



Summary of Resolutions – AIPPI World Congress, Milan 2016

Added matter: the standard for determining adequate support for amendments

The treatment of subject matter added to patents and patent applications by way of amendment remains different between different countries.

This Resolution seeks to harmonize what subject matter may be added to patents and patent applications, after filing, by way of amendments. In particular, the Resolution seeks to define impermissible added matter.

More specifically, the Resolution provides guidance as to how a patent application is to be interpreted – to include subject matter explicitly disclosed in the application as filed, as well as its implicit and inherent content, as understood by a person skilled in the art. Impermissible added matter is defined as matter extending beyond this content.

Procedurally, AIPPI resolved that patent offices and courts should not allow amendments to patents or patent applications that introduce impermissible added matter.

AIPPI endorsed a generally flexible approach to amendments, and resolved that proposed amendments need not be found word-for-word in the patent application as filed. Likewise, amendments adding new claims to a patent application or patent should not, *per se*, be considered as introducing impermissible added matter.

AIPPI also resolved that amendments introducing so-called “intermediate generalizations” – based on the combinations of features taken from disparate disclosed embodiments, or deletion of features from embodiments - should not by themselves be considered as introducing impermissible added matter, contrary to the existing practice of some patent offices.

Finally, the Resolution urges that national and regional legislation be amended to achieve harmony in the treatment of added matter.

Requirements for protection of designs

This Resolution concerns the definition of and the requirements for the protection of designs, with a particular focus on the role of functionality. It addresses a registered or patent design right, whether or not examined. It does not address partial designs.

Members of the Agreement on Trade-Related Aspects of Intellectual Property Rights (*TRIPs*) may provide that protection for designs not extend to designs that are dictated essentially by technical or functional considerations. Many national laws contain such a restriction, but are silent on how to evaluate “technical functionality”, and the effect of technical functionality of a portion of a design.

In this Resolution, AIPPI resolved that design protection should be available, by way of registration, to protect the overall visual appearance including ornamentation (**Appearance**) of an object or article of manufacture as a whole (**Product**). The Resolution states that the preferred term for this right is **Registered Design**.

While the Resolution focuses on the question of technical functionality, AIPPI also resolved that, at a minimum, novelty should be a requirement for protection of a Registered Design.

AIPPI resolved that protection as a Registered Design should not be available for the Appearance of a Product that is dictated solely by the Product's functional characteristics or functional attributes (**Technical Function**). However, Registered Design protection should not be denied to the Appearance of a Product a *portion* of which is dictated solely by the Product's Technical Function.

AIPPI resolved that the assessment of Technical Functionality should include at least whether there is no alternative Appearance for the Product that would obtain substantially the same Technical Function (the so-called "multiplicity-of-forms" test). However, it is acknowledged that in practice additional tests may be necessary. For example, there may be no real alternative where any alternatives are very costly or protected by another intellectual property right. An additional test may be to assess whether the need to achieve the Technical Function of the Product was the only relevant factor when the Appearance of the Product was arrived at.

AIPPI also resolved that, in assessing the significance of any portion with technical functionality, no visual portion of the Appearance of the Product should be excluded from consideration. This should be the case even if the appearance of any such portion is dictated solely by the functional characteristics or attributes of that portion of the Product. However, such portion may be given less weight in the assessment. While the functional characteristics or attributes of such portion should not be protected, all visual aspects of that portion, including size, position and spatial relationship relative to the Appearance of the Product, should be considered when assessing the scope of protection of the Registered Design.

Linking and making available on the Internet

This Resolution concerns the issue of whether and under what circumstances the act of linking to a copyrighted work on the Internet should constitute infringement of the making available right of the copyrighted work.

Immediately prior to the Congress, the Court of Justice for the European Union (CJEU) delivered judgment on this subject in the GS Media / Sanoma case. Debate on this Resolution made clear that the approach of the CJEU in this and earlier cases is not considered self-evident across the world.

This Resolution makes a distinction between user activated links (hyperlinks or deep links) and automatic links (framing links or embedded links).

AIPPI confirmed its earlier Resolution on Q216B – "Exceptions to copyright protection and the permitted uses of copyright works in the hi-tech and digital sectors" (Hyderabad, 2011) to the effect that providing a hyperlink to a copyrighted work that has already been made available to the public on the Internet with the authorization of the relevant rights holder should not, by itself, constitute a further act of making such a work available to the public. To this, the additional

element of “or otherwise lawful circumstances” was added throughout the Resolution. AIPPI further confirmed that providing a hyperlink to a copyrighted work that has already been made available to the public on the Internet lawfully should not, by itself, constitute a communication of such work to the public.

AIPPI resolved that the act of placing a framed link or an embedded link should constitute a communication to the public, at least when the manner in which the work has been framed or embedded misleads the public into believing that the party engaging in the framing or linking is the source of the work. The requirement that the fragment or embedded link should mislead is to preclude free speech issues.

AIPPI resolved that if a copyrighted work is made available lawfully on a webpage without any access restrictions, such work should be considered as having been made available to all members of the public that have access to the Internet.

AIPPI also resolved that placing a hyperlink or deep link to a copyrighted work may attract liability where the linker knows or ought to have known that the copyrighted work has been uploaded without the consent of the rights holder, or where the linker provides an inducement or authorization to copy, display or communicate the unauthorized work to the public, or contributes to the copying or communication to the public or display of such work.

Finally, it was resolved that linking to a copyrighted work which circumvents a technological restriction should attract liability under copyright law and/or other laws. However, AIPPI also resolved that a mere statement on a second website that prohibits linking should not, by itself, make placing on the first website a link to the second website an infringement of copyright by the linker.

Security interests over intellectual property

This Resolution addresses registered intellectual property rights (*IPRs*), defined as patents, registered trademarks and registered designs. It does not address unregistered intellectual property rights.

Floating charges – a general security interest over all the security provider's assets, which may therefore cover any PRs but without needing to specify such IPRs – are excluded from the scope of the Resolution.

This aim of harmonisation in this Resolution is consistent with the work done and ongoing by the UNCITRAL for the harmonisation of laws for secured transactions. The Resolution addresses three foundations for harmonization: availability, registration, creation and effect of security interests in IPRs; choice of law and freedom of contract; and the rights and obligations of the security provider and the security taker in the absence of a contractual provision to the contrary. The latter is limited to rights and obligations prior to any event of default relating to the security interest in the IPR.

Importantly, AIPPI resolved that security interests in IPRs should be available and capable of registration. By registration, security interests should be enforceable against third parties. It was also resolved that it should be open to use the same register in which the IPR is registered or any other register, and the register may be national, regional or multinational.

The registration should be in a register of the jurisdiction in which the IPR is registered, and that the availability, registration, creation and effect of security interest in IPRs should be governed by the law designated by the jurisdiction in which the IPR is registered. However, AIPPI also resolved that, as a minimum standard, two types of security interest should be available in all jurisdictions: security interests not requiring assignment of ownership, such as pledges; and security interests by full assignment of ownership.

AIPPI resolved that there should be full freedom of contract between the parties, including the choice of law for such contract, other than for mandatory provisions in the jurisdiction in which the IPR is registered relating to the availability, registration, creation and effect of a security interest in IPRs. However, the Resolution also provides, as a default, a set of minimum principles that should apply in all jurisdictions relating to the rights and obligations of the security provider and the security taker in the absence of a contractual provision to the contrary.

Publication of Patent Applications

This Resolution was prepared by AIPPI's Standing Committee on Patents.

Along with prior user rights, the grace period and the treatment of conflicting applications, publication of patent applications is one of four topics identified as being key to harmonisation of patent law by the Tegernsee Group. AIPPI's position, as set out in the Resolution, is that the international nature of patent law, legal certainty and the practical functioning of the patent system underpins the importance of harmonised procedures concerning publication of patent applications around the world.

AIPPI resolved that, as a general rule, a patent application should be published 18 months after the date of priority or the date of filing the patent application. Moreover, a patent applicant should have the right to request early publication with regard to specific applications.

AIPPI resolved that patent offices should notify the applicant of the proposed publication date at least two months in advance (unless early publication has been requested). Furthermore, an application should not be published if it is withdrawn, abandoned or rejected prior to the publication preparation due date, which should be no earlier than one month prior to the proposed publication date and no earlier than 17 months after the date of priority of the application.

AIPPI also resolved that if the applicant requests a search report and a preliminary assessment of patentability at the time of filing, patent offices should provide such report and assessment prior to, or at the same time as, notifying the proposed publication date. If a request for early publication has been made, such report and assessment should be provided no later than two months prior to the date which would have been the general 18-month publication date, absent the request for early publication.

Finally, AIPPI also resolved that patent offices should have the right to defer publication if the relevant national governmental officials are reasonably of the opinion that such publication would cause a threat to national security.

Patent Rights and Green Technology / Climate Change

This Resolution was prepared by AIPPI's Standing Committee on Intellectual Property and Green Technology.

That Committee's 2014 Report entitled "Climate Change and Environmental Technologies – the Role of Intellectual Property, esp. Patents" published at the 2014 AIPPI World Congress in Toronto provides a full discussion of the background to the issues addressed in this Resolution.

The Resolution states that the patent system minimum standards prescribed by the TRIPS Agreement should remain unchanged, as there is insufficient basis to suggest that any fundamental changes to patent laws would be warranted in the interest of speeding up research and development, in the light of the immediacy of the threat of climate change.

The Resolution supports accelerated examination of patent applications covering green technologies. It emphasizes the relevance of patents as an important source of information about existing technologies. It also encourages standardization efforts in the green technology field, where appropriate.

The Resolution also supports exemplary initiatives by institutions, aiming at the development, dissemination and implementation of green technologies. The Resolution specifically mentions the work of the European Patent Office on patent information, the WIPO GREEN program, an Internet platform facilitating the transfer of green technologies, and WIPO's training programs.

Finally, recognizing that the IP system is part of a larger ecosystem, the Resolution stresses the importance of improving and strengthening the innovation infrastructure, especially in developing and emerging countries. Accordingly, AIPPI resolved that IP asset development, IP licensing and R&D collaboration as a means to facilitate commercialization could and should be increased. Similarly, tax and other incentives should be available to encourage the dissemination of new technology.