

Do uso (agora) das flexibilidades de TRIPs no direito brasileiro

Denis Borges Barbosa (2010)

O ponto inicial de nossa perquirição é que os textos internacionais em vigor entre nós não impedem o uso de flexibilidades ainda não aproveitadas (salvo se determinadas por termo certo) e mesmo não vedam *o retorno ao padrão mínimo dos tratados se a lei nacional deles excedeu*.

Assim comentei a questão de um país, como o fez o Brasil, ir além do que TRIPs impõe¹ :

Going beyond the minimum: domestic context

Being *minimum*, these standards may be exceeded by the member state autonomously in its internal legal order, provided that such further protection does not contravene the provisions of the Agreement². Why would a country *voluntarily*³ exceed such base?

Two considerations might be pertinent: either domestic IP requirements would justify this more extensive protection, or else non-IP considerations would lead the country to impose extra requirements. As a result of the “single undertaking” rule, many countries would accept the basic standards that have no domestic demand, in order to achieve other targets in the wider range of the Uruguay Round agreements. The same reason would lead such countries to accept more extensive protection in the context of post-TRIPs bilateral or restricted agreements. The compatibility of this interest with TRIPs will be analyzed below.

Non-permissible unilateral enhancements

Not always is more extensive protection allowable, as the pertinent clause requires that any enhanced standard “does not contravene the provisions of this Agreement”.

More extensive protection may contravene TRIPs, for instance, by colliding with its maximum standards. A very specific aspect of TRIPs is that it contains rules consisting of *maximum* standards, and therefore does not admit more extensive protection:

Nevertheless, existing TRIPs standards may conflict with TRIPs-plus standards in bilateral agreements in cases in which the former do not only define minimum, but also maximum standards. Although it seems, according to Art. 1.1 TRIPs, that such maximum standards are inherently foreign to the concept of the TRIPs, the Agreement nevertheless prohibits “more intensive protection” in its provisions on enforcement of Part III to the extent that it fixes general procedural provisions to the benefit of any party to IP litigation. In some instances, the Agreement even explicitly provides for procedural rights of the defendant, like with regard to the level of legal certainty as a requirement for provisional measures (Art. 50.3 TRIPs) and the rights of the alleged infringer to be informed and to be heard

¹ BARBOSA, Denis Borges, Minimum standards vs. harmonization in the TRIPS context: the nature of obligations under TRIPS and modes of implementation at the national level in monist and dualist systems. In Carlos M. Correa, Intellectual Property in the WTO: Research Handbook on the Interpretation and Enforcement of Intellectual Property Under WTO Rules, Edward Elgar Publishing Ltd (1 Aug 2010)

² How would this further protection go against TRIPs? As mentioned in other section of this study, it could refuse that enhanced protection to non-nationals, violating the National Treatment rule. Or else (as exemplifies Nuno Carvalho), granting extended patent protection to pharmaceuticals, but denying it to aerospace technologies, violating the TRIPs art. 27 rule against discriminating among technology areas. Some authors note that the limits to enhanced protection are the provisions and not the principles of TRIPs; however, there are some principles clearly embodied in provisions as, e.g., Art. 7 and 8 of TRIPs.

³ The issue of whether enhanced protection (i.e., an implementation of rights more favorable to title holders or creators) is actually voluntary is quite complex. Indirect pressure and biased technical assistance may lead to uncoerced but tainted decisions. See S Sell, Private Power, Public Law: The Globalization of intellectual Property Rights (2003: Cambridge University Press), pp 151-2.

within a reasonable time after provisional measures have been adopted inaudita altera parte (Art. 50.4 TRIPs). Most strikingly, Art. 48 TRIPs provides for a right to indemnification of the defendant in case of an abuse of enforcement procedures⁴.

It also can be incompatible with the limitations contained in the basic treaties, as Carlos Correa remarks⁵:

Another situation [stet] of a 'more extensive' protection that contravenes the TRIPs Agreement can arise in the case of 'revalidation', 'confirmation', or 'importation' patents; that is, patents that are granted on the basis of foreign patent grants, without consideration of the novelty requirement. This kind of patent was introduced as a means to facilitate the importation of technologies in some patent laws and treaties⁶ of the nineteenth century, and survived in some countries (e.g. Argentina, Chile) until recently. The more extensive protection conferred by these patents conflicts with Article 4bis of the Paris Convention for the Protection of Industrial Property,⁷ as interpreted more than half a century ago in relation to Article 29 of the French law of 1844.⁸ The inconsistency of revalidation patents with the TRIPs Agreement was also found by the Argentine Supreme Court⁹, which declared that they were incompatible with the Paris Convention and the principles of the TRIPs Agreement.¹⁰

Also incompatible with TRIPs would be those protections that, albeit in excess of a minimum standard, oppose principles and rules intrinsic to the agreement. For example, an enhanced patent term that is not extended to foreign filings would contravene the National Treatment principle. Less stringent patent examination criteria for software inventions would infringe the non-discrimination rule of Art 27.1¹¹.

E, exatamente tendo em vista o que agora se propõe, quais são os limites de se *voltar ao que TRIPs impunha*:

Going back to required standards

Would excessive compliance, if recognized as such, be amendable by member states, in order to regain full benefit from TRIPs? Art. 65.5 only prevents a “rolling back” to prior non TRIPs-compliant levels during the transitional periods provided under art. 65 and 66:

This is essentially a provision which prevents WTO Members from “rolling back” during the transition period, i.e., from providing a reduced degree of IP protection in their domestic laws. On the other hand, this provision also makes sure that, if under a bilateral arrangement some developing countries choose to go “TRIPs plus”, the Agreement does

4 Drexl, op. cit. [Josef Drexl, ‘The TRIPs Agreement and the EC: What Comes Next after Joint Competence?’, in Friedrich-Karl Beier and Gerhard Schriker (eds), From GATT to TRIPs – The Agreement on Trade-Related Aspects of Intellectual Property Rights, Munich: Weinheim, [1996]

5 Comentary.... [Carlos M. Correa, *Trade Related Aspects of Intellectual Property Rights: Commentary on the TRIPs Agreement*, Oxford: Oxford University Press, 2007]

6 [Original footnote] See eg The Montevideo Treaty on Patents, signed on 16 January 1889.

7 [Original footnote] As discussed below, this Convention was incorporated into the TRIPs Agreement.

8 [Original footnote] See A Casalonga, *Traité Technique et pratique des brevets d'invention* (1949: Paris), pp 273, 296.

9 [Original footnote] See *Unilever NV v Instituto Nacional de Propiedad Industrial s/denegatória de patente*, reproduced in *El Derecho*, 2 August 2001.

10 [Original footnote] Bodenhausen argued that the principle of independence of the Paris Convention did not apply with regard to special patents like 'revalidation' patents. This argument, however, is unconvincing as the principle is to be applied, according to the Convention, in an 'unrestricted sense' (G Bodenhausen, *Guide to the Application of the Paris Convention of Industrial Property as revised at Stockholm in 1967* (1991: Geneva, WIPO) pp 208-9).

11 As related in Document WT/DS 153/ 1 of December 7, 1998, Canada denounced the Special Protection Certificate provided for Regulations EEC No 1768/92 and EEC No 1610/96, as incompatible with Article 27.1 of the TRIPs Agreement, as assured discriminatory advantages to the pharmaceutical sector.

not prevent them from rolling back to the common TRIPs standards. This issue would exclusively be governed by the respective bilateral agreement¹².

Therefore, after the transitional periods expire, any eventual mistakes committed by member states (e.g., in cases where enhanced protection has not demonstrated the beneficial effects they expected), could be corrected by rolling back such protection to the level of the pertinent minimum standard, and this retroaction would not violate directly TRIPs.

However, some caution must be in order here, as those other member states that demonstrate their *reasonable expectations* that the surplus IP protection provided by the rolling-back member would not be readjusted to lesser grounds could be motivated to try *non-violation* claims to prevent the retroaction¹³.

Assim, ainda que a retroação aos limites mínimos de TRIPs sejam lícitos, e não violem TRIPs, há que se tomar os devidos cuidados para que não ocorram violações relativas a demandas de não-violação. Um elemento importante deste cuidado é evitar que ocorra um desbalanceamento de direitos e obrigações, e evitar que não se frustrem as expectativas razoáveis dos demais Estados-membros *ao momento em que TRIPs era negociado*.

O ponto inicial de nossa perquirição é que os textos internacionais em vigor entre nós não impedem o uso de flexibilidades ainda não aproveitadas (salvo se determinadas por termo certo) e mesmo não vedam *o retorno ao padrão mínimo dos tratados se a lei nacional deles excedeu*.

Assim comentei a questão de um país, como o fez o Brasil, ir além do que TRIPs impõe¹⁴ :

Going beyond the minimum: domestic context

Being *minimum*, these standards may be exceeded by the member state autonomously in its internal legal order, provided that such further protection does not contravene the provisions of the Agreement¹⁵. Why would a country *voluntarily* ¹⁶exceed such base?

¹² UNCTAD-ICTSID, op. Cit., p. 715. The same opinion is expressed by Nuno Carvalho, op. cit., p. 751. Other standstill clause seems to have been included in the TRIPs section on Geographical Indications, as art. 24.3 freezes the TRIPs-plus levels already assured by some countries, as notes Dwijen Rangnekar in Geographical Indications A Review of Proposals at the TRIPs Council: Extending Article 23 to Products other than Wines and Spirits, found at http://ictsd.net/downloads/2008/06/cs_rangnekar.pdf, visited December 6, 2008.

¹³ See Tuan N Samahon, TRIPs copyright dispute settlement after the transition and moratorium: Nonviolation and situation complaints against developing countries, found at <http://www.allbusiness.com/legal/3589056-1.html>, visited December 6, 2008. Article 23 (1) (b) defines nonviolation as that which nullifies or impairs TRIPs objectives resulting from the "application by another contracting party of any measure, whether or not it conflicts with the provisions of this Agreement." (...) (1) affirmative government action, such as an offending member state's application of a measure offsetting any trade benefit it had conceded; (2) the complaining member state's justified reliance on the nonoccurrence of the applied measure or event; and (3) actual injury. In claiming that the offending state applied a nullifying or impairing measure, the injured state must point to a specific measure applied by the offending state. In addition, the application of the measure must have not been "reasonably anticipated at the time that specific rights and obligations of market access were negotiated."

¹⁴ BARBOSA, Denis Borges, Minimum standards vs. harmonization in the TRIPs context: the nature of obligations under TRIPs and modes of implementation at the national level in monist and dualist systems. In Carlos M. Correa, Intellectual Property in the WTO: Research Handbook on the Interpretation and Enforcement of Intellectual Property Under WTO Rules, Edward Elgar Publishing Ltd (1 Aug 2010)

Two considerations might be pertinent: either domestic IP requirements would justify this more extensive protection, or else non-IP considerations would lead the country to impose extra requirements. As a result of the “single undertaking” rule, many countries would accept the basic standards that have no domestic demand, in order to achieve other targets in the wider range of the Uruguay Round agreements. The same reason would lead such countries to accept more extensive protection in the context of post-TRIPs bilateral or restricted agreements. The compatibility of this interest with TRIPs will be analyzed below.

Non-permissible unilateral enhancements

Not always is more extensive protection allowable, as the pertinent clause requires that any enhanced standard “does not contravene the provisions of this Agreement”.

More extensive protection may contravene TRIPs, for instance, by colliding with its maximum standards. A very specific aspect of TRIPs is that it contains rules consisting of *maximum* standards, and therefore does not admit more extensive protection:

Nevertheless, existing TRIPs standards may conflict with TRIPs-plus standards in bilateral agreements in cases in which the former do not only define minimum, but also maximum standards. Although it seems, according to Art. 1.1 TRIPs, that such maximum standards are inherently foreign to the concept of the TRIPs, the Agreement nevertheless prohibits “more intensive protection” in its provisions on enforcement of Part III to the extent that it fixes general procedural provisions to the benefit of any party to IP litigation. In some instances, the Agreement even explicitly provides for procedural rights of the defendant, like with regard to the level of legal certainty as a requirement for provisional measures (Art. 50.3 TRIPs) and the rights of the alleged infringer to be informed and to be heard within a reasonable time after provisional measures have been adopted inaudita altera parte (Art. 50.4 TRIPs). Most strikingly, Art. 48 TRIPs provides for a right to indemnification of the defendant in case of an abuse of enforcement procedures¹⁷.

It also can be incompatible with the limitations contained in the basic treaties, as Carlos Correa remarks ¹⁸:

Another situation [stet] of a 'more extensive' protection that contravenes the TRIPs Agreement can arise in the case of 'revalidation', 'confirmation', or 'importation' patents; that is, patents that are granted on the basis of foreign patent grants, without consideration of the novelty requirement. This kind of patent was introduced as a means to facilitate the importation of technologies in some patent laws and treaties¹⁹ of the nineteenth century, and survived in some countries (e.g. Argentina, Chile) until recently. The more extensive protection conferred by these patents conflicts with Article 4bis of the Paris Convention for the Protection of Industrial Property,²⁰ as interpreted more than half a century ago in

15 How would this further protection go against TRIPs? As mentioned in other section of this study, it could refuse that enhanced protection to non-nationals, violating the National Treatment rule. Or else (as exemplifies Nuno Carvalho), granting extended patent protection to pharmaceuticals, but denying it to aerospace technologies, violating the TRIPs art. 27 rule against discriminating among technology areas. Some authors note that the limits to enhanced protection are the provisions and not the principles of TRIPs; however, there are some principles clearly embodied in provisions as, e.g., Art. 7 and 8 of TRIPs.

16 The issue of whether enhanced protection (i.e., an implementation of rights more favorable to title holders or creators) is actually voluntary is quite complex. Indirect pressure and biased technical assistance may lead to uncoerced but tainted decisions. See S Sell, *Private Power, Public Law: The Globalization of Intellectual Property Rights* (2003: Cambridge University Press), pp 151-2.

17 Drexl, op. cit. [Josef Drexl, “The TRIPs Agreement and the EC: What Comes Next after Joint Competence?”, in Friedrich-Karl Beier and Gerhard Schrickler (eds), *From GATT to TRIPs – The Agreement on Trade-Related Aspects of Intellectual Property Rights*, Munich: Weinheim, [1996]

18 Comentario.... [Carlos M. Correa, *Trade Related Aspects of Intellectual Property Rights: Commentary on the TRIPs Agreement*, Oxford: Oxford University Press, 2007]

19 [Original footnote] See eg The Montevideo Treaty on Patents, signed on 16 January 1889.

20 [Original footnote] As discussed below, this Convention was incorporated into the TRIPs Agreement.

relation to Article 29 of the French law of 1844.²¹ The inconsistency of revalidation patents with the TRIPs Agreement was also found by the Argentine Supreme Court²², which declared that they were incompatible with the Paris Convention and the principles of the TRIPs Agreement.²³

Also incompatible with TRIPs would be those protections that, albeit in excess of a minimum standard, oppose principles and rules intrinsic to the agreement. For example, an enhanced patent term that is not extended to foreign filings would contravene the National Treatment principle. Less stringent patent examination criteria for software inventions would infringe the non-discrimination rule of Art 27.1²⁴.

E, exatamente tendo em vista o que agora se propõe, quais são os limites de se *voltar ao que TRIPs impunha*:

Going back to required standards

Would excessive compliance, if recognized as such, be amendable by member states, in order to regain full benefit from TRIPs? Art. 65.5 only prevents a “rolling back” to prior non TRIPs-compliant levels during the transitional periods provided under art. 65 and 66:

This is essentially a provision which prevents WTO Members from “rolling back” during the transition period, i.e., from providing a reduced degree of IP protection in their domestic laws. On the other hand, this provision also makes sure that, if under a bilateral arrangement some developing countries choose to go “TRIPs plus”, the Agreement does not prevent them from rolling back to the common TRIPs standards. This issue would exclusively be governed by the respective bilateral agreement²⁵.

Therefore, after the transitional periods expire, any eventual mistakes committed by member states (e.g., in cases where enhanced protection has not demonstrated the beneficial effects they expected), could be corrected by rolling back such protection to the level of the pertinent minimum standard, and this retroaction would not violate directly TRIPs.

However, some caution must be in order here, as those other member states that demonstrate their *reasonable expectations* that the surplus IP protection provided by the rolling-back member would not be readjusted to lesser grounds could be motivated to try *non-violation* claims to prevent the retroaction²⁶.

21 [Original footnote] See A Casalonga, *Traité Technique et pratique des brevets d'invention* (1949: Paris), pp 273, 296.

22 [Original footnote] See *Unilever NV v Instituto Nacional de Propiedad Industrial s/denegatória de patente*, reproduced in *El Derecho*, 2 August 2001.

23 [Original footnote] Bodenhausen argued that the principle of independence of the Paris Convention did not apply with regard to special patents like 'revalidation' patents. This argument, however, is unconvincing as the principle is to be applied, according to the Convention, in an 'unrestricted sense' (G Bodenhausen, *Guide to the Application of the Paris Convention of Industrial Property as revised at Stockholm in 1967* (1991: Geneva, WIPO) pp 208-9).

24 As related in Document WT/DS 153/ 1 of December 7, 1998, Canada denounced the Special Protection Certificate provided for Regulations EEC No 1768/92 and EEC No 1610/96, as incompatible with Article 27.1 of the TRIPs Agreement, as assured discriminatory advantages to the pharmaceutical sector.

25 UNCTAD-ICTSID, *op. Cit.*, p. 715. The same opinion is expressed by Nuno Carvalho, *op. cit.*, p. 751. Other standstill clause seems to have been included in the TRIPs section on Geographical Indications, as art. 24.3 freezes the TRIPs-plus levels already assured by some countries, as notes Dwijen Rangnekar in *Geographical Indications A Review of Proposals at the TRIPs Council: Extending Article 23 to Products other than Wines and Spirits*, found at http://ictsd.net/downloads/2008/06/cs_rangnekar.pdf, visited December 6, 2008.

26 See Tuan N Samahon, *TRIPs copyright dispute settlement after the transition and moratorium: Nonviolation and situation complaints against developing countries*, found at <http://www.allbusiness.com/legal/3589056-1.html>, visited December 6, 2008. Article 23 (1) (b) defines nonviolation as that which nullifies or impairs TRIPs objectives resulting from the "application by another contracting party of any measure, whether or not it conflicts with the provisions of this

Assim, ainda que a retroação aos limites mínimos de TRIPs sejam lícitos, e não violem TRIPs, há que se tomar os devidos cuidados para que não ocorram violações relativas a demandas de não-violação. Um elemento importante deste cuidado é evitar que ocorra um desbalanceamento de direitos e obrigações, e evitar que não se frustrem as expectativas razoáveis dos demais Estados-membros *ao momento em que TRIPs era negociado*.

Agreement." (...) (1) affirmative government action, such as an offending member state's application of a measure offsetting any trade benefit it had conceded; (2) the complaining member state's justified reliance on the nonoccurrence of the applied measure or event; and (3) actual injury. In claiming that the offending state applied a nullifying or impairing measure, the injured state must point to a specific measure applied by the offending state. In addition, the application of the measure must have not been "reasonably anticipated at the time that specific rights and obligations of market access were negotiated."