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Some memories of the unique TRIPS negotiations

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The invitation to contribute to this book was certainly a pleasant surprise. The question for me was what I should write about: I had not been one of the negotiators and the chapter on the TRIPS negotiations from the perspective of the GATT Secretariat is dealt with by Adrian Otten, who was the Secretary of the TRIPS Negotiating Group. Several suggestions were made by my co-authors and, upon reflection, I decided to contribute with just a short compilation of some memories in respect of a diverse set of aspects, whether trade-related or not.

No one from the IP world would have believed you in 1986, if you had said that, within ten years, a treaty would be in force among more than 100 countries and territories establishing international norms and standards for IP protection in respect of all main areas of IP. People would even have laughed at you. Yet, in 1995, the TRIPS Agreement entered into force, establishing definitions, scope of protection, duration, permissible exceptions to protection and enforcement procedures in respect of copyright and related rights, trademarks, geographical indications (GIs), industrial designs, patents, layout-designs of integrated circuits and undisclosed information.

Before I joined the GATT Secretariat, in July 1989, I had worked as a legal officer at the Dutch Patent Office since 1981, involved in opposition and appeal procedures, which had allowed me to get insights into procedural as well as substantive law aspects of patent law. The job had also, however, allowed me to gain some experience in legislative work in the area of patents, trademarks and industrial designs, as well as in international negotiations, in particular in the area of trademarks – as I was part of the delegation of the Netherlands in the negotiations on the European Community Trademark Regulation and Directive, and in the negotiations in WIPO on the Madrid Protocol concerning the international registration of marks.

This experience was definitely a helpful background for the job in the GATT Secretariat during the TRIPS negotiations, in particular in respect of the nitty-gritty IP law aspects. For example, in June 1990, the Secretariat was entrusted by the TRIPS Negotiating Group to prepare a composite draft text of the various draft texts that had been tabled by delegations. This composite draft text was prepared by a Secretariat team that reported to David Hartridge and consisted of Adrian Otten, Arvind Subramaniam, Daniel Gervais and me. It was not an easy task, to decide on the approach to take in reflecting the various policy and legal aspects in a balanced way. I remember very well that, once the composite draft text had been put together by the four of us, Daniel and I went through the document for a final check, using, as Adrian called it, a very fine comb. The composite draft text became the starting point of a textual negotiation that resulted, a year and a half later, in the draft TRIPS agreement that formed part of the Draft Final Act of the Uruguay Round of multilateral trade negotiations dated 20 December 1991, the so-called Dunkel Draft. As explained elsewhere in this book, that draft of the TRIPS Agreement functioned, as of 1992, as a draft treaty establishing *de facto* international standards for IP protection. The text was adopted with very few changes as part of the Marrakesh Agreement Establishing the WTO (WTO Agreement) in 1994.

Another remembrance relates specifically to Article 27.3(b) of the TRIPS Agreement. The text of this provision was presented to the Chair of the TRIPS Negotiating Group, Ambassador Lars Anell, at some point late in the negotiations, as the result of negotiations between the "Quad" – Canada, the European Communities, Japan and the United States – and several developing countries, among which were Brazil and India. The text differed from earlier drafts that had been on the table in the Negotiating Group. When the Chair enquired about these differences, at the time that the group presented the text to him, John Gero of the Canadian delegation responded that this text was acceptable to all who had negotiated it. No explanations were given. The text found its way into the Dunkel Draft without any change. Article 27.3(b) allows for exceptions to patentable subject matter in respect of living matter, while, at the same time, requiring certain types of inventions in this category to be protectable under patent law or, as far as plant varieties are concerned, alternatively, an effective *sui generis* system or any combination of the two. Questions have since been asked as to how Article 27.3(b) should be interpreted, in particular as the provision was negotiated at a time when there were also other negotiations taking place relevant to aspects addressed in Article 27.3(b), that is, those that led to the revision of the International Convention for the Protection of New Varieties of Plants (UPOV

Convention) and those resulting in the adoption of the Convention on Biological Diversity. In this regard, the TRIPS negotiators seem to have opted for constructive ambiguity.

There are more provisions of this kind in the TRIPS Agreement, and the interpretation of several of these has meanwhile been addressed in proceedings under the WTO dispute settlement system. I may refer to the provisions of Articles 13, 17 and 30; the negotiators chose to model all three on Article 13 of the Berne Convention for the Protection of Literary and Artistic Works, despite the textual differences that were necessary in view of the different nature of the rights conferred under copyright law, trademark law and patent law, respectively. Article 20, which could also be mentioned in this regard, could not be modelled on a provision of one of the pre-existing IP conventions. The provision deals with the issue of special requirements encumbering the use of a trademark in the course of trade. Two real-life issues had been mentioned during the negotiations, namely, (i) a requirement in some jurisdictions to the effect that goods or services of a foreign company – and their trademark for these goods or services – could only be used in these countries and territories through a local company and together with the trademark of the local company; and (ii) a requirement that trademarks for pharmaceuticals could only be used together with the generic name of the pharmaceutical, in such a way that the generic name would predominantly appear on the packaging, for example, three times the size of the trademark. These two situations are reflected in Article 20, in a more general way – "use with another trademark" and "use in a special form" – and together with other criteria of a more general nature.

Of course, I would like to address here also a recollection from the negotiations concerning the provisions of the TRIPS Agreement on GIs. However, in view of my current position in WIPO, I cannot do so without the necessary restraints. Let me just say that I cannot imagine that anybody would have thought that the membership of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration would grow after the entry into force of the TRIPS Agreement. Rather the contrary. In 1995, the Lisbon Agreement had 17 member states and no new accessions had taken place since 1977. Then the TRIPS Agreement entered into force in 1995 (as part of the WTO Agreement), among more than 100 WTO members, requiring them – albeit subject to transitional periods – to provide, *inter alia*, for the protection of GIs. When preparing the implementation of their obligations under the TRIPS Agreement, many WTO members have taken initiatives that have resulted in the establishment of GIs for local products from their territories. Apparently, several have also looked

at the Lisbon Agreement in this connection, as the Lisbon Union has welcomed 11 new accessions since 1997 and about 25 per cent of the current registrations were filed after 1995. True, the number of members of the Lisbon Union is still modest, but interest in the Lisbon System is growing, in particular in view of the revision process that the Lisbon Union initiated in 2008, with the objective of refining and modernizing the legal framework of the Lisbon System and, thus, of allowing for accession by the largest possible number of countries or entities, including intergovernmental organizations administering regional systems for the registration of GIs. This revision process was finalized in May 2015 with the adoption of the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications.

In its section on copyright and related rights, the TRIPS Agreement excludes, in Article 9.1, the protection of moral rights under Article 6*bis* of the Berne Convention from rights and obligations under the TRIPS Agreement. During the negotiations, it was clear that obligations existing under the Berne Convention itself in respect of moral rights should be safeguarded from this exclusion. In the decisive debate on how this should all be reflected in the TRIPS Agreement, an attempt was made to draft the provision in such a way that it would not exclude the protection of moral rights from rights and obligations under the TRIPS Agreement but, instead, incorporate the norms and standards of Article 6*bis* of the Berne Convention, while allowing any WTO member to make a reservation in that regard. In the end, the exclusion provision was retained. As regards obligations in respect of moral rights under the Berne Convention, these should be understood to be safeguarded by Article 2.2 of the TRIPS Agreement. An interesting question in this regard is, of course, whether the violation of a safeguard provision can be the subject of dispute settlement under the TRIPS Agreement.

Let me finish this brief contribution with an anecdote from one of the meetings of the TRIPS Negotiating Group. It concerns a debate on one of the issues on which the delegations of India and the United States had diametrically opposed positions. The debate had already taken much of the Negotiating Group's time that morning, when the Chair announced that only a few minutes were left before the meeting had to be interrupted for lunch and that it was his intention to close the debate on the issue before lunch. However, he still had two requests for the floor – from the delegations of India and the United States. With these words, he gave the floor to A.V. Ganesan of the Indian delegation, who said: "Would you like us to make a joint statement, Mr. Chairman?"