Introduction

For over a century a general trend running like a thread through the international community has been the attempted harmonization of intellectual property laws between the various nations. Typically, these attempts at harmonization arise in Europe embodied as treaties such as The Paris Convention, The Madrid Treaty, The Madrid Protocol, The General Agreement On Trade And Tariffs (GATT/TRIPs) and the like. In most instances the United States has taken a conservative approach and either declined to become a member or if upon acceptance and ratification of a treaty made only the minimum modifications required under the terms of the treaty. However, the globalization of world economic markets is leading the U.S. to accept a greater amount of change in the name of international harmonization of intellectual property, especially in the area of patents. This is evidenced by the enactment of changes in the U.S. patent and trademark statutes as a result of membership in GATT, more recently the Trademark Law Treaty (TLT) and possibly within the next few months ratification of the Madrid Protocol.

Discussion

Patents and trademarks are inherently regional. Their effect is limited predominantly by national boundaries. Consequently the scope of interest of any government has been to protect and advance the intellectual property interests of its citizens. This governmental interest coincided with the industrial interests of individual nations. In contrast, for at least the last century, the trend of international treaties concerned with intellectual property has been the attempt to overcome this national self interest by standardizing procedures and removing inherent statutory prejudices against non-citizens. The object of treaties such as the Paris Convention was to harmonize intellectual property laws by providing for minimum rights between citizen and non-citizen applicants for patents and trademarks while allowing ample room for differences in the scope of national laws.

During the past ten years substantial changes have occurred that have driven the trend of harmonization of intellectual property. These major drivers include GATT/TRIPs and The Trademark Law Treaty. To some degree the economic self interests of multinational corporations have also helped to prompt international harmonization. The changes resulting from the harmonizing trend have been greater in the area of patent laws as witnessed by the following examples.

Patents

On December 8, 1994 the Uruguay Round Agreement (URAA) of GATT became law. A number of changes in U.S. patent law were mandated under the accompanying Agreement on Trade Related Aspects Of Intellectual Property (TRIPs). The enactment of the URAA ended the existence of GATT and ushered the World Trade Organization an administrative successor to GATT into being. The GATT/TRIPs provisions, largely inclusive of the intellectual property provisions of NAFTA obligated the U.S. to make
substantial changes to its patent laws. New patent term and application provisions took effect on June 8, 1995.

Under previous law a U.S. patent had a term of 17 years from its date of issue. However, Article 33 of GATT/TRIPs required U.S. law to allow a patent have a minimum term of 20 years from its earliest claimed priority under 35 U.S.C. sections 120, 121, or 365(c). In addition to the 20 year term, the patent statute was revised to allow for a transition period for U.S. patents in effect on June 8, 1995 which allowed for the greater of the difference between the previous 17 year from date of issue provision and the new 20 year from date of filing amendment. This was meant to soften the change between the old 17 year term and the new 20 year term from filing and to alleviate inequities generated because of the change. The relatively simple calculation for determining when a U.S. patent expired had now become much more complex. Add to this the fact that the U.S. Patent Office could not guarantee pendency of prosecution, the existence of extensions or “tack-ons” to the 20 year period for delays attributable to the Patent Office and it had become increasingly difficult to accurately determine the expiration date of a U.S. patent.

Further, as a result of amendments to the U.S. patent statutes although claims to an earlier filed domestic priority were used to calculate the beginnings of the 20 year term, claims of earlier filed foreign priorities under 35 U.S.C. section 119 were not included in such a calculation of the 20 year term. This put American inventors at a disadvantage with regard to some priority issues. Therefore a provisional application was created in the U.S. statute under 35 U.S.C. as section 111(b). The Provisional Application provided U.S. inventors with an inexpensive means of establishing a priority date to equal that of an earlier filed foreign priority without diminishing the 20 years from date of filing term.

Another provision of GATT/TRIPs requiring an amendment to a U.S. statute was Article 27 section 1 which provides: “[P]atents shall be available and patent rights enjoyable without discrimination as to the place of invention”. Prior to enactment of GATT the patent system in the U.S. was unique in that the inventor who was “first to invent” has priority rights in the invention. It was therefore crucial that an inventor had the ability to prove the date of invention in those cases where a dispute arose as to the actual invention date. Until the enactment of NAFTA and GATT/TRIPs, only activities carried out in the U.S. and related to the invention could be used to prove the date of invention. Activities in other countries were excluded by 35 U.S.C. section 104. In order to implement GATT/TRIPs the U.S. was required to amend section 104 to allow proof of date of invention by a showing of inventive activity in any World Trade Organization country. A substantive limitation included in the amendment of section 104 required that adequate discovery was available to the extent that such discovery was available in the United States. This amendment went into effect January 1, 1996.

The more recent American Inventors Protection Act of 1999 contains additional amendments to the patent statute. In general these amendments alleviate shortcomings in the previous amendments allowing the U.S. to conform to GATT requirements or further harmonize U.S. patent law with existing international practices.

Under the amendments required by GATT/TRIPs the U.S. went to a 20 year from date filing patent term. In part because the Patent Office could not guarantee a maximum time period for prosecution the enforceable term of U.S. patents could be significantly
less than the previous 17 year term allowed under the unrevised patent statute. In order
to remedy this shortcoming a new amendment under the 1999 American Inventors Act
 guarantees not only prompt response times in the United States Patent and Trademark
Office during pendency but also guarantees a limitation on the prosecution period of not
greater than 3 years from the U.S. filing date except for delays introduced by the
applicant. Another change under the recent Inventor's Reform Act is the domestic
publication of foreign filed patent applications. This is clearly directed to harmonization
of U.S. procedure with that of virtually every other industrialized nation. Under the
domestic publication provision, pending utility patents that are filed abroad will be
published 18 months from the earliest filing date relied upon. This publication
requirement will not apply to utility patents where the applicants indicate that there is to
be no foreign filing. In order to protect inventive entities from the possibility of
harassment under the new publication provisions, initiation of public protest and public
use proceedings against a published application will not be allowed after publication of
the pending application. The publication amendment also provides a right, assuming the
application issues into a patent, for a reasonable royalty for direct infringement occurring
between publication and patent grant.

Subtitle F of the American Inventor's Protection Act supplements the existing
reexamination procedure by allowing a party to request inter parties reexamination, thus
allowing a limited right to participate in the reexamination procedure. In the past, third
party participation was strictly limited. This change is an alternative to the full blown
opposition procedure found in numerous foreign countries where for a specified period of
time after grant of a patent interested members of the public could file and participate in
an opposition against the granted patent. Unlike the U.S. reexamination which is limited
to a reexamination of a patent based on published prior art foreign oppositions can be
based on prior use and/or printed materials. The object of the expanded inter parties
reexamination is to provide a relatively low cost third party option to litigation similar to
the foreign opposition process.

Subtitle H "Miscellaneous Patent Provisions under the American Inventors Protection
Act, further amends 35 U.S.C. 102(g)(1) to expressly allow reliance on acts in a foreign
country in an interference proceeding to the extent permitted under 35 U.S.C. 104,
providing such acts were not abandoned, suppressed or concealed. This allows foreign
nationals to use existing U.S. patent procedures on an equal footing with U.S. nationals.

All of the above are examples of changes to U.S. patent law that in effect promote the
harmonizing trend between the U.S. and the rest of the industrialized world.

Trademarks

Unlike the above examples of changes to U.S. patent law and practice that illustrate a
trend toward international harmonization, there has been little substantive change in the
law governing U.S. trademarks over the last 10 years. This is due in large part to the
fact that existing trademark law does not contain the built in prejudices found in U.S.9
patent law. Evidence of this lack of prejudice is the small number of amendments to the
Lanham Act10 necessitated by NAFTA and GATT/TRIPs. Part of the lack of prejudice can
be attributed to the U.S. being a member of the Paris Convention. The Paris Convention
rests on the principle of nondiscrimination between member nations.
In the last ten years legislation has been enacted to implement NAFTA, GATT/TRIPs and TLT. In order to implement NAFTA the only legislation required was that enacted to end the ability to register geographically misdescriptive terms. Only two trademark related changes were made as a result of the implementation of GATT/TRIPs in December, 1994. First the Lanham Act was amended to bar registration against a geographical indication for wine or liquor which identifies a place other than the origin of the goods and was first used after January 1, 1996; and second the Act was amended to lengthen from two to three years the time of non-use of a mark needed to trigger a presumption of abandonment. More recently the Trademark Law Treaty Implementation Act (TLTIA) enacted in order to bring the U. S. into compliance with the Trademark Law Treaty consisted of formal changes related to procedural matters. Under the TLTIA, standards for revival of abandoned applications under sections 12(b) and 1d)(4) were changed from a showing of unavoidable delay to the lesser standard of showing of unintentional delay. Section 8 of the Act was amended to require the filing of an affidavit or declaration of continued use or excusable non-use in the year preceding the tenth anniversary of the registration and every ten years thereafter. In addition section 9 grace periods were extended. Prior to the October 30, 1999 enactment date, section 8 affidavits were required between the fifth and sixth year after the date of registration no further affidavits were required under section 8 of the old Act. A section 8 affidavit is still required between the fifth and sixth year.

On the whole amendments to U.S. trademark law have been relatively minimal but still indicative of a willingness to change for the sake of international harmonization.

Conclusion

The above examples of changes in U.S. patent and trademark law are meant to serve as illustrations of the United States movement toward harmonization of international intellectual property law. The examples were not meant to be exhaustive but merely to give the reader an idea of the scope of ongoing change occurring within the international community.
LITERATURE CITED


2. Agreement of Madrid for the International Registration of Trademarks, April 14, 1891.


4. Final Act Embodying the Results of the Uruguay Round of Multilateral Trade Negotiations (URAA), Agreement onTrade Related Aspects of Intellectual Property Rights (TRIPS), December, 1993.


6. The North American Free Trade Agreement.


