

REVIEW OF LEGISLATION

Responses from Papua New Guinea to follow-up questions posed by Switzerland

Addendum

By means of a communication from the delegation of Papua New Guinea dated 12 November 2001, the Secretariat has received the following responses to the follow-up questions posed by Switzerland and circulated in document IP/C/W/239/Add.2.¹

A. PATENTS

Ad response to question 3:

In your answer, you mention that the condition set out in Article 31(e) of the TRIPS Agreement is not expressly mentioned in your legislation. Does this mean that this provision is directly applicable in your legislation?

Section 32 of the Patents and Industrial Designs Act 2000 (certified only) clearly seeks to enforce Article 31 of the TRIPS Agreement. Despite the unexpressed provision for Article 31(e), it can reasonably be implied that assignment (of the right to use of the subject matter of a patent) is not a right acquired with the right to use the subject matter of a patent. The Act clearly limits the right (of the authorized person) to use the subject matter of a patent only, and not to any other rights. The said Section also expressed in Sub-section (6)(c) that: -

"(6) The exploitation of a patented invention which is authorized by the Minister (under sub-sub-section (1)): -

(c) shall not exclude:

- (i) the conclusion of licensing contracts by the owner of the patent; and
- (ii) the continued exercise, by the owner of the patent, of his rights under Section 29(1)."

¹ Papua New Guinea's responses to Switzerland's initial questions were circulated in document IP/C/W/292.

The basis of Section 32 is founded on Article 31 of the TRIPS Agreement, and therefore its intention, purpose and scope can be ascertained by, and/or, linked to, this Article of the TRIPS Agreement.

B. PROTECTION OF UNDISCLOSED INFORMATION

Ad response to question 5:

You mention that there is no legislation governing undisclosed information in your country. Does this mean that the obligations contained in Article 39 of the TRIPS Agreement are directly applicable in your legislation?

From the body of current PNG IP or IP related legislation, protection of undisclosed information would be impossible due to lack of provision for this. However, although there is no legislation in place for the protection of undisclosed information, the Article's definition of this subject under Article 39(2) (a), (b) and (c) clearly qualify this matter as trade secret under the principles of trade secret law under Common Law and Equity. The British Common Law and Equity is adopted by the PNG National Constitution to constitute part of the country's underlying law.

An alternative would be, for example, to incorporate protection clauses into confidentiality agreements or contract clauses to be governed under the Common Law principles of Contract Law.

Because of the harmonious definition of undisclosed information with trade secret, the obligations as contained in the Article are directly applicable in PNG under the underlying law and therefore may be enforced as such thereunder.
