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European Intellectual Property Review

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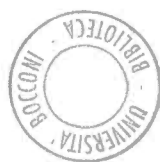


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solution retained in (G2/08) seemed legitimate,¹⁹ in particular from the point of view of legal certainty, the same does not apply to the solution retained in G3/19.

Such a practice raises questions about the very nature of the decisions of the European Office. Pursuant to art.4 EPC, the Office is the executive body of the European Patent Organisation and, as such, constitutes an administrative authority, and not a court rendering jurisdictional acts, at least if we retain the definition of the latter proposed by French authors.²⁰ On the one hand, from a formal point of view, the Examination and Opposition Divisions lack independence, whereas although it is supposed to be the prerogative of the Boards of Appeal (art.23 EPC), it has been breached in the past, the Enlarged board having itself declared that the Convention did not guarantee it the independence necessary to decide on the dismissal of a member of a Board of Appeal by the President of the Office, because of the disciplinary risks incurred by its own members.²¹ On the other hand, from a substantive point of view, *juris dictio* remains peculiar only to decisions ruling on oppositions and revoking titles. In view of the unifying role assigned to the Enlarged Board, it could, if necessary, be seen as the source of an administrative doctrine which the lower bodies of the Office will have to respect after it. However, it seems debatable whether such a doctrine should be given retroactive effect. Moreover, even if we consider that we are dealing with a judicial act, which therefore has the force of *res judicata*, new case law applies in principle in all new cases pending without it being necessary to take account of the date on which the facts occurred and even if they pre-date the development of case law.²² In this sense, it can be considered that the case law is declaratory and not constitutive of rights, since it does not create rights, so that “the old interpretation, declared null and void, and the new interpretation cannot coexist”.²³ This absence of a rights-creating character implies that decisions cannot have the force of retroactive laws. It is true, however, that in France, for example, the Court of Cassation regularly modulates the effects of its reversals over time.²⁴ But this criticised practice is unquestionably the work of a court, and moreover of the highest jurisdiction of the French civil and criminal judiciary.²⁵

In our case, the Enlarged Board sets the starting point for the effects of its decision at 1 July 2017, thus proposing a distinction between ongoing proceedings depending on whether they started before or after that date, with only the former being spared. While the logic followed is easily understandable, insofar as it is based on the entry into force of r.28(2), such a temporal delimitation is nonetheless surprising. This position undermines legal certainty by seeking to call into question

property rights—patent rights arising out of filings—which are in principle outside the scope of the decision. It would have been better for the Enlarged Board to have preserved all the proceedings in progress by declaring that its opinion was effective only for subsequent filings. By doing so, the temporal delimitation of the effects of the decision would, as in case G2/08, have contributed to the strengthening of legal certainty and not to its weakening, as in the present case.

Conclusion

While the appropriateness of the patentability of products resulting from essentially biological processes was debatable and discussed, particularly in view of the vagueness of the borderline between patent and plant variety certificate, Opinion G3/19 leaves the bitter taste of a hasty submission to the hierarchy, which was at the expense of legal certainty.

The WTO Saudi Arabia—Protection of IPRs Case and Trade-Related Enforcement of IP Rights: Reversing Course?

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© Copyright; Copyright offences; Enforcement; Intellectual property claims; Saudi Arabia; TRIPS

Abstract

The TRIPS Agreement provides for several obligations on the enforcement of IP rights. This article explores the implications of the recent decision by the WTO Panel in

the case Saudi Arabia-Protection of IPRs clarifying the scope of some of these obligations in light, in particular, of prior WTO cases.

Introduction

The inclusion of provisions on the enforcement of intellectual property rights (IPRs) in the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement or TRIPS; Pt III (arts 41–61)) at the World Trade Organization (WTO) has been “the most dramatic change in focus of international IPRs rulemaking”.¹ With time, IPRs enforcement has become “a priority in trade and IPRs negotiations”.²

Despite this growing relevance, the vague and broad language enforcement provisions in the TRIPS Agreement are couched in has raised several doubts. Indeed, some commentators have pointed out that “it is not entirely clear to what extent the [WTO] Members are obliged not only to ensure that enforcement remedies are available but also to provide for their effectiveness in practice”.³ And in WTO cases addressing the subject, such as *US-Section 211 Appropriations Act*⁴ or *China-Intellectual Property Rights*,⁵ panels and the Appellate Body (AB) have confirmed that WTO Members are left with a high degree of discretion.

The recent Panel’s report in *Saudi Arabia-Protection of IPRs* sheds further light on the subject.⁶ This article explores the implications of the Panel’s decision in respect, in particular, of the relevant IPRs enforcement provisions invoked in the case (arts 41, 42 and 61 of the TRIPS Agreement), and its relationship to prior jurisprudence on the subject. This article argues that, while the Panel pays lip service to prior panels and the AB’s reports, it takes a decisive turn towards more demanding IPRs enforcement obligations. Moreover, the Panel reaches its conclusion with an at times not fully convincing reasoning.

After a brief overview of enforcement provisions in the TRIPS Agreement and a discussion showing the apparent jurisprudential and doctrinal agreement on IPRs enforcement provisions flexible interpretation, the article focuses on the Panel’s report in *Saudi Arabia-Protection of IPRs*. In this regard, although the Panel’s report is also relevant for the Panel’s interpretation of the TRIPS Agreement security exception provision (art.73), this

article focuses mainly on the part of the Panel’s report concerning IPRs enforcement. After discussing the implications of the Panel’s report, some general conclusions are articulated in the last section of this article.

Trade-related enforcement of IP rights—where do we stand?

As noted above, the TRIPS Agreement has been the first to introduce rules on IPRs enforcement multilaterally at the international level. The 20 articles the Agreement dedicates to IPRs enforcement are divided into general obligations (art.41), obligations on civil and administrative procedures and remedies (arts 42–49), obligations on provisional measures (art.50), special requirements related to border measures (arts 51–60) and obligations on criminal procedures (art.61). As clarified by the Panel in *EC-Trademarks and Geographical Indications (Australia)*, Pt III of the TRIPS Agreement only covers the enforcement of IPRs as opposed to issues related to the acquisition of IPRs such as the possibility for interested parties to object to IPRs grants (something which falls, instead, under Pt IV of the TRIPS).⁷

Enforcement of IPRs was mentioned already in the 1986 *Ministerial Declaration of Punta del Este* on “Trade-related aspects of intellectual property rights, including trade in counterfeit goods”. The US considered the subject of both internal enforcement and border enforcement of IPRs an important issue even before TRIPS negotiations, and actively put it on the negotiation table since their start.⁸ Other negotiating parties such as the European Community (EC) aligned with the US only later, or just kept opposing the idea, as several developing countries did.⁹ IPRs enforcement continued to be a priority for the US even after the negotiations of the TRIPS Agreement had ended.¹⁰ The subject has nonetheless continued to be a sensitive one. While the protection of IPRs may be “of little value if there are no effective procedures for the enforcement of such rights”, the wide differences existing between national legislations on IPRs enforcement have led to the TRIPS including just some general IPRs enforcement standards.¹¹

In practical terms, TRIPS’ enforcement provisions are couched in a broad language and seem to leave a high margin of discretion to WTO Members. The Preamble

¹ F.M. Abbott et al, *International Intellectual Property in an Integrated World Economy* (US: Wolters Kluwer, 2019), p.885.

² Abbott et al, *International Intellectual Property in an Integrated World Economy* (2019), p.885.

³ S. Vander, “Article 41” in P.-T. Stoll et al (eds), *WTO—Trade-Related Aspects of Intellectual Property Rights* (Leiden & Boston: Martinus Nijhoff Publishers, 2009), p.689.

⁴ WTO Appellate Body Report, *United States—Section 211 Omnibus Appropriations Act of 1998*(US-Section 211 Appropriations Act), WT/DS176/AB/R (adopted on 1 February 2002).

⁵ WTO Panel Report, *China—Measures Affecting the Protection and Enforcement of Intellectual Property Rights (China-Intellectual Property Rights)*, WT/DS362/R (adopted on 20 March 2009).

⁶ WTO Panel Report, *Saudi Arabia—Measures Concerning the Protection of Intellectual Property Rights*(Saudi Arabia-Protection of IPRs), WT/DS567/R (circulated on 16 June 2020). On 28 July 2020, Saudi Arabia has notified the Dispute Settlement Body (DSB) of its decision to appeal the Panel’s report.

⁷ WTO Panel Report, *European Communities—Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs*(EC-Trademarks and Geographical Indications (Australia)), WT/DS290/R (adopted on 20 April 2005), para.7.731.

⁸ A. Otten, “The TRIPS Negotiations: An Overview” in J. Watal and A. Taubman (eds), *The Making of the TRIPS Agreement: Personal Insights from the Uruguay Round Negotiations* (World Trade Organization: Geneva, 2015), p.61.

⁹ Otten, “The TRIPS Negotiations: An Overview” in *The Making of the TRIPS Agreement* (2015), p.61.

¹⁰ M. Kennedy, *WTO Dispute Settlement and the TRIPS Agreement: Applying Intellectual Property Standards in a Trade Law Framework*. (Cambridge: Cambridge University Press, 2018), p.13.

¹¹ UNCTAD-ICTSD, *Resource Book on TRIPS and Development* (Cambridge: Cambridge University Press, 2005), p.575.

¹⁹ ABBOTT RESPIRATORY/Dosage regime (G2/08) [2010] E.P.O.R. 26; (2010) 114 B.M.L.R. 108.

²⁰ See G. Couchez and X. Lagarde, *Procédure civile*, 17th edn (Paris: Sirey Universités, 2014), No.212.

²¹ Request for a proposal of removal from office (G2301/16) 14 June 2016 EPO, EBA.

²² See P. Roubier, *Le droit transitoire (conflit de lois dans le temps)*, 2nd edn (Paris: Dalloz, 1960), p. 25.

²³ H. Battifol, note Rev. crit. DIP 1975, p.79.

²⁴ See Rapport “Molfessis” sur les revirements de jurisprudence (Paris: Litec, 2005).

²⁵ On these criticisms, see, for instance, F. Terré, *Introduction générale au droit*, 8th edn (Paris: Dalloz, Précis, 2009), No.533.

of the TRIPS already recognises the need for provisions on effective and appropriate IPRs enforcement means, “taking into account differences in national legal systems”. In general, “Members shall be free to determine the appropriate method of implementing the provisions [of the TRIPS Agreement] within their own legal system and practice” (art.1.1). In addition, with specific regard to enforcement obligations, “[n]othing in this Part [Pt III—Enforcement of IPRs] creates any obligation with respect to the distribution of resources as between enforcement of intellectual property rights and the enforcement of law in general” (art.41.5). This latter provision was adopted to reflect concerns of developing countries on the costs of IPRs enforcement and,¹² together with art.1.1, it has been regarded as a “key safeguard[s] against demands for overzealous enforcement of” IPRs.¹³ Moreover, WTO Members have a general obligation to make fair and equitable civil and judicial procedures concerning IPRs enforcement available to right holders, together with some specific procedural obligations, including for parties to be allowed to be represented by independent legal counsel (art.42); an obligation to give their judicial authorities the power to order prompt and effective provisional measures (art.50); and an obligation to “provide for criminal procedures and penalties to be applied at least in cases of wilful trade mark counterfeiting and copyright piracy on a commercial scale” (art.61), among others.

The combination of enforcement obligations and the possibility to resort to the WTO dispute settlement mechanism for any violation of obligations under WTO Agreements “put teeth” not only to the TRIPS but also to the provisions of prior conventions that have been “incorporated” or “adapted”¹⁴ into the TRIPS.¹⁵ On the one hand, the broad legal standards TRIPS enforcement provisions have been drafted in have resulted in some room for manoeuvre for WTO Members. Indeed, broad legal standards “allow[s] either the Council for TRIPS or duly appointed dispute-settlement panels to take local circumstances and diverse legal philosophies into account when seeking to mediate actual or potential conflicts between states”.¹⁶ On the other hand, the “inherent ambiguity” of enforcement provisions make them, according to some views, the “Achilles heel” of the Agreement.¹⁷ Thus, while the inclusion of IPRs enforcement obligations was initially praised, after more

careful consideration these obligations have been regarded simply as “truly minimum standards of due process”.¹⁸ According to some commentators, this situation was (is) not surprising as a set of diverse reasons from countries’ resources and capacity constraints to technological challenges have concurred with it.¹⁹

Panels and the AB have confirmed the existence of a wide margin of discretion for WTO Members in the field of IPRs enforcement. In *US-Section 211 Appropriations Act*, faced with the question of whether US s.211 applying to trade marks and trade names was consistent with the obligations under art.42 of the TRIPS Agreement, the AB held that enforcement procedures under the TRIPS Agreement “provide for an internationally-agreed minimum standard which Members are bound to implement in their domestic legislation”.²⁰ Under art.42, right holders “are entitled [...] to have access to civil judicial procedures that are effective in bringing about the enforcement of their rights covered by the Agreement”. Nevertheless, art.42 does not define “civil and judicial procedures” and, in this sense, the Agreement reserves “a degree of discretion to Members ... subject to the procedural minimum standards set out in that Agreement”.²¹ Moreover, “[t]here is nothing in the procedural obligations of Article 42 that prevents a Member, in such a situation, from legislating whether or not its courts must examine each and every requirement of substantive law at issue before making a ruling”.²²

IPRs enforcement obligations have been addressed also in *China-Intellectual Property Rights*, a case revolving around criminal procedures and penalties in cases of wilful trade mark counterfeiting or copyright piracy on a commercial scale in Chinese law and the disposal of IPRs-infringing goods confiscated by customs authorities, among others.²³ In that case, China argued that while its criminal law allowed for the possibility of private prosecution of certain crimes, defining a threshold for crimes that is too low would have resulted in a wave of private enforcement actions thus imposing a burden on the judicial system.²⁴ The Panel considered just that China had not substantiated its concern,²⁵ but this consideration has been regarded as an implicit recognition of “the possibility of using resource constraints to justify derogations from TRIPS enforcement obligations” under art.41.5.²⁶ Also, the Panel was very cautious when defining the concept of “commercial scale” in respect of

the US’ claim that China did not provide for criminal penalties against copyright infringement on a commercial scale in violation of art.61 of the TRIPS. The Panel held that “Article 61 contains no fewer than four limitations on the obligation that it sets forth”:²⁷ (1) it only applies to trade marks and copyright rather than all IPRs²⁸; (2) it only applies to counterfeiting and piracy rather than all infringements of trade marks and copyright²⁹; (3) it applies only to “wilful” trade mark counterfeiting and copyright piracy³⁰; and (4) it applies only to trade mark counterfeiting and copyright piracy “on a commercial scale”.³¹ Confronted with parties’ disagreement as to the meaning of the term “on a commercial scale”, the Panel held that the term involves an evaluation both in qualitative (when it refers to a “commercial” activity) and quantitative (when it makes reference to a certain “scale”) terms.³² The Panel concluded that the term

“on a commercial scale ... depend[s] on circumstances, which vary according to the differing forms of commerce and of counterfeiting and piracy to which these obligations apply”.³³

Hence, authoritative scholars have concluded that the Panel’s cautious understanding of the term “‘commercial scale’ makes it possible to adapt the obligations under the Agreement in terms of penalties to the specific domestic circumstances and needs of the country in question”.³⁴

To all this, one should add that, in the quarter-century since the adoption of the TRIPS, IPRs enforcement has been subject to, at least, two clear trends. On the one hand, IPRs enforcement rules have expanded through higher enforcement standards (TRIPS-plus) under bilateral and regional trade or economic agreements. The types of IPRs enforcement provisions in these agreements vary widely, spanning comprehensive regimes of enforcement to specific border measures provisions.³⁵ On the other hand, plurilateral efforts at adopting higher enforcement standards under the Anti-Counterfeiting Trade Agreement (ACTA) have been unsuccessful owing to unexpected business and civil society opposition, among others.³⁶ In any case, as authoritatively noted,

“[e]ven ACTA, which attempts to reduce the states’ room to maneuver, nonetheless acknowledges that its enforcement requirements must take into account ‘differences in [states’] respective legal systems and practices’”.³⁷

IPRs enforcement obligations in Saudi Arabia-protection of IPRs

The *Saudi Arabia-Protection of IPRs* dispute emerged out of growing tensions between countries in the Gulf region in the Middle East, leading to the severance by Saudi Arabia of diplomatic relations with Qatar.³⁸ These tensions, Qatar argued, had resulted in Saudi Arabia applying against Qatar “a scheme of coercive economic measures” impacting on several Qatari companies, including the beIN Media group LLC and its affiliates (“beIN”), an international Qatari company involved in the sports and entertainment business.³⁹ Moreover, in 2017, a broadcasting entity called beoutQ started to engage in several IPRs infringement activities.⁴⁰

The Panel held that of the six alleged Saudi Arabian measures that Qatar challenged in the dispute, there was evidence of the actual impact only of: (1) the anti-sympathy measures subjecting “lawyers based in Saudi Arabia to legal jeopardy if they express support for and/or provide assistance to Qatar and Qatari nationals, and thereby prevent[ing] beIN from securing legal representation needed to access civil enforcement procedures against infringement” of its IPRs; (2) the non-application of criminal procedures and penalties against beoutQ “despite the evidence that beoutQ’s activity constitute[s] copyright piracy on a commercial scale and the evidence that it is directed and controlled by persons and entities subject to the criminal jurisdiction of Saudi Arabia”; and (3) the promotion of public gatherings with screenings of beoutQ’s unauthorised broadcasts.⁴¹ It is worth noting that the Panel explicitly recognised that Qatar had not demonstrated “the existence of formal legal restrictions being applied to prevent beIN from accessing civil enforcement procedures”.⁴² These measures, according to Qatar, resulted in (1) Qatari nationals not being able to protect their IPRs; (2) the violation of the TRIPS national treatment and most-favoured-nation treatment obligations; (3) an undue

¹² P. Van den Bossche and W. Zdouc, *The Law and Policy of the World Trade Organization: Text, Cases and Materials* (Cambridge: Cambridge University Press, 2017), p.1043.

¹³ P.K. Yu, “TRIPS Enforcement and Developing Countries” (2011) 26 *American University International Law Review* 727, 729.

¹⁴ Some scholars prefer the term “adaptation” rather than “incorporation”: see J. Busche et al., “Article 2. Intellectual Property Conventions” in J. Busche et al (eds), *WTO—Trade-Related Aspects of Intellectual Property Rights* (Leiden/Boston: Brill | Nijhoff, 2009), pp.98, 213.

¹⁵ J.H. Reichman, “Enforcing the Enforcement Procedures of the TRIPS Agreement” (1996) 37 *Virginia Journal of International Law* 335, 339.

¹⁶ Reichman, “Enforcing the Enforcement Procedures of the TRIPS Agreement” (1996) 37 *Virginia Journal of International Law* 335, 344.

¹⁷ J.H. Reichman and D. Lange, “Bargaining Around the TRIPS Agreement: The Case for Ongoing Public-Private Initiatives to Facilitate Worldwide Intellectual Property Transactions” (1998) 9 *Duke Journal of Comparative & International Law* 11, 34.

¹⁸ Reichman and Lange, “Bargaining Around the TRIPS Agreement” (1998) 9 *Duke Journal of Comparative & International Law* 11, 34.

¹⁹ P.K. Yu, “TRIPS and Its Achilles’ Heel” (2011) 18 *Journal of Intellectual Property Law* 479, 479.

²⁰ WTO Appellate Body Report, *US-Section 211 Appropriations Act* (2002), paras 206–207.

²¹ WTO Appellate Body Report, *US-Section 211 Appropriations Act* (2002), para.216.

²² WTO Appellate Body Report, *US-Section 211 Appropriations Act* (2002), para.226.

²³ WTO Panel Report, *China-Intellectual Property Rights* (2009), paras 2.2–2.4.

²⁴ WTO Panel Report, *China-Intellectual Property Rights* (2009), para.7.598.

²⁵ WTO Panel Report, *China-Intellectual Property Rights* (2009), para.7.598.

²⁶ Yu, “TRIPS and Its Achilles’ Heel” (2011) 18 *Journal of Intellectual Property Law* 479, 780.

²⁷ WTO Panel Report, *China-Intellectual Property Rights* (2009), para.7.518.

²⁸ WTO Panel Report, *China-Intellectual Property Rights* (2009), para.7.518.

²⁹ WTO Panel Report, *China-Intellectual Property Rights* (2009), para.7.519.

³⁰ WTO Panel Report, *China-Intellectual Property Rights* (2009), para.7.523.

³¹ WTO Panel Report, *China-Intellectual Property Rights* (2009), para.7.524.

³² WTO Panel Report, *China-Intellectual Property Rights* (2009), paras 7.538–7.543.

³³ WTO Panel Report, *China-Intellectual Property Rights* (2009), para.7.578.

³⁴ C. Geiger, “Towards a Balanced International Legal Framework for Criminal Enforcement of Intellectual Property Rights” in H. Ullrich and others (eds), *TRIPS Plus 20: from Trade Rules to Market Principles* (Berlin & Heidelberg: Springer, 2016), pp.650–651.

³⁵ X. Seuba, *The Global Regime for the Enforcement of Intellectual Property Rights* (Cambridge: Cambridge University Press, 2017), pp.99–100.

³⁶ P.C. Mogens, “Evaluating the TRIPS Negotiations: A Plea for a Substantial Review of the Agreement” in J. Watal and A. Taubman (eds), *The Making of the TRIPS Agreement: Personal Insights from the Uruguay Round Negotiations* (Geneva: World Trade Organization: 2015), p.108.

³⁷ G.B. Dinwoodie and R.C. Dreyfuss, *A Neofederalist Vision of TRIPS: The Resilience of the International Intellectual Property Regime* (Oxford: Oxford University Press, 2012), p.192.

³⁸ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.2.16.

³⁹ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), paras 2.18, 2.30.

⁴⁰ beoutQ started to distribute and stream media content created by or licensed to beIN without authorisation, started to sell set-top boxes to receive satellite broadcasts of pirated content, and started to sell advertising slots on its pirated channels; see WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), paras 2.40–2.45.

⁴¹ See WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), paras 2.47, 7.42, 7.73, 7.94–7.95, 7.155, 7.157–7.163.

⁴² WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.164.

difficulty “for Qatari nationals to access civil judicial remedies, or to seek remedies, in respect of enforcement” of IPRs (in violation of arts 41.1 and 42 of the TRIPS); and (4) “Saudi Arabia’s omission to prosecute, as a criminal violation, piracy on a commercial scale, of material in which copyright is owned by, or licensed to, Qatari nationals” (in violation of art.61 of the TRIPS).⁴³

For its part, Saudi Arabia requested the Panel to reject Qatar’s claims in their entirety or, in the alternative, to find that Saudi Arabia’s measures were justified under the security exception of art.73(b)(iii) of the TRIPS Agreement.⁴⁴ Among others, Saudi Arabia argued that the measures contested by Qatar “either do not exist or do not have the effects alleged by Qatar”,⁴⁵ and that, in any case, the Panel should have declined to make any finding or recommendation given the “political, geopolitical and essential security” nature of the dispute.⁴⁶

The Panel acknowledged that the evidence provided by Qatar in respect of Saudi’s “anti-sympathy measures” was limited (evidence was mainly based on a Twitter statement by a Saudi news agency) and that Saudi Arabia had not enacted “any specific law or regulation establishing the general anti-sympathy measures”.⁴⁷ Nevertheless, multiple reports from Saudi news outlets proved the existence of the measures.⁴⁸ After referring to *US-Section 211 Appropriations Act*, the Panel concluded that Saudi Arabia’s measures had in practice “the result of preventing beIN from obtaining Saudi legal counsel to enforce its IP rights through civil enforcement procedures before Saudi courts and tribunals”, in violation of the right of parties to be allowed to be represented by independent legal counsel under art.42.⁴⁹ Interestingly, the Panel also held that

“the violation of the obligation under Article 42 of the TRIPS Agreement to allow parties to be ‘represented by independent legal counsel’ gives rise to a consequential violation of the obligation under Article 41.1 to ‘ensure that enforcement procedures as specified in this Part are available under their law’.”⁵⁰

In respect of Qatar’s art.61-related claims, the Panel first recalled the Panel’s findings in *China-Intellectual Property Rights*.⁵¹ The Panel stressed that the question of

the meaning of Members’ obligations under art.61 to provide for criminal procedures and penalties “to be applied” had never been dealt with in prior WTO jurisprudence.⁵² The Panel held that

“the obligation in the first sentence of Article 61 of the TRIPS Agreement is not automatically discharged through the creation of a formal written law that provides for the criminalization of wilful commercial-scale piracy without regard to whether and, if so, how the written law is applied in practice”.⁵³

In its reasoning, the Panel focused on the meaning of the verb “to apply” as “to put into practical operation”.⁵⁴ In its view, this was particularly relevant if contrasted with the term “shall make available” used in art.42.⁵⁵ Moreover, “a restrictive interpretation of the terms ‘shall provide for criminal procedures and penalties to be applied’ would also be at odds with the object and purpose of art.61. The object and purpose of art.61 includes singling out what negotiators of the TRIPS Agreement understood to be the two “most blatant and egregious acts of infringement” and “[t]his view must inform the interpretation of Article 61.” A restrictive interpretation of the obligation in the first sentence of art.61 would also be difficult to reconcile with the TRIPS Agreement’s overall object and purpose of “provid[ing] effective and appropriate means for the enforcement” of trade-related IP rights, as reflected in subparagraph (c) of the second recital of the preamble”.⁵⁶

The Panel then confirmed that beoutQ’s conduct amounted to “wilful ... copyright piracy on a commercial scale”.⁵⁷ In particular, beoutQ’s conduct amounted to “copyright piracy on a commercial scale” as beoutQ had “initially streamed pirated content online, and then expanded to the retail sale of beoutQ-branded STBs throughout Saudi Arabia and other countries”; had allegedly sold “advertising slots on its 10 pirated channels” and “had promoted its pirated streams on a variety of social media platforms”.⁵⁸ This conduct was certainly wilful as, looking at the “infringer’s intent”, it was not “infringing on third-party copyright in a manner that could be characterised as unintentional, accidental, or inadvertent”.⁵⁹ Moreover, Qatar had established a *prima facie* case that beoutQ was “operated by individuals or

entities subject to criminal jurisdiction of Saudi Arabia”⁶⁰ and, despite Saudi Arabia’s assertions that its authorities had taken actions to seize beoutQ’s STBs, Saudi Arabia had not suggested that any such seizures were “criminal procedures and penalties” in the sense of art.61 or that they related to beoutQ’s copyright piracy.⁶¹ Therefore, despite the existence in Saudi Arabia of a written law providing for criminal procedures and penalties consistent with art.61, by not providing for criminal procedures and penalties “to be applied” to beoutQ Saudi Arabia had violated art.61.⁶²

The Panel then considered it appropriate to exercise judicial economy in respect of Qatar’s remaining claims.⁶³ The remaining part of the Panel’s Report was dedicated to Saudi Arabia’s invocation of art.73(b)(iii) of the TRIPS Agreement. On this point, the Panel found that Saudi Arabia’s measures that directly or indirectly had prevented beIN from obtaining Saudi legal counsel to enforce its IPRs through civil enforcement procedures in Saudi Arabia in violation of arts 42 and 41.1 were justified under art.73(b)(iii); conversely, Saudi Arabia’s non-application of criminal procedures and penalties to beoutQ in violation of art.61 was not justified under art.73(b)(iii).⁶⁴

...Reversing course?

The question of IPRs enforcement obligation is very sensitive: this is testified by the number of third parties participating in *Saudi Arabia-Protection of IPRs* (19 WTO Members, both developed and developing members).⁶⁵

In its report, the Panel appears to have taken a decisive stance in favour of more demanding IPRs enforcement obligations. The Panel found that arts 42 and 41.1 apply to “informal” measures (in the words of the Panel, measures that are not formally established by laws or regulation). Moreover, the Panel held that the existence of formal written law(s) is not sufficient to discharge the obligation under art.61 since attention is to be paid also to how the law is applied in practice. These conclusions are partly tempered down by the Panel itself. On the one hand, the Panel has clarified that

“[i]n cases where a Member has not taken actions that could lead to the application of criminal procedures and penalties against wilful commercial-scale piracy, an assessment of compliance with Article 61 must consider the evidence available to the authorities and other relevant circumstances”.⁶⁶

Hence, the obligation to apply criminal procedures and penalties to the specific cases provided for in art.61 seems not to be absolute. On the other hand, the Panel did “not consider it necessary to determine further, in the abstract, the scope of the obligation to ‘provide for criminal procedures and penalties to be applied’”.⁶⁷ Thus, the Panel appears to tone down its own conclusions on the scope of obligations under art.61.

First, the Panel’s conclusion has important implications as it may indirectly restrict *de facto* the margin of discretion left to WTO Members by art.41.5 of the TRIPS in respect of the allocation of resources to IPRs enforcement. Formally, the Panel’s conclusion may seem consistent with the idea that, following *China-Intellectual Property Rights*, art.41.5 implicitly recognises “the possibility of using resource constraints to justify derogations from TRIPS enforcement obligations”.⁶⁸ However, in practical terms, more demanding IPRs enforcement obligations may require a higher amount of resources from WTO Members to be complied with.

Secondly, the Panel took a decisive stance on the scope of obligations under art.61 of the TRIPS amid disagreement of WTO Members. As the Panel noted:

“With respect to the interpretation of Article 61, the third parties presented diverse views. Several third parties, including Brazil, Canada and Ukraine, made arguments consistent with Qatar’s interpretation of this provision and submitted that this obligation requires more than merely ‘writing down’ certain criminal procedures and penalties in a Member’s domestic law. Several other third parties, including China, Singapore and the UAE, advanced a more restrictive interpretation, arguing that the obligation under Article 61 is fully discharged by the ‘writing down’ of criminal procedures and penalties in a Member’s domestic law.”⁶⁹

The EU and Japan considered that, under art.61, Members are just obliged to adopt criminal laws and make procedures available to interested parties.⁷⁰ The absence of an investigation and punishment of cases falling under this provision does not amount to a violation of this provision but a “constant” or “systematic” lack of enforcement “may” amount to a violation of art.61.⁷¹ As noted, this diverse spectrum of opinions may be explained in light of the vague language of the TRIPS enforcement provisions and the flexibility the Agreement leaves Members in this respect.

⁴³ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), paras 2.46, 3.1, 7.166.

⁴⁴ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.3.3.

⁴⁵ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.38.

⁴⁶ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.7 onwards.

⁴⁷ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), paras 7.55–7.58.

⁴⁸ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.59.

⁴⁹ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.194.

⁵⁰ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.198.

⁵¹ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), paras 7.202–7.205.

⁵² WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.602.

⁵³ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.702.

⁵⁴ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.208.

⁵⁵ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.209.

⁵⁶ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.211, quoting also WTO Panel Report, *China-Intellectual Property Rights* (2009), para.7.528.

⁵⁷ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.214.

⁵⁸ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.215.

⁵⁹ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.217.

⁶⁰ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.219.

⁶¹ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.220.

⁶² WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.221.

⁶³ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), paras 7.223–7.228.

⁶⁴ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), paras 7.241 onwards, 8.1.

⁶⁵ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.1.6.

⁶⁶ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.702.

⁶⁷ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.213.

⁶⁸ Yu, “TRIPS and Its Achilles’ Heel” (2011) 18 *Journal of Intellectual Property Law* 479, 780.

⁶⁹ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.179.

⁷⁰ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.179.

⁷¹ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.179.

In reaching its conclusion, the reasoning of the Panel was heavily based on a literal interpretation and the comparison of the language arts 42 and 61 are couched in, respectively. This approach seems fully in line with the long-preferred literal interpretation approach of the AB.⁷² A “rigorous textual approach” has been resorted to by panels and the AB both explicitly or through a “formalistic and mechanical” approach to the rules of treaty interpretation.⁷³ However, despite the text of a treaty being “equally authoritative in each language” the treaty is authenticated in,⁷⁴ the AB’s literal analysis has not applied equally to the three official languages of WTO Agreements (English, French, and Spanish).⁷⁵ Indeed, as some scholars have pointed out, the French and Spanish texts of WTO Agreements are not taken into account in every single WTO case and “[i]n practice, the Appellate Body and the parties to dispute treat the English text as if it were a ‘master’ text”.⁷⁶ Specifically, in *Saudi Arabia-Protection of IPRs*, the French and Spanish versions of the TRIPS Agreement may not warrant the same conclusion reached by the Panel. By looking at the English text of art.61, the Panel concluded that the term “shall provide” in art.61 means “to put into practical operation”, thus requiring Members not only to adopt written laws on criminal procedures and penalties but also to apply the law. This view is supported, according to the Panel, by the comparison of the English text of art.61 and the English text of art.42 which, in turn, provide that Members “shall make available to right holders civil judicial procedures”, and with the phrase “shall have the authority” in arts 44, 45 and 46 of the TRIPS.⁷⁷ Indeed, in the French version of the TRIPS Agreement, under art.61, “[l]es Membres prévoient des procédures pénales”, whereas under art.42, “[l]es Membres donneront aux détenteurs de droits”. The Spanish version is similar to the French one, art.61 providing that “[L]os Miembros establecerán procedimientos y sanciones penales” and art.42 that “[l]os Miembros pondrán al alcance de los titulares de derechos”.

Also, the conclusion reached by the Panel on art.61 somehow echoes its conclusions on art.42 that, while WTO Members are still left with some degree of discretion as to the type of “civil judicial procedures” they may adopt,⁷⁸ the obligation under art.42 means that procedures have not only to be formally available but

also to be “obtainable ... to have access to civil judicial procedures that are effective in bringing about the enforcement of their rights covered by the Agreement”.⁷⁹ However, as discussed above, despite the merits of the Panel’s view that IPRs enforcement obligations go beyond the adoption of formal legislation for these obligations not to be deprived of content, the reasoning of the Panel could have been more thorough.

In this context, it is also worth noting that, although the Panel refers to the object and purpose of art.61 and the overall object and purpose of the TRIPS Agreement, it does not assess nor mention arts 7 and 8 of the TRIPS Agreement on the objectives and principles of the Agreement, respectively. The relevance of these two provisions in general has been stressed in the 2001 Doha Ministerial Declaration and,⁸⁰ recently, in the TRIPS Council by South Africa also in respect of IPRs enforcement.⁸¹ Following these two provisions, it has been argued, IPRs enforcement should be mutually advantageous to producers and users of IPRs, thus balancing rights and obligations and leaving WTO Members with enough policy space in the field of IPRs enforcement.⁸² In this respect, the Panel’s approach in *Saudi Arabia-Protection of IPRs* fully reflects a common problem of panels that, in the past, have paid only lip service to the TRIPS Agreement’s object and purpose, also with specific regard to art.61.⁸³

More importantly, at a first reading, the Panel seems to follow prior WTO jurisprudence on the subject. However, on some points, the Panel pays only lip service to prior decisions. Indeed, although the question of the exact scope of art.61 and the term “shall provide” had not been dealt with in prior cases, in its analysis of art.61 in the case *China-Intellectual Property Rights*, the Panel had referred *en passant* to “an obligation to make such penalties available”,⁸⁴ “to provide for the application of criminal procedures and penalties”,⁸⁵ and “to criminalize” certain acts.⁸⁶ Since in *Saudi Arabia-Protection of IPRs*, the Panel referred extensively to the Panel’s report *China-Intellectual Property Rights*, more attention to why the Panel in that case used a language which does not fully match with the conclusion of the Panel in *Saudi Arabia-Protection of IPRs* may have been warranted for. This remark sheds light on a broader “selective” approach by the Panel in *Saudi Arabia-Protection of IPRs*: indeed, when assessing the invocation by Saudi Arabia of the

security exception under art.73(b)(iii) of the TRIPS Agreement, the Panel held that the “analytical framework” established by the Panel in the case *Russia-Traffic in Transit*,⁸⁷ when interpreting art.XXI(b)(iii) of the General Agreement on Tariffs and Trade of 1994 (GATT 1994) “can guide the assessment of the Panel [in *Saudi Arabia-Protection of IPRs*] of whether a respondent has properly invoked” art.73(b)(iii) of the TRIPS.⁸⁸ In addition, both disputing parties and the third parties agreed that the analysis of the Panel in *Russia-Traffic in Transit* could be “transposed” to art.73(b)(iii) of the TRIPS.⁸⁹ Nonetheless, in *Saudi Arabia-Protection of IPRs* the Panel proceeded to assess Saudi Arabia’s invocation of the security exception under art.73(b)(iii) of the TRIPS Agreement only after it had found that Saudi Arabia had violated its obligations under the TRIPS Agreement. Conversely, in *Russia-Traffic in Transit*, the Panel held that under art.XXI(b)(iii) there is no need to evaluate whether the measures at stake are in violation of the GATT 1994. In order to assess whether the measures at stake fall under art.XXI(b)(iii), the Panel only has to assess whether the measures fall under its terms of references, that they exist, and that they are taken during time of war or other emergency in international relations.⁹⁰

Hence, whereas, as noted, the conclusion of the Panel as to the scope of IPRs enforcement obligations may appear logical and prevent enforcement obligations to be deprived of meaning, the reasoning of the Panel raises some questions in terms of coherence and of consistency with prior WTO jurisprudence.

Conclusion

In *Saudi Arabia-Protection of IPRs*, the Panel takes a clear stance in favour of a wider scope of IPRs enforcement obligations under the TRIPS Agreement. To reach its conclusion, the Panel performs a textual analysis of relevant TRIPS provisions and refers to prior WTO cases. Nonetheless, as already pointed out, the textual analysis of the Panel may have been more thorough, and the assessment of prior WTO cases less selective. In any event, the conclusion of the Panel has the merits of safeguarding the meaning of IPRs enforcement obligations: IPRs enforcement provisions such as arts 42 and 61 entail obligations to make civil judicial procedures and criminal procedures and penalties effective. The mere adoption of IPRs enforcement provisions may not be enough for WTO Members to discharge their obligations under the TRIPS Agreement. Otherwise, the risk may be for enforcement obligations to be deprived of any significance in practice.

⁸⁷ WTO Panel Report, *Russia—Measures Concerning Traffic in Transit (Russia-Traffic in Transit)*, WT/DS512/R (adopted on 26 April 2019)(*Russia-Traffic in Transit*), WT/DS512/R (adopted on 26 April 2019).

⁸⁸ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.241.

⁸⁹ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.243.

⁹⁰ WTO Panel Report, *Russia-Traffic in Transit* (2019), paras 7.108–7.109.

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In this context, the Panel’s Report is in line with prior WTO jurisprudence by giving pre-eminence to the English text of the TRIPS Agreement and only limited relevance to a complete “object and purpose” analysis of the Agreement and its relevant provisions. Along these lines, given the sensitivity of the subject and WTO Members’ disagreement on the subject, the reasoning of the Panel could have included an assessment of the French and Spanish versions of the TRIPS Agreement, of the object and purpos(es) of the Agreement and of prior WTO jurisprudence.

On 28 July 2020, Saudi Arabia notified to the WTO Dispute Settlement Body its decision to file an appeal in respect of the Panel’s report. Yet, in the absence of a fully functioning Appellate Body, no AB’s report is expected in the near future. In the end, in particular in light of the current stall of the WTO dispute settlement mechanism, with the renewal of AB members’ nominations being blocked, the Panel’s Report in *Saudi Arabia-Protection of IPRs* provides for key clarifications and possible new directions on this sensitive, highly debated subject. Given WTO Members’ opposed views on it, further developments may loom on the horizon.

When Your Trade Mark Is Not Ale It’s Cracked Up to Be

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☞ Australia; Beer; Confusion; Defences; Descriptive marks; Distinctiveness; Infringement; Passing off; Trade marks

Abstract

In Urban Alley Brewery Pty Ltd v La Sirène Pty Ltd, O’Brien J dismissed a claim for trade mark infringement against La Sirène Pty Ltd brought by Urban Alley Brewery Pty Ltd for a breach of its URBAN ALE trade mark. In the process, O’Brien J held the URBAN ALE trade mark should be removed from the register because it was not distinctive, and on account of the mark being likely to deceive or cause confusion under s.88 of the Trade Marks Act 1995 (Cth). The decision highlights the perils of registering descriptive trade marks and the advantage of adopting truly distinctive beer labels. And as much as the new generation of craft brewers want to

⁷² C.-D. Ehlermann, “Six Years on the Bench of the ‘World Trade Court’ in F. Ortino and E.-U. Petersmann (eds), *The WTO Dispute Settlement System 1995–2003* (The Hague/London/New York: Kluwer Law International, 2004), p.509.

⁷³ F. Ortino, “Treaty Interpretation and the WTO Appellate Body Report in US—Gambling: A Critique” (2006) 9 *Journal of International Economic Law* 117.

⁷⁴ Article 33.1 of the Vienna Convention on the Law of Treaties (adopted on 23 May 1969; entered into force on 27 January 1980), U.N.T.S. 1155, p.331.

⁷⁵ WTO, Final Act Embodying the Results of the Uruguay Round of Multilateral Trade Negotiations (Geneva, 1994).

⁷⁶ B.J. Condon, “Lost in Translation: Plurilingual Interpretation of WTO Law” (2010) 1 *Journal of International Dispute Settlement* 191, 204, 215.

⁷⁷ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.209.

⁷⁸ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.188.

⁷⁹ WTO Panel Report, *Saudi Arabia-Protection of IPRs* (2020), para.7.187.

⁸⁰ WTO Ministerial Conference, Ministerial Declaration (adopted on 14 November 2001), WT/MIN(01)/DEC/1 (20 November 2001), para.19.

⁸¹ WTO Council for Trade-Related Aspects of Intellectual Property Rights, Minutes of Meeting Held on 17–18 October 2019, IP/C/M/93/Add.1 (9 December 2019), para.606.

⁸² H. Grosse Ruse-Khan, “Re-Delineation of the Role of Stakeholders: IP Enforcement beyond Exclusive Rights” in X. Li and C.M. Correa (eds), *Intellectual Property Enforcement: International Perspectives* (Cheltenham/UK & Northampton/USA: Edward Elgar, 2009), p.45.

⁸³ H. Grosse Ruse-Khan, “Criminal Enforcement and International IP Law” in C. Geiger (ed.), *Criminal Enforcement of Intellectual Property: A Handbook of contemporary research* (Cheltenham/UK & Northampton/USA: Edward Elgar, 2012), p.182.

⁸⁴ WTO Panel Report, *China-Intellectual Property Rights* (2009), para.7.523.

⁸⁵ WTO Panel Report, *China-Intellectual Property Rights* (2009), para.7.526.

⁸⁶ WTO Panel Report, *China-Intellectual Property Rights* (2009), para.7.527.