

**NON-EXHAUSTIVE LIST OF ISSUES AND QUESTIONS  
TO FACILITATE PREPARATIONS FOR THE BILATERAL MEETINGS  
CHAPTER 7 INTELLECTUAL PROPERTY LAW**

**INTRODUCTION**

During the bilateral meeting, candidate countries are invited to explain their (i) legal framework; (ii) administrative/institutional framework; and (iii) enforcement record. The Commission recalls that the *acquis* in the field of intellectual property includes a number of directives which have to be implemented by Member States, and the adoption of certain international obligations.

The draft agenda will broadly follow the same structure used in the explanatory meeting, i.e. copyright and related rights on day 1; industrial property rights and enforcement on day 2. More details will be available very soon.

The presentations concerning national legislation should include an assessment of the degree of alignment with the *acquis* and, where gaps exist, describe the approach and timetable foreseen to reach full alignment. Candidate countries should identify any issues which may cause specific difficulties or require a particularly long time to implement.

*NB: it would be helpful to receive information in writing in two days advance of the bilateral meeting.*

**COPYRIGHT AND RELATED RIGHTS**

Candidate countries are invited to make a comprehensive presentation of their copyright legislation. Particular attention should be given to those aspects which are harmonised by the *acquis*.

Specific information could be useful for the following issues:

- 1) In relation to the Directive 2001/29 on the harmonisation of copyright and related rights in the Information Society, the way in which the notion of 'fair compensation' for private copying and reprography has been or will be dealt with in your national legislation; the availability and scope of application of technological protection measures in your national market.
- 2) Concerning the Term Directive, the kind of protection for joint authorship and collective works, for works published in volumes, parts, instalments, issues or episodes, for cinematographic or audiovisual works, for previously unpublished works, for critical and scientific publications, for photographs, and the eventual measures to introduce to protect the rights of third parties;
- 3) Concerning the Rental and Lending Rights Directive, the kind of protection adopted for the public lending right (exclusive right or remuneration) and the means to finance it, as well as the possible exemptions, the kind of protection for the broadcasting and communication to the public rights, as well as the rules applied for ensuring the equitable remuneration, and the possible limitations;
- 4) As regards satellite broadcasting, the applicable law for broadcasts from other countries and the criteria in force for the payment of the copyright and the related rights to be acquired;
- 5) In relation to retransmissions of programmes from other countries via cable, the steps to be followed by cable operators in order to obtain a licence from rightholders;

- 6) With regard to resale right, the categories of works protected, the dealers of art concerned, as well as the beneficiaries (authors and/or persons entitled after his/her death).
- 7) In relation with several directives, how would the principle of EC exhaustion, as opposed to international exhaustion, be implemented?
- 8) Concerning international obligations, the candidate countries could give an update concerning membership to Berne and Rome Conventions, WCT, WPPT and clarify whether they have deposited reservations/notifications to these treaties and conventions.

## **INDUSTRIAL PROPERTY RIGHTS**

Candidate countries are invited to make a comprehensive presentation of their legislation in the field of industrial property. Particular attention should be given to those aspects which are harmonised by the *acquis*.

The implementation of some regulations requires the appointment of national competent authorities and related administrative procedures to be established, e.g. for the grant of supplementary protection certificates and concerning compulsory licensing in relation to patents and supplementary protection certificates concerning the manufacture and sale of pharmaceutical products. Candidate countries are invited to describe, if known, the approach and timetable they will take in respect of these provisions.

As regards biotechnological directive it would be useful to know how the directive has been applied at national level and if the National Patent Office encountered any particular problem in the examination process.

With regard to trademark, the answers to the following questions could be helpful.

What is the general structure of your trade mark system (e.g. existence of opposition procedure? Ex officio search of earlier rights)? Is there an interpretation as regards what constitutes "graphical representation" of a sign? What absolute grounds for refusal/invalidity exist? Are any absolute grounds for refusal/invalidity as the ones mentioned in Article 3(2) of Directive 89/104/EEC (TMD) included in your national system? Do you have an absolute ground for refusal/invalidity in relation to Regulation 2081/92 (see as example Article 7(1)(k) Regulation of 40/94)? What other grounds for refusal/invalidity are included in your system (see Article 4 TMD)? What rights are conferred by a trade mark (see Article 5 TMD)? Do you intend to use the option laid down in Article 5(2) TMD? What limitations to the rights conferred by a trade mark does your system know (see Article 6 TMD)? Under what circumstances is a trade mark right exhausted? Does your system know a "use requirement" and, if so, what constitutes "use" and what are the consequences of non-use (Articles 10-12 TMD)? Are there any consequences if a trade mark proprietor of an earlier right acquiesced the use of a later trade mark (see Article 9 TMD)? What are grounds for revocation of a mark exist (see Article 12 TMD)? Does your system know collective, guarantee or certification marks, and, if so, are there any particular reasons for not registering such marks, for revoking them or for declaring them invalid (see Article 15 TMD)?

## **ENFORCEMENT, INCLUDING ADMINISTRATIVE/INSTITUTIONAL FRAMEWORK**

Candidate countries are invited to a comprehensive presentation of their legislation concerning the enforcement of intellectual and industrial property rights. While all the requirements of Directive 2004/48/EC on the enforcement of intellectual property right should be covered and any gaps between national legislation and the Directive identified, candidate countries should not restrict themselves to the formal requirements of the Directive.

Effective enforcement is a general obligation under Community law. Article 12 of the EC Treaty states that "Member States shall take all appropriate measures, whether general or particular, to ensure fulfilment of the obligations arising out of this Treaty." Moreover, there is ample case-law from the European Court of Justice stating that Member States must impose sanctions which are

effective, proportionate and dissuasive to ensure the effective enforcement of Community law.<sup>1</sup> Candidate countries are therefore invited to describe their overall legal and administrative framework, including:

- a. civil and penal sanctions available in relation to infringements of intellectual property law;
- b. the allocation of responsibilities among, as well as the powers and resources available to the various public authorities involved in the enforcement of IPRs, including policy-making, law enforcement, technical services, prosecutors, the judiciary (for example if specialised judges, chambers or courts exist), etc.;
- c. the organisation, staffing and workload of your industrial property office and, if different, the authority responsible for copyright matters (such as the supervision of collecting societies);
- d. the procedures and institutions to promote co-ordination among all the relevant public authorities, including at both policy-making (e.g. inter-ministerial working group, national anti-piracy commission, etc.) and working-level (including sharing of operational information between different public authorities);
- e. an assessment of the main challenges your country faces in order to improve enforcement, including a description of the main types of infringements, main economic sectors affected, and the characteristics of the illicit trade in your country (the relative importance of domestic production vs. importation/transit, wholesale vs. retail channels, etc.);
- f. detailed statistics concerning activities designed to combat piracy and counterfeiting, including law enforcement actions (raids, seizures, cases reported to prosecutors/courts, etc.), indictments and prosecutions, as well as convictions (distinguishing between civil and criminal cases).

For points (e) and (f), candidate countries are invited to describe trends since 2000.

Some aspects related to IPR enforcement are covered in other chapters, such as for example customs measures which are covered under chapter 29 – Customs Union. Inevitably, this may entail some duplication of information. Candidate countries are nevertheless invited to be as comprehensive as possible.

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<sup>1</sup> See *inter alia* the ECJ judgements in C-68/88, C-326/88, C-352/92, C-341/94, C-186/98, C-354/99.