

## TPP, US, and TRIPS IP Law Comparison

TPP provisions from leaked February 2011 US proposed IP chapter, supplemented by leaked September 2011 Article 8 and 9 updates (patents). The following sources were particularly helpful in identifying corresponding statute sections and analysis: Jodie Griffin, *Comparing TPP to US Law*, PUBLICKNOWLEDGE (Oct. 24, 2011), <http://www.publicknowledge.org/comparing-tpp-us-law>, and Sean Flynn et al., Public Interest Analysis of the US TPP Proposal for an IP Chapter, Program on Information Justice and Intellectual Property (Dec. 6, 2011) *available at* <http://digitalcommons.wcl.american.edu/cgi/viewcontent.cgi?article=1023&context=research>. NB: use of brackets indicates paraphrased language.

Article	TPP Text	US Law	TRIPS & Other acts	Analysis
<b>ARTICLE 2 - TRADEMARK</b>				
2.1	No Party may require, as a condition of registration, that a sign be visually perceptible, nor may a Party deny registration of a trademark solely on the grounds that the sign of which it is composed is a sound or a scent.	15 USC § 1052. The Lanham Act simply carves out exceptions to when a trademark may be granted. Nothing indicates that a sound or sent cannot be trademarked.	<p>TRIPs Article 15</p> <p>1. Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.</p> <p>2. Paragraph 1 shall not be understood to prevent a Member from denying registration of a trademark on other grounds, provided that they do not derogate from the provisions of the Paris Convention (1967).</p>	TPP expands the scope of what can be a trademark as compared to the TRIPS agreement, and limits the acceptable reasons for denial. It appears to implement US Trademark Law for TPP members (less the US national symbol exceptions). It also strengthens the ability to use "Geographical Indication" trademarks (think "Idaho Potatoes"). There are some differences in the language of the "rights conferred" section, but their impact on trademarks is not clear.
2.2	Each Party shall provide that trademarks shall include certification marks. Each Party shall also provide that	Subject to the provisions relating to the registration of trademarks...collective and certification marks, including	<p>TRIPS Art. 22</p> <p>1. Geographical indications are, for the purposes of this Agreement, indications which</p>	Appears to implement US trademark law. Language may be slightly more restrictive.

	<p>geographical indications are eligible for protection as trademarks. Each Party shall ensure that its measures mandating the use of the term customary in common language as the common name for a good or service ("common name") including, inter alia, requirements concerning the relative size, placement or style of use of the trademark in relation to the common name, do not impair the use or effectiveness of trademarks used in relation to such good or service.</p>	<p>indications of regional origin, shall be registrable under this Act, in the same manner and with the same effect as are trademarks,...even though [those with the right may] not possess an industrial or commercial establishment, and when registered they shall be entitled to the protection provided herein in the case of trademarks, except in the case of certification marks when used so as to represent falsely.... Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.</p>	<p>identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.</p> <p>2. In respect of geographical indications, Members shall provide the legal means for interested parties to prevent:</p> <p>(a) the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good;</p> <p>(b) Any use which constitutes an act of unfair competition within the meaning of Article 10<i>bis</i> of the Paris Convention (1967).</p>	
2.3	<p>Each Party shall ensure that its measures mandating the use of the term customary in common language as the common name for a good or service ("common name") including, inter alia, requirements concerning the relative size, placement or style of use of the trademark in relation to the common name, do not impair the use or effectiveness of trademarks used in relation to such good or service.</p>	<p>Didn't see an equivalent provision in US law</p>	<p>TRIPS Art. 24.6 Nothing in this Section shall require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to goods or services for which the relevant indication is identical with the term customary in common language as the common name for such goods or services in the territory of that Member. Nothing in this Section shall require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to products of the vine for which the relevant indication is identical with the customary name of a</p>	<p>More or less similar, but the TPP Version contains an affirmative obligation to ensure that there isn't impairment of the trademark</p>

			grape variety existing in the territory of that Member as of the date of entry into force of the WTO Agreement.	
2.4	Each Party shall provide that the owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs, including geographical indications, for goods or services that are related to those goods or services in respect of which the owner's trademark is registered, where such use would result in a likelihood of confusion. In the case of the use of an identical sign, including a geographical indication, for identical goods or services, a likelihood of confusion shall be presumed.	Lanham Act 15 USC 1114 People who don't hold the rights may not: "a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or reproduce, counterfeit, copy, or b) colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive." Looks to be the same bundle of rights.	TRIPS Art. 16 1. The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use. 2. Article 6bis of the Paris Convention (1967) shall apply, <i>mutatis mutandis</i> , to services. In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark.	The major difference I see here is that there is a presumption of confusion in the case of an identical geographical indication (not 100% sure if this is a change from the USA)
2.5	Each Party may provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided that such exceptions take account of the legitimate interest of the owner of the trademark and of third parties.	See Below (KP Permanent, etc)	(TRIPS Art 17) Members may provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided that such exceptions take account of the legitimate interests of the owner of the trademark and of	No Alteration of US Law

			third parties.	
2.6	No Party may require as a condition for determining that a mark is a well-known mark that the mark has been registered in the Party or in another jurisdiction. Additionally, no Party may deny remedies or relief with respect to well-known marks based solely on F	See <i>KP Permanent Make-Up, Inc. v, Lasting Impression I, Inc.</i> , 543 US 111. Incontestability; defenses. To the extent that the right to use the registered mark has become incontestable under section 15 [15 USC 1065], the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce...and shall be subject to the following defenses or defects: 1) [Fraudulently obtained] 2) [Abandonment] 3) [Permission] 4) [Good faith use as a name or description rather than mark] 5) [Continuous good faith use prior to registration] 6) [Previously registered, used, and not abandoned] 7) That the mark has been or is being used to violate the antitrust laws of the United States; or 8) That the mark is functional; or 9) [Enjoined by equity]	TRIPS 18  The use of a trademark in the course of trade shall not be unjustifiably encumbered by special requirements, such as use with another trademark, use in a special form or use in a manner detrimental to its capability to distinguish the goods or services of one undertaking from those of other undertakings. This will not preclude a requirement prescribing the use of the trademark identifying the undertaking producing the goods or services along with, but without linking it to, the trademark distinguishing the specific goods or services in question of that undertaking.	Doesn't alter US trademark law - current exceptions, etc fit into the scheme fine. US law may actually serve as an example of how countries would craft a law given the conditions set up in TRIPs/TPP.
2.7	Article 6bis of the Paris Convention for the Protection of Industrial Property (1967) shall apply, <i>mutatis mutandis</i> , to goods or services that are not identical or similar to those identified by a well-known trademark, whether registered or not, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the trademark, and	15 USC 1059 Subject to the provisions of section 8 [ <a href="#">15 USC 1058</a> ], each registration may be renewed for periods of 10 years at the end of each successive 10-year period [subject to approval and meeting filing requirements]	(TRIPs 16.3 - rights conferred) 3. Article 6bis of the Paris Convention (1967) shall apply, <i>mutatis mutandis</i> , to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the	Direct Copy from TRIPs, US is a member, so likely little change. Looks like USA allows a month.

	provided that the interests of the owner of the trademark are likely to be damaged by such use.		interests of the owner of the registered trademark are likely to be damaged by such use.	
2.8	Each Party shall provide for appropriate measures to refuse or cancel the registration and prohibit the use of a trademark or geographical indication that is identical or similar to a wellknown trademark, for related goods or services, if the use of that trademark or geographical indication is likely to cause confusion, or to cause mistake, or to deceive or risk associating the trademark or geographical indication with the owner of the well-known trademark, or constitutes unfair exploitation of the reputation of the well-known trademark.	See 1052 above (can't cause confusion) - section d Consists of or comprises [an already registered mark], or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: and [the Director may decide whether or not there will be confusion, or cabin the use of trademarks].	Article 16: 1. The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.	Looks like a restatement of current US law. Copies the "likely to cause confusion" language. May be some expansion in the "related goods or services" term, as the US version refers to "used on or in connection with."
2.9	Each Party shall provide a system for the registration of trademarks, which shall include: (a) a requirement to provide to the applicant a communication in writing, which may be provided electronically, of the reasons for a refusal to register a trademark; (b) an opportunity for the applicant to respond to communications from the competent authorities, to contest an initial refusal, and to appeal judicially a final refusal to register; (c) an opportunity for interested parties to oppose a trademark application and to seek cancellation of a trademark registration after it has been granted; and	<b>(1)</b> The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director, and such number of specimens or facsimiles of the mark as used as may be required by the Director. (15 USC 1051(a)(1))	TRIPS 15.5 Members shall publish each trademark either before it is registered or promptly after it is registered and shall afford a reasonable opportunity for petitions to cancel the registration. In addition, Members may afford an opportunity for the registration of a trademark to be opposed.	Doesn't look like much of a change.

	(d) a requirement that decisions in opposition and cancellation proceedings be reasoned and in writing. Written decisions may be provided electronically			
2.10	[requirement of a publicly-available trademark database]			
2.11	a) Formatting of the Database b) goods or services may not be considered as being similar to each other solely on the ground that, in any registration or publication, they are classified in the same class of the Nice Classification. Conversely, each Party shall provide that goods or services may not be considered as being dissimilar from each other solely on the ground that, in any registration or publication, they are classified in different classes of the Nice Classification.		No TRIPs Equivalent	
2.12	Each Party shall provide that initial registration and each renewal of registration of a trademark shall be for a term of no less than ten years.	15 USC 1058(a) <b>Time periods for required affidavits</b> Each registration shall remain in force for 10 years, except that the registration of any mark shall be canceled by the Director unless the owner of the registration files in the United States Patent and Trademark Office affidavits that meet the requirements of subsection (b),	TRIPs 18 Initial registration, and each renewal of registration, of a trademark shall be for a term of no less than seven years. The registration of a trademark shall be renewable indefinitely.	Dials TRIPs up 3 years
2.13	No Party may require recordation of trademark licenses to establish the validity of the license, to assert any rights in a trademark, or for other purposes	Recordation/Registration is not required to assert rights, but can be used to establish a defense. Incontestability; defenses. To the extent that the right to use the registered mark has become incontestable under section 15 <a href="#">[15 USC 1065]</a> , the registration shall be conclusive evidence of the validity of the registered mark and		

		of the registration of the mark, of the registrant's ownership of the mark.... Such conclusive evidence shall relate to the exclusive right to use the mark on or in connection with the goods or services specified [under relevant provisions of US law]		
2.14	[Filing and Processing requirements. Nothing jumps out.]			
2.15	<p>(a) Each Party shall provide that the grounds for refusing protection or recognition of a geographical indication and for allowing opposition to, and cancellation of, a geographical indication shall include the following:</p> <p>(i) the geographical indication is likely to cause confusion with a trademark...</p> <p>(b) For purposes of this section, the date of protection of the geographical indication in a territory of a Party shall be:</p> <p>(i) in the case of protection or recognition provided as a result of an application or petition, the date of such application or petition was filed; and</p> <p>(ii) in the case of protection or recognition provided through other means, the date of protection or recognition specified under the Party's laws.</p>	<p>15 USC 1054</p> <p>Subject to the provisions relating to the registration of trademarks...collective and certification marks, including indications of regional origin, shall be registrable under this Act, in the same manner and with the same effect as are trademarks...and when registered they shall be entitled to the protection provided herein in the case of trademarks.</p>	<p>TRIPS Art. 22</p> <p>2. In respect of geographical indications, Members shall provide the legal means for interested parties to prevent:</p> <p>(a)[misleading designations]</p> <p>(b) any use which constitutes an act of unfair competition within the meaning of Article 10<i>bis</i> of the Paris Convention (1967).</p> <p>3. A Member shall, <i>ex officio</i> if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in that Member is of such a nature as to mislead the public as to the true place of origin.</p>	Appears similar
2.16	<p>If a Party elects to register or otherwise designate any sign as a geographical indication by means other than an ordinary application...that Party must:</p> <p>(a) provide...an opportunity for interested parties to oppose such designations or registrations, and to seek cancellations of such designations or registrations;</p>	Not applicable to US system	Geographical Indicators governed in their own section.	Creates a new procedure for challenging denial of geographical indications if they are governed by a process separate from trademarks. Burdens don't seem high.

	(b) require that decisions in such oppositions and cancellations are reasoned and in writing; and (c) provide that the grounds for such oppositions and cancellations include those set forth in paragraph [15].			
2.17	[Special provision with regard to geographical indications for spirits and wines]			
2.18	For purposes of this Agreement, a term is generic if it is the term customary in common language as the common name for the goods or services associated with the trademark or geographical indication			
2.19	[ Defines the factors to determine whether a party has a right to use a geographic indication]			
2.21	Where a determination is made that a multi-component term is protected as a geographical indication, each Party shall provide the possibility that particular components of the compound term may, be considered generic, based upon the factors set forth in paragraph [19].			
2.22	[Parties shall permit the use of] a geographical area that is not the true place of origin of the services or of the product, provided that: (a) [use is not misleading]; (b) use of the sign or indication does not constitute an act of unfair competition within the meaning of Article 10bis of the Paris Convention (1967); (c) use of the sign or indication would not cause a likelihood of confusion...; and (d) where a request for registration is concerned, the sign or indication is not a generic term			



	for the associated goods or services.			
<b>ARTICLE 3 – DOMAIN NAMES ON THE INTERNET</b>				
{See Flynn et. al. for analysis – note: does not change law but does preclude Parties from determining best practices for domain names}				
<b>ARTICLE 4 – COPYRIGHT AND RELATED RIGHTS</b>				
4.1 [copies]	“Each Party shall provide that authors, performers, and producers of phonograms have the right to authorize or prohibit all reproductions of their works, performances, and phonograms, in any manner or form, permanent or temporary (including temporary storage in electronic form).”	<p>17 USC § 106 – Exclusive rights in copyright works: “... the owner of copyright under this title has the exclusive rights to do and to authorize any of the following: (1) to reproduce the copyrighted work in copies or phonorecords; (2) to prepare derivative works ...; (3) to distribute copies ... to the public by sale or other transfer of ownership, or by rental, lease, or lending; (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.”</p> <p>[temporary storage – caching] 17 USC § 512(b)(1) “Limitation on liability.— A service provider shall not be liable for monetary relief, or, except as provided in subsection (j), for injunctive or other equitable relief, for infringement of copyright by</p>	<p>Berne Convention: Art. 8 Right of Translation; Art. 9 Right of Reproduction; Art. 11 Certain Rights in Dramatic and Musical Works [public performance, etc.]; Art. 11bis Broadcasting and Related Rights; Art. 11ter Certain Rights in Literary Works; Art. 12 Right of Adaptation, Arrangement and Other Alteration; Art. 14 Cinematographic and Related Rights...</p> <p>ACTA Art. 3 “1. This Agreement shall be without prejudice to provisions in a Party’s law governing the availability, acquisition, scope, and maintenance of intellectual property rights. 2. This Agreement does not create any obligation on a Party to apply measures where a right in intellectual property is not protected under its laws and regulations.”</p> <p>TRIPS Section 1 Copyright &amp; Related Rights, Article 9 “1. Members shall comply with Articles 1 through 21 of the Berne Convention (1971) and the Appendix thereto. [except 6bis] 2. Copyright protection shall extend to expressions and not to ideas, procedures, methods of operation or mathematical concepts as such”</p>	<p>4.1 protects rights “in any manner or form” while 106(1) limits rights to “copies or phonorecords”. In addition, 17 USC § 101 defines “copies” as “material objects, other than phonorecords, in which a work is fixed by any method”; a work is “fixed” when it is “is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.” TPP does not define copy, but the “temporary storage” language could indicate a move towards rights over transitory reproductions which US law does not provide for. (Griffin)</p> <p>In the ISP context, at the very least, temporary copies (that is cached) of infringing materials do not subject the ISP to liability. 17 USC § 512 .</p> <p>It is also worth noting that ACTA does not actually define intellectual property rights and instead leaves it up to the Party’s.</p>

		reason of the intermediate and temporary storage of material on a system or network controlled or operated by or for the service provider..."		
4.2 [parallel imports: importing copyrighted work from X where good is at price A, to Y where good is price B]	"Each Party shall provide to authors, performers, and producers of phonograms the right to authorize or prohibit the importation into that Party's territory of copies of the work, performance, or phonogram made without authorization, or made outside that Party's territory with the authorization of the author, performer, or producer of the phonogram."	Involves 17 USC § 109 [effects of transfer of a copy] and § 602(a)(1) [importation] – the law is unsettled. Recently litigated in <i>Costco v. Omega</i> , 541 F.3d 982 (9th Cir. 2008), <i>aff'd</i> 131 S.Ct. 565 (2010) (4-4 split, 9th Circuit limits first-sale doctrine [once good is sold, the copyright owner's right is exhausted] only to goods made in the U.S.)	TRIPS Art. 6 "nothing in this Agreement shall be used to address the issue of the exhaustion of intellectual property rights."  New Zealand lifted a ban on parallel importation in 1998 (Flynn)  NB: Could find no parallel in ACTA  U.S. FTAs negotiated with Australia, Singapore, and Morocco disallow parallel importing of <b>patented</b> products. Subsequent U.S. negotiated FTAs have NOT included this provision, due to language included in the Science, State, Justice, and Commerce, and Related Agencies, Appropriations Act of 2006 (P.L. 109-108), which prohibited the use of such provisions. CRS 34292 p. 28	The Supreme Court heard <i>Kirtsaeng v. John Wiley &amp; Sons</i> on Oct. 29, 2012. At issue: how 109 & 602(a)(1) apply to products with copyrights that were made and legally acquired abroad and then imported to the U.S – in this case textbooks purchased abroad and resold in the U.S. for substantially less, but with the reseller still making a profit. (below: 654 F.3d 120 (2011) – first-sale does not apply to works manufactured outside the U.S.). Decision likely in June, 2013
4.3	"Each Party shall provide to authors, performers, and producers of phonograms the right to authorize or prohibit the making available to the public of the original and copies of their works, performances, and phonograms through sale or other transfer of ownership."			Similar to 4.1
4.4	[balancing authorization requirements with authors and performers - seems uncontroversial]			

<p><b>4.5 [copyright duration]</b></p>	<p>"Each Party shall provide that, where the term of protection of a work (including a photographic work), performance, or phonogram is to be calculated:</p> <p>(a) on the basis of the life of a natural person, the term shall be not less than the life of the author and 70 years after the author's death; and</p> <p>(b) on a basis other than the life of a natural person, the term shall be:</p> <p>(i) not less than 95 years from the end of the calendar year of the first authorized publication of the work, performance, or phonogram, or</p> <p>(ii) failing such authorized publication within 25 years from the creation of the work, performance, or phonogram, not less than 120 years from the end of the calendar year of the creation of the work, performance, or phonogram."</p>	<p>17 USC § 302(a)-(b) "...endures for a term consisting of the life of the author and 70 years after the author's death..."</p> <p>(e) "Presumption as to Author's Death." – that after 95 years from first publication or 120 years after creation the author is presumed dead.</p>	<p>TRIPS Art. 12 "Whenever the term of protection of a work, other than a photographic work or a work of applied art, is calculated on a basis other than the life of a natural person, such term shall be no less than 50 years from the end of the calendar year of authorized publication, or, failing such authorized publication within 50 years from the making of the work, 50 years from the end of the calendar year of making."</p> <p>NB: ACTA includes no copyright duration provision</p>	<p>TPP explicitly makes the 70 years a minimum "not less than" but it is unclear that this would actually change anything in the US. The TPP also does not include a presumption of author's death.</p> <p>TRIPS only provides for 50 years.</p>
<p>4.6</p>	<p>[Party's will apply Art 18 of Berne Convention &amp; 14.6 of TRIPS Agreement to Art 5 &amp; 6]</p>			
<p>4.7</p>	<p>"Each Party shall provide that for copyright and related rights, any person acquiring or holding any economic right in a work, performance, or phonogram:</p> <p>(a) may freely and separately transfer that right by contract; and</p> <p>(b) by virtue of a contract, including contracts of employment underlying the creation of works, performances, and phonograms, shall be able to exercise that right in that person's own name and enjoy fully the</p>	<p>17 USC § 101 contains requirements for "work made for hire"</p>	<p>NB: no comparable ACTA or TRIPS provisions</p>	<p>Question regarding (b) as to whether it would grant authorship to employers or contractors. (Griffin)</p>

	benefits derived from that right."			
4.8	"[Placeholders for provision on (1) exceptions and limitations, (2) Internet retransmission, and (3) any other appropriate copyright/related rights provisions]"			Unknown
<b>ANTI-CIRCUMVENTION Art. 4.9</b>				
			<p>ACTA Art. 27.6 {NB: split up – provided for easier comprehension}</p> <p>“In order to provide the adequate legal protection and effective legal remedies referred to in paragraph 5, each Party shall provide protection at least against:</p> <p>(a) to the extent provided by its law:</p> <p>(i) the unauthorized circumvention of an effective technological measure carried out knowingly or with reasonable grounds to know; and</p> <p>(ii) the offering to the public by marketing of a device or product, including computer programs, or a service, as a means of circumventing an effective technological measure; and</p> <p>(b) the manufacture, importation, or distribution of a device or product, including computer programs, or provision of a service that:</p> <p>(i) is primarily designed or produced for the purpose of circumventing an effective technological measure; or</p> <p>(ii) has only a limited commercially significant purpose other than circumventing an effective technological measure.”</p>	NB: TRIPS has nothing on anti-circumvention, but WIPO does.

4.9(a)	“ In order to provide adequate legal protection and effective legal remedies against the circumvention of effective technological measures that authors, performers, and producers of phonograms use in connection with the exercise of their rights and that restrict unauthorized acts in respect of their works, performances, and phonograms, each Party shall provide that any person who:”	17 USC § 1201 [Circumvention of copyright protection systems]; 1202 [Integrity of copyright management information]; 1203 [Civil remedies]; 1204 [Criminal offenses and penalties]	WIPO Art. 11: “Contracting Parties shall provide adequate legal protection and effective legal remedies against the circumvention of effective technological measures that are used by authors in connection with the exercise of their rights...and that restrict acts, in respect of their works, which are not authorized by the authors concerned or permitted by law.”  ACTA 27.6 ““In order to provide the adequate legal protection and effective legal remedies referred to in paragraph 5, each Party shall provide protection at least against:”  NB: TRIPS contains no language on anti-circumvention	Largely the same as the USC’s anticircumvention provisions  NB: the structure of ACTA’s anticircumvention provision is quite different from the TPP (see row above). In addition, ACTA, requires knowledge (Art. 27.6(a)(ii))
4.9(a)(i)	“circumvents without authority any effective technological measure that controls access to a protected work, performance, phonogram, or other subject matter; or”	17 USC § 1201 does not include a knowledge requirement.	KORUS Art. 18.4.7(a)(i) “knowingly, or having reasonable grounds to know, circumvents without authority any effective technological measure that controls access to a protected work, performance, phonogram, or other subject matter; or”	TPP does not include a knowledge requirement – indicating that one could violate even without intent to circumvent. (Flynn) This expands on the provision in KORUS that does require knowledge. However, one may be liable under U.S. law without knowledge of circumvention.
4.9(a)(ii)	“manufactures, imports, distributes, offers to the public, provides, or otherwise traffics in devices, products, or components, or offers to the public or provides services, that:”	17 USC § 1201(a) “(2) No person shall manufacture, import, offer to the public, provide, or otherwise traffic in any technology, product, service, device, component, or part thereof, that—“	ACTA Art. 27.6 “(a) to the extent provided by its law: (i) the unauthorized circumvention of an effective technological measure carried out knowingly or with reasonable grounds to know; and (ii) the offering to the public by marketing of a device or product, including computer programs, or a service, as a means of circumventing an effective	

			technological measure; and (b)the manufacture, importation, or distribution of a device or product, including computer programs, or provision of a service that:"	
4.9(a)(ii) (A)	"are promoted, advertised, or marketed by that person, or by another person acting in concert with that person and with that person's knowledge, for the purpose of circumvention of any effective technological measure,"	17 USC § 1201(a)(2) "(C) is marketed by that person or another acting in concert with that person with that person's knowledge for use in circumventing a technological measure that effectively controls access to a work protected under this title."		TPP includes promotion and advertising, rather than just marketing – but whether this would actually impact the law remains to be seen.
4.9(a)(ii)(B)	"have only a limited commercially significant purpose or use other than to circumvent any effective technological measure, or"	1201(a)(2) "(B) has only limited commercially significant purpose or use other than to circumvent a technological measure that effectively controls access to a work protected under this title; or"	ACTA Art. 27.6(b)(ii) "has only a limited commercially significant purpose other than circumventing an effective technological measure."	No real difference
<b>4.9(a)(ii)(C)</b>	"are primarily designed, produced, or performed for the purpose of enabling or facilitating the circumvention of any effective technological measure,"	17 USC § 1201(a)(2) "... any technology, product, service, device, component, or part thereof, that— (A) is primarily designed or produced for the purpose of circumventing a technological measure that effectively controls access to a work protected under this title;"	ACTA Art. 27.6(b)(i) "is primarily designed or produced for the purpose of circumventing an effective technological measure; or"  SOPA 102(c)(4)(D) defines circumvention measures to include those that are "designed or marketed to enable a domain name describe in such an order – (i) to resolve to that domain name's Internet protocol address...; or (ii)" [to resolve to an address that the circumvention provider knows or reasonably should know is being used by a site offering infringing content]	US law: "produced for the purpose of" vs. TPP: "enabling or facilitating...circumvention"; this could expand activity that violates the anti-circumvention provisions.

4.9(a)	<p>“shall be liable and subject to the remedies set out in Article [12.12]. Each Party shall provide for criminal procedures and penalties to be applied when any person, other than a nonprofit library, archive, educational institution, or public noncommercial broadcasting entity, is found to have engaged willfully and for purposes of commercial advantage or private financial gain in any of the foregoing activities. Such criminal procedures and penalties shall include the application to such activities of the remedies and authorities listed in subparagraphs (a), (b), and (f) of Article [15.5] as applicable to infringements, <i>mutatis mutandis</i>.”</p>	<p>17 USC § 1204 “(a) In General.— Any person who violates section 1201 or 1202 willfully and for purposes of commercial advantage or private financial gain—  (1) shall be fined not more than \$500,000 or imprisoned for not more than 5 years, or both, for the first offense; and  (2) shall be fined not more than \$1,000,000 or imprisoned for not more than 10 years, or both, for any subsequent offense.”</p>	<p>ACTA Art. 27.5 “Each Party shall provide adequate legal protection and effective legal remedies against the circumvention of effective technological measures that are used by authors, performers or producers of phonograms in connection with the exercise of their rights in, and that restrict acts in respect of, their works, performances, and phonograms, which are not authorized by the authors, the performers or the producers of phonograms concerned or permitted by law.”</p>	<p>NB: see more on 12.12 and 15.5 below.</p> <p>TPP Art 12.12 “...judicial authorities shall, at the least, have the authority to: (b) provide an opportunity for the right holder to elect between actual damages it suffered....or pre-established damages;” ...[goes on to exclude libraries, etc. &amp; unknowing violaters from damages] which is commensurate with 17 USC § 1203(c)(5) [contrary to Griffin’s analysis]</p> <p>Art 15.5(a) specifies that Parties shall provide “penalties that include sentences of imprisonment <i>as well as</i> monetary fines sufficiently high to provide a deterrent...” (italics added). 1204 contains no requirement that both imprisonment and fines be used, but does provide for the option of both.</p>
4.9(b)	<p>“In implementing subparagraph (a), no Party shall be obligated to require that the...product provide for a response to any particular technological measure, so long as the product does not otherwise violate any measures implementing subparagraph (a).”</p>			
4.9(c)	<p>“Each Party shall provide that a violation of a measure implementing this paragraph is a separate cause of action, independent of any infringement that might occur under the Party’s law on copyright and related rights.”</p>	<p><i>Compare MDY v. Blizzard</i>, (9th Cir. 2010) (no traditional copyright infringement is required to violate 1201(a) because it creates a new right to prevent circumvention of access controls) <i>with Chamberlain Group v. Skylink Tech.</i>, 381 F.3d 1178 (Fed. Cir. 2004) (finding that circumvention is not infringement in itself and that for 1201(a) to be violated, a copyright right must</p>		<p>Seems to adopt <i>MDY</i>, although <i>MDY</i> also seemed to indicate that 1201 created an access control right. <i>MDY</i> makes it easier to prove a 1201 violation because one need only prove circumvention of access control measures.</p>

		actually be infringed – “infringement nexus requirement”)		
4.9(d)	<p>[Exceptions and limitations on measures implementing 4.9(a) are confined to the following activities {e.g. can allow for anticircumvention in only the following cases}:  (i) reverse engineering  (ii) research on flaws and vulnerabilities  (iii) components that protect minors  (iv) authorized computer security testing  (v) Identifying and disabling a capability to carry out undisclosed collection or dissemination of personally identifying information [vi] gov activities]  (vii) “noninfringing uses of a work, performance, or phonogram in a particular class of works, performances, or phonograms when an actual or likely adverse impact on those noninfringing uses is demonstrated in a legislative or administrative proceeding by <u>substantial evidence</u>; provided that any limitation or exception adopted in reliance upon this clause shall have effect for a renewable period of not more than three years from the date of conclusion of such proceeding.” (underlining added)</p>	<p><u>Corresponding with 4.9(d)(vii)</u> – 17 USC § 1201(a)(1)(C) governs the Librarian’s exemption recommendation process. The Librarian considers: “whether persons who are users of a copyrighted work are, or are likely to be in the succeeding 3-year period, adversely affected by the prohibition under subparagraph (A) in their ability to make noninfringing uses under this title of a particular class of copyrighted works.”  73 FR 58075 (2008), discussing burden of proof and stating that “proponents of an exemption bear the burden of providing sufficient evidence under this standard to support an exemption. How much evidence is sufficient will vary with the factual context of the alleged harm.”  77 FR 65261 (2012) “A proponent may not rely on speculation to support a proposed class, but instead must show by a preponderance of evidence that the alleged harm to noninfringing uses is more likely than not to occur during the next three years. The harm must be distinct and measurable, and more than <i>de minimis</i>.”</p>	<p>ACTA: “In providing adequate legal protection and effective legal remedies pursuant to the provisions of paragraphs 5 and 7, a Party may adopt or maintain appropriate limitations or exceptions to measures implementing the provisions of paragraphs 5, 6, and 7.”</p>	<p>4.9(d) &amp; ACTA – TPP’s specificity prevents other nations from determining their own exceptions and limitations. (Flynn)  Griffin argues that this will raise the standard in determining exemptions (from sufficient evidence to substantial evidence).  [However, given the more recent discussion by the Librarian in 77 FR 65261, “preponderance of the evidence” may be the new standard (or simply an elaboration on “sufficient evidence”). ]</p>
4.9(e)	[how application of (a) and the exceptions in (d) work]			



**RIGHTS MANAGEMENT INFORMATION**

<p>4.10(a) [see 4.10(c) for definition of rights management]</p>	<p>[anyone who (i) knowingly removes/alters RMI; (ii) distributes/imports RMI knowing it has been removed/alters; (iii) “distributes, imports for distribution, broadcasts, communicates or makes available to the public copies of works, performances, or phonograms knowing that [RMI] has been removed or altered without authority”; shall be liable &amp; subject to 12.12]</p>	<p>17 USC § 1202(b)(3) “distribute, import for distribution, or publicly perform works, copies of works, or phonorecords, knowing that copyright management information has been removed or altered without authority of the copyright owner or the law,”</p>	<p>ACTA 27.2 “To protect electronic rights management information, each Party shall provide adequate legal protection and effective legal remedies against any person knowingly performing without authority any of the following acts knowing, or with respect to civil remedies, having reasonable grounds to know, that it will induce, enable, facilitate, or conceal an infringement of any copyright or related rights: (a) to remove or alter any electronic rights management information; (b) to distribute, import for distribution, broadcast, communicate, or make available to the public copies of works, performances, or phonograms, knowing that electronic rights management information has been removed or altered without authority.”</p> <p>NB: no relevant TRIPS provision</p>	<p>4.10(a)(iii) expands 1202(b)(3) prohibition to include broadcasting, communication, and making available. (Griffin)</p> <p>4.10(a)(iii) is almost identical to ACTA 27.2(b).</p>
<p>4.10(b)</p>	<p>[exceptions to (a) only for government purposes]</p>			
<p>4.10(c)</p>	<p>“Rights management information means: (i) information that identifies a work, performance, or phonogram; the author of the work, the performer of the performance, or the producer of the phonogram; or the owner of any right in the work, performance, or phonogram; (ii) information about the terms and conditions of the use of the work, performance, or phonogram; or (iii) any numbers or codes that represent such information, when</p>	<p>17 USC § 1202 “(c) Definition.— As used in this section, the term “copyright management information” means any of the following information conveyed in connection with copies or phonorecords of a work or performances or displays of a work, including in digital form, except that such term does not include any personally identifying information about a user of a work or of a copy, phonorecord, performance, or display of a work:” [(1)-(3)identifying information</p>	<p>ACTA FN16 “for the purposes of this Article, rights management information means: (a) information that identifies the work, the performance, or the phonogram; the author of the work, the performer of the performance, or the producer of the phonogram; or the owner of any right in the work, performance, or phonogram; (b) information about the terms and conditions of use of the work, performance, or phonogram; or (c) any numbers or codes that represent the information</p>	<p>4.10(c) does not include 1202(c)(4) &amp; (5)’s exceptions for public performances on radio and television broadcast stations.</p>

	<p>any of these items is attached to a copy of the work, performance, or phonogram or appears in connection with the communication or making available of a work, performance or phonogram, to the public.”</p>	<p>including title, author, etc.]  “(4) With the exception of public performances of works by radio and television broadcast stations, the name of, and other identifying information about, a performer whose performance is fixed in a work other than an audiovisual work.  (5) With the exception of public performances of works by radio and television broadcast stations, in the case of an audiovisual work, the name of, and other identifying information about, a writer, performer, or director who is credited in the audiovisual work.  (6) Terms and conditions for use of the work.  (7) Identifying numbers or symbols referring to such information or links to such information.  (8) Such other information as the Register of Copyrights may prescribe by regulation, except that the Register of Copyrights may not require the provision of any information concerning the user of a copyrighted work.”</p>	<p>described in (a) and (b) above; when any of these items of information is attached to a copy of a work, performance, or phonogram, or appears in connection with the communication or making available of a work, performance, or phonogram to the public”</p> <p>NB: no relevant TRIPS provision</p>	
<b>DISTRIBUTION RIGHT</b>				
<p>5</p>	<p>“Without prejudice to Articles 11(1)(ii), 11<i>bis</i>(1)(i) and (ii), 11<i>ter</i>(1)(ii), 14(1)(ii), and 14<i>bis</i>(1) of the Berne Convention, each Party shall provide to authors the exclusive right to authorize or prohibit the communication to the public of their works, by wire or wireless means, including the <i>making available</i> to the public of their works in such a way that members of the public may access these works from a place and at a</p>	<p>17 USC § 106 “Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:…  (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;…”</p>	<p>TRIPS Art. 9.1 “Members shall comply with Articles 1 through 21 of the Berne Convention (1971) and the Appendix thereto…” (see 4.1 above)</p> <p>NB: ACTA doesn’t really have any articles defining the scope of copyright. See Article 3 “This Agreement shall be without prejudice to provisions in a Party’s law governing the availability, acquisition, scope, and maintenance of intellectual</p>	<p>Griffin notes that there is a circuit split on whether 106(3) includes a “‘making available’ right absent actual transfer”. However, this does not seem to be a legally significant split as it is confined to the district courts. Most cases that address the theory determine that “making available” is not included in the distribution rights.</p> <p>RIAA has argued that “making available” a copy (without actually copying it) is itself</p>

	<p>time individually chosen by them.” (italics added)</p>		<p>property rights.”</p>	<p>copyright infringement. The best support for this argument lies in <i>Hotaling v. Church of Jesus Christ of Latter-Day Saints</i>, 118 F.3d 199 (4th Cir. 1997) (holding that an owner of a collection of works may have distributed the works if he makes them available to the public). This has been rejected in the cases in which the RIAA has used the theory, for example. <i>Elektra v. Baker</i>, 551 F. Supp. 2d 234, 243 (SDNY 2008) (while rejecting “making available”, noting that the 106(3) distribution right may be infringed by the offer to distribute copies), <i>Atlantic v. Howell</i>, 554 F. Supp. 2d 976, 983 (D. Ariz. 2008) (stating that 106(3) “is not violated unless the defendant has actually distributed...”.) <i>Capitol v. Thomas</i>, 692 F.3d 899 (8th Cir. 2012) (declining to issue an opinion on the “making available” issue, but noting that there is a district court split)</p> <p>For more on “making available” jurisprudence in the United States see Diana Sterk (student note) “P2P File-Sharing and the Making Available War”.</p> <p>By criminalizing streaming (with financial gain), S.978 arguably codifies a limited “making available” right.</p>
--	---	--	--------------------------	--

**RELATED RIGHTS**

6.1	<p>“Each Party shall accord the rights provided for in this Chapter with respect to performers and producers of phonograms to the performers and producers of phonograms who are nationals of another Party and to performances or phonograms first published or first fixed in the territory of another Party. A performance or phonogram shall be considered first published in the territory of a Party in which it is published within 30 days of its original publication.”</p>		<p>KORUS Art. 18.6 “Related Rights”</p> <p>TRIPS {not quite analogous} Art. 14.5 “The term of the protection available...a period of 50 years computed from the end of the calendar year in which the fixation was made or the performance took place. The term of protection granted pursuant to paragraph 3 shall last for at least 20 years from the end of the calendar year in which the broadcast took place.”</p> <p>NB: ACTA has no analogous provision</p>	<p>6.1 adds an original publication date, while KORUS Art. 18.6 makes no mention of first publication. (Flynn)</p>
6.2	[performer’s rights RE unfixed performances]			
6.3	<p>“(a) Each Party shall provide to performers and producers of phonograms the right to authorize or prohibit the broadcasting and any communication to the public of their performances or phonograms, by wire or wireless means, including the making available to the public of those performances and phonograms in such a way that members of the public may access them from a place and at a time individually chosen by them.” (b) [Party can provide exceptions/limitations for radio, similar transmission]</p>		<p>WPPT Art. 10 [Making Available Fixed Performances] “Performers shall enjoy the exclusive right of authorizing the making available to the public of their performances fixed in phonograms, by wire or wireless means, in such a way that members of the public may access them from a place and at a time individually chosen by them.”</p> <p>TRIPS Article 14: Protection of Performers, Producers of Phonograms (Sound Recordings) and Broadcasting Organizations. NB: Art. 14.2 Producers of Phonograms have “the right to authorize or prohibit the direct or indirect reproduction of their phonograms”</p> <p>NB: ACTA has no analogous provision.</p>	<p>TPP adds “producers of phonograms” language. (Flynn)</p>
6.4	“No Party may subject the			

	enjoyment and exercise of the rights of performers and producers of phonograms provided for in this Chapter to any formality.”			
6.5	[definitions including: broadcasting, communication to the public, fixation, performers, phonogram, producer of a phonogram, publication of a performance or a phonogram] <b>“broadcasting</b> means the transmission to the public by wireless means or satellite of sounds or sounds and images, or representations thereof, including wireless transmission of encrypted signals where the means for decrypting are provided to the public by the broadcasting organization or with its consent; “broadcasting” does not include transmissions over computer networks or any transmissions where the time and place of reception may be individually chosen by members of the public” (emphasis added)	17 USC § 114 Scope of Exclusive rights in sound recordings (j) “(3) A “broadcast” transmission is a transmission made by a terrestrial broadcast station licensed as such by the Federal Communications Commission.”	KORUS 18.6(5)(a) “broadcasting means the transmission to the public by wireless means or satellite of sounds or sounds and images, or representations thereof, including wireless transmission of encrypted signals where the means for decrypting are provided to the public by the broadcasting organization or with its consent; “broadcasting” does not include transmissions over computer networks or any transmissions where the time and place of reception may be individually chosen by members of the public;”  Neither ACTA nor TRIPS have analogous provisions.	According to Griffin, the Copyright Act does not define broadcasting beyond 17 USC 114 which is about compulsory licenses.  Identical to the KORUS definition.  NB: Flynn et al erroneously state that KORUS does not include the “does not include transmissions over computer networks” language.
7	“Protection of Encrypted Program-Carrying Satellite and Cable Signals”			
<b>PATENT</b>				
35 USC § 101 Inventions Patentable. “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”				
NB: under TRIPS, software is treated as a literary work. Art. 10.1 “Computer programs, whether in source or object code, shall be protected as literary works under the Berne Convention (1971)”				

8.1	<p>“Each Party shall make patents available for any invention, whether a product or process, in all fields of technology, provided that the invention is new, involves an inventive step, and is capable of industrial application. In addition, the Parties confirm that: patents shall be available for any <u>new forms, uses, or methods of using a known product</u>; and a new form, use, or method of using a known product may satisfy the criteria for patentability, <u>even if such invention does not result in the enhancement of the known efficacy of that product.</u>” (underlining added)</p>	35 USC 101 “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”	<p>TRIPS Art. 27.1 “Subject to the provisions of paragraphs 2 and 3, patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application”</p> <p>NB: <u>ACTA does not cover patents.</u></p>	<p>Flynn et al notes that this section is most relevant to pharmaceutical patents, and highlights that “new form, use, or method” regardless of efficacy language is substantially more expansive than TRIPS. This could also apply to software as software and other technologies have been recognized as patentable, specifically, a “process, machine, manufacture or composition of matter” 35 USC § 101.</p> <p>See Flynn et. al. for detail on impacted countries, including the argument that this section is primarily directed at India (not a TPP member).</p> <p>NB: useful is “a requirement that is satisfied if the invention is operable and provides a tangible benefit.”  <a href="http://www.ipmall.info/hosted_resources/crs/R40378_011410.pdf">http://www.ipmall.info/hosted_resources/crs/R40378_011410.pdf</a>  ] TPP could run into problems of “newness” and “non-obviousness” given its definition (ipmall at 6)</p> <p>Does not seem problematic given US law – see “improvement patents” which can be an addition or a substitution but do not necessarily “enhance the efficacy”  <a href="http://www.nolo.com/legal-encyclopedia/improvement-patents-new-use-patents-30250.html">http://www.nolo.com/legal-encyclopedia/improvement-patents-new-use-patents-30250.html</a></p>
8.1 FN 15	“For the purposes of this Article, a Party may treat the terms “inventive step” and “capable of industrial application” as being synonymous with the terms “non-		TRIPS FN5: “For the purposes of this Article, the terms “inventive step” and “capable of industrial application” may be deemed by a Member to be synonymous with	

	obvious" and "useful," respectively. In determinations regarding inventive step (or non-obviousness), each Party shall consider whether the claimed invention would have been obvious to a skilled artisan (or a person having ordinary skill in the art) at the priority date of the claimed invention."		the terms "non-obvious" and "useful" respectively"	
8.2	[plants, medicine related]			
8.3	[limitations on what can be excluded from patentability]			
8.4	[limited exceptions to exclusive rights conferred by patent allowed]			
8.5 [sep]	[pharmaceuticals]			
8.6 [sep]	[patent processing, term adjustment]			
8.7 [Revocation of Patents]	"Each Party shall provide that a patent may be revoked only on grounds that would have justified a refusal to grant the patent. A Party may also provide that fraud, misrepresentation or inequitable conduct may be the basis for revoking a patent or holding a patent unenforceable. Where a Party provides proceedings that permit a third party to oppose the grant of a patent, a Party shall not make such proceedings available before the grant of the patent."	CRS lays out the law really well (the USC provisions themselves just set forth administrative rules) <a href="http://www.ipmall.info/hosted_resources/crs/R40378_011410.pdf">http://www.ipmall.info/hosted_resources/crs/R40378_011410.pdf</a>  <a href="http://en.wikipedia.org/wiki/Reexamination#Notable_reexaminations">http://en.wikipedia.org/wiki/Reexamination#Notable_reexaminations</a>	TRIPS Art. 32 "An opportunity for judicial review of any decision to revoke or forfeit a patent shall be available."	As Flynn et. al. note, TRIPS contains no limitation on grounds for revocation, only that there be an opportunity for judicial review.
8.8	[public disclosure info – disregard of]			
8.9 [amendments]	"Each Party shall provide patent applicants with at least one opportunity to make amendments, corrections, and observations in connection with their applications. Each Party shall permit applicants to make amendments to their patent claims prior to receipt of a first		KORUS 18.8.8 "Each Party shall provide patent applicants with at least one opportunity to make amendments, corrections, and observations in connection with their applications."  NB: TRIPS has no analogous provision.	TPP seems to allow for multiple (perhaps unlimited) amendments, since applicants may amend prior to receipt of a first patent office action or communication. This language is not included in KORUS or TRIPS (which does not include a section on patent amendment).

	patent office action or communication on the merits.”			
8.10 [disclosure sufficiency]	“Each Party shall provide that a disclosure of a claimed invention shall be considered to be sufficiently clear and complete if it provides information that allows the invention to be made and used by a person skilled in the art, without undue experimentation, as of the filing date.”	35 USC § 112 (a) “The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the <u>best mode</u> contemplated by the inventor or joint inventor of carrying out the invention.” (underlining added)	TRIPS Art. 29 “Members shall require that an applicant for a patent shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art and may require the applicant to indicate the <u>best mode</u> for carrying out the invention known to the inventor at the filing date or, where priority is claimed, at the priority date of the application.” (underlining added)	TRIPS and US law include “best mode” language that the TPP does not have. The “best mode” requirement ensures that the patent-holder reveals the best use of the patent to the public, rather than the second-best, for example.  Purpose of “best mode”: “There always exists, on the part of some people, a selfish desire to obtain patent protection without making a full disclosure, which the law, in the public interest, must guard against. Hence section 112 calls for description in "full, clear, concise, and exact terms" and the "best mode" requirement does not permit an inventor to disclose only what he knows to be his second-best embodiment, retaining the best for himself.” <i>In re Nelson</i> , 280 F.2d 172 (CCPA 1960)
8.11 [disclosure support]	“Each Party shall provide that a claimed invention is sufficiently supported by its disclosure if the disclosure reasonably conveys to a person skilled in the art that the applicant was in possession of the claimed invention as of the filing date.”		NB: TRIPS has no analogous provision.	
8.12	[industrially applicable if...]			
8.13	[info available about patents]			
<b>ARTICLE 9 – MEASURES RELATING TO CERTAIN REGULATED PRODUCTS</b>				
9.1	[Agricultural Chemical Products]			
9.2-11 (Sep)	[Pharmaceutical Products] See Flynn et. al. for analysis			



<b>Article 10 – GENERAL OBLIGATIONS RELATING TO ENFORCEMENT</b>				
10.1	[distribution of enforcement resources unrelated to req that this chapter be enforced]			
10.2 [presumptions of holder & rights]	“In civil, administrative, and criminal proceedings involving copyright or related rights, each Party shall provide for a presumption that, in the absence of proof to the contrary, the person whose name is indicated in the usual manner as the author, producer, performer, or publisher of the work, performance, or phonogram is the designated right holder in such work, performance, or phonogram. Each Party shall also provide for a presumption that, in the absence of proof to the contrary, the copyright or related right subsists in such subject matter. In civil, administrative, and criminal proceedings involving trademarks, each Party shall provide for a rebuttable presumption that a registered trademark is valid...”	17 USC § 401 – Notice of copyright: Visually perceptible copies [describing the form, position and evidentiary weight of notices for work that is copyrighted] “(d) Evidentiary Weight of Notice. If a notice of copyright in the form and position specified by this section appears on the published copy or copies to which a defendant in a copyright infringement suit had access, then no weight shall be given to such a defendant’s interposition of a defense based on innocent infringement”; § 402 [same information, but for sound recordings]; § 403 Publications incorporating United States Government works	NB: Neither TRIPS nor ACTA have an analogous provision.	According to Griffin, these presumptions do not exist in U.S. Copyright law.  As it relates to infringement, fulfilling notice requirements under US law relates to the defense of innocent infringement. (Griffin)
Article 11: enforcement practices, publicizing data, etc.				
<b>ARTICLE 12 – REMEDIES &amp; PROCEDURES</b>				
12.1	[civil judicial procedures available]			
12.2	[injunctions consistent with TRIPS Art. 44]			Flynn et. al. note that the 12.2 is a “watered down” version of the ACTA provision (Art 8.1)
12.3(a)	“in civil judicial proceedings, its judicial authorities shall have the authority to order the infringer to pay the right holder: (i) damages adequate to compensate for the injury the right holder has suffered as a result of the infringement,18 and	17 USC § 504 “(b) Actual Damages and Profits.— The copyright owner is entitled to recover the actual damages suffered by him or her as a result of the infringement, and any profits of the infringer that are attributable to the infringement and are not taken into account in computing the	TRIPS Art. 45.1 “The judicial authorities shall have the authority to order the infringer to pay the right holder damages adequate to compensate for the injury the right holder has suffered because of an infringement of that person’s intellectual	NB: Flynn et al state that 12.3 mandates compensatory damages in excess of the amount judged adequate (12.3(a)(i)), this does not seem supported by the 12.3 text. This section comports with U.S. law which also provides for lost profits in addition to damages.

	<p>(ii) at least in the case of copyright or related rights infringement and trademark counterfeiting, the profits of the infringer that are attributable to the infringement and that are not taken into account in computing the amount of the damages referred to in clause (i).”</p>	<p>actual damages.”</p>	<p>property right by an infringer who knowingly, or with reasonable grounds to know, engaged in infringing activity.”</p> <p>ACTA Art. 9.1 “...in civil judicial proceedings concerning the enforcement of intellectual property rights, its judicial authorities have the authority to order the infringer who, knowingly or with reasonable grounds to know, engaged in infringing activity to pay the right holder damages adequate to compensate for the injury the right holder has suffered as a result of the infringement. In determining the amount of damages for infringement of intellectual property rights, a Party’s judicial authorities shall have the authority to consider, inter alia, any legitimate measure of value the right holder submits, which may include lost profits, the value of the infringed goods or services measured by the market price, or the suggested retail price.” Art. 9.2 provides for lost profits in cases of copyright or related rights infringement and trademark counterfeiting.</p>	<p>The TRIPS language is less explicit than 12.3(a), and thus may not necessarily include profits in the damage calculation. Also, TRIPS requires “knowing” infringement, while 12.3 has no knowledge requirement.</p>
<p>12.3(b) [market value]</p>	<p>“... in determining damages for infringement of intellectual property rights, its judicial authorities shall consider, <i>inter alia</i>, the value of the infringed good or service, measured by the suggested retail price or other legitimate measure of value submitted by the right holder.”</p>	<p>See above (17 USC § 504(b))</p>	<p>ACTA Art. 9 Damages “In determining the amount of damages for infringement of intellectual property rights, a Party’s judicial authorities shall have the authority to consider, inter alia, any legitimate measure of value the right holder submits, which may include lost profits, the value of the infringed goods or services measured by the</p>	<p><i>Frank Music Corp v. Metro-Goldwyn-Mayer, Inc.</i>, 772 F.2d 505, 512 (9th Cir. 1985) notes that the 9th Circuit test for market value in the actual damages context is “what a willing buyer would have been reasonably required to pay to a willing seller for plaintiffs’ work” quoting <i>Krofft I</i>, 562 F.2d 1157, 1174.</p> <p>Flynn et al note that this</p>

			<p>market price, or the suggested retail price”</p> <p>NB: TRIPS does not have an analogous provision.</p>	<p>calculation method ignores “exclusionary pricing” in developing countries (i.e. that few people in these countries would pay \$15 for a CD), thus overcompensating right owners. See Flynn for more.</p>
12.4	<p>“In civil judicial proceedings, each Party shall, at least with respect to works, phonograms, and performances protected by copyright or related rights, and in cases of trademark counterfeiting, establish or maintain a system that provides for pre-established damages, which shall be available upon the election of the right holder. Pre-established damages shall be in an amount <u>sufficiently high to constitute a deterrent to future infringements</u> and to compensate fully the right holder for the harm caused by the infringement. In civil judicial proceedings concerning patent infringement, each Party shall provide that its judicial authorities shall have the authority to increase damages to an amount that is up to three times the amount of the injury found or assessed.” (underlining added)</p>	<p>17 USC § 504(c) provides for pre-established (statutory) damages, with higher possible damages if willful (2)</p> <p>35 USC § 284 – allows for treble damages for patent infringement</p>	<p>ACTA Art. 9.3 “At least with respect to infringement of copyright or related rights protecting works, phonograms, and performances, and in cases of trademark counterfeiting, each Party shall also establish or maintain a system that provides for one or more of the following:  (a) pre-established damages; or  (b) presumptions for determining the amount of damages sufficient to compensate the right holder for the harm caused by the infringement; or  (c) at least for copyright, additional damages.”</p> <p>TRIPS Art. 45.2 {not quite analogous} “In appropriate cases, Members may authorize the judicial authorities to order recovery of profits and/or payment of pre-established damages even where the infringer did not knowingly, or with reasonable grounds to know, engage in infringing activity.</p>	<p>There is no requirement in 504(c) that damages be sufficiently high to operate as a deterrent. (Griffin)  In addition, higher damages are only allowed for willful violations – there is no such limiting language for 12.4.</p> <p>ACTA makes pre-established one possible method. As Flynn et al note, pre-established damages are not used in every copyright system.</p> <p>TRIPS makes no comment on creating pre-established damages, simply that where they exist, they may be used.</p>

12.5	“Each Party shall provide that its judicial authorities, except in exceptional circumstances, have the authority to order, at the conclusion of civil judicial proceedings..., that the prevailing party shall be awarded payment by the losing party of court costs or fees and, at least in proceedings concerning copyright or related rights infringement or willful trademark counterfeiting, reasonable attorney’s fees...[same for patents].”	17 USC § 505 “In any civil action under this title, the court in its discretion may allow the recovery of full costs by or against any party other than the United States or an officer thereof. Except as otherwise provided by this title, the court may also award a reasonable attorney’s fee to the prevailing party as part of the costs.”	ACTA Art. 9.5 “Each Party shall provide that its judicial authorities, where appropriate, have the authority to order, at the conclusion of civil judicial proceedings concerning infringement of at least copyright or related rights, or trademarks, that the prevailing party be awarded payment by the losing party of court costs or fees and appropriate attorney’s fees, or any other expenses as provided for under that Party’s law.”  TRIPS Art. 45.2 “The judicial authorities shall also have the authority to order the infringer to pay the right holder expenses, which may include appropriate attorney’s fees. In appropriate cases, Members may authorize the judicial authorities to order recovery of profits and/or payment of pre-established damages even where the infringer did not knowingly, or with reasonable grounds to know, engage in infringing activity.”	TRIPS notes that expenses <i>may</i> include appropriate attorney’s fees. US law is also discretionary. Similarly, ACTA provides that costs may be awarded “where appropriate”. 12.5 on the other hand seems to make payment of attorney’s fees is the norm.
12.6	[authorities shall have authority to seize unlawful/allegedly infringing goods]			
<b>REMEDIES</b>				
12.7	“Each Party shall provide that in civil judicial proceedings:”			
12.7(a)	“at the right holder’s request, goods that have been found to be pirated or counterfeit shall be destroyed, except in exceptional circumstances;”		TRIPS Art. 46 “In order to create an effective deterrent to infringement, the judicial authorities shall have the authority to order that goods that they have found to be infringing be, without compensation of any sort, disposed of outside the channels of commerce in such a	12.7(a) sets destruction as the norm. TRIPS, on the other hand, allows simply for disposing of the goods – not necessarily destruction. ACTA, similarly, while providing for destruction, makes it discretionary (by giving authorities the ability to destroy, but not mandating).

			<p>manner as to avoid any harm caused to the right holder, or, unless this would be contrary to existing constitutional requirements, destroyed...”</p> <p>ACTA Art. 10.1 “At least with respect to pirated copyright goods and counterfeit trademark goods, each Party shall provide that, in civil judicial proceedings, at the right holder’s request, its judicial authorities have the authority to order that such infringing goods be destroyed, except in exceptional circumstances, without compensation of any sort.”</p>	
12.7(b)	<p>“its judicial authorities shall have the authority to order that materials and implements that have been used in the manufacture or creation of such pirated or counterfeit goods be, without compensation of any sort, promptly destroyed or, in exceptional circumstances, without compensation of any sort, disposed of outside the channels of commerce in such a manner as to minimize the risks of further infringements; and”</p>	<p>17 USC § 503 “(b) As part of a final judgment or decree, the court may order the destruction or other reasonable disposition of all copies or phonorecords found to have been made or used in violation of the copyright owner’s exclusive rights, and of all plates, molds, matrices, masters, tapes, film negatives, or other articles by means of which such copies or phonorecords may be reproduced.”</p>	<p>TRIPS Art. 46 “...The judicial authorities shall also have the authority to order that materials and implements the predominant use of which has been in the creation of the infringing goods be, without compensation of any sort, disposed of outside the channels of commerce in such a manner as to minimize the risks of further infringements...”</p> <p>ACTA Art. 10.2 “Each Party shall further provide that its judicial authorities have the authority to order that materials and implements, the predominant use of which has been in the manufacture or creation of such infringing goods, be, without undue delay and without compensation of any sort, destroyed or disposed of outside the channels of commerce in such a manner as to minimize the risks of further infringements.”</p>	<p>12.7(b)’s “materials and implements” language seems broader than 503(b) which is more specific about what goods may be destroyed. TRIPS is also less broad, and limits destruction to those goods predominantly used in the creation of infringing goods. ACTA similarly includes “the predominant use of which” language missing from 12.7(b).</p>

12.7(c)	“in regard to counterfeit trademarked goods, the simple removal of the trademark unlawfully affixed shall not be sufficient to permit the release of goods into the channels of commerce.”		<p>TRIPS Art. 46 “In regard to counterfeit trademark goods, the simple removal of the trademark unlawfully affixed shall not be sufficient, other than in exceptional cases, to permit release of the goods into the channels of commerce.”</p> <p>ACTA Art. 20.2 “In regard to counterfeit trademark goods, the simple removal of the trademark unlawfully affixed shall not be sufficient, other than in exceptional cases, to permit release of the goods into the channels of commerce.”</p>	TRIPS is slightly more permissive here, in that it allows for “exceptional cases” which 12.7(c) does not. NB: ACTA Art. 20.2 is closer to TRIPS than 12.7(c).
12.8 [information provided by infringer]	“Each Party shall provide that in civil judicial proceedings concerning the enforcement of intellectual property rights, its judicial authorities shall have the authority to order the infringer to provide any information that the infringer possesses or controls regarding any persons or entities involved in any aspect of the infringement and regarding the means of production or distribution channel of such goods or services, including the identification of third persons involved in the production and distribution of the infringing goods or services or in their channels of distribution, and to provide this information to the right holder.”		<p>TRIPS Art. 47 “Members may provide that the judicial authorities shall have the authority, unless this would be out of proportion to the seriousness of the infringement, to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the infringing goods or services and of their channels of distribution.”</p> <p>ACTA Art. 11 “Without prejudice to its law governing privilege, the protection of confidentiality of information sources, or the processing of personal data, each Party shall provide...”</p>	<p>TPP substantially expands the “right of information” provision within TRIPS, removing the “out of proportion” limitation, and also extending the information to include the means of production or distribution and identification of persons involved in “any aspect” rather than just the production or distribution of infringing goods. ACTA, furthermore, provides protection for privileged information.</p> <p>12.8 does not include exceptions for privileged information. The use of “infringer” instead of “alleged infringer” makes it unclear whether the provision only applies once a violation is found. (Griffin)</p>
12.9 [additional punishments]	“Each Party shall provide that its judicial authorities have the authority to: (a) fine or imprison, in appropriate cases, a party to a civil judicial proceeding who fails to abide by valid orders		KORUS 18.10.11 “Each Party shall provide that its judicial authorities have the authority to: (a) fine, detain, or imprison, in appropriate cases, a party to a civil judicial proceeding who fails to abide by valid orders issued by	As Flynn et al note, this extends into “contempt of court” territory.

	issued by such authorities; and (b) impose sanctions on parties to a civil judicial proceeding their counsel, experts, or other persons subject to the court's jurisdiction, for violation of judicial orders regarding the protection of confidential information produced or exchanged in a proceeding."		such authorities; and (b) impose sanctions on parties to a civil judicial proceeding, their counsel, experts, or other persons subject to the court's jurisdiction, for violation of judicial orders regarding the protection of confidential information produced or exchanged in a proceeding."	
12.10	[admin proc shall conform to principles consistent w/ this chapter]			
12.11	[cost of experts in trial should be related to the quantity & nature of work performed]			
12.12	"In civil judicial proceedings concerning the acts described in Article 4.[9] (TPMs) and Article 4.[10] (RMI), each Party shall provide that its judicial authorities shall, at the least, have the authority to:"			
12.12(a)	[impose provisional measures, including seizure of devices involved in the prohibited activity]			
12.12(b)	"provide an opportunity for the right holder to elect between actual damages...or pre-established damages;"	17 USC § 504(c) "(1)...the copyright owner may elect, at any time before final judgment is rendered, to recover, instead of actual damages and profits, an award of statutory damages	TRIPS Art. 45 allows for damages and fees	TRIPS does not state that the right holder may choose, but rather that the judicial authority has the authority to order the infringer's payment. However, the ability to choose is recognized under US law.
12.12(c)	"order payment to the prevailing right holder at the conclusion of civil judicial proceedings of court costs and fees, and reasonable attorney's fees, by the party engaged in the prohibited conduct; and"	17 USC § 505 "In any civil action under this title, the court in its discretion may allow the recovery of full costs by or against any party other than the United States or an officer thereof. Except as otherwise provided by this title, the court may also award a reasonable attorney's fee to the	See ACTA Art. 9.5 [costs of the prevailing party] and TRIPS Art. 45.2 [costs to the infringer – implying conviction] (above)	US law allows for recovery of costs by either party whereas 12.12(c) would only allow for recovery by the "right holder". (Griffin)

		prevailing party as part of the costs.		
12.12(d)	“order the destruction of devices and products found to be involved in the prohibited activity.”			
12.12 (cont) [limitations on damages – party]	“No Party shall make damages available under this paragraph against a nonprofit library, archives, educational institution, or public noncommercial broadcasting entity that sustains the burden of proving that such entity was not aware and had no reason to believe that its acts constituted a prohibited activity.”		NB: Neither ACTA nor TRIPS have analogous provisions	
<b>Article 13 - PROVISIONAL MEASURES</b>				
<b>13.1</b>	<p>“Each Party shall act on requests for provisional relief <i>inaudita altera parte</i> [ex parte] expeditiously, and shall, except in exceptional cases, generally execute such requests within ten days.”</p> <p>[Translation: preliminary injunctions granted to a party without prior hearing of the other side.]</p>	17 USC § 502 “(a) Any court having jurisdiction...may,..., grant temporary and final injunctions on such terms as it may deem reasonable to prevent or restrain infringement of a copyright.”	<p>TRIPS Art. 50.2 “The judicial authorities shall have the authority to adopt provisional measures <i>inaudita altera parte</i> where appropriate, in particular where any delay is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk of evidence being destroyed.”</p> <p>ACTA 12.2 “Each Party shall provide that its judicial authorities have the authority to adopt provisional measures <i>inaudita altera parte</i> where appropriate, in particular where any delay is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk of evidence being destroyed. In proceedings conducted <i>inaudita altera parte</i>, each Party shall provide its judicial authorities with the authority to act expeditiously on requests for provisional measures and to make a decision without undue delay.”</p>	<p>US Law contains no time-period requirement for granting preliminary injunctions.</p> <p>TPP expands upon TRIPS and ACTA, which limits preliminary injunctions to those where “delay is likely to cause irreparable harm”. ACTA also contains no explicit time constraint, only that action be taken “without undue delay” while TRIPS makes contains no language regarding speed of decision.</p>



13.2	[judicial authorities have the authority to require an applicant for a preliminary injunction to show evidence]...“in order to satisfy themselves with a sufficient degree of certainty that the applicant’s right is being infringed or that such infringement is imminent...”	<p>Preliminary Injunction requirements: (1) substantial likelihood of success on the merits; (2) substantial threat of irreparable harm if injunction is not granted; (3) the balance of harms weighs in favor of an injunction; (4) an injunction would serve the public interest.</p> <p><i>Winter v. Natural Resources Defense Council</i>, 555 U.S. 7, 12 (2008) (clarifying that a plaintiff must show that “irreparable injury is <i>likely</i> in the absence of an injunction”) (emphasis in original)</p> <p>SOPA: 103(c)(5)Cites FRCP (so seemingly consistent with US standard)</p>		13.2’s standards seem a significant departure from US law which currently emphasizes that irreparable harm must be likely for a preliminary injunction and further requires balancing and consideration of public interest ( <i>Winter</i> ). 13.2 on the other hand simply seems to require that a right is being infringed and that infringement is imminent.
------	---	--	--	---

**Article 14 - SPECIAL REQUIREMENTS RELATED TO BORDER ENFORCEMENT {TRIPS Section 4; ACTA Section 3}**

FN20 [definition of goods]	<p>“For purposes of Article 14:</p> <p>(a) <b>counterfeit trademark goods</b> means any goods, including packaging, bearing without authorization a trademark that is identical to the trademark validly registered in respect of such goods, or that cannot be distinguished in its essential aspects from such a trademark, and that thereby infringes the rights of the owner of the trademark in question under the law of the country of importation; and</p> <p>(b) <b>pirated copyright goods</b> means any goods that are copies made without the consent of the right holder or person duly authorized by the right holder in the country of production and that are made directly or indirectly from an article where the making</p>		<p>ACTA Art. 5(d) “<b>counterfeit trademark goods</b> means any goods, including packaging, bearing without authorization a trademark which is identical to the trademark validly registered in respect of such goods, or which cannot be distinguished in its essential aspects from such a trademark, and which thereby infringes the rights of the owner of the trademark in question under the law of the country in which the procedures set forth in Chapter II ... are invoked;”</p> <p>TRIPS FN14(a) defining counterfeit trademark goods and pirated copyright goods as those “which cannot be distinguished in its essential aspects from such a trademark, and which thereby infringes the rights of the owner of the trademark in question</p>	TPP’s definition, that “the law of the country of importation” rather than ACTA’s “law of the country in which the procedures...are invoked”, protects against the application of the law of in-transit countries; it is also in-line with the TRIPS definition. (Flynn et. al.).
-------------------------------	--	--	--	---

	of that copy would have constituted an infringement of a copyright or a related right under the law of the country of importation.”		under the law of the country of importation”	
14.1	[requirement of adequate evidence to satisfy authorities that there is prima facie infringement]			
14.2	[holding procedures for suspected counterfeit goods]			
14.3	[authorities may inform the right holder w/I 30 days of seizure of details of who was exporting/importing the goods]			
14.4	“Each Party shall provide that its competent authorities may initiate border measures <i>ex officio</i> [FN22 “...the parties understand that <i>ex officio</i> action does not require a formal complaint...”] with respect to imported, exported, or in-transit merchandise, or merchandise in free trade zones, that is suspected of being counterfeit or confusingly similar trademark goods, or pirated copyright goods.”		TRIPS Art. 58 <i>Ex Officio</i> Action “Where Members require competent authorities to act upon their own initiative and to suspend the release of goods in respect of which they have acquired prima facie evidence that an intellectual property right is being infringed:”  ACTA only provides (limited) <i>ex officio</i> action for criminal violations. (Art. 26)	TRIPS does not assume that <i>ex officio</i> action will be available, whereas TPP makes <i>ex officio</i> action the norm. TRIPS also requires a higher standard before action may be taken: “ <i>prima facie</i> evidence” that a right has been infringed, where TPP only requires that infringement is “suspected” and that goods are “confusingly similar” while TRIPS (infra FN20) requires that the good “cannot be distinguished in its essential aspects”.
14.5	[parties shall adopt procedures to determine whether goods infringe on an IP right]			
14.6	“Each Party shall provide that goods that have been determined by its competent authorities to be pirated or counterfeit shall be destroyed, except in exceptional circumstances. In regard to counterfeit trademark goods, the simple removal of the trademark unlawfully affixed shall not be sufficient to permit the release of the goods into the channels of commerce. In no event shall the competent		TRIPS Art. 46 “In order to create an effective deterrent to infringement, the judicial authorities shall have the authority to order that goods that they have found to be infringing be, without compensation of any sort, disposed of outside the channels of commerce in such a manner as to avoid any harm caused to the right holder, or, unless this would be contrary to existing constitutional requirements, destroyed.	TPP makes the standard destruction of infringing goods, whereas TRIPS provides the option of either disposing outside the channels of commerce or destruction. TPP does not provide for disposal outside the channels of commerce.

	authorities be authorized, except in exceptional circumstances, to permit the exportation of counterfeit or pirated goods or to permit such goods to be subject to other customs procedures.”		ACTA Art. 20.1 “Each Party shall provide that its competent authorities have the authority to order the destruction of goods following a determination referred to in Article 19 (Determination as to Infringement) that the goods are infringing. In cases where such goods are not destroyed, each Party shall ensure that, except in exceptional circumstances, such goods are disposed of outside the channels of commerce in such a manner as to avoid any harm to the right holder. 2. In regard to counterfeit trademark goods, the simple removal of the trademark unlawfully affixed shall not be sufficient, other than in exceptional cases, to permit release of the goods into the channels of commerce.”	
14.7	[fees for storage of such goods should not unreasonably deter recourse to these measures]			
14.8	“A Party may exclude from the application of this Article (border measures), small quantities of goods of a non-commercial nature contained in traveler’s personal luggage.”		TRIPS Art. 60 “Members may exclude from the application of the above provisions small quantities of goods of a non-commercial nature contained in travellers’ personal luggage or sent in small consignments.”  ACTA Art. 14.1 “Each Party shall include in the application of this Section goods of a commercial nature sent in small consignments. 2. A Party may exclude from the application of this Section small quantities of goods of a non-commercial nature contained in travellers’ personal luggage.”	TPP eliminates TRIPS’ and ACTA’s “small consignments” exceptions.

**Article 15 - CRIMINAL ENFORCEMENT {TRIPS Section 5; ACTA Section 4}**

<p><b>15.1</b></p>	<p>“Each Party shall provide for criminal procedures and penalties to be applied at least in cases of willful trademark counterfeiting or copyright or related rights piracy on a commercial scale. Willful copyright or related rights piracy on a commercial scale includes:                  (a) significant willful copyright or related rights infringements that have no direct or indirect motivation of financial gain; and                  (b) willful infringements for purposes of commercial advantage or private financial gain. [fn24 “...includes the receipt or expectation of anything of value.”]                  Each Party shall treat willful importation or exportation of counterfeit or pirated goods as unlawful activities subject to criminal penalties.”</p>	<p>17 USC § 506(a)(1) “Any person who willfully infringes a copyright shall be punished as provided under section 2319 of title 18, if the infringement was committed—                  (A) for purposes of commercial advantage or private financial gain;                  (B) [by reproduction or distribution during 180-days of infringing goods retailing for \$1,000]                  (C) [by making the work available on a public network if the person knew the work was intended for commercial distribution]</p> <p>SOPA 201(a)(1)(B) would amend 506(a) to include reproduction or distribution “by electronic means”</p>	<p>TRIPS Art. 61 “Members shall provide for criminal procedures and penalties to be applied at least in cases of wilful trademark counterfeiting or copyright piracy on a commercial scale.”</p> <p>ACTA Art. 23 “Each Party shall provide for criminal procedures and penalties to be applied at least in cases of wilful trademark counterfeiting or copyright or related rights piracy on a commercial scale. For the purposes of this Section, acts carried out on a commercial scale include at least those carried out as commercial activities for direct or indirect economic or commercial advantage.”</p>	<p>15.1 seems to greatly expand what qualifies as willful copyright on a commercial scale by including infringement that has “no direct or indirect motivation of financial gain.” This language seems to be an expansion on that in ACTA which at least requires economic advantage.</p> <p>US Law seems to be more narrow because it requires (except for C) financial or commercial motivation.</p> <p>The question, however, is how “significant” will be defined.</p> <p>The US-China case heard before the WTO established the following meaning for “commercial scale”: “the magnitude or extent of typical or usual commercial activity with respect to a given product in a given market”.  <a href="http://www.wto.org/english/tratop_e/dispu_e/cases_e/1pagesum_e/ds362sum_e.pdf">http://www.wto.org/english/tratop_e/dispu_e/cases_e/1pagesum_e/ds362sum_e.pdf</a> Factors are thus the type of product and the market in which the product is sold.</p>
<p>15.2</p>	<p>“Each Party shall also provide for criminal procedures and penalties to be applied, even absent willful trademark counterfeiting or copyright or related rights piracy, at least in cases of knowing trafficking in:                  (a) labels or packaging, of any type or nature, to which a counterfeit trademark has been applied, the use of which is likely to cause confusion, to cause mistake, or to deceive; and”</p>		<p>TRIPS Art. 61 <i>infra</i> 15.1</p> <p>ACTA Art. 23.2 “Each Party shall provide for criminal procedures and penalties to be applied in cases of wilful importation and domestic use, in the course of trade and on a commercial scale, of labels or packaging:                  (a) to which a mark has been applied without authorization which is identical to, or cannot be</p>	<p>15.2 expands upon ACTA by only requiring “knowing trafficking” and not willful counterfeiting (although “willful importation” could be similar to “knowing trafficking”). Additionally, the TPP includes “confusing” trademarks, a lower standard than ACTA’s “identical to, or cannot be distinguished from”.</p>

	(b) [counterfeit/illicit labels for programs, books, movies, etc.] (c) [counterfeit documentation or packaging]		distinguished from, a trademark registered in its territory; and (b) which are intended to be used in the course of trade on goods or in relation to services which are identical to goods or services for which such trademark is registered.”	
15.3	[penalties to anyone videotaping a movie/work in theaters, etc.]			
15.4	“With respect to the offenses for which this Article requires the Parties to provide for criminal procedures and penalties, Parties shall ensure that criminal liability for aiding and abetting is available under its law.”		ACTA Art. 23.4 “With respect to the offences specified in this Article for which a Party provides criminal procedures and penalties, that Party shall ensure that criminal liability for aiding and abetting is available under its law.”  NB: no analogous TRIPS provision	
15.5	“With respect to the offences described in Article 15.[1]-[4] above, each Party shall provide:”			
15.5(a)	“penalties that include sentences of imprisonment as well as monetary fines sufficiently high to provide a deterrent to future infringements, consistent with a policy of removing the infringer’s monetary incentive. Each Party shall further establish policies or guidelines that encourage judicial authorities to impose those penalties at levels sufficient to provide a deterrent to future infringements, including the imposition of actual terms of imprisonment when criminal infringement is undertaken for commercial advantage or private financial gain;”	18 USC § 2319 – Criminal infringement of a copyright [(b) provides for imprisonment, OR fines for offenses, OR both under 506(a)(1)(A); (c) provides for imprisonment OR fines, OR both for offenses under 506(a)(1)(B); (d) provides for imprisonment, OR fines, OR both for offenses under 506(a)(1)(C)]	ACTA Art. 24 Penalties “For offences specified in paragraphs 1, 2, and 4 of Article 23 (Criminal Offences), each Party shall provide penalties that include imprisonment as well as monetary fines (FN 12 “...there is no obligation for a Party to provide for the possibility of imprisonment and monetary fines to be imposed in parallel.”) sufficiently high to provide a deterrent to future acts of infringement, consistently with the level of penalties applied for crimes of a corresponding gravity.”  TRIPS Art. 61 “...Remedies available shall include imprisonment and/or monetary	US law makes no mention of deterrent effect being a goal of the penalties, and is more explicit regarding the various penalty options (use of “or”). Griffin notes that the US has no official policy of encouraging deterrent penalties.  However, the deterrent purpose is in-line with TRIPS, although TRIPS also makes it clear that imprisonment AND fines are not mandatory.  Additionally, the TPP states “as well as” which implies that both fines AND imprisonment ought to be used in punishing infringers. This language is very similar to that used in ACTA.

			<p>finer sufficient to provide a deterrent, consistently with the level of penalties applied for crimes of a corresponding gravity....”</p>	
15.5(b)	<p>“that its judicial authorities shall have the authority to order the seizure of suspected counterfeit or pirated goods, any related materials and implements used in the commission of the offense, any assets traceable to the infringing activity, and any documentary evidence relevant to the offense. Each Party shall provide that items that are subject to seizure pursuant to any such judicial order need not be individually identified so long as they fall within general categories specified in the order;”</p>		<p>ACTA Art. 25.1 “[with respect to certain criminal offenses]...its competent authorities have the authority to order the seizure of suspected counterfeit trademark goods or pirated copyright goods, any related materials and implements used in the commission of the alleged offence, documentary evidence relevant to the alleged offence, and the assets derived from, or obtained directly or indirectly through, the alleged infringing activity.” NB: TRIPS Art. 61 provides for seizure as a possible remedy.</p>	<p>Griffin notes that the Fourth Amendment requires that warrants are issued upon probable cause and “particularly” describe the place(s) to be searched and goods seized. The TPP’s language of “general categories” may not be “particular” enough to survive Fourth Amendment scrutiny.</p>
15.5(c)	<p>“that its judicial authorities shall have the authority to order, among other measures, the forfeiture of any assets traceable to the infringing activity, and shall order such forfeiture at least in cases of trademark counterfeiting;”</p>	<p>18 USC § 2323 – Forfeiture, destruction, and restitution [(a)(1) providing that the following is subject to forfeiture: (a) the infringing articles, (b) property used or intended to be used to facilitate infringement, (c) property or proceeds obtained directly or indirectly as a result of infringement]</p>	<p>TRIPS Art. 61 “...In appropriate cases, remedies available shall also include the seizure, forfeiture and destruction of the infringing goods and of any materials and implements the predominant use of which has been in the commission of the offence....”</p> <p>ACTA Art. 25 “...that Party shall provide that its competent authorities have the authority to order the seizure of suspected counterfeit trademark goods or pirated copyright goods, any related materials and implements used in the commission of the alleged offence, documentary evidence relevant to the alleged offence, and the assets derived from, or obtained directly or indirectly through, the</p>	<p>15.5(c) seems to be an expansion of TRIPS which requires “predominant use” in commission of infringement for forfeiture. Similarly, US law only provides for forfeiture in three specific instances. “Any assets traceable” seems to be a very low standard, and is even broader than ACTA which seems to follow US law fairly closely.</p>

			alleged infringing activity.	
15.5(d)	<p>“that its judicial authorities shall, except in exceptional cases, order (i) the forfeiture and destruction of all counterfeit or pirated goods, and any articles consisting of a counterfeit mark; and (ii) the forfeiture or destruction of materials and implements that have been used in the creation of pirated or counterfeit goods. Each Party shall further provide that forfeiture and destruction under this subparagraph and subparagraph (c) shall occur without compensation of any kind to the defendant;”</p>		<p>ACTA Art. 25.3 “competent authorities have the authority to order the forfeiture or destruction of all counterfeit trademark goods or pirated copyright goods. In cases where counterfeit trademark goods and pirated copyright goods are not destroyed, the competent authorities shall ensure that, except in exceptional circumstances, such goods shall be disposed of outside the channels of commerce in such a manner as to avoid causing any harm to the right holder.”</p> <p>TRIPS Art. 61 provides for “seizure, forfeiture and destruction of the infringing goods and of any materials and implements the predominant use of which has been in the commission of the offense.”</p>	15.5(d) expands on ACTA by requiring the destruction of counterfeit goods, while ACTA provides for the option of either forfeiture OR destruction. ACTA also provides for a disposal outside the channels of commerce exception, which the TPP does not have.
15.5(e)	[authority to seize equivalent assets]			
15.5(f)	[inventory of goods to be destroyed, authority to temporarily exempt]			
15.5(g)	<p>“that its authorities may initiate legal action <i>ex officio</i> with respect to the offenses described in this Chapter, without the need for a formal complaint by a private party or right holder.”</p>		<p>ACTA Art. 26 “Each Party shall provide that, in appropriate cases, its competent authorities may act upon their own initiative to initiate investigation or legal action with respect to the criminal offences specified in paragraphs 1, 2, 3, and 4 of Article 23 (Criminal Offences) for which that Party provides criminal procedures and penalties.”</p>	<p>As Griffin notes, if the TPP covers conduct that is not criminal under U.S. Law, the government would not have authority to initiate legal action.</p> <p>TPP also expands upon ACTA by removing the limitation “in appropriate cases”.</p>

<b>Art. 16 - SPECIAL MEASURES RELATING TO ENFORCEMENT IN THE DIGITAL ENVIRONMENT {TRIPS: none; ACTA Section 5}</b>				
16.1	[these enforcement procedures should actually be available under Party's law]			
16.2	[Party's shall provide laws, etc. ensuring government agencies do not use infringing software]			
16.3	[for effective enforcement procedures, each Party shall provide...:]	17 USC § 512 Limitations on liability relating to material online [Safe Harbor Provision]  SOPA 103(a)(1)(B)(ii) "(I) is taking, or has taken, deliberate actions to avoid confirming a high probability of the use of the U.S.-directed site to carry out acts that constitute a violation of section 501 or 1201 of title 17, United States Code; or		According to Griffin, 16.3 "mirrors" § 512. The most significant impact would thus be in settling 16.3 as the standard for other nations that may still be developing their ISP liability provisions.
16.3(a)	"legal incentives for service providers to cooperate with copyright owners in deterring the unauthorized storage and transmission of copyrighted materials; and"		ACTA Art. 27.3 "...endeavour to promote cooperative efforts within the business community to effectively address trademark and copyright or related rights infringement while preserving legitimate competition and, consistent with that Party's law, preserving fundamental principles such as freedom of expression, fair process, and privacy."	16.3(a) focuses on legal incentives whereas ACTA seems to focus more on the business-side of preventing infringement.
16.3(b)	"limitations in its law regarding the scope of remedies available against service providers for copyright infringements that they do not control, initiate or direct, and that take place through systems or networks controlled or operated by them or on their behalf, as set forth in this subparagraph (b)."	17 USC § 512(e) Limitation on Liability of Nonprofit Educational Institutions	ACTA Art. 27.2 "Further to paragraph 1, each Party's enforcement procedures shall apply to infringement of copyright or related rights over digital networks, which may include the unlawful use of means of widespread distribution for infringing purposes. These procedures shall be implemented in a manner that avoids the creation of barriers to legitimate activity, including	16.3 does not explicitly provide for a limitation on liability for nonprofit educational institutions.



			<p>electronic commerce, and, consistent with that Party's law, preserves fundamental principles such as freedom of expression, fair process, and privacy. (FN13 For instance, without prejudice to a Party's law, adopting or maintaining a regime providing for limitations on the liability of, or on the remedies available against, online service providers while preserving the legitimate interests of right holder."</p> <p>SOPA "102(c)(3)(ii) LIMITATIONS.—A service provider shall not be required—  (I) other than as directed under this subparagraph, to modify its net-work, software, systems, or facilities;  (II) to take any measures with respect to domain name resolutions not performed by its own domain name server; or  (III) to continue to prevent access to a domain name to which access has been effectively disabled by other means."</p>	
16.3(b)(i)	[the limitations preclude monetary relief and restrict court-ordered restrictions for certain functions (A) transmitting material without modifying it, (B) automatic caching, (C) user-directed storage, (D) linking using information location tools]	17 USC § 512 – all sections specify that “a service provider shall not be liable for monetary relief...” – corresponding section headings to 16.3(b)(i): (a) Transitory Digital Network Communications (b) System Caching (c) Information Residing on Systems or Networks at Direction of Users (d) Information Location Tools		
16.3(b)(ii)	[limitations apply only if ISP didn't..."initiate the chain of			

	transmission of the material...” or select the material/recipients]			
16.3(b)(iii)	[limitation qualification procedure]			
16.3(b)(iv)	[limitations condition on the ISP (A) only allowing significant access to caches to certain users, (B) complying with rules regarding updating cached material, (C) not interfering with cookies from originating site,] (D) “expeditiously removing or disabling access, on receipt of an effective notification of claimed infringement, to cached material that has been removed or access to which has been disabled at the originating site.”		NB: ACTA’s limitations regime is left to the Party’s (ACTA Art. 27.2 FN13)	
16.3(b)(v)	[for (i)(C) and (D) limitations conditioned on ISP (A) not receiving financial benefit attributable to infringement, (B) quickly removing infringing information, (C) “publicly designating a representative to receive such notifications”]			
16.3(b)(vi)	“Eligibility for the limitations in this subparagraph shall be conditioned on the service provider: (A) adopting and reasonably implementing a policy that provides for termination in appropriate circumstances of the accounts of repeat infringers; and (B) accommodating and not interfering with standard technical measures accepted in the Party’s territory that protect and identify copyrighted material, that are developed through an open, voluntary process by a broad consensus of copyright owners and service providers, that are	17 USC § 512 “(i) Conditions for Eligibility.— (1) Accommodation of technology.— The limitations on liability established by this section shall apply to a service provider only if the service provider— (A) has adopted and reasonably implemented, and informs subscribers and account holders of the service provider’s system or network of, a policy that provides for the termination in appropriate circumstances of subscribers and account holders of the service provider’s system or network who are repeat infringers; and (B) accommodates and does not interfere with standard technical	NB: ACTA’s limitations regime is left to the Party’s (ACTA Art. 27.2 FN13)	16.3(b)(vi)(B) is much more specific than US law regarding the technical measures. However, the additional language maybe beneficial to ISP’s in that it specifies that the terms should not impose substantial costs or burdens.

	available on reasonable and nondiscriminatory terms, and that do not impose substantial costs on service providers or substantial burdens on their systems or networks.”	measures.”		
16.3(b)(vii)	“Eligibility for the limitations in this subparagraph may not be conditioned on the service provider monitoring its service, or affirmatively seeking facts indicating infringing activity, except to the extent consistent with such technical measures.”	17 USC § 512(m) “Nothing in this section shall be construed to condition the applicability of subsections (a) through (d) on— (1) a service provider monitoring its service or affirmatively seeking facts indicating infringing activity, except to the extent consistent with a standard technical measure complying with the provisions of subsection (i); or (2) a service provider gaining access to, removing, or disabling access to material in cases in which such conduct is prohibited by law.”		16.3(b)(vii) does not include language similar to 512(m)(2), thus potentially failing to include freedom of expression, privacy and fair process protections.
16.3(b)(viii)	[if ISP qualifies under (i)(A) court may only compel termination of specific accounts, anything else under (i) court may compel removal of infringing material, etc. Court’s should consider burden on the ISP, technical feasibility, notice, etc.]			
16.3(b)(ix)	[procedures for effective notification of claimed infringement shall be established]			

16.3(b)(x)	<p>“If the service provider removes or disables access to material in good faith based on claimed or apparent infringement, each Party shall provide that the service provider shall be exempted from liability for any resulting claims, provided that, in the case of material residing on its system or network, it takes reasonable steps promptly to notify the person making the material available on its system or network that it has done so and, if such person makes an effective counter-notification and is subject to jurisdiction in an infringement suit, to restore the material online unless the person giving the original effective notification seeks judicial relief within a reasonable time.”</p>	<p>17 USC § 512(g) “(1) No liability for taking down generally.— Subject to paragraph (2), a service provider shall not be liable to any person for any claim based on the service provider’s good faith disabling of access to, or removal of, material or activity claimed to be infringing or based on facts or circumstances from which infringing activity is apparent, regardless of whether the material or activity is ultimately determined to be infringing....(3) Contents of counter notification (D)...a statement that the subscriber consents to the jurisdiction of Federal District Court for the judicial district in which the address is located, or if the subscriber’s address is outside of the United States, for any judicial district in which the service provider may be found...”</p>	<p>NB: no analogous ACTA provision.</p>	<p>16.3(b)(x) is vague on what “subject to jurisdiction” means, whereas 512(g)(3)(D) fairly clearly specifies the jurisdictional requirements for a counter-notification; especially the presumption of Federal District Court jurisdiction. Because it is not clear – and seems to imply that a counter-notification will only be effective if the alleged infringer is subject to the courts’ jurisdiction, 16.3(b)(x) could make it more difficult for an alleged infringer to have their material restored.</p>
16.3(b)(xi)	<p>“Each Party shall establish an administrative or judicial procedure enabling copyright owners who have given effective notification of claimed infringement to obtain expeditiously from a service provider information in its possession identifying the alleged infringer.”</p>	<p>17 USC § 512 “(h) Subpoena To Identify Infringer.— (1) Request.— A copyright owner or a person authorized to act on the owner’s behalf may request the clerk of any United States district court to issue a subpoena to a service provider for identification of an alleged infringer in accordance with this subsection.”</p>	<p>ACTA 27.4 “...authority to order an online service provider to disclose....information sufficient to identify a subscriber....where” [(1) there is a legally sufficient claim of infringement; (2) information sought is for the purpose of enforcing those rights; (3) procedures implemented in such a way as to avoid creating barriers to legitimate activity.]</p>	<p>16.3(b)(xi) is vague enough that it could be read as giving Parties the ability to create their own methods of obtaining identification of alleged infringers. It does not include the specificity and requirements found in US Law or ACTA.</p>
16.3(b)(xii)	[definition of ISP]			
SIDE LETTER				
FN35	<p>“In the case of notices regarding an information location tool pursuant to paragraph (b)(i)(D) of Article 16.3, the information provided must be reasonably sufficient to permit the service</p>	<p>17 USC § 512(c)(3) “(ii) Identification of the copyrighted work claimed to have been infringed, or, if multiple copyrighted works at a single online site are covered by a single</p>		<p>In <i>Viacom Intern. V. YouTube, Inc.</i>, the court held that YouTube’s decision to only remove specific clips identified by URL in DMCA notices (and not other, similarly infringing clips), did not violate 17</p>

	<p>provider to locate the reference or link residing on a system or network controlled or operated by or for it, except that in the case of a notice regarding a substantial number of references or links at a single online site residing on a system or network controlled or operated by or for the service provider, a representative list of such references or links at the site may be provided, if accompanied by information sufficient to permit the service provider to locate the references or links.”</p>	<p>notification, a representative list of such works at that site. (iii) Identification of the material that is claimed to be infringing or to be the subject of infringing activity and that is to be removed or access to which is to be disabled, and information reasonably sufficient to permit the service provider to locate the material.</p>		<p>USC § 512(c)(3) because the statute requires “specificity of notice” which would be eviscerated if a “representative list” were sufficient. 718 F. Supp. 2d 514, 528-29 (SDNY 2010).</p>
--	--	---	--	---