

Submissions on Consultation Document “Implementation of the Trans-Pacific Partnership Intellectual Property Chapter”

Name/Organisation

My name is Elspeth Victoria Buchanan, I am the principal of P.L. Berry & Associates, Christchurch. I have been in practice in New Zealand since 1977 as a patent attorney. I have a degree in Metallurgy from the University of Sheffield, and I am a Chartered Engineer. I am a registered patent attorney in both New Zealand and Australia.

Copyright – Digital Protection Measures

The proposed exceptions to digital protection measures should include the following, in addition to those listed in the Consultation Document:

- it should be legal to circumvent a TPM if there is no resulting copyright infringement;
- it should be legal to circumvent a TPM once the copyright in the work has expired;
- it should be legal to circumvent a TPM if the medium on which the copyright material is recorded has become, or is about to become, obsolete. This should apply whether or not the work is still in copyright, otherwise works can become lost simply because it is no longer possible to access the work on that medium.
- manufacturers of products which include a TPM must be required to provide the necessary information as to how the TPM can be removed or circumvented. If this information is not provided, then users who wish to circumvent the TPM for a legitimate reason will in fact be unable to do so, and the material will remain protected long after copyright has expired.

If the resulting law is such that in practice material with TPM remains in copyright indefinitely, and/or cannot be accessed for legitimate purposes, this is simply going to encourage otherwise law-abiding people to disregard the law completely, and removal of TPM is likely to become so widespread that it is impossible to restrain.

Patents

Patent Term Extension for Delays in the Patent Office

I have been in practice long enough to remember the extension of term provisions pre 1992, and I am well aware that they simply did not work at all well:- in an attempt to strike a balance between the public interest and the rights of a patentee, the burden of proof on the patentee in order to obtain an extension was so high that only a comparatively wealthy patentee could afford to apply for a patent term extension.

Turning to the proposed new provisions, providing the criteria remain as proposed in terms of defining what is an “unreasonable delay” I think these provisions are an improvement on the existing law.

The calculation of the length of extension as set out in paragraph 65 would be fair to all parties. I agree with the comment that, given current processing times in the New

Zealand Patent Office, very few patents would be eligible for extension, but I see no need to put a cap on the length of an extension, given that there can be unusual circumstances where a substantial extension would be justified.

I consider that third parties should not be able to oppose decisions to extend patents under these provisions – the criteria are clear and easily applied, and Opposition provisions are unnecessary.

It is important that the extended term should be clearly shown on the IPONZ database, so that competitors know exactly how long the patent term is going to be.

Patent Term Extension for Pharmaceuticals

The proposed patent term extension for delays in obtaining marketing approval would be an improvement on the present law, providing “unreasonable curtailment” is clearly defined. However, I consider that an overall cap of 2 years for any extension may well be unduly short, especially for biologics – input from the pharmaceutical industry on this point is needed.

I agree with the provisions restricting the extension of term to patents for pharmaceutical substances, to one extension per patent, and the restricted rights of the patent owner during the extended term as set out in paragraphs 93 and 94.

Performers Rights

The proposals seem appropriate, and modelling the New Zealand provisions on the existing UK provisions will provide New Zealand with a body of precedent to refer to.

However, I believe that the performers moral rights should apply to both the aural and vision aspects of their live performance, and any communication of that performance to the public.

Border Protection Measures

Allowing Customs to act on its own initiative to detain suspected infringing goods is a really bad idea:- in general, Customs officers are extremely competent, but they are not patent attorneys or lawyers, and they are not equipped to judge copyright or trademark infringement.

If the terms of TPP mean that there is no way that the introduction of such provisions can be avoided, then they should be as restricted as possible, to reduce unwarranted interference by Customs with the legitimate business of importers, bearing in mind that if goods are detained in error by Customs, this can cause a costly delay in getting the goods to market, and may also involve the importer in breaching delivery contract dates.

As a purely practical matter, how are Customs officers expected to know whether something is an infringement or not? Further, if rights owners are not sufficiently interested in their rights to file a Customs notice, why are public funds being used in this way?

The existing provisions for Customs detention, based on notices filed by rights owners, in general work very well – the only problems that I have experienced in this area were due to delays in Customs processing due to understaffing of the relevant department in Customs.

Extending Customs detention powers to goods intended for export would be an improvement in the present law, but for the reasons given above, this should be based on Customs notices filed by rights holders. Goods in transit should not be liable to detention under these provisions.

If the TPP provisions are such that allowing Customs detention where no notice has been filed by a rights holder cannot be avoided, then the provisions outlined in paragraphs 139 – 142 are probably as good as any, PROVIDING that all of the relevant periods are kept extremely short, for the reasons given above. For example, Customs must not be allowed to hold goods for consideration, while they decide whether or not they are infringing:– Customs must be required to make a determination (and therefore notify a rights holder if one can be found) at the time of initial inspection of the goods.

A period of three days between notification by Customs to a rights holder and the filing of a border protection notice by a rights holder is suitable: – although the period is short, the impact of any longer delay on what may well be an innocent third party is much greater than any possible inconvenience to the rights holder.

Customs must have a very short period (I suggest 24 hours) to make a decision as to whether it is practicable to notify a rights holder or not. In practice, it can be extremely difficult to locate copyright holders because there is no copyright registration, so that if this period is not limited, Customs could quite reasonably hold onto the goods for months while they searched for a copyright holder. Again, I make the point that if the rights holder could not be bothered to file a Customs Notice, it is wrong to disadvantage the importer.

Elsbeth Buchanan
B.Met. (Hons), C.Eng., MIMMM, FNZIPA