

WORLD TRADE
ORGANIZATION

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Council for Trade-Related Aspects
of Intellectual Property Rights

II. DEVELOPMENTS IN THE WTO

3. A "Declaration on Global Electronic Commerce" was adopted on 20 May 1998 in Geneva by the second session of the Ministerial Conference.⁴ Ministers recognized that global electronic commerce was growing and creating new opportunities for trade, and urged the General Council to establish a comprehensive work programme to examine all trade-related issues relating to global

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related to electronic commerce.¹⁴ Having regard to instructions of the Doha Ministerial Conference,¹⁵ the TRIPS Council, at its meeting in February 2003, put in place a mechanism for ensuring the monitoring and full implementation of the obligations in Article 66.2 of the TRIPS Agreement.¹⁶ The role of IP protection in the transfer of technology has also been addressed by the Working Group on Trade and Transfer of Technology, which was established by Ministers in Doha to examine the relationship between trade and the transfer of technology.¹⁷ The original note also discussed the potential of information and communications technologies to facilitate access from anywhere in the world to the valuable and extensive technological information contained in patent documents and to improve the efficiency of intellectual property offices in other ways.¹⁸ A number of developed country Members have reported to the Council on their technical cooperation activities aimed at modernizing IP offices and their services.¹⁹

15. The WIPO Survey summarizes the status of implementation of these treaties as follows:

"For most countries, particularly those already in compliance with existing treaties, the implementation of the Internet Treaties does not require major rewriting of the law on copyright and related rights, nor any fundamental change in policy or the structure of their legal systems. Typically, a country may need to clarify the scope of existing rights to add the right of 'making available' on demand. Because the scope of related rights has traditionally been more limited, additional rights such as moral rights may need to be added to protect performers or record producers. Although not required by the treaties, a country may choose to make adjustments to the limitations and exceptions to rights it provides. Finally, each country must provide adequate and effective legal remedies against the circumvention of technical protection measures and the deliberate deletion or alteration of rights management information, although these provisions are drafted generally in the treaties so as to give national legislators flexibility in their implementation."²⁷

Certain other WIPO activities

16. Paragraph 84 of the original background note discussed the protection of audiovisual performances, rights of broadcasting organizations and the protection of databases. As noted in that paragraph, the WPPT does not cover the rights of performers in audiovisual fixations of their performances. In December 2000, a Diplomatic Conference on the Protection of Audiovisual Performances was held under the auspices of WIPO with a view to extending the principles of the WPPT to audiovisual performances. While a provisional agreement was achieved on most substantive issues, agreement could not be reached on whether and, if so, how to regulate the transfer of rights from performers to producers, including whether such transfers should be internationally recognized. One possible approach considered by the Conference was to regulate this by determining the law applicable to such transfers.²⁸ The issue remains on WIPO's agenda. The WIPO General Assembly decided, at its meeting in September 2002, that the International Bureau should conduct informal consultations in the first quarter of 2003 with all interested parties to explore the possibilities of convening an *ad hoc* informal meeting to address the remaining differences and possible ways of resolving them.²⁹

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effective to avoid a commercial effect in that jurisdiction. Third, remedies for an infringement in a particular country must be proportionate to the commercial effect of the use of the sign in that country. In general, competent authorities should, as far as possible, refrain from granting "global injunctions" that would affect the use of the sign outside the jurisdiction in question.

Well-known trademarks

21. The protection of well-known marks was addressed in a "Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks",³⁵ that was adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of WIPO in September 1999.³⁶ First, it provides guidelines to assist competent authorities to determine whether a mark is well-known. Among the recommended criteria to be considered are the duration, extent and geographical area of any use and promotion of the mark. The explanatory notes prepared by the

23. WIPO commenced the Second WIPO Internet Domain Name Process in July 2000 to address abusive domain name registrations of identifiers other than trademarks. In September 2001, WIPO published its report on this process entitled "The Recognition of Rights and the Use of Names in the Internet Domain Name System", and presented it to WIPO's member States and ICANN. This report was analyzed by the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications ("SCT"), which formulated a set of recommendations.⁴² These recommendations were considered by the WIPO General Assembly at its meeting in September 2002.⁴³ The recommendation concerning country names was remitted for further consideration at the SCT's meeting in November 2002.⁴⁴ As a result, the member States of WIPO decided to recommend that the names and acronyms of intergovernmental organizations ("IGOs") and country names should be protected against abusive registration as domain names.⁴⁵ These recommendations were transmitted to ICANN.⁴⁶

IV. ENFORCEMENT AND RELATED MATTERS

Liability of service providers

24. Paragraphs 73 and 74 of document IP/W/128 addressed the issue of the liability of service providers in respect of the transmission and storage of material initiated by others: to what extent service providers, who act as intermediaries transmitting or storing potentially infringing content, are or should be held liable for such content and, if so, what remedies should be available. Given that the Internet is a borderless medium, it would be important that national approaches to this issues would be mutually compatible so as to allow global networks and markets to develop smoothly.

25. This issue was discussed in the context of the work leading up to the WIPO 1996 Diplomatic Conference. Article 8 of the WCT on the "Right of Communication to the Public" compiles the various provisions of the Berne Convention on the right of communication into a single provision,

"It is understood that the mere provision of physical facilities for enabling or making a communication does not in itself amount to communication within the meaning of this Treaty or the Berne Convention."

Private International Law

29. Paragraphs 68-72 of the original note in document IP/C/W/128 highlight certain jurisdictional questions that relate to the use of intellectual property over the Internet. Under the WTO Work Programme on Electronic Commerce, the question of "jurisdiction and applicable law/other legal issues" has been identified by delegations as a cross-cutting issue.⁵²

30. When a court is faced with a case involving a foreign element, it has to decide whether it possesses jurisdiction, and, if so, it has to decide the law applicable to the case. The third stage concerns the recognition and enforcement of foreign judgements. These issues have been addressed by national courts for long, leading to the gradual development of municipal law regulating these classic issues of private international law. What is particular for electronic commerce over global information networks is that it vastly increases the occurrence of potential disputes with foreign elements. The global nature of the Internet and the market-place it creates increases pressure to find compatible solutions to jurisdictional and choice of law questions, but at the same time it increases the complexity of the issues involved. As the technology and the market-place have developed, legal responses to these questions have continued to evolve under national jurisdictions.

31. Discussions on a new multilateral instrument have been under way under the auspices of the Hague Conference on Private International Law ("the Hague Conference")⁵³ since 1992. In June 2001, a Diplomatic Conference was held under the auspices of the Hague Conference to consider a convention on jurisdiction and the recognition and enforcement of foreign judgements in civil and commercial matters. This was to be the first session of the Diplomatic Conference to be conducted in two stages.⁵⁴ Among the main difficulties that have arisen in these discussions are the implications of e-commerce and the Internet on the new instrument, and how the instrument should treat intellectual property disputes. The kinds of questions that have arisen in regard to e-commerce include whether jurisdiction should

Hague Conference. They have recently concentrated on a possibly more limited convention, focusing in particular on choice of court clauses in business-to-business ("B2B") cases.⁵⁸

⁵⁸ An informal working group, set up in 2002, has elaborated a draft text focusing on certain core areas, namely on choice of court agreements in B2B cases (Prel. Doc. No 8, March 2003). At its meeting in April 2003, the Special Commission on General Affairs and Policy of the Conference requested the Secretary General of the Permanent Buto

ANNEX

TRIPS COUNCIL DOCUMENTATION ON ELECTRONIC COMMERCE

Document reference	Submitted by	Title	Date of Circulation
JOB(02)/15 ⁵⁹	WIPO	Activities of Relevance to the Work of the Council for TRIPS	4 March 2002
IP/C/W/286	Switzerland	Work Programme on Electronic Commerce	22 June 2001
IP/C/W/264 ⁶⁰	Cuba	Need for Unrestricted Global Electronic Commerce	16 May 2001
IP/C/W/233	Australia	Electronic Commerce Work Programme	7 December 2000
IP/C/20	Chairman of the Council	Work Programme on Electronic Commerce; Progress Report by the Chairman to the General Council	4 December 2000
IP/C/W/224	European Communities	Work Programme on Electronic Commerce	17 November 2000
IP/C/18	Council for TRIPS	Work Programme on Electronic Commerce; Progress Report to the General Council	30 July 1999
IP/C/W/149	United States	Work Programme on Electronic Commerce	14 July 1999
IP/C/W/147	India	Work Programme on Electronic Commerce	13 July 1999
IP/C/W/145	Japan	Work Programme on Electronic Commerce	13 July 1999
IP/C/W/144	Australia	Work Programme on Electronic Commerce	6 July 1999
IP/C/W/140	European Communities	Work Programme on Electronic Commerce	7 May 1999
IP/C/16 ⁶¹	United States	Work Programme on Electronic Commerce	12 February 1999
IP/C/W/128	Secretariat	Work Programme on Electronic Commerce; Background Note by the Secretariat	10 February 1999

⁵⁹ The document provides information on WIPO's activities of relevance to matters before the TRIPS Council, including electronic commerce.

⁶⁰ Also circulated as document WT/GC/W/435, G/C/W/254, S/C/W/193 and WT/COMTD/W/87.

⁶¹ Also circulated as document WT/GC/16, G/C/2, S/C/7 and WT/COMTD/17.