Secretariat. This may be the first step in the implementation of the Recommendations, which will enable Member States to get an initial understanding of the subject under consideration. The studies will analyze the various tools that are available for identifying subject matter that is in the public domain, and consider whether further action is required in any field to enhance the capacity of actors to identify material in the public domain. Depending on the findings and conclusions of the studies, Member States may decide on additional activities that might be undertaken to meet the concerns of the Recommendations: They should also form a basis to promote norm-setting activities related to IP that support a robust public domain in WIPO’s Member States.

(1) Copyright

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

systems address the issue of orphan works in those systems; (iii) solicit information on recorded/registered public domain subject matter; and (iv) attempt to include all Member States. The Survey would include conclusions based on the data received by Member States.

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

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

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

(2) Trademarks

Study on Misappropriation of Signs and Possibilities to Prevent Such Practices: The proposed study would be a fact-finding comparative study of national laws to analyze the situation in a representative number of Member States by looking at the applicable legal provisions, primarily in trademark law, and researching reported cases of alleged misappropriation of certain distinctive signs and abusive appropriation of signs, that should remain available for use by the public. The study would cover both trademark applications and registrations involving the appropriation of signs that should remain freely available to the public, and those involving the misappropriation of signs owned by specific collectivities. The study would be prepared by a consultant, with contributions from a number of regional consultants, as well as inputs from Member States. The findings of the study could form the basis for further consideration and deliberation, as to whether concrete action needs to be undertaken in that area. This component of the project would be coordinated with the Standing Committee on Trademarks. A draft study would be made available to Member States for comments before finalizing.

(3) Patents

3.1. Study on Patents and the Public Domain: It is proposed to undertake a study that would focus on patents and the role of patent information in the identification, access and use of public domain material. As mentioned above, a preliminary study on the dissemination of patent information (which has, *inter alia*, addressed the public domain issue) and another study on exclusions from patentable subject matter and exceptions and limitations to those rights, were prepared for the SCP, and would be a useful basis for preparing a specific study focusing on patents and the public domain. The study should also discuss the implication of the following activities on the public domain: so-called "patent thicketing", "ever greening patents", the extension of the patent term, pre-grant or post-grant opposition to patents, and the disclosure requirements. The specific study would be useful to further explore the analysis of patent information and certain provisions of the patent system as a tool and basis for identifying subject matter that has fallen into the public domain. The study would focus

particularly on legal status information to identify off-patent technology. The study would also analyze the implications and benefits of a rich and accessible public domain.

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

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

The following activities were proposed at the Fourth Session of the CDIP. However, many delegations opposed to them and it was agreed to remove 4.1 and 4.2 from this project.

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

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