

**Federal State Autonomous Educational Institution
for Higher Learning**

**THE NATIONAL RESEARCH UNIVERSITY
HIGHER SCHOOL OF ECONOMICS**

Faculty of Law

Approved at the Academic Council of Master Program
session “Private International Law” (Protocol N 17, 29
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**INTERNATIONAL INTELLECTUAL PROPERTY LAW
Course Syllabus**

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| ETC | 3 |
| Contact hours | 40 |
| Self-study hours | 74 |
| Year of study | 1 |
| Format of course learning | Without use of online-course |

1. Course Description

a. Title of a Course

International Intellectual Property Law

b. Pre-requisites

The course requires the students to have basic knowledge of law, sufficient level of English (to read legal sources, write essays and participate in class discussions), as well as other skills acquired during their studies at the university. Additional background in civil law, private international law and international procedure is welcome, although not mandatory for the course.

c. Course Type

Elective

d. Abstract

Intellectual property plays a huge role in the modern economy in the current information age. It is one of the key ingredients of the sustained economic growth, promotion of innovation and technologies. Each country has its own intellectual property protection system including such main types of intellectual property rights as Utility Models and Patents (for inventions), Trademarks, Industrial Designs, Trade Secrets and Copyright and Related or Neighboring Rights. However, the development of a more and more internationally oriented flow of technology and the increase of international trade require international regulation of IP rights in order to provide uniform standards of IP protection and harmonization of IP laws worldwide. This process started in 19th century when first international conventions in the sphere were adopted. In 1967 the World Intellectual Property Organization (WIPO) was established with the mission to lead the development of a balanced and effective international intellectual property (IP) system that enables innovation and creativity for the benefit of all countries and also to shape balanced international IP rules for a changing world. Nowadays, there are hundreds of international treaties administered by the WIPO. They contain intellectual regulation of IP rights, which is so important for each lawyer practicing in the sphere of Private International Law.

2. Learning Objectives

The aim of the course is to provide students with a theoretical and practical understanding of the international regulatory framework of the global intellectual property protection system, covering copyright, related rights, patents, trademarks, confidential information (know-how), enforcement of IP rights and international commercial transactions with IP. A special emphasis is put on the World Intellectual Property Organization, World Trade Organization standards, and recent developments in EU and EEU law.

3. Learning Outcomes

Students must gain knowledge on:

- general standards of IP protection under WIPO, WTO, EU and EEU Law;
 - enforcement of IP rights in global prospective;
- drafting international commercial transactions with IP component.

Skills and abilities:

- to use specific terms and sources of the global IP Law and Regulation;
- practical abilities of research, analysis of WIPO, WTO, EU and EEU legal documentation and scientific works;
- skills to analyze and solve cases, building up of the legal position and composition of procedural documents on cases in the sphere of International IP Law and Regulation.

Students should gain the following competences:

- ability to work with information (search, evaluate, use information, necessary for fulfilment of academic and professional tasks, from various sources, including application of the systematic approach);
- ability to carry out professional activities in the international environment;
- ability to search, analyse, and work with legally relevant information by using the juridical, comparative and other specific methods,
- ability to describe legal problems and situations in the field of International IP Law and Regulation.

4. Course Plan

SUBJECT 1.

Subject-matter, basic principles and sources of International IP Law and Regulation

1. Role of IP rights in modern information society. Innovation, technologies, economic growth and intellectual property.
2. System of IP rights. IP rights as property rights v. *sui generis* “exclusive” rights.
3. Basic principles of International IP Law and Regulation: territoriality principle, principle of national treatment, first sale exhaustion principle and others. IP and human rights (freedom of expression, protection of personal data).
4. Sources of IP Law and Regulation: national legislation, universal and regional international treaties.
5. Regulatory role of the World Intellectual Property Organization, the World Trade Organization, the European Union, the Eurasian Economic Union and other international organizations.

SUBJECT 2.

History and recent developments in International IP Law and Regulation

1. Historical development of Intellectual Property Law and Regulation.
2. International copyright and industrial property law harmonization (Berne, Paris, Madrid Conventions).
3. Establishment of the World Intellectual Property Organization: its role, functions, treaties administered by the WIPO.
4. The World Trade Organization and TRIPS Agreement.
5. Regional protection of IP (EU, EAEU).
6. Recent trends in the International IP system.

SUBJECT 3.

International copyright law

1. The process of internationalization of copyright law.
2. The norms of the International copyright law. Berne, Universal copyright conventions, WIPO copyright treaty, TRIPS Agreement.
3. Regional systems of copyright protection: EU and EAEU.
4. Subject matter of copyright: international standards.
5. Authorship and Ownership. Term of protection.
6. Economic and Moral rights. Exemptions and limitations of copyrights.

SUBJECT 4.

International regulation of related rights

1. International regulation of neighboring rights. Rome Convention, Geneva Phonograms Convention, WIPO performances and phonograms treaty, Brussels Satellite Convention, TRIPS agreement, Beijing Treaty on Audiovisual Performances.
2. Regional protection of neighboring rights (EU and EEU).
3. Subject matter of neighboring rights: international standards.
4. Authorship and Ownership. Term of protection.
5. Exemptions and limitations of neighboring rights.

SUBJECT 5.

International regulation of industrial property

1. Scope and sources of international industrial property protection. Paris Convention, Madrid Agreement, Patent cooperation treaty, Eurasian Patent convention, European patent convention, TRIPS Agreement.
2. International patent law. International registration of patents, patentability requirements, scope of patent protection, compulsory licenses, limitations of patent rights.
3. International trademark law. International registration of trademarks, regional trademarks, international trademark classification, first sale exhaustion rules and parallel imports, well-known trademarks.
4. International protection of trade secrets.

SUBJECT 6.

Regulation of intellectual property protection in Internet

1. Internet functioning, internet players and debates on internet regulation. Challenges for IP protection in cyber space.
2. WIPO internet treaties, EU Directive on the harmonization of certain aspects of copyright and related rights in the information society, Digital Millennium Copyright Act (DMCA), Russian Anti-Piracy regulations.
3. Private International Law issues: applicable law and jurisdiction.
4. Uniform Domain Name Dispute Resolution Policy and WIPO center for arbitration and mediation.

5. Intermediary liability for copyright infringements.

SUBJECT 7.

International commercial transactions with intellectual property rights

1. Acquisitions and divestitures of IP and technology assets: Private International Law issues
2. International joint ventures and joint development arrangements.
3. Licensing and technology transactions, research and development agreements: applicable law and dispute resolution.
4. IP due diligence in international perspective.

SUBJECT 8.

Enforcement of Intellectual Property in global perspective

1. International system of IP enforcement. Fair and Equitable Procedures.
2. Civil law remedies: injunctions, statutory damages, damages, evidence, right of information, indemnification of the defendant.
3. Administrative measures: customs control measures, administrative procedures and penalties.
4. Criminal law sanctions: criminal procedures and penalties, criminal remedies (imprisonment, monetary fines, seizure, forfeiture and destruction of the infringing goods).
5. Provisional measures under TRIPS Agreement.

5. Reading List

a. Required

1. Leonelli A. A study of form reveals the substance and direction of intellectual property law // Journal of Intellectual Property Law & Practice, Volume 13, Issue 8, 1 August 2018, Pages 677–678 [Electronic resource]. – Режим доступа: <https://proxylibrary.hse.ru:2103/10.1093/jiplp/jpy060>
2. Kur A. Enforcement of unitary intellectual property rights: international jurisdiction and applicable law // Journal of Intellectual Property Law & Practice, Volume 10, Issue 6, 1 June 2015, Pages 468–480 [Electronic resource]. – Режим доступа: <https://proxylibrary.hse.ru:2103/10.1093/jiplp/jpv059>
3. Pila J. The Subject Matter of Intellectual Property. Oxford Scholarship Online, 2017. — Режим доступа: <http://proxylibrary.hse.ru:2225/view/10.1093/oso/9780199688616.001.0001/oso-9780199688616?rskey=3QPPuM&result=4>
4. Ruse-Khan H. The Protection of Intellectual Property in International Law. Oxford University Press, 2016. – 810 p. — Режим доступа: <http://proxylibrary.hse.ru:2225/view/10.1093/oso/9780199663392.001.0001/oso-9780199663392?rskey=ODvHxz&result=1>

5. Sousa e Silva N. Less parochialism: intellectual property in the wider context of international law // *Journal of Intellectual Property Law & Practice*, Volume 12, Issue 5, 1 May 2017, Pages 442–444 [Electronic resource]. – Режим доступа: <https://proxylibrary.hse.ru:2103/10.1093/jiplp/jpx018>

b. Optional

1. Auvret C. European intellectual property law explained: a panorama of key issues over the last twenty years // *Journal of Intellectual Property Law & Practice*, Volume 12, Issue 4, 1 April 2017, Pages 356–357 [Electronic resource]. – Режим доступа: <https://proxylibrary.hse.ru:2103/10.1093/jiplp/jpx013>
2. Caso R., Giovanella F. (eds.) *Balancing Copyright Law in the Digital Age: Comparative Perspectives*. Springer, 2015. – 135 p. [Electronic resource]. – Режим доступа: <https://proxylibrary.hse.ru:2184/book/10.1007/978-3-662-44648-5>
3. Correa C., Viñuales J. Intellectual Property Rights as Protected Investments: How Open are the Gates? // *Journal of International Economic Law*, Volume 19, Issue 1, 1 March 2016, Pages 91–120 [Electronic resource]. – Режим доступа: <https://proxylibrary.hse.ru:2103/10.1093/jiel/jgw005>
4. Madies T., Guellec D., Prager J.-C. (eds.) *Patent Markets in the Global Knowledge Economy: Theory, Empirics and Public Policy Implications*. Cambridge University Press, 2014. – 259 p. [Electronic resource]. – Режим доступа: <https://proxylibrary.hse.ru:2100/core/books/patent-markets-in-the-global-knowledge-economy/B340CBE1F1E1F9F10CF5B85E9F9FF5B9>
5. Rowe E., Sandeen S. *Trade Secrecy and International Transactions: Law and Practice*. Edward Elgar Pub., 2015 [Electronic resource]. – Режим доступа: <https://proxylibrary.hse.ru:2424/view/9781782540779.xml?rskey=9kDuOr&result=1>
6. Schneider G. European intellectual property and data protection in the digital-algorithmic economy: a role reversal(?) // *Journal of Intellectual Property Law & Practice*, Volume 13, Issue 3, 1 March 2018, Pages 229–237 [Electronic resource]. – Режим доступа: <https://proxylibrary.hse.ru:2103/10.1093/jiplp/jpx213>
7. Vicente D.M. Arbitrability of intellectual property disputes: a comparative survey // *Arbitration International*, Volume 31, Issue 1, 1 March 2015, Pages 163–170 [Electronic resource]. – Режим доступа: <https://proxylibrary.hse.ru:2103/10.1093/arbint/aiv002>

6. Grading System

Grading in this course will be based on three types of work product:

- (1) Attendance, active participation and in-class discussion

(2) Essay

(3) Written exam

An overall assessment formula comprises a sum total of the following variables: $(\text{seminar attendance} / \text{participation}) * 0.2 + (\text{essay}) * 0.3 + (\text{exam}) * 0.5 = \text{final grade}$

7. Guidelines for Knowledge Assessment

- Attendance, active participation and in-class discussion: 20%

Each student is expected to attend all the sessions having go through and thought about the assigned material, including the questions and any problems in the text/ judgment, podcast, etc. that are assigned, and actively participate in class discussions, ask questions and make analytical comments about the assignments. Sessions will be structured as a mix of lectures, seminars, and participative workshops in order to stimulate class discussion: the participants are expected to cover the assigned materials in advance for each class.

- Essay: 30%

This assessment component includes a 10-minute in-class presentation during one of the classes that serves to help steering the discussion of the relevant topic. Tentative topics per each session are presented further in the syllabus.

- Written exam: 50%

Written exam by the end of the course.

7.1. Assessment criteria for an essay

| <i>10-point scale</i> | <i>Assessment criteria</i> |
|-----------------------|--|
| 10 points | Excellent study that meets all the requirements, and also differs in scientific novelty being a contribution to the development of legal science. |
| 9 points | The essay meets all the requirements for this kind of work. The topic of the essay is fully discovered, the author's position is clearly expressed, there are logical and reasonable conclusions. The essay is written using a large number of legal acts based on the recommended main and additional literature, as well as other literature selected by the student independently. The essay is well-structured and designed. |
| 8 points | The same requirements as for a score of 9 points. The student used additional literature to the one proposed in the course syllabus. |
| 7 points | The topic of the essay is fully discovered; the author's position is demonstrated, reasonable conclusions are formulated; necessary literature and regulations are used. |

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| | The essay is correctly framed. |
| 6 points | The topic of the essay is generally disclosed; the conclusions of the student are formulated, but not sufficiently substantiated; analysis of the problem is conducted with references to necessary regulations; both basic and additional literature is used; the author's position is not clear. The essay is correctly framed. |
| 5 points | The topic is disclosed based on the use of several primary and secondary sources; the author's position is weakly reflected, conclusions are not substantiated; the information is presented inconsistently, without corresponding argumentation and analysis of legal norms, although references to legal acts can be found. There are drawbacks in the design of the work. |
| 4 points | The topic is not fully disclosed; only the main (more than two) sources are used; there are references to legal acts, but the author's position is not expressed; conclusions are absent. There are drawbacks in the design of the work. |
| 3 points | The topic of the essay is not fully disclosed on the basis of two sources; the information is presented without author's assessment and conclusions; no references to legislation. There are drawbacks in the design of the work. |
| 2 points | The topic of the essay is not disclosed; the information is presented without author's assessment and conclusions; no references to legislation. There are drawbacks in the design of the work. |
| 1 point | Most of the essay's text coincides with other source. |

7.2. Topics for essays

1. Legal nature of IP Rights.
2. Treaty interpretation and the meaning of international IP agreements.
3. Role of international organizations in developing IP protection.
4. National treatment and reciprocal Protection of IP rights.
5. Originality and authorship: what should be protected under Copyright Law?
6. Moral rights concept: a comparative study.
7. "Fair use" standard in Copyright Law.
8. Problem of retroactivity in International Copyright Law.
9. Conflict of Laws and Choice of Law issues in cyber space.
10. Licensing of global IP rights in the digital age.
11. Madrid Agreement on International Registration of Trademarks: practice and problems.
12. Territoriality of trademark rights under Paris Convention and TRIPS Agreement.

13. Bad faith and conflicting trademarks: article 10 of the Paris Convention.
14. Protection of famous marks under Paris Convention and TRIPS Agreement.
15. Uniform Domain Name Dispute Resolution Policy and Cybersquatting.
16. EU Trademark Directive and Regulations.
17. Community trade marks: EU and EAEU.
18. Parallel imports and international exhaustion.
19. Conditions for patentability: a comparative study.
20. Global patent registration agreements.
21. Analysis of the Patent Cooperation Treaty, Patent Law Treaty and European Patent Convention.
22. Compulsory licenses and national emergencies under TRIPS Agreement.
23. International IP enforcement system.
24. Statutory damages: *pro and contra*.
25. Provisional measures under TRIPS Agreement.

A topic chosen by each student is subject to individual approval by the Course Instructor.

7.3. Assessment criteria for written exam: test + written assignment

| <i>10-point scale</i> | <i>Assessment criteria</i> |
|-----------------------|--|
| 10 points | 100 % of the answers are correct |
| 9 points | Correct answers are given for the number of questions from 96% to 99% (96% =< right answers < 100%) |
| 8 points | Correct answers are given for the number of questions from 90% to 95% (90% =< right answers < 96%) |
| 7 points | Correct answers are given for the number of questions from 86% to 89% (86% =< right answers < 90%) |
| 6 points | Correct answers are given for the number of questions from 80% to 85% (80% =< right answers < 86%) |
| 5 points | Correct answers are given for the number of questions from 70% to 79% (70% =< right answers < 80%) |
| 4 points | Correct answers are given for the number of questions from 60% to 69% (60% =< right answers < 70%) |
| 3 points | Correct answers are given for the number of questions from 50% to 59% (50% =< right answers < 60%) |

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| 2 points | Correct answers are given for the number of questions from 25% to 49% (25%= \leq right answers $<$ 50%) |
| 1 point | 1) Correct answers are given for less than 25% questions; 2) Cheating was noticed; 3) The student wrote the test, but did not submit the paper. |

7.4. Example of exam written assignment

NAME _____

I. Please choose the correct answer

1. TRIPS does not specifically regulate protection of:
 - a) Industrial designs
 - b) Know-how
 - c) Trade names
 - d) Related rights
2. What is the standard for exhaustion of IP rights under the TRIPS:
 - a. National principle of exhaustion
 - b. Regional principle of exhaustion
 - c. International principle of exhaustion
 - d. TRIPS does not have any standard for exhaustion
3. What is the minimum term of patents protection under TRIPS:
 - a. 20 years
 - b. 25 years
 - c. 30 years
4. What special exclusive right was introduced by the WIPO copyright Treaty
 - a. Right of communication to the public
 - b. Rental right
 - c. Right to compilation
 - d. Right to translation
5. What authority makes final decision on trademark registration under the Madrid Agreement Concerning the International Registration of Marks
 - a. WIPO
 - b. International trademark bureau
 - c. EPO
 - d. National trademark offices
6. Under TRIPS states have obligation to provide for criminal procedures and penalties to be applied

- a. In all IP cases
 - b. In patent infringement cases
 - c. in cases of trademark counterfeiting
 - d. in cases of copyright piracy
7. Patent Cooperation Treaty regulates
 - a. Procedure for obtaining international patent
 - b. Procedure for international patent search and evaluation
 - c. Procedure for international patent application
 8. What is the applicable law under CLIP principles for Internet and media infringements (one action – several infringements)
 - a. principle of closest connection
 - b. principle of choice of law
 - c. lex protectionis principle
 9. What treaty does not regulate unfair completion issues in IP
 - a. TRIPS
 - b. Paris convention
 - c. Rome convention
 10. The requirement of use of a trademark under TRIPS is
 - a. obligatory for member states
 - b. optional for member states

II. Please Answer the following questions

1. How would you recommend to protect this object?



2. EON Production is the owner of the Trademarks (James Bond 007) and has exclusive rights to films about James Bond. In January 2018 It found on YOUTUBE a 30-minutes film by a Russian commercial company about their 20-years anniversary. The Russian company was using music, style and characters' names from the original James Bond 007 films. Eon Production asked for your legal advice as to the following questions: 1) whether such use of their IP would constitute an infringement 2) what court would have jurisdiction to decide a case 3) what would be the applicable law to potential infringement

8. Methods of Instruction

The course notes contain required and further reading materials and you are also invited to do your own research using the library and electronic resources. Students are expected to do 27-28 academic hours of reading, researching and preparation per week. Classes will be structured as participative workshops in order to stimulate class discussion. Students are expected to read the materials indicated prior to each seminar.

Use of of interactive educational technologies, including:

- socratic method; but also
- interactive seminars;
- participative workshops;
- group discussion;
- brainstorming sessions.

9. Special Equipment and Software Support (if required):

Access to internet and computer-based drafting equipment.