It is common for legal challenges to WHO FCTC measures to raise intellectual property arguments. WHO FCTC Parties should be aware that:

- Tobacco companies do not have a right under international law to use their trademarks
- TRIPS article 20 only prevents ‘encumbrances’ on the use of trade marks if these are
‘unjustifiable’ and ‘by special requirements’

- The WTO’s Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement)’s objective and principles, as well as the WTO Ministerial Council’s Doha Declaration on TRIPS and public health, provides that the TRIPS Agreement should be interpreted consistently with public health.

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Introduction

The protection of intellectual property is a common theme in many legal challenges brought against WHO FCTC measures. Many of these challenges will cite the Agreement on Trade-Related Aspects of Intellectual Property Rights (or ‘TRIPS’ Agreement), a WTO agreement that sets out minimum standards of intellectual property protection that WTO member states agree to implement into domestic law. Examples of legal challenges raising TRIPS-related issues include, among others:

- the challenge to Australia’s plain packaging before a dispute settlement panel of the WTO
- the challenge to Uruguay’s packaging and labelling laws before an arbitral tribunal conducted under the Uruguay-Switzerland BIT
- the challenge to the UK’s standardized packaging in the High Court and Court of Appeal of England and Wales
- the challenge to Uganda’s graphic health warnings provisions of its Tobacco Control Law before the Constitutional Court of Uganda

It is also common for countries to receive threats of litigation from the tobacco industry that cite TRIPS. Generally, tobacco companies will allege that a measure prevents them from using their trademarks, or more generally fails to provide their trademarks with sufficient protection. TRIPS arguments will often also appear in domestic or investment law in conjunction with arguments about expropriation or other protections for private property.

These arguments generally suffer from a number of misconceptions regarding the nature of the obligations under TRIPS. In particular:

- there is no right to use a trademark under international law, so a measure implementing the WHO FCTC cannot infringe that right
- TRIPS article 20 only prohibits encumbrances that are ‘by special requirements’ and ‘unjustifiable’
- TRIPS must be interpreted in line with its general principles and objectives, which affirm that TRIPS obligations should be interpreted with regard to public health goals.

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20 default 2. No right to use a trademark line Item 1
Trademarks are distinctive signs used to distinguish the goods and services of one business from those of another business [tooltip hint="See, e.g., TRIPS article 15"][*][/tooltip]. In most domestic systems, most legal protections for trademarks depend on the trademark holder registering the trademark with the relevant authorities.

TRIPS aims to harmonise some aspects of trademark law across countries, and as such contains obligations to:

- provide for the registration of trademarks on a non-discriminatory basis (although a WTO member may decline to register offensive or misleading trademarks) – contained in article 15
- provide trademark owners with rights to prevent third parties from using their trademarks – contained in article 16

Notably, TRIPS does not include an obligation to allow the trademark to be used (e.g. by being displayed in marketing/advertising), or grant the trademark holder rights to prevent the State from regulating the use of a trademark (e.g. by restricting such marketing/advertising). Trademarks are what are known as negative rights - rights to prevent third parties from doing something. They are not positive rights that grant the trademark owner the right to do something themselves. They can be asserted only against other private actors, and not against the state. That trademarks are negative rights has been recognised in the Australia – Plain Packaging WTO decision (panel report at 7.1978), by other WTO panels (EC – Geographical Indications, at para 7.610-7.611 of the US panel report and para 7.610-7.611 of the Australia panel report), by the investment tribunal in Philip Morris v. Uruguay, and by domestic courts in the United Kingdom, France, Australia, and Uganda.

This means that provided they are implemented by restricting use rather than registration and do not affect the rights of tobacco companies to prevent competitors from using their marks, WHO FCTC-implementing measures are unlikely to fall within the scope of TRIPS’ protections for trademark registration or the rights of trademark holders.

20 default 3. No right to use a geographical indication or design line Item 2
Claims are also sometimes made in relation to other forms of intellectual property, most commonly geographical indications (which protect ways of identifying the place that a product is from and the characteristics it has as a result of that place of origin) or industrial designs (which protect new or original designs). Like trademarks, these rights are expressed in negative terms under TRIPS, and they likewise do not grant their owners rights against state regulation.[tooltip hint="See, e.g., EC - Geographical Indications (US), para. 7.210, EC - Geographical Indications (Australia), para. 7.246; Australia – Plain Packaging, para 7.2950-52"][*][/tooltip]
20 default 4. Unjustifiable encumbrances by special requirements line Item 2

A further argument has been made in relation to article 20 of TRIPS, which provides that the use of a
trademark in the course of trade ‘shall not be unjustifiably encumbered by special requirements, such
as ... use in a special form or use in a manner detrimental to its capability to distinguish the goods or
services of one undertaking from those of other undertakings.’ The meaning of this provision was a
key part of the Australia – Plain Packaging WTO dispute.

Article 20 prohibits only ‘unjustifiable’ encumbrances. It is likely that measures implementing the
WHO FCTC, an evidence-based multilateral public health treaty with 181 parties, will be justifiable.
According to the panel in Australia – Plain Packaging, whether an encumbrance by special
requirements is ‘unjustifiable’ involves an assessment of:

- The nature and extent of the encumbrance resulting from the special requirements, bearing in
  mind the legitimate interest of the trademark owner in using its trademark in the course of trade
  and thereby allowing the trademark to fulfil its intended function;
- The reasons for which the special requirements are applied, including any societal interests they
  are intended to safeguard
- Whether these reasons provide sufficient support for the resulting encumbrance

According to the panel, the need to address the ‘exceptionally grave’ health effects of tobacco use
and exposure to tobacco smoke, including by prohibiting and regulating the appearance of
trademarks, provided sufficient support for the encumbrances required by plain packaging. The panel
also noted that the importance of the public health reasons for adopting plain packaging is
underscored by the fact that plain packaging implemented the WHO FCTC, ‘which was “developed in
response to the globalization of the tobacco epidemic” and has been ratified in 180 countries’’. This
reasoning suggests that any encumbrances caused by measures implementing the WHO FCTC in good
faith are generally likely to be justifiable under article 20.

Additionally, article 20 only applies to encumbrances by ‘special requirements’. The panel in Australia
– Plain Packaging considered a special requirement to be ‘a condition which must be complied with;
has a close connection with or specifically addresses the use of trademarks; and is limited in
application’. In the case of plain packaging, this definition covered both prohibitions on figurative and
image trademarks, as well as requirements on how word marks should be displayed. The panel did not
elaborate on the test for a special requirement outside of the context of plain packaging, as it was
accepted by all of the parties to the dispute that general regulatory measures, such as advertising
bans, did not fall within the scope of article 20. However, it appears from the panel's reasoning that a
measure must be quite specifically linked to trademarks to be a 'special requirement', which means
that it is likely that many tobacco control measures are not caught by article 20.
The above provisions must all be interpreted in accordance with the general interpretive principles of TRIPS. These are as follows:

- Articles 7 and 8 of the TRIPS Agreement, which are its general principles and objectives clauses, emphasise that intellectual property rights serve public purposes, and are not ends in their own right. Article 7 refers to the need to protect and enforce intellectual property rights ‘in a manner conducive to social and economic welfare, and to a balance of rights and obligations’, and Article 8 provides that WTO Members may ‘adopt measures necessary to protect public health...provided that such measures are consistent with’ the TRIPS Agreement.

- The Doha Declaration on TRIPS and Public Health, adopted by the WTO Ministerial Conference (a meeting of all WTO members) in 2001, is also relevant in interpreting the TRIPS Agreement. The Declaration states that the TRIPS Agreement ‘does not and should not prevent Members from taking measures to protect public health’ and that TRIPS ‘can and should be interpreted and implemented in a manner supportive of WTO Members’ right to protect public health.’ While drafted in the context of access to medicines, the scope of the Doha Declaration is clearly expressed in much broader terms and covers public health measures more generally. The Australia – Plain Packaging panel recognised that the Doha Declaration is a subsequent agreement to TRIPS under article 31(3)(a) of the Vienna Convention on the law of treaties, and that the specific flexibilities recognised in paragraph 5 of the Doha Declaration are therefore to be taken into account in interpreting TRIPS.

The relevance of these statements to tobacco control is supported by statements of the WHO FCTC Conference of the Parties in the Punta del Este Declaration on the Implementation of the WHO Framework Convention on Tobacco Control, adopted at its fourth session, in November 2010, where the COP:

- recalled the statement in the Doha Declaration that the TRIPS Agreement ‘can and should be interpreted and implemented in a manner supportive of WTO Members’ right to protect public health’
- declared that, in light of Articles 7 and 8 and the Doha Declaration, ‘Parties may adopt measures to protect public health, including regulating the exercise of intellectual property rights in accordance with national public health policies, provided that such measures are consistent with the TRIPS Agreement.’

European Communities – Protection of Trademarks and Geographical Indications (United States), Panel Report, WT/DS174/R, 21 March 2005

European Communities – Protection of Trademarks and Geographical Indications (Australia), Panel Report, WT/DS290/R, 15 March 2005

British American Tobacco v. Secretary of State for Health [2016] EWHC 1169 (Admin)

British American Tobacco v. Secretary of State for Health [2016] EWCA Civ 1182

Philip Morris Brands Sàrl, Philip Morris Products S.A. and Abal Hermanos S.A. v. Oriental Republic of Uruguay, Award, ICSID Case No. ARB/10/7, 8 July 2016