IN THE MATTER OF AN ARBITRATION UNDER CHAPTER ELEVEN OF THE NORTH AMERICAN FREE TRADE AGREEMENT AND THE UNCITRAL ARBITRATION RULES (1976)

BETWEEN:

ELI LILLY AND COMPANY

Claimant/Investor

AND:

GOVERNMENT OF CANADA

Respondent/Party

(Case No. UNCT/14/2)

SECOND REPORT OF DR. DANIEL GERVAIS

December 7, 2015

Trade Law Bureau
Departments of Justice and of Foreign Affairs, Trade and Development
Lester B. Pearson Building
125 Sussex Drive
Ottawa, Ontario
K1A 0G2
CANADA

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I. INTRODUCTION

1. I have read the Reply Memorial filed by Eli Lilly (Claimant) and the report prepared by Mr. Philip Thomas in response to my first expert report. None of the arguments therein lead me to change any of the arguments made in my initial report. However, the Reply Memorial and Mr. Thomas misstate and distort my arguments and conclusions to such an extent that a supplemental report is required. In this supplemental report, I avoid repeating my previous conclusions to the extent possible. For the avoidance of doubt, I continue to fully rely upon, and wish to incorporate herein, all of my original conclusions.

2. I have attached an updated CV to this report. The only notable change is that as part of its Annual Congress held in Cape Town in September 2015, the General Assembly of the International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP) elected me as President-Elect (and ex officio member of the Executive Committee).

II. THE CLAIMANT CONTINUES TO IMPLICITLY CLAIM THAT PATENT LAW HAS BEEN HARMONIZED INTERNATIONALLY

3. I note at the outset that Claimant purports to agree with a number of points I made in my initial report. Most importantly, Claimant concedes that patentability criteria are not harmonized internationally.[1] In fact, Claimant goes so far as to say that this was never their claim, stating that "[i]t is uncontroversial that neither NAFTA (nor any other treaty) has harmonized substantive patent law."[2]

4. However, despite appearing to concede that international patent law is not harmonized, Claimant actually continues to imply that there is substantive harmonization, both internationally and more particularly amongst the NAFTA Parties. In particular, its Reply Memorial argues that there is a "baseline", in that Chapter Seventeen of NAFTA creates a minimum set of defined requirements that the NAFTA

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[1] Claimant's Reply Memorial, (Cl. Reply), para. 54.

[2] Cl. Reply, para. 54.

Parties may exceed, but not contravene.[3] Claimant's argument now seems to be that only certain definitions of utility are acceptable (basically, the current U.S. definition) under NAFTA. As such, Claimant's baseline argument is essentially a harmonization argument in disguise.

5. Claimant produces no evidence for its "baseline" argument other than assertions of its expert, Mr. Philip Thomas. In this report I will clarify the statements made in my initial report in view of the reoriented "baseline" argument made by Claimant.

III. PATENTABILITY CRITERIA WERE NOT INTERNATIONALLY HARMONIZED WHEN NAFTA WAS SIGNED

A. Practice in NAFTA Parties Shows That Patent Law Is Not Harmonized

6. Claimant's argument is dangerously close to saying that the U.S. definition of utility is the baseline standard established in Chapter Seventeen. This argument is unsustainable. As Professor Holbrook, and Claimant's experts Mr. Kunin and Mr. Merges, agree in their respective reports, the utility requirement in the U.S. is notoriously low. As Professor Holbrook explains, the U.S. accomplishes many of the goals of Canada's utility requirement through other closely-related doctrines (such as enablement and written description).[4] As a result, in my opinion it is difficult to conceive of a utility standard lower than the current U.S. standard. Accordingly, I cannot understand how the current U.S. standard – or the US standard at any particular point in time for that matter, because it has varied considerably – can be considered a "baseline" in any sense of that word.

7. Following Claimant's logic with respect to utility raises the question of whether the other patentability criteria mentioned in Chapter Seventeen are also governed by an unwritten-but-impliedly-agreed-upon "baseline". I am unaware of anything to suggest that this is the case. Take novelty, for example. When NAFTA was negotiated, novelty was defined in very different ways by most countries other than the United States. U.S.

[3] *See* Cl. Reply, para 58.

[4] Holbrook Second Report, Section D.

law considered novelty in part based on invention date under its "first-to-invent" system, whereas most other countries, including Canada and Mexico, applied some version of a "first-to-file" system, with a majority of those choosing absolute novelty.[5]

8. The United States switched in 2013 from a first-to-invent system to a relative novelty system based on filing date instead of invention date, calling it "first-inventor-to-file". This may be said to have increased the novelty threshold and burden on inventors, because two or more inventors working independently on the same invention (knowingly or not) must now ensure that they get to the patent office first.

9. A similar story could be offered with respect to the threshold for a patent to be considered non-obvious under U.S. patent law. As I understand it, the U.S. has substantially increased the threshold for inventions to be considered non-obvious as a result of the 2007 decision of the Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*[6]

10. The logical implication of Claimant's argument on utility is that a baseline must also have been established for novelty and non-obviousness. If that were the case, then one would expect that the current requirements in U.S. law now fall below a notional baseline by increasing the obligations imposed on inventors. I do not believe that this is the case.

11. The idea that significantly different understandings of core patentability requirements and variations of the definitions as defined by courts or legislators over time are compatible with both NAFTA and TRIPS is demonstrated by years of state practice.[7] In other words, international practice has recognized, and continues to recognize, a significant degree of latitude for states to define and implement patentability criteria.

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[5] Including Canada, which switched on October 1, 1989.

[6] *KSR International Co. v. Teleflex, Inc*., 550 US 398 (2007) (**R-130**).

[7] The significant differences between the two explain the years of negotiations outlined in the Thomas report, *see*: Thomas Report, para. 6.

12. The above demonstrates that neither the legislatures nor the courts of the NAFTA Parties felt that the NAFTA limited their discretion to define and implement novelty or other substantive patentability criteria to reflect technological changes or other factors.

B. International Practice Shows that Patent Law Is Not Harmonized

1) *The Paris Convention*

13. As alluded to in my initial report and Canada's Counter-Memorial, the backdrop to this whole analysis is a norm of international law enshrined in the Paris Convention. The original text of the Convention was adopted in 1883. In 1900, the principle of independence of patents was added as Article 4*bis* (1). That provision reads as follows:

> Patents applied for in the various countries of the Union [that is, countries party to the Convention] shall be independent of patents obtained for the same invention in other countries, whether members of the Union or not.[8]

14. In 1911, Article 4*bis*(2)was added. It reads as follows:

> The foregoing provisions is to be understood in an unrestricted sense, in particular, in the sense that patents applied for during the period of priority are independent, both as regards the grounds for nullity and forfeiture and as regards their normal duration.[9]

15. As three current WIPO officials wrote (in a personal capacity), including the recent Head of the Patent Law Section, in a chapter on international patent law in a book edited by me published earlier this year:

> [T]he sovereign right of the Contracting States to decide on granting or refusing patent protection can be understood to be confirmed by Article 4*bis* of the Paris Convention, whereby the independence of patents obtained for the same invention in different countries is ensured.[10]

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[8] *Paris Convention for the Protection of Industrial Property*, World Intellectual Property Organization, (1883), Article 4*bis* (**R-036**).

[9] *Paris Convention for the Protection of Industrial Property*, World Intellectual Property Organization, (1883), Article 4*bis* (**R-036**).

[10] Philippe Baechtold, Tomoko Miyamoto and Thomas Henninger, "International patent law: Principles, major instruments and institutional aspects", in D. Gervais (ed), International Intellectual Property: A Handbook of Contemporary Research (Cheltenham, Edward Elgar, 2015), p. 53 (**R-402**).

16. The Paris Convention has such broad membership (176 member States – including all NAFTA Parties – as of November 2015) that its rules must be considered as relevant context in understanding Chapter Seventeen of NAFTA. Moreover, NAFTA Article 1701(2) requires NAFTA Parties to give effect to the Paris Convention. A similar rule is contained in Article 2.1 of the TRIPS Agreement.

17. The idea that NAFTA Chapter Seventeen requires the NAFTA Parties to adopt the U.S. notion of utility (which, as explained in the Holbrook and Dimock reports, does not perform the same function in enforcing the patent bargain as it does in Canada), and/or some other unwritten and unspecified but somehow agreed notion of utility, is difficult to square with the clear principle enunciated in Article 4*bis*. Certainly if the NAFTA Parties had intended to deviate from this fundamental rule in one of the bedrock treaties of international intellectual property law, they should have been very clear about what they were doing. NAFTA Chapter Seventeen contains no such clear indication.

2) *TRIPS*

18. Claimant questions both my knowledge and understanding of the TRIPS Agreement and the relevance of TRIPS in the context of this proceeding.[11] For example, Claimant states the following: "Professor Gervais also discusses TRIPS at length. Again, TRIPS is not of primary relevance to the interpretation of NAFTA obligations. But in any case, his arguments are unsupported. Professor Gervais suggests that the absence of a definition for 'capable of industrial application' or 'useful' in the TRIPS Agreement indicates that 'TRIPS left ample room for national variations' and 'broad flexibilities.'[12] This leap of logic finds no support in the treaty text."[13]

19. I take issue with this statement by Claimant for several reasons. First, at the time the NAFTA was signed, the TRIPS Agreement was (and is) the *de facto* global

[11] On my knowledge of TRIPS, it may be useful to recall that my book on the Agreement has been cited on the interpretation of TRIPS by several courts, including the United States Supreme Court, and in opinions by Advocates General of the Court of Justice of the European Union. However, I do not limit my arguments, unlike Mr. Thomas, to beliefs and recollection or to arguments of authority.

[12] Gervais First Report, para. 25.

[13] Gervais First Report, footnote 82.

intellectual property instrument by which all NAFTA Parties are bound. As I exhaustively explained in my previous report, the TRIPS Agreement provides important context for interpreting the patentability requirements in the NAFTA. This is because of (a) the extreme similarity between the texts of NAFTA and TRIPS; (b) the fact that they negotiated at the same time; and (c) the fact that all NAFTA parties were involved in the GATT Uruguay Round, which led to the adoption of TRIPS.[14] When the same countries negotiate the same (or similar) words on the same topic in the same timeframe, it is not illogical to consider possible linkages between the interpretations of the two instruments in question.

20. Second, my view that TRIPS does not harmonize international patentability criteria is not a "leap of logic". Claimant itself acknowledges that such criteria have not been harmonized. My conclusion is the result of the plain wording of TRIPS when considered in accordance with accepted principles of international law. It is worth recalling also that a basic principle of international law is that states can do all that is not prohibited. Take, for example, the 1986 case *Military and Paramilitary Activities in and Against Nicaragua (Nicaragua v. United States)*, where the ICJ stated that "in international law there are no rules, other than such rules as may be accepted by the State concerned, by treaty or otherwise."[15]

21. The TRIPS Agreement does not prohibit a state from defining its substantive patentability criteria. This flexibility on how TRIPS is to be implemented is noted in the very first article of the Agreement, and has been recognized by cases from the WTO Appellate Body and various dispute-settlement panels that have interpreted TRIPS and other WTO instruments.

22. For example, I would like to draw the tribunal's attention to the interpretation of this same provision by the decision of the Appellate Body of the WTO in *India - Patent Protection For Pharmaceutical And Agricultural Chemical Products*, where it held:

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[14] Gervais First Report, para. 55.

[15] *Military and Paramilitary Activities in and Against Nicaragua (Nicaragua v. United States)*, 1986 I.C.J. 14 (June 27, 1986) (**RL-037**).

> [WTO] Members, therefore, are free to determine how best to meet their obligations under the TRIPS Agreement within the context of their own legal systems. And, as a Member, India is "free to determine the appropriate method of implementing" its obligations under the TRIPS Agreement within the context of its own legal system.[16]

23. The same point about flexibility in implementing TRIPS is reinforced in a more recent panel report in a case filed against China by the United States, in which the Panel noted:

> 7.601 The Panel notes that it is the standard in the treaty obligation that varies as applied to different fact situations, and not necessarily the means by which Members choose to implement that standard. The Panel recalls that the third sentence of Article 1.1 of the TRIPS Agreement, quoted and discussed at paragraphs 7.512 and 7.513 above, provides as follows: "Members shall be free to determine the appropriate method of implementing the provisions of this Agreement within their own legal system and practice.[17]

24. Given that NAFTA Chapter Seventeen and the TRIPS Agreement use the same language, I see no reason to doubt that the flexibility that is found in TRIPS is also found in NAFTA. In fact, similar to TRIPS, NAFTA Article 1709(1) names the three core patentability criteria (novelty, non-obviousness and utility) but it does not define them. Article 1709(1) further states that 'capable of industrial application' is deemed synonymous with "useful", and "result from an inventive step" is deemed synonymous with "non-obvious".[18] The fact that the NAFTA text does not say utility and industrial applicability *are* synonymous but only that they "*may be deemed*" to be synonymous by a Party or Member supports the conclusion that the NAFTA parties can implement the treaty in a variety of ways.[19] In the TRIPS context this "deeming" language was seen as a way to move forward without having to establish global or regional harmonization. I see no reason to think that it has a different purpose in NAFTA. Not only is this what I recall from those discussions with respect to TRIPS, but more importantly my recollection is supported by the plain meaning of the language.

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[16] *India – Patent Protection for Pharmaceutical and Agricultural Chemical Products*, document WT/DS50/AB/R, 19 December 1997, at para. 59 (**R-403**).

[17] *China – Measures Affecting the Protection and Enforcement of Intellectual Property Rights*, WTO document WT/DS362/R, 26 January 2009 (Footnotes omitted from quote) (**R-404**).

[18] North American Free Trade Agreement (NAFTA) (excerpts), Article 1709 (**CL-44**).

[19] Cl. Reply, para. 278.

25. In view of the above, I stand by my statements concerning Article 1(1) of TRIPS and the flexibilities that it provides member states to define and implement substantive patentability criteria in their domestic systems.

3) *The PCT*

26. Claimant has raised anew the matter of whether the PCT directly or indirectly imposes substantive patentability requirements.[20] It does not. As I explain below, Claimant's position is in conflict with the plain language of the PCT, and learned commentary on the Treaty. Publicly-available documents from WIPO further contradict Claimant's argument.

27. The PCT dates back to 1970, well before NAFTA (and TRIPS). As shown in my first report and further explained in this one, even after NAFTA, substantive harmonization remained elusive.[21]

28. There is no support that I can see for Claimant's claim that, while uncontested variations in the application of utility and industrial applicability are permitted under international rules, the promise of the patent doctrine is not acceptable.

29. For example, publicly available WIPO documents point to significant variations in national definitions, and *refer specifically to promises contained in patent applications*, without noting any protest or remarks filed by any government. I have provided examples of this in my initial report and will add significant new examples below that show that both domestic and international practice are not harmonized.

30. In 2001, WIPO prepared a 'Study on the Interface between the SPLT, the PLT and the PCT'. In this document, the Secretariat explains what harmonization *would* look like if it were achieved one day:

> [P]rovisions of the PCT relating to the definition of prior art and substantive conditions of patentability are expressly not binding on Contracting States for the purposes of examining claims and granting patents. In fact, the latter

[20] Cl. Reply, para 58.

[21] *See* Section IV of this report and, e.g., paragraph 32 below.

> provisions are not harmonized among the various Offices, such lack of harmonization being the *raison d'être* of the SPLT.
>
> […]
>
> Thus, the International Bureau would recommend that the SPLT be drafted in the following way, to achieve a seamless interface with the PLT and the PCT:
>
> […]
>
> (iii) requirements concerning the substantive examination of claims (namely, definition of prior art, disclosure of the claimed invention, patentable subject matter, novelty, inventive step/non-obviousness and, if included, industrial applicability/utility) are governed by express provisions in the SPLT. Offices may not examine claims using any different requirements*
>
> * [footnote in original text] The question whether the PCT should be modified to apply the SPLT substantive requirements to international preliminary search and examination would be a matter purely for the PCT Contracting States to decide.
>
> […]
>
> The result would be a uniform standard for preparing applications for filing, search and examination, whereby purely formal aspects, *and formal aspects linked to substance, would be harmonized for national and regional applications (under the PLT and the SPLT) and would be the same as for PCT applications*, except where otherwise provided by the SPLT. *Substantive requirements for patentability would be harmonized among national and regional offices* through express provisions in the SPLT, resulting in theoretically uniform results among the offices.[22]

31. This detailed explanation by WIPO recognizes (a) that the current 'interface' is not 'seamless'; (b) that differences among substantive patentability requirements do exist; and (c) that such differences lead to different results in different PCT members. In contrast, what it does *not* suggest is that there are inherent limits to the range of acceptable definitions of substantive requirements as a result of the PCT, as Claimant argues.

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[22] WIPO document SCP/6/5, 24 September 2001, at paras. 18-26 (some footnotes omitted; emphasis added) (**R-405**).

IV. PATENTABILITY CRITERIA HAVE NOT BEEN HARMONIZED SINCE NAFTA WAS SIGNED

A. The failure of the SPLT negotiations shows patentability criteria were not harmonized since NAFTA

32. As an initial matter, I note that Mr. Thomas makes much of the fact that he personally attended the negotiations on the PLT and SPLT. I do not deny that useful knowledge can be gained by attending these sessions in person in terms of atmosphere, or personal discussions with delegates. That knowledge is not however, a substitute for objective interpretation from published documents. Having also worked at WIPO and participated in treaty negotiations there and elsewhere (especially the GATT), as well as in diplomatic conferences and other sessions, I know that detailed documents and records of such meetings are published and indeed I consulted them to prepare my original report. The relevant sections of my report are thus based mostly on published documents and not on my personal recollections of events dating back 15 or 20 years.[23]

33. Mr. Thomas' report makes great case of the fact that utility and industrial applicability were not discussed in the WIPO sessions on the PLT and the SPLT, and that the discussions focused on highly contentious issues like "first-to-file". Getting the United States to adjust its patentability criteria to be closer to most of the rest of the world in jettisoning first-to-invent and adopting a version of first-to-file ("first-inventor-to-file") was a key objective for many stakeholders. It was thus not at all surprising to read that Mr. Thomas recollects that this was the focus in the discussions.

34. That said, my initial report was on a different point. Whether or not utility was a priority for negotiators does not matter. Claimant does not contest that WIPO proposals by Member States do not refer to utility and industrial applicability. From this, with no real evidence or support that I can see, Claimant asserts that it is because there were unspoken-yet-agreed notions among WIPO Member States. I disagree.

[23] By contrast, the TRIPS negotiations were mostly held in meetings for which no official reports were ever prepared, with monthly formal session during which little if any negotiation actually took place. I was present in most informal meetings as a member of the secretariat and wrote a first draft of my book on TRIPS quickly thereafter.

35. While Claimant asserts that my disagreement stems from a mischaracterization of the issue of convergence versus divergence,[24] I note that my view is shared. For example, the report of the PLT conference held in June 1997, *after* NAFTA and TRIPS had been signed, reports:

> The Delegation of the United States of America declared that, as it had already stated in the first, second and third sessions of the Committee of Experts, it was still not in a position to discuss substantive patent law harmonization. Accordingly, the Delegation considered that the distinction to be made between formal and substantive matters continued to be critically important for the ongoing discussions.[25]

36. Mr. Thomas offers no explanation as to why a supposed agreement on the definitions of utility and industrial applicability remained something of a well-kept secret. I reiterate that it would be a strange practice indeed at the multilateral treaty negotiation level for WIPO to leave a low-hanging fruit showing agreement between its members completely out of sight.

37. Moreover, Mr. Thomas' views appear to be inconsistent with Claimant's own arguments. Mr. Thomas says that utility was not discussed during the SPLT negotiations between 2000 and 2006 because there was an agreed definition. However, according to Claimant the 2002 *AZT* Supreme Court decision marked a "sea change" in Canadian patent law.[26] If, as Claimant asserts, *AZT* changed Canadian law in such a way that it now contravenes an unwritten-yet-agreed-upon notion of utility, it is strange that this was not discussed or noted in the SPLT negotiation documents.[27]

38. There is another explanation that is far more plausible for the silence: If the minimal discussion on utility and industrial applicability indicates anything, it is that *different approaches were recognized and accepted, not that there was agreement on a*

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[24] Cl. Reply, para. 68 and footnote 106.

[25] WIPO document PLT/CE/ICV/4, 27 June 1997, online: http://www.wipo.int/edocs/mdocs/mdocs/en/plt_ce_iv/plt_ce_iv_4.pdf , para. 12 (Emphasis added) (**R-406**). This report shows that Canada and Mexico were also present at this meeting.

[26] Cl. Reply, paras. 93-122 and 218.

[27] Thomas Report, para. 26.

singular approach. There was no such agreement. I shall now offer additional evidence in support of my claim.

B. WIPO Study

39. My initial report cited a WIPO report contemporaneous to the SPLT negotiations, which noted significant differences in the application of the notions of utility and industrial applicability, and referred specifically to patent applications that promise a result. Before turning to additional evidence, I take issue with Claimant's suggestion that my reference to a WIPO/WTO/WHO report was misleading because my quote from that report was "selective" and that I should have quoted more.

40. This issue directly attacks my credibility and is important. It deserves a detailed look.

41. I quoted in my report from page 57 of the WIPO Report (paragraph at bottom of right-hand column). The key part reads as follows:

> Even though the same essential patentability criteria are found in the vast majority of countries, there is no agreed international understanding about the definition and interpretation of these criteria. This creates some policy space regarding their establishment under the applicable national law. Accordingly, patent offices and courts interpret and apply national patentability requirements on a case-by-case basis within the applicable legal framework.[28]

42. A reader of Claimant's Reply Memorial may well infer from the way footnote 106 is drafted that what I "left out" was contained the sentence(s) that follow my quote. To the contrary, Claimant *quotes from page 59 immediately after my quote from page 57* and *deliberately omits* to note that my quote is from a passage two pages earlier. Claimant's criticism of my report in this regard is, as a result, disingenuous at best.

43. The quote Claimant argues I "omitted" was the following:

> Industrial applicability (or utility) means that the invention can be made or used in any industry, including agriculture, or that it has a specific, credible and substantial utility. In general, the application of this requirement does not pose

[28] WTO, WIPO and WHO, *Promoting Access to Medical Technologies and Innovation*, Intersections between public health, intellectual property and trade (2013), p. 57 (**R-220**).

> practical problems. However, in the area of biotechnology, it needs some consideration, given concerns that patent applications claiming gene-related inventions would block the use of the claimed gene sequence for uses that were not yet known by the applicant and, therefore, would not justify the grant of a patent in respect of the function which the applicant was not even aware of.[29]

44. This quote changes nothing on substance to my conclusion. It shows that "in general" there are few practical problems with utility and industrial applicability, but some may arise when the application of the claimed invention is not known to the applicant. This shows that there can be issues with utility and industrial applicability. The report does *not* state that issues exist *only* in the biotech field. Contrary to what Claimant claims, it uses biotech as an example.

45. My initial report also referred to various documents prepared for WIPO's Standing Committee on the Law of Patents (SCP). Since filing my original report I found another survey prepared by the WIPO International Bureau (Secretariat) on the notions of utility and industrial applicability.[30] This document was prepared for the fifth session of the SCP (which all NAFTA Parties attended).[31] At the fifth session, the Member States discussed a provision of the draft SPLT on utility and industrial applicability, which provided a number of options.[32] The report of that session includes a substantive discussion of utility and industrial applicability.[33] The Chair summary of the discussion noted that the "the debate revealed different national practices and divergent views."[34]

46. This document was prepared *after* NAFTA and TRIPS entered into force. While it appears this informal informational document was not submitted for approval or adoption, it is useful in the context of this proceeding because it *collects and reflects*

[29] WTO, WIPO and WHO, *Promoting Access to Medical Technologies and Innovation*, Intersections between public health, intellectual property and trade (2013), p. 59 (emphasis added) (**R-220**).

[30] WIPO, *The Practical Application of Industrial Applicability/Utility Requirements Under National And Regional Laws*, April 2001 (**R-407**).

[31] WIPO document SCP/5/6, 27 November 2001, para. 2 (**R-224**).

[32] WIPO document SCP/5/2, 4 April 2001, para 6 online: http://www.wipo.int/edocs/mdocs/scp/en/scp_5/scp_5_2.pdf (**R-223**).

[33] WIPO document SCP/5/6, 27 November 2001, paras. 132, 136 and 140-146 (**R-224**).

[34] WIPO document SCP/5/6, 27 November 2001, para. 146 (**R-224**).

actual examples of utility and industrial applicability in WIPO Member States (all NAFTA Parties are WIPO Member States).

47. The report makes four key points by way of examples from the domestic law of several WIPO members. First, the promise of the patent approach was acknowledged internationally at least as early as 2001 not just without any critical commentary, but as an example of utility.[35] Second, notions of utility and industrial applicability vary significantly by jurisdiction.[36] Third, it is up to national courts to determine whether the standard is met.[37] Fourth, the notions of utility and industrial applicability are not synonyms. They merely overlap, and this overlap leads the Secretariat to suggest that it is probably better to study them together.[38]

48. The summary of the document prepared by WIPO is itself quite instructive. It states:

> Information received by SCP members, reveals that there is a wide range of differences among SCP members concerning the interpretation and practice relating to the 'industrial applicability/utility' requirement. It also shows that the industrial applicability/utility requirement is closely linked, or sometimes overlaps, with other substantive patentability requirements, such as the sufficient disclosure (enablement) requirement, inventive step, exclusions from patentable subject matter and the definition of 'invention'.[39]

V. PATENTABILITY HARMONIZATION EFFORTS ARE CONTINUING

49. Further evidence that substantive patentability requirements have not yet been harmonized can be found in the fact that work is continuing. On October 15, 2015, the Forty-Seventh (22nd Ordinary) Session of the WIPO General Assembly adopted a budget and program for the next biennium. The report of the SCP presented to the

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[35] WIPO, *The Practical Application of Industrial Applicability/Utility Requirements under National and Regional Laws*, April 2001, paras. 13 and 19 (**R-407**).

[36] WIPO, *The Practical Application of Industrial Applicability/Utility Requirements under National and Regional Laws*, April 2001, paras. 2-5 (**R-407**)

[37] WIPO, *The Practical Application of Industrial Applicability/Utility Requirements under National and Regional Laws*, April 2001, paras. 15-16 (**R-407**).

[38] WIPO, *The Practical Application of Industrial Applicability/Utility Requirements under National and Regional Laws*, April 2001, para. 24 (**R-407**).

[39] WIPO, *The Practical Application of Industrial Applicability/Utility Requirements under National and Regional Laws*, April 2001 (**R-407**).

Assembly on that occasion contains the following passage about future work on substantive patentability criteria:

> During its twenty-second session, the Committee discussed two studies, namely (i) study on the inventive step and (ii) study on the sufficiency of disclosure. With respect to these two topics some delegations suggested further activities. As regards the item 'future work', at the twenty-second session, the Committee agreed that the non-exhaustive list of issues would remain open for further elaboration and discussion at the twenty-third session of the SCP. In addition, without prejudice to the mandate of the SCP, the Committee agreed that its work for the following session be *confined to fact-finding and should not lead to harmonization at that stage.*[40]

50. This 2015 SCP report does not mention utility or industrial applicability at all. In contrast, inventive step and non-obviousness are mentioned as patentability criteria to be studied. However, the Member States were self-evidently clear that harmonization was not the objective.

51. Where in all this Claimant finds a possible baseline definition of utility, let alone a binding norm applicable to all NAFTA Parties, is simply beyond my comprehension.

Signed at Nashville on: December 7, 2015

[signed]
Dr. Daniel Gervais

[40] WIPO, *Report on the Standing Committee on the Law of Patents (SCP)*, document WO/GA/47/6, 20 August 2015, online: http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=312043 (emphasis added) (**R-408**). Member States "took note" of this report at the General Assembly: *See* WIPO, *WIPO Member States Approve Organization's 2016/17 Program and Budget*, Geneva, 15 October 2015, document PR/2015/783, online: http://www.wipo.int/pressroom/en/articles/2015/article_0013.html. (**R-409**).

CURRICULUM VITAE

Daniel J. Gervais

PART I – EMPLOYMENT & HONORS

a1) CURRENT POSITION & TITLE

Professor of Law, Law School, Vanderbilt University
Professor of French (graduate students only), College of Arts & Science, Vanderbilt University
Director, Vanderbilt Intellectual Property Program
Faculty Director, LL.M. Program

a2) CURRENT UNIVERSITY SERVICE

University Faculty Marshal
Faculty Advisor, *Vanderbilt Journal of Technology and Entertainment Law*

a3) CURRENT POSITIONS AND AFFILIATIONS

1. Editor-in-Chief, *Journal of World Intellectual Property* (peer-reviewed), published by Wiley-Blackwell (2006-)
2. Associate Reporter, *Restatement of Copyright, First* (American Law Institute) (2014-)
3. Member (elected), American Law Institute
4. Research Affiliate, New Zealand Centre of International Economic Law
5. Editor of www.tripsagreement.net
6. Founding member, International Society for the Development of Intellectual Property (ADALPI)
7. Member, Editorial Board, *WIPO-WTO Colloquiums for Intellectual Property Teachers*
8. President-Elect, International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP) (2015-)
9. Panelist, UDRP, WIPO Arbitration and Mediation Center
10. Member of the ABA, AIPLA, Law Society of Upper Canada (Ontario) and Bar of Quebec
11. Twitter: @danielgervaisIP
12. Languages: English, French, Spanish. German (functional). One year of Chinese (Mandarin)

b) PREVIOUS UNIVERSITY SERVICE

1. Member, Vanderbilt University Copyright Task Force (2014-2015)

2. Process Chair, Faculty Grievances (Promotion and tenure), Vanderbilt University (2011-2015)
3. Faculty Senator, Vanderbilt University (2011-2014)
4. Acting Dean, Common Law Section, University of Ottawa (Feb-Jul 2006 and Sep-2007-July 2008)

c) EDUCATION

- Doctorate, University of Nantes (France), 1998
    - *magna cum laude* (“*très honorable*”)
- Diploma of Advanced International Studies, Geneva (Switzerland), 1989
    - *summa cum laude* (“*très bien*”)
- LL.M., University of Montreal, 1987
- Computer science studies University of Montreal, 1984-1985
- LL.B. (McGill University/University of Montreal), 1984
- D.E.C. (Science, Jean-de-Brébeuf College, Montréal), 1981

d) PREVIOUS EMPLOYMENT & POSITIONS

- Member, Executive Committee, International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP) (2011-)
- Chair, American Bar Association (ABA) Committee on International Copyright Laws & Treaties (2012-2014)
- University Research Chair, Common Law Section, University of Ottawa (2006-2008)
- Vice-Dean, Research, Common Law Section, University of Ottawa (2003-2006)
- Full Professor, Common Law Section, University of Ottawa (2005-2008)
- International editor, *Journal of Intellectual Property Law & Practice* (Oxford Univ. Press) (2005-2008)
- Associate Professor, Common Law Section, University of Ottawa (2001-2005)
- Vice-President, International, Copyright Clearance Centre, Inc., Massachusetts, USA, 1997-2000
- Consultant, Organization for Economic Cooperation and Development (OECD), Paris, 1997
- Assistant Secretary General, International Confederation of Societies of Authors and Composers (CISAC), Paris, 1995-1996
- Head of Section, World Intellectual Property Organization (WIPO), Geneva, 1992-1995
- Consultant & Legal Officer, General Agreement on Tariffs and Trade (GATT/WTO), Geneva, 1990-1991
- Lawyer, Clark, Woods, (Montreal), 1985-1990

e) VISITING PROFESSORSHIPS

- Yong Shook Lin Professor of Intellectual Property, National University of Singapore, February 2015
- Visiting Professor, *Université de Strasbourg* (Centre for International Intellectual Property Studies (CEIPI), France), Nov.-Dec. 2009, March 2012, May 2014, January 2016
- Gide Loyrette Nouel Visiting Chair, *Institut d'études politiques de Paris* (Sciences Po Law), Feb.-Apr. 2012

- Visiting Lecturer, Washington College of Law, American University, June 2011
- Visiting Professor, *Université de Liège* (Belgium), March 2010 and 2011
- Visiting Professor, *Université de Montpellier*, France (Feb. 2007 and Apr. 2008)
- Visiting Professor, University of Haifa (2005)
- 2004 Trilateral Distinguished Scholar-in-Residence, Michigan State University, Detroit College of Law (April-May 2004)
- Visiting Scholar, Stanford Law School, Feb-Apr. 2004
- Visiting Professor, DEA (graduate) program, Faculty of Law, University of Nantes, France (May 2003)
- Visiting Professor, Faculty of Law, Graduate program in Intellectual Property (DESS), Centre universitaire d'enseignement et de recherché en propriété intellectuelle (CUERPI), *Université Pierre Mendès-France* (Grenoble II), France (2002)
- Visiting Professor, Faculty of Law, University of Puerto Rico (June-July 2002--instruction in Spanish and English)
- Lecturer, Institute for Information Law, Faculty of Law, University of Amsterdam, Postdoctoral Summer Program in International Copyright Law (every year since 2000; last in July 2015)

f) HONORS & MEMBERSHIPS

- Member, American Law Institute (2015-)
- Member, Academy of Europe (2012-)
- Selected (by student vote) as Commencement speaker, Vanderbilt Law School, May 2014
- FedEx Research Professorship, Vanderbilt University Law School (2011-2012)
- Ontario Research Excellence Award (ex PREA), 2005[1]
- Charles B. Seton Award, Copyright Society of the U.S.A., 2003 (see under Articles below)
- Quebec Bar. Finished first *ex aequo* out of 700+ candidates—received all available awards, including:
    - Paris Bar Prize
    - Quebec Bar Award
    - Quebec Young Bar Award
- Two Academic Excellence Awards, Faculty of Law, University of Montreal

PART II- RESEARCH

a) PRESENTATIONS AT ACADEMIC EVENTS

- Distinguished Visiting Speaker, University of Manitoba, November 5, 2015
- Speaker, "Campbell @ 21" event, University of Washington (Seattle), April 18, 2015
- Co-chair, "Intellectual Property and Regulation of the Internet: The Nexus with Human and Economic Development," New Zealand Centre of International Economic Law, Wellington, February 19, 2015
- Moderator, "Beyond Regulation: The US Government as Funder, Creator, and User of Intellectual Property," Annual Symposium of the Vanderbilt Journal of Technology and Entertainment Law, January 23, 2015
- Lecturer, "Patentability criteria as TRIPS Flexibilities," University of London in Paris/Queen Mary,

[1] Of the 64 research awards in that round, only one given to a law professor.

December 4, 2014

- Lecturer, “Collective management”, University of Nottingham, December 1, 2014
- Co-Chair and moderator, “Intellectual Property on the Internet: Is there Life Outside of the Big Three?,” Victoria University of Wellington, November 17-18, 2014
- Moderator, Is Copyright Working for Music Creators event, Vanderbilt Law School, October 24, 2014.
- Panelist, Kernochan Center for Law, Media, and the Arts 2014 Symposium, Columbia Law School, New York, October 10, 2014
- Moderator, panel on the future of moral rights, ALAI Annual Congress, Brussels, September 19-20, 2014
- Chair, Breakfast Panel, Annual ATRIP Conference, Montpellier (France), July 8, 2014
- Panelist, “Rights in the mix” session, Information Influx International Conference, University of Amsterdam, July 2-3, 2014
- Speaker, Intellectual Property and the Performing Arts, event organized by Indiana University, Maurer School of Law (Bloomington), Indiana University Jacobs School of Music, and the Indiana Arts Commission, Indianapolis, , “Performers rights in comparative perspective” May 16, 2014
- Speaker, Rethinking International Intellectual Property, CEIPI, Strasbourg (France), “The Role of WIPO” May 12, 2014
- Speaker, “Trademarks and Tobacco Packaging”, Florida International University, Miami, FL, March 18, 2014
- Lecturer, Concordia University, John Molson School of Business, Montreal, November 4, 2013;
- Speaker, The Future of Corporate Governance and Intellectual Property Protection, FGV Direito, Rio de Janeiro, Brazil, May 24, 2013,
- Moderator, From Berne to Beijing, Symposium of the Vanderbilt Journal of Entertainment and Technology Law, January 25, 2013
- Speaker, “Patents on Science or Technology?”, Colloquium of the Department of Physics, Vanderbilt University, January 8, 2013
- Co-Host, Evolution and Equilibrium in Copyright Conference, Wellington, New Zealand, November 20-21, 2012
- Speaker, ALAI Congress, Kyoto, Japan, October 15-16, 2012
- Speaker, Amsterdam workshop on copyright formalities, University of Amsterdam, July 7, 2012;
- Speaker, Workshop on When Technology Disrupts Law: How Do IP, Internet and Bio Law Adapt?, AALS Mid-Year Meeting, Berkeley, CA, June 11, 2012;
- Speaker, Law & Business Conference, organized by Vanderbilt Law School; with the Indian School of Business (ISB) and NALSAR, ISB, Hyderabad, India, May 30-31, 2012;
- Speaker, The International Copyright System and Access to Education: Challenges, New Access Models and Prospects for New Principles, Max-Planck Institute, Munich, Germany May 14-15, 2012;
- Speaker, Chicago IP Colloquium, Loyola Law School, Chicago, April 17, 2012
- Participant, Workshop “Intellectual Property at the Edge,” Columbia Law School, April 13, 2012
- Panelist, Fordham International Intellectual Property Law & Policy Conference, New York, April 12, 2012
- Speaker, Faculty of Law, University of Nantes, Nantes (France), March 23, 2012
- Speaker, European and International IP Center (CEIPI), Strasbourg (France), March 19, 2012
- Speaker, IP Colloquium, Washington University, St. Louis, Feb. 27, 2012
- Speaker, Canada-Israel Israeli Canadian Workshop on Copyright Law Reforms & Developments, The Hebrew University Of Jerusalem, Feb. 20 -21, 2012
- Moderator, Vanderbilt Intellectual Property Association/Hyatt Fund event, Lockdown on Password Sharing, Feb. 1, 2012
- Moderator, 2011-2012 Symposium of the Vanderbilt Journal of Entertainment and Technology Law (JETLaw), Copyright & Creativity: Perspectives on Fixation, Authorship, & Expression, Jan. 27, 2012

- Moderator & organizer, Melbourne-Vanderbilt Global Debate, Vanderbilt Law School, Nashville, November 15, 2011
- Speaker, IP Colloquium, Indiana University Maurer School of Law, Bloomington, IN, November 3, 2011
- Speaker, Copyright in a borderless online environment Symposium, Thoresta Herrgård, Bro, Sweden, October 27-28, 2011
- Speaker, International Law Weekend, Intellectual Property Law in National Politics and International Relations, New York, NY, Oct. 21-22, 2011
- Panelist, American Intellectual Property Law Association (AIPLA), Annual Meeting, Washington DC, October 20, 2011
- Speaker, Golan v. Holder Roundtable, Harvard Law School, September 23, 2011
- Moderator, Max-Planck Institute Workshop on Economic Partnership Agreements of the EU: A Step Ahead an International IP Law?" Frauenchiemsee, Germany, June 26-28, 2011
- Keynote speaker, 39e Colloque annuel International de l'AFEC, Stretching borders: How far can Canada Go?, Montpellier, France, June 15-17, 2011
- Moderator, Vanderbilt University Law School Program, Beijing, China, May 21, 2011
- Moderator and panelist, 19th Annual Conference on Intellectual Property Law & Policy, Fordham University Law School, New York, April 28-29, 2011
- Chair, Invitation-only Intellectual Property Workshop, Canadian International Council, Ottawa, March 31-April 1, 2011
- Moderator, Patent Unrest, Vanderbilt Law School. February 24, 2011
- Keynote speaker, Annual Symposium of the Kernochan Center for Law, Media & the Arts, Columbia Law School, New York, January 28, 2011
- Speaker, Intellectual Property Institute of Australia (IPRIA), University of Melbourne, Australia, December 13, 2010
- Speaker, Trade, Intellectual Property and the Knowledge Assets of Indigenous Peoples: The Developmental Frontier, Victoria University, Wellington, New Zealand, December 8-10, 2010
- Speaker, Computer Programs and TRIPS, TRIPS@10 Conference, Columbia University, November 16-18, 2010
- Speaker, International Law Weekend, American Branch of the International Law Association, Fordham Law School, New York, October 22-23, 2010
- Speaker, Bits Without Borders conference, Michigan State University, East Lansing, MI, September 25-26, 2010
- Speaker, World Trade Forum, Bern, Switzerland, September 3-4, 2010
- Speaker, Copyright @ 300, UC Berkeley School of Law, Berkeley, CA, April 9-10, 2010
- Speaker, The Statute of Anne 300 Birthday, Cardozo Law School, New York, March 24-25, 2010
- Panelist, Access to Knowledge (A2K) conference, Yale Law School, February 12-13, 2010
- Speaker, IUS COMMUNE, Reinventing the Lisbon Agreement, Maastricht University, The Netherlands, November 26, 2009
- Speaker, The Lisbon Agreement, CEIPI (Université de Strasbourg, France), November 17, 2009
- Keynote speaker, Signifiers in Cyberspace: Domain Names and Online Trademarks Conference, Case Western Reserve University, Cleveland, Ohio, November 12, 2009
- Speaker, Beyond TRIPS: The Current Push for Greater International Enforcement of Intellectual Property, American University (Washington College of Law), November 5, 2009
- Speaker, Intellectual Property Developments in China: Global Challenge, Local Voices conference, Drake University, Des Moines, Iowa, October 15-16, 2009
- Speaker, University of Hong Kong, June 12-13, 2009
- Speaker, Conference on 100th Anniversary of the 1909 Copyright Act, Santa Clara University, April 27, 2009
- Panelist, Fordham International Intellectual Property law & Policy Conference, Cambridge, England, April 15-16, 2009

- Participant, University of Cambridge-University of Queensland Copyright History Roundtable, Cambridge, England, April 15, 2009
- Commentator, Vanderbilt Roundtable on User-Generated Content, Social Networking & Virtual Worlds, Nashville, November 14, 2008
- Distinguished Finnegan Lecturer, Washington College of Law, Washington, D.C., October 18, 2008
- Panelist, International Law Weekend, New York, October 16, 2008
- Speaker, IP Speaker Series, Cardozo Law School, September 22, 2008
- Lecturer, Intellectual Property Research Institute of Australia (IPRIA), Melbourne, June 3, 2008
- Speaker, International Conference on Patent Law, University of New Zealand, Wellington, May 29-30, 2008
- Speaker, Law School of National Taiwan University, March 21, 2008
- Commentator, EDGE Project Conference on Intellectual Property and Development, Hong Kong, March 17-18, 2008
- Speaker, Cardozo Law School Conference on Harmonizing Exceptions and Limitations to Copyright Law, New York, March 30-31, 2008
- Panelist, Fordham Conference on International Intellectual Property Law & Policy, New York, March 27-28, 2008
- *Rapporteur*, International Literary and Artistic Association Biennial Congress (ALAI), Punta del Este, Uruguay, Oct. 31 – Nov. 3 2007
- Speaker, Vanderbilt University, Nashville, Tennessee, Oct. 16-17, 2007. "Collective Management of Copyright in North America", (conference organized in cooperation with WIPO)
- Speaker, University of South Carolina, Columbia, SC, October 12, 2007 "The Future of Copyright Law"
- Panelist, Fordham University Conference on International Intellectual Property Law & Policy, New York, April 12-13, 2007
- Speaker, Dean's lectures on intellectual property, George Washington University School of Law, Washington D.C., March 13, 2007
- Speaker, UCLA Conference on the WIPO Development Agenda, Los Angeles, March 9-11, 2007
- Speaker, International Conference on Impact of TRIPS: Indo-US Experience. NALSAR University of Law, Hyderabad (India), Dec. 15-16, 2006
- Speaker, International intellectual property conference, University of Chicago-Kent, October 12-13, 2006
- Speaker, Study days of the International Literary and Artistic Association, Barcelona, June 18-21, 2006
- Moderator, Fourteenth Annual Conference on International Intellectual Property Law & Policy, New York, April 20-21 2006
- Speaker, University of Michigan, Ann Arbor. Intellectual Property & Development, April 14 2006
- Speaker, Michigan State University College of Law (MSU), East Lansing, The International Intellectual Property Regime Complex, April 7-8 2006
- Roundtable participant, Vanderbilt University Law School, Nashville, Tennessee. Private International Law and Intellectual Property Law: Theory and Practice, March 24-25, 2006
- Panelist, Federalist Society, Annual Lawyers Convention. Washington, D.C., November 2005
- Panel Chair, Annual meeting of the International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP), Montréal, July 11-13, 2005
- Lecturer, Institute of European Studies, Macau (IEEM), Advanced IP course (25 June-1 July 2005)
- Lecturer, Advanced IP conference, Macau, June 27-30, 2005
- Speaker, Conference on the Relationship between international and domestic law McGill University, June 15-16, 2005
- Speaker, Conference on the Collective Management of Copyright, Oslo, May 19-21, 2005
- Keynote speaker, Conference of the Department of Justice on intellectual property and Internet Law, Ottawa, April 21, 2005
- Keynote speaker, LSUC Annual Communications Law Conference, Toronto, April 8-9, 2005

- Speaker, Law & the Information Society Conference, Fordham University, New York, April 6-7, 2005
- Panelist, Fordham International Intellectual Property Law & Policy Conference, New York, March 31-Apirl 1, 2005
- Speaker, Shanghai 2004: Intellectual Property Rights and WTO Compliance. University of East China, Shanghai, China, Nov. 24, 2004
- Speaker, "The Internet: A Global Conversation" Conference, University of Ottawa, Oct. 1-2, 2004
- Lecturer, Office for Harmonization in the Internal Market (Trade Marks and Designs). Alicante (Spain), July 2004
- Organizer and Speaker, Rethinking Copyright Conference, University of Ottawa, May 20-21, 2004
- Panelist, American Intellectual Property Lawyers Association (AIPLA), Dallas TX, May 13-14, 2004
- Speaker , 2004 Computers Freedom & Privacy Conference, Berkeley, California Apr. 20-23, 2004
- Speaker, Intellectual Property, Sustainable Development & Endangered Species Conference. Detroit College of Law, Michigan State University, March 26-27, 2004
- Speaker, Securing Privacy in the Internet Age Symposium, Stanford Law School, March 13-14, 2004
- Keynote speaker, "US Copyright Office Comes to California" Conference, Hastings College of Law, San Francisco, CA, March 3, 2004
- Speaker, Global Arbitration Forum, Geneva, Switzerland, Dec. 4-5, 2003
- Panel Chair and Speaker, "Copyright and the Music Industry: Digital Dilemmas", Institute for Information Law, Amsterdam, July 4-5, 2003. Topic: "Collective Rights Management & the Future of Copyright"
- Conference Fellow, "International Public Goods and Transfer of Technology under a Globalized Intellectual Property Regime" Conference, Duke Law School, Raleigh, NC, USA, Apr. 4-6, 2003
- Speaker, Roundtable on questions arising out of the intersections of technology and questions of social justice, University of Ottawa, March 28, 2003. Topic: "Democracy, Technology and Social Justice" (available at commonlaw.uottawa.ca)
- Speaker, Conference of Copyright Law Association of Japan (CLAJ), Tokyo, Dec. 7, 2002. Topic : "Transactional Copyright: Licensing Tailored Uses"
- Speaker, Facultés universitaires de Saint-Louis, Belgique, May 25-26 2002. Topic : «De l'œuvre à l'auteur »
- Speaker. Institutions administratives du droit d'auteur, colloquium organized by the Université de Montréal, Montreal, Oct. 2001. Topic : « La gestion collective au Canada : fragmentation des droits ou gestion fragmentaire »
- Speaker, Annual Meeting of the International Literary and Artistic Association (ALAI International), Columbia University, New York, 2001. Topic: " Rights Management Systems"
- Lecturer, Swedish School of Economics and the Finnish IPR Institute, Helsinki, Finland, 2000. Topic: "Copyright and Electronic Commerce", lecture presented to graduate students
- Speaker, Fordham University Conference on International Intellectual Property, New York, April 2001. Topic "Electronic Commerce and Copyright"
- Speaker, Fordham University Conference on International Intellectual Property, New York, April 2000. Topic: "The TRIPS Agreement After Seattle"
- Speaker, Ohio State University, Columbus, Ohio, 2000. Topic: "Digital Licensing of Copyright"
- Speaker, Fordham University Conference on International Intellectual Property, New York, April 1999. Topic: "Digital Distance Education: Exemption or Licensing?"
- Speaker, Fordham University Conference on International Intellectual Property, New York, April 1999. Topic: "An Overview of TRIPS: Historical and Current Issues"

b) PUBLIC LECTURES & OTHER EVENTS

- Invited speaker, Association des juristes pour l'avancement de la vie artistique (AJAVA), Espace Grévin, Montréal, October 30, 2015
- Invited panelist, WIPO Worldwide Symposium on the protection of Geographical Indications, topic: Socio-Economic Aspects of Geographical Indications, Budapest, October 19-21, 2015
- Distinguished Guest Speaker, IP Academy of Singapore, February 2015
- Keynote speaker, International Congress of Music Authors (CIAM), Nashville, October 22, 2014
- Speaker, Intellectual Property Institute of Canada (IPIC), 88th Annual Meeting, Halifax, Nova Scotia, October 16-17, 2014
- Panelist, Copyright Office's Roundtable on Music Licensing, Nashville, TN, June 4-5, 2014
- Panelist, Workshop organized by the International Law Research Program at the Centre for International Governance Innovation (CIGI), Waterloo, ON, June 3-4, 2014
- Panelist, USPTO and NTIA Roundtable, Green Paper Green Paper on Copyright Policy, Creativity and Innovation in the Digital Economy, Vanderbilt Law School, May 21, 2014
- Testimony, Subcommittee on Courts, Intellectual Property and the Internet Committee on the Judiciary, United States House of Representatives, 113th Congress, 1st Session, May 16, 2013
- Lecturer, NORCODE/WIPO Course on Collective Management of Copyright, Oslo, Norway, June 12-13, 2013
- Speaker, Intellectual Property Institute of Canada, Annual Congress, Vancouver, B.-C., October 11, 2012
- Speaker, The Copyright Office Comes to Music City, Nashville, TN, April 26, 2012
- Panelist, ABA IP Section, Annual Meeting, Crystal City VA, March 29, 2012
- Speaker, Practising Law Institute, New York, March 28, 2012
- Speaker, Gide Loyrette Nouel, Paris (France), March 14, 2012 ("Non Traditional Trademarks")
- Speaker, Leadership Music, Nashville, TN, March 9, 2012
- Moderator, Canadian International Council conference on Innovation ("Right and Rents"), Ottawa, October 5-7, 2011
- Chair and Speaker, Canadian International Council Workshop on Innovation, Ottawa, March 31 and April 1st, 2011
- Speaker and session leader, High-level (Ministerial) Forum on Intellectual Property for the Least-Developed Countries, WIPO, Geneva, July 24-25, 2009
- Moderator, Copyright Counseling, Management, and Litigation Law Seminar, Seattle, WA, April 26-27, 2009
- Speaker, Annual Meeting. Commission on Intellectual Property, International Chamber of Commerce, Cambridge, England, April 17, 2009
- Keynote speaker, Asian Copyright Seminar, Tokyo, Japan, February 25-27, 2009
- Speaker, International Copyright Institute, Washington DC, Nov. 28, 2006
- Speaker, International Trademark Association, Trademarks Administrators Conference, Crystal City, Virginia, September 19-20, 2006
- Speaker, General Assembly of the National Association of Publishers (ANEL), Montréal, September 14, 2006
- Speaker, Federalist Society Annual Lawyers Convention, Washington D.C. November 2005.

- Keynote speaker. InSIGHT, Old Mill Inn, Toronto, September 2005. Topic: "Copyright Reform in Canada"
- Speaker. Canadian Institute, , Montréal, June 5-6, 2005
- Speaker, Canadian Bar Association, Montreal, Nov. 9, 2004. Topic: "Recent developments in Canadian copyright law"
- Speaker, Peer-to-Peer Luncheon speech, The 45th Circuit, Ottawa Centre for Research and Innovation (OCRI), Oct. 5, 2004. Topic: "Peer-to-Peer File-Sharing"
- Speaker, Luncheon conference, ALAI Canada, Toronto, Sept. 13, 2004. Topic: "The Supreme Court decision in *SOCAN v. Can. Ass'n of Internet Providers*"
- Lecturer, International Copyright Institute, Washington, D.C., May 5, 2004. Topic: "Collective management of copyright"
- Speaker, Biannual Canadian Bar Association/Law Society of Upper Canada Communications Law Conference, Ottawa, April 23-24, 2004. Topic: "The Supreme Court decision in *CCH v. Law Society of Upper Canada"*
- Speaker, Stanford law School, Symposium Securing Privacy in the Internet Age, Topic "Privacy protection through aggregation of data concerning networked copyright usage," March 13, 2004
- Speaker, Association pour l'avancement des sciences et des techniques de la documentation (ASTED), Annual Meeting, Gatineau, Québec, Nov. 7, 2003. Topic : "Copyright Exceptions and Librarians"
- Keynote speaker, International Conference on National Copyright Administrative Institutions, Ottawa, Oct. 8-10, 2003. Topic: "Status Report on Internet Tariffs"
- Panelist, Intellectual Property Institute of Canada (IPIC), Annual Meeting, Halifax, Sept. 19, 2003. Topic: "Technical Protection Measures and Copyright"
- Speaker, North American Workshop on Intellectual Property and Traditional Knowledge, Ottawa, Sept. 7-9, 2003. Topic: Traditional Knowledge and Intellectual Property: The Issues"
- Speaker, Association des juristes d'expression française de l'Ontario (AJEFO), Ottawa, June 21, 2003. Topic: Law & Technology
- Speaker, Editors Association of Canada, Ottawa, June 15, 2003. Topic : "A Walk Through the Copyright Labyrinth"
- Keynote speaker, Computer Assisted Language Instruction Consortium (CALICO), Ottawa, May 22, 2003. Topic : "Copyright, Copyleft, Copywrong?"
- Speaker, Expert Roundtable on Transactions in Intellectual Property, Amsterdam, May 17-18, 2003. Topic: "Fragmentation of Copyright and Rights Management"
- Speaker, "The 45th Circuit" (OCRI), Ottawa, Apr. 1, 2003. Topic : "Emerging Issues in Digital Rights Management"
- Speaker, Information Highways Conference, Toronto, March 24, 2003. Topic : Digital Rights Management : Balancing Creators Rights and User Interests"
- Speaker, Literary and Artistic Association (ALAI Canada), Montréal, QC, Oct. 22, 2002. Topic: "La gestion collective es-elle en crise?"
- Instructor, World Trade Organization (WTO), Nairobi, Sept. 2002. Topic: The TRIPS Agreement after Doha"
- Instructor, World Trade Organization (WTO), Casablanca, Sept. 2002. Topic: "The TRIPS Agreement After Doha"

- Speaker, Literary and Artistic Association (ALAI Canada), Montreal, May 7, 2002. Topic: « La décision de la Cour suprême dans l'affaire *Galeries d'art du Petit Champlain Inc. c. Théberge »*
- Instructor. International Copyright Institute (Washington, D.C.), Nov. 2000 and Nov. 2001. Topic: "Collective Management of Copyright in the Digital Age"
- Speaker. Annual Meeting of the International Trademark Association (INTA), Denver, CO, USA, May 2000. Topic: "The TRIPS Agreement: Implementation and Dispute Settlement Issues"
- Speaker, New York Bar (NYCLA), 2000. Topic : "Current Rights Clearance Issues"
- Speaker, Society of Scholarly and Professional Publishers (SSP), Boston, Mass., 1999. Topic: "Copyright Licensing Issues"
- Speaker, Canadian Writers Union Conference, Toronto, 2000. Topic: "Copyright Management in the Digital Age"
- Speaker, Heritage Canada Roundtable on Copyright Management, Ottawa, 1999. Topic: "Copyright Management: US Practices"
- Speaker, International Publishers Association (IPA) Congress, Tokyo, Japan, 1998. Topic: "Copyright, Publishing in the Face of Technological Change"
- Speaker, Marché international du multimédia (MILIA), Cannes, France, 1995. Topic : "Droit d'auteur et multimédia"
- Speaker, Chilean Book Fair, Santiago, Chile, 1999. Topic: "El papel de las sociedades de derechos reprográficos y de la IFRRO"
- Speaker, Sydney Bar, NSW, Australia, 1996. Topic: "Intellectual Property and Technology"
- Speaker, Congress of the International Publishers Association, Barcelona, Spain, 1996. Topic: "Online Copyright Licensing"
- Speaker, Pan African Film Festival (FESPACO), Ouagadougou, Burkina Faso, 1994. Topic: "Protection of Intellectual Property in Film"
- Speaker, Chambre française du commerce et de l'exportation (CFCE), Paris, 1990. Topic : "TRIPS: Le point à dix semaines de Bruxelles"

c) **Publications** [2]

i) Summary

Books authored .... 10+2

Books edited .... 6+1

Book chapters .... 50+5

Articles 72

Conference proceedings 2

Book reviews 2

General publications 35

Technical Reports, Law Reform, and Commissioned Research Work 6

ii) Detailed description

Books (authored)

1. RESTRUCTURING COPYRIGHT: A PATH TOWARDS INTERNATIONAL COPYRIGHT REFORM (forthcoming, Edward Elgar[3], 2016), approximately 350 pages
2. INTERNATIONAL INTELLECTUAL PROPERTY: AN ADVANCED INTRODUCTION (E Elgar, *forthcoming January 2016*) – with Prof. Susy Frankel, approximately 140 pages
3. THE TRIPS AGREEMENT: DRAFTING HISTORY AND ANALYSIS, 4th edn (Sweet & Maxwell, 2012)
4. THE TRIPS AGREEMENT: DRAFTING HISTORY AND ANALYSIS, Asian edition (Sweet & Maxwell Asia, 2012)
5. INTELLECTUAL PROPERTY: THE LAW IN CANADA, 2d ed. (Carswell, 2011) --with Prof. Elizabeth Judge, 1223 p.

   - Cited by the Supreme Court of Canada in a number of cases
6. L'ACCORD SUR LES ADPIC: PROPRIÉTÉ INTELLECTUELLE À L'OMC (Larcier, 2010), 733 p.
7. THE TRIPS AGREEMENT: DRAFTING HISTORY AND ANALYSIS, 3rd edn. (Sweet & Maxwell, December 2008), 785 p.

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[2] Where possible, titles are hyperlinked. *See also* http://bit.ly/tsGP0y. The number following the "+" sign indicates the number of forthcoming titles in each category accepted for publication.
[3] New 'premium monograph series' edited by Professors Graeme Dinwoodie (Oxford) and Rochelle Dreyfuss (NYU Law).

a. **Cited by the Supreme Court of the United States in Golan v. Holder (2011) and Wiley v. Kirtsaeng (2013)**
b. **This and previous editions cited in several Advocate Generals' Opinions, Court of Justice of the European Union**

8. LE DROIT DE LA PROPRIETE INTELLECTUELLE, (Yvon Blais, 2006). 702 pages--with Professors Elizabeth Judge and Mistrale Goudreau
9. INTELLECTUAL PROPERTY: THE LAW IN CANADA (Carswell, 2005), with Prof. Elizabeth Judge
10. THE TRIPS AGREEMENT: DRAFTING HISTORY AND ANALYSIS, 2ND ed. (Sweet & Maxwell, June 2003). 590 p.
11. THE TRIPS AGREEMENT: DRAFTING HISTORY AND ANALYSIS. (Sweet & Maxwell, 1998). 444 p.
12. LA NOTION D'ŒUVRE DANS LA CONVENTION DE BERNE ET EN DROIT COMPARÉ. (Librairie Droz, 1998). 276 p.

Books (edited)

1. COLLECTIVE MANAGEMENT OF COPYRIGHT AND RELATED RIGHTS, 3rd edn (Kluwer Law International, *forthcoming*) 495 p.
2. INTERNATIONAL INTELLECTUAL PROPERTY: A HANDBOOK OF CONTEMPORARY RESEARCH (E Elgar, 2015). 482 pages
3. INTELLECTUAL PROPERTY, TRADE AND DEVELOPMENT 2nd edn (Oxford Univ. Press, 2014). 364 pages.
4. THE EVOLUTION AND EQUILIBRIUM OF COPYRIGHT IN THE DIGITAL AGE (Cambridge Univ. Press, 2014)—with Prof. Susy Frankel. 325 pages.
5. COLLECTIVE MANAGEMENT OF COPYRIGHT AND RELATED RIGHTS, 2nd edn (Kluwer Law International, 2010) 495 p.
6. INTELLECTUAL PROPERTY, TRADE AND DEVELOPMENT (Oxford Univ. Press, 2007). 564 p.
7. COLLECTIVE MANAGEMENT OF COPYRIGHT AND RELATED RIGHTS (Kluwer Law International, 2006), 464 p.

Book chapters (all languages)

1. *The Cultural Role of Copyright Collectives*, in RESEARCH HANDBOOK ON INTELLECTUAL PROPERTY IN MEDIA AND ENTERTAINMENT (M. Richardson, ed) (E Elgar, 2015-16, *forthcoming*)
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