

MODULE IX

DISPUTE PREVENTION AND SETTLEMENT

A Introduction

Modules II to VIII have dealt with members' commitments as regards the substantive standards for protection of IPRs under domestic laws, as well as their enforcement through their domestic legal systems. An important feature of the TRIPS Agreement is that disputes between members about compliance by member governments with these TRIPS obligations are subject to the dispute settlement system of the WTO. The TRIPS provisions on dispute settlement are contained in Part V of the TRIPS Agreement entitled 'Dispute Prevention and Settlement'.

Dispute settlement is a major feature of the WTO legal system, and this module outlines how it applies to disputes between members concerning compliance with TRIPS obligations. First, however, it reviews the main TRIPS provisions and working methods relating to transparency, whose main goal is to contribute to preventing disputes from arising between governments in the first place. This module then reviews the main principles governing dispute settlement, including the jurisdiction of the WTO, and briefly describes the WTO dispute settlement procedures. A particular matter, still unresolved, concerns the applicability of the so-called non-violation and situation complaints to the settlement of disputes under the TRIPS Agreement. This module then reviews the experience to date with disputes about TRIPS compliance. A complete list of disputes in the area of TRIPS is provided at the end of this module, together with information about how to access the key documents.

This module provides a general overview of how the WTO dispute settlement system relates to the TRIPS Agreement. A guide to resources is provided at the end of the module.

B Dispute prevention and the review of implementing legislation

Module I described how the TRIPS Council is the body, open to all members of the WTO, that has responsibility for the administration of the TRIPS Agreement, in particular for monitoring the operation of the Agreement. The Council also constitutes a forum for consultations on any problems relating to TRIPS arising between members as well as for clarifying and interpreting provisions of the TRIPS Agreement. The aim is, whenever possible, to resolve differences between members without the need for formal recourse to dispute settlement.

The TRIPS Agreement promotes transparency by requiring members to publish laws and regulations and final judicial decisions and administrative rulings of general application made effective by a member pertaining to the subject matter of the

Agreement. Relevant bilateral and other agreements must also be published (Article 63.1).

Article 63.2 requires members to notify relevant laws and regulations to the TRIPS Council in order to assist in its review of the operation of the Agreement. This is also designed to promote transparency. Module I and Appendix 1 discuss these procedures in detail.

One of the characteristics of the former GATT and now of the WTO is the detailed and continuous follow-up of the implementation of obligations and the monitoring of compliance with them. The underlying belief is that unless there is monitoring of compliance with international commitments, those commitments will be worthless. Monitoring of compliance in the TRIPS Council is done in two main ways.

First, the TRIPS Council is a body in which any member can raise any issue relating to compliance with the TRIPS Agreement by other parties. This has happened on a number of occasions, either in relation to the practices of a specific member, or concerning the application of a specific provision of the TRIPS Agreement.

The second approach to monitoring compliance is a systematic examination of each member's national implementing legislation by the other members, involving the notification and a review of the legislation of members. The initial notification of implementing laws and regulations made by each member pursuant to Article 63.2 at the end of its transition period forms the basis for the review of the implementing legislation of that member carried out by the Council. Reviews were held for developed country members starting in 1996, and for developing countries in 2000. The implementing legislation of an acceding member is reviewed after it becomes a WTO member. For the discussion of the procedures for these reviews and resulting documentation, see Module I, section E2(b).

These reviews have produced a great deal of valuable information about the diverse ways in which members have given effect in their national laws to the general principles set out in TRIPS. By providing an opportunity to identify deficiencies in notified laws and regulations, as well as differences in interpretation, the review mechanism is an important vehicle for resolving issues that might otherwise become the subject of formal dispute settlement proceedings.

The initial review of the great majority of members' legislation has concluded; however, this review is for many jurisdictions significantly dated (being well over 20 years old), and many significant reforms and revisions have been implemented in members' legislation since their initial review. Hence, the question has arisen for the TRIPS Council as to how to sustain its review function in a 'steady state' environment now that the initial 'ramp up' stage of initial reviews has more or less concluded.

Another provision promoting transparency and aimed at preventing disputes is found in Article 63.3. It requires each member to be prepared to supply, in response to a

written request from another member, information on its relevant laws and regulations, decisions of general application, and bilateral agreements. A member, having reason to believe that a specific judicial decision, administrative ruling or bilateral agreement affects its rights under the TRIPS Agreement, may also request in writing to be given access to or be informed in sufficient detail of such material.

C Dispute settlement

1 General

An important feature of the TRIPS Agreement is that it provides an operational system for the settlement of disputes between governments of members about compliance with their respective obligations relating to IPRs. Pre-existing international law in this area did not provide any practical means of recourse, at the multilateral level, to a country that believed that another country was not respecting its treaty obligations. Now, member governments who wish to take action against an alleged violation of a TRIPS obligation have recourse to the multilateral WTO dispute settlement procedures in order to obtain a satisfactory settlement of the matter. These procedures also apply to alleged violations of the provisions of the Berne and Paris Conventions, and other treaties, where incorporated in the TRIPS Agreement.

Article 64.1 provides that Articles XXII and XXIII of the General Agreement on Tariffs and Trade 1994 (GATT 1994), as elaborated and applied by the Dispute Settlement Understanding on Rules and Procedures Governing the Settlement of Disputes (DSU), shall apply to consultations and the settlement of disputes under the TRIPS Agreement. As noted in Module I, like the TRIPS Agreement, the DSU is an annex to the Marrakesh Agreement Establishing the World Trade Organization (WTO Agreement). The DSU provides rules and procedures for consultations and the settlement of disputes between members concerning their rights and obligations under certain WTO agreements. It applies to the WTO Agreement and the agreements listed in Appendix 1 of the DSU, referred to as the 'covered agreements'.⁸⁴

In general, the procedures are based on previous experience in the GATT, which was the forerunner of the WTO. This is why Article 64.1 of the TRIPS Agreement refers to the provisions of Articles XXII and XXIII of the GATT 1994, as elaborated and applied by the DSU.

Only a member can initiate and participate in WTO dispute settlement, and such complaints can only be directed at other members, due to the intergovernmental nature of the WTO. Members decide which disputes to bring to the WTO. Neither the

⁸⁴ The covered agreements include the WTO Agreement, multilateral agreements on trade in goods, the GATS, the TRIPS Agreement, and the DSU itself. The covered agreements also include the Plurilateral Trade Agreements contained in Annex 4 to the WTO Agreement, subject to the adoption of a decision by the parties to each agreement setting out the terms for the application of the DSU. To date, among the Plurilateral Trade Agreements currently in force, only the Committee on Government Procurement has taken a decision to apply the DSU to the Agreement on Government Procurement. The DSU also applies to the Revised Agreement on Government Procurement, as stipulated in its Article XX.

WTO as an organization, nor its Secretariat, nor any private party can make that decision. Before bringing a case, a member must exercise its judgment as to whether action under the dispute settlement procedures would be fruitful but, once it has engaged the dispute settlement mechanism, the WTO must follow its procedures to their conclusion or until the parties agree otherwise. Parties to a dispute can agree to settle the case at any stage of the process. A solution mutually agreed by the parties and consistent with the WTO covered agreements is clearly to be preferred.

Private parties whose rights and interests are affected by the implementation of the covered agreements have no standing in WTO dispute settlement, but must rely on their government to bring or defend an action, or to intervene as a so-called third party. A 'third party' is a member who is not a party to the dispute but has a substantial interest in the matter. It can request to take part in consultations, and shall have an opportunity to be heard by, and make written submissions to, the panel (Article 10.2 of the DSU). It may also participate in the appellate review process (Article 17.4 of the DSU).

Article XXIII:1 of the GATT 1994 provides for three grounds for complaints: (1) the failure of another member to carry out its obligations under a WTO covered agreement; (2) the application by another member of any measure, whether or not it conflicts with the provisions of a covered agreement; or (3) the existence of any other situation.

In practice, most complaints brought to the WTO dispute settlement system are of the first type: concerning an alleged failure by another member to carry out its obligation under a WTO covered agreement, including the TRIPS Agreement. These are commonly known as 'violation complaints'.

The second and third grounds for complaint allow a member to initiate dispute settlement proceedings even when an agreement has not been violated, so-called 'non-violation complaints' or 'situation complaints'. While these complaints can be raised about other WTO covered agreements, members have agreed to a moratorium on the use of non-violation and situation complaints in the area of TRIPS (see section C2 below).

Members have agreed to have recourse to the WTO procedures when they seek to take action against a violation of an obligation, and not to make unilateral determinations of violation or on retaliatory action. A member must first go through the dispute settlement procedure before it makes a determination that a violation has occurred, which requires it to prove its claims before an impartial *ad hoc* panel, and on appeal if this avenue is chosen. Where its claims are upheld, the report of the panel or Appellate Body will recommend that the committee of all members known as the Dispute Settlement Body (DSB) request the member concerned to bring its measures into conformity with its obligations under the TRIPS Agreement.

The WTO dispute settlement system is designed to ensure the rule of law in international trade relations through the impartial and effective resolution of disputes

between member governments. Members must engage in dispute settlement procedures in good faith in an effort to resolve disputes and are expected to comply with the final rulings and recommendations in adopted reports, pending which compensation may be accorded or countermeasures authorized.

Section D below contains a brief description of the dispute settlement procedures.

2 *Non-violation and situation complaints*

As noted above, most complaints brought to the dispute settlement system concern an alleged failure by another member to carry out its obligations under a WTO covered agreement. These are commonly known as ‘violation complaints’. ‘Non-violation’ deals with a member’s entitlement to bring a dispute to the WTO, based on loss of an expected benefit caused by another member’s actions in circumstances when no covered WTO agreement or commitment has actually been violated. An example of this could be where a member has agreed to lower tariffs on certain goods, but then introduces measures that nullify the effect of the tariff reduction, for example by providing an equivalent production subsidy to its domestic producers.⁸⁵

BOX IX.1 PARAGRAPH 1 OF ARTICLE XXIII OF GATT 1994 ON THE THREE GROUNDS FOR COMPLAINTS

If any contracting party should consider that any benefit accruing to it directly or indirectly under this Agreement is being nullified or impaired or that the attainment of any objective of the Agreement is being impeded as the result of

- (a) the failure of another contracting party to carry out its obligations under this Agreement, or
- (b) the application by another contracting party of any measure, whether or not it conflicts with the provisions of this Agreement, or
- (c) the existence of any other situation,

the contracting party may, with a view to the satisfactory adjustment of the matter, make written representations or proposals to the other contracting party or parties which it considers to be concerned. Any contracting party thus approached shall give sympathetic consideration to the representations or proposals made to it.

In general, the aim of non-violation complaints is to help preserve the balance of benefits struck during multilateral negotiations, recognizing that it is not possible or

⁸⁵ See Working Party Report, *The Australian Subsidy on Ammonium Sulphate*, [GATT/CP.4/39](#), adopted 3 April 1950.

desirable to seek to regulate all government measures that may affect the value of such benefits.

A ‘situation’ complaint is understood to cover any situation that results in nullification or impairment of benefits, not necessarily through a specific government measure, but this concept has never been analysed in WTO and GATT dispute settlement.

Initially, Article 64.2 of the TRIPS Agreement prevented the application of non-violation and situation complaints to disputes under the TRIPS Agreement within the first five years of the entry into force of the Agreement. Article 64.3 of the TRIPS Agreement instructed the TRIPS Council to examine the extent and way (‘scope and modalities’) in which complaints of this type could be made and make recommendations to the General Council by the end of 1999.

This ‘moratorium’ on the use of non-violation and situation complaints has been extended a number of times, namely by ministers at the Doha Ministerial Conference in 2001,⁸⁶ by the WTO General Council in 2004 as part of the so-called ‘July 2004 package’,⁸⁷ and by the Ministerial Conferences in Hong Kong, China in 2005;⁸⁸ Geneva in 2009⁸⁹ and 2011;⁹⁰ Bali in 2013;⁹¹ Nairobi in 2015;⁹² and Buenos Aires in 2017.⁹³ Most recently, the moratorium was extended by the General Council in 2019.⁹⁴ At the same time, the TRIPS Council has been instructed to continue its examination of the scope and modalities for these types of complaints and make recommendations.⁹⁵

D Description of the dispute settlement procedures

This section reviews what happens when one WTO member chooses to bring a formal complaint against another member concerning compliance with TRIPS standards. The procedures are the same as for any other WTO dispute, there being no special procedures for TRIPS (apart from the restriction to ‘violation’ disputes, discussed above). The dispute settlement process has three main phases: (i) consultations between the parties; (ii) adjudication by panels and, if either party appeals a panel ruling, by the Appellate Body; and (iii) adoption of panel/appellate reports(s) and implementation of the ruling, which includes the possibility of countermeasures in the event that the losing party fails to implement the ruling. Figure IX.1 illustrates the procedural steps in a typical WTO dispute settlement case, which are discussed below.

⁸⁶ Decision on Implementation-Related Issues and Concerns, [WT/MIN\(01\)/17](#) (14 November 2001), para. 11.1.

⁸⁷ Decision on the Doha Work Programme, [WT/L/579](#) (1 August 2004), para. 1.h.

⁸⁸ Ministerial Declaration on the Doha Work Programme, [WT/MIN\(05\)/DEC](#) (18 December 2005), para. 45.

⁸⁹ Decision on TRIPS Non-Violation and Situation Complaints, [WT/L/783](#) (2 December 2009).

⁹⁰ Decision on TRIPS Non-Violation and Situation Complaints, [WT/L/842](#) (17 December 2011).

⁹¹ Decision on TRIPS Non-Violation and Situation Complaints, [WT/MIN\(13\)/31-WT/L/906](#) (7 December 2013).

⁹² Decision on TRIPS Non-Violation and Situation Complaints, [WT/MIN\(15\)/41-WT/L/976](#) (19 December 2015).

⁹³ Decision on TRIPS Non-Violation and Situation Complaints, [WT/MIN\(17\)/66-WT/L/1033](#) (13 December 2017).

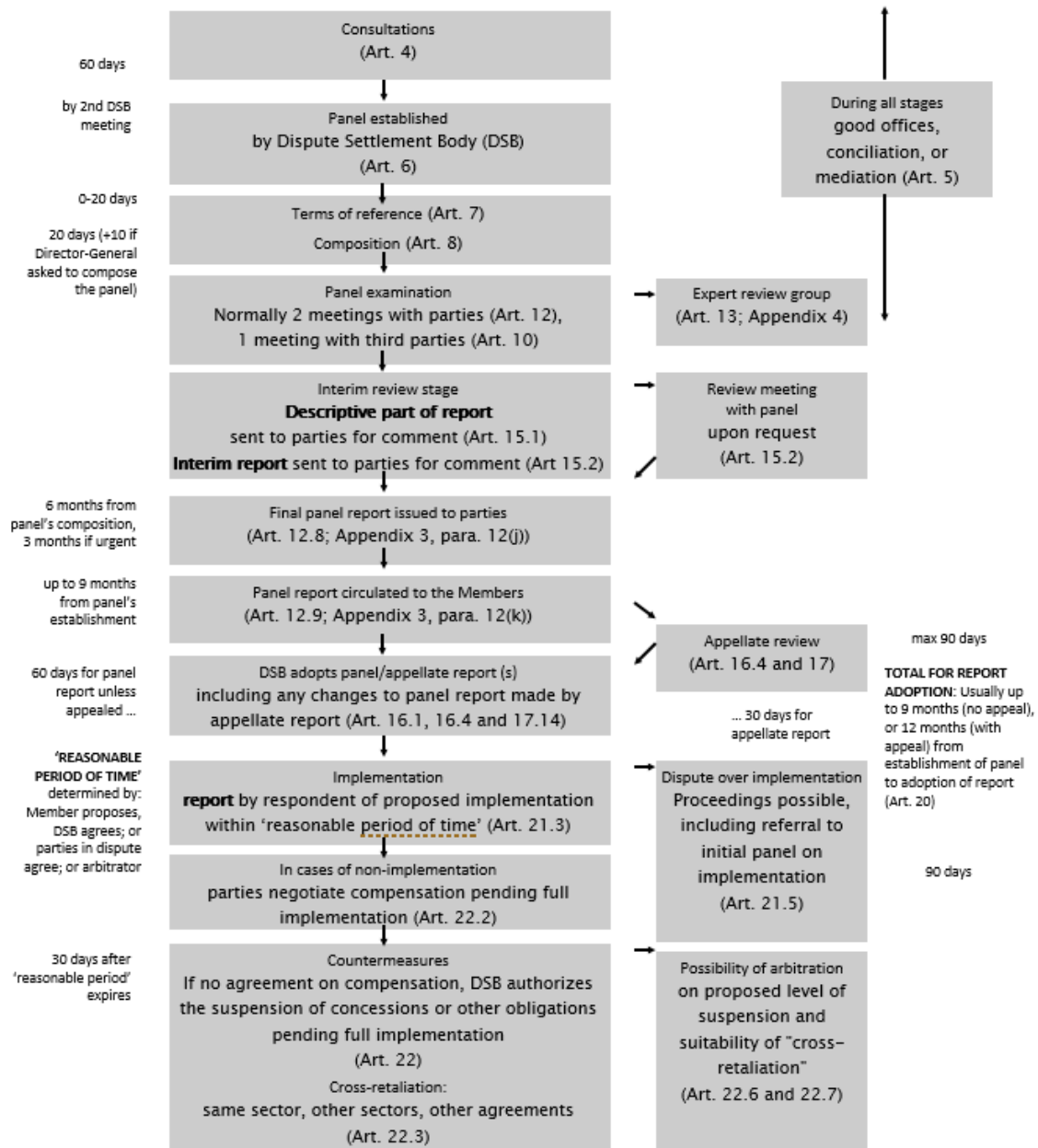
⁹⁴ Decision on TRIPS Non-Violation and Situation Complaints Moratorium, [WT/L/1080](#) (11 December 2019).

⁹⁵ Further information can be found in a Secretariat summary note on delegations’ positions on non-violation complaints at the TRIPS Council in document [IP/C/W/349/Rev.2](#), and in a factual background note on experience with non-violation complaints under the GATT/WTO in document [IP/C/W/124](#). For recent member communications summarizing positions and offering proposals on this subject, see [IP/C/W/385/Rev.1](#) and Add.1-3 and [IP/C/W/599](#).

1 Consultations between the parties

The procedures begin with a mandatory consultation period in an effort to find a mutually satisfactory solution. Members must enter into consultations in good faith within thirty days of a formal request for consultations, and the consultations must last at least sixty days from the date of receipt of the request, unless the parties agree otherwise or the member addressed by the request refuses to consult. During this time, the issues in dispute may be clarified, helping the parties to settle the dispute without further procedures, as indeed has happened in a number of cases. Other members with a substantial trade interest can also request to join the consultations. All requests for consultations are circulated to all members and made available to the public on the WTO website; they outline the substance of the complaint and identify the provisions that are at issue.

Figure IX.1 WTO dispute settlement process, including references to relevant provisions of the DSU



2 Panel examination

If the consultations fail to settle a dispute, the complaining member may request the DSB to establish a 'panel' to examine the matter and make such findings as will assist the DSB in making recommendations to secure a positive solution to the dispute. A panel must be established at the latest by the second request to the DSB. Other members with a substantial interest in the matter can join the dispute as third parties.

Panels normally comprise three persons of appropriate background and experience, who are not citizens of members party to the dispute or third parties, unless the parties to the dispute agree otherwise. They serve in their individual capacity and not as government representatives. They are never serving WTO Secretariat officials. The parties to the dispute attempt to agree on the composition of the panel on the basis of names proposed by the Secretariat, failing which the Director-General can, upon request, determine its composition in consultation with the parties to the dispute. The names of the panellists are made public on the WTO website.

The parties to the dispute make written submissions and oral statements at meetings with the panel. Third parties also have an opportunity to be heard by the panel and make written submissions to it. A panel should normally complete its work within six months, by publishing a report containing findings of fact and law, with its conclusions. The report is circulated to all members and made available to the public on the WTO website. If there is no appeal, it can be proposed for adoption by the DSB.

3 Appellate review

A party to the dispute may appeal the panel's findings to the Appellate Body, which is a standing body of seven individuals, three of whom serve on any one case. Members, in the DSB, appoint Appellate Body members to four-year terms.

Appeals are limited to issues of law covered in the panel report and legal interpretations developed by the panel. The parties, and optionally third parties, make written submissions and oral statements at a meeting with the Appellate Body. The DSU provides that the Appellate Body is to complete its work within ninety days by publishing a report containing its findings on the issues raised in the appeal, which may uphold, modify or reverse the legal findings and conclusions of the panel. The report is circulated to all members and made available to the public on the WTO website.

4 Adoption of panel/appellate report(s) and implementation

If the panel report is not appealed in a dispute, the DSB considers and adopts the report unless there is consensus among members not to do so: once adopted, the panel report is binding on the parties to the dispute. If it is appealed, the resultant Appellate Body report is similarly binding on the parties.

Where a panel or the Appellate Body has concluded that a measure was inconsistent with the TRIPS Agreement, or any other WTO covered agreement, its report will recommend that the member concerned bring the measure into conformity with that agreement. The member is given a reasonable period of time in which to do so. The reasonable period of time is agreed by the parties, failing which it can be determined by arbitration. In TRIPS cases this has generally ranged from six months, where a regulation had to be repealed, to twelve months, where a statute had to be amended by the legislature.

In the great majority of cases, members comply with the recommendations contained in a report as adopted by the DSB. However, if there is disagreement as to whether a member has indeed complied, the disagreement can be decided through another proceeding before a panel, wherever possible the same three persons who formed the original panel. This has only occurred in a relatively small number of cases so far, sometimes because there was a disagreement as to whether amendments made to the law to comply with the recommendations were themselves consistent with the WTO covered agreements. The panel completes its work by publishing another report, which can also be appealed to the Appellate Body.

The DSB monitors implementation of its recommendations. The member concerned must provide regular status reports on implementation from at least six months after the date on which the reasonable period of time is established until the issue is resolved.

Full implementation of a recommendation to bring a measure into conformity with the WTO covered agreements is the aim of this part of the procedures. However, pending implementation there is a possibility for the party which prevailed in the dispute to obtain voluntary compensation from the member concerned, or authorization from the DSB to suspend obligations or withdraw concessions *vis-à-vis* that member (in other words to impose 'countermeasures' or 'retaliate'). This possibility is intended to give credibility to the system and ensure prompt compliance within the reasonable period of time. Although findings are normally implemented within this period, in a relatively small number of cases countermeasures have been authorized.

Countermeasures can be authorized, as a general principle, in the same WTO covered agreement where WTO inconsistencies have been found. So, for example, import duties can be increased above the bound rates on goods from a member that has been found in breach of the GATT rules on trade in goods. Where this general principle is not practicable or effective, countermeasures can be authorized under another WTO covered agreement from the one in which the WTO inconsistencies have been found, which is known as 'cross-retaliation'.

As of the end of 2019, the DSB has authorized countermeasures in twenty-one disputes. Three of them involved 'cross-retaliation', namely *EC – Bananas III (Ecuador)* (DS27), *US – Gambling* (DS285) and *US – Upland Cotton* (DS267). In each of them,

countermeasures were authorized *inter alia* in the area of TRIPS concerning violations in the area of the GATT or the General Agreement on Trade in Services (GATS).⁹⁶ For example, the first of them concerned the failure of the European Communities to bring its banana regime into compliance with a panel ruling. In 2000, Ecuador received authorization to cross-retaliate against the European Communities by denying them protection of related rights, GIs and industrial designs. This and other related disputes were finally settled by the Geneva Agreement on Trade in Bananas in December 2009.⁹⁷

E Experience in the area of TRIPS

It appears that most cases relating to matters of compliance with the requirements of the TRIPS Agreement are resolved in bilateral consultations between the members concerned, either in Geneva or in capitals, without invoking the dispute settlement procedures in the DSB. Many issues have also come up in the reviews of members' TRIPS implementing legislation carried out by the TRIPS Council, but only very rarely do these issues get a follow-up in dispute settlement proceedings. Even after the invocation of formal dispute settlement procedures, members are encouraged throughout the process to develop a mutually acceptable solution consistent with the WTO covered agreements. In fact, the settlement rate has so far been quite high in the area of TRIPS.

As of December 2019, 42 dispute settlement complaints had been initiated in the WTO in the area of TRIPS in relation to 32 distinct matters or specific cases. This represents about 7 per cent of cases filed under all WTO covered agreements. Panel reports and, when they have been appealed, Appellate Body reports, have been adopted in twelve cases. Fourteen of the other cases have been settled bilaterally between the parties to the dispute; the terms of these settlements are made public and can be important in influencing the way others implement the Agreement. As regards the rest, consultations or panel or Appellate Body proceedings are still pending, or the case has become inactive.

Table IX.1 below contains a list of all the TRIPS cases, their status as of February 2020, and the primary IP issues and TRIPS provisions relevant to each. Additional information on these disputes may be found in the *WTO Analytical Index: Guide to Law and Practice*, www.wto.org/analyticalindex, *WTO Dispute Settlement: One-Page Case Summaries*, www.wto.org/onepagecasesummaries, and on the WTO website, www.wto.org/finddisputes.

⁹⁶ The complaining parties in these three cases were Ecuador, Antigua and Barbuda, and Brazil, respectively. The authorizations by the DSB were based on reports by arbitrators that acted pursuant to Article 22.6 of the DSU to examine whether the level of suspension of concessions or other obligations proposed by the complaining party was equivalent to the level of nullification or impairment, and to determine if the proposed suspension was allowed under the covered agreement. The decisions of the arbitrators can be found in documents [WT/DS27/ARB/EQU](#), [WT/DS285/ARB](#), and [WT/DS267/ARB/1](#) and 2, respectively.

⁹⁷ [WT/L/784](#).

Some of the early TRIPS cases only concerned transitional arrangements. For example, the first TRIPS complaint concerned the extent to which sound recordings that had been made before the TRIPS Agreement became applicable had to be protected (*Japan – Measures Concerning Sound Recordings* (DS28, 42), two cases that were both settled). The first two panel and/or Appellate Body reports were issued on two complaints concerning the so-called ‘mailbox’ and exclusive marketing rights provisions in paragraphs 8 and 9 of Article 70 (*India – Patents (US)* (DS50) and *India – Patents (EC)* (DS79)). Another case on the same issue was settled (*Pakistan – Patent Protection for Pharmaceutical and Agricultural Chemical Products* (DS36)). Panel and appellate reports in a further case concerned the extent to which patents issued prior to the entry into force of the Agreement benefited from the protection under it (*Canada – Patent Term* (DS170)).

Table IX.1 Dispute settlement cases in the area of TRIPS⁹⁸ (as at 6 October 2021)

WTO dispute number ⁹⁹	Respondent and title of dispute (short title provided where a panel has been established)	Complainant	Status	TRIPS provisions ¹⁰⁰	IP issues
DS590	JAPAN – Measures Related to the Exportation of Products and Technology to Korea	KOREA, REPUBLIC OF	Panel established on 29 July 2020	Arts. 3, 4, 28	National and MFN treatment in the protection of IP rights; right to assign and license patents.
DS583	TURKEY – Pharmaceutical Products (EU)	EU	Panel established on 30 September 2019	Arts. 3, 27, 28, 39 (noted in request for consultations but omitted from panel request)	National treatment in the protection of IP rights; discrimination among imported and locally produced products in the availability and enjoyment of patent rights; right to assign and transfer patents and conclude licensing contracts; protection of undisclosed information.
DS567	SAUDI ARABIA – IPRs	QATAR	Panel report circulated on 16 June 2020, appealed on 29 July 2020	Arts. 3, 4, 9 (incorporating Arts. 9, 11, 11 <i>bis</i> and 11 <i>ter</i> of the Berne Convention), 14, 16, 41, 42, 61	National and MFN treatment in the protection of IP rights; certain substantive protections in respect of works and broadcasts; access to civil procedures for IP enforcement; application of criminal procedures.
DS549	CHINA – Certain Measures on the Transfer of Technology	EU	Consultations requested on 1 June 2018	Arts. 3, 28, 33, 39	National treatment in the protection of IP rights, patent rights and licensing; term of patent protection; protection of undisclosed information.

⁹⁸ This table is intended to facilitate understanding of the cited cases but does not constitute an official or authoritative interpretation by the WTO Secretariat or WTO Members of the cases or the TRIPS Agreement.

⁹⁹ Click the link in this column to be taken to the corresponding dispute web page, where additional details and links to relevant documents may be found. Alternatively, go to www.wto.org/disputes, 'Find disputes', to search for a dispute web page and/or create document alerts.

¹⁰⁰ A single dispute often implicates provisions from multiple WTO agreements; this table only identifies those from the TRIPS Agreement. The contents of this column derive from the panel report; if a panel report was not circulated, the panel request; or if a panel was not requested, the request for consultations.

WTO dispute number ⁹⁹	Respondent and title of dispute (short title provided where a panel has been established)	Complainant	Status	TRIPS provisions ¹⁰⁰	IP issues
DS542	CHINA – Intellectual Property Rights II	US	Panel established on 21 November 2018, work suspended most recently on 8 June 2020, authority lapsed on 9 June 2021	Arts. 3, 28	National treatment in the protection of IP rights; patent rights and licensing.
DS528	SAUDI ARABIA – Measures Relating to Trade in Goods and Services, and Trade-Related Aspects of Intellectual Property Rights	QATAR	Consultations requested on 31 July 2017	Arts. 3, 4	National and MFN treatment in the protection of IP rights.
DS527	BAHRAIN – Measures Relating to Trade in Goods and Services, and Trade-Related Aspects of Intellectual Property Rights	QATAR	Consultations requested on 31 July 2017	Arts. 3, 4	National and MFN treatment in the protection of IP rights.
DS526	UNITED ARAB EMIRATES – Goods, Services and IP Rights	QATAR	Panel established on 22 November 2017, work suspended on	Arts. 3, 4, 41, 42 and 61	National and MFN treatment in the protection of IP rights; access to civil procedures for IP enforcement; application of criminal procedures.

WTO dispute number ⁹⁹	Respondent and title of dispute (short title provided where a panel has been established)	Complainant	Status	TRIPS provisions ¹⁰⁰	IP issues
			15 January 2021		
DS467	AUSTRALIA – Tobacco Plain Packaging (Indonesia)	INDONESIA	Panel report adopted on 27 August 2018	Arts. 2 (incorporating Art. 10bis of the Paris Convention), 15, 16, 20, 22, 24	Registration and protection of trademarks, and special requirements on their use; protection of GIs; unfair competition.
DS458	AUSTRALIA – Tobacco Plain Packaging (Cuba)	CUBA	Panel report adopted on 27 August 2018	Arts. 2 (incorporating Arts. 6quinquies, 7, and 10bis of the Paris Convention), 15, 16, 20, 22, 24	Registration and protection of trademarks, and special requirements on their use; protection of GIs; unfair competition.
DS441	AUSTRALIA – Tobacco Plain Packaging (Dominican Republic)	DOMINICAN REPUBLIC	Appellate Body and Panel reports adopted on 29 June 2020	Arts. 2 (incorporating Art. 10bis of the Paris Convention), 15, 16, 20, 22, 24	Registration and protection of trademarks, and special requirements on their use; protection of GIs; unfair competition.
DS435	AUSTRALIA – Tobacco Plain Packaging (Honduras)	HONDURAS	Appellate Body and Panel reports adopted on 29 June 2020	Arts. 2 (incorporating Arts. 6quinquies, 7, and 10bis of the Paris Convention), 15, 16, 20, 22, 24	Registration and protection of trademarks, and special requirements on their use; protection of GIs; unfair competition.
DS434	AUSTRALIA – Tobacco Plain Packaging (Ukraine)	UKRAINE	Panel established on 28 September 2012, work	Arts. 1, 2 (incorporating Arts. 6quinquies, 7, and 10bis of the Paris	Registration and protection of trademarks, and special requirements on their use; unfair competition.

WTO dispute number ⁹⁹	Respondent and title of dispute (short title provided where a panel has been established)	Complainant	Status	TRIPS provisions ¹⁰⁰	IP issues
			suspended on 29 May 2015, authority lapsed on 30 May 2016	Convention), 3, 15, 16, 20	
DS409	EUROPEAN UNION AND A MEMBER STATE – Seizure of Generic Drugs in Transit	BRAZIL	Consultations requested on 11 May 2010	Arts. 1, 2 (incorporating Art. 4bis of the Paris Convention), 28, 31, 41, 42, 49, 50-55, 58, 59	Seizure of generic drugs while in transit in the EU, covered by patent rights in the EU but not in original country or final destination.
DS408	EUROPEAN UNION AND A MEMBER STATE – Seizure of Generic Drugs in Transit	INDIA	Consultations requested on 11 May 2010	Arts. 2, 7, 8, 28, 31, 41, 42	Seizure of generic drugs while in transit in the EU, covered by patent rights in the EU but not in original country or final destination.
DS372	CHINA – Measures Affecting Financial Information Services and Foreign Financial Information Suppliers	EC	Mutually agreed solution notified on 4 December 2008	Art. 39	Whether measures affecting foreign suppliers of financial information enabled suppliers to protect secret and commercially valuable information lawfully within their control.
DS362	CHINA – Intellectual Property Rights	US	Panel report adopted on 20 March 2009	Arts. 9 (incorporating Arts. 2(6) and 5 of the Berne Convention), 41, 46, 59, 61	Thresholds for trademark counterfeiting and copyright piracy to be subject to criminal procedures and penalties; disposal of infringing goods confiscated by customs authorities; criminal procedures and penalties for unauthorized reproduction or unauthorized distribution of copyrighted works; and copyright protection and

WTO dispute number ⁹⁹	Respondent and title of dispute (short title provided where a panel has been established)	Complainant	Status	TRIPS provisions ¹⁰⁰	IP issues
					enforcement for material not authorized for the publication or distribution within China.
DS290	EUROPEAN COMMUNITIES – Trademarks and GIs (Australia)	AUSTRALIA	Panel report adopted on 20 April 2005	Arts. 2 (incorporating Arts. 2, 10bis, and 10ter of the Paris Convention), 3, 4, 10, 16, 17, 22, 24	National treatment in the protection of GIs, and the relationship of GI protection with pre-existing trademarks.
DS224	UNITED STATES – US Patents Code	BRAZIL	Consultations requested on 31 January 2001	Arts. 27, 28	Patent rights on inventions made with federal assistance.
DS199	BRAZIL – Measures Affecting Patent Protection	US	Mutually agreed solution notified on 5 July 2001	Arts. 27, 28	'Local working' requirements for patents, and possibility of compulsory licensing if not produced locally.
DS196	ARGENTINA – Certain Measures on the Protection of Patents and Test Data	US	Mutually agreed solution notified on 31 May 2002	Arts. 27, 28, 31, 34, 39, 50, 62, 65, 70	Protection against unfair commercial use of test data submitted for regulatory use; scope of biotechnology patents; provisional court orders for infringement and the burden of proof for infringement of process patents; patent rights over products produced by patented processes and imports; safeguards for compulsory licences; transitional patents.

WTO dispute number ⁹⁹	Respondent and title of dispute (short title provided where a panel has been established)	Complainant	Status	TRIPS provisions ¹⁰⁰	IP issues
DS186	UNITED STATES – Section 337 of the Tariff Act of 1930 and Amendments thereto	EC	Consultations requested on 12 January 2000	Arts. 2 (incorporating Art. 2 of the Paris Convention), 3, 9 (incorporating Art. 5 of the Berne Convention), 27, 41, 42, 49, 50, 51	National treatment and non-discrimination in the enforcement of IP rights.
DS176	UNITED STATES – Section 211 Appropriations Act	EC	Appellate Body and Panel reports adopted on 1 February 2002	Arts. 2 (incorporating Art. 6quinquies of the Paris Convention), 3, 4, 15, 16, 42	National treatment in the enjoyment of trademark rights; ownership entitlements on IP.
DS174	EUROPEAN COMMUNITIES – Trademarks and GIs (US)	US	Panel report adopted on 20 April 2005	Arts. 1, 2 (incorporating Art. 2 of the Paris Convention), 3, 4, 16, 17, 22, 24	National treatment in the protection of GIs, and the relationship of GI protection with pre-existing trademarks; exceptions to trademark rights.
DS171	ARGENTINA – Patent Protection for Pharmaceuticals and Test Data Protection for Agricultural Chemicals	US	Mutually agreed solution notified on 31 May 2002	Arts. 27, 39, 65, 70	Patent protection or exclusive marketing rights for pharmaceutical products; protection of test data during transition period for TRIPS implementation.
DS170	CANADA – Patent Term	US	Appellate Body and Panel reports adopted on 12 October 2000	Arts. 33, 65, 70	Term of patents already in force when TRIPS comes into effect.

WTO dispute number ⁹⁹	Respondent and title of dispute (short title provided where a panel has been established)	Complainant	Status	TRIPS provisions ¹⁰⁰	IP issues
DS160	UNITED STATES – Section 110(5) Copyright Act	EC	Panel report adopted on 27 July 2000 Award of the arbitrator pursuant to the recourse to Arbitration under Article 25 circulated on 9 November 2001 Mutually Satisfactory Temporary Arrangement notified on 23 June 2003 (effective until 21 December 2004)	Arts. 9 (incorporating Arts. 11 and 11 <i>bis</i> of the Berne Convention), 13	Substantive protections, and exceptions and limitations to copyright.

WTO dispute number ⁹⁹	Respondent and title of dispute (short title provided where a panel has been established)	Complainant	Status	TRIPS provisions ¹⁰⁰	IP issues
DS153	EUROPEAN COMMUNITIES – Patent Protection for Pharmaceutical and Agricultural Chemical Products	CANADA	Consultations requested on 2 December 1998	Art. 27	Discrimination as to field of technology in patent term extensions.
DS125 (Concerns same measures as DS124 , respondent EC)	GREECE – Enforcement of Intellectual Property Rights for Motion Pictures and Television Programs	US	Mutually agreed solution notified on 20 March 2001	Arts. 41, 61	Enforcement of copyright over TV broadcasts of motion pictures and television programmes.
DS124 (Concerns same measures as DS125 , respondent Greece)	EUROPEAN COMMUNITIES – Enforcement of Intellectual Property Rights for Motion Pictures and Television Programs	US	Mutually agreed solution notified on 20 March 2001	Arts. 41, 61	Enforcement of copyright over TV broadcasts of motion pictures and television programmes.

WTO dispute number ⁹⁹	Respondent and title of dispute (short title provided where a panel has been established)	Complainant	Status	TRIPS provisions ¹⁰⁰	IP issues
DS115 (Concerns same measures as DS82 , respondent Ireland)	EUROPEAN COMMUNITIES – Measures Affecting the Grant of Copyright and Neighbouring Rights	US	Mutually agreed solution notified on 6 November 2000	Arts. 9, 13, 14, 41-48, 61, 63, 65, 70	Copyright protection of translations of official works, architectural works, and anonymous and pseudonymous works; ownership of rights in film, and recognition of bodies established to protect the rights of unknown authors of unpublished works; limitations and exceptions to copyright; rental rights for phonograms; unauthorized recording of performances; criminal procedures and penalties for copyright piracy on a commercial scale; protection of pre-existing material.
DS114	CANADA – Pharmaceutical Patents	EC	Panel report adopted on 7 April 2000	Arts. 27, 28, 30, 33	Exceptions and limitations to rights under a patent; discrimination between fields of technology in patent system.
DS86	SWEDEN – Measures Affecting the Enforcement of Intellectual Property Rights	US	Mutually agreed solution notified on 2 December 1998	Arts. 50, 63, 65	Provisional measures <i>inaudita altera parte</i> in civil proceedings to secure evidence of infringement of IP rights.
DS83	DENMARK – Measures Affecting the Enforcement of Intellectual Property Rights	US	Mutually agreed solution notified on 7 June 2001	Arts. 50, 63, 65	Provisional measures <i>inaudita altera parte</i> in civil proceedings to secure evidence of infringement of IP rights.

WTO dispute number ⁹⁹	Respondent and title of dispute (short title provided where a panel has been established)	Complainant	Status	TRIPS provisions ¹⁰⁰	IP issues
DS82 (Concerns same measures as DS115 , respondent EC)	IRELAND – Measures Affecting the Grant of Copyright and Neighbouring Rights	US	Mutually agreed solution notified on 6 November 2000	Arts. 9 (incorporating Arts. 1-21, except Art. 6 <i>bis</i> , of the Berne Convention), 12-14, 41-48, 61, 63, 65, 70	Copyright protection of translations of official works, architectural works, and anonymous and pseudonymous works; ownership of rights in film, and recognition of bodies established to protect the rights of unknown authors of unpublished works; limitations and exceptions to copyright; rental rights for phonograms; unauthorized recording of performances; criminal procedures and penalties for copyright piracy on a commercial scale; protection of pre-existing material.
DS79	INDIA – Patents (EC)	EC	Panel report adopted on 22 September 1998	Arts. 27, 65, 70	Provisional arrangements pending the introduction of patents on pharmaceutical products.
DS59 (See related complaints by the EC (DS54) and Japan (DS55 , DS64))	INDONESIA – Autos	US	Panel report adopted on 23 July 1998	Arts. 3, 20, 65	Whether benefits for motor vehicles bearing a unique Indonesian trademark owned by Indonesian nationals discriminates against national treatment principle vis-à-vis foreign-owned trademarks and their owners.

WTO dispute number ⁹⁹	Respondent and title of dispute (short title provided where a panel has been established)	Complainant	Status	TRIPS provisions ¹⁰⁰	IP issues
DS50	INDIA – Patents (US)	US	Appellate Body and Panel reports adopted on 16 January 1998	Arts. 27, 65, 70	Provisional arrangements pending the introduction of patents on pharmaceutical products ('mailbox' case).
DS42	JAPAN – Measures Concerning Sound Recordings	EC	Mutually agreed solution notified on 7 November 1997	Arts. 14, 70	Protection of past performances and existing sound recordings.
DS37	PORTUGAL – Patent Protection under the Industrial Property Act	US	Mutually agreed solution notified on 3 October 1996	Arts. 33, 65, 70	Patent terms to be at least 20 years.
DS36	PAKISTAN – Patent Protection for Pharmaceutical and Agricultural Chemical Products	US	Mutually agreed solution notified on 28 February 1997	Arts. 27, 65, 70	Patent protection for pharmaceutical and agricultural chemical products and exclusive marketing rights in such products.
DS28	JAPAN – Measures Concerning Sound Recordings	US	Mutually agreed solution notified on 24 January 1997	Arts. 3, 4, 14, 61, 65, 70	Protection of past performances and existing sound recordings.

A number of the adopted reports relate in substantial part to the scope of allowable exceptions under the Agreement. *Canada – Pharmaceutical Patents* (DS114) focused on the three-step test under Article 30,¹⁰¹ *US – Section 110(5) Copyright Act* (DS160) on the three-step test under Article 13,¹⁰² and *EC – Trademarks and Geographical Indications* (DS174, 290) on Article 17.¹⁰³

More recently, *Australia – Tobacco Plain Packaging* (DS435, 441, 458, 467) addressed, *inter alia*, the scope of trademark rights under Article 16 and Article 20, which provides that the use of a trademark in the course of trade shall not be unjustifiably encumbered by special requirements.¹⁰⁴

The reports in *US – Section 211 Appropriations Act*¹⁰⁵ (DS176) and *EC – Trademarks and Geographical Indications* (DS174, 290) focused on the central principle of non-discrimination. Some bilaterally settled cases have focused on enforcement (*Denmark and Sweden – Measures Affecting the Enforcement of Intellectual Property Rights* (DS83, 86), and *European Communities and Greece – Enforcement of Intellectual Property Rights for Motion Pictures and Television Programs* (DS124, 125)).

The reports in *US – Section 110(5) Copyright Act* (DS160), *US – Section 211 Appropriations Act* (DS176), *EC – Trademarks and Geographical Indications* (DS174, 290), *China – Intellectual Property Rights* (DS362), and *Australia – Tobacco Plain Packaging* (DS435, 441, 458, 467) have had to interpret provisions of the Berne or Paris Conventions, as incorporated into the TRIPS Agreement. Panels and the Appellate Body have sought to take care to interpret the provisions of the TRIPS Agreement and these WIPO conventions in ways which reconcile them and avoid conflicts between them, taking into account the drafting history of the Berne and Paris Conventions and the subsequent practice relating to them. Panels have invariably sought and obtained factual information from the International Bureau of WIPO about drafting history and subsequent practice in regard to WIPO provisions that they have been called upon to interpret.

F Guide to resources

All the WTO documents referred to above are available on the WTO website at docs.wto.org. A special document portal – accessed through the Dispute Settlement Gateway on the WTO website, www.wto.org/disputes – provides easy access to documents on specific TRIPS disputes. Appendix 2 to this Guide provides more information on how to access WTO documents.

¹⁰¹ For a brief summary of the case, see Box V.1.

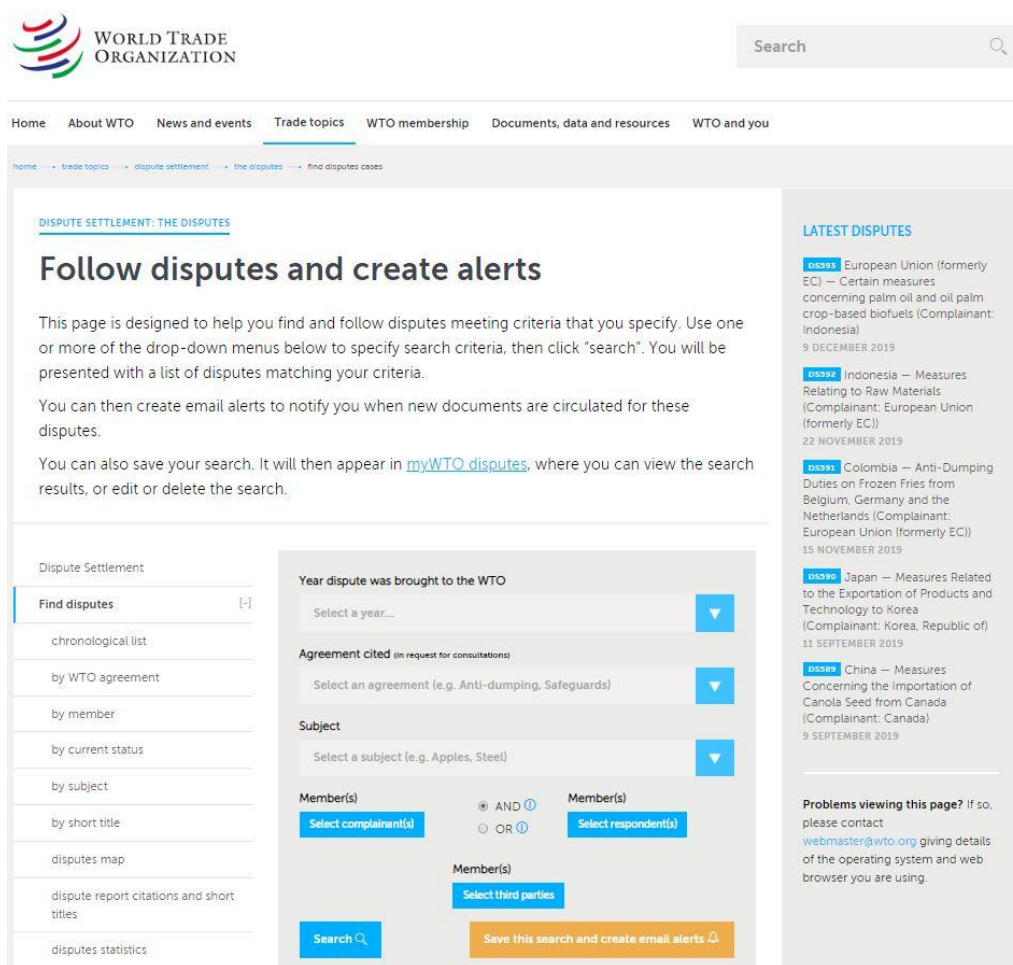
¹⁰² For a brief summary of the case, see Box II.1.

¹⁰³ For a brief summary of the cases, see Box III.4.

¹⁰⁴ For a brief summary of the cases, see Box III.3.

¹⁰⁵ For a brief summary of the case, see Box III.1.

Figure IX.2 Accessing dispute settlement documents at www.wto.org/finddisputes



A more detailed description of the dispute settlement system can be found in the WTO Secretariat publication *A Handbook on the WTO Dispute Settlement System*.¹⁰⁶ A useful resource on the legal interpretation and application of the WTO agreements by the Appellate Body, dispute settlement panels and other WTO bodies is the *WTO Analytical Index: Guide to Law and Practice*, available at www.wto.org/analyticalindex. It provides information on the jurisprudence and practice relating to each provision of the WTO agreements.

The provisions of the GATT 1994 referred to in the TRIPS Agreement and the DSU are not included in this volume. They can be found in *The WTO Agreements: The Marrakesh Agreement Establishing the World Trade Organization and its Annexes*,¹⁰⁷ *A Handbook*

¹⁰⁶ *A Handbook on the WTO Dispute Settlement System*, 2nd edn (Cambridge University Press, 2017).

¹⁰⁷ *The WTO Agreements: The Marrakesh Agreement Establishing the World Trade Organization and its Annexes* (Cambridge University Press, 2017).

on the WTO Dispute Settlement System, and on the WTO website,
www.wto.org/legaltexts.